

# Chapter 600 Parts, Form, and Content of Application

<b>601</b>	<b>Content of Provisional and Nonprovisional Applications</b>	<b>60201(c)(2)</b>	Correcting or Updating Inventor Name 37 CFR 1.48(f) – Request Filed On or After September 16, 2012
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## 601 Content of Provisional and Nonprovisional Applications [R-07.2022]

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

*[Editor Note: Applicable to any patent application filed under this provision on or after December 18, 2013. See [pre-PLT \(AIA\) 35 U.S.C. 111](#) or [pre-AIA 35 U.S.C. 111](#) for the law otherwise applicable.]*

#### (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](#);
- (B) a drawing as prescribed by [section 113](#); and
- (C) an oath or declaration as prescribed by [section 115](#).

(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

(4) FILING DATE.—The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States 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 [section 112\(a\)](#); and
- (B) a drawing as prescribed by [section 113](#).

(2) CLAIM.—A claim, as required by subsections (b) through (e) of [section 112](#), shall not be required in a provisional application.

(3) FEE.—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing

date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

(4) FILING DATE.—The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States 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\(e\)\(3\)](#), 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](#), [365\(a\)](#), or [386\(a\)](#) or to the benefit of an earlier filing date in the United States under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#).

(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 131](#) and [135](#).

(c) PRIOR FILED APPLICATION.—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

- (1) the application is revived under [section 27](#); and
- (2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

### 35 U.S.C. 111 (pre-PLT (AIA)) Application.

*[Editor Note: Applicable to any patent application filed on or after September 16, 2012, and before December 18, 2013. See [35 U.S.C. 111](#) or [pre-AIA 35 U.S.C. 111](#) for the law otherwise applicable.]*

## (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](#);
- (B) a drawing as prescribed by [section 113](#); and
- (C) an oath or declaration as prescribed by [section 115](#).

(3) FEE AND OATH OR DECLARATION.—The application must be accompanied by the fee required by law. The fee and oath or declaration 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 or declaration 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 or declaration 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 [section 112\(a\)](#); and
- (B) a drawing as prescribed by [section 113](#).

(2) CLAIM.—A claim, as required by subsections (b) through (e) 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\(e\)\(3\)](#), 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\(a\)](#) or to the benefit of an earlier filing date in the United States under [section 120](#), [121](#), or [365\(c\)](#).

(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 131](#) and [135](#).

[Pre-AIA 35 U.S.C. 111](#) requirements substantially correspond to those of [pre-PLT \(AIA\) 35 U.S.C. 111](#), but do not include conforming amendments with regard to the oath or declaration provisions and other miscellaneous provisions of the AIA.

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

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office. An application transmittal letter limited to the transmittal of the documents and fees comprising a patent application under this section may be signed by a juristic applicant or patent owner.

(b) A complete application filed under [§ 1.53\(b\)](#) or [§ 1.53\(d\)](#) comprises:

- (1) A specification as prescribed by [35 U.S.C. 112](#), including a claim or claims, see [§§ 1.71](#) to [1.77](#);
- (2) The inventor's oath or declaration, see [§§ 1.63](#) and [1.64](#);
- (3) Drawings, when necessary, see [§§ 1.81](#) to [1.85](#); and
- (4) The prescribed filing fee, search fee, examination fee, and application size fee, see [§ 1.16](#).

(c) A complete provisional application filed under [§ 1.53\(c\)](#) comprises:

- (1) A cover sheet identifying:
  - (i) The application as a provisional application,
  - (ii) The name or names of the inventor or inventors, (see [§ 1.41\(a\)\(2\)](#)),
  - (iii) The residence of each named inventor,
  - (iv) The title of the invention,
  - (v) The name and registration number of the attorney or agent (if applicable),
  - (vi) The docket number used by the person filing the application to identify the application (if applicable),

(vii) The correspondence address, and

(viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(2) A specification as prescribed by [35 U.S.C. 112\(a\)](#), see § [1.71](#);

(3) Drawings, when necessary, see §§ [1.81](#) to [1.85](#); and

(4) The prescribed filing fee and application size fee, see § [1.16](#).

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

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

The following guidelines illustrate the preferred layout and content of patent applications filed under [35 U.S.C. 111\(a\)](#). These guidelines are suggested for the applicant's use. See also [37 CFR 1.77](#) and [MPEP § 608.01\(a\)](#). If an application data sheet ([37 CFR 1.76](#)) is used, data supplied in the application data sheet need not be provided elsewhere in the application with one exception for applications filed before September 16, 2012. For such applications, the citizenship of each inventor must be provided in the oath or declaration under [pre-AIA 37 CFR 1.63](#) even if this information is provided in the application data sheet (see [pre-AIA 37 CFR 1.76\(b\)](#)). If there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors which is governed by [37 CFR 1.41](#) and, for applications filed before September 16, 2012, the citizenship of the inventors. See [MPEP § 601.05](#).

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

### *Arrangement and Contents of the Specification*

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

(A) Title of the invention. (See [MPEP § 606](#)).

(B) Cross-reference to related applications. (See [MPEP § 211 et seq.](#)).

(C) Statement regarding federally sponsored research or development. (See [MPEP § 310](#)).

(D) The names of the parties to a joint research agreement (see [37 CFR 1.71\(g\)](#)).

(E) An incorporation by reference statement regarding the material in:

(1) One or more ASCII plain text files, submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see [37 CFR 1.52\(e\)\(8\)](#)) for the following document types:

(2) An XML file for a "Sequence Listing XML" (see [37 CFR 1.831\(a\)](#)), submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see [37 CFR 1.52\(e\)\(8\)](#)).

(F) Statement regarding prior disclosures by an inventor or joint inventor.

(G) Background of the invention. (See [MPEP § 608.01\(c\)](#)).

(1) Field of the invention.

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

(H) Brief summary of the invention. (See [MPEP § 608.01\(d\)](#)).

(I) Brief description of the several views of the drawing. (See [MPEP § 608.01\(f\)](#)).

(J) Detailed description of the invention. (See [MPEP § 608.01\(g\)](#)).

(K) Claim(s) (commencing on a separate sheet). (See [MPEP § 608.01\(i\)-\(p\)](#)).

(L) Abstract of the Disclosure (commencing on a separate sheet). (See [MPEP § 608.01\(b\)](#)).

(M) “Sequence Listing”, if present and submitted as a PDF image file via the USPTO patent electronic filing system or on physical sheets of paper (see 37 CFR 1.821(c) (2) and (3)).

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

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

A cover sheet providing identifying information is required for a complete provisional application. In accordance with [37 CFR 1.51\(c\)\(1\)](#) the cover sheet must state that it is for a provisional application, it must identify and give the residence of the inventor or inventors, and it must give a title of the invention. The cover sheet must also give the name and registration number of the attorney or agent (if applicable), the docket number used by the person filing the application (if applicable) and the correspondence address. If there is a governmental interest, the cover sheet must include a statement as to rights to inventions made under federally sponsored research and development (See [MPEP § 310](#)). [37 CFR 1.51\(c\)\(1\)\(viii\)](#) requires the name of the government agency and the contract number, if the invention was developed by or while under contract with an agency of the U.S. government.

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

This cover sheet information enables the Office to prepare a proper filing receipt and provides the

Office of Patent Application Processing (OPAP) with most of the information needed to process the provisional application. See [MPEP § 201.04](#) for a sample cover sheet.

## III. THE APPLICATION

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

The paper standard requirements for papers submitted as part of the record of a patent application is covered in [MPEP § 608.01](#), subsection I. Determination of completeness of an application is covered in [MPEP § 506](#) and [§ 601.01](#) *et seq.*

The elements of the application are stored together in an electronic file wrapper, bearing appropriate identifying data including the application number and filing date ([MPEP § 719](#)).

See also the following the MPEP sections.

Provisional applications, [MPEP § 201.04](#).

Divisional applications, [MPEP § 201.06](#).

Continuation applications, [MPEP § 201.06\(c\)](#).

Continued prosecution applications, [MPEP § 201.06\(d\)](#).

Reissue applications, [MPEP § 1401](#).

Design applications, [MPEP Chapter 1500](#).

Plant applications, [MPEP Chapter 1600](#).

International applications filed under the Patent Cooperation Treaty (PCT), [MPEP Chapter 1800](#).

International Applications, commencement and entry into national stage, [MPEP § 1893.01](#).

Biotechnology applications, [MPEP Chapter 2400](#).

International design applications, [MPEP Chapter 2900](#).



*Ex Parte* Reexamination, [MPEP Chapter 2200](#).

*Inter Partes* Reexamination, [MPEP Chapter 2600](#).

Supplemental Examination, [MPEP Chapter 2800](#).

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

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

## 601.01 Complete Application [R-07.2022]

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

*[Editor Note: Paragraphs (b), (c), (f) and (h) below have limited applicability as follows:*

- (1) Paragraph (c)(4) is applicable to all applications irrespective of filing date;
- (2) Paragraphs (b) and (c), are applicable only to patent applications filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013. See [pre-PLT \(AIA\) 37 CFR 1.53](#) for paragraphs (b) and (c) otherwise in effect;
- (3) Paragraph (f), effective December 18, 2013, and paragraph (h), effective September 16, 2012, are applicable only to patent applications filed under [35 U.S.C. 111\(a\)](#) on or after September 16, 2012. See [pre-AIA 37 CFR 1.53](#) for paragraphs (f) and (h) otherwise in effect.]

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

(b) *Application filing requirements — Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by [35 U.S.C. 112](#), including at least one claim, and any required drawings are received in the 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, 365\(c\)](#), or [386\(c\)](#) and [§ 1.78](#).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named

in the prior application may be filed under this paragraph or paragraph (d) of this section.

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

(c) *Application filing requirements — Provisional application.* The filing date of a provisional application is the date on which a specification, with or without claims, is received in the 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; or
- (iii) Expiration of twelve months after the filing date of 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 [35 U.S.C. 112\(b\)](#), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by [35 U.S.C.](#)

[112\(b\)](#). 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, and the surcharge required by [§ 1.16\(f\)](#) if either the basic filing fee for a nonprovisional application or the inventor's 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](#), [365\(a\)](#), or [386\(a\)](#) or [§ 1.55](#), or to the benefit of an earlier filing date under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) or [§ 1.78](#) of any other application. No claim for priority under [35 U.S.C. 119\(e\)](#) or [§ 1.78\(a\)](#) may be made in a design application based on a provisional application. A provisional application disclosing nucleotide and/or amino acid sequences is not required to include a separate sequence listing; however, if submitted in a provisional application filed on or after July 1, 2022, any submission of nucleotide and/or amino acid sequence data must be by way of a "Sequence Listing XML" in compliance with §§ [1.831](#) through [1.834](#).

(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, but not an international design application, that is complete as defined by [§ 1.51\(b\)](#) except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in [§ 1.53\(f\)\(3\)\(i\)](#); and
- (iii) The application under this paragraph is filed before the earliest of:
  - (A) Payment of the issue fee on the prior application, unless a petition under [§ 1.313\(c\)](#) is granted in the prior application;
  - (B) Abandonment of the prior application; or
  - (C) Termination of proceedings on the prior application.

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

- (i) Must identify the prior application;

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

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

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

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

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in [§ 1.16\(b\)](#), the search fee as set forth in [§ 1.16\(l\)](#), and the examination fee as set forth in [§ 1.16\(p\)](#).

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

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

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

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



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

- (i) Title of invention;
- (ii) Name of applicant(s); and
- (iii) Correspondence address.

(9) See [§ 1.103\(b\)](#) for requesting a limited suspension of action in an application filed under this paragraph.

(e) Failure to meet filing date requirements.

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

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

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

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

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, search fee, or examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include at least one claim or the inventor's oath or declaration ([§§ 1.63, 1.64, 1.162](#) or [1.175](#)), and the applicant has provided a correspondence address ([§ 1.33\(a\)](#)), the applicant will be notified and given a period of time within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by [§ 1.16\(f\)](#) to avoid abandonment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, search fee, examination fee, at least one claim, or the inventor's oath or declaration, and the applicant

has not provided a correspondence address ([§ 1.33\(a\)](#)), the applicant has three months from the filing date of the application within which to file a claim or claims, pay the basic filing fee, search fee, and examination fee, and pay the surcharge required by [§ 1.16\(f\)](#) to avoid abandonment.

(3) The inventor's oath or declaration in an application under [§ 1.53\(b\)](#) must also be filed within the period specified in paragraph (f)(1) or (f)(2) of this section, except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in paragraphs (f)(3)(i) and (f)(3)(ii) of this section.

(i) The application must be an original (non-reissue) application that contains an application data sheet in accordance with [§ 1.76](#) identifying:

(A) Each inventor by his or her legal name;

(B) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(ii) The applicant must file each required oath or declaration in compliance with [§ 1.63](#), or substitute statement in compliance with [§ 1.64](#), no later than the date on which the issue fee for the patent is paid. If the applicant is notified in a notice of allowability that an oath or declaration in compliance with [§ 1.63](#), or substitute statement in compliance with [§ 1.64](#), executed by or with respect to each named inventor has not been filed, the applicant must file each required oath or declaration in compliance with [§ 1.63](#), or substitute statement in compliance with [§ 1.64](#), no later than the date on which the issue fee is paid to avoid abandonment. This time period is not extendable under [§ 1.136](#) (see [§ 1.136\(c\)](#)). The Office may dispense with the notice provided for in paragraph (f)(1) of this section if each required oath or declaration in compliance with [§ 1.63](#), or substitute statement in compliance with [§ 1.64](#), has been filed before the application is in condition for allowance.

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

(5) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See [§ 1.63\(d\)](#) concerning the submission of a copy of the inventor's oath or declaration from the prior application for a continuing application under paragraph (b) of this section.

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

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

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

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

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

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

(h) *Subsequent treatment of application — Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that the inventor's oath or declaration may be filed when the application is otherwise in condition for allowance pursuant to paragraph (f)(3) of this section and minor informalities may be waived subject to subsequent correction whenever required.

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

**37 CFR 1.53 pre-PLT (AIA) Application number, filing date, and completion of application.**

[Editor Note: Paragraphs (b) and (c)(1) to (3) are applicable to patent applications filed under [35 U.S.C. 111](#) before December 18, 2013. For the text of paragraphs (a), (c)(4), (d), (e), (g), and (i) applicable to patent applications filed under [35 U.S.C. 111](#) before December 18, 2013, see [37 CFR 1.53](#). For the text of paragraphs (f) and (h), see [37 CFR 1.53](#) for applications filed under [35 U.S.C. 111](#) on or after September 16, 2012 and see [pre-AIA 37 CFR 1.53](#) for applications filed before September 16, 2012.]

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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\(c\) and \(d\)](#).

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

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

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by [35 U.S.C. 112\(a\)](#), 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; or

(iii) Expiration of twelve months after the filing date of 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 [35 U.S.C. 112\(b\)](#), unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by [35 U.S.C. 112\(b\)](#). 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, the inventor's oath or declaration, and the surcharge required by [§ 1.16\(f\)](#) if either the basic filing fee for a nonprovisional application or the inventor's oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

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

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

*[Editor Note: Applicable to patent applications filed under pre-AIA 35 U.S.C. 111 before September 16, 2012. For the text of paragraphs (a), (c)(4), (d), (e), (g), and (i) applicable to patent applications filed under 35 U.S.C. 111 before September 16, 2012, see 37 CFR 1.53. For the text of paragraphs (b) and (c)(1) to (3) applicable to patent applications filed under 35 U.S.C. 111 before September 16, 2012, see pre-PLT (AIA) 37 CFR 1.53.]*

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

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

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the

basic filing fee, the search fee, the examination fee, or an oath or declaration by the applicant pursuant to [§§ 1.63, 1.162](#) or [§ 1.175](#), and applicant has not provided a correspondence address ([§ 1.33\(a\)](#)), applicant has two months from the filing date of the application within which to pay the basic filing fee, search fee, and examination fee, file an oath or declaration, and pay the surcharge required by [§ 1.16\(f\)](#) to avoid abandonment.

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

(4) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. See [§ 1.63\(d\)](#) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.

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

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

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[37 CFR 1.53](#) relates to application numbers, filing dates, and completion of applications. Note that the substantive requirements under [37 CFR 1.53](#) for applications filed on or after September 16, 2012 as compared to those filed prior to September 16, 2012 (pre-AIA) are the same with the exception of [37 CFR 1.53\(f\)](#), pertaining to completion of a nonprovisional application subsequent to filing. Also, note that the filing date requirements under [37 CFR 1.53\(b\) and \(c\)](#) for applications filed on or after December 18, 2013 are different from those filed prior to December 18, 2013. For example, under [37 CFR 1.53\(b\)](#), except for design applications, nonprovisional applications filed on or after December 18, 2013 may receive a filing date even if the application is filed without claims or drawings.

See [MPEP § 601.01\(a\)](#) for additional information. Similarly, provisional applications filed on or after December 18, 2013 may receive a filing date even if the application is filed without drawings. See [MPEP § 601.01\(b\)](#) for additional information. If the subject matter of a nonprovisional application admits of illustration by a drawing to facilitate understanding of the invention, including where a drawing is necessary for the understanding of the invention, the Office will continue the practice of requiring a drawing. See [MPEP § 608.02](#) (item IV). Any claim or any drawing submitted after the filing date of an application may not contain new matter. [37 CFR 1.53\(a\)](#) indicates that an application number is assigned for identification purposes to any paper which purports to be an application for a patent, even if the application is incomplete or informal. The remaining sections of [37 CFR 1.53](#) treat nonprovisional applications filed under [35 U.S.C. 111\(a\)](#) separately from provisional applications filed under [35 U.S.C. 111\(b\)](#).

[37 CFR 1.53\(d\)](#) sets forth the filing date requirements for a continued prosecution application (CPA). A CPA is a nonprovisional application which must be filed on or after December 1, 1997. Only a continuation or divisional application (but not a continuation-in-part) may be filed as a CPA. See [MPEP § 201.06\(d\)](#). CPA practice under [37 CFR 1.53\(d\)](#) does not apply to utility and plant applications. CPAs can only be filed in design applications filed under [35 U.S.C. 111\(a\)](#).

## **601.01(a) Nonprovisional Applications Filed Under 35 U.S.C. 111(a) [R-07.2022]**

### **I. APPLICATION FILING REQUIREMENTS**

The procedure for filing a nonprovisional application under [35 U.S.C. 111\(a\)](#) is set forth in [37 CFR 1.53\(b\)](#) and [37 CFR 1.53\(d\)](#). [37 CFR 1.53\(b\)](#) may be used to file any original, reissue, or substitute nonprovisional application and any continuing application, i.e., continuation, divisional, or continuation-in-part.

Except for design applications, the filing date for applications filed under [35 U.S.C. 111](#) on or after December 18, 2013 is the date on which a specification, with or without claims, is received in

the Office. The filing date for a design application, except for a continued prosecution application (CPA) under [37 CFR 1.53\(d\)](#), is the date on which the specification as required by [35 U.S.C. 112](#), including at least one claim, and any required drawings are received in the Office. Effective for applications filed on or after December 18, 2013, [37 CFR 1.53\(b\)](#) was amended to implement the changes to [35 U.S.C. 111\(a\)](#) and [35 U.S.C. 171](#) by the Patent Law Treaties Implementation Act of 2012 (PLTIA) (Public Law 112-211). [35 U.S.C. 111\(a\)](#) now provides minimal formal requirements necessary for an application to be entitled to a filing date to safeguard against the loss of a filing date due to a technicality. However, these minimal formal requirements should not be viewed as prescribing a best practice for the preparation and filing of a patent application. The preparation of claims to any claimed invention for which patent protection is desired and the inclusion of such claims with the application on filing will help ensure that the application satisfies the disclosure requirements of [35 U.S.C. 112\(a\)](#) for any such claimed invention.

For applications filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013, a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the U.S. Patent and Trademark Office (Office). See [pre-PLT \(AIA\) 37 CFR 1.53\(b\)](#).

Failure to meet any of the requirements in [37 CFR 1.53\(b\)](#) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all of the requirements of [37 CFR 1.53\(b\)](#) are met.

[37 CFR 1.53\(d\)](#) may be used to file either a continuation or a divisional application (but not a continuation-in-part) of a design application. The prior nonprovisional application must be a design application, but not an international design application, that is complete as defined by [37 CFR 1.51\(b\)](#), except for the inventor's oath or declaration if the continued prosecution application (CPA) is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet indicating the name, residence, and mailing address of each inventor. Any application



filed under [37 CFR 1.53\(d\)](#) must disclose and claim only subject matter disclosed in the prior nonprovisional application and must name as inventors the same or less than all of the inventors named in the prior nonprovisional application. Under [37 CFR 1.53\(d\)](#), the filing date assigned is the date on which a request, on a separate paper, for an application under [37 CFR 1.53\(d\)](#) is filed. An application filed under [37 CFR 1.53\(d\)](#) must be filed before the earliest of:

(A) payment of the issue fee on the prior application, unless a petition under [37 CFR 1.313\(c\)](#) is granted in the prior application;

(B) abandonment of the prior application; or

(C) termination of proceedings on the prior application.

The filing fee, search fee and examination fee for an application filed under [37 CFR 1.53\(b\)](#) or [37 CFR 1.53\(d\)](#) and the oath or declaration for an application filed under [37 CFR 1.53\(b\)](#) can be submitted after the filing date. In addition, for applications, other than design applications, filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, the claims and drawings may be submitted after the filing date, within such period and under such conditions, including the payment of a surcharge, as prescribed by the Office. See subsection II below for more information on completion of an application subsequent to filing. However, no amendment (including the submission of claims and drawings) may introduce new matter into the disclosure of an application after its filing date. Drawings should be submitted on filing if necessary for the understanding of the invention.

If the required basic filing fee is not paid during the pendency of the application, the application will be disposed of.

The basic filing fee must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in a subsequent nonprovisional application, international application, or international design application.

See [37 CFR 1.78](#). Copies of an application will be provided by the USPTO upon request and payment

of the fee set forth in [37 CFR 1.19\(b\)](#) unless the application has been disposed of (see [37 CFR 1.53\(e\)](#) and [\(f\)](#)).

[37 CFR 1.53\(h\)](#) indicates that a patent application will not be forwarded for examination on the merits until all required parts have been received, except applications filed on or after September 16, 2012 will be forwarded for examination even if lacking the inventor's oath or declaration provided that a compliant application data sheet (ADS) is filed.

## II. COMPLETION OF NONPROVISIONAL APPLICATION UNDER 35 U.S.C. 111 SUBSEQUENT TO FILING

For applications filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, except for design applications, a filing date is granted to a nonprovisional application when a specification, with or without claims, is received in the Office. The filing date for a design application, except for a continued prosecution application (CPA) under [37 CFR 1.53\(d\)](#), is the date on which the specification as required by [35 U.S.C. 112](#), including at least one claim, and any required drawings are received in the Office.

For applications filed prior to December 18, 2013, a filing date is granted to a nonprovisional application for patent that includes at least 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 referred to in the specification or required by [37 CFR 1.81\(a\)](#), which is filed in the U.S. Patent and Trademark Office.

### ***A. Completion of Nonprovisional Application That Is Filed On or After December 18, 2013 And Is Not A Design Application***

*[Editor Note: See subsection B., below, for information that pertains to all applications filed under [35 U.S.C. 111\(a\)](#) on or after September 16, 2012 (including utility and plant patent applications filed on or after December 18, 2013 and design patent applications). See subsection C., below, for information pertaining to applications filed under [35 U.S.C. 111\(a\)](#) before September 16, 2012.]*



If an application which has been accorded a filing date does not include the appropriate filing fee, search fee, examination fee, or inventor's oath or declaration, applicant will be so notified in accordance with [37 CFR 1.53\(f\)](#). See subsection II.B. below for information regarding completion of a nonprovisional application that is missing the appropriate filing fee, search fee, examination fee, or inventor's oath or declaration.

If an application which has been accorded a filing date does not include at least one claim, the applicant will be notified and given a time period to file claim(s) and pay the surcharge, if required by [37 CFR 1.16\(f\)](#), to avoid abandonment of the application provided the applicant has given a correspondence address. If the applicant failed to provide a correspondence address, the applicant has three months from the filing date of the application within which to file claim(s) and pay the surcharge required by [37 CFR 1.16\(f\)](#) to avoid abandonment of the application. Therefore, an application filed without any claims will be treated in a manner analogous to how an application without the filing fee, search fee, or examination fee is treated. See subsection B. below for more information.

If an application which has been accorded a filing date does not include any drawings, see [MPEP § 601.01\(f\)](#) for information on completing the application. If an application which has been accorded a filing date but is without all the figures of drawings, see [MPEP § 601.01\(g\)](#) for information on completing the application.

***B. Completion of Nonprovisional Application, Including Design Application, Filed On or After September 16, 2012***

*[Editor Note: See subsection A., above, for specific information regarding applications that are filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013 and are not design applications. See subsection C., below, for applications filed before September 16, 2012.]*

If an application which has been accorded a filing date does not include the appropriate filing fee, search fee, examination fee, or inventor's oath or

declaration, applicant will be so notified in accordance with [37 CFR 1.53\(f\)](#).

For applications filed before September 16, 2012, the Office issued a Notice to File Missing Parts if an application under [37 CFR 1.53\(b\)](#) did not contain the basic filing fee, the search fee, or the examination fee, or the inventor's oath or declaration, and the applicant was given a time period (usually two months) within which to file the missing basic filing fee, the search fee, the examination fee, or the inventor's oath or declaration and pay the surcharge required by [37 CFR 1.16\(f\)](#) to avoid abandonment. See subsection II.C. below for additional information regarding completion of a nonprovisional application filed before September 16, 2012.

For applications filed on or after September 16, 2012, the former missing parts practice under [pre-AIA 37 CFR 1.53\(f\)](#) was revised to allow applicants to postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. [37 CFR 1.53\(f\)](#) was further revised, effective December 18, 2013, to require that, for applications filed on or after September 16, 2012, the inventor's oath or declaration in compliance with [37 CFR 1.63](#) or a substitute statement in compliance with [37 CFR 1.64](#) must be filed no later than the date the issue fee is paid to avoid abandonment of the application. This time period is not extendable under [37 CFR 1.136](#) (see [37 CFR 1.136\(c\)](#)). The Office may dispense with the notice under [37 CFR 1.53\(f\)\(1\)](#) if each required oath or declaration in compliance with [37 CFR 1.63](#) or substitute statement in compliance with [37 CFR 1.64](#) has been filed before the application is in condition for allowance.

[37 CFR 1.53\(f\)\(1\)](#) provides for a notice (if the applicant has provided a correspondence address) if the application does not contain the basic filing fee, the search fee, or the examination fee, or if the application under [37 CFR 1.53\(b\)](#) does not contain the inventor's oath or declaration. [37 CFR 1.53\(f\)\(1\)](#) provides that applicant must pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by [37 CFR 1.16\(f\)](#) within the time period set in the notice to avoid abandonment.

[Section 1.53\(f\)\(3\)](#) (discussed subsequently) sets forth the time period for filing the inventor's oath or declaration in an application under [37 CFR 1.53\(b\)](#) and provides the conditions under which an applicant may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance.

[37 CFR 1.53\(f\)\(2\)](#) provides for the situation where applicant has not provided a correspondence address in an application under [37 CFR 1.53\(b\)](#), and the application does not contain the basic filing fee, the search fee, or the examination fee, or does not contain the inventor's oath or declaration. [37 CFR 1.53\(f\)\(2\)](#) provides that if the applicant has not provided a correspondence address, the applicant must pay the basic filing fee, search fee, and examination fee, and pay the surcharge if required by [37 CFR 1.16\(f\)](#), within three months from the filing date of the application to avoid abandonment.

[37 CFR 1.53\(f\)\(3\)](#) sets forth the time period for filing the inventor's oath or declaration in an application under [37 CFR 1.53\(b\)](#) and provides the conditions under which an applicant may postpone filing the inventor's oath or declaration until the application is otherwise in condition for allowance. [Section 1.53\(f\)\(3\)](#) specifically provides that the inventor's oath or declaration in an application under [37 CFR 1.53\(b\)](#) must also be filed within the period specified in [37 CFR 1.53\(f\)\(1\) or \(f\)\(2\)](#), except that the filing of the inventor's oath or declaration may be postponed until the application is otherwise in condition for allowance under the conditions specified in [37 CFR 1.53\(f\)\(3\)\(i\) through \(f\)\(3\)\(ii\)](#). This requires payment of the surcharge under [37 CFR 1.16\(f\)](#) if the inventor's oath or declaration (executed by or with respect to each inventor) is not submitted on filing of the application. If the surcharge is not paid at the time the application is filed, the Office will send a Notice to File Missing Parts requiring the surcharge. If, however, a general authorization to charge any required fees to a deposit account (that covers fees under [37 CFR 1.16](#)) is submitted on filing of the application, the Office will charge the surcharge in accordance with the deposit account authorization. Payment of the surcharge cannot be postponed until a Notice of Allowance issues or payment of the issue fee but must be paid

in the time period specified in [37 CFR 1.53\(f\)\(1\)](#) or [37 CFR 1.53\(f\)\(2\)](#).

[37 CFR 1.53\(f\)\(3\)\(i\)](#) provides that the application must be an original (non-reissue) application that contains an application data sheet in accordance with [37 CFR 1.76](#) identifying: (1) each inventor by their legal name; and (2) a mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor. The applicant must file an oath or declaration in compliance with [37 CFR 1.63](#), or substitute statement in compliance with [37 CFR 1.64](#), executed by or with respect to each actual inventor no later than the date on which the issue fee is paid. See [35 U.S.C. 115\(f\)](#).

If an application under [37 CFR 1.53\(b\)](#) does not include the inventor's oath or declaration but does contain the applicable filing fees (basic filing fee, search fee, the examination fee, any applicable excess claims fee, and any applicable application size fee), the surcharge required by [37 CFR 1.16\(f\)](#) (for filing the oath or declaration later than the filing date), and a signed application data sheet providing the information required by [37 CFR 1.53\(f\)\(3\)\(i\)](#), the Office will not issue a Notice to File Missing Parts requiring the applicant to file the inventor's oath or declaration.

If an application under [37 CFR 1.53\(b\)](#) that does not contain the inventor's oath or declaration also does not contain the applicable filing fees, or the surcharge required by [37 CFR 1.16\(f\)](#), or a signed application data sheet providing the information required by [37 CFR 1.53\(f\)\(3\)\(i\)](#), the Office will issue a Notice to File Missing Parts giving the applicant a time period (usually two months) within which to file the missing parts. While the inventor's oath or declaration will not be required to be filed within the period for reply to the Notice to File Missing Parts if the applicant provides a signed application data sheet providing the information required by [37 CFR 1.53\(f\)\(3\)\(i\)](#), any required filing fees and surcharge required by [37 CFR 1.16\(f\)](#) must be filed within the period for reply to the Notice to File Missing Parts to avoid abandonment.

If an application is in condition for allowance but does not include an oath or declaration in compliance with [37 CFR 1.63](#), or a substitute statement in compliance with [37 CFR 1.64](#), executed by or with respect to each actual inventor, the Office will issue a “Notice of Allowance and Fee(s) Due” (PTOL-85) together with a “Notice of Allowability” (PTOL-37) including a “Notice Requiring Inventor’s Oath or Declaration” (PTOL-2306) requiring the applicant to file an oath or declaration in compliance with [37 CFR 1.63](#), or substitute statement in compliance with [37 CFR 1.64](#), executed by or with respect to each actual inventor, no later than the date of payment of the issue fee to avoid abandonment. If applicant receives a “Notice Requiring Inventor’s Oath or Declaration” and fails to file a proper reply to the notice before or with the payment of the issue fee, the application will be regarded as abandoned. See [37 CFR 1.53\(f\)\(3\)\(ii\)](#).

**C. Completion of Nonprovisional Application Filed Before September 16, 2012**

*[Editor Note: See subsections A. and B., above, for applications filed under [35 U.S.C. 111](#) on or after December 18, 2013. See subsection B., above, for applications filed on or after September 16, 2012.]*

If an application which has been accorded a filing date does not include the appropriate filing fee, search fee, examination fee, or oath or declaration, applicant will be so notified in accordance with [pre-AIA 37 CFR 1.53\(f\)](#) and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in [37 CFR 1.16\(f\)](#) in order to prevent abandonment of the application

Applicants should submit a copy of any notice to file missing parts or notice of incomplete application with the reply submitted to the U.S. Patent and Trademark Office, unless the reply is being submitted via the USPTO patent electronic filing system. Applicants should also include the application number on all correspondence to the Office. These measures will aid the Office in matching papers to applications, thereby expediting the processing of applications.

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

The oath or declaration filed in reply to such a notice under [pre-AIA 37 CFR 1.53\(f\)](#) must be executed by the inventors and must identify the specification and any amendment filed with the specification which includes subject matter not otherwise included in the specification (including claims) or drawings of the application as filed. See [MPEP § 602](#). If an amendment is filed with the oath or declaration filed after the filing date of the application, it may be identified in the oath or declaration but may not include new matter. No new matter may be included after the filing date of the application. See [MPEP § 608.04\(b\)](#). If the oath or declaration improperly refers to an amendment filed after the filing date of the application which contains new matter, a supplemental oath or declaration will be required pursuant to [pre-AIA 37 CFR 1.67](#), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under [pre-AIA 37 CFR 1.53\(b\)](#) is filed it is a part of the original application papers and the question of new matter is not considered. Similarly, if the application papers are altered prior to execution of the oath or declaration and the filing of the application, new matter is not a consideration since the alteration is considered as part of the original disclosure.

### III. APPLICATION UNDER 35 U.S.C. 111(a) FILED BY REFERENCE

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

*[Editor Note: Applicable to any patent application filed under this provision on or after December 18, 2013. See [pre-PLT \(AIA\) 35 U.S.C. 111](#) or [pre-AIA 35 U.S.C. 111](#) for the law otherwise applicable.]*

#### (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](#);
- (B) a drawing as prescribed by [section 113](#); and
- (C) an oath or declaration as prescribed by [section 115](#).

(3) FEE, OATH OR DECLARATION, AND CLAIMS.—The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

(4) FILING DATE.—The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

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(c) PRIOR FILED APPLICATION.—Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless—

(1) the application is revived under [section 27](#); and

(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

#### **37 CFR 1.57 Incorporation by reference**

*[Editor Note: Paragraph (a) below is only applicable to patent applications filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013.]*

(a) Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with [§ 1.76](#) upon the filing of an application under [35 U.S.C. 111\(a\)](#) to a previously filed application, indicating that the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) for purposes of a filing date under [§ 1.53\(b\)](#).

(1) If the applicant has provided a correspondence address ([§ 1.33\(a\)](#)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by [§ 1.17\(i\)](#) if it is in a language other than English, and pay the surcharge required by [§ 1.16\(f\)](#), to avoid abandonment. Such a notice may be combined with a notice under [§ 1.53\(f\)](#).

(2) If the applicant has not provided a correspondence address ([§ 1.33\(a\)](#)), the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by [§ 1.17\(i\)](#) if it is in a language other than English, and pay the surcharge required by [§ 1.16\(f\)](#), to avoid abandonment.

(3) An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:

(i) The application is revived under [§ 1.137](#); and

(ii) A copy of the specification and any drawings of the previously filed application are filed in the Office.

(4) A certified copy of the previously filed application must be filed in the Office, unless the previously filed application is an application filed under [35 U.S.C. 111](#) or [363](#), or the previously filed application is a foreign priority application and the conditions set forth in [§ 1.55\(i\)](#) are satisfied with respect to such foreign priority application. The certified copy of the previously filed application, if required by this paragraph, must be filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, or be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in [§ 1.17\(g\)](#).

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Effective December 18, 2013, title II of the Patent Law Treaties Implementation Act of 2012 (PLTIA) amends the patent laws to implement the provisions of the Patent Law Treaty. Section 201(a) of the PLTIA amended [35 U.S.C. 111](#) to add [35 U.S.C. 111\(c\)](#). As provided in [35 U.S.C. 111\(c\)](#), a nonprovisional application filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, may be filed



by a reference to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. [35 U.S.C. 111\(c\)](#) specifically provides that the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under [35 U.S.C. 111\(a\)](#) to a previously filed application (specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed) shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. [35 U.S.C. 111\(c\)](#) further provides that a copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director, and that a failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. [35 U.S.C. 111\(c\)](#) finally provides that such an application shall be treated as having never been filed, unless: (1) the application is revived under [35 U.S.C. 27](#); and (2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

Effective December 18, 2013, [37 CFR 1.57](#) was amended to implement the reference filing provisions of [35 U.S.C. 111\(c\)](#). [37 CFR 1.57\(a\)](#) now provides that, subject to the conditions and requirements of [37 CFR 1.57\(a\)](#), a reference, made in the English language in an application data sheet (ADS) in accordance with [37 CFR 1.76](#) upon the filing of an application under [35 U.S.C. 111\(a\)](#), to a previously filed application, indicating that the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) for purposes of a filing date under [37 CFR 1.53\(b\)](#). Thus, the specification and any drawings of the

previously filed application will be considered in determining whether an application under [35 U.S.C. 111\(a\)](#) filed by reference under [37 CFR 1.57\(a\)](#) is entitled to a filing date under [37 CFR 1.53\(b\)](#). When an application for a design patent includes a reference to a previously filed application under [35 U.S.C. 111\(c\)](#), the previously filed application must include at least one claim. [35 U.S.C. 171](#) provides that the filing date of an application for a design patent is the date on which the specification as prescribed by [35 U.S.C. 112](#), which includes at least one claim, and any required drawings are filed.

In a reference filing under [37 CFR 1.57\(a\)](#), the reference to a previously filed application in an ADS is not sufficient to establish a priority or benefit claim to that previously filed application. Reference filing information is provided in a section of the ADS that is separate from the foreign priority information section and the domestic benefit claim information section. See [MPEP § 211 et seq.](#) for information regarding domestic benefit claims and [MPEP § 213 et seq.](#) for information regarding claims for foreign priority.

The PLT and the Regulations under the PLT provide for the establishment of Model International Forms (PLT Model forms). The PLT Model forms may be found on WIPO's Internet website at <https://wipolex.wipo.int/en/text/289773>. The requirement for a reference to the previously filed application in an ADS will be satisfied by the presentation of such reference to the previously filed application on the Patent Law Treaty Model International Request Form (PLT Model Request form). Applicants may use the PLT Model Request form for national applications under [35 U.S.C. 111](#) filed in the USPTO or national applications filed in other PLT countries. However, as provided in [37 CFR 1.76\(d\)\(2\)](#), information in an ADS will govern when inconsistent with the information supplied at any time in PLT Model forms. Furthermore, if applicants want to postpone submission of the inventor's oath or declaration until the application is in condition for allowance, an ADS that provides the inventor information is required. Accordingly, the use of an ADS to supply application information for reference filing is encouraged.



If the applicant has provided a correspondence address ([37 CFR 1.33\(a\)](#)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by [37 CFR 1.17\(i\)](#) if it is in a language other than English, and pay the surcharge required by [37 CFR 1.16\(f\)](#), to avoid abandonment. Such a notice may be combined with a notice under [37 CFR 1.53\(f\)](#) (e.g., a notice requiring that the applicant provide at least one claim and pay the filing fees). See [37 CFR 1.57\(a\)\(1\)](#).

If the applicant has not provided a correspondence address ([37 CFR 1.33\(a\)](#)), the applicant has three months from the filing date of the application under [35 U.S.C. 111\(a\)](#) filed by reference under [37 CFR 1.57\(a\)](#) to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application and the fee required by [37 CFR 1.17\(i\)](#) if it is in a language other than English, and pay the surcharge required by [37 CFR 1.16\(f\)](#), to avoid abandonment. See [37 CFR 1.57\(a\)\(2\)](#).

In response to a notice requiring a copy of the specification and drawings from the previously filed application, applicants must submit an actual copy of the specification (including any claims) and any drawings of the previously filed application without any modifications. If the specification and drawings submitted in response to the notice are modified, i.e., updated, corrected, or reformatted in any manner, such modified specification and any modified drawings would not satisfy the copy requirement of [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)](#). Any desired changes to the copy of the previously filed application must be made by way of an amendment under [37 CFR 1.121](#) without adding new matter.

An application abandoned under [37 CFR 1.57\(a\)\(1\)](#) or [\(a\)\(2\)](#) shall be treated as having never been filed, unless: (1) the application is revived under [37 CFR 1.137](#); and (2) a copy of the specification and any drawings of the previously filed application are filed in the Office. See [37 CFR 1.57\(a\)\(3\)](#).

An applicant may also claim priority to or the benefit of an application filed by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)](#). However, the phrase "treated as having never been filed" in [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)\(3\)](#) precludes an applicant from claiming priority to or the benefit of an application filed by reference that has been abandoned under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)\(1\)](#) or [1.57\(a\)\(2\)](#). An applicant may claim priority to or the benefit of an application abandoned under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)\(1\)](#) or [\(a\)\(2\)](#) only if the application is revived under [37 CFR 1.137](#) and a copy of the specification and any drawings of the previously filed application are submitted to the Office.

A certified copy of the previously filed application must be filed in the Office within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, unless the previously filed application is an application filed under [35 U.S.C. 111](#) or [35 U.S.C. 363](#), or the previously filed application is a foreign priority application and the conditions set forth in [37 CFR 1.55\(h\)](#) are satisfied with respect to such foreign priority application. See [37 CFR 1.57\(a\)\(4\)](#).

If a certified copy is required under [37 CFR 1.57\(a\)\(4\)](#) and it is not filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, the certified copy must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in [37 CFR 1.17\(g\)](#). The requirement for a certified copy of a previously filed foreign application is to ensure that the copy of the specification and any drawings subsequently provided by the applicant correspond to the specification and any drawings of the previously filed foreign application. The interim copy provision of [37 CFR 1.55\(j\)](#) is not applicable to the requirement for a certified copy of a previously filed foreign application in an application filed by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)](#).

Applicants filing by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57](#) should take care to ensure

that the application number, filing date, and intellectual property authority or country of the previously filed application is accurately specified on the ADS as the specification and drawings of the application specified on the ADS is the specification and drawings of the application being filed by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57](#). If an applicant specifies an application number, filing date, or intellectual property authority or country of an application other than the application number, filing date, or intellectual property authority or country of the intended previously filed application on the ADS (i.e., the applicant mistypes the application number, filing date, or intellectual property authority or country on the ADS), the applicant may file a petition under [37 CFR 1.53](#) to have the application accorded a filing date as of the date the specification and drawings of the intended previously filed application is filed in the Office using that specification and drawings (rather than the specification and drawings of the application specified on the ADS). Simply submitting the specification and drawings of the intended previously filed application without such a petition under [37 CFR 1.53](#) in reply to a notice under [37 CFR 1.57\(a\)](#) requiring the specification and drawings of the application specified on the ADS will result in the submission being treated as an incomplete reply. A reference filing statement made upon filing cannot be rescinded because the reference to the previously filed application constitutes the specification and any drawings of the instant application. See [35 U.S.C. 111\(c\)](#). Accordingly, to avoid the risk of incorrect filings and the required surcharge, applicants should simply file a copy of the specification and drawings of the previously filed application, if available, instead of relying upon the reference filing provisions.

If the previously filed application is also a priority application under [35 U.S.C. 119\(a\) through \(d\) and \(f\)](#), [35 U.S.C. 365\(a\) or \(b\)](#), or [35 U.S.C. 386\(a\) or \(b\)](#) and [37 CFR 1.55](#), an applicant should also consider filing a copy of the specification and drawings of the previously filed application in the Office no later than fourteen month from the filing date of the previously filed application (regardless of the time period provided in [37 CFR 1.57\(a\)](#)) to avoid the loss of the right of priority under [37 CFR 1.55](#) in the event that the application number, filing

date, or intellectual property authority or country of an application specified on the ADS is not the application number, filing date, or intellectual property authority or country of the intended previously filed application.

An application filed to obtain a filing date which includes both a reference to a previously filed application as provided for in [37 CFR 1.57\(a\)](#) and application papers including a specification and drawings will be processed as a reference filing and applicant will be charged the surcharge under [37 CFR 1.16\(f\)](#) even though a specification and drawings were submitted with the reference filing. The ADS form indicates that “the description and any drawings of the present application are replaced by this reference to the previously filed application.” Accordingly, the Office will send out a notice (e.g., Notice to File Missing Parts) requiring the surcharge and a copy of the specification and any drawings. Applicants must respond to the notice by filing a copy of the specification and any drawings of the previously filed application or by stating that the specification and drawings submitted on filing is a copy of the specification and drawings of the previously filed application. If the specification and drawings submitted on filing were not a copy of the specification and drawings of the previously filed application but instead were modified, i.e., updated, corrected, or reformatted in any manner, such modified specification and any modified drawings would not satisfy the copy requirement of [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)](#). In response to the notice, applicant must submit a copy of the specification and any drawings of the previously filed application. Any desired changes to the copy of the previously filed application must be made by way of an amendment under [37 CFR 1.121](#) without adding new matter. The modified specification and any drawings that were submitted on filing would not constitute the specification and drawings of the instant application and thus would not be used for examination purposes. However, applicant may file a petition under [37 CFR 1.182](#), including the fee under [37 CFR 1.17\(f\)](#), requesting that the modified specification and any drawings submitted on filing be removed from the file of the application filed by reference, 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 application filed by reference was filed. An application filed by reference is not improper simply because it is accompanied by a specification and drawings. Thus, an applicant will not be entitled to a refund of the filing fees paid in a proper application filed by reference. If the petition under [37 CFR 1.182](#) requesting that the modified specification and any drawings be removed from the file of the application filed by reference is granted, new filing fees, including the surcharge required by [37 CFR 1.16\(f\)](#), would be needed for the new application created as a result of the grant of the petition.

Reference filing is intended for situations when a copy of the previously filed application is not available at the time the current application is being filed. If a copy of the previously filed application is available, applicant should file the copy of the specification and drawings under [35 U.S.C. 111\(a\)](#) and [37 CFR 1.51\(b\)](#) and not complete the section of the ADS for filing by reference. As explained above, if the reference filing section of the ADS is completed, applicants will be required to pay the surcharge under [37 CFR 1.16\(f\)](#), even if a copy of the previously filed application is present on filing the application. A reference filing statement made upon filing cannot be rescinded because the reference to the previously filed application constitutes the specification and any drawings of the instant application. See [35 U.S.C. 111\(c\)](#).

There is no provision for the filing of a continuation-in-part of a previously filed application under [37 CFR 1.57\(a\)](#). [35 U.S.C. 111\(c\)](#) provides that the reference to the previously filed application “shall constitute the specification and any drawings of the subsequent application.” The specification and any drawings of a continuation-in-part would need to extend beyond the specification and any drawings of the previously filed application. Thus, the filing by reference of a continuation-in-part of the previously filed application is not contemplated by [35 U.S.C. 111\(c\)](#).

### **601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b) [R-07.2015]**

A provisional application filed on or after December 18, 2013 will be given a filing date as of the date a specification, with or without claims, is received in the Office. For provisional applications filed prior to December 18, 2013, the application will be given a filing date in accordance with [pre-PLT \(AIA\) 37 CFR 1.53\(c\)](#) as of the date the written description and any necessary drawings are filed in the Office. The filing date requirements for a provisional application set forth in [37 CFR 1.53\(c\)](#) substantially parallel the requirements for a nonprovisional application set forth in [37 CFR 1.53\(b\)](#). Amendments, other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

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

[37 CFR 1.53\(c\)\(1\)](#) requires all provisional applications be filed with a cover sheet, which may be an application data sheet ([37 CFR 1.76](#)) or a cover letter identifying the application as a provisional application. The Office will treat an application as having been filed under [37 CFR 1.53\(b\)](#), unless the application is clearly identified as a provisional application. A provisional application, which is identified as such, but which does not have a complete cover sheet as required by [37 CFR 1.51\(c\)\(1\)](#) will be treated as a provisional application. However, the complete cover sheet and a surcharge will be required to be submitted at a later date in conformance with [37 CFR 1.53\(g\)](#).

When the provisional application does not have a complete cover sheet or the appropriate fee, the applicant will be notified pursuant to [37 CFR 1.53\(g\)](#) and given a time period in which to provide the necessary fee or cover sheet and to pay the surcharge as set forth in [37 CFR 1.16\(g\)](#) in order to avoid abandonment of the application. The time period

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

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

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

## **601.01(c) Conversion to or from a Provisional Application [R-07.2015]**

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

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

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(c)

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(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; or

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section.

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An application filed under [37 CFR 1.53\(b\)](#) may be converted to a provisional application in accordance with the procedure described in [37 CFR 1.53\(c\)\(2\)](#). The procedure requires the filing of a request for conversion and the processing fee set forth in [37 CFR 1.17\(q\)](#). The provisional application filing fee ([37 CFR 1.16\(d\)](#)) and the surcharge set forth in [37 CFR 1.16\(g\)](#) are also required, although these fees do not need to be paid with the request for conversion. If the provisional application filing fee and the surcharge are not paid at the time of filing of the request for conversion, the Office will send a Notice to File Missing Parts in the provisional application requiring these fees. Filing of the request in the nonprovisional application is required prior to the abandonment of the [37 CFR 1.53\(b\)](#) application, the payment of the issue fee, or the expiration of 12 months after the filing date of the [37 CFR 1.53\(b\)](#) application, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under [37 CFR 1.53\(b\)](#).

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

A provisional application is not entitled to claim priority to or benefit of a prior-filed application under [35 U.S.C. 119, 120, 121, 365, or 386](#). See [MPEP § 201.04](#). After the nonprovisional application has been converted to a provisional application, any



priority or benefit claims submitted in the nonprovisional application will be disregarded.

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

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

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

[Editor Note: Applicable to patent applications filed under [35 U.S.C. 111](#) on or after December 18, 2013. See [pre-PLT \(AIA\) 37 CFR 1.53\(c\)](#) for the rule otherwise in effect.]

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(c)

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

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

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

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An application filed under [37 CFR 1.53\(c\)](#) may be converted to a nonprovisional application in accordance with the procedure described in [37 CFR 1.53\(c\)\(3\)](#). Applicants should carefully consider the patent term consequences of requesting conversion rather than simply filing a nonprovisional application claiming the benefit of the filing date of the provisional application under [35 U.S.C. 119\(e\)](#). Claiming the benefit of the provisional application under [35 U.S.C. 119\(e\)](#) is less expensive and will result in a longer patent term. The procedure requires the filing of a request in the provisional application for the conversion of the provisional application to a nonprovisional application and the fee set forth in [37 CFR 1.17\(i\)](#). The nonprovisional application resulting from conversion of a provisional application must also include the basic filing fee, search fee, and examination fee for the nonprovisional application. In addition, if the provisional application was not filed with an executed oath or declaration and the appropriate fees for a nonprovisional application, the surcharge set forth in [37 CFR 1.16\(f\)](#) is required. Furthermore, an inventor's oath or declaration is required to be filed in accordance with [37 CFR 1.53\(f\)](#) if the provisional application was filed on or after September 16, 2012 or [pre-AIA 37 CFR 1.53\(f\)](#) if the provisional application was filed prior to September 16, 2012. See [MPEP § 601.01\(a\)](#). Filing of the request for conversion in the provisional application is required prior to the abandonment of the provisional application or the expiration of 12 months after the filing date of the [37 CFR 1.53\(c\)](#) application, whichever event is earlier. The grant of any such request does not entitle applicant to a refund of the fees properly paid in the application filed under [37 CFR 1.53\(c\)](#).

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



### 601.01(d) Application Filed Without All Pages of Specification [R-07.2022]

The Office of Patent Application Processing (OPAP) reviews application papers to determine whether all of the pages of specification are present in the application. For an application filed under [37 CFR 1.53\(b\) or \(c\)](#) prior to December 18, 2013 or a design application, if the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least one drawing figure, if necessary under [35 U.S.C. 113](#) (first sentence), and, in a nonprovisional application, at least one claim, an OPAP notice (e.g., a “Notice of Omitted Items”) will be sent indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification. For an application other than a design application filed under [37 CFR 1.53\(b\)](#) or (c) on or after December 18, 2013, if the application is filed without all of the page(s) of the specification, but contains something that can be construed as a specification, with or without claims, an OPAP notice (e.g., a “Notice of Omitted Items”) will be sent indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification.

If the application does not contain anything that can be construed as a written description, OPAP will mail a Notice of Incomplete Application indicating that the application lacks the specification required by [35 U.S.C. 112](#) and no filing date is granted.

#### I. APPLICATION ENTITLED TO FILING DATE

The procedure for handling nonprovisional application papers having omitted items was revised in “Change in Procedure for Handling Nonprovisional Applications Having Omitted Items,” 1315 OG 103 (February 20, 2007). Under the revised procedure, the mailing of an OPAP notice regarding a missing page(s) of specification in a nonprovisional application will permit the applicant to:

(A) promptly establish prior receipt in the USPTO of the page(s) at issue. An applicant asserting that the page(s) was in fact received by the USPTO with the application papers must, within

two months from the date of the OPAP notice, file a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), along with evidence of such deposit. The petition fee will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing. The two-month period is extendable under [37 CFR 1.136](#);

(B) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within two months from the date of the OPAP notice, file any omitted page(s) and a petition under [37 CFR 1.182](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), requesting the later filing date. The two-month period is extendable under [37 CFR 1.136](#). For applications filed before September 16, 2012, an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) must be filed with the omitted page(s) and refer to such page(s); or

(C) accept the application as deposited in the USPTO by filing an appropriate amendment. Applicant may accept the application as deposited in the USPTO by either:

(1) filing a substitute specification (including claims) that amends the specification to renumber the pages consecutively and cancels any incomplete sentences, in compliance with [37 CFR 1.121\(b\)\(3\)](#) and [1.125](#), without adding the subject matter that was in the omitted page(s) and without adding any new matter (see [35 U.S.C. 132\(a\)](#)). For a missing page of the claim listing only, applicant is required to submit a replacement claim listing with the claims renumbered consecutively, or, if amendment to the claims is also necessary, then a complete claim listing in compliance with [37 CFR 1.121\(c\)](#). The application will maintain the filing date as of the date of deposit of the application papers in the USPTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit, or

(2) filing a substitute specification (excluding claims), in compliance with [37 CFR 1.121\(b\)\(3\)](#) and [1.125](#), to add the subject matter in the omitted

page(s) by relying on an incorporation by reference under [37 CFR 1.57\(b\)](#) or other portions of the original disclosure, without any adding new matter (see [35 U.S.C. 132\(a\)](#)). For a missing page of the claim listing, applicant is required to submit a complete claim listing in compliance with [37 CFR 1.121\(c\)](#). If an application was filed on or after September 21, 2004, and contains a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application, or a claim under [37 CFR 1.78](#) for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the specification pursuant to [37 CFR 1.57\(b\)](#). The amendment should be identified as an amendment pursuant to [37 CFR 1.57\(b\)](#) and must comply with the requirements of [37 CFR 1.57\(b\)](#) and [37 CFR 1.121](#). See [MPEP § 217](#). The application will maintain the filing date as of the date of deposit of the original application papers in the USPTO. The original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the original date of deposit. The two-month period is extendable under [37 CFR 1.136](#).

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

notice regarding omitted page(s) in a provisional application will permit the applicant to either: (1) promptly establish prior receipt of the page(s) at issue by filing of a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), along with evidence of such deposit; or (2) accept the application as deposited by failing to file a petition within a two-month non-extendable time period. Applications in which an OPAP notice regarding omitted items has been mailed will be retained in OPAP to await a reply to the notice. Failure to timely reply to the OPAP notice in a nonprovisional application will result in abandonment of the application. Nonprovisional applications that are timely completed will then be forwarded to the appropriate Technology Center for examination of the application. For provisional applications in which applicant accepts the application as deposited by failing to timely file a petition in response to an OPAP notice regarding omitted items, if the provisional application is complete under [37 CFR 1.51\(c\)](#), it will be held in the Office's Image File Wrapper (IFW) system and automatically abandoned at the end of its pendency period. See [MPEP § 601.01\(a\)](#) for treatment of nonprovisional applications that are not complete under [37 CFR 1.51\(b\)](#) and [MPEP § 601.01\(b\)](#) for treatment of provisional applications that are not complete under [37 CFR 1.51\(c\)](#).

## II. APPLICATION NOT ENTITLED TO FILING DATE

If the application does not contain anything that can be construed as a written description, OPAP will mail a Notice of Incomplete Application indicating that the application lacks the specification required by [35 U.S.C. 112](#). Applicant may:

(A) file a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), asserting that (1) the missing specification was submitted, or (2) the application papers as deposited contain an adequate written description under [35 U.S.C. 112](#). The petition under [37 CFR 1.53\(e\)](#) must be accompanied by sufficient evidence ([37 CFR 1.181\(b\)](#)) to establish applicant's entitlement to the requested filing date (e.g., a date-stamped postcard receipt ([MPEP § 503](#)) to establish prior receipt in the USPTO of the missing specification);

(B) submit the omitted specification, including at least one claim if the application is a nonprovisional application filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 or a design application, and accept the date of such submission as the application filing date. For applications filed before September 16, 2012, the omitted specification should be accompanied by an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to the specification being submitted; or

(C) submit an amendment under [37 CFR 1.57\(b\)](#) in a nonprovisional application. If a nonprovisional application was filed on or after September 21, 2004, and contains a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application, or a claim under [37 CFR 1.78](#) for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted specification pursuant to [37 CFR 1.57\(b\)](#). The amendment must be accompanied by a petition under [37 CFR 1.53\(e\)](#) along with the petition fee set forth in [37 CFR 1.17\(f\)](#). See [MPEP § 217](#). The amendment should be identified as an amendment pursuant to [37 CFR 1.57\(b\)](#) and must comply with the requirements of [37 CFR 1.57\(b\)](#) and [37 CFR 1.121](#). The two-month period is extendable under [37 CFR 1.136](#).

Applications in which a “Notice of Incomplete Application” has been mailed will be retained in OPAP to await action by the applicant since further action by the applicant is necessary for the application to be accorded a filing date. Unless applicant completes the application or files a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), within the period set in the “Notice of Incomplete Application,” the application will be processed as an incomplete application under [37 CFR 1.53\(e\)](#).

### III. APPLICATION FORWARDED FOR EXAMINATION

If it is discovered that an application that was forwarded to a Technology Center (TC) for

examination was filed without all of the page(s) of the specification, and a Notice of Omitted Items has not been mailed by OPAP, the examiner should review the application to determine whether the application is entitled to a filing date. An application filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 or a design application is entitled to a filing date if the application contains something that can be construed as a written description, at least one drawing figure (if necessary under [35 U.S.C. 113](#), first sentence), and at least one claim. If the application is not a design application and was filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, the application is entitled to a filing date if it is filed with a specification, with or without claims. However, claims must be filed before the application is sent to the TC.

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

If an application filed without all of the pages of the specification is entitled to a filing date, the examiner should notify applicant of the omission in the next Office action and require applicant to do one of the following:

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

(B) file any omitted page(s) and a petition under [37 CFR 1.182](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), requesting the date of submission of the omitted page(s) as the application filing date. For applications filed before September 16, 2012, the omitted pages must be accompanied by an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to the omitted page(s); or

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

If applicant is willing to accept the application, as filed, without all of the page(s) of the application (item A above), an amendment of the specification

is required to renumber the pages of the application consecutively and to cancel any incomplete sentences caused by the absence of the omitted page(s). The amendment should be submitted in response to the Office action.

If an application was filed on or after September 21, 2004, and contains a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application, or a claim under [37 CFR 1.78](#) for the benefit of a prior-filed provisional, nonprovisional, international, or international design application that was present on the filing date of the application, and the omitted portion of the specification was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the specification pursuant to [37 CFR 1.57\(b\)](#). The amendment should be submitted in response to the Office action and must comply with [37 CFR 1.57\(b\)](#) and [37 CFR 1.121](#). See [MPEP § 217](#).

Any petition filed in accordance with item B or C above will be forwarded to the Office of Petitions.

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

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

### **601.01(e) Nonprovisional Application Filed Without at Least One Claim [R-07.2015]**

*[Editor Note: This section is only applicable to nonprovisional applications filed prior to December 18, 2013 or to design applications. Nonprovisional applications, which are not design applications, filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013 are entitled to a filing date even if the specification does not contain claims. If such an application is filed without claims, it may be completed subsequent to its filing date. See [MPEP § 601.01\(a\)](#), subsection II.]*

For nonprovisional applications filed prior to December 18, 2013 or design applications, the

applicable version of [35 U.S.C. 111\(a\)\(2\)](#) requires that an application for patent include, *inter alia*, “a specification as prescribed by section 112,” and the applicable version of [35 U.S.C. 111\(a\)\(4\)](#) provides that the “filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.” [35 U.S.C. 112\(a\)](#) provides, in part, that “[t]he specification shall contain a written description of the invention,” and [35 U.S.C. 112\(b\)](#), provides that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Also, the Court of Appeals for the Federal Circuit stated in *Litton Systems, Inc. v. Whirlpool Corp.*:

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

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

Therefore, in an application filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 and in a design application, a claim is a statutory requirement for according a filing date to the application. [35 U.S.C. 171](#) makes [35 U.S.C. 112](#) applicable to design applications. [35 U.S.C. 162](#) specifically requires the specification in a plant patent application to contain a claim, but a claim is not required for receiving a filing date for plant patent applications filed on or after December 18, 2013. In addition, [35 U.S.C. 111\(b\)\(2\)](#) provides that “[a] claim, as required by subsections (b) through (e) of section 112, shall not be required in a provisional application.” Thus, only design applications and nonprovisional applications filed prior to December 18, 2013 that are filed without at least one claim are incomplete and not entitled to a filing date.



If a nonprovisional application filed prior to December 18, 2013 or a design application does not contain at least one claim, a “Notice of Incomplete Application” will be mailed to the applicant(s) indicating that no filing date has been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. See *In re Mattson*, 208 USPQ 168 (Comm’r Pat. 1980). In applications filed before September 16, 2012, an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to the claim being submitted is also required.

If a nonprovisional application filed prior to December 18, 2013 or a design application is accompanied by a preliminary amendment which cancels all claims without presenting any new or substitute claims, the Office will disapprove such an amendment. See [37 CFR 1.115\(b\)\(1\)](#) and *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 60 USPQ2d 1368 (Fed. Cir. 2001). Thus, the application will not be denied a filing date merely because such a preliminary amendment was submitted on filing. For fee calculation purposes, the Office will treat such an application as containing only a single claim.

As [37 CFR 1.53\(c\)\(2\)](#) permits the conversion of an application filed under [35 U.S.C. 111\(a\)](#) to an application under [35 U.S.C. 111\(b\)](#), an applicant in an application, other than for a design patent, filed under [35 U.S.C. 111\(a\)](#) on or after June 8, 1995, without at least one claim has the alternative of filing a petition under [37 CFR 1.53\(c\)\(2\)](#) to convert such application into an application under [35 U.S.C. 111\(b\)](#), which does not require a claim to be entitled to its date of deposit as a filing date. Such a petition, however, must be filed prior to the expiration of 12 months after the date of deposit of the application under [35 U.S.C. 111\(a\)](#), and comply with the other requirements of [37 CFR 1.53\(c\)\(2\)](#). See [MPEP § 601.01\(c\)](#). For nonprovisional applications filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, there is no need to request conversion to a provisional application because such applications do not require presentation of at least one claim to obtain a filing date.

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

### **601.01(f) Applications Filed Without Drawings [R-10.2019]**

*[Editor Note: This section is only applicable to applications filed prior to December 18, 2013 or to design applications. Applications, which are not design applications, filed under [35 U.S.C. 111\(a\)](#) or [\(b\)](#) on or after December 18, 2013 are entitled to a filing date even if the application does not contain drawings. If such an application is filed without drawings, it may be completed subsequent to its filing date. See [37 CFR 1.53\(e\)](#) and [MPEP § 601.01\(g\)](#).]*

[35 U.S.C. 111\(a\)\(2\)\(B\)](#) and [35 U.S.C. 111\(b\)\(1\)\(B\)](#) each provide, in part, that an “application shall include . . . a drawing as prescribed by section 113.” [35 U.S.C. 113](#) (first sentence) in turn provides that an “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.” For applications filed prior to December 18, 2013, [35 U.S.C. 111\(a\)\(4\)](#) and [35 U.S.C. 111\(b\)\(4\)](#) each provide, in part, that the “filing date. . . shall be the date on which . . . any required drawing are received in the Patent and Trademark Office.” Therefore, design applications and applications filed under [35 U.S.C. 111\(a\) or \(b\)](#) prior to December 18, 2013 must have any required drawing, if it is necessary for the understanding of the invention, in order to receive a filing date. For applications other than design applications filed on or after December 18, 2013, although drawings are not required in order to receive a filing date, drawings should be submitted on filing if necessary for the understanding of the invention because no amendment may introduce new matter into the disclosure of an application after its filing date.

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

It has been USPTO practice to treat an application that contains at least one process or method claim

as an application for which a drawing is not necessary for an understanding of the invention under [35 U.S.C. 113](#) (first sentence). The same practice has been followed in composition applications. Other situations in which drawings are usually not considered necessary for the understanding of the invention under [35 U.S.C. 113](#) (first sentence) are:

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

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

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

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

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

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

A nonprovisional application filed prior to December 18, 2013 or a design application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, not describing drawing figures in the specification, and filed without drawings will simply be processed, so long as the application contains something that can be

construed as a written description. A nonprovisional application filed prior to December 18, 2013 or a design application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in [MPEP § 601.01\(g\)](#), so long as the application contains something that can be construed as a written description. In a situation in which the appropriate Technology Center (TC) determines that drawings are necessary under [35 U.S.C. 113](#) (first sentence) the filing date issue will be reconsidered by the USPTO in nonprovisional applications filed prior to December 18, 2013 or in design applications. The application will be returned to the Office of Patent Application Processing (OPAP) for mailing of a “Notice of Incomplete Application.”

If a nonprovisional application filed prior to December 18, 2013 or a design application does not have at least one claim directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, or a provisional application filed prior to December 18, 2013 does not have at least some disclosure directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, and is filed without drawings, OPAP will mail a “Notice of Incomplete Application” indicating that the application lacks drawings and that [35 U.S.C. 113](#) (first sentence) requires a drawing where necessary for the understanding of the subject matter sought to be patented.

Applicant may file a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), asserting that (A) the drawing(s) at issue was submitted, or (B) the drawing(s) is not necessary under [35 U.S.C. 113](#) (first sentence) for a filing date. The petition must be accompanied by sufficient evidence to establish applicant’s entitlement to the requested filing date (e.g., a date-stamped postcard receipt ([MPEP § 503](#)) to establish prior receipt in the USPTO of the drawing(s) at issue). Alternatively, applicant in a nonprovisional application may submit

drawing(s) and accept the date of such submission as the application filing date. For applications filed before September 16, 2012, such drawings must be accompanied by an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to the drawing(s) being submitted.

If the drawing(s) was inadvertently omitted from a nonprovisional application filed on or after September 21, 2004, and the application contains a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application, or a claim under [37 CFR 1.78](#) for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application that was present on the filing date of the application, and the inadvertently omitted drawing(s) is completely contained in the prior-filed application, the applicant may submit the omitted drawing(s) by way of an amendment in compliance with [37 CFR 1.57\(b\)](#). The amendment must be by way of a petition under [37 CFR 1.53\(e\)](#) accompanied by the petition fee set forth in [37 CFR 1.17\(f\)](#). See [MPEP § 217](#).

In design applications, OPAP will mail a “Notice of Incomplete Application” indicating that the application lacks the drawings required under [35 U.S.C. 113](#) (first sentence). The applicant may: (A) promptly file a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), asserting that the missing drawing(s) was submitted; or (B) promptly submit drawing(s) and accept the date of such submission as the application filing date. For applications filed before September 16, 2012, such drawing(s) must be accompanied by an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#). Applicant may also be able to file an amendment by way of a petition under [37 CFR 1.53\(e\)](#) as provided for in [37 CFR 1.57\(b\)\(3\)](#) as discussed above. [37 CFR 1.153\(a\)](#) provides that the claim in a design application “shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described.” As such, petitions under [37 CFR 1.53\(e\)](#) asserting that drawings are unnecessary under [35 U.S.C. 113](#) (first sentence) for a filing date in a design application will not be found persuasive.

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

## **601.01(g) Applications Filed Without All Figures of Drawings [R-07.2022]**

### **I. REVIEW BY THE OFFICE OF PATENT APPLICATION PROCESSING**

The Office of Patent Application Processing (OPAP) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If an application filed under [35 U.S.C. 111](#) prior to December 18, 2013, or a design application, is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under [35 U.S.C. 113](#) (first sentence), and, in a nonprovisional application, at least one claim, an OPAP notice (e.g., a “Notice of Omitted Item(s)”) will be sent indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification. For an application, which is not a design application, filed under [37 CFR 1.53\(b\)](#) or (c) on or after December 18, 2013, if the application is filed without all of the drawings, but contains something that can be construed as a specification, with or without claims, an OPAP notice (e.g., a “Notice of Omitted Items”) will be sent indicating that the application papers so deposited have been accorded a filing date, but are lacking some drawings.

The procedure for handling nonprovisional applications having omitted items was revised in “Change in Procedure for Handling Nonprovisional Applications Having Omitted Items,” 1315 OG 103 (February 20, 2007).

Under the revised procedure, the mailing of an OPAP notice regarding a missing drawing figure(s) in a nonprovisional application will permit the applicant to:

(A) promptly establish prior receipt in the USPTO of the drawing(s) at issue. An applicant asserting that the drawing(s) was in fact received by

the USPTO with the application papers must, within two months from the date of the OPAP notice, file a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), along with evidence of such deposit. The petition fee will be refunded if it is determined that the drawing(s) was in fact received by the USPTO with the application papers deposited on filing. The two-month period is extendable under [37 CFR 1.136](#);

(B) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant desiring to submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date must, within two months from the date of the OPAP notice, file any omitted drawing(s) and a petition under [37 CFR 1.182](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), requesting the later filing date. For applications filed before September 16, 2012, the omitted drawings must be filed with an oath or declaration in compliance with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to such drawing(s). The two-month period is extendable under [37 CFR 1.136](#); or

(C) accept the application as deposited in the USPTO by filing an appropriate amendment. Applicant may accept the application as deposited in the USPTO by either:

(1) filing an amendment including replacement drawing sheets in compliance with [37 CFR 1.121\(d\)](#) to renumber the drawing figures consecutively (if necessary), and a substitute specification (excluding claims) that amends the specification to cancel any references to any omitted drawing(s) and corrects the references in the specification to the drawing figures to correspond with any relabeled drawing figures, in compliance with [37 CFR 1.121\(b\)\(3\)](#) and [1.125](#), without adding the subject matter that was in the omitted drawing(s) and without adding any new matter (see [35 U.S.C. 132\(a\)](#)). The application will maintain the filing date as of the date of deposit of the original application papers in the USPTO. The original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the original date of deposit. Amendment of the specification is required in a nonprovisional application to cancel all references to the omitted drawing, both in the brief and detailed

descriptions of the drawings and including any reference numerals shown only in the omitted drawings. In addition, an amendment with replacement sheets of drawings in compliance with [37 CFR 1.121\(d\)](#) is required in a nonprovisional application to renumber the drawing figures consecutively, if necessary, and amendment of the specification is required to correct the references to the drawing figures to correspond with any relabeled drawing figures, both in the brief and detailed descriptions of the drawings, or

(2) filing an amendment to add the missing figure(s) by relying on an incorporation by reference under [37 CFR 1.57\(b\)](#) or other portions of the original disclosure, without adding any new matter (see [35 U.S.C. 132\(a\)](#)). Applicant is required to submit new and replacement drawing sheets in compliance with [37 CFR 1.121\(d\)](#) to add the missing figure(s). If an application was filed on or after September 21, 2004, and contains a claim under [37 CFR 1.55](#) for priority of a prior-filed foreign application, or a claim under [37 CFR 1.78](#) for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the omitted portion of the drawings was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the drawings pursuant to [37 CFR 1.57\(b\)](#). The amendment should be identified as an amendment pursuant to [37 CFR 1.57\(b\)](#) and must comply with the requirements of [37 CFR 1.57\(b\)](#) and [37 CFR 1.121](#). See [MPEP § 217](#). The application will maintain the filing date as of the date of deposit of the original application papers in the USPTO. The original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the original date of deposit.

The submission of omitted drawing(s) in a nonprovisional application and acceptance of the date of such submission as the application filing date is tantamount to simply filing a new application. Thus, applicants should consider filing a new application as an alternative to submitting a petition under [37 CFR 1.182](#) (with the petition fee under [37 CFR 1.17\(f\)](#)) with any omitted drawing(s), which is a cost effective alternative in instances in which a



nonprovisional application is deposited without filing fees. Likewise, in view of the relatively low filing fee for provisional applications, and the USPTO's desire to minimize the processing of provisional applications, the USPTO will not grant petitions under [37 CFR 1.182](#) to accept omitted drawing(s) and accord an application filing date as of the date of such submission in provisional applications. The applicant should simply file a new completed provisional application. The mailing of an OPAP notice regarding missing drawing figure(s) in a provisional application will permit the applicant to either: (1) promptly establish prior receipt of the drawing(s) at issue by filing a petition under [37 CFR 1.53\(e\)](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), along with evidence of such deposit; or (2) accept the application as deposited by failing to file a petition within a two-month non-extendable time period.

Applications in which an OPAP notice regarding omitted items has been mailed will be retained in OPAP to await a reply to the notice. Failure to timely reply to the OPAP notice in a nonprovisional application will result in abandonment of the application. Nonprovisional applications that are timely completed will then be forwarded to the appropriate Technology Center for examination of the application. For provisional applications in which applicant accepts the application as deposited by failing to timely file a petition in response to an OPAP notice regarding omitted items, if the provisional application is complete under [37 CFR 1.51\(c\)](#), it will be held in the Office's Image File Wrapper (IFW) system and automatically abandoned at the end of its pendency period. See [MPEP § 601.01\(a\)](#) for treatment of nonprovisional applications that are not complete under [37 CFR 1.51\(b\)](#) and [MPEP § 601.01\(b\)](#) for treatment of provisional applications that are not complete under [37 CFR 1.51\(c\)](#).

The treatment of an application subsequent to the mailing of a "Notice of Omitted Item(s)" is discussed in [MPEP § 601.01\(d\)](#).

Applications are often filed with drawings with several views of the invention where the views are labeled using a number-letter combination, e.g., Fig. 1A, Fig. 1B, and Fig. 1C. If a figure which is referred

to in the specification by a particular number cannot be located among the drawings, and the drawings include at least one figure labeled with that particular number in combination with a letter, correction will be required. For example, if the drawings show Figures 1A, 1B, and 1C and the brief description of the drawings refers only to Figure 1, this is an error in the specification which must be corrected.

## II. REVIEW BY EXAMINER

If it is discovered that an application that was forwarded for examination was filed without all of the drawing figure(s) referred to in the specification, and a Notice of Omitted Items or other OPAP notice regarding omitted items has not been mailed by OPAP, the examiner should review the application to determine whether the application is entitled to a filing date if the application was filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 or is a design application. An application filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 or a design application is entitled to a filing date if the application contains something that can be construed as a written description, at least one drawing figure (if necessary under [35 U.S.C. 113](#), first sentence), and at least one claim. If the application is not a design application and was filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, the application is entitled to a filing date if it is filed with a specification, with or without drawings.

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

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

(A) accept the application, as filed, without all of the drawing figure(s) referred to in the specification;

(B) file any omitted drawing figure(s) and a petition under [37 CFR 1.182](#) with the petition fee set forth in [37 CFR 1.17\(f\)](#), requesting the date of submission of the omitted drawing figure(s) as the application filing date. For applications filed before September 16, 2012, the omitted drawing(s) must be filed with an oath or declaration in compliance

with [pre-AIA 37 CFR 1.63](#) and [pre-AIA 37 CFR 1.64](#) referring to the omitted drawing figure(s); or

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

If applicant is willing to accept the application, as filed, without all of the drawing figure(s) referred to in the application (item A above), applicant is required to submit (1) an amendment to the specification canceling all references to the omitted drawing figure(s) including any reference numerals shown only in the omitted drawing figure(s), (2) an amendment with replacement sheets of drawings in compliance with [37 CFR 1.121\(d\)](#) renumbering the drawing figure(s) submitted on filing consecutively, and (3) a further amendment to the specification correcting references to drawing figure(s) to correspond with the relabeled drawing figure(s), both in the brief and detailed descriptions of the drawings. The amendment should be submitted in response to the Office action.

If an 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, international application, or international design application, that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to [37 CFR 1.57\(b\)](#). The amendment should be submitted in response to the Office action and must comply with [37 CFR 1.57\(b\)](#) and [37 CFR 1.121](#). See [MPEP § 217](#).

Any petition filed in accordance with item (B) or (C) above will be forwarded to the Office of Petitions.

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

If upon review of the application, the examiner determines that the application filed under [35 U.S.C. 111\(a\)](#) prior to December 18, 2013 or a design application is NOT entitled to a filing date because the application does not contain any drawing figure, and at least one drawing figure is necessary under [35 U.S.C. 113](#), first sentence, the examiner should forward the application to OPAP for mailing of a “Notice of Incomplete Application.”

#### **601.02 Power of Attorney [R-07.2015]**

The attorney’s or agent’s full mailing address (including ZIP Code) must be given in every power of attorney. The telephone and fax numbers of the attorney or agent should also be included in the power of attorney. The prompt delivery of communications will thereby be facilitated.

See [MPEP § 402.02\(a\)](#) for detailed information and relevant forms pertaining to appointment of a power of attorney in applications filed on or after September 16, 2012. See [MPEP § 402.02\(b\)](#) for detailed information and relevant forms pertaining to appointment of a power of attorney in applications filed before September 16, 2012.

#### **601.03 Correspondence Address [R-11.2013]**

An application must specify a correspondence address to which the Office will send notices, letters, and other communications relating to an application. The Office should be promptly notified of any change in correspondence address. The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

See [MPEP § 601.03\(a\)](#) for information specific to correspondence address changes in an application

filed on or after September 16, 2012. See [MPEP § 601.03\(b\)](#) for information specific to correspondence address changes in an application filed before September 16, 2012.

See [MPEP § 711.03\(c\)](#) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action at the correspondence address of record (e.g., because the Office action was mailed to the incorrect correspondence address).

Note that the obligation (see [37 CFR 11.11](#)) of a registered attorney or agent to notify the Director of the Office of Enrollment and Discipline of any change of his or her address is separate from the obligation to file a notice of change of address in individual applications. Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See [MPEP § 403](#) for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification of the change of address ([37 CFR 11.11](#)), or may be retained by applicant.

### **601.03(a) Change of Correspondence Address in Applications Filed On or After September 16, 2012 [R-01.2024]**

*[Editor Note: See [MPEP § 601.03\(b\)](#) for change of correspondence address in applications filed before September 16, 2012.]*

#### **37 CFR 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet ([§ 1.76](#)), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see [§§ 1.76\(b\)\(1\)](#) and [37 CFR 1.63\(b\)\(2\)](#)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters,

and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the USPTO patent electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed by the parties set forth in paragraph (b)(1) or (b)(3) of this section. Prior to the appointment of any power of attorney under [§ 1.32\(b\)](#), the correspondence address may also be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of [§ 1.34](#).

(b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to [§ 1.27\(c\)\(2\)\(iii\)](#) or [\(c\)\(2\)\(iv\)](#), filed in the application must be signed by:

- (1) A patent practitioner of record;
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of [§ 1.34](#); or
- (3) The applicant ([§ 1.42](#)). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

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(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See [§ 11.11](#) of this title.

(f) Where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

(g) A patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner.

[37 CFR 1.33\(a\)](#) provides that the application must specify a correspondence address to which the Office will send notice, letters, and other communications relating to an application. The correspondence address must either be in an application data sheet ([37 CFR 1.76](#)) or in a clearly identifiable manner

elsewhere in any papers submitted with the application filing.

Applicants should provide clear instructions regarding the correspondence address. If more than one correspondence address is specified, whether in a single paper or in multiple papers, the Office will select one of the specified addresses for use as the correspondence address and, if given, may select the address associated with a Customer Number over a typed correspondence address. If an applicant provides multiple correspondence addresses in a single paper (e.g., providing both a typed correspondence address and a Customer Number in a single paper) or multiple papers (e.g., an oath or declaration, a transmittal letter, and a preliminary amendment that each includes a different correspondence address), and the Office does not select the correspondence address actually desired by applicant, the Office will not remail papers to the desired address. See [MPEP § 707.13](#) for remailing of returned Office correspondence. Note that the hierarchy provided in [37 CFR 1.76\(d\)](#) for inconsistencies between an application data sheet and other documents governs. Accordingly, if the ADS includes a typed correspondence address, and the declaration submitted at the same time gives a different address (e.g., the address associated with a Customer Number) as the correspondence address, the Office will use the typed correspondence address as included on the ADS. After the correspondence address has been entered according to the above procedure, it will only be changed pursuant to [37 CFR 1.33\(a\)](#).

For applications submitted via the USPTO patent electronic filing system, although an electronic acknowledgment receipt will be sent to the submitter, a correspondence address must still be set forth in either an application data sheet ([37 CFR 1.76](#)) or in a clearly identifiable manner elsewhere in any papers submitted with the application filing.

The submission of a daytime telephone number of the party to whom correspondence is to be addressed is requested pursuant to [37 CFR 1.33\(a\)](#). While business is to be conducted on the written record ([37 CFR 1.2](#)), a daytime telephone number is useful in initiating contact that could later be reduced to writing. Any party who may change the

correspondence address may also change the telephone number.

[37 CFR 1.33\(a\)](#) specifies that the correspondence address may be changed by the parties set forth in [37 CFR 1.33\(b\)\(1\)](#) (a patent practitioner of record) or [37 CFR 1.33\(b\)\(3\)](#) (the applicant under [37 CFR 1.42](#)). [37 CFR 1.33\(a\)](#) also provides that prior to the appointment of any power of attorney under [37 CFR 1.32\(b\)](#), the correspondence address may be changed by any patent practitioner named in the application transmittal papers who acts in a representative capacity under the provisions of [37 CFR 1.34](#).

Prior to the appointment of any power of attorney, if a patent practitioner (i.e., registered attorney or agent) filed the application, any other patent practitioners named in the transmittal papers may also change the correspondence address. A patent practitioner named in a letterhead would not be considered as being named in the transmittal papers for purposes of changing the correspondence address. A clear identification of the individual as a representative is required. If an application is filed by a company to whom the invention has been assigned or to whom there is an obligation to assign the invention, a person (other than a patent practitioner) who has the authority to act on behalf of the company **may not** change the correspondence address, as all papers signed on behalf of a juristic entity must be signed by a patent practitioner.

The correspondence address will not be changed by filing a paper (such as an application data sheet) which includes a correspondence address which is different from the correspondence address of record if the paper does not clearly identify that an address change is being made.

[37 CFR 1.33\(e\)](#) provides that a change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See [37 CFR 11.11](#).

[37 CFR 1.33\(f\)](#) provides that where application papers (e.g., the inventor's oath or declaration) from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate



paper identifying the correspondence address to be used for the continuing application must be submitted. If not submitted, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application and correspondence may be mailed to a previously designated correspondence address.

[37 CFR 1.33\(g\)](#) provides that a practitioner acting in a representative capacity whose correspondence address is the correspondence address of record in

an application may change the correspondence address after the patent has issued, provided that the change of correspondence address is accompanied by a statement that notice has been given to the patentee or owner. [37 CFR 1.33\(g\)](#) provides a means for practitioners acting in a representative capacity in an application to effect a change in correspondence address after the patent has granted but does not provide authority to a practitioner acting under [37 CFR 1.34](#) to change the correspondence address in an application. See [37 CFR 1.33\(a\)](#).

PTO/AIA/122 (08-12)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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<p><b>CHANGE OF CORRESPONDENCE ADDRESS Application</b></p> <p>Address to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p>	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

Please change the Correspondence Address for the above-identified patent application to:

The address associated with Customer Number:

**OR**

Firm or Individual Name

Address

City	State	Zip
Country		
Telephone	Email	

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the:

Applicant

Attorney or agent of record. Registration Number \_\_\_\_\_.

Registered practitioner named in the application transmittal papers who acts in a representative capacity under 37 CFR 1.34. See 37 CFR 1.33(a)(1). Registration Number \_\_\_\_\_.

Signature

Typed or Printed Name

Date	Telephone
------	-----------

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below<sup>1</sup>.

\*Total of \_\_\_\_\_ forms are submitted.

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0035. Public burden for this form is estimated to average 3 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. If filing this completed form by mail, 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.*

### 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. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013). <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to: 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law; 2) a Federal, state, local, or international agency, in response to its request; 3) a contractor of the USPTO having need for the information in order to perform a contract; 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record; 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations; 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals; 8) 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)); 9) the Office of Personnel Management (OPM) for personnel research purposes; and 9) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

### Additional Uses

Additional USPTO uses of the information in this record may include disclosure to: 1) the International Bureau of the World Intellectual Property Organization, if the record is related to an international application filed under the Patent Cooperation Treaty; 2) the public i) after publication of the application pursuant to 35 U.S.C. 122(b), ii) after issuance of a patent pursuant to 35 U.S.C. 151, iii) 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 inspections, or an issued patent, or iv) without publication of the application or patent under the specific circumstances provided for by 37 CFR 1.14(a)(1)(v)-(vii); and/or 3) the National Archives and Records Administration, for inspection of records.

PTO/AIA/123 (08-12)

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<p align="center"><b>CHANGE OF CORRESPONDENCE ADDRESS Patent</b></p> <p>Address to: Mail Stop Post Issue Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p>	Patent Number	
	Issue Date	
	Application Number	
	Filing Date	
	First Named Inventor	
	Attorney Docket Number	

Please change the Correspondence Address for the above-identified patent to:

The address associated with Customer Number:

**OR**

**Firm or Individual Name**

**Address**

<b>City</b>	<b>State</b>	<b>ZIP</b>
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**Country**

<b>Telephone</b>	<b>Email</b>
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This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

This form will not affect any "fee address" provided for the above-identified patent. To change a "fee address" use the "Fee Address Indication Form" (PTO/SB/47).

I am the:

Patentee.

If the Patentee was not the applicant for patent (37 CFR 1.42), then a Statement under 37 CFR 3.73(c) (Form PTO/AIA/96 or equivalent) is enclosed or was filed on \_\_\_\_\_. See 37 CFR 3.71.

Attorney or agent of record. Registration Number \_\_\_\_\_.

Patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record. Notice has been given to the patentee or owner. Registration Number \_\_\_\_\_.

Signature

Typed or Printed Name

Date	Telephone
------	-----------

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

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Routine uses of the information in this record may include disclosure to: 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law; 2) a Federal, state, local, or international agency, in response to its request; 3) a contractor of the USPTO having need for the information in order to perform a contract; 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record; 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations; 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals; 8) 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)); 9) the Office of Personnel Management (OPM) for personnel research purposes; and 9) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

### Additional Uses

Additional USPTO uses of the information in this record may include disclosure to: 1) the International Bureau of the World Intellectual Property Organization, if the record is related to an international application filed under the Patent Cooperation Treaty; 2) the public i) after publication of the application pursuant to 35 U.S.C. 122(b), ii) after issuance of a patent pursuant to 35 U.S.C. 151, iii) 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 inspections, or an issued patent, or iv) without publication of the application or patent under the specific circumstances provided for by 37 CFR 1.14(a)(1)(v)-(vii); and/or 3) the National Archives and Records Administration, for inspection of records.

## 601.03(b) Change of Correspondence Address in Applications Filed Before September 16, 2012 [R-10.2019]

[Editor Note: See [MPEP § 601.03\(a\)](#) for change of correspondence address in applications filed on or after September 16, 2012.]

**37 CFR 1.33 (pre-AIA) Correspondence respecting patent applications, reexamination proceedings, and other proceedings.**

(a) *Correspondence address and daytime telephone number.* When filing an application, a correspondence address must be set forth in either an application data sheet ([§ 1.76](#)), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see [§§ 1.76\(b\)\(1\)](#) and [1.63\(c\)\(2\)](#)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

(1) *Prior to filing of [§ 1.63](#) oath or declaration by any of the inventors.* If a [§ 1.63](#) oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.

(2) *Where a [§ 1.63](#) oath or declaration has been filed by any of the inventors.* If a [§ 1.63](#) oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

\*\*\*\*\*

[Pre-AIA 37 CFR 1.33\(a\)](#) provides that the application must specify a correspondence address

to which the Office will send notice, letters, and other communications relating to an application. The correspondence address must either be in an application data sheet ([pre-AIA 37 CFR 1.76](#)) or in a clearly identifiable manner elsewhere in any papers submitted with the application filing. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. Additionally, applicants will often specify the correspondence address in more than one paper that is filed with an application, and the address given in the different places sometimes conflicts. Where the applicant specifically directs the Office to use non-matching correspondence addresses in more than one paper, priority will be accorded to the correspondence address specified in the following order: (A) application data sheet (ADS); (B) application transmittal; (C) oath or declaration (unless power of attorney is more current); and (D) power of attorney. Accordingly, if the ADS includes a typed correspondence address, and the declaration gives a different address (i.e., the address associated with a Customer Number) as the correspondence address, the Office will use the typed correspondence address as included on the ADS. In the experience of the Office, the ADS is the most recently created document and tends to have the most current address. After the correspondence address has been entered according to the above procedure, it will only be changed pursuant to [pre-AIA 37 CFR 1.33\(a\)\(1\)](#).

The submission of a daytime telephone number of the party to whom correspondence is to be addressed is requested pursuant to [pre-AIA 37 CFR 1.33\(a\)](#). While business is to be conducted on the written record ([37 CFR 1.2](#)), a daytime telephone number is useful in initiating contact that could later be reduced to writing. Any party who may change the correspondence address may also change the telephone number.

[Pre-AIA 37 CFR 1.33\(a\)\(1\)](#) provides that the party filing the application and setting forth a correspondence address may later change the correspondence address provided that an executed oath or declaration under [pre-AIA 37 CFR 1.63](#) by any of the inventors has not been filed. If a patent

practitioner (i.e., registered attorney or agent) filed the application, any other patent practitioners named in the transmittal papers may also change the correspondence address. A patent practitioner named in a letterhead would not be considered as being named in the transmittal papers for purposes of changing the correspondence address. A clear identification of the individual as a representative is required. If an application is filed by a company to whom the invention has been assigned or to whom there is an obligation to assign the invention, a person who has the authority to act on behalf of the company may change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address pursuant to [pre-AIA 37 CFR 1.33\(a\)\(1\)](#). The filing of an executed oath or declaration that does not include a correspondence address does not affect any correspondence address previously established on filing of the application, or changed pursuant to [pre-AIA 37 CFR 1.33\(a\)\(1\)](#).

Where a correspondence address has been established on filing of the application or changed pursuant to [pre-AIA 37 CFR 1.33\(a\)\(1\)](#) (prior to the filing of an executed oath or declaration under [pre-AIA 37 CFR 1.63](#) by any of the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under [pre-AIA 37 CFR 1.63](#) and can only be subsequently changed

pursuant to [pre-AIA 37 CFR 1.33\(a\)\(2\)](#). Under [pre-AIA 37 CFR 1.33\(a\)\(2\)](#), where an executed oath or declaration under [pre-AIA 37 CFR 1.63](#) has been filed by any of the inventors, the correspondence address may be changed by (A) a patent practitioner of record, (B) an assignee as provided for under [pre-AIA 37 CFR 3.71\(b\)](#), or (C) all of the applicants ([pre-AIA 37 CFR 1.41\(b\)](#)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with [pre-AIA 37 CFR 3.71](#). See [pre-AIA 37 CFR 1.33\(a\)\(2\)](#).

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under [pre-AIA 37 CFR 1.53\(b\)](#) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. See [pre-AIA 37 CFR 1.63\(d\)\(4\)](#).

PTO/SB/122 (04-15)

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<b>CHANGE OF CORRESPONDENCE ADDRESS Application</b>  Address to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

Please change the Correspondence Address for the above-identified patent application to:		
<input type="checkbox"/>	The address associated with Customer Number:	<input style="width: 200px; height: 20px;" type="text"/>
<b>OR</b>		
<input type="checkbox"/>	Firm or Individual Name	
Address		
City	State	Zip
Country		
Telephone	Email	
This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).		
I am the:		
<input type="checkbox"/>	Applicant/Inventor	
<input type="checkbox"/>	Assignee of record of the entire interest. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).	
<input type="checkbox"/>	Attorney or agent of record. Registration Number _____.	
<input type="checkbox"/>	Registered practitioner named in the application transmittal letter in an application without an executed oath or declaration. See 37 CFR 1.33(a)(1). Registration Number _____.	
Signature		
Typed or Printed Name		
Date	Telephone	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.		
<input type="checkbox"/>	*Total of _____ forms are submitted.	

This collection of information is required by 37 CFR 1.33. 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 3 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 and select option 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.

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This collection of information is required by 37 CFR 1.33. 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 3 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: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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### 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.

#### **601.04 National Stage Requirements of the United States as a Designated Office [R-08.2012]**

See [MPEP Chapter 1800](#), especially [MPEP § 1893.01](#) for requirements for entry into the national stage before the Designated Office or Elected Office under the Patent Cooperation Treaty (PCT).

#### **601.05 Bibliographic Information - Application Data Sheet (ADS) [R-01.2024]**

An application data sheet (ADS) is a sheet or set of sheets containing bibliographic data, which is arranged in a format specified by the Office. An ADS must comply with the requirements of [37 CFR 1.76](#), and may be submitted in a provisional application under [35 U.S.C. 111\(b\)](#), a nonprovisional application under [35 U.S.C. 111\(a\)](#), a nonprovisional international design application, or a national stage application under [35 U.S.C. 371](#). See [MPEP § 601.05\(a\)](#) for requirements for an ADS that are specific to applications filed on or after September 16, 2012. See [MPEP § 601.05\(b\)](#) for requirements for an ADS that are specific to applications filed prior to September 16, 2012.

When an application data sheet is provided in a patent application, the application data sheet becomes part of the application and must comply with [37 CFR 1.52](#). While the use of an application data sheet is not always required (see [MPEP §§ 601.05\(a\)](#) and [601.05\(b\)](#)), the Office prefers its use in all applications to help facilitate the electronic capturing of important data. When an ADS is optional, the data that is suggested to be supplied by way of an application data sheet can also be provided elsewhere in the application papers, but it is to applicant's advantage to submit the data via an application data sheet. To help ensure that the Office efficiently captures the data, the Office specifies a particular format to be used. The Office also provides a fillable form (PTO/AIA/14 for applications filed on or after September 16, 2012 and PTO/SB/14 for applications filed prior to September 16, 2012) on the Office's website, which contains the bibliographic data arranged in the specified format. The Office's fillable form is designed to be completed electronically and then filed via Patent

Center or in paper. However, the data will only load directly into the USPTO patent electronic system when the PTO/AIA/14 or PTO/SB/14 is submitted as a Fillable Form, rather than a scanned portable document format (PDF) image.

In addition to the Office's fillable form, applicants have the option to utilize the enhanced Web-based version of the ADS for submission of an ADS with the filing of a new utility or design application. For more information, see the "Quick Start Guide for Web-based Application Data Sheet (Web ADS)" available at [www.uspto.gov/patents/apply/patent-center](http://www.uspto.gov/patents/apply/patent-center). If the applicant is a registered filer of Patent Center, a Web-based corrected ADS is also available for use for certain existing applications filed on or after September 16, 2012. A corrected Web-based ADS is not permitted in international applications, national stage applications under [35 U.S.C. 371](#), provisional applications, plant applications, reexamination proceedings, and supplemental examinations under [35 U.S.C. 257](#). The corrected Web-based ADS will be pre-populated with information of record. Therefore, applicants can type in the desired changes in the corrected Web-based ADS and the system will create a PDF version with the appropriate strike-through and underlining.

#### **601.05(a) Application Data Sheet (ADS) -- Application Filed On or After September 16, 2012 [R-01.2024]**

*[Editor Note: See [MPEP § 601.05\(b\)](#) for a discussion of the requirements of an ADS for applications filed before September 16, 2012. [37 CFR 1.76\(b\)\(3\)](#), directed to reference filing under [37 CFR 1.57\(a\)](#), is applicable only to patent applications filed under [35 U.S.C. 111](#) on or after December 18, 2013. For [37 CFR 1.76\(b\)\(3\)](#) applicable to applications filed on or after September 16, 2012 and before December 18, 2013, see [37 CFR 1.76 \(2012-09-16 thru 2013-12-17\)](#); for applications filed prior to September 16, 2012, see [pre-AIA 37 CFR 1.76](#) as reproduced in [MPEP § 601.05\(b\)](#).]*

##### **37 CFR 1.76 Application data sheet.**

(a) *Application data sheet:* An application data sheet is a sheet or sheets, that may be submitted in a provisional application under [35 U.S.C. 111\(b\)](#), a nonprovisional application under [35 U.S.C. 111\(a\)](#), a nonprovisional international design



application, or a national stage application under [35 U.S.C. 371](#), and must be submitted when required by [§ 1.55](#) or [1.78](#) to claim priority to or the benefit of a prior-filed application under [35 U.S.C. 119](#), [120](#), [121](#), [365](#), or [386](#). An application data sheet must be titled "Application Data Sheet." An application data sheet must contain all of the section headings listed in paragraph (b) of this section, except as provided in paragraph (c)(2) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the application for which it has been submitted.

(b) Bibliographic data. Bibliographic data as used in paragraph (a) of this section includes:

(1) *Inventor information.* This information includes the legal name, residence, and mailing address of the inventor or each joint inventor.

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see [§ 1.33\(a\)](#)).

(3) *Application information.* This information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to [§ 5.2](#) of this chapter (see [§ 5.2\(c\)](#)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. When information concerning the previously filed application is required under [§ 1.57\(a\)](#), application information also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (see [§ 1.32](#)).

(5) *Domestic benefit information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#). Providing this information in the application data sheet constitutes the specific reference required by [35 U.S.C. 119\(e\)](#) or [120](#), and [§ 1.78](#).

(6) *Foreign priority information.* This information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by [35 U.S.C. 119\(b\)](#) and [§ 1.55](#).

(7) *Applicant information.* This information includes the name (either natural person or juristic entity) and address of the legal representative, assignee, person to whom the inventor

is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under [§ 1.43](#) or [§ 1.46](#). Providing assignment information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) Correcting and updating an application data sheet.

(1) Information in a previously submitted application data sheet, inventor's oath or declaration under [§ 1.63](#), [§ 1.64](#) or [§ 1.67](#), or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of [§ 1.48](#), foreign priority and domestic benefit information changes must comply with [§§ 1.55](#) and [1.78](#), and correspondence address changes are governed by [§ 1.33\(a\)](#).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under [35 U.S.C. 371](#).

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents:

(1) The most recent submission will govern with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor's oath or declaration, except that:

(i) The most recent application data sheet will govern with respect to foreign priority ([§ 1.55](#)) or domestic benefit ([§ 1.78](#)) claims; and

(ii) The naming of the inventorship is governed by [§ 1.41](#) and changes to inventorship or the names of the inventors is governed by [§ 1.48](#).

(2) The information in the application data sheet will govern when inconsistent with the information supplied at the same time by a designation of correspondence address or the inventor's oath or declaration. The information in the application data sheet will govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

(3) The Office will capture bibliographic information from the application data sheet. The Office will generally not review the inventor's oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. Incorrect bibliographic information contained in an

application data sheet may be corrected as provided in paragraph (c)(1) of this section.

(e) *Signature requirement.* An application data sheet must be signed in compliance with [§ 1.33\(b\)](#). An unsigned application data sheet will be treated only as a transmittal letter.

(f) *Patent Law Treaty Model International Forms.* The requirement in [§ 1.55](#) or [§ 1.78](#) for the presentation of a priority or benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form, and the requirement in [§ 1.57\(a\)](#) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form. The requirement in [§ 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

(g) *Patent Cooperation Treaty Request Form.* The requirement in [§ 1.78](#) for the presentation of a benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet will be satisfied in a national stage application under [35 U.S.C. 371](#) by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under [PCT Article 21\(2\)](#). The requirement in [§ 1.55](#) or [§ 1.78](#) for the presentation of a priority or benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet and the requirement in [§ 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied in an application under [35 U.S.C. 111](#) by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. If a Patent Cooperation Treaty Request Form is submitted in an application under [35 U.S.C. 111](#), the Patent Cooperation Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under [35 U.S.C. 111](#) is desired.

[37 CFR 1.76\(a\)](#) provides that an application data sheet may be submitted in a provisional application under [35 U.S.C. 111\(b\)](#), a nonprovisional application under [35 U.S.C. 111\(a\)](#), a nonprovisional international design application, or a national stage application under [35 U.S.C. 371](#). However, [37 CFR 1.76\(a\)](#) also provides that an application data sheet **must** be submitted when required by [37 CFR 1.55](#) and [1.78](#) to claim priority to, or the benefit of, a prior-filed application under [35 U.S.C. 119](#), [120](#), [121](#), [365](#), or [386](#) in accordance with [37 CFR 1.55](#) and [1.78](#). An application data sheet **must** also be

submitted in accordance with [37 CFR 1.46](#) when an application is filed by an assignee, a person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows a sufficient proprietary interest in the matter under [35 U.S.C. 118](#).

## I. BIBLIOGRAPHIC INFORMATION

[37 CFR 1.76\(a\)](#) requires that any ADS contain the seven headings listed in [37 CFR 1.76\(b\)](#) with any appropriate data for each section heading (except as provided in [37 CFR 1.76\(c\)\(2\)](#) for an ADS providing corrected or updated information). The ADS must be titled “Application Data Sheet” and any heading that does not contain any corresponding data will be interpreted by the Office to mean that there is no corresponding data for that heading anywhere in the application. Bibliographic data under [37 CFR 1.76\(b\)](#) includes: (1) inventor information; (2) correspondence information; (3) application information; (4) representative information; (5) domestic benefit information; (6) foreign priority information; and (7) applicant information.

Inventor information includes the legal name, residence, and mailing address of each inventor ([37 CFR 1.41\(b\)](#)). Whether or not the inventor is the applicant, the Office will continue to use the inventor’s name for application and patent identification purposes. Inventor names tend to provide a more distinct identification than assignee name, for example. The “mailing address” is the address where the inventor customarily receives mail.

Correspondence information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see [37 CFR 1.33\(a\)](#)).

As set forth in [37 CFR 1.76\(b\)\(3\)](#), application information includes the title of the invention, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, and the type of application (e.g., utility, plant, design, reissue, provisional). The Office now uses the drawing figure suggested by the applicant

for the front page of the patent application publication when the suggestion is included on a compliant ADS timely before the process of publishing the application begins. However, the Office continues not to be bound by the applicant's figure suggestion, and failure to use the suggested figure for the first page of the patent application publication will not be considered a material mistake for purposes of corrected publication under [37 CFR 1.221\(b\)](#). See Applicant-Suggested Drawing Figure in the Publication of Patent Applications, 1514 OG 107 (September 5, 2023).

Application information includes whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to [37 CFR 5.2\(c\)](#). [37 CFR 1.76\(b\)\(3\)](#) also requests that the plant patent applicant state the Latin name and the variety denomination for the plant claimed. The Latin name of the genus and species and the variety denomination of the claimed plant are usually included in the specification of the plant patent application, and will be included in any plant patent or plant patent application publication if included in an application data sheet or patent application. The Office, pursuant to the "International Convention for the Protection of New Varieties of Plants" (generally known by its French acronym as the UPOV convention), has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant. Having this information in an ADS will make the process of compiling this database more efficient.

For applications filed on or after December 18, 2013, when information concerning the previously filed application is required under [37 CFR 1.57\(a\)](#), application information also includes the reference to the previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed. Effective December 18, 2013, [37 CFR 1.57](#) and [37 CFR 1.76\(b\)\(3\)](#) were amended to implement the reference filing provisions of [35 U.S.C. 111\(c\)](#). [37 CFR 1.57\(a\)](#) now provides that, subject to the

conditions and requirements of [37 CFR 1.57\(a\)](#), a reference to a previously filed application, made in the English language in an ADS in accordance with [37 CFR 1.76](#) upon the filing of an application under [35 U.S.C. 111\(a\)](#) indicating that the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) are replaced by the reference to the previously filed application, shall constitute the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) for purposes of a filing date under [37 CFR 1.53\(b\)](#). Thus, applicants filing by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57](#) should take care to ensure that the application number, filing date, and intellectual property authority or country of the previously filed application are accurately specified on the ADS as the specification and drawings of the application specified on the ADS is the specification and drawings of the application being filed by reference under [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57](#). See [MPEP § 601.01\(a\)](#), subsection III, for more information on reference filing. The reference to a previously filed application in an ADS under [37 CFR 1.57\(a\)](#) is not **sufficient to establish a priority or benefit claim** to that previously filed application. Applicants must still provide priority and/or benefit information under the domestic benefit information heading or foreign priority information heading, as appropriate, in the application data sheet even if utilizing the reference filing provisions of [35 U.S.C. 111\(c\)](#) and [37 CFR 1.57\(a\)](#).

Representative information includes the registration number of each practitioner appointed with a power of attorney in the application (preferably by reference to a customer number). [37 CFR 1.76\(b\)\(4\)](#) states that providing this information in the application data sheet does not constitute a power of attorney in the application (see [37 CFR 1.32](#)). This is because the Office does not expect the application data sheet to be executed by the party (applicant or assignee) who may appoint a power of attorney in the application.

Domestic benefit information includes the application number (series code and serial number), the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), [365\(c\)](#), or [386\(c\)](#). The application data sheet, if provided, is considered part of the

application. [37 CFR 1.76\(b\)\(5\)](#) states that providing this information in the application data sheet constitutes the specific reference required by [35 U.S.C. 119\(e\)](#) or [120](#), and [37 CFR 1.78](#). A specific reference to the earlier application(s) is no longer required to be made in the specification, such as in the first sentence(s) thereof. The continuity data for the patent front page will be taken from the application data sheet. No continuity data will be included in the first sentence(s) of the specification, unless applicant separately provides it there. [37 CFR 1.76\(b\)\(5\)](#) does not apply to provisional applications.

Foreign priority information includes the application number, country (or intellectual property authority), and filing date of each foreign application for which priority is claimed. [37 CFR 1.76\(b\)\(6\)](#) states that providing this information in the application data sheet constitutes the claim for priority as required by [35 U.S.C. 119\(b\)](#) and [37 CFR 1.55](#). [37 CFR 1.76\(b\)\(6\)](#) does not apply to provisional applications.

[37 CFR 1.76\(b\)\(7\)](#) provides that applicant information includes the name (either natural person or juristic entity) and address of the applicant under [37 CFR 1.43](#) or [1.46](#). Thus, [37 CFR 1.76\(b\)\(7\)](#) provides for the situation in which the applicant is a person other than the inventor under [37 CFR 1.43](#) (legal representative) or [37 CFR 1.46](#) (assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter). This heading should be left blank if the applicant is the inventor or is the remaining joint inventor or inventors ([37 CFR 1.45](#)).

[37 CFR 1.46\(b\)](#) provides that if an application is filed by the assignee, a person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter, the application must contain an application data sheet under [37 CFR 1.76](#) specifying the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter in the applicant information section. [37 CFR 1.46\(b\)](#) also requires if an application entering the national stage under [35 U.S.C. 371](#), or a nonprovisional international design application, is applied for by a person other than the

inventor under [37 CFR 1.46\(a\)](#), the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3). [37 CFR 1.46\(c\)\(1\)](#) provides that any request to correct or update the name of the applicant must include an application data sheet under [37 CFR 1.76](#) specifying the corrected or updated name of the applicant in the applicant information section in accordance with [37 CFR 1.76\(c\)\(2\)](#). [37 CFR 1.46\(c\)\(1\)](#) also provides that a change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application. [37 CFR 1.46\(c\)\(2\)](#) provides that any request to change the applicant must include an application data sheet under [37 CFR 1.76](#) specifying the applicant in the applicant information section and comply with [37 CFR 3.71](#) and [3.73](#). The application data sheet must comply with the provisions for correcting and updating an application data sheet set forth in [37 CFR 1.76\(c\)](#). [37 CFR 1.76\(b\)\(7\)](#) explains that providing assignment information in the application data sheet does not substitute for compliance with any requirement of 37 CFR part 3 to have an assignment recorded by the Office. Assignment information must be recorded to have legal effect.

## II. CORRECTING AND UPDATING AN ADS OR INFORMATION OTHERWISE OF RECORD

[37 CFR 1.76\(c\)](#) provides the procedure for correcting and updating not only an application data sheet (ADS), but also information otherwise of record (e.g., information provided on the most recent filing receipt). Any ADS filed after the filing date of the application or the submission of a first ADS is considered a corrected (or updated) ADS even if an ADS was not previously submitted. Such a corrected ADS must identify the information that is being changed with underlining for insertions and strike-through or brackets for text removed, except that identification of information being changed is not required for an ADS included with an initial submission under [35 U.S.C. 371](#). In general, the



identification of the information being changed should be made relative to the most recent filing receipt. If appropriate, use of the corrected Web-based ADS is recommended because it will pre-populate with information of record. Accordingly, applicants can type in the desired changes in the corrected Web-based ADS, and the system will create a PDF version with the appropriate strike-through and underlining. A corrected Web-based ADS, however, is not permitted in international applications, national stage applications under [35 U.S.C. 371](#), provisional applications, plant applications, reexamination proceedings, and supplemental examinations under [35 U.S.C. 257](#). For more information, see the “Quick Start Guide for Corrected Web-based Application Data Sheet (Corrected Web ADS)” available at [www.uspto.gov/patents/apply/patent-center](http://www.uspto.gov/patents/apply/patent-center).

A corrected ADS may be submitted until payment of the issue fee to either correct or update information in a previously submitted application data sheet, or in an inventor’s oath or declaration under [37 CFR 1.63](#), [1.64](#), or [1.67](#), or otherwise of record. See [37 CFR 1.76\(c\)\(1\)](#). Note, however, a corrected ADS filed after final rejection or allowance is not entered as a matter of right. See [37 CFR 1.116](#) or [1.312](#), respectively. For a discussion of amendments and other replies after final rejection or action, see [MPEP § 714.12](#) and [§ 714.13](#). For a discussion of amendments filed after notice of allowance, see [MPEP § 714.16](#). In addition, inventorship changes must comply with the requirements of [37 CFR 1.48](#), foreign priority and domestic benefit information changes must comply with [37 CFR 1.55](#) and [1.78](#), and correspondence address changes must comply with [37 CFR 1.33\(a\)](#). Note also that any request to correct or update the name of the applicant, or change the applicant, must comply with [37 CFR 1.46\(c\)](#).

A corrected ADS may include all of the section headings listed in [37 CFR 1.76\(b\)](#) with all appropriate data for each heading or only those sections (including the section headings) containing changed or updated information. See [37 CFR 1.76\(c\)\(2\)](#).

A corrected ADS should be filed with a request for a corrected filing receipt unless accompanied by a

request to take some other action, such as a request under [37 CFR 1.48](#), a request under [37 CFR 1.46\(c\)](#), or the submission of a power of attorney. A corrected ADS accompanying a request to change the applicant under [37 CFR 1.46\(c\)](#) must show the changes in applicant information relative to the applicant information on the most recent filing receipt, even if an ADS was not previously filed or an applicant was not previously identified in an ADS because the filing receipt identifies the applicant information of record. If no applicant was identified in the applicant information section of a properly signed ADS filed with the application, a corrected ADS identifying a new applicant with underlining does not need to show the deletion of the inventor-applicant(s) with strikethrough. A corrected ADS submitted to correct information provided in the inventor’s oath or declaration, such as residence information for an inventor, must show the original incorrect information with strike-through or brackets, and the new information with underlining, as if the incorrect information was submitted in an ADS filed with the application even though an ADS was not previously filed. If there are multiple inventors, all of the inventors must be listed in the “Inventor Information” section of the corrected ADS, even if the residence information is only being changed for one of the inventors.

If submitted during the time period for making a benefit or priority claim set forth in [37 CFR 1.78](#) or [1.55](#), a request for corrected filing receipt should be filed with a corrected ADS to correct domestic benefit or foreign priority claim information. A petition for an unintentionally delayed claim under [37 CFR 1.78\(c\) or \(e\)](#) or [37 CFR 1.55\(e\)](#) may be required if the domestic benefit or foreign priority claim is being submitted outside the time period for making a benefit or priority claim. Where the most recent filing receipt does not include a benefit claim or priority claim, either because a previously submitted ADS failed to comply with [37 CFR 1.78](#) or [1.55](#) or the claim was not previously included in an ADS, a corrected ADS submitted to add the benefit or priority claim must identify the addition of the benefit claim or priority claim with underlining relative to the most recent filing receipt (i.e., the entire benefit or priority claim must be underlined). For example, if an ADS included a benefit claim but the relationship between the instant



application and the parent application was not provided, and the most recent filing receipt for the application shows no benefit claim, the entire benefit claim must be shown with underlining in the corrected ADS. In addition, if the ADS identified an incorrect benefit claim (e.g., “division of” instead of “continuation of”) and the most recent filing receipt included the incorrect benefit claim, the corrected ADS should identify the information being deleted (e.g., “division of”) with strike-through or brackets, and should identify the information being added (e.g., “continuation of”) with underlining. In the rare circumstance where a domestic benefit or a priority claim is being deleted, applicant must provide a corrected ADS identifying the deletion of the foreign priority claim with strike-through or brackets. Before deleting a domestic benefit claim or a foreign priority claim, applicant should consider the status of the application since 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. Applicants are cautioned that new prior art may be available as a result of deleting the claim. Also, deleting a benefit or priority claim may be considered a showing that the applicant is intentionally waiving the benefit claim or priority claim to the prior application in the instant application. See [MPEP § 211.02\(a\)](#), subsection III.

### III. TREATMENT OF INCONSISTENT INFORMATION

Resolution of inconsistent information supplied by both an application data sheet and other documents (e.g., the oath or declaration under [37 CFR 1.63](#), [1.64](#), or [1.67](#)) are addressed in [37 CFR 1.76\(d\)](#).

[37 CFR 1.76\(d\)\(1\)](#) provides that the most recent submission will govern (control) with respect to inconsistencies as between the information provided in an application data sheet, a designation of a correspondence address, or by the inventor’s oath or declaration, except that: (1) the most recent application data sheet will govern with respect to foreign priority ([37 CFR 1.55](#)) or domestic benefit ([37 CFR 1.78](#)) claims; and (2) the naming of the inventorship is governed by [37 CFR 1.41](#) and changes to inventorship or the names of the inventors is governed by [37 CFR 1.48](#).

[37 CFR 1.76\(d\)\(2\)](#) provides that the information in the application data sheet will govern when the inconsistent information is supplied at the same time by a designation of correspondence address or the inventor’s oath or declaration. The information in the application data sheet will also govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

If an ADS is inconsistent with the information provided in another document that was submitted at the same time or prior to the ADS submission, the ADS will control. This is because the application data sheet is intended to be the means by which applicant provides complete bibliographic information. In the small number of instances where another document has more accurate information than a concurrently supplied application data sheet ([37 CFR 1.76\(d\)\(2\)](#)), a corrected application data sheet should be submitted to conform the information in the ADS to the correct information as provided in the other document(s).

[37 CFR 1.76\(d\)\(3\)](#) provides that the Office will capture bibliographic information from the application data sheet. [37 CFR 1.76\(d\)\(3\)](#) further provides that the Office will generally not review the inventor’s oath or declaration to determine if the bibliographic information contained therein is consistent with the bibliographic information provided in an application data sheet. [37 CFR 1.76\(d\)\(3\)](#) further provides that incorrect bibliographic information contained in an application data sheet may be corrected as provided in [37 CFR 1.76\(c\)\(1\)](#).

Examples:

If an application naming inventors A and B is filed with an application data sheet that improperly identifies the residence of inventor B and an executed [37 CFR 1.63](#) declaration that properly identifies the residence of inventor B, the Office will capture the residence information of inventor B as identified in the application data sheet, and include that information in the filing receipt. Applicant may correct the residence information by submitting an application data sheet under [37 CFR 1.76\(c\)](#)

with the name of inventor B and the corrected residence for inventor B with underlining for insertions and strike-through or brackets for text removed.

If an application is filed with an application data sheet improperly identifying inventors A, B and C and an executed [37 CFR 1.63](#) declaration correctly setting forth the inventorship as A and B, the Office will capture the inventorship as inventors A, B and C based on the information in the application data sheet, and include that information in the filing receipt. To correct the inventorship, applicant must submit a request to correct the inventorship pursuant to [37 CFR 1.48](#). See [MPEP § 602.01\(c\)](#) *et seq.*

If an application is filed with an application data sheet, the Office will capture the applicant information as identified in the application data sheet. To change the name of the applicant, a request in accordance with [37 CFR 1.46\(c\)](#), and in compliance with [37 CFR 3.71](#) and [3.73](#), is required. See [MPEP § 605.01](#), subsection II.

#### IV. ADDITIONAL INFORMATION

The application data sheet form PTO/AIA/14 provides a section where applicants can make a request not to publish the application or a request for early publication.

The application data sheet form PTO/AIA/14 provides a section where applicants can provide an Authorization to Permit Access to the Instant Application by Participating Offices. If the box in this section of the form is checked, the Office has the authority to provide access to the instant patent application to the participating offices in which a foreign application claiming priority to the instant patent application is filed.

The application data sheet form PTO/AIA/14 provides an assignee information section, which includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. The inclusion of this information in the application data sheet does not substitute for compliance with any requirement of 37 CFR part 3 to have an assignment recorded by the Office. Providing assignee information in the application data sheet is considered a request to

include such information on the patent application publication, since there is no other reason for including such information in the application data sheet. Assignment information must be recorded to have legal effect. Assignees who are the applicant will appear on the patent application publication as the applicant and only need to separately provide assignee information in the assignee information section if identification as an assignee is also desired on the patent application publication.

[37 CFR 1.76\(e\)](#) provides that an application data sheet must be signed in compliance with [37 CFR 1.33\(b\)](#). The rule further provides that an unsigned application data sheet will be treated only as a transmittal letter. Thus, an unsigned application data sheet will not be effective to provide the name of the inventor for any invention claimed in the application ([37 CFR 1.41\(b\)](#)), name as the applicant an assignee, obligated assignee, or a person who otherwise shows sufficient propriety interest in the application ([37 CFR 1.46](#)), make a claim to priority of a foreign application ([37 CFR 1.55](#)), or make a claim to the benefit of a prior-filed domestic application ([37 CFR 1.78](#)).

Effective December 18, 2013 for all applications no matter when filed, [37 CFR 1.76](#) was amended by adding new paragraphs (f) and (g) to permit the use of Patent Law Treaty Model International Forms as appropriate or the Patent Cooperation Treaty Request Form in lieu of an application data sheet under [37 CFR 1.76](#) to provide certain information. However, as provided in [37 CFR 1.76\(d\)\(2\)](#), information in an ADS will govern when inconsistent with the information supplied at any time in such forms. Furthermore, if applicants want to postpone submission of the inventor's oath or declaration until after the time period set to complete the application as provided in [37 CFR 1.53\(f\)\(1\) or \(2\)](#), an ADS that provides the inventor information is required. Accordingly, the use of an ADS to supply application information is encouraged.

[37 CFR 1.76\(f\)](#) provides that: (1) The requirement in [37 CFR 1.55](#) or [37 CFR 1.78](#) for the presentation of a priority or benefit claim under [35 U.S.C. 119, 120, 121](#), or [365](#) in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model

International Request Form; (2) the requirement in [37 CFR 1.57\(a\)](#) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form; and (3) the requirement in [37 CFR 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

[37 CFR 1.76\(g\)](#) provides that the requirement in [37 CFR 1.78](#) for the presentation of a benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet will be satisfied in a national stage application under [35 U.S.C. 371](#) by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under [PCT Article 21\(2\)](#). [37 CFR 1.76\(g\)](#) states “the Patent Cooperation Treaty Request Form contained in the international application” to make clear that the provision does not allow for that addition or correction of benefit claim (or any other) information during the national stage via the submission of a new Patent Cooperation Treaty Request Form. Applicants may add or correct benefit claim (or any other) information during the national stage via the submission of an application data sheet under [37 CFR 1.76](#) (assuming that the conditions and requirements for such addition or correction are satisfied). [37 CFR 1.76\(g\)](#) provides for presence of such benefit claim on the front page of the publication of the international application under [PCT Article 21\(2\)](#) to account for replacement sheets of the Patent Cooperation Treaty Request Form that may not be forwarded to each national office but that are reflected in the International Bureau’s publication of the international application. [37 CFR 1.76\(g\)](#) does not mention either the provisions in [37 CFR 1.55](#) for the presentation of a priority claim under [35 U.S.C. 119](#) or [365](#) in an application data

sheet or the provisions in [37 CFR 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet with respect to a national stage application under [35 U.S.C. 371](#) as this information is taken from the WIPO records of the international application in a national stage application under [35 U.S.C. 371](#).

[37 CFR 1.76\(g\)](#) also provides that the requirement in [37 CFR 1.55](#) or [37 CFR 1.78](#) for the presentation of a priority or benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet and the requirement in [37 CFR 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied in an application under [35 U.S.C. 111](#) by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. [37 CFR 1.76\(g\)](#) finally also provides that if a Patent Cooperation Treaty Request Form is submitted in an application under [35 U.S.C. 111](#), the Patent Cooperation Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under [35 U.S.C. 111](#) is desired.

### **601.05(b) Application Data Sheet (ADS) in Application Filed Before September 16, 2012 [R-01.2024]**

*[Editor Note: See [MPEP § 601.05\(a\)](#) for a discussion of the requirements of an ADS for applications filed on or after September 16, 2012.]*

#### **37 CFR 1.76 (pre-AIA) Application data sheet.**

*[Editor Note: [37 CFR 1.76](#) as reproduced below includes the revisions to paragraph (d)(2) and the addition of paragraphs (f) and (g) set forth in Changes to Implement the Patent Law Treaty, 78 FR 62368 (October 21, 2013)(final rule) as those provisions are applicable to applications filed before September 16, 2012.]*

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled “Application Data Sheet” and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Applicant information.* This information includes the name, residence, mailing address, and citizenship of each applicant (§ 1.41(b)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§ 1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor.

(2) *Correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see § 1.33(a)).

(3) *Application information.* This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (e.g., utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to § 5.2 of this chapter (see § 5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the suggested classification and Technology Center should be based upon the disclosure.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (see § 1.32).

(5) *Domestic priority information.* This information includes the application number, the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c). Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5), and need not otherwise be made part of the specification.

(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and § 1.55(a).

(7) *Assignee information.* This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

(c) *Supplemental application data sheets.* Supplemental application data sheets:

(1) May be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet, or an oath or declaration under § 1.63 or § 1.67, except that inventorship changes are governed by § 1.48, correspondence changes are governed by § 1.33(a), and citizenship changes are governed by § 1.63 or § 1.67; and

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.

(d) Inconsistencies between application data sheet and other documents. For inconsistencies between information that is supplied by both an application data sheet under this section and other documents.

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, or by a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by an amendment to the specification, a designation of correspondence address, or a § 1.63 or § 1.67 oath or declaration, except as provided by paragraph (d)(3) of this section. The information in the application data sheet will govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

(3) The oath or declaration under § 1.63 or § 1.67 governs inconsistencies with the application data sheet in the naming of inventors (§ 1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);

(4) The Office will capture bibliographic information from the application data sheet (notwithstanding whether an oath or declaration governs the information). Thus, the Office shall generally, for example, not look to an oath or declaration under § 1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet (whether the oath or declaration is submitted prior to or subsequent to the application data sheet). Captured bibliographic information derived from an application data sheet containing errors may be corrected if applicant submits a request therefor and a supplemental application data sheet.

[Editor Note: 37 CFR 1.76(e) is not applicable to applications filed before September 16, 2012.]

(f) *Patent Law Treaty Model International Forms.* The requirement in § 1.55 or § 1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model



International Request Form, and the requirement in [§ 1.57\(a\)](#) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form. The requirement in [§ 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

(g) *Patent Cooperation Treaty Request Form.* The requirement in [§ 1.78](#) for the presentation of a benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet will be satisfied in a national stage application under [35 U.S.C. 371](#) by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under [PCT Article 21\(2\)](#). The requirement in [§ 1.55](#) or [§ 1.78](#) for the presentation of a priority or benefit claim under [35 U.S.C. 119](#), [120](#), [121](#), or [365](#) in an application data sheet and the requirement in [§ 1.46](#) for the presentation of the name of the applicant under [35 U.S.C. 118](#) in an application data sheet will be satisfied in an application under [35 U.S.C. 111](#) by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. If a Patent Cooperation Treaty Request Form is submitted in an application under [35 U.S.C. 111](#), the Patent Cooperation Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under [35 U.S.C. 111](#) is desired.

## I. BIBLIOGRAPHIC INFORMATION

The naming of the inventors and the setting forth of the citizenship of each inventor must be provided in the oath or declaration under [pre-AIA 37 CFR 1.63](#) (as required by [pre-AIA 35 U.S.C. 115](#)) even if this information is provided in the application data sheet.

Applicant information includes the name, residence, mailing address, and citizenship of each applicant ([pre-AIA 37 CFR 1.41\(b\)](#)). The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. (If the applicant is not an inventor, this information also includes the applicant's authority ([pre-AIA 37 CFR 1.42](#), [1.43](#), and [1.47](#)) to apply for the patent on behalf of the inventor. The "mailing address" is the address where applicant customarily receives mail.

Correspondence information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (see [pre-AIA 37 CFR 1.33\(a\)](#)).

Application information includes the title of the invention, a suggested classification by class and subclass, the Technology Center (TC) to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, and the type of application (e.g., utility, plant, design, reissue, provisional). Application information also includes whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to [37 CFR 5.2\(c\)](#).

Although the submission of the information related to a suggested classification and TC may be provided for both provisional and nonprovisional applications filed before September 16, 2012, the Office no longer utilizes this information and will continue to follow its present procedures for classifying and assigning new applications. With regard to the suggested drawing figure, the Office now uses the drawing figure suggested by the applicant for the front page of the patent application publication when the suggestion is included on a compliant ADS timely filed before the process of publishing the application begins. However, the Office continues not to be bound by the applicant's figure suggestion, and failure to use the suggested figure for the first page of the patent application publication will not be considered a material mistake for purposes of corrected publication under [37 CFR 1.221\(b\)](#). See *Applicant-Suggested Drawing Figure in the Publication of Patent Applications*, 1514 OG 107 (September 5, 2023).

[Pre-AIA 37 CFR 1.76\(b\)\(3\)](#) also requests that the plant patent applicant state the Latin name and the variety denomination for the plant claimed. The Latin name and the variety denomination of the claimed plant are usually included in the specification of the plant patent application, and will be included in any plant patent or plant patent application publication if included in an application



data sheet or patent application. The Office, pursuant to the “International Convention for the Protection of New Varieties of Plants” (generally known by its French acronym as the UPOV convention), has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant. Having this information in an ADS will make the process of compiling this database more efficient.

Representative information includes the registration number appointed with a power of attorney in the application (preferably by reference to a customer number). [Pre-AIA 37 CFR 1.76\(b\)\(4\)](#) states that providing this information in the application data sheet does not constitute a power of attorney in the application (see [pre-AIA 37 CFR 1.32](#)). This is because the Office does not expect the application data sheet to be executed by the party (applicant or assignee) who may appoint a power of attorney in the application.

Domestic priority information includes the application number (series code and serial number), the filing date, the status (including patent number if available), and relationship of each application for which a benefit is claimed under [35 U.S.C. 119\(e\)](#), [120](#), [121](#), or [365\(c\)](#). [Pre-AIA 37 CFR 1.76\(b\)\(5\)](#) states that providing this information in the application data sheet constitutes the specific reference required by [35 U.S.C. 119\(e\)](#) or [120](#). Since the application data sheet, if provided, is considered part of the application, the specific reference to an earlier filed provisional or nonprovisional application in the application data sheet satisfies the “specific reference” requirement of [35 U.S.C. 119\(e\)\(1\)](#) or [120](#), and it also complies with [37 CFR 1.78\(a\)\(3\)](#) or [\(d\)\(3\)](#). Thus, a specific reference does not otherwise have to be made in the specification, such as in the first sentence(s) of the specification. If continuity data is included in an application data sheet, but not in the first sentence(s) of the specification, the continuity data for the patent front page will be taken from the application data sheet. No continuity data will be included in the first sentence(s) of the specification if applicant does not provide it there. [Pre-AIA 37 CFR 1.76\(b\)\(5\)](#) does not apply to provisional applications.

Foreign priority information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. [Pre-AIA 37 CFR 1.76\(b\)\(6\)](#) states that providing this information in the application data sheet constitutes the claim for priority as required by [35 U.S.C. 119\(b\)](#) and [37 CFR 1.55](#). The patent statute, [35 U.S.C. 119\(b\)](#), does not require that a claim to the benefit of a prior foreign application take any particular form. [Pre-AIA 37 CFR 1.76\(b\)\(6\)](#) does not apply to provisional applications.

[Pre-AIA 37 CFR 1.76\(b\)\(7\)](#) provides that the assignee information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. The inclusion of this information in the application data sheet does not substitute for compliance with any requirement of 37 CFR [part 3](#) to have an assignment recorded by the Office. Providing assignee information in the application data sheet is considered a request to include such information on the patent application publication, since there is no other reason for including such information in the application data sheet. Assignment information must be recorded to have legal effect.

Supplemental application data sheets may be subsequently supplied prior to payment of the issue fee to either correct or update information in a previously submitted application data sheet, or an oath or declaration under [pre-AIA 37 CFR 1.63](#) or [1.67](#). See [pre-AIA 37 CFR 1.76\(c\)\(1\)](#). A supplemental data sheet cannot be used to correct the following: (1) inventorship changes ([37 CFR 1.48](#)); (2) correspondence changes ([pre-AIA 37 CFR 1.33\(a\)](#)); and (3) citizenship changes ([pre-AIA 37 CFR 1.63](#) or [pre-AIA 37 CFR 1.67](#)). Supplemental application data sheets must be titled “Supplemental Application Data Sheet” and also contain all of the seven section headings listed in [37 CFR 1.76\(b\)](#) with all appropriate data for each heading. Supplemental application data sheets identifying only the information that is being changed (added, deleted, or modified) in the supplemental ADS are not acceptable. A supplemental ADS containing only new or changed information is likely to confuse the record, create unnecessary work for the Office, and

does not comply with [pre-AIA 37 CFR 1.76](#). If no ADS was originally filed, but applicant wants to submit an ADS to correct, modify, or augment the original application data, the ADS, even though it is the first-filed ADS, must be titled “Supplemental Application Data Sheet.”

## II. SUPPLEMENTAL ADS SUBMISSIONS

For applications filed before September 16, 2012, when submitting an application data sheet after the initial filing of the application to correct, modify, or augment the application data sheet that was submitted with the application papers on filing, the following applies:

(A) the supplemental application data sheet must be titled “Supplemental Application Data Sheet” (while the title “Supplemental Application Data Sheet” is preferred, “Supp. ADS”, “Supplemental ADS” or other variations thereof will be accepted);

(B) the supplemental application data sheet must be a full replacement copy of the original ADS, if any, with each of the seven section headings listed in [pre-AIA 37 CFR 1.76\(b\)](#), and with all appropriate data for the section heading;

(C) the supplemental application data sheet must be submitted with all changes indicated, preferably with insertions or additions indicated by underlining, and deletions, with or without replacement data, indicated by strike-through or brackets; and

(D) the supplemental application data sheet must be signed as it is a paper and/or amendment filed in the application (see [pre-AIA 37 CFR 1.33\(b\)](#) and [37 CFR 11.18](#)).

Any ADS submitted after the filing date of the application is a supplemental ADS, regardless of whether an original ADS was submitted with the application papers on filing. A supplemental ADS that is being used to correct data shown in an oath or declaration, such as foreign priority or residence information for an inventor, would show the original incorrect information with strike-through or brackets, and the new information with underlining, as if an ADS had originally been used to submit the information. For example, if the original oath or declaration included a foreign priority claim, in order to delete the foreign priority claim, applicant should provide a supplemental ADS showing the foreign

priority claim with strike-through or brackets to ensure that the patent will reflect such change.

## III. TREATMENT OF INCONSISTENT INFORMATION

Resolution of inconsistent information supplied by both an application data sheet and other documents (e.g., the oath or declaration under [pre-AIA 37 CFR 1.63](#), or [pre-AIA 37 CFR 1.67](#)) are addressed in [pre-AIA 37 CFR 1.76 \(d\)](#). If an ADS is inconsistent with the information provided in another document that was submitted at the same time or previous to the ADS submission, the ADS will control. [Pre-AIA 37 CFR 1.76\(d\)\(1\)](#) provides that the latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, a designation of a correspondence address, or by an oath or declaration under [pre-AIA 37 CFR 1.63](#) or [pre-AIA 37 CFR 1.67](#), except as provided by [pre-AIA 37 CFR 1.76\(d\)\(3\)](#). This is because the application data sheet is intended as the means by which applicants will provide most information to the Office. In the small number of instances where another document has more accurate information than a concurrently supplied application data sheet ([37 CFR 1.76\(d\)\(2\)](#)), a supplemental application data sheet should be submitted to conform the information presented by the supplemental application data sheet with the correct information in the other document(s) ([pre-AIA 37 CFR 1.76\(d\)\(1\)](#)). The information in the application data sheet will also govern when inconsistent with the information supplied at any time in a Patent Cooperation Treaty Request Form, Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form.

If an application is filed with an application data sheet improperly identifying the residence of one of the inventors, inventor B, and an executed [pre-AIA 37 CFR 1.63](#) declaration setting forth the correct but different residence of inventor B, the Office will capture the residence of inventor B found in the application data sheet as the residence of B, and include that information in the filing receipt. If

applicant desires correction of the residence, applicant should submit a supplemental application data sheet under [pre-AIA 37 CFR 1.76\(c\)](#), with the name of inventor B and the corrected residence for inventor B.

Pursuant to [pre-AIA 37 CFR 1.76\(d\)\(3\)](#), the oath or declaration under [pre-AIA 37 CFR 1.63](#) or [pre-AIA 37 CFR 1.67](#) governs inconsistencies with the application data sheet in the naming of inventors and setting forth their citizenship. If different inventors are listed in the application data sheet than are named in the oath or declaration for the application, the inventors, named in the oath or declaration, are considered to be the inventors named in the patent application. See [pre-AIA 37 CFR 1.76\(d\)\(3\)](#). Any change in the inventorship set forth in the oath or declaration under [pre-AIA 37 CFR 1.63](#) must be by way of a request under [AIA 37 CFR 1.48\(a\)](#) notwithstanding identification of the correct inventive entity in an application data sheet or supplemental application data sheet. Similarly, if the oath or declaration under [pre-AIA 37 CFR 1.63](#) incorrectly sets forth the citizenship of one of the inventors, that inventor must submit a supplemental oath or declaration under [pre-AIA 37 CFR 1.67](#) with the correct citizenship notwithstanding the correct identification of the citizenship in an application data sheet or supplemental application data sheet. If the spelling of the inventor's name is incorrect, a request under [37 CFR 1.48\(f\)](#) is required. See MPEP §§ [602.01\(c\)\(2\)](#) and [602.08\(b\)](#).

The Office will rely upon information supplied in the application data sheet over an oath or declaration to capture the data even where the type of information supplied (citizenship, inventorship) is governed by the oath or declaration according to statute ([pre-AIA 35 U.S.C. 115](#)) or other rule ([pre-AIA 37 CFR 1.41\(a\)\(1\)](#)). Where the oath or declaration under [37 CFR 1.63](#) or [pre-AIA 37 CFR 1.67](#) contains the correct information regarding inventors or their citizenship and the application data sheet does not, even though the oath or declaration governs pursuant to [pre-AIA 37 CFR 1.76\(d\)\(3\)](#), the information in the application data sheet must be corrected by submission of a request for correction and a supplemental application data sheet. If the spelling of the inventor's name is incorrect, a request

under [37 CFR 1.48\(f\)](#) is required. See MPEP §§ [602.01\(c\)\(2\)](#) and [602.08\(b\)](#).

If an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed [pre-AIA 37 CFR 1.63](#) declaration setting forth a different incorrect citizenship of inventor B, the Office will capture the citizenship of inventor B found in the application data sheet. Applicant, however, must submit a supplemental oath or declaration under [pre-AIA 37 CFR 1.67](#) by inventor B setting forth the correct citizenship even though it appears correctly in the application data sheet. A supplemental application data sheet cannot be used to correct the citizenship error in the oath or declaration. If, however, the error is one of residence, no change would be required ([pre-AIA 37 CFR 1.76\(d\)\(2\)](#)).

#### IV. ADDITIONAL INFORMATION

As to the submission of class/subclass information in the application data sheet, the Office notes that there is a distinction between permitting applicants to aid in the identification of the appropriate Art Unit to examine the application and requiring the Office to always honor such identification/request, which could lead to misuse by some applicants of forum shopping. Even when an applicant's identification of an Art Unit is appropriate, internal staffing/workload requirements may dictate that the application be handled by another Art Unit qualified to do so, particularly when the art or claims encompass the areas of expertise of more than one Art Unit.

If the applicant is not an inventor, the applicant information should also include the applicant's authority to apply for the patent on behalf of the inventor (see [pre-AIA 37 CFR 1.42](#), [1.43](#) and [1.47](#)). For example, if the inventor is deceased or legally incapacitated, the applicant should include "Legal Representative" as the authority. Similarly, if a petition under [pre-AIA 37 CFR 1.47\(b\)](#) is filed, the applicant's authority would be "Party in Interest under [35 U.S.C. 118](#)." If the application is filed by the Administrator of NASA, the applicant's authority would be "Government Property Interest."

The correspondence information may be indicated by reference to a Customer Number to which correspondence is to be directed.

Effective December 18, 2013 for all applications no matter when filed, [37 CFR 1.76](#) was amended by adding new paragraphs (f) and (g) to permit the use of Patent Law Treaty Model International Forms as appropriate or the Patent Cooperation Treaty Request Form in lieu of an application data sheet under [37 CFR 1.76](#). See [MPEP § 601.05\(a\)](#), subsection IV, for more information.

## 602 Oaths and Declarations [R-11.2013]

### 35 U.S.C. 25 Declaration in lieu of oath.

(a) The Director may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Director may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both ([18 U.S.C. 1001](#)).

### 35 U.S.C. 26 Effect of defective execution.

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Director despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

A copy, such as a photocopy or facsimile transmission, of an originally executed oath or declaration is encouraged to be filed (see [MPEP § 502.01](#)), especially since applications are maintained in electronic form, not paper. The original should be retained by applicant, or his or her representative as evidence of authenticity. If a question of authenticity arises, the U.S. Patent and Trademark Office may require submission of the original. See [37 CFR 1.4\(d\)\(1\)\(ii\)](#).

## I. OATHS

### *37 CFR 1.66 Statements under oath.*

An oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer

oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

An oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made in accordance with [37 CFR 1.66](#). The authority of military personnel to act as a notary is set forth in 10 U.S.C. 1044(a).

The language of [35 U.S.C. 115](#) and [37 CFR 1.66](#) is such that an attorney in the application is not barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his or her authority and jurisdiction and will not knowingly jeopardize his or her client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, a new oath or declaration should be submitted. The application file may be referred to the Office of Enrollment and Discipline. See [37 CFR 1.66](#) and [MPEP § 604](#).

### A. Seal

A seal is usually impressed on an oath. Documents with seals cannot be adequately scanned for retention in an Image File Wrapper, and because the Office maintains patent applications in an image form, the Office strongly encourages the use of declarations rather than oaths. However, oaths executed by military personnel in accordance with 10 U.S.C.



1044(a) and those executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina, and Virginia need not be impressed with a seal. See paragraph B. below for information regarding venue.

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his or her official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted above. When the issue concerns the authority of the person administering the oath, proof of authority may be required. Depending on the jurisdiction, the seal may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina, and Virginia.

See [MPEP § 602.04](#) for foreign executed oaths.

### **B. Venue**

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on the oath. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given either in the venue or in the body of the jurat. Otherwise, a new oath or declaration, or a certificate of the notary that the oath was taken within his or her jurisdiction, should be submitted.

## **II. DECLARATIONS**

### ***37 CFR 1.68 Declaration in lieu of oath.***

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both ([18 U.S.C. 1001](#)) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

### **18 U.S.C. 1001 Statements or entries generally.**

Whoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not more than \$10,000 or imprisoned not more than five years, or both.

By statute, [35 U.S.C. 25](#), the Director has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent and Trademark Office." A declaration may be submitted in lieu of an oath in any document filed in the Office provided the declaration complies with the requirements of [37 CFR 1.68](#). A [37 CFR 1.68](#) declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. However, because it is an integral part of the application, it must be maintained together therewith. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration.

The filing of a written declaration is acceptable in lieu of an original application oath that is informal.

Office personnel are authorized to accept a statutory declaration under 28 U.S.C. 1746 filed in the U.S. Patent and Trademark Office in lieu of an "oath" or declaration under [35 U.S.C. 25](#) and [37 CFR 1.68](#), provided the statutory declaration otherwise complies with the requirements of law.

Section 1746 of Title 28 of the United States Code provides:



Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required or permitted to be supported, evidenced, established, or proved by the sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1] If executed without the United States:

“I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature).”

[2] If executed within the United States its territories, possessions, or commonwealths:

“I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature).”

## 602.01 Naming the Inventor; Inventor's Oath or Declaration [R-07.2022]

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent (other than a provisional application) must execute an oath or declaration directed to the application, except as provided for in [37 CFR 1.64](#). See [MPEP § 602.01\(a\)](#) for the requirements of an inventor's oath or declaration in an application filed on or after September 16, 2012. See [MPEP § 602.01\(b\)](#) for the requirements of an original oath or declaration in an application filed before September 16, 2012.

See [MPEP § 2109](#) for the definition of, and requirements for, inventorship and [MPEP §§ 602.09](#) and [2109.01](#) for information pertaining to joint inventorship.

## I. NAMING INVENTORSHIP IN APPLICATION FILED ON OR AFTER SEPTEMBER 16, 2012

*[Editor Note: See subsection II., below, for naming inventorship in applications filed before September 16, 2012.]*

### 37 CFR 1.41 Inventorship.

(a) An application must include, or be amended to include, the name of the inventor for any invention claimed in the application.

(b) The inventorship of a nonprovisional application under [35 U.S.C. 111\(a\)](#) is the inventor or joint inventors set forth in the application data sheet in accordance with [§ 1.76](#) filed before or concurrently with the inventor's oath or declaration. If an application data sheet is not filed before or concurrently with the inventor's oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor's oath or declaration, except as provided for in [§§ 1.53\(d\)\(4\)](#) and [1.63\(d\)](#). Once an application data sheet or the inventor's oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to [§ 1.48](#). If neither an application data sheet nor the inventor's oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to [§ 1.53\(b\)](#), unless the applicant files a paper, including the processing fee set forth in [§ 1.17\(i\)](#), supplying the name or names of the inventor or joint inventors.

(c) The inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#). Once a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#) is filed in a provisional application, any correction of inventorship must be pursuant to [§ 1.48](#). If a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to [§ 1.53\(c\)](#), unless applicant files a paper including the processing fee set forth in [§ 1.17\(q\)](#), supplying the name or names of the inventor or joint inventors.

(d) In a nonprovisional application under [35 U.S.C. 111\(a\)](#) filed without an application data sheet or the inventor's oath or declaration, or in a provisional application filed without a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#), the name and residence of each person believed to be an actual inventor should be provided when the application papers pursuant to [§ 1.53\(b\)](#) or [§ 1.53\(c\)](#) are filed.

(e) The inventorship of an international application entering the national stage under [35 U.S.C. 371](#) is the inventor or joint inventors set forth in the application data sheet in accordance with [§ 1.76](#) filed with the initial submission under [35 U.S.C. 371](#). Unless the initial submission under [35 U.S.C. 371](#) is accompanied by an application data sheet in accordance with [§ 1.76](#) setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under [PCT Rule 92 bis](#).

(f) The inventorship of an international design application designating the United States is the creator or creators set forth

in the publication of the international registration under Hague Agreement Article 10(3). Any correction of inventorship must be pursuant to [§ 1.48](#).

An application must include, or be amended to include, the name of the inventor for any invention claimed in the application (the inventorship). See [35 U.S.C. 115\(a\)](#) and [37 CFR 1.41\(a\)](#).

As provided in [37 CFR 1.41\(b\)](#), the applicant may name the inventorship of a nonprovisional application under [35 U.S.C. 111\(a\)](#) in the application data sheet in accordance with [37 CFR 1.76](#) or in the inventor's oath or declaration. The inventorship of a nonprovisional application under [35 U.S.C. 111\(a\)](#) is the inventor or joint inventors set forth in the application data sheet in accordance with [37 CFR 1.76](#) filed before or concurrently with the inventor's oath or declaration. An application data sheet must be signed to comply with [37 CFR 1.76](#). An unsigned application data sheet is treated as only a transmittal letter. See [37 CFR 1.76\(e\)](#). If an application data sheet is not filed before or concurrently with the inventor's oath or declaration, the inventorship is the inventor or joint inventors set forth in the inventor's oath or declaration except as provided in [37 CFR 1.53\(d\)\(4\)](#) (continued prosecution applications for designs) and [37 CFR 1.63\(d\)](#) (continuing applications). Once an application data sheet or the inventor's oath or declaration is filed in a nonprovisional application, any correction of inventorship must be pursuant to [37 CFR 1.48\(a\)](#). If neither an application data sheet nor inventor's oath or declaration is filed during the pendency of a nonprovisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to [37 CFR 1.53\(b\)](#), unless the applicant files a paper, including the processing fee set forth in [37 CFR 1.17\(i\)](#), supplying the name or names of the inventor or joint inventors.

Applicants who wish to take advantage of the ability to name the inventors in an application data sheet rather than the inventor's oath or declaration should take care to ensure that an application data sheet under [37 CFR 1.76](#) that is signed in compliance with [37 CFR 1.33\(b\)](#) is present on filing, or at least prior to the filing of any inventor's oath or declaration in the application. If an inventor's oath or declaration is filed in the application prior to the filing of an application data sheet under [37 CFR 1.76](#) that is

signed in compliance with [37 CFR 1.33\(b\)](#), the inventorship named in the inventor's oath or declaration controls. For example, if an inventor's oath or declaration naming only inventor "A" is present on filing without an accompanying application data sheet, and a signed application data sheet is filed naming inventors "A" and "B" is subsequently filed in the application, the application will be treated as naming only inventor "A" (the inventor provided in the inventor's oath or declaration) until the inventorship is corrected under [37 CFR 1.48\(a\)](#).

As provided in [37 CFR 1.41\(c\)](#), the inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#). Once a cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#) is filed in a provisional application, any correction of inventorship must be pursuant to [37 CFR 1.48](#). If a cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant to [37 CFR 1.53\(c\)](#), unless the applicant files a paper including the processing fee set forth in [37 CFR 1.17\(q\)](#), supplying the name or names of the inventor or joint inventors.

[37 CFR 1.41\(d\)](#) provides that in either a nonprovisional application under [35 U.S.C. 111\(a\)](#) filed without an application data sheet or the inventor's oath or declaration, or in a provisional application filed without a cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#), the name and residence of each person believed to be an actual inventor should be provided when the application papers filed pursuant to [37 CFR 1.53\(b\) or \(c\)](#) are filed. Naming the individuals known to be inventors or the persons believed to be the inventors may enable the Office to identify the application, if applicant does not know the application number. Where no inventor(s) is known and applicant cannot name a person believed to be an inventor on filing, the Office requests that an alphanumeric identifier be submitted for the application. The use of very short identifiers should be avoided to prevent confusion. Without supplying at least a unique identifying name the Office may have no ability or only a delayed ability to match any papers submitted after filing of the application

and before issuance of an identifying application number with the application file. Any identifier used that is not an inventor's name should be specific, alphanumeric characters of reasonable length, and should be presented in such a manner that it is clear to application processing personnel what the identifier is and where it is to be found. Failure to apprise the Office of an application identifier such as the names of the inventors or the alphanumeric identifier being used may result in applicants having to resubmit papers that could not be matched with the application and proof of the earlier receipt of such papers where submission was time dependent.

[37 CFR 1.41\(e\)](#) provides that the inventorship of an international application entering the national stage under [35 U.S.C. 371](#) is the inventor or joint inventors set forth in the application data sheet in accordance with [37 CFR 1.76](#) filed with the initial submission under [35 U.S.C. 371](#). Thus, the applicant in an international application may change inventorship as to the U.S. at the time of national stage entry by simply filing an application data sheet in accordance with [37 CFR 1.76](#) with the initial submission under [35 U.S.C. 371](#) naming the inventor or joint inventors. Unless the initial submission under [35 U.S.C. 371](#) is accompanied by an application data sheet in accordance with [37 CFR 1.76](#) setting forth the inventor or joint inventors, the inventorship is the inventor or joint inventors set forth in the international application, which includes any change effected under [PCT Rule 92bis](#). [37 CFR 1.41\(e\)](#) does not provide the ability to name the inventor or joint inventors via the inventor's oath or declaration even when an application data sheet in accordance with [37 CFR 1.76](#) is not provided.

[37 CFR 1.41\(f\)](#) was added to set forth the inventorship in an international design application designating the United States. Specifically, the inventorship of an international design application designating the United States is the creator or creators set forth in the publication of the international registration under Hague Agreement Article 10(3). [37 CFR 1.41\(f\)](#) further provides that any correction of inventorship must be pursuant to [37 CFR 1.48](#).

## II. NAMING INVENTORSHIP IN AN APPLICATION FILED BEFORE SEPTEMBER 16, 2012

*[Editor Note: See subsection I., above, for naming inventorship in applications filed on or after September 16, 2012.]*

### **37 CFR 1.41 (pre-AIA) Applicant for patent.**

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by [§ 1.63](#), except as provided for in §§ [1.53\(d\)\(4\)](#) and [1.63\(d\)](#). If an oath or declaration as prescribed by [§ 1.63](#) is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to [§ 1.53\(b\)](#), unless applicant files a paper, including the processing fee set forth in [§ 1.17\(i\)](#), supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#). If a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to [§ 1.53\(c\)](#), unless applicant files a paper including the processing fee set forth in [§ 1.17\(q\)](#), supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by [§ 1.63](#) or a provisional application filed without a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to [§ 1.53\(b\)](#) or [§ 1.53\(c\)](#) are filed.

(4) The inventorship of an international application entering the national stage under [35 U.S.C. 371](#) is that inventorship set forth in the international application, which includes any change effected under [PCT Rule 92 bis](#). See [§ 1.497\(d\) and \(f\)](#) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under [PCT Rule 92 bis](#) subsequent to the execution of any declaration filed under [PCT Rule 4.17\(iv\)](#) ([§ 1.48\(f\)\(1\)](#) does not apply to an international application entering the national stage under [35 U.S.C. 371](#)).

(b) Unless the contrary is indicated the word "applicant" when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ [1.42](#), [1.43](#) or [1.47](#) who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office on behalf of the inventor or inventors, but an oath or declaration for the application ([§ 1.63](#)) can only be made in accordance with [§ 1.64](#).

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[Pre-AIA 37 CFR 1.41\(a\)\(1\)](#) defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of [pre-AIA 37 CFR 1.63](#), except as provided for in [37 CFR 1.53\(d\)\(4\)](#) and [pre-AIA 37 CFR 1.63\(d\)](#).

For applications filed prior to September 16, 2012, where the first-filed executed oath or declaration 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 [Pre-AIA 37 CFR 1.41\(a\)\(1\)](#).

As provided in [pre-AIA 37 CFR 1.41\(a\)\(2\)](#), the inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#).

See [MPEP §§ 602.08\(b\)](#) and [605.02](#) for additional information.

### III. CORRECTION OF INVENTORSHIP

For correction of inventorship, see [MPEP § 602.01\(c\)](#) *et seq.* Note that requests to correct the inventorship under [37 CFR 1.48](#) filed on or after September 16, 2012 (regardless of the application filing date) are treated by OPAP. If the request is granted, OPAP will correct the Office records and send a corrected filing receipt.

#### **602.01(a) Inventor's Oath or Declaration in Application Filed On or After September 16, 2012 [R-07.2022]**

*[Editor Note: See [MPEP § 602.01\(b\)](#) for information pertaining to an inventor's oath or declaration in applications filed before September 16, 2012.]*

##### **35 U.S.C. 115 Inventor's oath or declaration.**

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—An application for patent that is filed under [section 111\(a\)](#) or commences the national stage under [section 371](#) shall include, or be amended to include, the name of the inventor for any invention claimed in the application.

Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

(1) the application was made or was authorized to be made by the affiant or declarant; and

(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

(c) ADDITIONAL REQUIREMENTS.—The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

(d) SUBSTITUTE STATEMENT.—

(1) IN GENERAL.—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

(2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—

(A) is unable to file the oath or declaration under subsection (a) because the individual—

(i) is deceased;

(ii) is under legal incapacity; or

(iii) cannot be found or reached after diligent effort; or

(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

(3) CONTENTS.—A substitute statement under this subsection shall—

(A) identify the individual with respect to whom the statement applies;

(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

(C) contain any additional information, including any showing, required by the Director.

(e) MAKING REQUIRED STATEMENTS IN ASSIGNMENT OF RECORD.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

(f) TIME FOR FILING.—The applicant for patent shall provide each required oath or declaration under subsection (a), substitute statement under subsection (d), or recorded assignment meeting the requirements of subsection (e) no later than the date on which the issue fee for the patent is paid.



**(g) EARLIER-FILED APPLICATION CONTAINING REQUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—**

(1) EXCEPTION.—The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and that claims the benefit under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) of the filing of an earlier-filed application, if—

(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

**(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—**

(1) IN GENERAL.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

(2) SUPPLEMENTAL STATEMENTS NOT REQUIRED.—If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

(3) SAVINGS CLAUSE.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

(i) ACKNOWLEDGMENT OF PENALTIES.—Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under [section 1001 of title 18](#) by fine or imprisonment of not more than 5 years, or both.

**37 CFR 1.63 Inventor's oath or declaration.**

(a) The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as

provided for in [§ 1.64](#). An oath or declaration under this section must:

(1) Identify the inventor or joint inventor executing the oath or declaration by his or her legal name;

(2) Identify the application to which it is directed;

(3) Include a statement that the person executing the oath or declaration believes the named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and

(4) State that the application was made or was authorized to be made by the person executing the oath or declaration.

(b) Unless the following information is supplied in an application data sheet in accordance with [§ 1.76](#), the oath or declaration must also identify:

(1) Each inventor by his or her legal name; and

(2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

(c) A person may not execute an oath or declaration for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in [§ 1.56](#). There is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute, i.e., understand, the document that the person is executing.

(d)

(1) A newly executed oath or declaration under [§ 1.63](#), or substitute statement under [§ 1.64](#), is not required under [§§ 1.51\(b\)\(2\)](#) and [1.53\(f\)](#), or under [§§ 1.497](#) and [1.1021\(d\)](#), for an inventor in a continuing application that claims the benefit under [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#) in compliance with [§ 1.78](#) of an earlier-filed application, provided that an oath or declaration in compliance with this section, or substitute statement under [§ 1.64](#), was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that it was executed, is submitted in the continuing application.

(2) The inventorship of a continuing application filed under [35 U.S.C. 111\(a\)](#) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless it is accompanied by a statement signed pursuant to [§ 1.33\(b\)](#) stating the name of each inventor in the continuing application.



(3) Any new joint inventor named in the continuing application must provide an oath or declaration in compliance with this section, except as provided for in [§ 1.64](#).

(e)

(1) An assignment may also serve as an oath or declaration required by this section if the assignment as executed:

(i) Includes the information and statements required under paragraphs (a) and (b) of this section; and

(ii) A copy of the assignment is recorded as provided for in part 3 of this chapter.

(2) Any reference to an oath or declaration under this section includes an assignment as provided for in this paragraph.

(f) With respect to an application naming only one inventor, any reference to the inventor's oath or declaration in this chapter includes a substitute statement executed under [§ 1.64](#). With respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

(g) An oath or declaration under this section, including the statement provided for in paragraph (e) of this section, must be executed (i.e., signed) in accordance either with [§ 1.66](#) or with an acknowledgment that any willful false statement made in such declaration or statement is punishable under [18 U.S.C. 1001](#) by fine or imprisonment of not more than five (5) years, or both.

(h) An oath or declaration filed at any time pursuant to [35 U.S.C. 115\(b\)\(1\)](#) will be placed in the file record of the application or patent, but may not necessarily be reviewed by the Office. Any request for correction of the named inventorship must comply with [§ 1.48](#) in an application and [§ 1.324](#) in a patent.

## **I. IDENTITY OF INVENTOR(S), APPLICATION, AND REQUIRED STATEMENTS**

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent (other than a provisional application) must execute an oath or declaration directed to the application, except as provided for in [37 CFR 1.64](#). See [37 CFR 1.63\(a\)](#) and [35 U.S.C. 115](#). An oath or declaration must: (1) identify the inventor or joint inventor executing the oath or declaration by their legal name; (2) identify the application to which it is directed; (3) include a statement the person executing the oath or declaration believes the named inventor or joint inventors to be the original inventor or an original joint inventor of a claimed invention in the application for which the oath or declaration is being submitted; and (4) state that the application was made or authorized to be made by the person

executing the oath or declaration. Items (3) and (4) above are requirements of [35 U.S.C. 115\(a\) and \(b\)](#).

### **A. Inventor Name And Mailing Address**

The requirements that an oath or declaration must identify the inventor or joint inventor executing the oath or declaration by their legal name and identify the application to which it is directed are necessary for the Office to ensure compliance with the requirement of [35 U.S.C. 115\(a\)](#). Specifically, [35 U.S.C. 115\(a\)](#) requires that each individual who is the inventor or a joint inventor of a claimed invention in an application for patent has executed an oath or declaration in connection with the application (except as provided for in [35 U.S.C. 115](#)). See [MPEP § 602.08\(b\)](#) for additional information pertaining to inventor names.

Unless such information is supplied in an application data sheet in accordance with [37 CFR 1.76](#), the oath or declaration must also identify: (1) each inventor by their legal name; (2) a mailing address where the inventor or each joint inventor customarily receives mail; and (3) a residence for each inventor or joint inventor who lives at a location which is different from where the inventor or joint inventor customarily receives mail. See [37 CFR 1.63\(b\)](#).

For nonprovisional international design applications, [37 CFR 1.1021\(d\)\(3\)](#) provides that the requirement in [37 CFR 1.63\(b\)](#) to identify each inventor by their legal name, mailing address, and residence, if an inventor lives at a location which is different from the mailing address, will be considered satisfied by the presentation of such information in the international design application prior to international registration.

See also [MPEP § 602.08\(a\)](#) for additional details regarding inventor bibliographic information.

If applicant files an application data sheet (ADS) that identifies each inventor by their legal name, in accordance with [37 CFR 1.76](#), the applicant is not required to name each inventor in a single oath or declaration. This permits each joint inventor to execute an oath or declaration stating only that the joint inventor executing the oath or declaration is an original joint inventor of the claimed invention in

the application for which the oath or declaration is being submitted. To be in accordance with [37 CFR 1.76](#), the application data sheet must be signed in compliance with [37 CFR 1.33\(b\)](#). An unsigned application data sheet will be treated only as a transmittal letter.

### ***B. Identification Of Application***

See [MPEP § 602.08\(c\)](#) for the minimum information necessary to identify the application to which an oath or declaration under [37 CFR 1.63](#) is directed.

### ***C. Required Statements***

An oath or declaration under [37 CFR 1.63](#) in an application filed on or after September 16, 2012 is no longer required to contain the “reviewed and understands” clause and “duty to disclose” clause of [pre-AIA 37 CFR 1.63\(b\)\(2\) and \(b\)\(3\)](#). However, [37 CFR 1.63](#) still requires that a person executing an oath or declaration review and understand the contents of the application, and be aware of the duty to disclose under [37 CFR 1.56](#). See [37 CFR 1.63\(c\)](#). There is no minimum age for a person to be qualified to execute an oath or declaration, but the person must be competent to execute (i.e., understand) the document that the person is executing.

## **II. ASSIGNMENT-STATEMENT AS OATH OR DECLARATION**

[37 CFR 1.63\(e\)](#) implements the provisions of [35 U.S.C. 115\(e\)](#). An assignment may also serve as an oath or declaration required by [37 CFR 1.63](#) if the assignment: (1) includes the information and statements required under [37 CFR 1.63\(a\) and \(b\)](#); and (2) a copy of the assignment is recorded as provided for in 37 CFR part 3. The assignment, including the information and statements required under [37 CFR 1.63\(a\) and \(b\)](#), must be executed by the individual who is under the obligation of assignment. Any reference to an oath or declaration includes an assignment as provided for in [37 CFR 1.63\(e\)](#).

Applicants should be mindful that [37 CFR 3.31](#) requires a conspicuous indication, such as by use of a check-box on the assignment cover sheet, to alert the Office that an assignment submitted with an

application is being submitted for a dual purpose: recording in the assignment database, such as to support a power of attorney, and for use in the application as the inventor’s oath or declaration. Assignments cannot be recorded unless an application number is provided against which the assignment is to be recorded. When filing an application on paper, if an assignment is submitted for recording along with the application, the assignment is separated from the paper application after the application is assigned an application number and is forwarded to the Assignment Recordation Branch for recording in its database. The assignment does not become part of the application file. If the applicant indicates that an assignment-statement is also an oath or declaration, the Office will scan the assignment into the Image File Wrapper (IFW) file for the application before forwarding it to the Assignment Recordation Branch.

For USPTO patent electronic filing system filing of application papers, the USPTO patent electronic filing system does not accept assignments for recording purposes when filing an application. Assignments submitted via the USPTO patent electronic filing system will be made of record in the application, and will not be forwarded to the Assignment Recordation Branch for recordation by the Office. Recording of assignments may only be done electronically in EPAS (Electronic Patent Assignment System). If an applicant files the assignment-statement for recording via EPAS and utilizes the check-box, the Office will place a copy of the assignment-statement in the application file.

## **III. EXECUTION OF INVENTOR’S OATH OR DECLARATION**

With respect to an application naming more than one inventor, any reference to the inventor’s oath or declaration in 37 CFR chapter I means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless it is otherwise clear from the context. Thus, any requirement in 37 CFR chapter I for the inventor’s oath or declaration with respect to an application naming more than one inventor is met if an oath or declaration under [37 CFR 1.63](#), an assignment-statement under [37 CFR 1.63\(e\)](#), or a substitute statement under [37 CFR 1.64](#) executed by

or with respect to each joint inventor is filed. See [37 CFR 1.63\(f\)](#).

An oath or declaration under [37 CFR 1.63](#), including the assignment-statement provided for in [37 CFR 1.63\(e\)](#), must be executed (i.e., signed) in accordance either with [37 CFR 1.66](#), or with an acknowledgement that any willful false statement made in such declaration or statement is punishable under [18 U.S.C. 1001](#) by fine or imprisonment of not more than five (5) years, or both. See [37 CFR 1.63\(g\)](#) and [35 U.S.C. 115\(i\)](#). The inventor's oath or declaration must be executed (i.e., signed) by the inventor or the joint inventors, unless the inventor's oath or declaration is a substitute statement under [37 CFR 1.64](#), which must be signed by the applicant, or an assignment-statement under [37 CFR 1.63\(e\)](#), which must be signed by the inventor who is under the obligation of assignment of the patent application.

See [MPEP § 602.08\(b\)](#) for additional information regarding the execution of the inventor's oath or declaration.

See [35 U.S.C. 115\(g\)](#), [37 CFR 1.63\(d\)](#) and [MPEP § 602.05\(a\)](#) regarding the use of copies of inventor's oaths or declarations in continuing applications.

[35 U.S.C. 115\(h\)\(1\)](#) provides that any person making a statement under this section may at any time "withdraw, replace, or otherwise correct the statement at any time." [37 CFR 1.63\(h\)](#) provides that an oath or declaration filed at any time pursuant to [35 U.S.C. 115\(h\)\(1\)](#) will be placed in the file record of the application or patent, but may not necessarily be reviewed by the Office.

#### IV. FORMS

Forms PTO/AIA/01 through PTO/AIA/11 may be used when submitting the inventor's oath or declaration in an application filed on or after September 16, 2012. These forms and an "AIA Inventor's Oath or Declaration Quick Reference Guide" are available on the USPTO website at [www.uspto.gov/PatentForms](http://www.uspto.gov/PatentForms).

### 602.01(b) Inventor's Oath or Declaration in Application Filed Before September 16, 2012 [R-07.2022]

*[Editor Note: See [MPEP § 602.01\(a\)](#) for information pertaining to an inventor's oath or declaration in applications filed on or after September 16, 2012.]*

#### 35 U.S.C. 115 (pre-AIA) Oath of applicant.

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority is proved by certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. Such oath is valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him. For purposes of this section, a consular officer shall include any United States citizen serving overseas, authorized to perform notarial functions pursuant to section 1750 of the Revised Statutes, as amended (22 U.S.C. 4221).

#### 37 CFR 1.63 (pre-AIA) Oath or declaration.

(a) An oath or declaration filed under [§ 1.51\(b\)\(2\)](#) as a part of a nonprovisional application must:

(1) Be executed, i.e., signed, in accordance with either [§ 1.66](#) or [§ 1.68](#). There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

(3) Identify the country of citizenship of each inventor; and

(4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in [§ 1.56](#).

(c) Unless such information is supplied on an application data sheet in accordance with [§ 1.76](#), the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor; and

(2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to [§ 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.

(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.

(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent (other than a provisional application) must execute an oath or declaration directed to the application, except as provided for in [pre-AIA 37 CFR 1.64](#). See [pre-AIA 37 CFR 1.63\(a\)](#) and [pre-AIA 35 U.S.C. 115](#). When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant or declarant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that the affiant or declarant does verily believe that the affiant or declarant is the original, first and joint inventor together with "A" or "A & B, etc." as the facts may be.

[Pre-AIA 37 CFR 1.63\(a\) and \(b\)](#) set forth the basic requirements for an oath or declaration in an application filed before September 16, 2012.

See [MPEP § 602.08 et seq.](#) for details specific to the required inventor bibliographic information, signature, and name, and to the identification of the application to which the oath or declaration applies.

Unless included in an application data sheet, oaths and declarations must make reference to any foreign application for patent (or inventor's certificate) for which priority is claimed and any foreign application filed prior to the filing date of an application on which priority is claimed. See [pre-AIA 37 CFR 1.63\(c\)\(2\)](#).

The applicant is required to recite all foreign applications filed prior to the application on which priority is claimed. It is required to give the foreign



application number and name of the country or office in which filed, as well as the filing date of each foreign application to which priority is claimed.

See [MPEP § 602.03](#) for information pertaining to defective oaths or declarations.

Forms PTO/SB/01 through PTO/SB/04 may be used when submitting the inventor's oath or declaration in an application filed before September 16, 2012, which are available on the USPTO website at [www.uspto.gov/patents/apply/forms/forms](http://www.uspto.gov/patents/apply/forms/forms).

### **602.01(c) Correction of Inventorship, Name of Inventor, and Order of Names in an Application [R-07.2022]**

#### **I. NAMING INVENTORSHIP**

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 without an executed oath or declaration. See [MPEP § 602.01](#) for information specific to naming inventorship. Correction of inventorship may be requested under [37 CFR 1.48](#) or may be obtained by filing a continuing application under [37 CFR 1.53](#).

See [MPEP § 601.01\(a\)](#), subsection II for information regarding completion of a nonprovisional application subsequent to the filing date pursuant to [37 CFR 1.53\(f\)](#) (e.g., because the inventor's oath or declaration was not present on filing date). See [MPEP § 601.01\(b\)](#) for information regarding completion of a provisional application subsequent to the filing date.

#### **II. REQUESTS FOR CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48**

Correction of inventorship in an application is permitted by amendment under [35 U.S.C. 116](#), which is implemented by [37 CFR 1.48](#).

For requests for correction of inventorship filed under [37 CFR 1.48\(a\)](#) or [\(d\)](#) on or after September 16, 2012 (without regard to the filing date of the application), see [MPEP § 602.01\(c\)\(1\)](#).

For requests filed on or after September 16, 2012, under [37 CFR 1.48\(f\)](#) to correct or update inventor names, or to change the order of inventor names, see [MPEP § 602.01\(c\)\(2\)](#). Note that requests under [37 CFR 1.48](#) filed on or after September 16, 2012 will be handled by the Office of Patent Application Processing (OPAP).

For requests for correction of inventorship filed before September 16, 2012 (without regard to the filing date of the application), see [MPEP § 602.01\(c\)\(3\)](#) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018.

For additional information pertaining to correction of inventorship in applications that name joint inventors, see [MPEP § 602.09](#).

[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 [37 CFR 1.171](#)- [37 CFR 1.175](#) and [MPEP § 1412.04](#). Where such an error is to be corrected via a certificate of correction under [37 CFR 1.324](#), see [MPEP § 1481](#). See [37 CFR 1.48\(i\)](#) for correction of inventorship in interferences and contested cases before the Patent Trial and Appeal Board.

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.

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; and

(B) Where a court has issued an order under [35 U.S.C. 256](#) for correction of the inventorship of a patent. Such request should be submitted directly to the Certificate of Correction Division along with form PTO/SB/44 (see [MPEP § 1485](#)).



### III. CORRECTION OF INVENTORSHIP BY FILING CONTINUING 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](#), although it should be noted that the requirements for a request under [37 CFR 1.48](#) filed on or after September 16, 2012 are minimal.

[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. However, refiling to change inventorship could result in the loss of a benefit claim if there is no overlap in inventorship between the two applications.

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 was 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\(a\)](#) was filed requesting deletion of inventor B. The request under [37 CFR 1.48\(a\)](#) was granted by OPAP. Prior to 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.

Note that a correction of inventorship may result in the loss of power of attorney. For applications filed on or after September 16, 2012, [37 CFR 1.32\(e\)](#) provides that if the power of attorney was granted by the originally named inventive entity, and an added inventor pursuant to [37 CFR 1.48](#) does not provide a power of attorney consistent with the power of attorney granted by the originally named inventive entity, the addition of the inventor results in the loss of that power of attorney upon grant of

the [37 CFR 1.48](#) request. This provision does not preclude a practitioner from acting in a representative capacity pursuant to [37 CFR 1.34](#), if applicable.

For applications filed on or after September 16, 2012, the inventorship in the continuing application is the inventor or joint inventors specified in the ADS filed before or with the copy of the inventor's oath or declaration from the earlier-filed application. If an ADS is not filed before or with the copy of the inventor's oath or declaration, then the inventorship is the inventorship in the copy of the inventor's oath or declaration from the earlier-filed application, unless accompanied by a statement, signed by a [37 CFR 1.33\(b\)](#) party, stating the name of each inventor in the continuing application. Any new joint inventor named in the continuing application must execute an inventor's oath or declaration, except as provided for in [37 CFR 1.64](#).

#### 602.01(c)(1) Correction of Inventorship in an Application – Request Filed On or After September 16, 2012 [R-01.2024]

*[Editor Note: See [MPEP § 602.01\(c\)\(3\)](#) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018 for information about correction of inventorship for requests filed before September 16, 2012.]*

***37 CFR 1.48 Correction of inventorship pursuant to 35 U.S.C. 116 or correction of the name or order of names in a patent application, other than a reissue application.***

(a) *Nonprovisional application:* Any request to correct or change the inventorship once the inventorship has been established under [§ 1.41](#) must include:

(1) An application data sheet in accordance with [§ 1.76](#) that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in [§ 1.17\(i\)](#).

(b) *Inventor's oath or declaration for added inventor:* An oath or declaration as required by [§ 1.63](#), or a substitute statement in compliance with [§ 1.64](#), will be required for any actual inventor who has not yet executed such an oath or declaration.

(c) Any request to correct or change the inventorship under paragraph (a) of this section filed after the Office action on the merits has been given or mailed in the application must also be accompanied by the fee set forth in [§ 1.17\(d\)](#), unless the request is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.

(d) *Provisional application.* Once a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#) is filed in a provisional application, any request to correct or change the inventorship must include:

(1) A request, signed by a party set forth in [§ 1.33\(b\)](#), to correct the inventorship that identifies each inventor by his or her legal name; and

(2) The processing fee set forth in [§ 1.17\(q\)](#).

(e) 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.

\*\*\*\*\*

Requests for correction of inventorship under [37 CFR 1.48](#) filed on or after September 16, 2012 are handled by the Office of Patent Application Processing (OPAP).

### **I. 37 CFR 1.48(a) - NONPROVISIONAL APPLICATION**

Under [37 CFR 1.48\(a\)](#), an applicant may submit a request for correction of inventorship in a nonprovisional patent application once the inventorship has been established. Note that inventorship is established upon the first submission of an application data sheet or inventor's oath or declaration. See [MPEP § 602.08\(b\)](#), subsection III, for details regarding naming inventorship in an application filed on or after September 16, 2012.

A request to correct the inventorship filed under [37 CFR 1.48\(a\)](#) should identify the inventorship change and must be accompanied by a signed application data sheet (ADS) including the legal name, residence, and mailing address of the inventor or each actual joint inventor (see [37 CFR 1.76\(b\)\(1\)](#)) and the processing fee set forth in [37 CFR 1.17\(i\)](#). The application data sheet submitted with a request under [37 CFR 1.48\(a\)](#) must identify the information being changed with underlining for insertions and strike-through or brackets for text removed.

[37 CFR 1.48\(a\)](#) enables an applicant to correct inventorship where an application sets forth improper inventorship as well as where the prosecution of an application results in the need to add or delete one or more inventors (e.g., due to the addition or deletion of claims or an amendment to the claims).

### **II. 37 CFR 1.48(b) – INVENTOR'S OATH OR DECLARATION FOR ADDED INVENTOR**

[37 CFR 1.48\(b\)](#) provides that an oath or declaration as required by [37 CFR 1.63](#), or a substitute statement in compliance with [37 CFR 1.64](#), will be required for any actual inventor who has not yet executed such an oath or declaration.

For applications filed on or after September 16, 2012, the oath or declaration required by [37 CFR 1.48\(b\)](#) must comply with [37 CFR 1.63](#) in effect for applications filed on or after September 16, 2012. See [MPEP § 602.01\(a\)](#). A substitute statement in compliance with [37 CFR 1.64](#) is only available for applications filed on or after September 16, 2012. See [MPEP § 604](#) for the requirements for substitute statements.

For applications filed before September 16, 2012, the oath or declaration required by [37 CFR 1.48\(b\)](#) for an added inventor must comply with [pre-AIA 37 CFR 1.63](#) which remains in effect for applications filed before September 16, 2012. See [MPEP § 602.01\(b\)](#).

### **III. 37 CFR 1.48(c) – REQUEST FILED AFTER OFFICE ACTION ON THE MERITS**

[37 CFR 1.48\(c\)](#) provides that the fee set forth in [37 CFR 1.17\(d\)](#) (in addition to the processing fee) is required when requests under [37 CFR 1.48](#) are filed after the Office action on the merits has been given or mailed in the application. However, the fee will not be required when inventors are deleted if the request to correct or change inventorship is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.

### **IV. 37 CFR 1.48(d) – PROVISIONAL APPLICATION**

[37 CFR 1.48\(d\)](#) provides for correcting inventorship in provisional applications. Under [37 CFR 1.41\(c\)](#), the inventorship of a provisional application is the inventor or joint inventors set forth in the cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#). Once a cover sheet is filed in a provisional application, any correction of inventorship must be pursuant to [37](#)

[37 CFR 1.48](#). If a cover sheet as prescribed by [37 CFR 1.51\(c\)\(1\)](#) is not filed during the pendency of a provisional application, the inventorship is the inventor or joint inventors set forth in the application papers filed pursuant [37 CFR 1.53\(c\)](#), unless the applicant files a paper, including the processing fee set forth in [37 CFR 1.17\(q\)](#), supplying the name or names of the inventor or joint inventors.

[37 CFR 1.48\(d\)](#) provides a procedure for adding or deleting or correcting or updating the name of an inventor in a provisional application. [37 CFR 1.48\(d\)](#) requires that the submission include: (1) a request, signed by a party set forth in [37 CFR 1.33\(b\)](#), to correct the inventorship that identifies each inventor by their legal name; and (2) the fee set forth in [37 CFR 1.17\(q\)](#). When an inventor is being added, applicants should also file a corrected application data sheet or a new cover sheet providing the residence of all inventors. See [37 CFR 1.51\(c\)](#). For provisional applications, it may not be necessary to correct the inventorship under [37 CFR 1.48\(d\)](#) unless there would be no overlap of inventors upon the

filing of the nonprovisional application with the correct inventorship. 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 § 213](#).

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\(d\)](#) may still be filed with OPAP.

#### **V. FORM TO REQUEST CORRECTION OR CHANGE TO INVENTORSHIP**

The Office has a form PTO/AIA/40 to request correction in a patent application (other than a reissue application) relating to inventorship, an inventor name, or order of names. The form is reproduced below and is also available on [www.uspto.gov/PatentForms](http://www.uspto.gov/PatentForms).

Doc Code: R48.REQ

Document Description: Request under Rule 48 correcting inventorship

PTO/AIA/40 (04-18)  
 Approved for use through 05/31/2024. OMB 0651-0031  
 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.

<b>REQUEST FOR CORRECTION IN A PATENT APPLICATION RELATING TO INVENTORSHIP OR AN INVENTOR NAME, OR ORDER OF NAMES, OTHER THAN IN A REISSUE APPLICATION (37 CFR 1.48)</b>	Application Number	
	Filing Date	
	First Named Inventor	
	Art Unit	
	Examiner Name	
	Practitioner Docket Number	

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

Applicant hereby requests that the inventorship be corrected or changed, or that the name of the inventor or a joint inventor, or the order of the names of joint inventors, be changed, in the above-identified application. Note: 37 CFR 1.48 applies to any request to correct inventorship filed on or after September 16, 2012, regardless of the application filing date. Do not submit this form after payment of the issue fee or if the application has been patented. See 37 CFR 1.324 for correction of inventorship in a patent.

Please check the applicable box(es) below.

**For a nonprovisional application:**

- 1. This request is to correct or change the inventorship in a nonprovisional application (under 37 CFR 1.48(a)) and includes:
    - An application data sheet (ADS) in accordance with 37 CFR 1.76(c) with the corrected or updated information shown with markings (e.g., underlining for insertions, strikethrough for deletions). See the Manual of Patent Examining Procedure (MPEP) section 601.05(a) for information about filing an ADS in an application filed on/after September 16, 2012. For information about filing a Supplemental ADS in an application filed before September 16, 2012, see MPEP 601.05(b).
    - The processing fee set forth in 37 CFR 1.17(i). \$ \_\_\_\_\_
    - An inventor is being added. An inventor's oath or declaration by any actual inventor who has not yet executed an oath or declaration is required (see 37 CFR 1.48(b)). See MPEP 602.01(a) for information about an inventor's oath or declaration for an application filed on/after September 16, 2012 (e.g., form PTO/AIA/01). For information about an inventor's oath or declaration for an application filed before September 16, 2012 (e.g., form PTO/SB/01), see MPEP 602.01(b).
    - This request is being filed after the first Office action on the merits has been given or mailed (see 37 CFR 1.48(c) and 1.17(d)). Check one of the following:
      - This request to correct or change the inventorship is due solely to the cancellation of claims in the application.
- OR
- The fee set forth in 37 CFR 1.17(d) is due (in addition to the fee set forth in 37 CFR 1.17(i)). \$ \_\_\_\_\_

[Page 1 of 2]

A Federal agency may not conduct or sponsor, and a person is not required to respond to, nor shall a person be subject to a penalty for failure to comply with an information collection subject to the requirements of the Paperwork Reduction Act of 1995, unless the information collection has a currently valid OMB Control Number. The OMB Control Number for this information collection is 0651-0031. Public burden for this form is estimated to average 1 hour per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the information collection. Send comments regarding this burden estimate or any other aspect of this information collection, including suggestions for reducing this burden to the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 or email InformationCollection@uspto.gov. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. If filing this completed form by mail, 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/AIA/40 (04-18)

Approved for use through 05/31/2024. OMB 0651-0031

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.

**REQUEST FOR CORRECTION IN A PATENT APPLICATION RELATING TO INVENTORSHIP OR AN  
INVENTOR NAME, OR ORDER OF NAMES, OTHER THAN IN A REISSUE APPLICATION  
(37 CFR 1.48)**

2. This request is to correct or update the name of the inventor or a joint inventor, or the order of names of joint inventors, in a **nonprovisional** application (under 37 CFR 1.48(f)) and includes:

An application data sheet in accordance with 37 CFR 1.76(c) identifying the complete inventive entity, including the corrected or updated name of the inventor, or the new order of names shown with markings (e.g., underlining for insertions, strikethrough for deletions). See the MPEP 601.05(a) for information about filing an ADS in an application filed on/after September 16, 2012. For information about filing a Supplemental ADS in an application filed before September 16, 2012, see MPEP 601.05(b).

The processing fee set forth in 37 CFR 1.17(i). \$ \_\_\_\_\_

**For a provisional application:**

This request is to change or correct the inventorship, or correct or update the name of the inventor or a joint inventor, in a **provisional** application (under 37 CFR 1.48(d)) and includes:

**Attached hereto** is a document that is signed by a party set forth in 37 CFR 1.33(b) and identifies each inventor by his or her legal name, in the preferred order. Note: the document may be an application data sheet in accordance with 37 CFR 1.76(c) that identifies the changes with markings (underlining for insertions, strikethrough for deletions).

The processing fee set forth in 37 CFR 1.17(q). \$ \_\_\_\_\_

**Fee Payment Information:**

Applicant asserts small entity status. See 37 CFR 1.27.

Applicant certifies micro entity status. See 37 CFR 1.29.  
Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously

A check in the amount of the fee is enclosed.

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

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. \_\_\_\_\_.

Payment made via EFS-Web.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

Applicant\*                       attorney or agent of record                       attorney or agent acting under 37 CFR 1.34

Registration number \_\_\_\_\_                      Registration number \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Date \_\_\_\_\_

**NOTE:** This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. \*Juristic entities must be represented by a patent practitioner (See 37 CFR 1.31, applicable to any paper filed on or after September 16, 2012 that is presented on behalf of a juristic entity, regardless of application filing date). Submit multiple forms if more than one signature is required, see below\*\*.

\*\* Total of \_\_\_\_\_ forms are submitted.



#### 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. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013). <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to: 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law; 2) a Federal, state, local, or international agency, in response to its request; 3) a contractor of the USPTO having need for the information in order to perform a contract; 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record; 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations; 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals; 8) 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)); 9) the Office of Personnel Management (OPM) for personnel research purposes; and 9) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

#### Additional Uses

Additional USPTO uses of the information in this record may include disclosure to: 1) the International Bureau of the World Intellectual Property Organization, if the record is related to an international application filed under the Patent Cooperation Treaty; 2) the public i) after publication of the application pursuant to 35 U.S.C. 122(b), ii) after issuance of a patent pursuant to 35 U.S.C. 151, iii) 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 inspections, or an issued patent, or iv) without publication of the application or patent under the specific circumstances provided for by 37 CFR 1.14(a)(1)(v)-(vii); and/or 3) the National Archives and Records Administration, for inspection of records.

### **602.01(c)(2) Correcting or Updating Inventor Name 37 CFR 1.48(f) – Request Filed On or After September 16, 2012 [R-07.2022]**

*[Editor Note: See [MPEP § 602.01\(c\)\(3\)](#) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018 for a discussion of the requirements for requests to correct or update inventor name filed before September 16, 2012.]*

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

\*\*\*\*\*

(f) *Correcting or updating the name of an inventor:* Any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include:

(1) An application data sheet in accordance with [§ 1.76](#) that identifies each inventor by his or her legal name in the desired order; and

(2) The processing fee set forth in [§ 1.17\(i\)](#).

\*\*\*\*\*

The change in the order of the names of inventors in a provisional application is not provided for since provisional applications do not become application publications or patents.

The procedures for correction of inventorship and for correction to the name of an inventor or to the order of the names of the inventors are not distinct. [37 CFR 1.48\(f\)](#) permits an applicant to change or update a particular inventor's name if their legal name has changed (e.g., due to marriage), or an inventor's name contains an error (e.g., typographical or transliteration mistake or the reversal of family or given names) and allows an applicant to adjust the order of the names of joint inventors (e.g., to control the order of names on a printed patent). [37 CFR 1.48\(f\)](#) specifically provides that any request to correct or update the name of the inventor or a joint inventor, or the order of the names of joint inventors, in a nonprovisional application must include: (1) an application data sheet in accordance with [37 CFR 1.76](#) that identifies each inventor by their legal name in the desired order (identifying the information that is being changed as required by [37 CFR 1.76\(c\)\(2\)](#)); and (2) the processing fee set forth in [37 CFR 1.17\(i\)](#). In addition to the corrected

application data sheet, the request should also identify the desired inventor name change.

See [MPEP § 602.01\(c\)\(1\)](#) for a copy of form PTO/AIA/40 that may be used to correct or update in inventor's name or change the order of names in applications (other than reissue applications).

### **602.01(c)(3) [Reserved]**

### **602.02 New Oath or Substitute for Original [R-11.2013]**

Applicant may submit a new inventor's oath or declaration to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. See [37 CFR 1.67\(a\)](#). Some deficiencies or inaccuracies can be corrected with an application data sheet (ADS) in accordance with [37 CFR 1.76](#). See [MPEP § 601.05](#).

For applications filed on or after September 16, 2012, joint inventors may execute separate oaths or declarations in which only the person executing the oath or declaration is identified if an ADS is filed that provides the required inventor information. If such an ADS is not filed, then each oath or declaration must name all of the inventors. See [37 CFR 1.63\(a\) and \(b\)](#). Each separate oath or declaration by an inventor should be complete in itself.

For applications filed before September 16, 2012, where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but each oath or declaration names all of the inventors and the two taken together give all the required data, no further oath or declaration is needed.

### **602.03 Office Finds the Inventor's Oath or Declaration Defective [R-07.2022]**

Examiners are not required to review inventor's oaths or declarations that are filed in non-reissue applications. Non-examiner staff will review inventor's oaths or declarations that are filed before allowance of an application for compliance with [37 CFR 1.63](#) or [1.64](#) and may send an informational

notice to the applicant regarding any deficiencies. Similarly, non-examiner staff will review inventor's oaths or declarations at or after allowance of an application for compliance with [37 CFR 1.63](#) or [1.64](#) and will send a requirement to the applicant to correct any deficiencies. If an application data sheet has been submitted, applicant may postpone the filing of the inventor's oath or declaration until the application is in condition for allowance for applications filed on or after September 16, 2012. If an oath or declaration in compliance with [37 CFR 1.63](#), or a substitute statement in compliance with [37 CFR 1.64](#), executed by or with respect to each inventor has not been submitted at the time of allowance, a notice requiring the inventor's oath or declaration may be sent with the Notice of Allowability. The required inventor's oath or declaration must be submitted no later than the date on which the issue fee is paid. See [35 U.S.C. 115\(f\)](#).

The Office does not check the date of execution of the oath or declaration and will not require a newly executed oath or declaration based on an oath or declaration being stale (i.e., when the date of execution is more than three months prior to the filing date of the application) or where the date of execution has been omitted. However, applicants are reminded that they have a continuing duty of disclosure under [37 CFR 1.56](#).

The wording of an oath or declaration should not be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration should be submitted. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper such as an application data sheet (see [37 CFR 1.76](#) and [MPEP § 601.05](#)) and a new oath or declaration is not necessary. See [37 CFR 1.63\(b\)](#). For example, if the oath does not set forth evidence that the notary was acting within their jurisdiction at the time the oath is administered the oath, a certificate of the notary that the oath was taken within their jurisdiction will correct the deficiency. See [MPEP § 602](#).

The inventor's oath or declaration must include certain inventor bibliographic information (see [MPEP § 602.08\(a\)](#)), name the inventor or each joint

inventor and except as otherwise provided be signed by each inventor (see [MPEP § 602.08\(b\)](#)), and identify the application to which it is directed (see [MPEP § 602.08\(c\)](#)). See [MPEP § 602.04](#) for a defective foreign executed oath.

## **602.04 Foreign Executed Oath [R-07.2022]**

### *37 CFR 1.66 Statements under oath.*

*[Editor Note: Applicable only to patent applications filed under [35 U.S.C. 111\(a\)](#), [363](#), or [385](#) on or after September 16, 2012. See [37 CFR 1.66 \(pre-AIA\)](#) for the rule otherwise in effect.]*

An oath or affirmation may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

An oath executed in a foreign country must be properly authenticated.

### **I. HAGUE CONVENTION APOSTILLE**

On October 15, 1981, the Hague "Convention Abolishing the Requirement of Legalization for Foreign Public Documents" entered into force between the United States and 28 foreign countries as parties to the Convention. Subsequently, additional countries have become parties to the Convention. The Convention applies to any document submitted to the United States Patent and Trademark Office for filing or recording, which is sworn to or acknowledged by a notary public in any one of the member countries. The Convention abolishes the certification of the authority of the notary public in a member country by a diplomatic or consular officer of the United States and substitutes certification by a special certificate, or

apostille, executed by an officer of the member country.

Accordingly, the Office will accept for filing or recording a document sworn to or acknowledged before a notary public in a member country if the document bears, or has appended to it, an apostille certifying the notary's authority. The requirement for a diplomatic or consular certificate, specified in [37 CFR 1.66](#), will not apply to a document sworn to or acknowledged before a notary public in a member country if an apostille is used.

A list of the current member countries that are parties to the Hague Convention can be obtained from the Internet website of the Hague Conference on Private International Law at [www.hcch.net/en/instruments/conventions/status-table/?cid=41](http://www.hcch.net/en/instruments/conventions/status-table/?cid=41).

The Convention prescribes the following form for the apostille:

#### Model of Certificate

The certificate will be in the form of a square with sides at least 9 centimeters long.

**APOSTILLE**  
(Convention de La Haye du Oct. 5, 1961)

1. Country .....

    This public document

2. has been signed by .....

3. acting in the capacity of .....

4. bears the seal/stamp of .....

**Certified**

5. at .....

6. the .....

7. by .....

8. No. ....

9. Seal/stamp:                                      10. Signature:

.....

**II. CERTIFICATE OF DIPLOMATIC OR CONSULAR OFFICER**

When the oath is made in a foreign country not a member of the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the

United States. See [37 CFR 1.66](#). This proof may be through an intermediary, e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer



of the United States and whose authority is not authenticated or accompanied with an apostille certifying the notary's authority, the application is nevertheless accepted for purposes of examination. Applicant should submit a new oath properly authenticated by an appropriate diplomatic or consular officer, the filing of proper apostille, or a declaration ([37 CFR 1.68](#)). The Office does not return improperly authenticated oaths for proper authentication.

### **602.05 Oath or Declaration in Continuing Applications [R-11.2013]**

A copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application, or with a continuation-in-part application filed on or after September 16, 2012, even if the oath or declaration identifies the application number of the prior application. However, if such a copy of the oath or declaration is filed after the filing date of the continuation or divisional application and an application number has been assigned to the continuation or divisional application (see [37 CFR 1.5\(a\)](#)), the cover letter accompanying the oath or declaration should identify the application number of the continuation or divisional application. The cover letter should also indicate that the oath or declaration submitted is a copy of the oath or declaration from a prior application to avoid the oath or declaration being incorrectly matched with the prior application file. Furthermore, applicant should also label the copy of the oath or declaration with the application number of the continuation or divisional application in the event that the cover letter is separated from the copy of the oath or declaration.

A copy of the oath or declaration from a prior nonprovisional application may be filed in a continuation or divisional application even if the specification for the continuation or divisional application is different from that of the prior application, in that revisions have been made to clarify the text to incorporate amendments made in the prior application, or to make other changes provided the changes do not constitute new matter relative to the prior application. If the examiner determines that the continuation or divisional application contains new matter relative to the prior

application, the examiner should so notify the applicant in the next Office action and indicate that the application should be redesignated as a continuation-in-part.

See [MPEP § 602.05\(a\)](#) for information regarding an oath or declaration in a continuing application filed on or after September 16, 2012. See [MPEP § 602.05\(b\)](#) for information regarding an oath or declaration in a continuing application filed before September 16, 2012.

### **602.05(a) Oath or Declaration in Continuing Applications Filed On or After September 16, 2012 [R-07.2015]**

*[Editor Note: See [MPEP § 602.05\(b\)](#) for information regarding oath or declaration in a continuing application filed before September 16, 2012.]*

For applications filed on or after September 16, 2012, a continuing application, including a continuation-in-part application, may be filed with a copy of an oath or declaration or substitute statement from the prior nonprovisional application, provided that the oath or declaration is in compliance with [37 CFR 1.63](#) or the substitute statement is in compliance with [37 CFR 1.64](#). See [37 CFR 1.63\(d\)\(1\)](#). It should be noted that a copy of the inventor's oath or declaration submitted in a continuing application filed on or after September 16, 2012 must comply with requirements of [35 U.S.C. 115](#) and [37 CFR 1.63](#) or [1.64](#) in effect for applications filed on or after September 16, 2012. For example, the inventor's oath or declaration must include a statement that the application was made or was authorized to be made by the person executing the oath or declaration. Accordingly, a new inventor's oath or declaration may need to be filed in a continuing application filed on or after September 16, 2012, where the prior application was filed before September 16, 2012, in order to meet the requirements of [35 U.S.C. 115](#) and [37 CFR 1.63](#) (or [1.64](#)) in effect for applications filed on or after September 16, 2012.

For continuing applications filed on or after September 16, 2012 under [37 CFR 1.53\(b\)](#), the inventorship is the inventor or joint inventors

specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless it is accompanied by a signed statement pursuant to [37 CFR 1.33\(b\)](#) that states the name of each inventor in the continuing application. See [37 CFR 1.63\(d\)\(2\)](#). Any new joint inventor named in the continuing application must provide an oath or declaration in compliance with [37 CFR 1.63](#), except as provided in [37 CFR 1.64](#). See [37 CFR 1.63\(d\)\(3\)](#).

### **602.05(b) Oath or Declaration in Continuing Applications Filed Before September 16, 2012 [R-07.2015]**

*[Editor Note: See [MPEP § 602.05\(a\)](#) for information regarding oath or declaration in a continuing application filed on or after September 16, 2012.]*

A continuation or divisional application filed before September 16, 2012 under [37 CFR 1.53\(b\)](#) (other than a continuation-in-part (CIP)) may be filed with a copy of the oath or declaration from the prior nonprovisional application. See [pre-AIA 37 CFR 1.63\(d\)\(1\)\(iv\)](#).

A continuation or divisional application of a prior application accorded status under [pre-AIA 37 CFR 1.47](#) will be accorded status under [pre-AIA 37 CFR 1.47](#) if a copy of the decision according [pre-AIA 37 CFR 1.47](#) status in the prior application is filed in the continuation or divisional application, unless an oath or declaration signed by all of the inventors is included upon filing the continuation or divisional application. An oath or declaration in an application accorded status under [pre-AIA 37 CFR 1.47](#) is generally not signed by all of the inventors. Accordingly, if a copy of an oath or declaration of a prior application is submitted in a continuation or divisional application filed under [37 CFR 1.53\(b\)](#) and the copy of the oath or declaration omits the signature of one or more inventors, the Office of Patent Application Processing (OPAP) should send

a "Notice to File Missing Parts" requiring the signature of the nonsigning inventor, unless a copy of the decision according status under [pre-AIA 37 CFR 1.47](#) is also included at the time of filing of the continuation or divisional application. If OPAP mails such a Notice, a copy of the decision according status under [pre-AIA 37 CFR 1.47](#), together with a surcharge under [37 CFR 1.16\(f\)](#) for its late filing, will be an acceptable reply to the Notice. Alternatively, applicant may submit an oath or declaration signed by the previously nonsigning inventor together with the surcharge set forth in [37 CFR 1.16\(f\)](#) in reply to the Notice.

If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under [37 CFR 1.53\(b\)](#), the continuation or divisional application may either be filed (A) with a copy of an oath or declaration from a prior application and 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 continuation or divisional application (see [pre-AIA 37 CFR 1.63\(d\)](#)), or (B) with a newly executed oath or declaration naming the correct inventive entity. If an inventor named in a prior application is not an inventor in a continuation or divisional application filed under [37 CFR 1.53\(d\)](#) (continued prosecution design application), the request for filing the 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 of the invention being claimed in the continuation or divisional application (see [37 CFR 1.53\(d\)\(4\)](#)).

A continuation or divisional application filed under [37 CFR 1.53\(b\)](#) of a prior application in which a petition (or request) under [37 CFR 1.48](#) to add an inventor was filed should be filed with a copy of the executed declaration naming the correct inventive entity from the prior application or a newly executed declaration naming the correct inventive entity. A copy of any decision under [37 CFR 1.48](#) from the prior application is not required to be filed in the continuation or divisional application. See MPEP § 602.01(c)(3) in Revision 08.2017 of the Ninth Edition of the MPEP, published in January 2018, for the language of pre-AIA 37 CFR 1.48.

## 602.06 Non-English Oath or Declaration [R-08.2012]

### *37 CFR 1.69 Foreign language oaths and declarations.*

(a) Whenever an individual making an oath or declaration cannot understand English, the oath or declaration must be in a language that such individual can understand and shall state that such individual understands the content of any documents to which the oath or declaration relates.

(b) Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with [PCT Rule 4.17\(iv\)](#), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under [§ 1.63](#), the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

[37 CFR 1.69](#) requires that oaths and declarations be in a language which is understood by the individual making the oath or declaration, i.e., a language which the individual comprehends. If the individual comprehends the English language, he or she should preferably use it. If the individual cannot comprehend the English language, any oath or declaration must be in a language which the individual can comprehend. If an individual uses a language other than English for an oath or declaration, the oath or declaration must include a statement that the individual understands the content of any documents to which the oath or declaration relates. If the documents are in a language the individual cannot comprehend, the documents may be explained to him or her so that he or she is able to understand them.

The Office will accept a single non-English language oath or declaration where there are joint inventors, of which only some understand English but all understand the non-English language of the oath or declaration.

## 602.07 Oath or Declaration Filed in United States as a Designated Office [R-08.2012]

See [MPEP § 1893.01\(e\)](#).

## 602.08 Inventor and Application Information [R-11.2013]

The inventor, or each individual who is a joint inventor of a claimed invention, in an application

for patent (other than a provisional application) must execute an oath or declaration directed to the application, except as provided for in [37 CFR 1.64](#). See [MPEP § 602.01\(a\)](#) for the requirements of an inventor's oath or declaration in an application filed on or after September 16, 2012. See [MPEP § 602.01\(b\)](#) for the requirements of an original oath or declaration in an application filed before September 16, 2012.

The inventor's oath or declaration must include certain inventor bibliographic information (see [MPEP § 602.08\(a\)](#)), name the inventor or each joint inventor and except as otherwise provided be signed by each inventor (see [MPEP § 602.08\(b\)](#)), and identify the application to which it is directed (see [MPEP § 602.08\(c\)](#)).

## 602.08(a) Inventor Bibliographic Information [R-10.2019]

### I. INVENTOR'S CITIZENSHIP

For applications filed on or after September 16, 2012, the citizenship of the inventor is no longer required by [35 U.S.C. 115](#) or [37 CFR 1.63](#).

For nonprovisional applications filed before September 16, 2012, [pre-AIA 35 U.S.C. 115](#) requires the inventor(s) to state his or her citizenship. Where an inventor is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement, but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

### II. INVENTOR'S RESIDENCE

Each inventor's place of residence, that is, the city and either state or foreign country, is required to be included in the oath or declaration in a nonprovisional application for compliance with [37 CFR 1.63](#) unless it is included in an application data sheet ([37 CFR 1.76](#)). In the case of an inventor who is in one of the U.S. Armed Services, a statement to that effect is sufficient as to residence. For change of residence, see [MPEP § 719.02](#). Each inventor's residence must be included on the cover sheet for a

provisional application unless it is included in an application data sheet ([37 CFR 1.76](#)).

If only a mailing address where the inventor customarily receives mail is provided, the Office will presume that the inventor's residence is the city and either state or foreign country of the mailing address. If the inventor lives at a location which is different from the inventor's mailing address, the inventor's residence (city and either state or foreign country) must be included in the inventor's oath or declaration or an application data sheet.

### III. INVENTOR'S MAILING OR POST OFFICE ADDRESS

Each inventor's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. See [37 CFR 1.63\(b\)](#), [pre-AIA 37 CFR 1.63\(c\)](#), and [37 CFR 1.76](#). If the mailing address of any inventor has been omitted, OPAP will notify applicant of the omission and require the omitted mailing address in response to the notice.

The inventor's mailing address means that address at which he or she customarily receives his or her mail, even if it is not the main mailing address of the inventor. Either the inventor's home or business address is acceptable as the mailing address. A post office box is also acceptable. The mailing address should include the ZIP Code designation. The object of requiring each inventor's mailing address is to enable the Office to communicate directly with the inventor if desired; hence, the address of the attorney with instruction to send communications to the inventor in care of the attorney is not sufficient.

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased or legally incapacitated, such as in an application filed on or after September 16, 2012 in which a substitute statement under [37 CFR 1.64](#) is filed, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

## 602.08(b) Inventor Signature and Name [R-01.2024]

### I. SIGNATURE REQUIREMENT - EXECUTION OF INVENTOR'S OATHS OR DECLARATIONS

United States patent applications which have not been prepared and executed in accordance with the requirements of Title 35 of the United States Code and Title 37 of the Code of Federal Regulations may be abandoned. Although the statute and the rules have been in existence for many years, the Office continues to receive a number of applications which have been improperly executed and/or filed. Since the improper execution and/or filing of patent applications can ultimately result in a loss of rights, it is appropriate to emphasize the importance of proper execution and filing.

There is no requirement that a signature be made in any particular manner. See [MPEP § 402.03](#). It is permissible for an applicant to use a title of nobility or other title, such as "Dr.", in connection with their signature. The title will not appear in the printed patent. If applicant signs their name using non-English characters, then such a signature will be accepted. If the applicant is unable to write, their mark as affixed to the oath or declaration must be attested to by a witness. In the case of the oath, the notary's signature to the jurat is sufficient to authenticate the mark. See [MPEP § 602](#).

Applications filed through the USPTO patent electronic filing system must also contain an oath or declaration personally signed by the inventor.

It is improper for an applicant to sign an oath or declaration which is not attached to or does not identify the application (e.g., a specification and drawings) to which it is directed.

Attached does not necessarily mean that all the papers must be literally fastened. It is sufficient that the specification, including the claims, and the oath or declaration are physically located together at the time of execution. Physical connection is not required. Copies of declarations are encouraged. See [MPEP § 502.01](#), [§ 502.02](#), [§ 602](#), and [§ 602.05\(a\)](#).



An oath or declaration under [37 CFR 1.63](#) by each actual inventor must be presented. Each inventor need not execute the same oath or declaration. For nonprovisional international design applications, see also [37 CFR 1.1021\(d\)](#) and [1.1067](#). For applications filed before September 16, 2012, 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 (by combining the signature pages).

The provisions of [35 U.S.C. 363](#) for filing an international application under the Patent Cooperation Treaty (PCT) which designates the United States and thereby has the effect of a regularly filed United States national application, except as provided in [pre-AIA 35 U.S.C. 102\(e\)](#), are somewhat different than the provisions of [35 U.S.C. 111](#). The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in [35 U.S.C. 371\(c\)\(4\)](#) and [37 CFR 1.497](#).

[37 CFR 1.52\(c\)](#) states that “[i]nterlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to [§ 1.63](#) remain applicable to those application papers. A substitute specification ([§ 1.125](#)) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.”

An inventor is not required to re-execute a new inventor's oath or declaration after alteration of the application papers provided that the changes are minor, for example, correction of typographical errors, grammatical problems, and clarifying sentences. If the changes would amount to the introduction of new matter had the change been made to a filed application, however, then the inventor should execute a new oath or declaration after reviewing the amended application. The rule permits alterations to the specification without the inventor re-executing an oath or declaration only where the statements in the executed declaration

remain applicable. Additionally, an inventor must before executing the oath or declaration (i) review and understand the contents of the application; and (ii) be aware of their duty of disclosure. See [37 CFR 1.63\(c\)](#). If the changes made to the specification before an application is filed result in substantial alterations to the application, then an inventor may not understand the contents of the application or be aware of their duty to disclose information relating to the substantial alteration.

The signing and execution by the applicant of oaths or declarations in certain continuation or divisional applications may be omitted. See [MPEP § 201.06](#), [§ 201.07](#), and [§ 602.05\(a\)](#). For the signature on a reply, see [MPEP §§ 714.01\(a\)](#), [714.01\(c\)](#), and [714.01\(d\)](#).

## II. SIGNATURE REQUIREMENT - EXECUTION OF OATH OR DECLARATION ON BEHALF OF INVENTOR

### *A. For applications filed on or after September 16, 2012*

The inventor, or each individual who is a joint inventor of a claimed invention, in an application for patent must execute an oath or declaration directed to the application, except as provided under [37 CFR 1.64](#). Only inventors can execute an oath or declaration under [37 CFR 1.63](#). The applicant for patent may execute a substitute statement under [37 CFR 1.64](#) in lieu of an oath or declaration under the permitted circumstances. For information on the execution of a substitute statement, see [MPEP § 604](#).

### *B. For applications filed before September 16, 2012*

The oath or declaration required by [pre-AIA 35 U.S.C. 115](#) must be signed by all of the actual inventors, except under limited circumstances. [35 U.S.C. 116](#) provides that joint inventors can sign on behalf of an inventor who cannot be reached or refuses to join. See [MPEP § 409.03\(a\)](#). [35 U.S.C. 117](#) provides that the legal representative of a deceased or incapacitated inventor can sign on behalf of the inventor. If a legal representative executes an oath or declaration on behalf of a deceased inventor, the legal representative must state that the person is



a legal representative and provide the citizenship, residence, and mailing address of the legal representative. See [pre-AIA 37 CFR 1.64](#) and [MPEP § 409.01\(b\)](#). [Pre-AIA 35 U.S.C. 118](#) provides that a party with proprietary interest in the invention claimed in an application can sign on behalf of the inventor, if the inventor cannot be reached or refuses to join in the filing of the application. See [MPEP § 409.03\(b\)](#) and [§ 409.03\(f\)](#). The oath or declaration may not be signed by an attorney on behalf of the inventor, even if the attorney has been given a power of attorney to do so. *Opinion of Hon. Edward Bates*, 10 Op. Atty. Gen. 137 (1861). See also *Staeger v. Commissioner of Patents and Trademarks*, 189 USPQ 272 (D.D.C. 1976) and *In re Striker*, 182 USPQ 507 (PTO Solicitor 1973) (In each case, an oath or declaration signed by the attorney on behalf of the inventor was defective because the attorney did not have a proprietary interest in the invention.).

### III. INVENTOR'S NAME

For nonprovisional applications filed on or after September 16, 2012, [37 CFR 1.63](#) requires the identification of the inventor by his or her legal name. [37 CFR 1.63\(a\)\(1\)](#) simplifies the requirement for the inventor's name to be his or her name and no longer refers to a family or given name. The requirement for an inventor's legal name is sufficient, given that individuals do not always have both a family name and a given name, or have varying understandings of what a "given" name requires.

For nonprovisional applications filed before September 16, 2012, [pre-AIA 37 CFR 1.63\(a\)\(2\)](#) requires that each inventor be identified by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial in the oath or declaration. For example, if the applicant's full name is "John Paul Doe," either "John P. Doe" or "J. Paul Doe" is acceptable. A situation may arise where an inventor's full given name is a singular letter, or is a plurality of singular letters. For example, an inventor's full given name may be "J. Doe" or "J.P. Doe," i.e., the "J" and the "P" are not initials. In such a situation, identifying the inventor by his or her family name and the singular letter(s) is acceptable, since that is the inventor's full given name. In order to avoid an

objection under [37 CFR 1.63\(a\)\(2\)](#), applicant should point out in the oath or declaration that the singular lettering set forth is the inventor's given name. A statement to this effect, accompanying the filing of the oath or declaration, will also be acceptable.

#### A. Correction of Name

In an application where the name is typewritten with a middle name or initial, but the signature does not contain such middle name or initial, the typewritten version of the name will be used as the inventor's name for the purposes of the application and any patent that may issue from the application. No objection should be made in this instance, since the inventor's signature may differ from their legal name. Any request to have the name of the inventor or a joint inventor in a nonprovisional application corrected or updated, including correction of a typographical or transliteration error in the spelling of an inventor's name, must be by way of a request under [37 CFR 1.48\(f\)](#). A request under [37 CFR 1.48\(f\)](#) must include (1) an application data sheet in accordance with [37 CFR 1.76](#) that identifies each inventor by their legal name, and (2) the processing fee set forth in [37 CFR 1.17\(i\)](#). Requests under [37 CFR 1.48\(f\)](#) filed on or after September 16, 2012, are treated by the Office of Patent Application Processing (OPAP). If the request complies with [37 CFR 1.48\(f\)](#), OPAP will correct the Office records and send a corrected filing receipt.

If the error in the inventor's name is not detected until after the payment of the issue fee, because amendments are not permitted after the payment of the issue fee, either (A) the application must be withdrawn from issue under [37 CFR 1.313\(c\)\(2\)](#) and a request under [37 CFR 1.48\(f\)](#) to correct the inventor's name submitted with a request for continued examination (RCE) under [37 CFR 1.114](#), or (B) a certificate of correction, along with a petition under [37 CFR 1.182](#), must be filed after the patent issues requesting correction of inventor's name.

Any request to correct or change inventorship, or correct or update the name of the inventor or a joint inventor, in a provisional application must be made pursuant to [37 CFR 1.48\(d\)](#). [37 CFR 1.48\(d\)](#) requires a request signed by a party set forth in [37 CFR](#)

[1.33\(b\)](#), that identifies each inventor by their legal name, and the processing fee set forth in [37 CFR 1.17\(q\)](#). OPAP treats requests under [37 CFR 1.48\(d\)](#) and will correct the Office records and send a corrected filing receipt if the request complies with [37 CFR 1.48\(d\)](#).

### ***B. Change of Name***

When an inventor's name has been changed after the nonprovisional application has been filed and the inventor desires to change their name on the application, they must submit a request under [37 CFR 1.48\(f\)](#), including an application data sheet in accordance with [37 CFR 1.76](#), that identifies each inventor by their legal name and the processing fee set forth in [37 CFR 1.17\(i\)](#). The corrected application data sheet must identify the information being changed as required by [37 CFR 1.76\(c\)\(2\)](#). The Office of Patent Application Processing (OPAP) treats requests under [37 CFR 1.48\(f\)](#) and will correct the Office records and send a corrected filing receipt if the request complies with [37 CFR 1.48\(f\)](#). Since amendments are not permitted after the payment of the issue fee ([37 CFR 1.312](#)), a request under [37 CFR 1.48\(f\)](#) to change the name of the inventor cannot be granted if filed after the payment of the issue fee.

If the application is assigned, applicant should submit a corrected assignment document along with a cover sheet and the recording fee as set forth in [37 CFR 1.21\(h\)](#) to the Assignment Recordation Branch for a change in the assignment record.

### ***C. Order of Joint Inventor Names***

For applications filed on or after September 16, 2012, the order of names of joint patentees in the heading of the patent is taken from the order in which the names appear in the application data sheet if submitted before or with the inventor's oath or declaration. For applications filed before September 16, 2012, the order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the

names would entail changing numerous records in the Office.

Because the particular order in which the names appear is of no consequence insofar as the legal rights of the joint inventors are concerned, no changes will be made except when a request under [37 CFR 1.48\(f\)](#) (filed on or after September 16, 2012) is granted. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration. The Office of Patent Application Processing (OPAP) treats requests under [37 CFR 1.48\(f\)](#) and if the request is granted OPAP will change the order of the names in the Office computer records and send a corrected filing receipt. Because a change to the order of names of joint inventors is an amendment to the application and amendments are not permitted after the payment of the issue fee ([37 CFR 1.312](#)), a request under [37 CFR 1.48\(f\)](#) to change the order of the names of joint inventors cannot be granted if filed after the payment of the issue fee.

In those instances where the joint inventors file separate oaths or declarations in an application filed before September 16, 2012, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing or a request under [37 CFR 1.48\(f\)](#) is granted. For applications filed on or after September 16, 2012, the order of inventors is taken from an application data sheet in accordance with [37 CFR 1.76](#) if filed before or with the inventor's oath or declaration unless a request under [37 CFR 1.48\(f\)](#) is granted. A request under [37 CFR 1.48\(f\)](#) may be filed on or after September 16, 2012 to change the order of the names of joint inventors in a nonprovisional application regardless of the filing date of the application.

## **602.08(c) Identification of Application [R-07.2015]**

[37 CFR 1.63](#) requires that an oath or declaration identify the application (e.g., specification and drawings) to which it is directed.

The following combination of information supplied in an oath or declaration filed on the application filing date with a specification are acceptable as minimums for identifying the application and compliance with any one of the items below will be accepted as complying with the identification requirement of [37 CFR 1.63](#):

(A) name of inventor(s), and reference to an attached specification or application which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration on filing;

(B) name of inventor(s), and attorney docket number which was on the specification as filed; or

(C) name of inventor(s), and title of the invention which was on the specification as filed.

Filing dates are granted on applications filed without an inventor's oath or declaration in compliance with [37 CFR 1.63](#). The following combinations of information supplied in an oath or declaration filed after the filing date of the application are acceptable as minimums for identifying the application and compliance with any one of the items below will be accepted as complying with the identification requirement of [37 CFR 1.63](#):

(A) application number (consisting of the series code and the serial number, e.g., 08/123,456);

(B) serial number and filing date;

(C) international application number of an international application;

(D) international registration number of an international design application;

(E) attorney docket number which was on the specification as filed;

(F) title of the invention which was on the specification as filed and reference to an attached specification or application which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(G) title of the invention which was on the specification as filed and accompanied by a cover letter accurately identifying the application for which it was intended by either the application number (consisting of the series code and the serial number, e.g., 08/123,456), or serial number and filing date.

Absent any statement(s) to the contrary, it will be presumed that the application filed in the USPTO is the application which the inventor(s) executed by signing the oath or declaration.

Any specification that is filed attached to an oath or declaration on a date later than the application filing date will not be compared with the specification submitted on filing. Absent any statement(s) to the contrary, the "attached" specification will be presumed to be a copy of the specification and any amendments thereto, which were filed in the USPTO in order to obtain a filing date for the application.

Any variance from the above guidelines will only be considered upon the filing of a petition for waiver of the rules under [37 CFR 1.183](#) accompanied by a petition fee ([37 CFR 1.17\(f\)](#)).

Further an oath or declaration attached to a cover letter referencing an incorrect application may not become associated with the correct application and, therefore, could result in the abandonment of the correct application.

See [MPEP § 1896](#) for the identification requirements for a declaration filed in a U.S. national stage application filed under [35 U.S.C. 371](#).

## 602.09 Joint Inventors [R-10.2019]

### 35 U.S.C. 116 Inventors.

*[Editor Note: Applicable to proceedings commenced on or after September 16, 2012. See [35 U.S.C. 116 \(pre-AIA\)](#) for the law otherwise applicable.]*

(a) JOINT INVENTIONS.—When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

(b) OMITTED INVENTOR.—If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Director, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever through error a person is named in an application for patent as the inventor, or through an error an inventor is not named in an application, the Director may permit the application to be amended accordingly, under such terms as he prescribes.

**35 U.S.C. 116 (pre-AIA) Inventors.**

*[Editor Note: Not applicable to proceedings commenced on or after September 16, 2012. See [35 U.S.C. 116](#) for the law otherwise applicable.]*

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each make the required oath, except as otherwise provided in this title. Inventors may apply for a patent jointly even though (1) they did not physically work together or at the same time, (2) each did not make the same type or amount of contribution, or (3) each did not make a contribution to the subject matter of every claim of the patent.

\*\*\*\*\*

**37 CFR 1.45 Joint inventors.**

\*\*\*\*\*

(b) Inventors may apply for a patent jointly even though:

- (1) They did not physically work together or at the same time;
- (2) Each inventor did not make the same type or amount of contribution; or
- (3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under [35 U.S.C. 116](#). If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under [35 U.S.C. 116](#).

Joint inventors do not have to separately “sign the application,” but only need apply for the patent jointly and make the required oath or declaration in a nonprovisional application by signing the same. See [MPEP §§ 602.01\(a\)](#) and [602.01\(b\)](#).

Because provisional applications may be filed without claims, [37 CFR 1.45\(c\)](#) states that each inventor named in a joint provisional application must have made a contribution to the subject matter disclosed in the application.

[35 U.S.C. 116](#) recognizes the realities of modern team research. A research project may include many

inventions. Some inventions may have contributions made by individuals who are not involved in other, related inventions.

[35 U.S.C. 116](#) (and [37 CFR 1.45](#)) allows inventors to apply for a patent jointly even though

(A) they did not physically work together or at the same time,

(B) each did not make the same type or amount of contribution, or

(C) each did not make a contribution to the subject matter of every claim of the patent.

See [MPEP § 2109.01](#) for a discussion of the legal requirements for joint inventorship.

Applicants are responsible for correcting, and are required to correct, the inventorship in compliance with [37 CFR 1.48](#) when the application is amended to change the claims so that one (or more) of the named inventors is no longer an inventor of the subject matter of a claim remaining in the application. Requests under [37 CFR 1.48](#) filed on or after September 16, 2012 (regardless of the application filing date) are treated by OPAP. If the request is granted, OPAP will correct the Office records and send a corrected filing receipt.

Like other patent applications, jointly filed applications are subject to the requirements of [35 U.S.C. 121](#) that an application be directed to only a single invention. If an application by joint inventors includes more than one independent and distinct invention, restriction may be required with the possible result of a necessity to change the inventorship named in the application if the elected invention was not the invention of all the originally named inventors. In such a case, a “divisional” application complying with [35 U.S.C. 120](#) would be entitled to the benefit of the earlier filing date of the original application. In requiring restriction in an application filed by joint inventors, the examiner should remind applicants of the necessity to correct the inventorship pursuant to [37 CFR 1.48](#) if an invention is elected and the claims to the invention of one or more inventors are canceled.

[35 U.S.C. 116](#) increases the likelihood that different claims of an application or patent may have different



dates of invention even though the patent covers only one independent and distinct invention within the meaning of [35 U.S.C. 121](#). The examiner should not inquire of the patent applicant concerning the inventors and the invention dates for the subject matter of the various claims until it becomes necessary to do so in order to properly examine the application. If an application is filed with joint inventors, the examiner should assume that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made, unless there is evidence to the contrary. When necessary, the U.S. Patent and Trademark Office or a court may inquire of the patent applicant or owner the inventorship or ownership of each claimed invention on its effective filing date, or on its date of invention, as applicable. [37 CFR 1.110](#). Pending nonprovisional applications will be permitted to be amended by complying with [37 CFR 1.48](#) to add claims to inventions by inventors not named when the application was filed as long as such inventions were disclosed in the application as filed since [37 CFR 1.48](#) permits correction of inventorship where the correct inventor or inventors are not named in an application for patent.

## 603 Supplemental Oath or Declaration [R-07.2015]

### I. APPLICATIONS FILED ON OR AFTER SEPTEMBER 16, 2012

*[Editor Note: See subsection II., below, for information regarding supplemental oath or declaration in an application filed before September 16, 2012.]*

#### **37 CFR 1.67 Supplemental oath or declaration.**

(a) The applicant may submit an inventor's oath or declaration meeting the requirements of [§ 1.63](#), [§ 1.64](#), or [§ 1.162](#) to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. Deficiencies or inaccuracies due to the failure to meet the requirements of [§ 1.63\(b\)](#) in an oath or declaration may be corrected with an application data sheet in accordance with [§ 1.76](#), except that any correction of inventorship must be pursuant to [§ 1.48](#).

(b) A supplemental inventor's oath or declaration under this section must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

(c) The Office will not require a person who has executed an oath or declaration in compliance with [35 U.S.C. 115](#) and [§](#)

[1.63](#) or [1.162](#) for an application to provide an additional inventor's oath or declaration for the application.

(d) No new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to correct deficiencies or inaccuracies present in the earlier-filed inventor's oath or declaration.

[37 CFR 1.67](#) provides for a supplemental inventor's oath or declaration (which includes oaths, declarations, assignment-statements under [37 CFR 1.63\(e\)](#), and substitute statements under [37 CFR 1.64](#)) under [35 U.S.C. 115\(h\)](#).

[37 CFR 1.67\(a\)](#) provides that the applicant may submit an inventor's oath or declaration meeting the requirements of [37 CFR 1.63](#), [1.64](#), or [1.162](#) to correct any deficiencies or inaccuracies present in an earlier-filed inventor's oath or declaration. See [35 U.S.C. 115\(h\)\(1\)](#). [37 CFR 1.67\(a\)](#) also provides that deficiencies or inaccuracies due to the failure to meet the requirements of [37 CFR 1.63\(b\)](#) in an oath or declaration may be corrected with an application data sheet in accordance with [37 CFR 1.76](#), except that any correction of inventorship must be pursuant to [37 CFR 1.48](#). Thus, an error in an inventor's mailing address may be corrected with an application data sheet in accordance with [37 CFR 1.76](#). See [37 CFR 1.76\(c\)](#). Any request to correct or change inventorship in a nonprovisional application must be by way of a request under [37 CFR 1.48\(a\)](#). Any request to correct or update the name of an inventor in a nonprovisional application must be by way of a request under [37 CFR 1.48\(f\)](#).

[37 CFR 1.67\(b\)](#) provides that a supplemental inventor's oath or declaration under [37 CFR 1.67](#) must be executed by the person whose inventor's oath or declaration is being withdrawn, replaced, or otherwise corrected.

[37 CFR 1.67\(c\)](#) provides that the Office will not require a person who has executed an oath or declaration in compliance with [35 U.S.C. 115](#) and [37 CFR 1.63](#) or [1.162](#) for an application to provide an additional inventor's oath or declaration for the application. See [35 U.S.C. 115\(h\)\(2\)](#).

[37 CFR 1.67\(d\)](#) contains the provision of former [37 CFR 1.67\(b\)](#) that no new matter may be introduced into a nonprovisional application after its filing date even if an inventor's oath or declaration is filed to



correct deficiencies or inaccuracies present in the earlier-filed oath or declaration.

## II. APPLICATIONS FILED BEFORE SEPTEMBER 16, 2012

*[Editor Note: See subsection I., above, for information regarding supplemental oath or declaration in an application filed on or after September 16, 2012.]*

### 37 CFR 1.67 (pre-AIA) Supplemental oath or declaration.

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of [§ 1.63](#) or [§ 1.162](#) to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants ([§§ 1.42, 1.43, or 1.47](#)) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) ([§§ 1.42, 1.43 or 1.47](#)) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of [§ 1.63\(c\)](#) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with [§ 1.76](#).

(4) Submission of a supplemental oath or declaration or an application data sheet ([§ 1.76](#)), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by [§ 1.33\(a\)\(2\)](#) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of [§ 1.63](#) must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with [§ 1.53\(f\)](#) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c) [Reserved]

[Pre-AIA 37 CFR 1.67](#) requires in the supplemental oath or declaration substantially all the data called for in [pre-AIA 37 CFR 1.63](#) for the original oath or declaration. As to the purpose to be served by the supplemental oath or declaration, the examiner

should bear in mind that it cannot be availed of to introduce new matter into an application.

Deficiencies or inaccuracies in an oath or declaration may be corrected by a supplemental oath or declaration. The supplemental oath or declaration must (1) identify the entire inventive entity, and (2) be signed by all the inventors when the correction relates to all the inventors or applicants ([pre-AIA 37 CFR 1.42, 1.43, or 1.47](#)), or by only those inventor(s) or applicants ([pre-AIA 37 CFR 1.42, 1.43, or 1.47](#)) to whom the corrections relates. See [pre-AIA 37 CFR 1.67\(a\)](#). A deficiency or inaccuracy relating to information required by [pre-AIA 37 CFR 1.63\(c\)](#) may also be corrected with an application data sheet ([pre-AIA 37 CFR 1.67\(a\)\(3\)](#)). The following examples illustrate how certain deficiencies or inaccuracies in an oath or declaration may be corrected:

Example 1: An application was filed with a declaration under [pre-AIA 37 CFR 1.63](#) executed by inventors A, B, and C. If it is later determined that the citizenship of inventor C was in error, a supplemental declaration identifying inventors A, B, and C may be signed by inventor C alone correcting C's citizenship.

Example 2: An application was filed with a declaration under [pre-AIA 37 CFR 1.63](#) executed by inventors A, B, and C. If it is later determined that the duty to disclose clause was omitted, a supplemental declaration identifying inventors A, B, and C must be signed by inventors A, B, and C. If separate declarations had been executed by each of the inventors and the duty to disclose clause had been omitted only in the declaration by inventor B, then only inventor B would need to execute a supplemental declaration identifying the entire inventive entity.

Example 3: An application was filed with a declaration under [pre-AIA 37 CFR 1.63](#) executed by inventors A, and B, and the legal representative of deceased inventor C. It is later determined that an error was made in the citizenship of deceased inventor C. A supplemental declaration identifying A, B, and C as the inventors would be required to be signed by the legal representative of deceased inventor C alone correcting C's citizenship.

Example 4: An application was filed with a declaration under [pre-AIA 37 CFR 1.63](#) executed by inventors A and B. If it is later determined that an error exists in the mailing address of inventor B, the mailing address of inventor B may be corrected by a supplemental declaration identifying the entire inventive entity and signed by inventor B alone, or an application data sheet under [37 CFR 1.76](#) containing only a change in inventor B's mailing address.

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with [37 CFR 1.183](#). All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See [MPEP § 409.03\(a\)](#). If there are no joint inventor(s), then the party with sufficient proprietary interest must sign the supplemental declaration on behalf of the nonsigning inventor. See [MPEP § 409.03\(b\)](#).

### 603.01 Supplemental Oath or Declaration Filed After Allowance [R-11.2013]

Supplemental oaths and declarations covering the claims in the application may be filed after allowance as a matter of right. When received they will be placed in the file by the Office of Data Management, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under [37 CFR 1.312](#), since they make no change in the wording of the papers on file. See [MPEP § 714.16](#).

### 604 Substitute Statements [R-10.2019]

*[Editor Note: This MPEP section is **only applicable** to patent applications filed on or after September 16, 2012.]*

#### *37 CFR 1.64 Substitute statement in lieu of an oath or declaration.*

(a) An applicant under [§ 1.43](#), [1.45](#) or [1.46](#) may execute a substitute statement in lieu of an oath or declaration under [§ 1.63](#) if the inventor is deceased, is under a legal incapacity, has refused to execute the oath or declaration under [§ 1.63](#), or cannot be found or reached after diligent effort.

(b) A substitute statement under this section must:

(1) Comply with the requirements of [§ 1.63\(a\)](#), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state;

(2) Identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with [§ 1.76](#), the residence and mailing address of the person signing the substitute statement;

(3) Identify the circumstances permitting the person to execute the substitute statement in lieu of an oath or declaration under [§ 1.63](#), namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under [§ 1.63](#); and

(4) Unless the following information is supplied in an application data sheet in accordance with [§ 1.76](#), also identify:

(i) Each inventor by his or her legal name; and

(ii) The last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

(c) A person may not execute a substitute statement provided for in this section for an application unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in [§ 1.56](#).

(d) Any reference to an inventor's oath or declaration includes a substitute statement provided for in this section.

(e) A substitute statement under this section must contain an acknowledgment that any willful false statement made in such statement is punishable under [section 1001 of title 18](#) by fine or imprisonment of not more than 5 years, or both.

(f) A nonsigning inventor or legal representative may subsequently join in the application by submitting an oath or declaration under [§ 1.63](#). The submission of an oath or declaration by a nonsigning inventor or legal representative in an application filed under [§ 1.43](#), [1.45](#) or [1.46](#) will not permit the nonsigning inventor or legal representative to revoke or grant a power of attorney.

[37 CFR 1.64](#) implements the substitute statement provisions of [35 U.S.C. 115\(d\)](#) and applies to applications filed on or after September 16, 2012.

[37 CFR 1.64\(a\)](#) provides that an applicant under [37 CFR 1.43](#), [1.45](#) or [1.46](#) may execute a substitute statement in lieu of an oath or declaration under [37 CFR 1.63](#) if the inventor is deceased, is under a legal

incapacity, has refused to execute the oath or declaration under [37 CFR 1.63](#), or cannot be found or reached after diligent effort. Thus, the following applicant entities may sign a substitute statement on behalf of an inventor when such a statement is permitted in a patent application:

(i) the inventor's legal representative under [37 CFR 1.43](#), where the inventor is deceased or legally incapacitated;

(ii) the other joint inventors under [37 CFR 1.45](#), where the inventor refuses to execute the oath or declaration or cannot be found or reached after diligent effort;

(iii) an applicant under [37 CFR 1.46](#) who is the assignee or party to whom the inventor is under an obligation to assign, where the inventor is deceased, legally incapacitated, refuses to execute the oath or declaration, or cannot be found or reached after diligent effort; or

(iv) an applicant under [37 CFR 1.46](#) who is a party who otherwise shows a sufficient proprietary interest in the claimed invention under [37 CFR 1.46\(b\)](#), where the inventor is deceased, legally incapacitated, refuses to sign the declaration or cannot be reached or located after diligent effort.

[35 U.S.C. 115\(d\)](#) provides that “the applicant for patent” may provide a substitute statement under one of the permitted circumstances. [37 CFR 1.64\(a\)](#) states “an applicant” but the use of “an” is to identify alternative applicant types under [37 CFR 1.43](#), [1.45](#) or [1.46](#), and should not be interpreted to provide that only one or some of the parties named as the applicant may execute the substitute statement. The following examples are provided to assist applicant in execution of the substitute statement:

1. If the inventors are the applicant and one of the inventors refuses to execute the oath or declaration or cannot be found or reached, then under [37 CFR 1.45](#) all of the other joint inventors who are the applicant (and who executed an oath or declaration) must execute the substitute statement on behalf of the non-signing inventor. Joint inventors cannot execute a substitute statement for a deceased or legally incapacitated joint inventor.

2. If the inventor is deceased or legally incapacitated, then the substitute statement may be executed by a legal representative under [37 CFR](#)

[1.43](#) or by the applicant under [37 CFR 1.46](#). Where the inventors are the applicant, only the legal representative would execute the substitute statement for the deceased or legally incapacitated inventor, and the Office would recognize the legal representative as an applicant in place of the deceased or legally incapacitated inventor. Where the deceased or legally incapacitated inventor assigned his or her rights to a party or was under an obligation to do so, and the party is named as the applicant under [37 CFR 1.46](#), then the [37 CFR 1.46](#) applicant may execute the substitute statement without the need to seek a signature from the legal representative.

3. An applicant under [37 CFR 1.46](#) can sign under all four permitted circumstances. Where there are multiple assignees or obligated assignees who together are the applicant under [37 CFR 1.46](#), all of the parties must execute the substitute statement on behalf of the non-signing inventor. As stated previously, [35 U.S.C. 115\(d\)](#) specifies that “the applicant for patent” may execute the substitute statement. For example, where there are two inventors, and the first inventor assigned her rights to Company X and the second inventor was under an obligation to assign his rights to Company Y, Company X and Company Y could be named as the applicant for patent in the applicant information ([37 CFR 1.77\(b\)\(7\)](#)) section of the application data sheet (PTO/AIA/14 or equivalent) and should preferably be named on filing of the application. If the second inventor refused to execute an oath or declaration, then a substitute statement must be filed for the second inventor. The substitute statement must be executed by an appropriate official of Company X and an appropriate official of Company Y since together X and Y are “the applicant for patent.” Under this example, neither Company X nor Company Y could be named as the sole applicant in the application. All parties having any portion of the ownership in the patent must act together as a composite entity in patent matters before the Office. See [MPEP § 301](#).

A non-inventor applicant need not submit proof of the permitted circumstance to file a substitute statement (e.g., inventor's death certificate to establish that a named inventor is deceased). However, where the permitted circumstance identified in accordance with [37 CFR 1.64\(b\)\(3\)](#) is

other than the inventor's death or legal incapacity, the inventor must have refused to execute the oath or declaration, or applicant must have exercised diligent effort to find or reach the inventor. Though proof is not required to be submitted to the Office, proof of attempts to secure the inventor's signature should be kept in applicant's file. There is no change to what is considered a good faith attempt to contact an inventor and what constitutes a refusal to sign.

A substitute statement under [37 CFR 1.64](#) must: (1) comply with the requirements of [37 CFR 1.63\(a\)](#), identifying the inventor or joint inventor with respect to whom a substitute statement in lieu of an oath or declaration is executed, and stating upon information and belief the facts which such inventor is required to state; (2) identify the person executing the substitute statement and the relationship of such person to the inventor or joint inventor with respect to whom the substitute statement is executed, and unless such information is supplied in an application data sheet in accordance with [37 CFR 1.76](#), the residence and mailing address of the person signing the substitute statement; and (3) identify the circumstances permitting the person to execute the substitute statement, namely whether the inventor is deceased, is under a legal incapacity, cannot be found or reached after a diligent effort was made, or has refused to execute the oath or declaration under [37 CFR 1.63](#). For nonprovisional international design applications, the requirement in [37 CFR 1.64\(b\)\(2\)](#) to identify the residence and mailing address of the person signing the substitute statement will be considered satisfied by the presentation of such information in the international design application prior to international registration. See [37 CFR 1.1021\(d\)\(3\)](#).

Where an assignee executes a substitute statement, the assignee must supply his/her residence and mailing address. If the assignee is a juristic entity, the residence and mailing address of the juristic entity should be used. Additionally, if the assignee is a juristic entity, the applicant name and the title of the person executing the substitute statement must be included. For a juristic entity, the substitute statement may be signed by (A) a person in the organization having apparent authority to sign on

behalf of the organization (e.g., an officer), or (B) any person if the substitute statement sets forth that the person signing is authorized (or empowered) to act on behalf of the juristic entity (e.g., the general counsel). See [MPEP §§ 324](#) and [325](#). Note: a power of attorney to a patent practitioner to prosecute a patent application executed by the juristic entity does not make that practitioner an official of the juristic entity or empower the practitioner to sign the substitute statement.

In addition, unless such information is supplied in an application data sheet in accordance with [37 CFR 1.76](#), or in an international design application prior to registration (see [37 CFR 1.1021\(d\)\(3\)](#)), the substitute statement must also identify: (1) each inventor by his or her legal name; and (2) the last known mailing address where the inventor customarily receives mail, and last known residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor who is not deceased or under a legal incapacity.

A non-inventor applicant is not required to state in the substitute statement that he/she has reviewed and understands the contents of the application, including the claims. Nevertheless, it should be noted that a person may not execute a substitute statement under [37 CFR 1.64](#) unless that person has reviewed and understands the contents of the application, including the claims, and is aware of the duty to disclose to the Office all information known to the person to be material to patentability as defined in [37 CFR 1.56](#). See [37 CFR 1.64\(c\)](#). Any reference to an inventor's oath or declaration also includes a substitute statement as provided for in [37 CFR 1.64](#).

A substitute statement under [37 CFR 1.64](#) must contain an acknowledgement that any willful false statement made in such statement is punishable under [18 U.S.C. 1001](#) by fine or imprisonment of not more than five (5) years, or both.

A nonsigning inventor may subsequently join in the application by submitting an oath or declaration under [37 CFR 1.63](#).

Doc code: Oath  
Document Description: Oath or declaration filed

PTO/AIA/02 (07-13)  
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**SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR UTILITY  
OR DESIGN PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

<b>Title of Invention</b>			
This statement is directed to:			
<input type="checkbox"/> The attached application,			
OR			
<input type="checkbox"/> United States application or PCT international application number _____ filed on _____.			
<b>LEGAL NAME of inventor to whom this substitute statement applies:</b>			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Residence (except for a deceased or legally incapacitated inventor):			
City	State	Country	
Mailing Address (except for a deceased or legally incapacitated inventor):			
City	State	Zip	Country
I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application.			
The above-identified application was made or authorized to be made by me.			
I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies:			
<input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only),			
<input type="checkbox"/> Assignee,			
<input type="checkbox"/> Person to whom the inventor is under an obligation to assign,			
<input type="checkbox"/> Person who otherwise shows a sufficient proprietary interest in the matter (petition under 37 CFR 1.46 is required), or			
<input type="checkbox"/> Joint Inventor.			

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. 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 1 minute 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.

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## SUBSTITUTE STATEMENT

Circumstances permitting execution of this substitute statement:

Inventor is deceased,

Inventor is under legal incapacity,

Inventor cannot be found or reached after diligent effort, or

Inventor has refused to execute the oath or declaration under 37 CFR 1.63.

If there are joint inventors, please check the appropriate box below:

An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.

OR

An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

**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.

**PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

Name:	Date (Optional):
-------	------------------

Signature:

**APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

If the applicant is a juristic entity, list the applicant name and the title of the signer:

Applicant Name:

Title of Person Executing This Substitute Statement:

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

**Residence of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent):**

City	State	Country
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**Mailing Address of the signer (unless provided in an application data sheet, PTO/AIA/14 or equivalent)**

City	State	Zip	Country
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Note: Use an additional PTO/AIA/02 form for each inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration under 37 CFR 1.63.

### 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.

Doc code: Oath  
 Document Description: Oath or declaration filed

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**SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR  
 PLANT PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

<b>Title of Invention</b>			
This statement is directed to: <input type="checkbox"/> The attached application, OR <input type="checkbox"/> United States application number _____ filed on _____.			
<b>LEGAL NAME of inventor to whom this substitute statement applies:</b>			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Residence (except for a deceased or legally incapacitated inventor):			
City	State	Country	
Mailing Address (except for a deceased or legally incapacitated inventor):			
City	State	Zip	Country
I have asexually reproduced the plant to which this application applies; <input type="checkbox"/> The plant was found in a cultivated area (check this box for a newly found plant only);  I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application.  The above-identified application was made or authorized to be made by me.  I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies: <input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only), <input type="checkbox"/> Assignee, <input type="checkbox"/> Person to whom the inventor is under an obligation to assign, <input type="checkbox"/> Person who otherwise shows a sufficient proprietary interest in the matter (petition under 37 CFR 1.46 is required), or <input type="checkbox"/> Joint Inventor.			

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. 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 1 minute 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.

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## SUBSTITUTE STATEMENT

Circumstances permitting execution of this substitute statement:

- Inventor is deceased,  
 Inventor is under legal incapacity,  
 Inventor cannot be found or reached after diligent effort, or  
 Inventor has refused to execute the oath or declaration under 37 CFR 1.63.

If there are joint inventors, please check the appropriate box below:

- An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.

OR

- An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

### 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.

### PERSON EXECUTING THIS SUBSTITUTE STATEMENT:

Name:

Date (Optional):

Signature:

### APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:

If the applicant is a juristic entity, list the applicant name and the title of the signer:

Applicant Name:

Title of Person Executing  
This Substitute Statement:

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

### Residence (unless provided in an application data sheet, PTO/SB/14 or equivalent):

City

State

Country

### Mailing Address (unless provided in an application data sheet, PTO/SB/14 or equivalent)

City

State

Zip

Country

Note: Use an additional PTO/AIA/04 form for each inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration under 37 CFR 1.63.

### 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.

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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.



Doc code: REIS.DECL

Document Description: Reissue Declaration Filed In Accordance With MPEP 1414

PTO/AIA/07 (09-13)

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**SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR  
REISSUE PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

<b>Title of Invention</b>			
This statement is directed to:			
<input type="checkbox"/> The attached application, OR <input type="checkbox"/> was filed on _____ as reissue application number _____.			
<b>LEGAL NAME of inventor to whom this substitute statement applies:</b>			
(E.g., Given Name (first and middle (if any)) and Family Name or Surname)			
Residence (except for a deceased or legally incapacitated inventor):			
City	State	Country	
Mailing Address (except for a deceased or legally incapacitated inventor):			
City	State	Zip	Country
I believe the above-named inventor or joint inventor to be the original inventor or an original joint inventor of a claimed invention in the application. The above-identified application was made or authorized to be made by me. I hereby acknowledge that any willful false statement made in this statement is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
Relationship to the inventor to whom this substitute statement applies:			
<input type="checkbox"/> Legal Representative (for deceased or legally incapacitated inventor only), <input type="checkbox"/> Assignee, or <input type="checkbox"/> Joint Inventor.			
Circumstances permitting execution of this substitute statement:			
<input type="checkbox"/> Inventor is deceased, <input type="checkbox"/> Inventor is under legal incapacity, <input type="checkbox"/> Inventor cannot be found or reached after diligent effort, or <input type="checkbox"/> Inventor has refused to execute the oath or declaration under 37 CFR 1.175.			

[Page 1 of 3]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. 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 1 minute 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.*

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 REISSUE PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

If there are joint inventors, please check the appropriate box below:

An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) naming the entire inventive entity has been or is currently submitted.

OR

An application data sheet under 37 CFR 1.76 (PTO/AIA/14 or equivalent) has not been submitted. Thus, a Substitute Statement Supplemental Sheet (PTO/AIA/11 or equivalent) naming the entire inventive entity and providing inventor information is attached. See 37 CFR 1.64(b).

I believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

by reason of a defective specification or drawing.

by reason of the patentee claiming more or less than he had the right to claim in the patent.

by reason of other errors.

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, a claim that the application seeks to broaden must be identified:

**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.

**PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

Name:	Date (Optional):
-------	------------------

Signature:

**APPLICANT NAME AND TITLE OF PERSON EXECUTING THIS SUBSTITUTE STATEMENT:**

If the applicant is a juristic entity, list the applicant name and the title of the signer.

Applicant Name:

Title of Person Executing This Substitute Statement:

The signer, whose title is supplied above, is authorized to act on behalf of the applicant.

PTO/AIA/07 (09-13)

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**SUBSTITUTE STATEMENT IN LIEU OF AN OATH OR DECLARATION FOR  
REISSUE PATENT APPLICATION (35 U.S.C. 115(d) AND 37 CFR 1.64)**

<b>Residence of the signer (unless provided in an application data sheet, PTO/SB/14 or equivalent):</b>			
City	State	County	
Mailing Address of the signer (unless provided in an application data sheet, PTO/SB/14 or equivalent):			
City	State	Zip	Country
Note: Use an additional PTO/AIA/07 form for each inventor who is deceased, legally incapacitated, cannot be found or reached after diligent effort, or has refused to execute the oath or declaration under 37 CFR 1.63.			

[Page 3 of 3]

## 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.

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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.

## 605 Applicant [R-11.2013]

Effective September 16, 2012, the Office revised the rules of practice to permit a person to whom the inventor has assigned or is under an obligation to assign an invention to file and prosecute an application for patent as the applicant, and to permit a person who otherwise shows sufficient proprietary interest in the matter to file and prosecute an application for patent as the applicant on behalf of the inventor. See [MPEP § 605.01](#) for information regarding the applicant in applications filed on or after September 16, 2012.

For applications filed before September 16, 2012, a person to whom the inventor assigned an invention could file and prosecute an application for patent, but the inventor is considered the applicant. See [MPEP § 605.02](#) for information regarding the applicant in applications filed before September 16, 2012.

### 605.01 Applicant for Application filed on or after September 16, 2012 [R-10.2019]

*[Editor Note: See [MPEP § 605.02](#) for information regarding the applicant in applications filed before September 16, 2012.]*

The owner or assignee of a patent property can take action in a patent application as the applicant. The original applicant is presumed to be the owner of an application for an original patent, and any patent that may issue therefrom in the absence of an assignment. [37 CFR 3.73](#). An assignee who is not the original applicant must become the applicant under [37 CFR 1.46](#) in order to request or take action in a patent application. See [MPEP § 325](#).

#### I. DEFINITION OF APPLICANT

##### *37 CFR 1.42 Applicant for patent.*

(a) The word "applicant" when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in [§§ 1.43, 1.45, or 1.46](#).

(b) If a person is applying for a patent as provided in [§ 1.46](#), the word "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under [§ 1.46](#) and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in [§ 1.45](#), the phrase "the applicant" means the joint inventors who are applying for the patent without the omitted inventor(s).

(d) Any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with [§ 1.63](#) or [1.64](#), a correspondence address may be provided only in accordance with [§ 1.33\(a\)](#), and amendments and other papers must be signed in accordance with [§ 1.33\(b\)](#).

(e) The Office may require additional information where there is a question concerning ownership or interest in an application, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

##### *37 CFR 1.43 Application for patent by a legal representative of a deceased or legally incapacitated inventor.*

If an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. If an inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention. See [§ 1.64](#) concerning the execution of a substitute statement by a legal representative in lieu of an oath or declaration.

##### *37 CFR 1.45 Application for patent by joint inventors.*

(a) Joint inventors must apply for a patent jointly, and each must make an inventor's oath or declaration as required by [§ 1.63](#), except as provided for in [§ 1.64](#). If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See [§ 1.64](#) concerning the execution of a substitute statement by the other joint inventor or inventors in lieu of an oath or declaration.

(b) Inventors may apply for a patent jointly even though:

- (1) They did not physically work together or at the same time;
- (2) Each inventor did not make the same type or amount of contribution; or
- (3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under [35 U.S.C. 116](#). If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under [35 U.S.C. 116](#).

##### *37 CFR 1.46 Application for patent by an assignee, obligated assignee, or a person who otherwise shows sufficient proprietary interest in the matter.*



[Editor Note: Applicable only to patent applications filed under [35 U.S.C. 111\(a\)](#) or [363](#) on or after September 16, 2012. See [37 CFR 1.46 \(pre-AIA\)](#) for the rule otherwise in effect.]

(a) A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties.

(b) If an application under [35 U.S.C. 111](#) is made by a person other than the inventor under paragraph (a) of this section, the application must contain an application data sheet under [§ 1.76](#) specifying in the applicant information section ([§ 1.76\(b\)\(7\)](#)) the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter. If an application entering the national stage under [35 U.S.C. 371](#), or a nonprovisional international design application, is applied for by a person other than the inventor under paragraph (a) of this section, the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter must have been identified as the applicant for the United States in the international stage of the international application or as the applicant in the publication of the international registration under Hague Agreement Article 10(3).

(1) If the applicant is the assignee or a person to whom the inventor is under an obligation to assign the invention, documentary evidence of ownership (*e.g.*, assignment for an assignee, employment agreement for a person to whom the inventor is under an obligation to assign the invention) should be recorded as provided for in part 3 of this chapter no later than the date the issue fee is paid in the application.

(2) If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including:

(i) The fee set forth in [§ 1.17\(g\)](#);

(ii) A showing that such person has sufficient proprietary interest in the matter; and

(iii) A statement that making the application for patent by a person who otherwise shows sufficient proprietary interest in the matter on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties.

(c)(1) *Correction or update in the name of the applicant.* Any request to correct or update the name of the applicant under this section must include an application data sheet under [§ 1.76](#) specifying the correct or updated name of the applicant in the applicant information section ([§ 1.76\(b\)\(7\)](#)), in accordance with [§ 1.76\(c\)\(2\)](#). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

(c)(2) *Change in the applicant.* Any request to change the applicant under this section after an original applicant has been specified must include an application data sheet under [§ 1.76](#) specifying the applicant in the applicant information section

([§ 1.76\(b\)\(7\)](#)) in accordance with [§ 1.76\(c\)\(2\)](#) and comply with [§§ 3.71](#) and [3.73](#) of this title.

(d) Even if the whole or a part interest in the invention or in the patent to be issued is assigned or obligated to be assigned, an oath or declaration must be executed by the actual inventor or each actual joint inventor, except as provided for in [§ 1.64](#). See [§ 1.64](#) concerning the execution of a substitute statement by an assignee, person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter.

(e) If a patent is granted on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest. Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in [§ 3.81](#). Where a real party in interest has filed an application under [§ 1.46](#), the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest.

(f) The Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette*.

[37 CFR 1.42](#) defines who is the applicant for a patent. The word “applicant” when used in title 37 refers to the inventor or all joint inventors, or to the person applying for a patent as provided in [37 CFR 1.43](#), [1.45](#), or [1.46](#). If a person is applying for a patent as provided in [37 CFR 1.46](#), the word “applicant” refers to the assignee, the person to whom the inventor is under an obligation to assign, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for the patent under [37 CFR 1.46](#) and not the inventor. If fewer than all joint inventors are applying for the patent as provided in [37 CFR 1.45](#), the phrase “the applicant” means the joint inventors who are applying for the patent without the omitted inventor(s).

[37 CFR 1.43](#) provides that if an inventor is deceased or under legal incapacity, the legal representative of the inventor may make an application for patent on behalf of the inventor. See also [MPEP § 409.01\(a\)](#).

[37 CFR 1.45](#) pertains to an application filed by joint inventors. Joint inventors must apply for a patent jointly and each joint inventor must make the inventor’s oath or declaration required by [37 CFR 1.63](#), except as provided for in [37 CFR 1.64](#). See [35 U.S.C. 116\(a\)](#) and [37 CFR 1.45\(a\)](#). If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the other

joint inventor or inventors may make the application for patent on behalf of themselves and the omitted inventor. See [35 U.S.C. 116\(b\)](#) and [37 CFR 1.45\(a\)](#). See also [MPEP § 409.02](#).

[37 CFR 1.46](#) provides for the filing of an application for patent by an assignee, a person to whom the inventor is under an obligation to assign the invention, or a person who otherwise shows sufficient proprietary interest in the matter under [35 U.S.C. 118](#). If an application under [35 U.S.C. 111](#) is made by a person other than the inventor under [37 CFR 1.46\(a\)](#), the application must contain an application data sheet under [37 CFR 1.76](#) specifying in the applicant information section the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter. While identifying the party making the application for patent (the applicant) in an application data sheet is not a filing date requirement, a delay in naming the applicant under [37 CFR 1.46](#) may cause it to appear that applicant is the inventor and thus requiring the party to file a request under [37 CFR 1.46\(c\)](#) to become the applicant, which requires compliance with [37 CFR 3.71](#) and [3.73](#). See [MPEP § 325](#). If an assignee is filing an application under [37 CFR 1.46](#), but the assignee is not the assignee of the entire right, title and interest in the application, then the assignee would need to be named as the applicant under [37 CFR 1.46](#) together with the other party who has an ownership interest. For example, if there are two joint inventors, and one inventor has assigned his rights in the invention to the assignee, but the other inventor has not assigned his rights in the invention and is under no obligation to assign his rights, the assignee and the other inventor should be identified as the applicant in the applicant information section of the application data sheet. See [37 CFR 3.71](#). Under the example provided, the assignee would have an undivided interest in the entirety of the one inventor's interest but would not be the owner of the entire right, title and interest in the invention. Because of this, the assignee cannot be named as the sole applicant in the application. All parties having any portion of the ownership in the patent must act together as a composite entity in patent matters before the Office. See [MPEP § 301](#).

If the applicant is the assignee or person to whom the inventor is under an obligation to assign the invention, the documentary evidence of ownership (e.g., assignment for an assignee, employment agreement for an obligated assignee) should be recorded as provided for in 37 CFR part 3 no later than the date the issue fee is paid. See [37 CFR 1.46\(b\)\(1\)](#).

If the applicant is a person who otherwise shows sufficient proprietary interest in the matter, such applicant must submit a petition including: (1) the fee set forth in [37 CFR 1.17\(g\)](#); (2) a showing that such person has sufficient proprietary interest in the matter; and (3) a statement that making the application for patent by a person who otherwise shows sufficient proprietary interest on behalf of and as agent for the inventor is appropriate to preserve the rights of the parties. See [37 CFR 1.46\(b\)\(2\)](#). A discussion of the evidence necessary for a showing that a person has sufficient proprietary interest in the matter is set forth in [MPEP § 409.05](#). The Office may publish notice of the filing of the application by a person who otherwise shows sufficient proprietary interest in the *Official Gazette*. See [37 CFR 1.46\(f\)](#).

Any request to correct or update the name of the applicant after an applicant has been specified under [37 CFR 1.46\(b\)](#) must include an application data sheet under [37 CFR 1.76](#) specifying the correct or updated name of the applicant in the applicant information section. See [37 CFR 1.46\(c\)\(1\)](#). Thus, if there is no change in the applicant itself but just the applicant's name (due to a correction or name change), the applicant need only submit an application data sheet specifying the correct or updated name of the applicant in the applicant information section. Any corrected application data sheet must identify the information being changed with underlining for insertions and strike-through or brackets for text removed as required by [37 CFR 1.76\(c\)\(2\)](#). A change in the name of the applicant recorded pursuant to Hague Agreement Article 16(1)(ii) will be effective to change the name of the applicant in a nonprovisional international design application.

## II. CHANGE OF APPLICANT

Where no applicant is identified, the Office will, by default, consider the inventor to be the applicant (e.g., to complete processing of the application so that it can be forwarded for examination). Any request to change the applicant must include an application data sheet under [37 CFR 1.76](#) specifying the applicant in the applicant information section in accordance with [37 CFR 1.76\(c\)\(2\)](#) and must comply with [37 CFR 3.71](#) and [3.73](#). See [37 CFR 1.46\(c\)\(2\)](#). Thus, if there is a change of applicant under [37 CFR 1.46](#) (e.g., from the inventor to the assignee, or from one assignee to another assignee), the new applicant must establish its ownership of the application under [37 CFR 3.71\(b\)](#) and [3.73](#).

[37 CFR 1.46\(e\)](#) provides that if a patent is granted on an application filed under [37 CFR 1.46](#) by a person other than the inventor, the patent shall be granted to the real party in interest (e.g., the current assignee for an application that has been assigned). Otherwise, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in [37 CFR 3.81](#).

Where a real party in interest has filed an application under [37 CFR 1.46](#), the applicant shall notify the Office of any change in the real party in interest no later than payment of the issue fee. The Office will treat the absence of such a notice as an indication that there has been no change in the real party in interest. See [35 U.S.C. 118](#) and [37 CFR 1.46\(e\)](#). The use of box 3 of the Part B – Fee(s) Transmittal form, PTOL-85B will be required where the real party in interest has changed from filing of the application and the application was filed pursuant to [37 CFR 1.46](#). Identification of the real party in interest in box 3 of PTOL-85B will not change the applicant of record in the application. For example, where the application was filed pursuant to [37 CFR 1.46](#) and identified Assignee X as the applicant, but the ownership subsequently changed and box 3 of PTOL-85B identified Assignee Y as the real party in interest, the issued patent would identify Assignee X as the applicant and Assignee Y as the assignee. Assignee Y would only be identified as the applicant if a proper request to change the applicant is filed pursuant to [37 CFR 1.46](#) no later than payment of the issue fee. Furthermore, a request to change the

applicant under [37 CFR 1.46\(c\)\(2\)](#) should not be filed after the patent has issued because such a request cannot be granted.

## III. CORRECTION OR UPDATE OF 37 CFR 1.46 APPLICANT

For correction of an inventor's name, see [37 CFR 1.48](#) and [MPEP § 602.01\(c\)\(2\)](#).

If a minor typographical error in a [37 CFR 1.46](#) applicant's name is detected prior to payment of the issue fee, a request to correct the applicant's name under [37 CFR 1.46\(c\)\(1\)](#) should be filed promptly and must be filed no later than payment of the issue fee. The request, which can essentially be a signed transmittal letter, must be filed with an application data sheet under [37 CFR 1.76](#) specifying the correct name of the applicant in the applicant information section ([37 CFR 1.76\(b\)\(7\)](#)) and must be shown with appropriate markings (underlining for additions, strikethrough for deletions). The request should be clear that the request is being filed under [37 CFR 1.46\(c\)\(1\)](#) rather than [37 CFR 1.46\(c\)\(2\)](#). Neither a fee nor a statement under [37 CFR 3.73\(c\)](#) is required.

If the minor typographical error in the applicant's name is not detected until after the payment of the issue fee, the application must be withdrawn from issue or a certificate of correction must be filed, as further described below, because amendments are not permitted after the payment of the issue fee. If the application is withdrawn from issue under [37 CFR 1.313\(c\)\(2\)](#), the request under [37 CFR 1.46\(c\)\(1\)](#) to correct the applicant's name must be submitted with a request for continued examination (RCE) under [37 CFR 1.114](#) if the application is a utility or plant application. In the case of a design application, the petition to withdraw from issue under [37 CFR 1.313\(c\)\(3\)](#) and request under [37 CFR 1.46\(c\)\(1\)](#) should be accompanied by a continued prosecution application (CPA) under [37 CFR 1.53\(d\)](#). If a certificate of correction is filed, a petition under [37 CFR 1.182](#) must be filed with the certificate of correction after the patent issues requesting correction of the applicant's name.

If a [37 CFR 1.46](#) applicant's name changes (e.g., XYZ, LLC changes its name to XYZ, Inc.), a request to update the name of the applicant under [37 CFR](#)

[1.46\(c\)\(1\)](#) should be filed promptly and must be filed no later than payment of the issue fee. The request, which can essentially be a signed transmittal letter, must be filed with an application data sheet under [37 CFR 1.76](#) specifying the correct name of the applicant in the applicant information section ([37 CFR 1.76\(b\)\(7\)](#)) and must be shown with appropriate markings (underlining for additions, strikethrough for deletions). The request should be clear that the request is being filed under [37 CFR 1.46\(c\)\(1\)](#) rather than [37 CFR 1.46\(c\)\(2\)](#). Neither a fee nor a statement under [37 CFR 3.73\(c\)](#) is required, however, applicant may submit a statement under [37 CFR 3.73\(c\)](#) that includes a reference to the name change document, if desired.

[37 CFR 1.46\(c\)\(1\)](#) does not provide for deletion of a party who was incorrectly named as the applicant (e.g., Company X was identified in the applicant information section of the application data sheet, but the named inventors neither assigned nor were under an obligation to assign to Company X, and Company X is not a sufficient proprietary interest party). In such a situation, a petition under [37 CFR 1.182](#), including the petition fee under [37 CFR 1.17\(f\)](#), may be filed and accompanied by an application data sheet under [37 CFR 1.76](#) specifying the correct name of the applicant in the applicant information section ([37 CFR 1.76\(b\)\(7\)](#)) in accordance with [37 CFR 1.76\(c\)\(2\)](#). The petition should provide an adequate explanation regarding the identification of a party as the applicant who was not the actual applicant.





### 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.

## 605.02 Applicant for Application Filed Before September 16, 2012 [R-07.2015]

[Editor Note: See [MPEP § 605.01](#) for information regarding the applicant in applications filed on or after September 16, 2012.]

### 37 CFR 1.41 (pre-AIA) Applicant for patent.

(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by [§ 1.63](#), except as provided for in [§§ 1.53\(d\)\(4\)](#) and [1.63\(d\)](#). If an oath or declaration as prescribed by [§ 1.63](#) is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to [§ 1.53\(b\)](#), unless applicant files a paper, including the processing fee set forth in [§ 1.17\(i\)](#), supplying or changing the name or names of the inventor or inventors.

(2) The inventorship of a provisional application is that inventorship set forth in the cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#). If a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#) is not filed during the pendency of a provisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to [§ 1.53\(c\)](#), unless applicant files a paper including the processing fee set forth in [§ 1.17\(q\)](#), supplying or changing the name or names of the inventor or inventors.

(3) In a nonprovisional application filed without an oath or declaration as prescribed by [§ 1.63](#) or a provisional application filed without a cover sheet as prescribed by [§ 1.51\(c\)\(1\)](#), the name, residence, and citizenship of each person believed to be an actual inventor should be provided when the application papers pursuant to [§ 1.53\(b\)](#) or [§ 1.53\(c\)](#) are filed.

(4) The inventorship of an international application entering the national stage under [35 U.S.C. 371](#) is that inventorship set forth in the international application, which includes any change effected under [PCT Rule 92bis](#). See [§ 1.497\(d\) and \(f\)](#) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under [PCT Rule 92bis](#) subsequent to the execution of any declaration filed under [PCT Rule 4.17\(iv\)](#) ([§ 1.48\(f\)\(1\)](#)) does not apply to an international application entering the national stage under [35 U.S.C. 371](#)).

(b) Unless the contrary is indicated the word “applicant” when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in [§§ 1.42, 1.43](#) or [1.47](#) who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office on behalf of the inventor or inventors, but an oath or declaration for the application ([§ 1.63](#)) can only be made in accordance with [§ 1.64](#).

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

### 37 CFR 1.45 (pre-AIA) Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in [§ 1.47](#).

(b) Inventors may apply for a patent jointly even though

(1) They did not physically work together or at the same time,

(2) Each inventor did not make the same type or amount of contribution, or

(3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under [35 U.S.C. 116](#). If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under [35 U.S.C. 116](#).

[Pre-AIA 37 CFR 1.41\(a\)](#) defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of [pre-AIA 37 CFR 1.63](#), except as provided for in [37 CFR 1.53\(d\)\(4\)](#) and [pre-AIA 37 CFR 1.63\(d\)](#). The oath or declaration may be filed on the filing date of the application or on a later date. If an oath or declaration is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to [37 CFR 1.53\(b\)](#), unless an applicant files a paper under [pre-AIA 37 CFR 1.41\(a\)\(1\)](#) accompanied by the processing fee set forth in [37 CFR 1.17\(i\)](#) supplying or changing the name or names of the inventor or inventors.

For correction of inventorship, see [MPEP § 602.01\(c\) et seq.](#)

For applications filed before September 16, 2012, if the application is filed by another, see [MPEP § 409.03 et seq.](#)

For assignments of application by inventor, see [MPEP § 301](#).

For applications filed before September 16, 2012 by another on behalf of a deceased or legally incapacitated inventor, see [MPEP § 409.01\(b\)](#). For

applications filed before September 16, 2012 where at least one inventor is unavailable, see [MPEP § 409.03](#) *et seq.*

## 606 Title of Invention [R-10.2019]

### 37 CFR 1.72 Title and abstract.

(a) The title of the invention may not exceed 500 characters in length and must be as short and specific as possible. Characters that cannot be captured and recorded in the Office's automated information systems may not be reflected in the Office's records in such systems or in documents created by the Office. Unless the title is supplied in an application data sheet ([§ 1.76](#)), the title of the invention should appear as a heading on the first page of the specification.

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The title of the invention should be placed at the top of the first page of the specification unless it is provided in the application data sheet (see [37 CFR 1.76](#)). The title should be brief but technically accurate and descriptive and should contain fewer than 500 characters.

The words listed below are not considered as part of the title of an invention, these words should not be included at the beginning of the title of the invention and will be deleted when the Office enters the title into the Office's computer records, and when any patent issues. The term "new" will not be deleted when it is a part of a proper name, such as "New York". Similarly, the term "design" will not be deleted when it is a part of a term, such as "Design-aiding apparatus...".

A

An

The

Improved

Improvement(s) in/for/of

New

Novel

Related to

Design

Design for/of (a)

Ornamental design

Ornamental

## 606.01 Examiner May Require Change in Title [R-01.2024]

Where the title is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. Form paragraphs 6.11 and 6.11.01 may be used.

### ¶ 6.11 Title of Invention Is Not Descriptive

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### Examiner Note:

If a change in the title of the invention is being suggested by the examiner, follow with form paragraph 6.11.01.

### ¶ 6.11.01 Title of Invention, Suggested Change

The following title is suggested: "[1]"

This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the examiner may, at the time of allowance, change the title by an examiner's amendment. See [MPEP § 1302.04](#). When the Technology Center (TC) technical support staff prepares the application for issue and sees that the title has been changed, the TC technical support staff will make the required change in the Office computer record systems.

## 607 Filing Fee [R-01.2024]

Patent application filing fees are set in accordance with [35 U.S.C. 41](#) and the Fee Setting Authority set forth in section 10 of Public Law 112-29, September 16, 2011 (the Leahy-Smith America Invents Act), as amended by Public Law 117-328, December 29, 2022 (Unleashing American Innovators Act). The fee amounts are available from the USPTO's website at [www.uspto.gov/Fees](http://www.uspto.gov/Fees).

### I. BASIC FILING, SEARCH, AND EXAMINATION FEES

For nonprovisional applications filed under [35 U.S.C. 111\(a\)](#) on or after December 8, 2004 (including reissue applications), the following fees

are required: basic filing fee as set forth in [37 CFR 1.16\(a\), \(b\), \(c\) or \(e\)](#); search fee as set forth in [37 CFR 1.16\(k\), \(l\), \(m\), or \(n\)](#); examination fee as set forth in [37 CFR 1.16\(o\), \(p\), \(q\), or \(r\)](#); application size fee as set forth in [37 CFR 1.16\(s\)](#), if applicable (see subsection II. below); excess claims fees as set forth in [37 CFR 1.16\(h\), \(i\), or \(j\)](#), if applicable (see subsection III. below); and non-electronic filing fee as set forth in [37 CFR 1.16\(t\)](#), if applicable (see subsection IV. below).

The basic filing, search and examination fees are due on filing of the nonprovisional application under [35 U.S.C. 111\(a\)](#). These fees may be paid on a date later than the filing date of the application provided they are paid within the time period set forth in [37 CFR 1.53\(f\)](#) and include the surcharge set forth in [37 CFR 1.16\(f\)](#).

For provisional applications filed under [35 U.S.C. 111\(b\)](#), the basic filing fee set forth in [37 CFR 1.16\(d\)](#) is required. The basic filing fee is due on filing of the provisional application, but may be paid later, if paid within the time period set forth in [37 CFR 1.53\(g\)](#) and accompanied by payment of a surcharge as set forth in [37 CFR 1.16\(g\)](#).

For international applications entering the national stage under [35 U.S.C. 371](#), see [37 CFR 1.492](#) for the required fees. See also [MPEP § 1893.01\(c\)](#). For international design applications under [35 U.S.C. 385](#), see [37 CFR 1.1031](#) for the required fees.

See also [MPEP § 1415](#) for reissue application fees.

## II. APPLICATION SIZE FEE

The application size fee set forth in [37 CFR 1.16\(s\)](#) applies to any application (including any provisional applications and any reissue applications) filed under [35 U.S.C. 111](#) the specification (including claims) and drawings of which exceed 100 sheets of paper. The calculation of the application size fee required excludes any American Standard Code for Information Interchange (ASCII) plain text file or any eXtensible Markup Language XML file (as applicable) submitted on read-only optical disc or via the USPTO patent electronic filing system for any “Sequence Listing,” any computer readable form

(CRF) of a “Sequence Listing,” any “Sequence Listing XML,” or a “Computer Program Listing Appendix.” See [37 CFR 1.52\(f\)](#). The application size fee applies for each additional 50 sheets or fraction thereof over 100 sheets of paper. A preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. See [MPEP § 714.01\(e\)](#), subsection II. Thus, the Office will count the pages of a preliminary amendment present on the filing date of the application, including multiple sets of drawings or multiple sets of a specification, e.g., clean and marked-up versions, in determining the application size fee required. Accordingly, the Office does not recommend filing a substitute specification or multiple sets of drawings with the initial filing of the application. The Office will not count the sheets of paper making up any English translation of a non-English language specification if submitted with the application on filing. However, if the originally-filed application papers did not comply with [37 CFR 1.52](#), any papers filed to comply with [37 CFR 1.52](#) (if the page count of such papers is larger than the page count of the initial submission) will be counted for the purpose of determining the application size fee due, in place of the originally-filed specification and drawings. Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with [37 CFR 1.821\(c\)](#) or [\(e\)](#) and any “Computer Program Listing Appendix” in compliance with [37 CFR 1.96\(c\)](#) submitted on a read-only optical disc under [37 CFR 1.52\(e\)](#) or submitted in an ASCII plain text file via the USPTO patent electronic filing system will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#). Any “Sequence Listing XML” on a read-only optical disc or submitted via the USPTO patent electronic filing system in compliance with [37 CFR 1.831\(a\)](#) will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#). See [37 CFR 1.52\(f\)\(1\)](#) and [\(2\)](#).

For purposes of determining the application size fee required by [37 CFR 1.16\(s\)](#), for an application component submitted in part on a read-only optical disc in compliance with [37 CFR 1.52\(e\)](#), excluding any ASCII plain text file or XML file (as applicable) of any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with [37 CFR 1.821\(c\)](#) or [\(e\)](#), any “Computer Program Listing Appendix” in

compliance with [37 CFR 1.96\(c\)](#), or any “Sequence Listing XML” in compliance with [37 CFR 1.831\(a\)](#), each three kilobytes of content submitted on a read-only optical disc shall be counted as a sheet of paper. See [37 CFR 1.52\(f\)\(1\)](#).

The paper size equivalent of the specification (including claims) and drawings of an application submitted via the USPTO patent electronic filing system will be considered to be seventy five percent of the number of sheets of paper present in the specification (including claims) and drawings of the application when entered into the Office file wrapper after being rendered by the USPTO patent electronic filing system for purposes of computing the application size fee required by [37 CFR 1.16\(s\)](#). Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with [37 CFR 1.821\(c\)](#) or [\(e\)](#) and any “Computer Program Listing Appendix” in compliance with [37 CFR 1.96\(c\)](#), submitted via the USPTO patent electronic filing system will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#) if the listing is submitted in ASCII plain text as part of an associated file of the application. Any “Sequence Listing XML” in compliance with [37 CFR 1.831\(a\)](#) submitted via the USPTO patent electronic filing system will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#) if the listing is submitted in XML file format as part of an associated file of the application. See [37 CFR 1.52\(f\)\(1\)](#). “Sequence Listings” or computer program listings submitted via the USPTO patent electronic filing system in Portable Document Format (PDF) as part of the specification or as Tagged Image File Format (TIFF) drawing files would not be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#).

For information on oversized submissions of a “Sequence Listing” or a “Sequence Listing XML” under [37 CFR 1.52\(f\)\(3\)](#), see [MPEP § 2422.03](#) *et seq.*

### III. EXCESS CLAIMS FEES

[37 CFR 1.16\(h\)](#) sets forth the excess claims fee for each independent claim in excess of three. [37 CFR 1.16\(i\)](#) sets forth the excess claims fee for each claim (whether independent or dependent) in excess of

twenty. The excess claims fees specified in [37 CFR 1.16\(h\) and \(i\)](#) apply to any excess claims fee paid, regardless of the filing date of the application and regardless of the date on which the claim necessitating the excess claims fee payment was added to the application.

The excess claims fees specified in [37 CFR 1.16\(h\) and \(i\)](#) also apply to all reissue applications. Under [35 U.S.C. 41\(a\)\(2\)](#), the claims in the original patent are not taken into account in determining the excess claims fee for a reissue application. The excess claims fees specified in [37 CFR 1.16\(h\) and \(i\)](#) are required for each independent claim in excess of three that is presented in a reissue application and for each claim (whether independent or dependent) in excess of twenty that is presented in a reissue application.

Fees for a proper multiple dependent claim are calculated based on the number of claims to which the multiple dependent claim refers, [37 CFR 1.75\(c\)](#), and a separate fee is required in each application containing a proper multiple dependent claim. See [37 CFR 1.16\(j\)](#). For an improper multiple dependent claim, the fee charged is that charged for a single dependent claim. See [MPEP § 608.01\(n\)](#) for multiple dependent claims.

For nonprovisional applications filed under [35 U.S.C. 111\(a\)](#) without claims, if more than three independent claims, more than twenty total claims, or a multiple dependent claim, are presented in the application, the excess claims fee as set forth in [37 CFR 1.16\(h\), \(i\), and/or \(j\)](#) is due when the excess claims are presented in the application.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required.

Amendments before the first action, or not filed in reply to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive



thereto and the practice set forth in [MPEP § 714.03](#) will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim or adds to the number of claims referred to in a multiple dependent claim, and the replacement of a claim by a claim of the same type, unless it is a multiple dependent claim which refers to more prior claims, do not require any additional fees.

For purposes of determining the fee due the U.S. Patent and Trademark Office, a claim will be treated as dependent if it contains reference to one or more other claims in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact, is not a proper dependent claim, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, nonelected claims that are withdrawn from consideration will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

An amendment canceling claims accompanying the papers constituting the application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a response to a Notice To File Missing Parts of Application that required the fees set forth in [37 CFR 1.16](#), which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate fees due in response to the Notice To

File Missing Parts of Application. No refund will be made for claims being canceled in the response that have already been paid for.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment. However, unentered claims will not be counted when calculating the fee due in subsequent amendments.

Amendments affecting the claims cannot serve as the basis for granting any refund. See [MPEP § 607.02](#) subsection V for refund of excess claims fees.

Excess claims fees set forth in [37 CFR 1.20\(c\)\(3\)](#) and [\(c\)\(4\)](#) apply to excess claims that are presented during a reexamination proceeding.

#### IV. NON-ELECTRONIC FILING FEE

Section 10(h) of Public Law 112-29, September 16, 2011 (the Leahy-Smith America Invents Act) provided that an additional fee be established for each application for an original (i.e., non-reissue) patent, except for a design, plant, or provisional application, not filed by electronic means. See [37 CFR 1.16\(t\)](#) for the non-electronic fee applicable to applications under [35 U.S.C. 111\(a\)](#) filed on or after November 15, 2011 other than by the USPTO patent electronic filing system. See [37 CFR 1.445\(a\)\(1\)\(ii\)](#) for the non-electronic filing fee portion of the transmittal fee due in an international application filed with the USPTO as receiving Office on or after November 15, 2011.

For any application filed on or after January 17, 2024 under [35 U.S.C. 111](#) for an original patent, except design, plant or provisional applications, when the application is filed non-electronically, the fee for not conforming to the USPTO requirements for submission in DOCX format is also applicable. See [37 CFR 1.16\(u\)](#).

## V. APPLICANT DOES NOT SPECIFY FEES TO WHICH PAYMENT IS TO BE APPLIED

In situations in which a payment submitted for the fees due on filing in a nonprovisional application filed under [35 U.S.C. 111\(a\)](#) is insufficient and the applicant has not specified the fees to which the payment is to be applied, the Office will apply the payment in the following order until the payment is expended:

- (1) the basic filing fee ([37 CFR 1.16\(a\), \(b\), \(c\), or \(e\)](#));
- (2) the non-electronic filing fee ([37 CFR 1.16\(t\)](#));
- (3) the non-DOCX fee ([37 CFR 1.16\(u\)](#));
- (4) the application size fee ([37 CFR 1.16\(s\)](#));
- (5) the late filing surcharge ([37 CFR 1.16\(f\)](#));
- (6) the processing fee for an application filed in a language other than English ([37 CFR 1.17\(i\)](#));
- (7) the search fee ([37 CFR 1.16\(k\), \(l\), \(m\), or \(n\)](#));
- (8) the examination fee ([37 CFR 1.16\(o\), \(p\), \(q\), or \(r\)](#)); and
- (9) the excess claims fee ([37 CFR 1.16\(h\), \(i\), and \(j\)](#)).

In situations in which a payment submitted for the fees due on filing in a provisional application filed under [35 U.S.C. 111\(b\)](#) is insufficient and the applicant has not specified the fees to which the payment is to be applied, the Office will apply the payment in the following order until the payment is expended:

- (1) the basic filing fee ([37 CFR 1.16\(d\)](#));
- (2) the application size fee ([37 CFR 1.16\(s\)](#)); and
- (3) the late filing surcharge ([37 CFR 1.16\(g\)](#)).

See also [MPEP § 509](#).

Since the basic filing fee, search fee, and examination fee under the patent fee structure are often referred to as the “filing fee,” the Office will treat a deposit account authorization to charge “the filing fee” as an authorization to charge the applicable fees under [37 CFR 1.16](#) (the basic filing

fee, search fee, examination fee, any excess claims fee, and any application size fee) to the deposit account. The Office will also treat a deposit account authorization to charge “the basic filing fee” as an authorization to charge the applicable basic filing fee, search fee, and examination fee to the deposit account. Any deposit account authorization to charge the filing fee but not the search fee or examination fee must specifically limit the authorization by reference to one or more of paragraphs (a) through (e) of [37 CFR 1.16](#). See [MPEP § 509.01](#).

### 607.01 [Reserved]

### 607.02 Returnability of Fees [R-07.2022]

#### 35 U.S.C. 42 Patent and Trademark Office funding

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(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

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#### *37 CFR 1.26 Refunds.*

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts. If a party paying a fee or requesting a refund does not provide the banking information necessary for making refunds by electronic funds transfer (31 U.S.C. 3332 and 31 CFR part 208), or instruct the Office that refunds are to be credited to a deposit account, the Director may require such information, or use the banking information on the payment instrument to make a refund. Any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged.

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in [§ 1.28\(a\)](#). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization ([§ 1.25\(b\)](#)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

(c) If the Director decides not to institute a reexamination proceeding in response to a request for reexamination or supplemental examination, fees paid with the request for reexamination or supplemental examination will be refunded or returned in accordance with paragraphs (c)(1) through (c)(3) of this section. The reexamination requester or the patent owner who requested a supplemental examination proceeding, as

appropriate, should indicate the form in which any refund should be made (e.g., by check, electronic funds transfer, credit to a deposit account). Generally, refunds will be issued in the form that the original payment was provided.

(1) For an *ex parte* reexamination request, the *ex parte* reexamination filing fee paid by the reexamination requester, less the fee set forth in [§ 1.20\(c\)\(7\)](#), will be refunded to the requester if the Director decides not to institute an *ex parte* reexamination proceeding.

(2) For an inter partes reexamination request, a refund of \$7,970 will be made to the reexamination requester if the Director decides not to institute an inter partes reexamination proceeding.

(3) For a supplemental examination request, the fee for reexamination ordered as a result of supplemental examination, as set forth in [§ 1.20\(k\)\(2\)](#), will be returned to the patent owner who requested the supplemental examination proceeding if the Director decides not to institute a reexamination proceeding.

Under [35 U.S.C. 42\(d\)](#) and [37 CFR 1.26](#), the Office may refund: (1) a fee paid by mistake (e.g., fee paid when no fee is required); or (2) any fee paid in excess of the amount of fee that is required. See *Ex parte Grady*, 59 USPQ 276, 277 (Comm'r Pat. 1943) (the statutory authorization for the refund of fees under the “by mistake” clause is applicable only to a mistake relating to the fee payment).

When an applicant or patentee takes an action “by mistake” (e.g., files an application or maintains a patent in force “by mistake”), the submission of fees required to take that action (e.g., a filing fee submitted with such application or a maintenance fee submitted for such patent) is not a “fee paid by mistake” within the meaning of [35 U.S.C. 42\(d\)](#).

[37 CFR 1.26\(a\)](#) also provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee.

All questions pertaining to the return of fees are referred to the Refunds Section of the Receipts Division of the Office of Finance. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases. Such questions may also be treated, to the extent appropriate, in decisions on petition decided by various U.S. Patent and Trademark Office officials.

## I. MANNER OF MAKING A REFUND

[37 CFR 1.26\(a\)](#) authorizes the Office to obtain the banking information necessary for making refunds by electronic funds transfer, or obtain the deposit account information to make the refund to the deposit account. If a party paying a fee or requesting a refund does not instruct the refund to be credited to a deposit account, the Office will attempt to make the refund by electronic fund transfer. The Office may (1) use the banking information on a payment instrument (e.g., a personal check) to refund an amount paid by the payment instrument in excess of that required, or (2) in other situations, require the banking information necessary for electronic funds transfer or require instructions to credit a deposit account. If it is not cost effective to require the banking information, the Office may obtain the deposit account information or simply issue any refund by treasury check.

[37 CFR 1.26\(a\)](#) further provides that any refund of a fee paid by credit card will be by a credit to the credit card account to which the fee was charged. The Office will not refund a fee paid by credit card by treasury check, electronic funds transfer, or credit to a deposit account.

## II. TIME PERIOD FOR REQUESTING A REFUND

Any request for a refund which is not based upon subsequent entitlement to small entity status (see [37 CFR 1.28\(a\)](#)) must be filed within the two-year nonextendable time limit set forth in [37 CFR 1.26\(b\)](#).

## III. FEES PAID BY DEPOSIT ACCOUNT

The Office treats authorizations to charge a deposit account as being received by the Office on the date of receipt as defined in [37 CFR 1.6](#) for purposes of refund payments under [37 CFR 1.26](#) and [37 CFR 1.28](#). Payment by authorization to charge a deposit account is treated for refund purposes the same as payments by other means (e.g., check or credit card charge authorization). Accordingly, the time period for requesting a refund of any fee paid by a deposit account begins on the date the charge authorization is received in the Office. For refund purposes: where a [37 CFR 1.8](#) certificate is used, the refund period will begin on the date of actual receipt (not the [37](#)

[CFR 1.8](#) date of mailing); where Priority Mail Express® under [37 CFR 1.10](#) is used, the “date accepted” on the Priority Mail Express® label will control (not the actual date of receipt by the Office). The use of payment receipt date for refund purposes has no effect on the certificate of mailing practice under [37 CFR 1.8](#) for making a timely reply to an Office action.

Notwithstanding the foregoing, if the Office charges a deposit account by an amount other than an amount specifically indicated on the charge authorization, any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and must include a copy of that deposit account statement. This provision of [37 CFR 1.26\(b\)](#) applies, for example, in the following types of situations: (1) a deposit account charged for an extension of time pursuant to [37 CFR 1.136\(a\)\(3\)](#) as a result of there being a prior general authorization in the application; or (2) a deposit account charged for the outstanding balance of a fee as a result of an insufficient fee submitted with an authorization to charge the deposit account for any additional fees that are due. In these situations, the party providing the charge authorization is not in a position to know the exact amount by which the deposit account will be charged until the date of the deposit account statement indicating the amount of the charge. Therefore, the two-year time period set forth in [37 CFR 1.26\(b\)](#) does not begin until the date of the deposit account statement indicating the amount of the charge.

#### **IV. LATER ESTABLISHMENT OF SMALL ENTITY STATUS**

Effective November 7, 2000, [37 CFR 1.28\(a\)](#) was amended to provide a three-month period (instead of the former two-month period) for requesting a refund based on later establishment of small entity status. As the Office now treats the receipt date of a deposit account charge authorization as the fee payment date (for refund purposes), any request for a refund under [37 CFR 1.28\(a\)](#) must be made within three months from the date the charge authorization is received in the Office.

#### **V. REFUND OF SEARCH FEE AND EXCESS CLAIMS FEE**

The Office may refund the search fee and any excess claims fee paid in an application filed under [35 U.S.C. 111\(a\)](#) if applicant files a petition under [37 CFR 1.138\(d\)](#) to expressly abandon the application before an examination has been made of the application. See [MPEP § 711.01](#).

The basic filing fee, non-electronic filing fee, the examination fee, and the application size fee cannot be refunded unless the fee was paid by mistake or in excess of that required.

#### **608 Disclosure [R-11.2013]**

To obtain a valid patent, a patent application as filed must contain a full and clear disclosure of the invention in the manner prescribed by [35 U.S.C. 112\(a\)](#). The requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent. All amendments and claims must find descriptive basis in the original disclosure. No new matter may be introduced into an application after its filing date. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed. See also [37 CFR 1.121\(f\)](#) and [MPEP § 608.04](#).

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he or she should object to the use of the language as failing to comply with [37 CFR 1.3](#) which proscribes the presentation of papers which are lacking in decorum and courtesy. The inclusion of such proscribed language in a federal government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to.

An application should not be classified for publication under [35 U.S.C. 122\(b\)](#) and an examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.



For design application practice, see [MPEP § 1504](#) *et seq.*

See [MPEP § 714.25](#) for information pertaining to amendments and other papers presented in violation of [37 CFR 1.3](#).

## 608.01 Specification [R-01.2024]

### 35 U.S.C. 22 Printing of papers filed.

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten, or on an electronic medium.

#### *37 CFR 1.71 Detailed description and specification of the invention.*

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see [§ 1.84\(s\)](#). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe”(17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner

has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract, and "Sequence Listing" (if required or submitted under [§ 1.821\(c\)](#)) should not be included on a sheet including any other part of the application.

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in [§ 1.9\(e\)](#).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth [§ 1.17\(i\)](#) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in [§ 1.491](#) in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under [§ 1.114](#).

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under [35 U.S.C. 255](#) and [§ 1.323](#) for the amendment to be effective.

The specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention pertains to make and use the same. See [35 U.S.C. 112](#) and [37 CFR 1.71](#). If a newly filed application obviously fails to disclose an invention with the clarity required by [35 U.S.C. 112](#), revision of the application should be required. See [MPEP § 702.01](#). The written description must not include information that is not related to applicant's invention, e.g., prospective disclaimers regarding comments made by examiners. If such information is included in the written description, the examiner will object to the specification and require applicant to take appropriate action, e.g., cancel the



information. The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and "Sequence Listing" (if required or submitted under [37 CFR 1.821\(c\)](#) on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) or as a PDF image file via the USPTO patent electronic filing system ([37 CFR 1.821\(c\)\(2\)](#)) should not be included on a sheet including any other part of the application ([37 CFR 1.71\(f\)](#)). That is, the claim(s), abstract and "Sequence Listing" (if required or submitted under [37 CFR 1.821\(c\)](#) on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) or as a PDF image file via the USPTO patent electronic filing system ([37 CFR 1.821\(c\)\(2\)](#)) should each begin on a new page since each of these sections (specification, abstract, claims, "Sequence Listing") of the disclosure are separately indexed in the Image File Wrapper (IFW). There should be no overlap on a single page of more than one section of the disclosure.

The specification does not require a date.

Certain cross references to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be canceled. U.S. applications identified only by the attorney's docket number may be amended to properly identify the earlier application(s). See [37 CFR 1.78](#).

As the specification is never returned to applicant under any circumstances, the applicant should retain an accurate copy thereof. In amending the specification, the attorney or the applicant must comply with [37 CFR 1.121](#) (see [MPEP § 714](#)).

Examiners should not object to the specification and/or claims in patent applications merely because applicants are using British English spellings (e.g., colour) rather than American English spellings. It is not necessary to replace the British English spellings with the equivalent American English spellings in the U.S. patent applications. Note that [37 CFR 1.52\(b\)\(1\)\(ii\)](#) only requires the application to be in the English language. There is no additional requirement that the English must be American English.

Form paragraph 7.29 may be used where the disclosure contains minor informalities.

#### ¶ 7.29 Disclosure Objected to, Minor Informalities

The disclosure is objected to because of the following informalities: [1]. Appropriate correction is required.

#### Examiner Note:

Use this paragraph to point out minor informalities such as spelling errors, inconsistent terminology (see the requirement of [37 CFR 1.71\(a\)](#) for "full, clear, concise, and exact terms"), numbering of elements (see [37 CFR 1.74](#)), etc., which should be corrected. See form paragraphs 6.28 to 6.31 for specific informalities.

Form paragraphs 6.29-6.31 should be used where appropriate.

#### ¶ 6.29 Specification, Spacing of Lines

The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1 1/2 or double spaced (see [37 CFR 1.52\(b\)\(2\)](#)) on good quality paper are required.

#### ¶ 6.30 Numerous Errors in Specification

[35 U.S.C. 112\(a\)](#) or [35 U.S.C. 112](#) (pre-AIA), first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with [35 U.S.C. 112\(a\)](#) or [35 U.S.C. 112 \(pre-AIA\)](#). Examples of some unclear, inexact or verbose terms used in the specification are: [1].

#### ¶ 6.31 Lengthy Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

## I. PAPER REQUIREMENTS

### *37 CFR 1.52 Language, paper, writing, margins, read-only optical disc specifications.*

(a) *Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application, or a reexamination or supplemental examination proceeding.*

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination or supplemental examination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See [§ 1.58](#) for chemical and mathematical formulae and tables, and [§ 1.84](#) for drawings.

(5) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the USPTO patent electronic filing system requirements.

(b) *The application (specification, including the claims, drawings, and the inventor's oath or declaration) or reexamination or supplemental examination proceeding, any amendments to the application or reexamination proceeding, or any corrections to the application, or reexamination or supplemental examination proceeding.*

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in [§ 1.69](#) and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination or supplemental examination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in [§§ 1.821](#) through [1.825](#), must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (*e.g.*, a font size of 6); and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate physical sheet or electronic page ([§ 1.75\(h\)](#)).

(4) The abstract must commence on a separate physical sheet or electronic page or be submitted as the first page of the patent in a reissue application or reexamination or supplemental examination proceeding ([§ 1.72\(b\)](#)).

(5) Other than in a reissue application or reexamination or supplemental examination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably below, the text.

(6) Other than in a reissue application or reexamination or supplemental examination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (*e.g.*, [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (*e.g.*, tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(c) Interlineation, erasure, cancellation, or other alteration of the application papers may be made before or after the signing of the inventor's oath or declaration referring to those application papers, provided that the statements in the inventor's oath or declaration pursuant to [§ 1.63](#) remain applicable to those application papers. A substitute specification ([§ 1.125](#)) may be required if the application papers do not comply with paragraphs (a) and (b) of this section.

(d) A nonprovisional or provisional application under [35 U.S.C. 111](#) may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application under [35 U.S.C. 111\(a\)](#) is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in [§ 1.17\(i\)](#) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application under [35 U.S.C. 111\(b\)](#) is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See [§ 1.78\(a\)](#) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

(e) *Electronic documents submitted on a read-only optical disc that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application, reexamination, or supplemental examination proceeding.*

(1) The following documents may be submitted to the Office on a read-only optical disc in compliance with this paragraph (e):

(i) A “Computer Program Listing Appendix” (see [§ 1.96\(c\)](#));

(ii) A “Sequence Listing” (submitted under [§ 1.821\(c\)](#) in compliance with §§ [1.822](#) through [1.824](#)) or a “Sequence Listing XML” (submitted under [§ 1.831\(a\)](#) in compliance with §§ [1.832](#) through [1.834](#)); or

(iii) “Large Tables” (see [§ 1.58\(c\)](#)).

(2) Read-only optical disc as used in this part means a finalized disc, in conformance with International Organization for Standardization (ISO) 9660, on which the data is recorded so it is permanent and cannot be changed or erased, and is one of:

(i) Compact Disc-Read-Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R); or

(ii) Digital Video Disc-Recordable (DVD-R or DVD+R);

(3) Each read-only optical disc must conform to the following requirements:

(i) Computer compatibility: PC or Mac<sup>®</sup>;

(ii) Operating system compatibility: MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, MacOS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>;

(iii) The contents of each read-only optical disc must be in American Standard Code for Information Interchange (ASCII) plain text and if compressed, must be compressed in accordance with [§ 1.58](#) for “Large Tables,” with [§ 1.96](#) for a “Computer Program Listing Appendix,” or [§ 1.824](#) for a “Sequence Listing” or Computer Readable Form (CRF) of the “Sequence Listing,” as applicable; and

(iv) The contents of each read-only optical disc for a “Sequence Listing XML” must be in eXtensible Markup Language (XML) file format, and if compressed, must be compressed in accordance with [§ 1.834](#).

(4) Each read-only optical disc must be enclosed in a hard case within an unsealed, padded, and protective mailing envelope, and must be accompanied by a transmittal letter in accordance with paragraph (a) of this section, including the following information:

(i) First-named inventor (if known);

(ii) Title of the invention;

(iii) Attorney docket or file reference number (if applicable);

(iv) Application number and filing date (if known);

(v) The operating system (MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>) used to produce the disc; and

(vi) The file(s) contained on the read-only optical disc, including the name of the file, the size of the file in bytes, and the date of creation.

(5) Each read-only optical disc must have a label permanently affixed thereto on which the following information has been hand-printed or typed:

(i) First-named inventor (if known);

(ii) Title of the invention;

(iii) Attorney docket or file reference number (if applicable);

(iv) Application number and filing date (if known);

(v) Date on which the data were recorded on the read-only optical disc; and

(vi) Disc order (*e.g.*, “1 of X”), if multiple read-only optical discs are submitted.

(6) Read-only optical discs will not be returned to the applicant and may not be retained as part of the patent application file.

(7) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with [§ 1.58\(g\)](#) for “Large Tables,” [§ 1.96\(c\)\(5\)](#) for a “Computer Program Listing Appendix,” [§ 1.825\(b\)](#) for a “Sequence Listing” or CRF of a “Sequence Listing,” and [§ 1.835\(b\)](#) for a “Sequence Listing XML.”

(8) The specification must contain an incorporation by reference of the material on each read-only optical disc in a separate paragraph ([§ 1.77\(b\)\(5\)](#)), identifying the name of each file, their date of creation, and their size in bytes, except for an international application in the international stage. The Office may require the applicant to amend the specification to include the material incorporated by reference.

(9) If a file is unreadable, it will be treated as not having been submitted, and a notice will be issued to require a compliant submission.

(f) *Determining application size fees for applications containing electronic documents submitted on a read-only optical disc or via the USPTO patent electronic filing system—*

(1) *Submission on read-only optical discs.* The application size fee required by [§ 1.16\(s\)](#) or [§ 1.492\(j\)](#), for an application component submitted in part on a read-only optical disc in compliance with paragraph (e) of this section, shall be determined such that each three kilobytes of content submitted on a read-only optical disc shall be counted as a sheet of paper. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted on a read-only optical disc under paragraph (e) of this section containing:

(i) Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with § 1.821(c) or (e), or any “Sequence Listing XML” in compliance with § 1.831(a); or

(ii) Any “Computer Program Listing Appendix” in compliance with § 1.96(c).

(2) *Submission via the USPTO patent electronic filing system.* The application size fee required by § 1.16(s) or § 1.492(j), for an application submitted in whole or in part via the USPTO patent electronic filing system, shall be determined such that the paper size equivalent will be considered to be 75% of the number of sheets of paper present in the specification and drawings for the application when entered into the Office records after being rendered by the USPTO patent electronic filing system. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted via the USPTO patent electronic filing system containing:

(i) Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with § 1.821(c)(1) or (e), or any “Sequence Listing XML” in compliance with § 1.831(a); or

(ii) Any “Computer Program Listing Appendix” in compliance with § 1.96(c).

(3) *Oversized submission.* Any submission of a “Sequence Listing” in electronic form or a “Sequence Listing XML” of 300 MB–800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in § 1.21(o)(1). Any submission of a “Sequence Listing” in electronic form or a “Sequence Listing XML” that exceeds 800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in § 1.21(o)(2).

### 37 CFR 1.58 *Chemical and mathematical formulas and tables.*

(a) The specification, including the claims, may contain chemical and mathematical formulae, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables, but the same tables should not be included in both the drawings and description portion of the specification. Claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) Chemical and mathematical formulas and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulas or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulas and tables must be chosen from a block (nonscript) type font or lettering style having capital letters that should be at least 0.422 cm (0.166 inches) high (*e.g.*, preferably Arial, Times Roman, or Courier, with a font size of 12 points), but may be no smaller than 0.21 cm (0.08 inches) high (*e.g.*, a font size of 6 points). A space at least 0.64 cm (0.25 inches) high should be provided between complex formulas and tables and the text. Chemical and mathematical formulas must be configured to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

(c) The following “Large Tables” may be submitted in electronic form in ASCII plain text via the USPTO patent

electronic filing system or on a read-only optical disc, in compliance with § 1.52(e), excluding an international application during the international stage:

(1) Any individual table that is more than 50 pages in length; or

(2) Multiple tables, if the total number of pages of all the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper, in conformance with paragraph (b) of this section.

(d) “Large Tables” submitted in electronic form in ASCII plain text must conform to the following requirements:

(1) Must maintain the spatial relationships (*e.g.*, alignment of columns and rows) of the table elements when displayed to visually preserve the relational information they convey;

(2) Must have the following compatibilities:

(i) Computer compatibility: PC or Mac<sup>®</sup>;

(ii) Operating system compatibility: MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>.

(3) Must be in ASCII plain text, where:

(i) All printable characters (including the space character) are permitted;

(ii) No nonprintable (ASCII control) characters are permitted, except ASCII Carriage Return plus ASCII Line Feed (CRLF) or Line Feed (LF) as line terminators.

(4) Must be named as \*.txt, where “\*” is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name; and

(5) Must be incorporated by reference in a separate paragraph of the specification, in accordance with § 1.77(b)(5).

(e) “Large Tables” submitted via the USPTO patent electronic filing system must not exceed 25 MB, and file compression is not permitted.

(f) “Large Tables” submitted in compliance with § 1.52(e) via read-only optical disc must meet the following requirements:

(1) The ASCII plain text file may be compressed using WinZip<sup>®</sup>, 7-Zip, or Unix<sup>®</sup>/Linux<sup>®</sup> Zip;

(2) A compressed file must not be self-extracting; and

(3) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts in accordance with the target read-only optical disc size and labeled in compliance with § 1.52(e)(5)(vi).

(g) Any amendments to “Large Tables” in electronic form in ASCII plain text format must include:

(1) A replacement ASCII plain text file, in accordance with the requirements of paragraphs (d) through (f) of this section, submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with § 1.52(e), labeled as “REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated);



(2) A request that the amendment be made by incorporation by reference of the material in the replacement ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes (*see* § [1.77\(b\)\(5\)](#));

(3) A statement that identifies the location of all deletions, replacements, or additions to the ASCII plain text file; and

(4) A statement that the replacement ASCII plain text file contains no new matter.

(h) The specification of an application with “Large Tables” as an ASCII plain text file, present on the application filing date, without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with § [1.77\(b\)\(5\)](#).

(i) Any read-only optical disc for “Large Tables” must be submitted in duplicate. The read-only optical disc and duplicate copy must be labeled “Copy 1” and “Copy 2,” respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical disc copies are not identical, the Office will use the read-only optical disc labeled “Copy 1” for further processing.

(j) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with paragraph (g) of this section, where the replacement read-only optical disc and copy must be labeled “COPY 1 REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated), and “COPY 2 REPLACEMENT MM/DD/YYYY,” respectively.

The pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. The lines of the specification, and any amendments to the specification, must be 1 1/2 or double spaced. The text must be written in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6) ([37 CFR 1.52\(b\)\(2\)\(ii\)](#)). The text may not be written solely in capital letters.

All application papers (specification, including claims, abstract, any drawings, oath or declaration, and other papers), and also papers subsequently filed, must have each page plainly written on only one side of a sheet of paper. The specification must commence on a separate sheet. Each sheet including

part of the specification may not include other parts of the application or other information. The claim(s), abstract and “Sequence Listing” (if required or submitted under [37 CFR 1.821\(c\)](#)) on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) or as a PDF image file via the USPTO patent electronic filing system ([37 CFR 1.821\(c\)\(2\)](#)) should not be included on a sheet including any other part of the application ([37 CFR 1.71\(f\)](#)). The claim or claims must commence on a separate sheet or electronic page and any sheet including a claim or portion of a claim may not contain any other parts of the application or other material ([37 CFR 1.75\(h\)](#)). The abstract must commence on a separate sheet and any sheet including an abstract or portion of an abstract may not contain any other parts of the application or other material ([37 CFR 1.72\(b\)](#)).

All application papers that are submitted on paper or by facsimile transmission which are to become a part of the permanent record of the U.S. Patent and Trademark Office must be on sheets of paper which are the same size (for example, an amendment should not have two different sizes of paper, but the specification can have one size of paper and the drawings a different size) and are either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches). See [37 CFR 1.52\(a\)\(1\)](#) and [37 CFR 1.84\(f\)](#). Each sheet, other than the drawings, must include a top margin of at least 2.0 cm. (3/4 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (3/4 inch), and a bottom margin of at least 2.0 cm. (3/4 inch). No holes should be made in the sheets as submitted.

Application papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the USPTO patent electronic filing system requirements. See [37 CFR 1.52\(a\)\(5\)](#). See also [MPEP § 502.05](#) and the Legal Framework for Patent Electronic System ([www.uspto.gov/PatentLegalFramework](http://www.uspto.gov/PatentLegalFramework)) for details regarding correspondence transmitted to the Office using the USPTO patent electronic filing system.

Applicants must make every effort to file patent applications, and papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or



a reexamination proceeding, in a form that is clear and reproducible. If the papers are not of the required quality, substitute papers of suitable quality will be required. See [37 CFR 1.125](#) for filing rewritten papers constituting a substitute specification required by the Office. See also [MPEP § 608.01\(q\)](#). All papers which are to become a part of the permanent records of the U.S. Patent and Trademark Office must be legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent in portrait orientation on flexible, strong, smooth, nonshiny, durable, and white paper. Typed, mimeographed, xeroprinted, multigraphed or nonsmearing carbon copy forms of reproduction are acceptable. So-called “Easily Erasable” paper having a special coating so that erasures can be made more easily may not provide a “permanent” copy, [37 CFR 1.52\(a\)\(1\)\(iv\)](#). Since application papers are now maintained in an Image File Wrapper, the type of paper is unlikely to be an issue so long as the Office is able to scan and reproduce the papers that were filed.

Where an application is filed with papers that do not comply with [37 CFR 1.52](#), the Office of Patent Application Processing will mail a “Notice to File Corrected Application Papers” indicating the deficiency and setting a time period within which the applicant must correct the deficiencies to avoid abandonment. The failure to submit application papers in compliance with [37 CFR 1.52](#) does not affect the grant of a filing date, and original application papers that do not comply with [37 CFR 1.52](#) will be retained in the application file as the original disclosure of the invention. The USPTO will not return papers simply because they do not comply with [37 CFR 1.52](#).

Legibility includes ability to be photocopied and scanned so that suitable reprints can be made and paper can be electronically reproduced by use of digital imaging and optical character recognition. This requires a high contrast, with black lines and a white background. Gray lines and/or a gray background sharply reduce photo reproduction quality and if present in application papers, will likely result in a notification (e.g. Notice to File Corrected Application Papers) that the papers are not in compliance with [37 CFR 1.52](#). In order to enhance readability of electronic submissions, the

USPTO strongly recommends use of a black colored font for text on a white background.

Some of the patent application papers received by the U.S. Patent and Trademark Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

#### ¶ 6.32.01 Application Papers Must Be Legible

The specification (including the abstract and claims), and any amendments for applications, except as provided for in [37 CFR 1.821](#) through [1.825](#), must have text written plainly and legibly either by a typewriter or machine printer in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm. (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6) in portrait orientation and presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition; and only a single column of text. See [37 CFR 1.52\(a\)](#) and (b).

The application papers are objected to because [I].

A legible substitute specification in compliance with [37 CFR 1.52\(a\)](#) and (b) and [1.125](#) is required.

#### Examiner Note:

1. In bracket I, identify the part of the specification that is illegible: all of the specification; or certain pages of the specification.
2. Do not use this form paragraph for reissue applications or reexamination proceedings.

## II. ALTERATION OF APPLICATION PAPERS

[37 CFR 1.52\(c\)](#) does not prohibit interlineations and other alterations of the application papers from being made after the signing of the inventor’s oath or declaration. However, it should be noted that if such interlineations or other alterations are made after the signing of the inventor’s oath or declaration, then the statements in the inventor’s oath or declaration pursuant to [37 CFR 1.63](#) must remain applicable to the application papers. Otherwise, the inventor may need to execute a new inventor’s oath or declaration. See also [MPEP § 602.08\(b\)](#).

### III. CERTIFIED COPIES OF AN APPLICATION-AS-FILED

If an application-as-filed does not meet the sheet size/margin and quality requirements of [37 CFR 1.52](#) and [1.84\(f\)](#) and [\(g\)](#), certified copies of such application may be illegible and/or ineffective as priority documents. When an applicant requests that the USPTO provide a certified copy of an application-as-filed and pays the fee set forth in [37 CFR 1.19\(b\)\(1\)](#), the USPTO will make a copy of the application-as-filed from the records in the IFW database (or the microfilm database). If papers submitted in the application-as-filed are not legible, certified copies of the application as originally filed will not be legible.

The USPTO performs exception processing when scanning application papers that do not comply with the sheet size/margin and quality requirements. If papers submitted in the application-as-filed (including any transmittal letter or cover sheet) do not meet the sheet size requirement of [37 CFR 1.52](#) and [1.84\(f\)](#) (e.g., the papers are legal size (8 1/2 by 14 inches)), the USPTO must reduce such papers to be able to image-scan the entire application and record it in the IFW database. In addition, if papers submitted in the application-as-filed do not meet the quality requirements of [37 CFR 1.52](#) (e.g., the papers are shiny or non-white), the USPTO will attempt to enhance such papers before scanning to make the resulting electronic record in the IFW database more readable. However, if exception processing is required to make the IFW copy, certified copies of the application as originally filed may not be legible.

If application papers are filed that do not meet sheet size/margin and quality requirements, the USPTO will require the applicant to file substitute papers that do comply with the requirements of [37 CFR 1.52](#) and [1.84\(e\), \(f\) and \(g\)](#). The substitute papers submitted in reply to the above-mentioned requirement will provide the USPTO with an image- and OCR-scannable copy of the application for printing the application as a patent publication or patent. However, the USPTO will not treat application papers submitted after the filing date of an application as the original disclosure of the application for making a certified copy of the application-as-filed or any other purpose. That is,

even if an applicant subsequently files substitute application papers that comply with [37 CFR 1.52](#) and then requests that the USPTO provide a certified copy of an application-as-filed, paying the fee set forth in [37 CFR 1.19\(b\)\(1\)](#), the USPTO will still make a copy of the application-as-filed rather than a copy of the subsequently filed substitute papers.

### IV. USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

The initials S.I. stand for “Le Système International d’ Unités,” the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

### V. FILING OF NON-ENGLISH LANGUAGE APPLICATIONS

*37 CFR 1.52 Language, paper, writing, margins, read-only optical disc specifications.*

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(d) A nonprovisional or provisional application under [35 U.S.C. 111](#) may be in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application under [35 U.S.C. 111\(a\)](#) is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in [§ 1.17\(i\)](#) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application under [35 U.S.C. 111\(b\)](#) is filed in a language other than English, an English language translation of the non-English language provisional application will not be required in the provisional application. See [§ 1.78\(a\)](#) for the requirements for claiming the benefit of such provisional application in a nonprovisional application.

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The U.S. Patent and Trademark Office will accord a filing date to an application meeting the requirements of [35 U.S.C. 111\(a\)](#), or a provisional application in accordance with [35 U.S.C. 111\(b\)](#), even though some or all of the application papers, including the written description and any claims, is in a language other than English and hence does not comply with [37 CFR 1.52](#).

As provided in [35 U.S.C. 111\(c\)](#), a nonprovisional application filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, may be filed by a reference to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. See [MPEP § 601.01\(a\)](#), subsection III, for more information on the filing and treatment of such applications.

If a nonprovisional application under [35 U.S.C. 111\(a\)](#) is filed in a language other than English, an English translation of the non-English language papers, a statement that the translation is accurate, the fees set forth in [37 CFR 1.16](#), the oath or declaration and fee set forth in [37 CFR 1.17\(i\)](#) should either accompany the nonprovisional application papers or be filed in the Office within the time set by the Office. If a provisional application is filed 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 submitted if benefit of the provisional application is claimed in a later-filed nonprovisional application (see [37 CFR 1.78\(a\)\(5\)](#)). If the translation and statement were not previously filed in the provisional application, applicant will be notified in the nonprovisional application that claims the benefit of the provisional application and be given a period of time within which to file the translation and statement in the provisional application. Applicants may file the translation and statement in the provisional application even if the provisional application has become abandoned. A timely reply to such 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 withdrawal of the benefit claim. For applications filed before September 16, 2012, an amendment or Supplemental Application

Data Sheet withdrawing the benefit claim may be filed. For applications filed on or after September 16, 2012, a corrected application data sheet withdrawing the benefit claim may be filed. Failure to take one of the above actions will result in the abandonment of the nonprovisional application.

A subsequently filed English translation must contain the complete identifying data for the application in order to permit prompt association with the papers initially filed. Accordingly, it is strongly recommended that the original application papers be filed via the USPTO patent electronic filing system or be accompanied by a cover letter and a self-addressed return postcard, each containing the following identifying data in English: (a) applicant's name(s); (b) title of invention; (c) number of pages of specification, claims, and sheets of drawings; (d) whether an oath or declaration was filed and (e) amount and manner of paying the fees set forth in [37 CFR 1.16](#).

The translation must be a literal translation and must be accompanied by a statement that the translation is accurate. The translation must also be accompanied by a signed request from the applicant or applicant's attorney or agent, asking that the English translation be used as the copy for examination purposes in the Office. If the English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by [35 U.S.C. 132](#). If such an application is published as a patent application publication, the document that is published is the translation. See [37 CFR 1.215\(a\)](#) and [MPEP § 1121](#) regarding the content of the application publication. In the event that the English translation and the statement are not timely filed in the nonprovisional application, the nonprovisional application will be regarded as abandoned.

It should be recognized that this practice is intended for emergency situations to prevent loss of valuable rights and should not be routinely used for filing applications. There are at least two reasons why this should not be used on a routine basis. First, there are obvious dangers to applicant and the public if applicant fails to obtain a correct literal translation.

Second, the filing of a large number of applications under the procedure will create significant administrative burdens on the Office. See also [MPEP § 601.01\(a\)](#), subsection III, for information on reference filing, which is also a practice intended for emergency situations to prevent the loss of rights and should not be routinely used for filing applications.

## VI. ILLUSTRATIONS IN THE SPECIFICATION

Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of [37 CFR 1.58\(a\)](#), which permits tables, chemical and mathematical formulas in the specification in lieu of drawings. The examiner should object to such descriptive illustrations in the specification and request drawings in accordance with [37 CFR 1.81](#) when an application contains graphs, drawings, or flow charts in the specification.

The specification, including any claims, may contain chemical formulas and mathematical equations, but the written description portion of the specification must not contain drawings or flow diagrams. A claim may incorporate by reference to a specific figure or table where there is no practical way to define the invention in words. See [MPEP § 2173.05\(s\)](#). The description portion of the specification may contain tables, but the same tables should not be included in both the drawings as a figure and in the description portion of the specification. Claims may contain tables either if necessary to conform to [35 U.S.C. 112](#) or if otherwise found to be desirable. See [MPEP § 2173.05\(s\)](#). When such a patent is printed, however, the table will not be included as part of the claim, and instead the claim will contain a reference to the table number.

## VII. HYPERLINKS AND OTHER FORMS OF BROWSER-EXECUTABLE CODE IN THE SPECIFICATION

Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in a patent application. [37 CFR 1.57\(e\)](#) states that an incorporation by reference by hyperlink or other form of browser executable

code is not permitted. Examples of a hyperlink or a browser-executable code are a URL placed between these symbols “< >” and http:// followed by a URL address. When a patent application with embedded hyperlinks and/or other forms of browser-executable code issues as a patent (or is published as a patent application publication) and the patent document is placed on the USPTO webpage, when the patent document is retrieved and viewed via a web browser, the URL is interpreted as a valid HTML code and it becomes a live web link. When a user clicks on the link with a mouse, the user will be transferred to another webpage identified by the URL, if it exists, which could be a commercial website. USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views or accuracy of the information contained on these outside sites.

If hyperlinks and/or other forms of browser-executable code are embedded in the text of the patent application, examiners should object to the specification and indicate to applicants that the embedded hyperlinks and/or other forms of browser-executable code are impermissible and that references to websites should be limited to the top-level domain name without any prefix such as http:// or other browser-executable code. This requirement does not apply to electronic documents listed on forms PTO-892 and PTO/SB/08 where the electronic document is identified by reference to a URL.

The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. See [37 CFR 1.57\(e\)](#) and [MPEP § 608.01\(p\)](#), paragraph I regarding incorporation by reference. Where the hyperlinks and/or other forms of browser-executable codes themselves rather than the contents of the site to which the hyperlinks are directed are part of applicant's invention and it is necessary to have them included in the patent application in order to comply with the requirements of [35 U.S.C. 112\(a\)](#), and applicant does not intend to have these hyperlinks be active links, examiners should not object to these hyperlinks. The Office will disable these hyperlinks when preparing the text to be loaded onto the USPTO web database.



Note that nucleotide and/or amino acid sequence data placed between the symbols “< >” are not considered to be hyperlinks and/or browser-executable code and therefore should not be objected to as being an improper incorporation by reference (see [37 CFR 1.821 – 1.825](#)).

#### ¶ 7.29.04 Disclosure Objected To, Embedded Hyperlinks or Other Forms of Browser-Executable Code

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code; references to websites should be limited to the top-level domain name without any prefix such as [http://](#) or other browser-executable code. See [MPEP § 608.01](#).

#### Examiner Note:

- Examples of a hyperlink or a browser-executable code are a URL placed between these symbols “< >” and “[http://](#)” followed by a URL address. Nucleotide and/or amino acid sequence data placed between the symbols “< >” are not considered to be hyperlinks and/or browser-executable code.
- If the application attempts to incorporate essential or nonessential subject matter into the patent application by reference to the contents of the site to which a hyperlink and/or other form of browser-executable code is directed, use form paragraph 6.19 or 6.19.01 instead. See also [MPEP § 608.01\(p\)](#).
- The requirement to delete an embedded hyperlink or other form of browser-executable code does not apply to electronic documents listed on forms PTO-892 and PTO/SB/08 where the electronic document is identified by reference to a URL.
- Examiners should not object to hyperlinks where the hyperlinks and/or browser-executable codes themselves (rather than the contents of the site to which the hyperlinks are directed) are necessary to be included in the patent application in order to meet the requirements of [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112](#), first paragraph, and applicant does not intend to have those hyperlinks be active links.

### 608.01(a) Arrangement of Application [R-07.2022]

#### *37 CFR 1.77 Arrangement of application elements.*

(a) The elements of the application, if applicable, should appear in the following order:

- Utility application transmittal form.
- Fee transmittal form.
- Application data sheet (see [§ 1.76](#)).
- Specification.
- Drawings.
- The inventor’s oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) An incorporation by reference statement regarding the material in:

(i) One or more ASCII plain text files, submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see [§ 1.52\(e\)\(8\)](#)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes, for the following document types:

(A) A “Computer Program Listing Appendix” (see [§ 1.96\(c\)](#));

(B) A “Sequence Listing” (see [§ 1.821\(c\)](#));

or

(C) “Large Tables” (see [§ 1.58\(c\)](#)).

(ii) An XML file for a “Sequence Listing XML” (see [§ 1.831\(a\)](#)), submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see [§ 1.52\(e\)\(8\)](#)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes.

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) “Sequence Listing,” required by [§ 1.821\(c\)](#), that is submitted as a Portable Document Format (PDF) file (as set forth in [§ 1.821\(c\)\(2\)](#)) via the USPTO patent electronic filing system or on physical sheets of paper (as set forth in [§ 1.821\(c\)\(3\)](#)).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

For design patent specification, see [MPEP § 1503.01](#).

For plant patent specification, see [MPEP § 1605](#).

For reissue patent specification, see [MPEP § 1411](#).



The order of arrangement of specification elements as set forth in [37 CFR 1.77\(b\)](#) is preferable (e.g., not required) in framing the nonprovisional specification and each of the items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading. It is recommended that provisional applications follow the same general format, although claims are not required. If an application data sheet ([37 CFR 1.76](#)) is used, data supplied in the application data sheet need not be provided elsewhere in the application except that for applications filed before September 16, 2012, the citizenship of each inventor must be provided in the oath or declaration under [37 CFR 1.63](#) even if this information is provided in the application data sheet.

For applications filed on or after September 16, 2012, if there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of inventors. The naming of the inventorship is governed by [37 CFR 1.41](#), and changes to inventorship or the names of inventors is governed by [37 CFR 1.48](#). In addition, for applications filed on or after September 16, 2012, the most recent application data sheet in compliance with [37 CFR 1.76](#) will govern with respect to foreign priority claims or domestic benefit claims. See [37 CFR 1.76\(d\)](#) and [MPEP § 601.05\(a\)](#).

For applications filed before September 16, 2012, if there is a discrepancy between the information submitted in an application data sheet and the information submitted elsewhere in the application, the application data sheet will control except for the naming of the inventors and the citizenship of the inventors. See [pre-AIA 37 CFR 1.76\(d\)](#) and [MPEP § 601.05\(b\)](#).

Applicant (typically a *pro se*) may be advised of the proper arrangement by using Form Paragraph 6.01 or 6.02.

#### ¶ 6.01 Arrangement of the Sections of the Specification in a Utility Application

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

#### Arrangement of the Specification

As provided in [37 CFR 1.77\(b\)](#), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase “Not Applicable” should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A READ-ONLY OPTICAL DISC, AS A TEXT FILE OR AN XML FILE VIA THE PATENT ELECTRONIC SYSTEM.
- (f) STATEMENT REGARDING PRIOR DISCLOSURES BY THE INVENTOR OR A JOINT INVENTOR.
- (g) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under [37 CFR 1.97](#) and [1.98](#).
- (h) BRIEF SUMMARY OF THE INVENTION.
- (i) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (j) DETAILED DESCRIPTION OF THE INVENTION.
- (k) CLAIM OR CLAIMS (commencing on a separate sheet).
- (l) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (m) SEQUENCE LISTING. (See [MPEP § 2422.03](#) and [37 CFR 1.821-1.825](#)). A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in [37 CFR 1.821\(a\)](#) and if the required “Sequence Listing” is not submitted as an electronic document either on read-only optical disc or as a text file via the patent electronic system.

#### Examiner Note:

For the arrangement of the sections of the specification in a design application, see [37 CFR 1.154\(b\)](#). Form paragraph 15.05 may be used for a design application. For the arrangement of the sections of the specification in a plant application, see [37](#)

[CFR 1.163\(c\)](#). For the requirements of the specification in a reissue application, see [37 CFR 1.173\(a\)\(1\)](#).

## ¶ 6.02 Content of Specification

### Content of Specification

(a) **TITLE OF THE INVENTION:** See [37 CFR 1.72\(a\)](#) and [MPEP § 606](#). The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words. It may not contain more than 500 characters.

(b) **CROSS-REFERENCES TO RELATED APPLICATIONS:** See [37 CFR 1.78](#) and [MPEP § 211](#) et seq.

(c) **STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT:** See [MPEP § 310](#).

(d) **THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.** See [37 CFR 1.71\(g\)](#).

(e) **INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A READ-ONLY OPTICAL DISC, AS A TEXT FILE OR AN XML FILE VIA THE PATENT ELECTRONIC SYSTEM:** The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See [37 CFR 1.77\(b\)\(5\)](#) and [MPEP § 608.05](#). See also the Legal Framework for Patent Electronic System posted on the USPTO website (<https://www.uspto.gov/sites/default/files/documents/2019LegalFrameworkPES.pdf>) and [MPEP § 502.05](#).

(f) **STATEMENT REGARDING PRIOR DISCLOSURES BY THE INVENTOR OR A JOINT INVENTOR.** See [35 U.S.C. 102\(b\)](#) and [37 CFR 1.77](#).

(g) **BACKGROUND OF THE INVENTION:** See [MPEP § 608.01\(c\)](#). The specification should set forth the Background of the Invention in two parts:

(1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled “Technical Field.”

(2) **Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98:** A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant’s invention. This item may also be titled “Background Art.”

(h) **BRIEF SUMMARY OF THE INVENTION:** See [MPEP § 608.01\(d\)](#). A brief summary or general statement of the invention as set forth in [37 CFR 1.73](#). The summary is separate and distinct

from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(i) **BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S):** See [MPEP § 608.01\(f\)](#). A reference to and brief description of the drawing(s) as set forth in [37 CFR 1.74](#).

(j) **DETAILED DESCRIPTION OF THE INVENTION:** See [MPEP § 608.01\(g\)](#). A description of the preferred embodiment(s) of the invention as required in [37 CFR 1.71](#). The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described, and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(k) **CLAIM OR CLAIMS:** See [37 CFR 1.75](#) and [MPEP § 608.01\(m\)](#). The claim or claims must commence on a separate sheet or electronic page ([37 CFR 1.52\(b\)\(3\)](#)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See [37 CFR 1.75](#) and [MPEP 608.01\(i\)-\(p\)](#).

(l) **ABSTRACT OF THE DISCLOSURE:** See [37 CFR 1.72\(b\)](#) and [MPEP § 608.01\(b\)](#). The abstract is a brief narrative of the disclosure as a whole, as concise as the disclosure permits, in a single paragraph preferably not exceeding 150 words, commencing on a separate sheet following the claims. In an international application which has entered the national stage ([37 CFR 1.491\(b\)](#)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under [PCT Article 21](#). The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See [MPEP § 1893.03\(e\)](#).

(m) **SEQUENCE LISTING:** See [37 CFR 1.821-1.825](#) and [MPEP §§ 2421-2431](#). The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See [MPEP § 2422.01](#).

**Examiner Note:**

In this paragraph an introductory sentence will be necessary. This paragraph is intended primarily for use in *pro se* applications.

**608.01(b) Abstract of the Disclosure  
[R-01.2024]****37 CFR 1.72 Title and abstract.**

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(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading “Abstract” or “Abstract of the Disclosure.” The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract must be as concise as the disclosure permits, preferably not exceeding 150 words in length. The purpose of the abstract is to enable the Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.

The Office of Patent Application Processing (OPAP) will review all applications filed under [35 U.S.C. 111\(a\)](#) for compliance with [37 CFR 1.72](#) and will require an abstract, if one has not been filed. In all other applications which lack an abstract, the examiner in the first Office action should require the submission of an abstract directed to the technical disclosure in the specification. See Form Paragraph 6.12 (below). Applicants may use either “Abstract” or “Abstract of the Disclosure” as a heading.

If the abstract contained in the application does not comply with the guidelines, the examiner should point out the defect to the applicant in the first Office action, or at the earliest point in the prosecution that the defect is noted, and require compliance with the guidelines. Since the abstract of the disclosure has been interpreted to be a part of the specification for the purpose of compliance with [35 U.S.C. 112](#) (*In re Armbruster*, 512 F.2d 676, 678-79, 185 USPQ 152, 154 (CCPA 1975)), it would ordinarily be preferable that the applicant make the necessary changes to the abstract to bring it into compliance with the guidelines. See Form Paragraphs 6.13-6.16 (below).

Replies to such actions requiring either a new abstract or amendment to bring the abstract into compliance with the guidelines should be treated under [37 CFR 1.111\(b\)](#) practice like any other formal matter. Any submission of a new abstract or amendment to an existing abstract should be

carefully reviewed for introduction of new matter, [35 U.S.C. 132](#), [MPEP § 608.04](#). The abstract will be printed on the patent.

Upon passing the application to issue, the examiner should make certain that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines. If the application is otherwise in condition for allowance except that the abstract does not comply with the guidelines, the examiner generally should make any necessary revisions by a formal examiner’s amendment after obtaining applicant’s authorization (see [MPEP § 1302.04](#)) rather than issuing an *Ex parte Quayle* action requiring applicant to make the necessary revisions.

**I. GUIDELINES FOR THE PREPARATION OF  
PATENT ABSTRACTS****A. Background**

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, [37 CFR 1.72\(b\)](#).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his or her degree of familiarity with patent documents, to determine quickly from a cursory inspection of the abstract the nature and gist of the technical disclosure and that which is new in the art to which the invention pertains.

**B. Content**

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be included in the abstract.

With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., “The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics.” Exemplification of a species could be illustrative of members of the class. For processes, the type of reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

### *C. Language and Format*

The abstract must commence on a separate sheet, preferably following the claims, under the heading “Abstract” or “Abstract of the Disclosure.” The sheet or sheets presenting the abstract may not include other parts of the application or other material. Form paragraph 6.16.01 (below) may be used if the abstract does not commence on a separate sheet. Note that the abstract for a national stage application filed under [35 U.S.C. 371](#) may be found on the front page of the Patent Cooperation Treaty publication (i.e., pamphlet). See [MPEP § 1893.03\(e\)](#).

The abstract should be in narrative form and generally limited to a single paragraph preferably within the range of 50 to 150 words in length. The abstract should not exceed 15 lines of text. Abstracts exceeding 15 lines of text or 150 words should be checked to see that they are as concise as the disclosure permits. The form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided. The abstract should sufficiently describe the disclosure to assist readers

in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, “This disclosure concerns,” “The disclosure defined by this invention,” “This disclosure describes,” etc.

### *D. Responsibility*

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant’s contribution to the art are most important in the preparation of the abstract. The review of the abstract for compliance with these guidelines is the responsibility of the examiner. Any necessary amendment to the abstract at the time of allowance or a printer query must be made either by the applicant or by the examiner with applicant’s approval. See [MPEP § 1302.04](#).

### *E. Sample Abstracts*

(1) A heart valve which has an annular valve body defining an orifice and a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

(2) A method for sealing whereby heat is applied to seal, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

(3) Amides are produced by reacting an ester of a carbonized acid with an amine, using as catalyst an dioxide of an alkali metal. The ester is first heated to at least 75 °C under a pressure



of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

## F. Form Paragraphs

### ¶ 6.12 Abstract Missing (Background)

This application does not contain an abstract of the disclosure as required by [37 CFR 1.72\(b\)](#). An abstract on a separate sheet is required.

#### Examiner Note:

1. For a *pro se* applicant, consider following this paragraph with form paragraphs 6.14 to 6.16 as applicable.
2. This form paragraph should not be used during the national stage prosecution of international applications (“371 applications”) if an abstract was published with the international application under [PCT Article 21](#).

### ¶ 6.13 Abstract Objected To

The abstract of the disclosure is objected to because [1]. A corrected abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text. See [MPEP § 608.01\(b\)](#).

#### Examiner Note:

1. In bracket 1, indicate the informalities that require correction such as the inclusion of legal phraseology, undue length, etc.
2. For a *pro se* applicant, this paragraph should be followed by form paragraphs 6.14 to 6.16 as applicable.

### ¶ 6.14 Abstract of the Disclosure: Content

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. The abstract should also mention by way of example any preferred modifications or alternatives.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of an apparatus should not be included in the abstract. The abstract

should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words in length.

See [MPEP § 608.01\(b\)](#) for guidelines for the preparation of patent abstracts.

#### Examiner Note:

See form paragraph 6.16

### ¶ 6.15 Abstract of the Disclosure: Chemical Cases

Applicant is reminded of the proper content of an abstract of the disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, “The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics.” Exemplification of a species could be illustrative of members of the class. For processes, the type of reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

#### Examiner Note:

See also form paragraphs 6.12 – 6.14 and 6.16.

### ¶ 6.16 Abstract of the Disclosure: Language

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet preferably within the range of 50 to 150 words in length. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, “The disclosure concerns,” “The disclosure defined by this invention,” “The disclosure describes,” etc. In addition, the form and legal phraseology often used in patent claims, such as “means” and “said,” should be avoided.

#### Examiner Note:

See also form paragraph 6.12 - 6.15.

### ¶ 6.16.01 Abstract of the Disclosure: Placement

The abstract of the disclosure does not commence on a separate sheet in accordance with [37 CFR 1.52\(b\)\(4\)](#) and [1.72\(b\)](#). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

#### Examiner Note:

1. [37 CFR 1.72\(b\)](#) requires that the abstract be set forth on a separate sheet. This requirement applies to amendments to the abstract as well as to the initial filing of the application.
2. This form paragraph should not be used during the national stage prosecution of international applications (“371



applications”) if an abstract was published with the international application under [PCT Article 21](#).

### **608.01(c) Background of the Invention** **[R-07.2022]**

The Background of the Invention may (but is not required to) include the following parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable Cooperative Patent Classification (CPC) definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the related art including information disclosed under [37 CFR 1.97](#) and [37 CFR 1.98](#): A paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant’s invention should be indicated. See also [MPEP § 608.01\(a\)](#), [§ 608.01\(p\)](#) and [§ 707.05\(b\)](#).

### **608.01(d) Brief Summary of Invention** **[R-07.2015]**

#### *37 CFR 1.73 Summary of the invention.*

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under [37 CFR 1.73](#).

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, [MPEP § 1302](#).

### **608.01(e) [Reserved]**

### **608.01(f) Brief Description of Drawings** **[R-01.2024]**

#### *37 CFR 1.74 Reference to drawings.*

When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

The Office of Patent Application Processing (OPAP) will review the specification, including the brief description, to determine whether all of the figures of drawings described in the specification are present. If the specification describes a figure which is not present in the drawings or lacks any drawings, and if the application, other than a design application, is filed on or after December 18, 2013, the application will be treated as an application filed without all figures of drawings in accordance with [MPEP § 601.01\(g\)](#). If the application is filed prior to December 18, 2013 or is a design application and lacks any drawings, the application will be treated as an application filed without drawings in accordance with [MPEP § 601.01\(f\)](#).

The examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used. If the drawings show Figures 1A, 1B, and 1C and the brief description of the drawings refers only to Figure 1, the examiner should object to the brief description, and require applicant to provide a brief description of Figures 1A, 1B, and 1C.

The specification must contain or be amended to contain proper reference to the existence of drawings executed in color as required by [37 CFR 1.84](#).

**37 CFR 1.84 Standards for drawings.**

(a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink*. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color*. Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see [PCT Rule 11.13](#)). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in [§ 1.17\(h\)](#);

(ii) One (1) set of color drawings if submitted via the USPTO patent electronic filing system, or three (3) sets of color drawings if not submitted via the USPTO patent electronic filing system; and

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) *Photographs*.—

(1) *Black and white*. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (*e.g.*, immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient

quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs*. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

\*\*\*\*\*

(y) *Types of drawings*. See [§ 1.152](#) for design drawings, [§ 1.1026](#) for international design reproductions, [§ 1.165](#) for plant drawings, and [§ 1.173\(a\)\(2\)](#) for reissue drawings.

**608.01(g) Detailed Description of Invention [R-10.2019]**

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by [37 CFR 1.71](#), [MPEP § 608.01](#), [2161](#), and [2162](#), must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation and must clearly convey enough information about the invention to show that applicant invented the subject matter that is claimed. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. See [37 CFR 1.84\(p\)](#). Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See [37 CFR 1.75](#), [MPEP § 608.01\(i\)](#), [§ 608.01\(o\)](#), and [§ 1302.01](#), and [2111.01](#).

For completeness of the specification, see [MPEP § 608.01\(p\)](#).

## 608.01(h) Mode of Operation of Invention [R-11.2013]

The best mode contemplated by the inventor of carrying out his or her invention must be set forth in the description. See [35 U.S.C. 112](#). There is no statutory requirement for the disclosure of a specific example. A patent specification is not intended nor required to be a production specification.

*Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Gay*, 309 F.2d 769, 135 USPQ 311 (CCPA 1962). The absence of a specific working example is not necessarily evidence that the best mode has not been disclosed, nor is the presence of one evidence that it has. *In re Honn*, 364 F.2d 454, 150 USPQ 652 (CCPA 1966). In determining the adequacy of a best mode disclosure, only evidence of concealment (accidental or intentional) is to be considered. That evidence must tend to show that the quality of an applicant's best mode disclosure is so poor as to effectively result in concealment.

*Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1536, 3 USPQ2d 1737, 1745 (Fed. Cir. 1987); *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980).

The question of whether an inventor has or has not disclosed what he or she feels is his or her best mode is a question separate and distinct from the question of sufficiency of the disclosure. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1532, 3 USPQ2d 1737, 1742 (Fed. Cir. 1987); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974); *In re Gay*, 309 F.2d 769, 135 USPQ 311 (CCPA 1962). See [35 U.S.C. 112](#) and [37 CFR 1.71\(b\)](#).

If the best mode contemplated by the inventor at the time of filing the application is not disclosed, such defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter.

For completeness, see [MPEP § 608.01\(p\)](#). For a discussion of the best mode requirement see [MPEP § 2165](#) to [§ 2165.04](#).

## 608.01(i) Claims [R-08.2012]

### 37 CFR 1.75 Claims.

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim ("multiple dependent claim") shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under [§ 1.16](#), a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in [§ 1.16\(j\)](#). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See [§ 1.58\(a\)](#).)

(2) See [§§ 1.141](#) to [1.146](#) as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as "wherein the improvement comprises," and

(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate physical sheet or electronic page. Any sheet including a claim

or portion of a claim may not contain any other parts of the application or other material.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

For numbering of claims, see [MPEP § 608.01\(j\)](#).

For form of claims, see [MPEP § 608.01\(m\)](#).

For dependent claims, see [MPEP § 608.01\(n\)](#).

For examination of claims, see [MPEP § 706](#).

For claims in excess of fee, see [MPEP § 714.10](#).

### **608.01(j) Numbering of Claims [R-08.2012]**

#### *37 CFR 1.126 Numbering of claims.*

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

In a single claim case, the claim is not numbered.

Form paragraph 6.17 may be used to notify applicant.

#### **¶ 6.17 Numbering of Claims, 37 CFR 1.126**

The numbering of claims is not accordance with [37 CFR 1.126](#), which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim [1] been renumbered [2].

#### **Examiner Note:**

1. In bracket 1, insert appropriate claim number(s) and --has-- or -- have --.
2. In bracket 2, insert correct claim number(s) and --, respectively -- if more than one claim is involved.

### **608.01(k) Statutory Requirement of Claims [R-10.2019]**

[35 U.S.C. 112](#) requires that the specification shall particularly point out and distinctly claim the subject matter which the inventor or joint inventor regards as his or her invention. The portion of the application in which this is done forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

### **608.01(l) Claims Present on the Application Filing Date [R-10.2019]**

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the claims present on the filing date of the application if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be objected to or rejected because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description.

On the other hand, when the subject matter is not shown in the drawing or described in the description, the words of the original claim must sufficiently describe the invention so that one of ordinary skill in the art would recognize that the inventor had possession of the full scope of the claimed invention. If the claim does not provide its own description in this case, the claim should be rejected under [35 U.S.C. 112\(a\)](#) as failing to be supported by an adequate written description.



## 608.01(m) Form of Claims [R-10.2019]

The claim or claims must commence on a separate physical sheet or electronic page and should appear after the detailed description of the invention. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with “I (or we) claim,” “The invention claimed is” (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the Office of Data Management. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, [37 CFR 1.75\(i\)](#).

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. Generally, the presence or absence of such reference characters does not affect the scope of a claim.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive. All dependent claims should be grouped

together with the claim or claims to which they refer to the extent practicable. Where separate species are claimed, the claims of like species should be grouped together where possible. Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

When two claims in an application comply with the requirements of [35 U.S.C. 112\(d\)](#) but are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under [37 CFR 1.75](#) as being a substantial duplicate of the allowed claim. Note however, that court decisions have confirmed applicant’s right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough. Form paragraphs 7.05.05 and 7.05.06 may be used where duplicate claims are present in an application.

See [MPEP § 608.01\(n\)](#), subsection II, for rejections under [35 U.S.C. 112\(d\)](#) of dependent claims that do not specify a further limitation of the subject matter claimed. See [MPEP § 804](#) for double patenting rejections of claims in different applications that are not patentable over each other.

The form of claim required in [37 CFR 1.75\(e\)](#) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

The following form paragraphs may be used to object to the form of the claims.

### ¶ 6.18.01 Claims: Placement

The claims in this application do not commence on a separate sheet or electronic page in accordance with [37 CFR 1.52\(b\)\(3\)](#) and [1.75\(h\)](#). Appropriate correction is required in response to this action.

### ¶ 7.29.01 Claims Objected to, Minor Informalities

Claim[1] objected to because of the following informalities: [2]. Appropriate correction is required.



**Examiner Note:**

1. Use this form paragraph to point out minor informalities such as spelling errors, inconsistent terminology (see the requirement of [37 CFR 1.71\(a\)](#) for “full, clear, concise, and exact terms”), etc., which should be corrected.
2. If the informalities render the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under [35 U.S.C. 112\(b\)](#) or [35 U.S.C. 112](#) (pre-AIA), second paragraph.

**¶ 7.29.02 Claims Objected to, Reference Characters Not Enclosed Within Parentheses**

The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See [MPEP § 608.01\(m\)](#).

**Examiner Note:**

1. If the lack of parentheses renders the claim(s) indefinite, use form paragraph 7.34.01 instead to reject the claim(s) under [35 U.S.C. 112\(b\)](#) or pre-AIA [35 U.S.C. 112](#), second paragraph.

**¶ 7.29.03 Claims Objected to, Spacing of Lines**

The claims are objected to because the lines are crowded too closely together, making reading difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See [37 CFR 1.52\(b\)](#).

**¶ 7.05.05 Duplicate Claims, Warning**

Applicant is advised that should claim [1] be found allowable, claim [2] will be objected to under [37 CFR 1.75](#) as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See [MPEP § 608.01\(m\)](#).

**Examiner Note:**

1. Use this form paragraph whenever two claims are found to be substantial duplicates, but they are not allowable. This will give the applicant an opportunity to correct the problem and avoid a later objection.
2. If the claims are allowable, use form paragraph 7.05.06.
3. When a dependent claim does not specify a further limitation of the subject matter claimed as required by [35 U.S.C. 112\(d\)](#), the dependent claim should be rejected using form paragraphs 7.36 and 7.36.01. See [MPEP § 608.01\(n\)](#), subsection III. It is not necessary to also warn of the prohibition against duplicate claims using this form paragraph.

**¶ 7.05.06 Duplicate Claims, Objection**

Claim [1] objected under [37 CFR 1.75](#) as being a substantial duplicate of claim [2]. When two claims in an application are

duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See [MPEP § 608.01\(m\)](#).

**Examiner Note:**

1. If the duplicate claims are not allowable, use form paragraph 7.05.05.
2. When a dependent claim does not specify a further limitation of the subject matter claimed as required by [35 U.S.C. 112\(d\)](#), the dependent claim should be rejected using form paragraphs 7.36 and 7.36.01. See [MPEP § 608.01\(n\)](#), subsection III. It is not necessary to also object to the improper dependent claim using this form paragraph.

Amendments to the claims must be in compliance with [37 CFR 1.121\(c\)](#).

**608.01(n) Dependent Claims [R-01.2024]****I. MULTIPLE DEPENDENT CLAIMS****35 U.S.C. 112 Specification.**

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(e) REFERENCE IN MULTIPLE DEPENDENT FORM. — A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

\*\*\*\*\*

**37 CFR 1.75 Claim(s).**

\*\*\*\*\*

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under [§ 1.16](#), a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in [§ 1.16\(j\)](#). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

\*\*\*\*\*

Generally, a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.

[35 U.S.C. 112\(e\)](#), authorizes multiple dependent claims in applications as long as they are in the alternative form (e.g., “A machine according to claims 3 or 4, further comprising ---”). Cumulative claiming (e.g., “A machine according to claims 3 and 4, further comprising ---”) is not permitted. A multiple dependent claim may refer in the alternative to only one set of claims. A claim such as “A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8” is improper. [35 U.S.C. 112](#) allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim.

[35 U.S.C. 112](#) indicates that the limitations or elements of each claim incorporated by reference into a multiple dependent claim must be considered separately. Thus, a multiple dependent claim, as such, does not contain all the limitations of all the alternative claims to which it refers, but rather contains in any one embodiment only those limitations of the particular claim referred to for the embodiment under consideration. Hence, a multiple dependent claim must be considered in the same manner as a plurality of single dependent claims. See *Nested Bean, Inc. v. Big Beings Pty Ltd.*, IPR2020-01234, Paper 42 (Feb. 24, 2023).

A multiple dependent claim which depends from another multiple dependent claim should be objected to by using form paragraph 7.45.

#### ¶ 7.45 Improper Multiple Dependent Claims

Claim [1] objected to under [37 CFR 1.75\(c\)](#) as being in improper form because a multiple dependent claim [2]. See [MPEP § 608.01\(n\)](#). Accordingly, the claim [3] not been further treated on the merits.

#### Examiner Note:

1. In bracket 2, insert --should refer to other claims in the alternative only--, and/or, --cannot depend from any other multiple dependent claim--.

2. Use this paragraph rather than [35 U.S.C. 112\(e\)](#) or [35 U.S.C. 112](#) (pre-AIA), fifth paragraph.

3. In bracket 3, insert --has-- or --s have--.

Assume each claim example given below is from a different application.

#### A. Acceptable Multiple Dependent Claim Wording

Claim 5. A gadget according to claims 3 or 4, further comprising ---

Claim 5. A gadget as in any one of the preceding claims, in which ---

Claim 5. A gadget as in any one of claims 1, 2, and 3, in which ---

Claim 3. A gadget as in either claim 1 or claim 2, further comprising ---

Claim 4. A gadget as in claim 2 or 3, further comprising ---

Claim 16. A gadget as in claims 1, 7, 12, or 15, further comprising ---

Claim 5. A gadget as in any of the preceding claims, in which ---

Claim 8. A gadget as in one of claims 4-7, in which ---

Claim 5. A gadget as in any preceding claim, in which ---

Claim 10. A gadget as in any of claims 1-3 or 7-9, in which ---

Claim 11. A gadget as in any one of claims 1, 2, or 7-10 inclusive, in which ---

#### B. Unacceptable Multiple Dependent Claim Wording

##### 1. Claim Does Not Refer Back in the Alternative Only

Claim 5. A gadget according to claim 3 and 4, further comprising ---

Claim 9. A gadget according to claims 1-3, in which ---

Claim 9. A gadget as in claims 1 or 2 and 7 or 8, which ---

Claim 6. A gadget as in the preceding claims in which ---

Claim 6. A gadget as in claims 1, 2, 3, 4 and/or 5, in which ---

Claim 10. A gadget as in claims 1-3 or 7-9, in which ---

## **2. Claim Does Not Refer to a Preceding Claim**

Claim 3. A gadget as in any of the following claims, in which ---

Claim 5. A gadget as in either claim 6 or claim 8, in which ---

## **3. Reference to Two Sets of Claims to Different Features**

Claim 9. A gadget as in claim 1 or 4 made by the process of claims 5, 6, 7, or 8, in which ---

## **4. Reference Back to Another Multiple Dependent Claim**

Claim 8. A gadget as in claim 5 (claim 5 is a multiple dependent claim) or claim 7, in which ---

### ***C. Restriction Practice***

For restriction purposes, each embodiment of a multiple dependent claim is considered in the same manner as a single dependent claim. Therefore, restriction may be required between the embodiments of a multiple dependent claim. Also, some embodiments of a multiple dependent claim may be held withdrawn while other embodiments are considered on their merits.

### ***D. Handling of Multiple Dependent Claims by the Office of Patent Application Processing***

The Office of Patent Application Processing (OPAP) is responsible for verifying whether multiple dependent claims filed with the application are in proper alternative form, that they depend only upon prior independent or single dependent claims and also for calculating the amount of the filing fee. Form PTO/SB/07 has been designed to be used in conjunction with the current fee calculation form PTO/SB/06.

### ***E. Handling of Multiple Dependent Claims by the Technology Center Technical Support Staff***

The Technology Center (TC) technical support staff is responsible for verifying compliance with the statute and rules of multiple dependent claims added by amendment and for calculating the amount of any additional fees required. This calculation should be performed on form PTO/SB/07.

*There is no need for a TC technical support staff to check the accuracy of the initial filing fee since this has already been verified by the Office of Patent Application Processing.*

If a multiple dependent claim (or claims) is added in an amendment without the proper fee, either by adding references to prior claims or by adding a new multiple dependent claim, the amendment should not be entered until the fee has been received. In view of the requirements for multiple dependent claims, no amendment containing new claims or changing the dependency of claims should be entered before checking whether the paid fees cover the costs of the amended claims. The applicant, or the applicant's attorney or agent, should be contacted to pay the additional fee. Where a letter is written in an insufficient fee situation, a copy of the multiple dependent claim fee calculation, form PTO/SB/07 should be included for applicant's information.

Where the TC technical support staff notes that the reference to the prior claims is improper in an added or amended multiple dependent claim, a notation should be made in the left margin next to the claim itself and the number 1, which is inserted in the "Dep. Claim" column of that amendment on form

PTO/SB/07 should be circled in order to call this matter to the examiner’s attention.

**F. Handling of Multiple Dependent Claims by the Examiner**

Pursuant to [35 U.S.C. 112](#) and [37 CFR 1.75\(c\)](#), a claim in dependent form must refer only to a claim or claims *previously set forth*. The following procedures are to be followed by examiners when faced with claims which refer to numerically succeeding claims:

If any series of dependent claims contains a claim with an improper reference to a numerically following claim which cannot be understood, the claim referring to a following claim should normally be objected to and not treated on the merits. (See Example A, below.)

However, in situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, all claims should be examined on the merits and no objection as to form need be made. In such cases, an examiner’s amendment should be prepared if the order of the claims is changed. (See Example B, below.)

Any unusual problems should be brought to the supervisor’s attention.

**Example A**

(Claims 4 and 6 should be objected to as not being understood and should not be treated on the merits.)

1. Independent
2. Dependent on claim 5
3. Dependent on claim 2
4. “. . . as in any preceding claim”
5. Independent
6. Dependent on claim 4

**Example B**

Note: Parenthetical numerals represent the claim numbering for issue should all claims be allowed.

(All claims should be examined.)

1. (1) Independent
2. (5) Dependent on claim 5 (4)
3. (2) Dependent on claim 1 (1)
4. (3) Dependent on claim 3 (2)
5. (4) Dependent on either claim 1 (1) or claim 3 (2)

The following practice is followed by patent examiners when making reference to a dependent claim either singular or multiple:

(A) When identifying a singular dependent claim which does not include a reference to a multiple dependent claim, either directly or indirectly, reference should be made only to the number of the dependent claim.

(B) When identifying the embodiments included within a multiple dependent claim, or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, each embodiment should be identified by using the number of the claims involved, starting with the highest, *to the extent necessary* to specifically identify each embodiment.

(C) When all embodiments included within a multiple dependent claim or a singular dependent claim which includes a reference to a multiple dependent claim, either directly or indirectly, are subject to a common rejection, objection, or requirement, reference may be made only to the number of the dependent claim.

The following table illustrates the current practice where each embodiment of each claim must be treated on an individual basis:

Claim No.	Claim dependency	Identification All claims	Approved practice
1	Independent	1	1
2	Depends from 1	2/1	2
3	Depends from 2	3/2/1	3
4	Depends from 2 or 3	4/2/1 4/3/2/1	4/2 4/3
5	Depends from 3	5/3/2/1	5

Claim No.	Claim dependency	Identification All claims	Approved practice
6	Depends from 2, 3, or 5	6/2/1 6/3/2/1 6/5/3/2/1	6/2 6/3 6/5
7	Depends from 6	7/6/2/1 7/6/3/2/1 7/6/5/3/2/1	7/6/2 7/6/3 7/6/5

When all embodiments in a multiple dependent claim situation (claims 4, 6, and 7 above) are subject to a common rejection, objection, or requirements, reference may be made to the number of the individual dependent claim only. For example, if 4/2 and 4/3 were subject to a common ground of rejection, reference should be made only to claim 4 in the statement of that rejection.

The provisions of [35 U.S.C. 132](#) require that each Office action make it explicitly clear what rejection, objection and/or requirement is applied to each claim embodiment.

### *G. Fees for Multiple Dependent Claims*

#### **1. Use of Form PTO/SB/07**

To assist in the computation of the fees for multiple dependent claims, a separate “Multiple Dependent Claim Fee Calculation Sheet,” form PTO/SB/07 has been designed for use with the current “Patent Application Fee Determination Record,” form PTO/SB/06. Form PTO/SB/07 will be placed in the application file by the Office of Patent Application Processing (OPAP) where multiple dependent claims are in the application as filed or submitted in response to an OPAP notice requiring claims. If multiple dependent claims are not included upon filing or submitted in response to an OPAP notice requiring claims, but are later added by amendment, the TC technical support staff will place the form in the application file. If there are multiple dependent claims in the application, the total number of independent and dependent claims for fee purposes

will be calculated on form PTO/SB/07 and the total number of claims and number of independent claims is then placed on form PTO/SB/06 for final fee calculation purposes.

#### **2. Calculation of Fees**

##### **(a) Proper Multiple Dependent Claim**

[35 U.S.C. 41\(a\)](#), provides that claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers. Any proper claim depending directly or indirectly from a multiple dependent claim is also considered as the number of dependent claims as referred to in the multiple dependent claim from which it depends.

##### **(b) Improper Multiple Dependent Claim**

If none of the multiple dependent claims is proper, the multiple dependent claim fee set forth in [37 CFR 1.16\(j\)](#) will not be required. However, the multiple dependent claim fee is required if at least one multiple dependent claim is proper.

If any multiple dependent claim is improper, OPAP may indicate that fact by placing an encircled numeral “1” in the “Dep. Claims” column of form PTO/SB/07. The fee for any improper multiple dependent claim, whether it is defective for either not being in the alternative form or for being directly or indirectly dependent on a prior multiple dependent claim, will only be one, since only an objection to the form of such a claim will normally be made. This procedure also greatly simplifies the calculation of fees. Any claim depending from an improper multiple dependent claim will also be considered to be improper and be counted as one dependent claim.

##### **(c) Fee Calculation Example**



<i>Claim No.</i>	<i>Ind.</i>	<i>Dep.</i>
1.	Independent	1
2.	Dependent on claim 1	1
3.	Dependent on claim 2	1
4.	Dependent on claim 2 or 3	2
5.	Dependent on claim 4	2
6.	Dependent on claim 5	2
7.	Dependent on claim 4, 5 or 6	①
8.	Dependent on claim 7	①
9.	Independent	1
10.	Dependent on claim 1 or 9	2
11.	Dependent on claims 1 and 9	①
<b>Total</b>		2      13

**i) Comments On Fee Calculation Example**

*Claim 1* — This is an independent claim; therefore, a numeral “1” is placed opposite claim number 1 in the “Ind.” column.

*Claim 2* — Since this is a claim dependent on a single independent claim, a numeral “1” is placed opposite claim number 2 of the “Dep.” column.

*Claim 3*— Claim 3 is also a single dependent claim, so a numeral “1” is placed in the “Dep.” column.

*Claim 4* — Claim 4 is a proper multiple dependent claim. It refers directly to two claims in the alternative, namely, claim 2 *or* 3. Therefore, a numeral “2” to indicate direct reference to two claims is placed in the “Dep.” column opposite claim number 4.

*Claim 5* — This claim is a singularly dependent claim depending from a multiple dependent claim. For fee calculation purposes, such a claim is counted as being that number of claims to which direct reference is made in the multiple dependent claim from which it depends. In this case, the multiple dependent claim number 4 it depends from counts as 2 claims; therefore, claim 5 also counts as 2 claims. Accordingly, a numeral “2” is placed opposite claim number 5 in the “Dep.” column.

*Claim 6* — Claim 6 depends indirectly from a multiple dependent claim 4. Since claim 4 counts as 2 claims, claim 6 also counts as 2 dependent claims. Consequently, a numeral “2” is placed in the “Dep.” column after claim 6.

*Claim 7*— This claim is a multiple dependent claim since it refers to claims 4, 5, or 6. However, as can be seen by looking at the “2” in the “Dep.” column opposite claim 4, claim 7 depends from a multiple dependent claim. This practice is improper under [35 U.S.C.112](#) and [37 CFR 1.75\(c\)](#). Following the procedure for calculating fees for improper multiple dependent claims, a numeral “1” is placed in the “Dep.” column with a circle drawn around it to alert the examiner that the claim is improper.

*Claim 8* — Claim 8 is improper since it depends from an improper claim. If the base claim is in error, this error cannot be corrected by adding additional claims depending therefrom. Therefore, a numeral “1” with a circle around it is placed in the “Dep.” column.

*Claim 9* — Here again we have an independent claim which is always indicated with a numeral “1” in the “Ind.” column opposite the claim number.

*Claim 10* — This claim refers to two independent claims in the alternative. A numeral “2” is, therefore, placed in the “Dep.” column opposite claim 10.

*Claim 11* — Claim 11 is a dependent claim which refers to two claims in the conjunctive (“1” *and* “9”) rather than in the alternative (“1” *or* “9”). This form is improper under [35 U.S.C. 112](#) and [37 CFR 1.75\(c\)](#). Accordingly, since claim 11 is improper, an encircled number “1” is placed in the “Dep.” column opposite Claim 11.

## ii) Calculation of Fee in Fee Example

After the number of “Ind.” and “Dep.” claims are noted on form PTO/SB/07, each column is added. In this example, there are 2 independent claims and 13 dependent claims or a total of 15 claims. The number of independent and total claims can then be placed on form PTO/SB/06 and the fee calculated.

## II. INITIAL TREATMENT OF DEPENDENT CLAIMS

The initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. The initial acceptance of a claim as a dependent claim does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim.

## III. TEST FOR PROPER DEPENDENCY

In accordance with [35 U.S.C. 112\(d\)](#), or [pre-AIA 35 U.S.C. 112, fourth paragraph](#), a claim in dependent form shall contain:

- (i) a reference to a claim previously set forth, and
- (ii) then specify a further limitation of the subject matter claimed.

A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Following the statute, the test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends and specify a further limitation of the subject matter

claimed. For example, if claim 1 recites the combination of elements A, B, C, and D, a claim reciting the structure of claim 1 in which D was omitted or replaced by E would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements. A dependent claim does not lack compliance with [35 U.S.C. 112\(d\)](#) simply because there is a question as to the significance of the further limitation added by the dependent claim.

The fact that a dependent claim, which is otherwise proper might relate to a separate invention that would require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it further specifies limitations relating to the method of making the product of claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product can be made by a method other than that recited in the base method claim, and thus, does not include the limitations of the base claim.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

When examining a dependent claim, the examiner should determine whether the claim complies with [35 U.S.C. 112\(d\)](#), which requires that dependent claims contain a reference to a previous claim in the same application, specify a further limitation of the subject matter claimed, and include all the limitations of the previous claim. If the dependent claim does not comply with the requirements of [35 U.S.C.](#)

[112\(d\)](#), the examiner should reject the dependent claim under [35 U.S.C. 112\(d\)](#) as unpatentable rather than objecting to the claim. See *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284, 1291-92, 79 USPQ2d 1583, 1589-90 (Fed. Cir. 2006) (holding a dependent claim in a patent invalid for failure to comply with [pre-AIA 35 U.S.C. 112, fourth paragraph](#) (now [35 U.S.C. 112\(d\)](#))). Although the requirements of [35 U.S.C. 112\(d\)](#) are related to matters of form, non-compliance with [35 U.S.C. 112\(d\)](#) renders the claim unpatentable just as non-compliance with other paragraphs of [35 U.S.C. 112](#) would. For example, a dependent claim must be rejected under [35 U.S.C. 112\(d\)](#) if it omits an element from the claim upon which it depends or it fails to add a limitation to the claim upon which it depends.

Claims which are in improper dependent form for failing to further limit the subject matter of a previous claim, or for not including every limitation of the claim from which it depends, should be rejected under [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112, fourth paragraph](#) by using form paragraphs 7.36 and 7.36.01.

**¶ 7.36 Statement of Statutory Basis, 35 U.S.C. 112(d) and Pre-AIA 35 U.S.C. 112, Fourth Paragraph**

The following is a quotation of [35 U.S.C. 112\(d\)](#):

(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The following is a quotation of [pre-AIA 35 U.S.C. 112](#), fourth paragraph:

Subject to the following paragraph [i.e., the fifth paragraph of pre-AIA 35 U.S.C. 112], a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

**Examiner Note:**

1. The statute is no longer being recited in all Office actions. It is only required in first actions on the merits and final rejections. Where the statute is not being cited in an action on the merits, use paragraph 7.103.

2. Form paragraph 7.36 is to be used ONLY ONCE in a given Office action.

**¶ 7.36.01 Rejection under 35 U.S.C. 112(d) or pre-AIA 35 U.S.C. 112, 4th Paragraph, Improper Dependent Claim**

Claim [1] rejected under [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112, 4th paragraph](#), as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends. [2]. Applicant may cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, rewrite the claim(s) in independent form, or present a sufficient showing that the dependent claim(s) complies with the statutory requirements.

**Examiner Note:**

1. In bracket 2, insert an explanation of what is in the claim and why it does not constitute a further limitation.

2. The U.S. Court of Appeals for the Federal Circuit indicated that although the requirements of [pre-AIA 35 U.S.C. 112, 4th paragraph](#), are related to matters of form, non-compliance with [pre-AIA 35 U.S.C. 112, 4th paragraph](#), renders the claim unpatentable just as non-compliance with other paragraphs of [35 U.S.C. 112](#) would. See *Pfizer, Inc. v. Ranbaxy Labs., Ltd.*, 457 F.3d 1284, 1291-92, 79 USPQ2d 1583, 1589-90 (Fed. Cir. 2006) (holding a dependent claim in a patent invalid for failure to comply with [pre-AIA 35 U.S.C. 112, 4th paragraph](#)). Therefore, if a dependent claim does not comply with the requirements of [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112, 4th paragraph](#), the dependent claim should be rejected under [35 U.S.C. 112\(d\)](#) or [pre-AIA 35 U.S.C. 112, 4th paragraph](#), as unpatentable rather than objecting to the claim.

3. This form paragraph must be preceded by form paragraph 7.36.

**IV. CLAIM FORM AND ARRANGEMENT**

A singular dependent claim 2 could read as follows:

2. The product of claim 1 in which . . . .

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said “dependent claim.” It should be kept in mind that a dependent claim may refer back to any preceding independent claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant’s sequence should not be changed. See [MPEP](#)

[§ 608.01\(j\)](#). Applicant may be so advised by using form paragraph 6.18.

#### ¶ 6.18 Series of Singular Dependent Claims

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See [MPEP § 608.01\(n\)](#).

During prosecution, the order of claims may change and be in conflict with the requirement that dependent claims refer to a preceding claim. Accordingly, the numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

## V. REJECTION AND OBJECTION

If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be objected to rather than rejected, if it is otherwise allowable.

Form paragraph 7.43 can be used to state the objection.

#### ¶ 7.43 Objection to Claims, Allowable Subject Matter

Claim [1] objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### 608.01(o) Basis for Claim Terminology in Description [R-07.2015]

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special

meaning in the description. See [MPEP § 2111.01](#) and [§ 2173.05\(a\)](#).

Usually the terminology of the claims present on the filing date of the application follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims, including claims first presented after the application filing date where no claims were submitted on filing, and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. See [37 CFR 1.75](#), [MPEP § 608.01\(i\)](#) and [§ 1302.01](#) and [§ 2103](#). Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see [37 CFR 1.75\(d\)\(1\)](#). If the examiner determines that the claims presented late in prosecution do not comply with [37 CFR 1.75\(d\)\(1\)](#), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

The specification should be objected to if it does not provide proper antecedent basis for the claims by using form paragraph 7.44.

#### ¶ 7.44 Claimed Subject Matter Not in Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See [37 CFR 1.75\(d\)\(1\)](#) and [MPEP § 608.01\(o\)](#). Correction of the following is required: [1]

## 608.01(p) Completeness of Specification [R-07.2022]

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in [MPEP § 702.01](#).

The contents of an application, to be complete, must include a specification containing a written description of the invention using such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. See [35 U.S.C. 112](#). At least one specific operative embodiment or example of the invention must be set forth. The example(s) and description should be of sufficient scope as to justify the scope of the claims.

For the written description requirement, an applicant's specification must reasonably convey to those skilled in the art that the applicant was in possession of the claimed invention as of the date of invention. See [MPEP § 2163](#) *et seq.* for further guidance with respect to the evaluation of a patent application for compliance with the written description requirement.

An applicant's specification must enable a person skilled in the art to make and use the claimed invention without undue experimentation. The fact that experimentation is complex, however, will not make it undue if a person of skill in the art typically engages in such complex experimentation. See [MPEP § 2164](#) *et seq.* for detailed guidance with regard to the enablement requirement of [35 U.S.C. 112](#).

See also [MPEP § 2161.01](#) regarding computer programming and [35 U.S.C. 112](#); and [MPEP § 2181](#) and [§ 2185](#) regarding [35 U.S.C. 112](#) in the context of functional claims.

The specification should include a statement which identifies a specific and substantial credible utility for the claimed invention. This usually presents no problem in mechanical or electrical cases. Questions regarding compliance with the utility requirement

arise more often in biotechnological or chemical cases.

For “Guidelines For Examination Of Applications For Compliance With The Utility Requirement of [35 U.S.C. 101](#),” see [MPEP § 2107](#).

For “General Principles Governing Utility Rejections,” see [MPEP § 2107.01](#).

For a discussion of the utility requirement under [35 U.S.C. 111\(a\)](#) in drug cases, see [MPEP § 2107.03](#) and [§ 2164.06\(a\)](#).

For “Procedural Considerations Related to Rejections for Lack of Utility,” see [MPEP § 2107.02](#).

For “Special Considerations for Asserted Therapeutic or Pharmacological Utilities,” see [MPEP § 2107.03](#).

### I. INCORPORATION BY REFERENCE

#### *37 CFR 1.57 Incorporation by reference.*

*[Editor Note: Paragraph (a) below is only applicable to patent applications filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013.]*

(a) Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with [§ 1.76](#) upon the filing of an application under [35 U.S.C. 111\(a\)](#) to a previously filed application, indicating that the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under [35 U.S.C. 111\(a\)](#) for purposes of a filing date under [§ 1.53\(b\)](#).

(1) If the applicant has provided a correspondence address ([§ 1.33\(a\)](#)), the applicant will be notified and given a period of time within which to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by [§ 1.17\(i\)](#) if it is in a language other than English, and pay the surcharge required by [§ 1.16\(f\)](#), to avoid abandonment. Such a notice may be combined with a notice under [§ 1.53\(f\)](#).

(2) If the applicant has not provided a correspondence address ([§ 1.33\(a\)](#)), the applicant has three months from the filing date of the application to file a copy of the specification and drawings from the previously filed application, an English language translation of the previously filed application, and the fee required by [§ 1.17\(i\)](#) if it is in a language other than English,



and pay the surcharge required by [§ 1.16\(f\)](#), to avoid abandonment.

(3) An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:

(i) The application is revived under [§ 1.137](#); and

(ii) A copy of the specification and any drawings of the previously filed application are filed in the Office.

(4) A certified copy of the previously filed application must be filed in the Office, unless the previously filed application is an application filed under [35 U.S.C. 111](#) or [363](#), or the previously filed application is a foreign priority application and the conditions set forth in [§ 1.55\(i\)](#) are satisfied with respect to such foreign priority application. The certified copy of the previously filed application, if required by this paragraph, must be filed within the later of four months from the filing date of the application or sixteen months from the filing date of the previously filed application, or be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in [§ 1.17\(g\)](#).

(b) 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, international application, or international design 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 paragraph (b)(1) of this section 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 under this section 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. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to [PCT Rule 20.8\(b\)](#), must be submitted in accordance with [PCT Rule 20](#).

(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 [§ 1.53\(e\)](#) accompanied by the fee set forth in [§ 1.17\(f\)](#).

(4) Any amendment to an international design application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

(c) Except as provided in paragraphs (a) or (b) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (e.g., “incorporate by reference”); and

(2) Clearly identify the referenced patent, application, or publication.

(d) “Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material” is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by [35 U.S.C. 112\(a\)](#);

(2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by [35 U.S.C. 112\(b\)](#); or

(3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by [35 U.S.C. 112\(f\)](#).

(e) Other material (“Nonessential material”) may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

(f) The examiner may require the applicant to supply a copy of the material incorporated by reference. If the Office requires the applicant to supply a copy of material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

(g) Any insertion of material incorporated by reference into the specification or drawings of an application must be by way of an amendment to the specification or drawings. Such an amendment must be accompanied by a statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

(h) An incorporation of material by reference that does not comply with paragraphs (c), (d), or (e) of this section is not effective to incorporate such material unless corrected 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. In addition:

(1) A correction to comply with paragraph (c)(1) of this section is permitted only if the application as filed clearly conveys an intent to incorporate the material by reference. A mere reference to material does not convey an intent to incorporate the material by reference.

(2) A correction to comply with paragraph (c)(2) of this section is only permitted for material that was sufficiently described to uniquely identify the document.

(i) An application transmittal letter limited to the transmittal of a copy of the specification and drawings from a previously filed application submitted under paragraph (a) or (b) of this section may be signed by a juristic applicant or patent owner.

The Director has considerable discretion in determining what may or may not be incorporated by reference in a patent application. *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968). In 2004, the Office codified in [37 CFR 1.57\(b\)–\(g\)](#) existing practice with respect to explicit incorporations by reference with a few changes to reflect the eighteen-month publication of applications. In addition, in 2004, [37 CFR 1.57\(a\)](#) was added 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 inadvertently omitted from an application, such as through a clerical error. In 2013, the Office moved the provisions of former [37 CFR 1.57\(a\)](#) to [37 CFR 1.57\(b\)](#) in order to provide for reference filing in [37 CFR 1.57\(a\)](#), which is a new procedure provided by the implementation of section 201(a) of the Patent Law Treaties Implementation Act of 2012 (PLTIA) (Public Law 112-211). [37 CFR 1.57\(b\)](#) permits 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 a prior-filed application (for which priority/benefit is claimed) even though there is no explicit incorporation by reference of the prior-filed

application. See [MPEP § 217](#) for discussion regarding [37 CFR 1.57\(b\)](#).

As mentioned above, [37 CFR 1.57](#) was revised, effective December 18, 2013, to implement the reference filing provisions in title II of the PLTIA, which amended the patent laws in accordance with the Patent Law Treaty. As provided in [35 U.S.C. 111\(c\)](#), as amended by the PLTIA, a nonprovisional application filed under [35 U.S.C. 111\(a\)](#) on or after December 18, 2013, may be filed by a reference to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. See [MPEP § 601.01\(a\)](#), subsection III, for information on the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under [35 U.S.C. 111\(a\)](#) to a previously filed application shall constitute the specification and any drawings of the subsequent application for purposes of a filing date.

The incorporation by reference practice with respect to applications which issue as U.S. patents provides the public with a patent disclosure which minimizes the public's burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The following is the manner in which the Director has elected to exercise that discretion. Section A provides the guidance for incorporation by reference in applications which are to issue as U.S. patents. Section B provides guidance for incorporation by reference in benefit applications; i.e., those domestic ([35 U.S.C. 120](#)) or foreign ([35 U.S.C. 119\(a\)](#)) applications relied on to establish an earlier effective filing date. See [MPEP § 2181](#) for the impact of incorporation by reference on the determination of whether applicant has complied with the requirements of [35 U.S.C. 112\(b\)](#) when [35 U.S.C. 112\(f\)](#) is invoked.

#### ***A. Review of Applications Which Are To Issue as Patents***

An application as filed must be complete in itself in order to comply with [35 U.S.C. 112](#). Material

nevertheless may be incorporated by reference. An application for a patent when filed may incorporate “essential material” by reference to (1) a U.S. patent, or (2) a U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. See [37 CFR 1.57\(d\)](#).

“Essential material” is defined in [37 CFR 1.57\(d\)](#) as that which is necessary to (1) provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by [35 U.S.C. 112\(a\)](#); (2) describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by [35 U.S.C. 112\(b\)](#); or (3) describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by [35 U.S.C. 112\(f\)](#). In any application that is to issue as a U.S. patent, essential material may only be incorporated by reference to a U.S. patent or patent application publication.

Other material (“nonessential subject matter”) may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior and concurrently filed, commonly owned U.S. applications, or (3) non-patent publications. Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art. See [37 CFR 1.57\(e\)](#).

An incorporation by reference by hyperlink or other form of browser executable code is not permitted. See [37 CFR 1.57\(e\)](#) and [MPEP § 608.01](#).

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](#). *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). [37 CFR 1.57\(c\)\(1\)](#) limits a proper incorporation by reference (except as

provided in [37 CFR 1.57\(b\)](#)) to instances only where the perfecting words “incorporated by reference” or the root of the words “incorporate” (e.g., incorporating, incorporated) and “reference” (e.g., referencing) appear. The requirement for specific root words will bring greater clarity to the record and provide a bright line test as to where something is being referred to is an incorporation by reference. The Office intends to treat references to documents that do not meet this “bright line” test as noncompliant incorporations by reference and may require correction pursuant to [37 CFR 1.57\(h\)](#). If a reference to a document does not clearly indicate an intended incorporation by reference, examination will proceed as if no incorporation by reference statement has been made and the Office will not expend resources trying to determine if an incorporation by reference was intended. In addition to other requirements for an application, the referencing application must include an identification of the referenced patent, application, or publication. See [37 CFR 1.57\(c\)\(2\)](#). Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. Guidelines for situations where applicant is permitted to fill in a number for Application No. \_\_\_\_\_ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971) (Abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent.). See [37 CFR 1.14\(a\)\(i\), \(iv\), and \(vi\)](#), and [MPEP § 103](#).

### 1. Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be canceled by amendment and may be substituted by reference to a U.S. patent or a U.S. patent application publication. The amendment must be accompanied by a statement signed by the applicant, or a practitioner representing the applicant, stating that the material canceled from the application is the same material that has been incorporated by reference and no new matter has been included (see [37 CFR 1.57\(g\)](#)). The same procedure is available for nonessential material.

If an application as filed incorporates material by reference, a copy of the incorporated by reference material may be required to be submitted to the Office even if the material is properly incorporated by reference. The examiner may require a copy of the incorporated material to review and to understand what is being incorporated or to put the description of the material in its proper context. Another instance where a copy of the incorporated material may be required is where the material is being inserted by amendment into the body of the application to replace an improper incorporation by reference statement so that the Office can determine that the material being added by amendment in lieu of the incorporation is the same material as was attempted to be incorporated. If the Office requires the applicant to supply a copy of the material incorporated by reference, the material must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application. See [37 CFR 1.57\(f\)](#).

## 2. Improper Incorporation

[37 CFR 1.57\(g\)](#) addresses corrections of incorporation by reference by inserting the material previously incorporated by reference. A noncompliant incorporation by reference statement may be corrected by an amendment. [37 CFR 1.57\(g\)](#). However, the amendment must not include new matter. Incorporating by reference material that was not incorporated by reference on filing of an application may introduce new matter. An incorporation by reference of essential material to an unpublished U.S. patent application, a foreign application or patent, or to a publication is improper under [37 CFR 1.57\(d\)](#). The improper incorporation by reference is not effective to incorporate the material unless corrected by the applicant ([37 CFR 1.57\(h\)](#)). Any underlying objection or rejection (e.g., under [35 U.S.C. 112](#)) should be made by the examiner until applicant corrects the improper incorporation by reference by submitting an amendment to amend the specification or drawings to include the material incorporated by reference. A statement that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter is also required. [37 CFR 1.57\(g\)](#). See also *In re Hawkins*,

486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Improper incorporation by reference statements and late corrections thereof require expenditure of unnecessary examination resources and slow the prosecution process. Applicants know (or should know) whether they want material incorporated by reference, and must timely correct any incorporation by reference errors. Correction must be done within the time period set forth in [37 CFR 1.57\(h\)](#).

An incorporation by reference that does not comply with [37 CFR 1.57\(c\), \(d\), or \(e\)](#) is not effective to incorporate such material unless corrected within any time period set by the Office (should the noncompliant incorporation by reference be first noticed by the Office and applicant informed thereof), but in no case later than the close of prosecution as defined by [37 CFR 1.114\(b\)](#) (should applicant be the first to notice the noncompliant incorporation by reference and the Office informed thereof), or abandonment of the application, whichever occurs earlier. The phrase “or abandonment of the application” is included in [37 CFR 1.57\(h\)](#) to address the situations where an application is abandoned prior to the close of prosecution, e.g., the situation where an application is abandoned after a non-final Office action.

[37 CFR 1.57\(h\)\(1\)](#) authorizes the correction of noncompliant incorporation by reference statements that do not use the root of the words “incorporate” and “reference” in the incorporation by reference statement when the application as filed clearly conveys an intent to incorporate the material by reference. This correction can usually be made, for example, when an originally filed claim of an application identifies an amino acid or nucleotide sequence by database accession number. In making the determination of clear intent the examiner should consider the language used in referencing the sequence, the context in which it is disclosed, and any additional arguments or evidence presented by applicants.

[37 CFR 1.57\(h\)\(2\)](#) states that a citation of a document can be corrected where the document is sufficiently described to uniquely identify the



document. Correction of a citation for a document that cannot be identified as the incorporated document may be new matter and is not authorized by [37 CFR 1.57\(h\)\(2\)](#). An example would be where applicant intended to incorporate a particular journal article but supplied the citation information for a completely unrelated book by a different author, and there is no other information to identify the correct journal article. Since it cannot be determined from the citation originally supplied what article was intended to be incorporated, it would be improper (e.g., new matter) to replace the original incorporation by reference with the intended incorporation by reference. A citation of a patent application by attorney docket number, inventor name, filing date and title of invention may sufficiently describe the document, but even then correction should be made to specify the application number.

A petition under [37 CFR 1.183](#) to suspend the time period requirement set forth in [37 CFR 1.57\(h\)](#) will not be appropriate. After the application has been abandoned, applicant must file a petition to revive under [37 CFR 1.137](#) for the purpose of correcting the incorporation by reference. After the application has issued as a patent, applicant may correct the patent by filing a reissue application. Correcting an improper incorporation by reference with a certificate of correction is not an appropriate means of correction because it may alter the scope of the claims. The scope of the claims may be altered because [37 CFR 1.57\(h\)](#) provides that an incorporation by reference that does not comply with paragraph (c), (d), or (e) is not an effective incorporation. For example, an equivalent means omitted from a patent disclosure by an ineffective incorporation by reference would be outside the scope of the patented claims. Hence, a correction of an incorporation by reference pursuant to [37 CFR 1.57](#) may alter the scope of the claims by adding the omitted equivalent means. Changes involving the scope of the claims should be done via the reissue process. Additionally, the availability of the reissue process for corrections would make a successful showing required under [37 CFR 1.183](#) unlikely. The following examples show when an improper incorporation by reference is required to be corrected:

#### Example 1:

Upon review of the specification, the examiner noticed that the specification included an incorporation by reference statement incorporating essential material disclosed in a foreign patent. In a non-final Office action, the examiner required the applicant to amend the specification to include the essential material.

In reply to the non-final Office action, applicant must correct the improper incorporation by reference by filing an amendment to add the essential material disclosed in the foreign patent and a statement in compliance with [37 CFR 1.57\(g\)](#) within the time period for reply set forth in the non-final Office action.

#### Example 2:

Upon review of the specification, the examiner determined that the subject matter incorporated by reference from a foreign patent was “nonessential material” and therefore, did not object to the incorporation by reference. In reply to a non-final Office action, applicant filed an amendment to the claims to add a new limitation that was supported only by the foreign patent. The amendment filed by the applicant caused the examiner to re-determine that the incorporated subject matter was “essential material” under [37 CFR 1.57\(d\)](#). The examiner rejected the claims that include the new limitation under [35 U.S.C. 112\(a\)](#) in a final Office action.

Since the rejection under [35 U.S.C. 112\(a\)](#) was necessitated by the applicant’s amendment, the finality of the Office action is proper. If the applicant wishes to overcome the rejection under [35 U.S.C. 112\(a\)](#) by filing an amendment under [37 CFR 1.57\(g\)](#) to add the subject material disclosed in the foreign patent into the specification, applicant may file the amendment as an after final amendment in compliance with [37 CFR 1.116](#). Alternatively, applicant may file an RCE under [37 CFR 1.114](#) accompanied by the appropriate fee, and an amendment per [37 CFR 1.57\(g\)](#) within the time period for reply set forth in the final Office action.

The following form paragraphs may be used:

#### ¶ 6.19 Incorporation by Reference, Unpublished U.S. Application, Foreign Patent or Application, Publication

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. [37 CFR 1.57\(g\)](#).

#### Examiner Note:

Since the material that applicant is attempting to incorporate in the specification is considered to be essential material, an appropriate objection to the specification under [35 U.S.C. 132](#)



and/or rejection of the claim(s) under [35 U.S.C. 112](#), should be made. One or more of form paragraphs 7.31.01 to 7.31.04, as for example, should be used following this form paragraph.

#### ¶ 6.19.01 Ineffective Incorporation by Reference, General

The attempt to incorporate subject matter into this application by reference to [1] is ineffective because [2].

##### Examiner Note:

1. In bracket 1, identify the document such as an application or patent number or other identification.
2. In bracket 2, give reason(s) why it is ineffective (e.g., the root words “incorporate” and/or “reference” have been omitted, see [37 CFR 1.57\(c\)\(1\)](#); the reference document is not clearly identified as required by [37 CFR 1.57\(c\)\(2\)](#)).
3. This form paragraph should be followed by form paragraph 6.19.03.

#### ¶ 6.19.03 Correction of Ineffective Incorporation by Reference

The incorporation by reference will not be effective until correction is made to comply with [37 CFR 1.57\(c\), \(d\), or \(e\)](#). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective. Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in [37 CFR 1.114\(b\)](#), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. [37 CFR 1.57\(g\)](#).

The filing date of any application wherein essential material is improperly incorporated by reference will not be affected by applicant’s correction where (A) there is a clear intent to incorporate by reference the intended material and the correction is to add the root words of “incorporate” and “reference,” (B) the incorporated document can be uniquely identified and the correction is to clarify the document’s identification, and (C) where the correction is to insert the material from the reference where incorporation is to an unpublished U.S. patent application, foreign application or patent, or to a publication.

Reliance on a commonly assigned, prior filed or concurrently filed copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure provided the incorporated material is directed to nonessential material. See [37 CFR 1.57\(e\)](#). See *In re Fried*, 329 F.2d 323, 141 USPQ 27 (CCPA 1964), and *General Electric Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335 (D.C. Cir. 1968).

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied on to establish a constructive reduction to practice or an enabling disclosure as of the filing date. *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Glass*, 492 F.2d 1228, 181 USPQ 31 (CCPA 1974).

#### ***B. Review of Applications Which Are Relied on To Establish an Earlier Effective Filing Date***

The limitations on the material which may be incorporated by reference in U.S. patent applications which are to issue as U.S. patents do not apply to applications relied on only to establish an earlier effective filing date under [35 U.S.C. 119](#) or [35 U.S.C. 120](#). Neither [35 U.S.C. 119\(a\)](#) nor [35 U.S.C. 120](#) places any restrictions or limitations as to how the claimed invention must be disclosed in the earlier application to comply with [35 U.S.C. 112\(a\)](#). Accordingly, an application is entitled to rely upon the filing date of an earlier application, even if the earlier application itself incorporates essential material by reference to another document. See *Ex parte Maziere*, 27 USPQ2d 1705, 1706-07 (Bd. Pat. App. & Inter. 1993).

The reason for incorporation by reference practice with respect to applications which are to issue as U.S. patents is to provide the public with a patent disclosure which minimizes the public’s burden to search for and obtain copies of documents incorporated by reference which may not be readily available. Through the Office’s incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The same policy concern does not apply where the sole purpose for which an applicant relies on an

earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates “essential material” by reference, or (4) a foreign application, is not critical in the case of a “benefit” application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by [35 U.S.C. 112\(a\)](#) so that benefit may be accorded. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

As a safeguard against the omission of a portion of a prior application for which priority is claimed under [35 U.S.C. 119\(a\)-\(d\) or \(f\)](#), or for which benefit is claimed under [35 U.S.C. 119\(e\) or 120](#), applicant may include a statement at the time of filing of the later application incorporating by reference the prior application. See [MPEP § 201.06\(c\)](#) and [211 et seq.](#) where domestic benefit is claimed. See [MPEP §§ 213 - 216](#) where foreign priority is claimed. See [MPEP § 217](#) regarding [37 CFR 1.57\(b\)](#). The inclusion of such an incorporation by reference statement in the later-filed application will permit applicant to include subject matter from the prior application into the later-filed application without the subject matter being considered as new matter. For the incorporation by reference to be effective as a proper safeguard, the incorporation by reference statement must be filed at the time of filing of the later-filed application. 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\(a\)](#)). Although, as discussed above, an incorporation by reference statement can be used as a safeguard against an omission of a portion of a prior application for which priority is claimed under [35 U.S.C. 119\(a\)-\(d\) or \(f\)](#), or for which benefit is claimed under [35 U.S.C. 119\(e\) or 120](#), it should be noted that an incorporation by reference statement will not satisfy the specific reference requirement of [35 U.S.C. 119\(e\) or 120 or 37 CFR 1.78](#). See *Droplets, Inc. v. E\*TRADE Bank*, 887 F.3d 1309, 126 USPQ2d 317 (Fed. Cir. 2018).

## II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense. *Hoffman-La Roche, Inc. v. Promega Corp.*, 323 F.3d 1354, 1367, 66 USPQ2d 1385, 1394 (Fed. Cir. 2003). For further guidance, see “*Properly Presenting Prophetic and Working Examples in a Patent Application*,” 86 FR 35074 (July 1, 2021).

For problems arising from the designation of materials by trademarks and trade names, see [MPEP § 608.01\(v\)](#).

### 608.01(q) Substitute or Rewritten Specification [R-07.2015]

#### *37 CFR 1.125 Substitute specification.*

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) Subject to [§ 1.312](#), a substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by a statement that the substitute specification includes no new matter.

(c) A substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form paragraph 6.28 may be used where the specification is in faulty English.

#### ¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with [37 CFR 1.52\(a\)](#) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

[37 CFR 1.125\(a\)](#) applies to a substitute specification required by the Office. If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof be rewritten. Note that legibility includes ability to be photocopied and scanned so that suitable reprints can be made and papers can be electronically reproduced by use of digital imaging and optical character recognition. See [MPEP § 608.01](#).

Form paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

#### ¶ 6.28.01 Substitute Specification Required by Examiner

A substitute specification [1] the claims is required pursuant to [37 CFR 1.125\(a\)](#) because [2].

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version

of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strikethrough except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

#### Examiner Note:

1. In bracket 1, insert either --excluding-- or --including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, [37 CFR 1.125](#).
4. See also form paragraph 13.01 for partial rewritten specification.

[37 CFR 1.125\(b\)](#) applies to a substitute specification voluntarily filed by the applicant. Subject to the provisions of [37 CFR 1.312](#), a substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by a statement that the substitute specification includes no new matter. The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of [37 CFR 1.125\(b\)](#) are satisfied.

[37 CFR 1.125\(c\)](#) requires a substitute specification filed under [37 CFR 1.125\(a\)](#) or (b) be submitted in clean form without markings. A marked-up copy of the substitute specification showing all the changes relative to the immediate prior version of the specification of record must also be submitted. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Numbering the paragraphs of the specification of record is not considered a change that must be shown under [37 CFR 1.125\(c\)](#). The paragraphs of any substitute specification, other than the claims, should be individually numbered in

Arabic numerals (for example [0001]) so that any amendment to the specification may be made by replacement paragraph in accordance with [37 CFR 1.121\(b\)\(1\)](#).

A substitute specification filed under [37 CFR 1.125\(b\)](#) must be accompanied by a statement indicating that no new matter was included. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether new matter has been added. If, however, an examiner becomes aware that new matter is present, an objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. [37 CFR 1.125\(d\)](#).

A substitute specification which complies with [37 CFR 1.125](#) should normally be entered. A substitute specification which is denied entry should be so marked.

Form paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under [37 CFR 1.125\(b\)](#) has not been entered.

¶ **6.28.02 Substitute Specification Filed Under 37 CFR 1.125(b) and (c) Not Entered.**

The substitute specification filed [1] has not been entered because it does not conform to [37 CFR 1.125\(b\)](#) and (c) because: [2]

**Examiner Note:**

1. In bracket 2, insert statement of why the substitute specification is improper, for example: -- the statement as to a lack of new matter under [37 CFR 1.125\(b\)](#) is missing--, -- a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--; -- a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--; or, -- the substitute specification has been filed: - in a reissue application or in a reexamination proceeding, [37 CFR 1.125\(d\)](#)-, or - after payment of the issue fee-, or - containing claims (to be amended)- --.

2. A substitute specification filed after final action or appeal (prior to the date an appeal brief is filed pursuant to [37 CFR](#)

[41.37](#), see [37 CFR 41.33\(a\)](#)) is governed by [37 CFR 1.116](#). A substitute specification filed after the mailing of a notice of allowance is governed by [37 CFR 1.312](#).

See [MPEP § 714.20](#) regarding entry of amendments which include an unacceptable substitute specification.

For new matter in amendment, see [MPEP § 608.04](#).

For application prepared for issue, see [MPEP § 1302.02](#).

**608.01(r) Derogatory Remarks About Prior Art in Specification [R-08.2012]**

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, *per se*.

**608.01(s) Restoration of Canceled Matter [R-08.2012]**

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. [37 CFR 1.121\(b\)\(4\)](#). A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. [37 CFR 1.121\(c\)\(5\)](#). See [MPEP § 714](#).

**608.01(t) Use in Subsequent Application [R-10.2019]**

No part of a specification can normally be transferred to another application. Similarly, drawings cannot normally be transferred to another application See [MPEP § 608.02\(i\)](#).



**608.01(u) [Reserved]****608.01(v) Marks Used in Commerce and Trade Names [R-01.2024]****15 U.S.C. 1127 Construction and definitions; intent of chapter**

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The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

The term "trademark" includes any word, name, symbol, or device, or any combination thereof-

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof-

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term "certification mark" means any word, name, symbol, or device, or any combination thereof-

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term "collective mark" means a trademark or service mark-

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term "mark" includes any trademark, service mark, collective mark, or certification mark.

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**I. PERMISSIBLE USE IN PATENT APPLICATIONS**

A mark as defined by 15 U.S.C. 1127 (i.e., trademark, service mark, collective mark, or certification mark) or trade name may be used in a patent application to identify an article or product, service, or organization if:

(A) its meaning is established by an accompanying definition in the specification which is sufficiently descriptive, enabling, precise and definite such that a claim including the mark or trade name complies with the requirements of [35 U.S.C. 112](#), or

(B) its meaning is well-known to one skilled in the relevant art and is satisfactorily defined in the literature.

See, e.g., *United States Gypsum Co. v. National Gypsum Co.*, 74 F.3d 1209, 1214 n.6, 37 USPQ2d 1388, 1392 n. 6 (Fed. Cir. 1996). Condition (A) or (B) must be met at the time of filing of the complete application.

The relationship between a mark or trade name and the product, service, or organization it identifies is sometimes indefinite, uncertain, and arbitrary. For example, the formula or characteristics of a product may change from time to time and yet it may continue to be sold under the same mark or trade name. In patent specifications, the details of the product, service, or organization identified by a mark or trade name should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary marks or trade names which are liable to mean different things at the pleasure of the owner do not constitute such



language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

If the product, service, or organization to which a mark refers is set forth in such language that its identity is clear, examiners are authorized to permit the use of the mark if it is distinguished from common descriptive nouns by capitalization. See subsection II, below. If a mark or trade name has a fixed and definite meaning, it constitutes sufficient identification unless some specific characteristic of the product, service, or organization is involved in the invention such that further description is necessary to comply with the requirements of [35 U.S.C. 112](#). In that event, as also in those cases where the mark or trade name has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. See, e.g., *United States Gypsum Co. v. National Gypsum Co.*, 74 F.3d 1209, 1214 n.6, 37 USPQ2d 1388, 1392 n. 6 (Fed. Cir. 1996); *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941).

The matter of sufficiency of disclosure must be decided on an individual case-by-case basis. *In re Metcalfe*, 410 F.2d 1378, 161 USPQ 789 (CCPA 1969).

Where the identification of a mark or trade name is introduced by amendment, it must be restricted to the characteristics of the product, service, or organization known at the time the application was filed to avoid any question of new matter.

If proper identification of the product, service, or organization identified by a mark or a trade name is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject, on the ground of insufficient disclosure, any claims based on the identification of the product, service, or organization merely by mark or trade name. If, for example, a product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted unless such amendment would result in the introduction of new matter. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the

product as set forth in the amendment was known at the time of filing of the application.

## II. PROPRIETARY NATURE OF MARKS USED IN COMMERCE

Although the use of marks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Marks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as marks.

Examiners may conduct a search for registered marks by using Trademark Search which is available on the USPTO website to determine whether an apparent or identified mark in the patent application is a registered mark or to what particular goods a registered mark applies.

Form paragraph 6.20 may be used to inform applicant of the proprietary nature of marks used in commerce.

### ¶ 6.20 Trade Names, Trademarks, and Other Marks Used in Commerce

The use of the term [1], which is a trade name or a mark used in commerce, has been noted in this application. The term should be accompanied by the generic terminology; furthermore the term should be capitalized wherever it appears or, where appropriate, include a proper symbol indicating use in commerce such as <sup>TM</sup>, <sup>SM</sup>, or <sup>®</sup> following the term.

Although the use of trade names and marks used in commerce (i.e., trade marks, service marks, certification marks, and collective marks) are permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as commercial marks.

#### Examiner Note:

1. Capitalize each letter of the term in the bracket or, where appropriate, include a proper symbol indicating use in commerce such as <sup>TM</sup>, <sup>SM</sup>, or <sup>®</sup> following the term.
2. Examiners may conduct a search for registered marks by using Trademark Search which is available on the USPTO website to determine whether a mark identified in the patent application is a registered mark or not.

The examiner should not permit the use of language such as “the product X (a descriptive name) commonly known as Y (trade name or mark)” since such language does not bring out the fact that the latter is a trade name or mark. Language such as “the product X (a descriptive name) sold under the trademark Y” is permissible.

The use of a mark in the title of an application should be avoided as well as the use of a mark coupled with the word “type”, e.g., “Band-Aid type bandage.”

In the event that a registered mark is a “symbol or device” depicted in a drawing, either the brief description of the drawing or the detailed description of the drawing should specify that the “symbol or device” is a registered mark of Company X. The owner of a mark may be identified in the specification.

Technology Center Directors should reply to all complaint letters regarding the misuse of marks used in commerce and forward a copy of the complaint letter and reply to the Office of the Deputy Commissioner for Patents who oversees the Office of Petitions. Where a letter demonstrates the misuse of a mark in a patent application publication, the Office should, where the application is still pending, ensure that the mark is replaced by appropriate generic terminology.

## **608.01(w) Copyright and Mask Work Notices [R-11.2013]**

### ***37 CFR 1.71 Detailed description and specification of the invention***

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(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see [§ 1.84\(s\)](#). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

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### ***37 CFR 1.84 Standards for drawings***

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(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in [§ 1.71\(e\)](#) is included at the beginning (preferably as the first paragraph) of the specification.

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The U.S. Patent and Trademark Office will permit the inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, which discloses material on which copyright or mask work protection has previously been established, under the following conditions:

(A) The copyright or mask work notice must be placed adjacent to the copyright or mask work material. Therefore, the notice may appear at any appropriate portion of the patent application disclosure, including the drawing. However, if appearing in the drawing, the notice must comply with [37 CFR 1.84\(s\)](#). If placed on a drawing in conformance with these provisions, the notice will not be objected to as extraneous matter under [37 CFR 1.84](#).

(B) The content of the notice must be limited to only those elements required by law. For example, “©1983 John Doe”(17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited, and under current statutes, legally sufficient notices of copyright and mask work respectively.

(C) Inclusion of a copyright or mask work notice will be permitted only if the following authorization in [37 CFR 1.71\(e\)](#) is included at the beginning (preferably as the first paragraph) of the specification to be printed for the patent:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent disclosure, as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(D) Inclusion of a copyright or mask work notice after a Notice of Allowance has been mailed will be permitted only if the criteria of [37 CFR 1.312](#) have been satisfied.

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the U.S. Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C) above does not include the specific language “(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,...” the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with [37 CFR 1.181](#).

## 608.02 Drawing [R-01.2024]

### 35 U.S.C. 113 Drawings.

The applicant shall furnish a drawing where necessary for the understanding of the subject matter to be patented. When the nature of such subject matter admits of illustration by a drawing and the applicant has not furnished such a drawing, the

Commissioner may require its submission within a time period of not less than two months from the sending of a notice thereof. Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

### **37 CFR 1.81 Drawings required in patent application.**

[Editor Note: Para. (a) below is only applicable to patent applications filed under [35 U.S.C. 111](#) on or after December 18, 2013.]

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

### **37 CFR 1.81 (pre-PLT) Drawings required in patent application**

[Editor Note: Para. (a) below is applicable to patent applications filed before December 18, 2013.]

(a) The applicant for a patent is required to furnish a drawing of the invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

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## I. FILING DATE IN THE ABSENCE OF DRAWING

### A. Applications Filed under 35 U.S.C. 111 on or after December 18, 2013

For applications filed on or after December 18, 2013, other than design applications, [35 U.S.C. 111](#) no longer requires that an application contain a drawing where necessary for the understanding of the subject matter sought to be patented to be entitled to a filing date. [35 U.S.C. 113](#) continues to provide, however, that “[t]he applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented” and that “[d]rawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.” Thus, the absence of any drawing on the filing date of an application where a drawing is necessary for the understanding of the subject matter sought to be patented may result in an applicant not being able to obtain a patent for any claimed invention presented in the application, but except for design applications, the absence of any drawing on the filing of an application no longer raises a question as to whether the application is entitled to a filing date.

Pursuant to [35 U.S.C. 171](#), a design application (whether filed before, on, or after December 18, 2013) must be filed with any required drawing to be entitled to a filing date.

The preparation of drawings for a provisional or nonprovisional application is prudent where a drawing is necessary for the understanding of the subject matter sought to be patented, and inclusion of such drawing(s) with the application on filing will help ensure that the requirements of [35 U.S.C. 113](#) are satisfied for any such claimed invention.

### B. Applications Filed before December 18, 2013

For applications filed under [35 U.S.C. 111](#) before December 18, 2013, a drawing (where necessary for the understanding of the subject matter sought to be patented), or a high quality copy thereof, must be

filed with the application. See [pre-PLT 35 U.S.C. 111](#), [35 U.S.C. 113](#), and [pre-PLT 37 CFR 1.81](#).

In accordance with [pre-PLT 35 U.S.C. 111](#), a specification and any necessary drawing(s) are among the requirements for an application to be given a filing date. The first sentence of [35 U.S.C. 113](#) requires a drawing to be submitted where such drawing is necessary for the understanding of the invention. In this situation, the lack of a drawing renders the application incomplete and, as such, the application cannot be given a filing date until the drawing is received. The second sentence of [35 U.S.C. 113](#) addresses the situation wherein a drawing is not necessary for the understanding of the invention, but the subject matter sought to be patented admits of illustration and no drawing was submitted on filing. The lack of a drawing in this situation does not render the application incomplete but rather is treated as an informality. The examiner should require such drawings in almost all such instances. Such drawings could be required during the initial processing of the application but do not have to be furnished at the time the application is filed. The applicant is given at least two months from the date of the letter requiring drawings to submit the drawing(s).

## II. RECEIPT OF DRAWING AFTER THE FILING DATE

If the examiner discovers new matter in a substitute or additional drawing, the drawing should not be entered and the examiner should describe the new matter that resulted in non-entry in the next Office action. A new drawing without such new matter may be required if the examiner determines that a drawing is needed under [37 CFR 1.81](#) or [37 CFR 1.83](#). Form paragraph 6.37, reproduced in [MPEP § 608.02\(h\)](#), may be used. The examiner’s decision would be reviewable by filing a petition under [37 CFR 1.181](#). The Technology Center (TC) Director would decide such a petition.

## III. HANDLING OF DRAWING REQUIREMENTS UNDER THE FIRST SENTENCE OF 35 U.S.C. 113

The Office of Patent Application Processing (OPAP) will make the initial decision in all new applications as to whether a drawing is “necessary” under the



first sentence of [35 U.S.C. 113](#). A drawing will be considered necessary under the first sentence of [35 U.S.C. 113](#) in all applications where the drawing is referred to in the specification and one or more figures have been omitted.

The determination under [35 U.S.C. 113](#) (first sentence) as to when a drawing is necessary will be handled in OPAP in accordance with the following procedure. OPAP will make the initial determination as to whether drawings are required for the understanding of the subject matter of the invention. When no drawings are included in the application as filed and drawings are required, the applicant is so informed by OPAP. A filing date will not be granted if the application was filed under [35 U.S.C. 111](#) before December 18, 2013 and applicant will be notified to complete the application ([37 CFR 1.53\(e\)](#)). If a drawing is later furnished in an application filed under [35 U.S.C. 111](#) before December 18, 2013, a filing date may be granted as of the date of receipt of such drawing.

An OPAP formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date for applications, other than design applications, filed under [35 U.S.C. 111](#) on or after December 18, 2013. For applications filed before December 18, 2013 a drawing is not required for a filing date under [pre-PLT 35 U.S.C. 111](#) if the application contains:

- (A) at least one process claim including the term “process” or “method” in its introductory phrase;
- (B) at least one composition claim including the term “composition,” “compound,” “mixture” or “pharmaceutical” in its introductory phrase;
- (C) at least one claim directed to a coated article or product or to an article or product made from a particular material or composition (i.e., an article of known and conventional character (e.g., a table), coated with or made of a particular composition (e.g., a specified polymer such as polyvinyl-chloride));
- (D) at least one claim directed to a laminated article or product (i.e., a laminated article of known and conventional character (e.g., a table)); or
- (E) at least one claim directed to an article, apparatus, or system where the sole distinguishing

feature is the presence of a particular material (e.g., a hydraulic system using a particular hydraulic fluid, or a conventional packaged suture using a particular material).

For a more complete explanation about when a drawing is required, see [MPEP § 601.01\(f\)](#). For applications submitted without all of the drawings described in the specification, see [MPEP § 601.01\(g\)](#).

If an examiner determines that a filing date should not have been granted in an application filed before December 18, 2013 because it does not contain drawings, the matter should be brought to the attention of the supervisory patent examiner (SPE) for review. If the SPE decides that drawings are required to understand the subject matter of the invention, the SPE should return the application to OPAP with a typed, signed, and dated memorandum requesting cancellation of the filing date and identifying the subject matter required to be illustrated.

#### **IV. HANDLING OF DRAWING REQUIREMENTS UNDER THE SECOND SENTENCE OF 35 U.S.C. 113 - ILLUSTRATION SUBSEQUENTLY REQUIRED**

[35 U.S.C.113](#) addresses the situation wherein a drawing is not necessary for the understanding of the invention, but the subject matter sought to be patented admits of illustration by a drawing and the applicant has not furnished a drawing. The lack of a drawing in this situation is treated as an informality. A filing date will be accorded with the original presentation of the papers. The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under [37 CFR 1.81\(c\)](#). In requiring such a drawing, the examiner should clearly indicate that the requirement is made under [37 CFR 1.81\(c\)](#) which applies when the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter. Examiners making such requirements are to specifically require, as a part of the applicant’s next reply, at least an ink sketch or permanent print of any drawing in reply to the requirement, even though no allowable subject matter is yet indicated. This



will afford the examiner an early opportunity to determine the sufficiency of the illustration and the absence of new matter. See [37 CFR 1.121](#) and [37 CFR 1.81\(d\)](#). One of the following form paragraphs may be used to require a drawing:

**¶ 6.23 Subject Matter Admits of Illustration**

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under [37 CFR 1.81\(c\)](#). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#).

**Examiner Note:**

When requiring drawings before examination use form paragraph 6.23.01 with a PTOL-90 or PTO-90C form as a cover sheet.

**¶ 6.23.01 Subject Matter Admits of Illustration (No Examination of Claims)**

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under [37 CFR 1.81](#). No new matter may be introduced in the required drawing.

Applicant is given a shortened statutory period of **TWO (2) MONTHS** to submit a drawing in compliance with [37 CFR 1.81](#). Extensions of time may be obtained under the provisions of [37 CFR 1.136\(a\)](#) but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute ([35 U.S.C. 133](#)). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

**Examiner Note:**

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to lack of an illustration of the invention resulting in a lack of understanding of the claimed subject matter.
2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

Applicant should also amend the specification accordingly to refer to the new illustration at the time of submission of the drawing(s). This may obviate further correspondence where an amendment places the application in condition for allowance.

**V. DRAWING STANDARDS**

**37 CFR 1.84 Standards for drawings.**

(a) *Drawings*. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) *Black ink*. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

(2) *Color*. Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see [PCT Rule 11.13](#)). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in [§ 1.17\(h\)](#);
- (ii) One (1) set of color drawings if submitted via the USPTO patent electronic filing system, or three (3) sets of color drawings if not submitted via the USPTO patent electronic filing system; and
- (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) *Photographs*.—

(1) *Black and white*. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (*e.g.*, immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

(2) *Color photographs*. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

(c) *Identification of drawings.* Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to § 1.121(d). If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet" pursuant to § 1.121(d)(1).

(d) *Graphic forms in drawings.* Chemical or mathematical formulae, tables, and waveforms may be submitted as drawings and are subject to the same requirements as drawings. Each chemical or mathematical formula must be labeled as a separate figure, using brackets when necessary, to show that information is properly integrated. Each group of waveforms must be presented as a single figure, using a common vertical axis with time extending along the horizontal axis. Each individual waveform discussed in the specification must be identified with a separate letter designation adjacent to the vertical axis.

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

- (1) 21.0 cm. by 29.7 cm. (DIN size A4), or
- (2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two cater-corner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

(h) *Views.* The drawing must contain as many views as necessary to show the invention. The views may be plan, elevation, section, or perspective views. Detail views of portions of elements, on a larger scale if necessary, may also be used. All views of the drawing must be grouped together and arranged on the sheet(s) without wasting space, preferably in an upright position, clearly separated from one another, and must not be included in the sheets containing the specifications, claims, or abstract. Views must not be connected by projection lines and

must not contain center lines. Waveforms of electrical signals may be connected by dashed lines to show the relative timing of the waveforms.

(1) *Exploded views.* Exploded views, with the separated parts embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When an exploded view is shown in a figure which is on the same sheet as another figure, the exploded view should be placed in brackets.

(2) *Partial views.* When necessary, a view of a large machine or device in its entirety may be broken into partial views on a single sheet, or extended over several sheets if there is no loss in facility of understanding the view. Partial views drawn on separate sheets must always be capable of being linked edge to edge so that no partial view contains parts of another partial view. A smaller scale view should be included showing the whole formed by the partial views and indicating the positions of the parts shown. When a portion of a view is enlarged for magnification purposes, the view and the enlarged view must each be labeled as separate views.

(i) Where views on two or more sheets form, in effect, a single complete view, the views on the several sheets must be so arranged that the complete figure can be assembled without concealing any part of any of the views appearing on the various sheets.

(ii) A very long view may be divided into several parts placed one above the other on a single sheet. However, the relationship between the different parts must be clear and unambiguous.

(3) *Sectional views.* The plane upon which a sectional view is taken should be indicated on the view from which the section is cut by a broken line. The ends of the broken line should be designated by Arabic or Roman numerals corresponding to the view number of the sectional view, and should have arrows to indicate the direction of sight. Hatching must be used to indicate section portions of an object, and must be made by regularly spaced oblique parallel lines spaced sufficiently apart to enable the lines to be distinguished without difficulty. Hatching should not impede the clear reading of the reference characters and lead lines. If it is not possible to place reference characters outside the hatched area, the hatching may be broken off wherever reference characters are inserted. Hatching must be at a substantial angle to the surrounding axes or principal lines, preferably 45°. A cross section must be set out and drawn to show all of the materials as they are shown in the view from which the cross section was taken. The parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes, the space between strokes being chosen on the basis of the total area to be hatched. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) that is illustrated in cross section. The hatching of juxtaposed different elements must be angled in a different way. In the case of large areas, hatching may be confined to an edging drawn around the entire inside of the outline of the area to be hatched. Different types of hatching should have different conventional meanings as regards the nature of a material seen in cross section.

(4) *Alternate position.* A moved position may be shown by a broken line superimposed upon a suitable view if

this can be done without crowding; otherwise, a separate view must be used for this purpose.

(5) *Modified forms.* Modified forms of construction must be shown in separate views.

(i) *Arrangement of views.* One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

(j) *Front page view.* The drawing must contain as many views as necessary to show the invention. One of the views should be suitable for inclusion on the front page of the patent application publication and patent as the illustration of the invention. Views must not be connected by projection lines and must not contain center lines. Applicant may suggest a single view (by figure number) for inclusion on the front page of the patent application publication and patent.

(k) *Scale.* The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as “actual size” or “scale 1/2” on the drawings are not permitted since these lose their meaning with reproduction in a different format.

(l) *Character of lines, numbers, and letters.* All drawings must be made by a process which will give them satisfactory reproduction characteristics. Every line, number, and letter must be durable, clean, black (except for color drawings), sufficiently dense and dark, and uniformly thick and well-defined. The weight of all lines and letters must be heavy enough to permit adequate reproduction. This requirement applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. Lines and strokes of different thicknesses may be used in the same drawing where different thicknesses have a different meaning.

(m) *Shading.* The use of shading in views is encouraged if it aids in understanding the invention and if it does not reduce legibility. Shading is used to indicate the surface or shape of spherical, cylindrical, and conical elements of an object. Flat parts may also be lightly shaded. Such shading is preferred in the case of parts shown in perspective, but not for cross sections. See paragraph (h)(3) of this section. Spaced lines for shading are preferred. These lines must be thin, as few in number as practicable, and they must contrast with the rest of the drawings. As a substitute for shading, heavy lines on the shade side of objects can be used except where they superimpose on each other or obscure reference characters. Light should come from the upper left corner at an angle of 45°. Surface delineations should preferably be shown by proper shading. Solid black shading areas are not permitted, except when used to represent bar graphs or color.

(n) *Symbols.* Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) *Legends.* Suitable descriptive legends may be used subject to approval by the Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible.

(p) *Numbers, letters, and reference characters.*

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, *e.g.*, encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

(2) The English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas.

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

(4) The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

(5) Reference characters not mentioned in the description shall not appear in the drawings. Reference characters mentioned in the description must appear in the drawings.

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

(r) *Arrows.* Arrows may be used at the ends of lines, provided that their meaning is clear, as follows:

(1) On a lead line, a freestanding arrow to indicate the entire section towards which it points;

(2) On a lead line, an arrow touching a line to indicate the surface shown by the line looking along the direction of the arrow; or

(3) To show the direction of movement.

(s) *Copyright or Mask Work Notice.* A copyright or mask work notice may appear in the drawing, but must be placed within the sight of the drawing immediately below the figure representing the copyright or mask work material and be limited to letters having a print size of .32 cm. to .64 cm. (1/8 to 1/4 inches) high. The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe” (17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in [§ 1.71\(e\)](#) is included at the beginning (preferably as the first paragraph) of the specification.

(t) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.*

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation “FIG.” Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation “FIG.” must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

(v) *Security markings.* Authorized security markings may be placed on the drawings provided they are outside the sight, preferably centered in the top margin.

(w) *Corrections.* Any corrections on drawings submitted to the Office must be durable and permanent.

(x) *Holes.* No holes should be made by applicant in the drawing sheets.

(y) *Types of drawings.* See [§ 1.152](#) for design drawings, [§ 1.1026](#) for international design reproductions, [§ 1.165](#) for plant drawings, and [§ 1.173\(a\)\(2\)](#) for reissue drawings.

See [MPEP § 608.02\(b\)](#) for information pertaining to the acceptability of drawings. Note that good quality copies are acceptable if the lines are uniformly thick, black, and solid.

Each drawing sheet submitted after the filing date of an application must be identified as either “Replacement Sheet” or “New Sheet” so that the Office will recognize how to treat such a drawing sheet for entry into the application. See [37 CFR 1.84\(c\)](#). Corrections to drawings must be made in the form of replacement sheets labeled, in the header, “Replacement Sheet” since the Office does not release drawings for correction. See [37 CFR 1.85](#). If a marked-up copy of any amended drawing figure, including annotations indicating the changes made, is filed, such marked-up copy must be clearly labeled as “Annotated Sheet.”

Black and white drawings are permitted to be transmitted by facsimile if the drawings are being submitted after the filing date of the application. Applicants should ensure that the facsimile transmission process does not unreasonably degrade the quality of the drawings. Color drawings are not permitted to be transmitted by facsimile. See [37 CFR 1.6\(d\)\(4\)](#).

Drawings are currently accepted in two different size formats. It is, however, required that all drawing sheets in a particular application be the same size for ease of handling.

For information regarding certified copies of an application-as-filed which does not meet the sheet size/margin and quality requirements of [37 CFR 1.52](#), [1.84\(f\)](#), and [1.84\(g\)](#), see [MPEP § 608.01](#), subsection III.

For design patent drawings, [37 CFR 1.152](#), see [MPEP § 1503.02](#).

For international design reproductions, [37 CFR 1.1026](#), see [MPEP § 2920.04\(b\)](#). Note that pursuant to [37 CFR 1.1061](#), the provisions of [37 CFR 1.84](#), except for [1.84\(c\)](#), do not apply to international design applications.

For plant patent drawings, [37 CFR 1.165](#), see [MPEP § 1606](#).

For reissue application drawings, see [MPEP § 1413](#).

For correction of drawings, see [MPEP § 608.02\(p\)](#).  
For return of drawings, see [MPEP § 608.02\(y\)](#).

For amendment of drawings, [37 CFR 1.121\(d\)](#), see [MPEP § 714](#).

The filing of a divisional or continuation application under the provisions of [37 CFR 1.53\(b\)](#) does not obviate the need for acceptable drawings. See [MPEP § 608.02\(b\)](#).

See [MPEP § 601.01\(f\)](#) for treatment of design applications without drawings or applications filed prior to December 18, 2013 without drawings and [MPEP § 601.01\(g\)](#) for treatment of applications filed without all figures of drawings or applications, other than a design application, filed on or after December 18, 2013 without drawings.

## VI. DEFINITIONS

A number of different terms are used when referring to drawings in patent applications. The following definitions are used in this Manual.

*Original drawings:* The drawing submitted with the application when filed.

*Substitute drawing:* A drawing filed later than the filing date of an application. Usually submitted to replace an original drawing that was unacceptable.

*Acceptable drawing:* A drawing that is acceptable for publication of the application or issuance of the patent.

*Corrected drawing:* A drawing that includes corrections of informalities and changes approved by the examiner.

*Unacceptable drawing:* The Office no longer considers drawings as formal or informal; drawings are either acceptable or unacceptable. Drawings that do not comply with all of the form requirements of [37 CFR 1.84](#), e.g., because they are not on the proper size sheets, or the quality of the lines is poor, may be acceptable for the purposes of publication and

examination if the drawings are readable and reproducible for publication purposes. An objection will generally only be made to a drawing that does not comply with the form requirements of [37 CFR 1.84](#) if the Office is unable to reproduce the drawing or the contents of the drawing are unacceptable to the examiner.

*Plan:* This term is used to illustrate the top view.

*Elevation:* This term is used to illustrate views showing the height of objects.

## VII. BLACK AND WHITE PHOTOGRAPHS AND LINE DRAWINGS

### *37 CFR 1.84 Standards for drawings.*

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications.

(1) Black ink. Black and white drawings are normally required. India ink, or its equivalent that secures solid black lines, must be used for drawings; or

\*\*\*\*\*

(b) *Photographs.*—

(1) *Black and white.* Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable. If the subject matter of the application admits of illustration by a drawing, the examiner may require a drawing in place of the photograph. The photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent.

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### A. *Black And White Drawings*

Black and white drawings are normally required in utility patent applications. India ink, or its equivalent that secures solid black lines, must be used for drawings. See [MPEP § 608.02\(c\)](#) for information relating to the location of drawings in IFW applications.



### ***B. Black And White Photographs And Grayscale Drawings***

Black and white photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. Photographs or photomicrograph printed on sensitized paper are acceptable as drawings, in lieu of India ink drawings, as are photographic images submitted via the USPTO patent electronic filing system, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings, e.g., electrophoresis gels, blots, (e.g., immunological, western, Southern, and northern), autoradiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, metallurgical microstructures, textile fabrics, grain structures and, in a design patent application, ornamental effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning such drawings.

Black and white photographs submitted in lieu of ink drawings must comply with [37 CFR 1.84\(b\)](#). There is no requirement for a petition or petition fee, and only one set of photographs is required. See [37 CFR 1.84\(b\)\(1\)](#).

To be acceptable, such photographs must be of sufficient quality so that all details in the photographs are reproducible in the printed patent. If several photographs are used to make one sheet of drawings, the photographs must be contained on a single sheet.

See [MPEP § 608.02\(c\)](#) for information relating to the location of drawings in IFW applications. See [MPEP § 1503.02](#) for discussion of photographs used in design patent applications.

## **VIII. COLOR DRAWINGS OR COLOR PHOTOGRAPHS**

### ***37 CFR 1.84 Standards for drawings.***

(a) Drawings. There are two acceptable categories for presenting drawings in utility and design patent applications:

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(2) Color. Color drawings are permitted in design applications. Where a design application contains color drawings, the application must include the number of sets of color drawings required by paragraph (a)(2)(ii) of this section and the specification must contain the reference required by paragraph (a)(2)(iii) of this section. On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see [PCT Rule 11.13](#)). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

(i) The fee set forth in [§ 1.17\(h\)](#);

(ii) One (1) set of color drawings if submitted via the USPTO patent electronic filing system, or three (3) sets of color drawings if not submitted via the USPTO patent electronic filing system; and

(iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

(b) Photographs .

\*\*\*\*\*

(2) Color photographs. Color photographs will be accepted in utility and design patent applications if the conditions for accepting color drawings and black and white photographs have been satisfied. See paragraphs (a)(2) and (b)(1) of this section.

\*\*\*\*\*

Color drawings and color photographs are permitted in design applications without the need for a petition. However, the specification of design applications filed under [35 U.S.C. 111\(a\)](#) must include, or be amended to include, the reference to a drawing executed in color as provided for in [37 CFR 1.84\(a\)\(2\)\(iii\)](#). Note that the drawing requirements set forth in [37 CFR 1.84](#) do not apply to nonprovisional international design applications, except for those set forth in [37 CFR 1.84\(c\)](#). See [37 CFR 1.1061\(b\)](#).

Color drawings and color photographs are not accepted in utility applications filed under [35 U.S.C.](#)

[111](#) unless a petition filed under [37 CFR 1.84\(a\)\(2\)](#) or [\(b\)\(2\)](#) is granted. Color drawings and color photographs are not permitted in international applications (see [PCT Rule 11.13](#)).

Unless a petition is filed and granted, color drawings or color photographs will not be accepted in a utility patent application filed under [35 U.S.C. 111](#). The examiner must object to the color drawings or color photographs as being improper and require applicant either to cancel the drawings or to provide substitute black and white drawings.

Under [37 CFR 1.84\(a\)\(2\)](#) and [\(b\)\(2\)](#), the applicant must file a petition with fee requesting acceptance of the color drawings or color photographs. Color drawings and photographs must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color photographs may be acceptable if the conditions for accepting color drawings and black and white photographs are met. One set of color drawings or color photographs is required if submitted via the USPTO patent electronic filing system, or three sets of color drawings or color photographs are required if not submitted via the USPTO patent electronic filing system ([37 CFR 1.84\(a\)\(2\)\(ii\)](#)). The petition is decided by a Supervisory Patent Examiner. See [MPEP § 1002.02\(d\)](#).

Color photographs or color drawings will be stored in a content management system and a black and white copy thereof will be placed in the file wrapper along with a placeholder sheet. Color drawings or color photographs submitted in paper are also maintained in an artifact folder.

Where color drawings or color photographs are filed in a continuing utility application, applicant must renew the petition under [37 CFR 1.84\(a\)\(2\)](#) and [\(b\)\(2\)](#) even though a similar petition was filed in the prior application. Until the renewed petition is granted, the examiner must object to the color drawings or color photographs in the utility patent application as being improper.

Utility patents granted prior to April 18, 2023, were published in paper. The patent copies printed at that time depict the drawings in black and white only.

However, a set of color drawings or color photographs was attached to the Letters Patent. Utility patents granted on or after April 18, 2023 are issued as an electronic grant (egrant) which will include color drawings or color photographs. See [MPEP § 1309](#). Copies of any patent with color drawings or color photographs attached thereto will be provided by the U.S. Patent and Trademark Office upon special request and payment of the fee necessary to recover the actual costs associated therewith.

All issued utility patents are presented with black and white drawings or photographs in the USPTO search systems. Accordingly, the petition must also be accompanied by a proposed amendment to insert the following language as the first paragraph in the portion of the specification containing a brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

If color drawings or color photographs have been filed, but the required petition has not, form paragraph 6.24.01 may be used to notify applicant that a petition is needed.

#### **¶ 6.24.01 Color Photographs and Color Drawings, Petition Required**

Color photographs and color drawings are not accepted in utility applications unless a petition filed under [37 CFR 1.84\(a\)\(2\)](#) is granted. Any such petition must be accompanied by the appropriate fee set forth in [37 CFR 1.17\(h\)](#), one set of color drawings or color photographs, as appropriate, if submitted via the USPTO patent electronic filing system or three sets of color drawings or color photographs, as appropriate, if not submitted via the USPTO patent electronic filing system, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings and black and white photographs have been satisfied. See [37 CFR 1.84\(b\)\(2\)](#).

**Examiner Note:**

1. This form paragraph should be used only if the application contains color photographs or color drawings as the drawings required by [37 CFR 1.81](#).
2. This form paragraph should not be used in design applications.

It is anticipated that such a petition will be granted only when the U.S. Patent and Trademark Office has determined that a color drawing or color photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

It is emphasized that a decision to grant the petition should not be regarded as an indication that color drawings or color photographs are necessary to comply with a statutory requirement. In this latter respect, clearly it is desirable to file any desired color drawings or color photographs as part of the original application papers in order to avoid issues concerning statutory defects (e.g., lack of enablement under [35 U.S.C. 112](#) or new matter under [35 U.S.C. 132](#)).

See [MPEP § 608.02\(c\)](#) for information relating to the location of drawings in IFW applications.

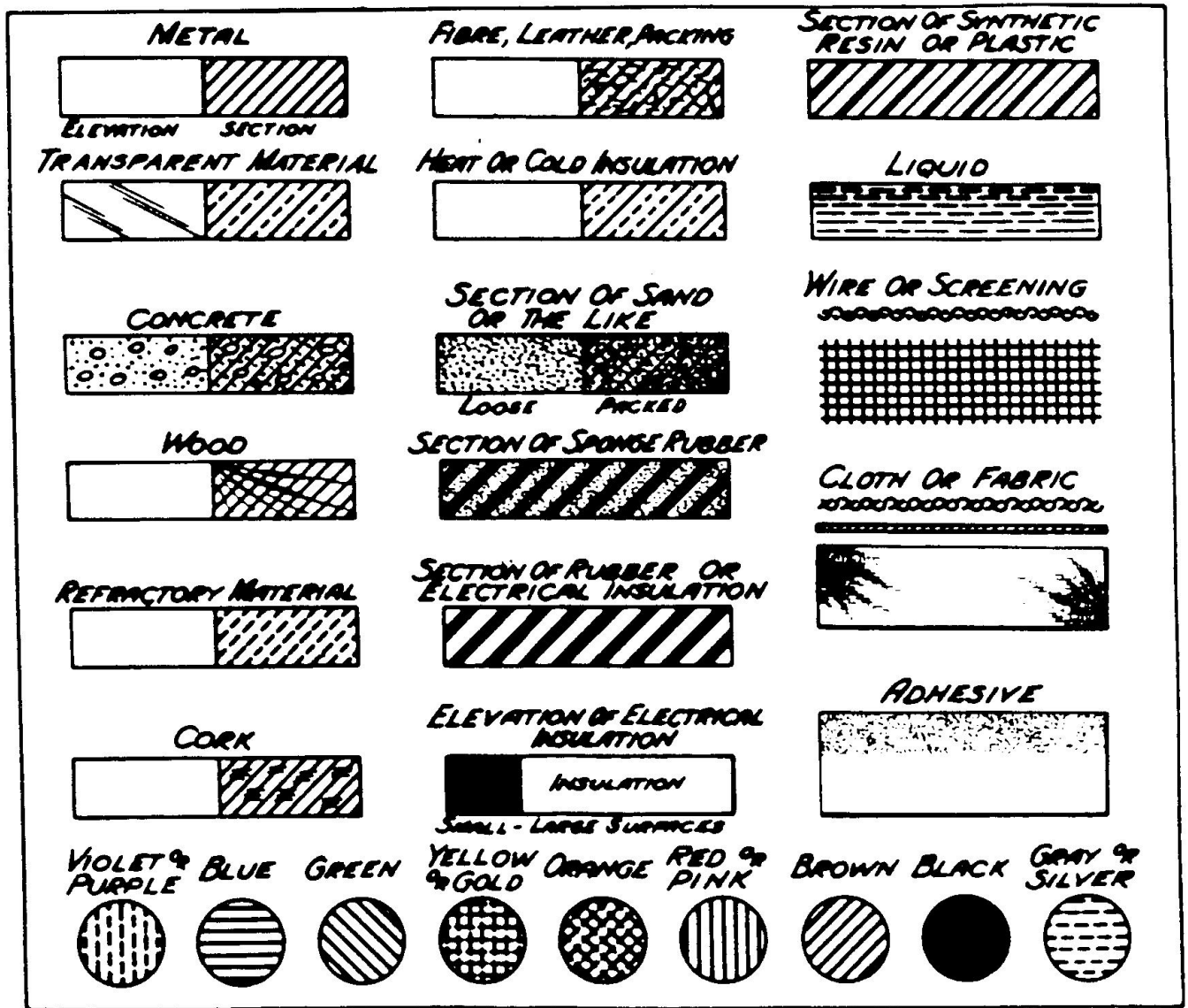
## IX. DRAWING SYMBOLS

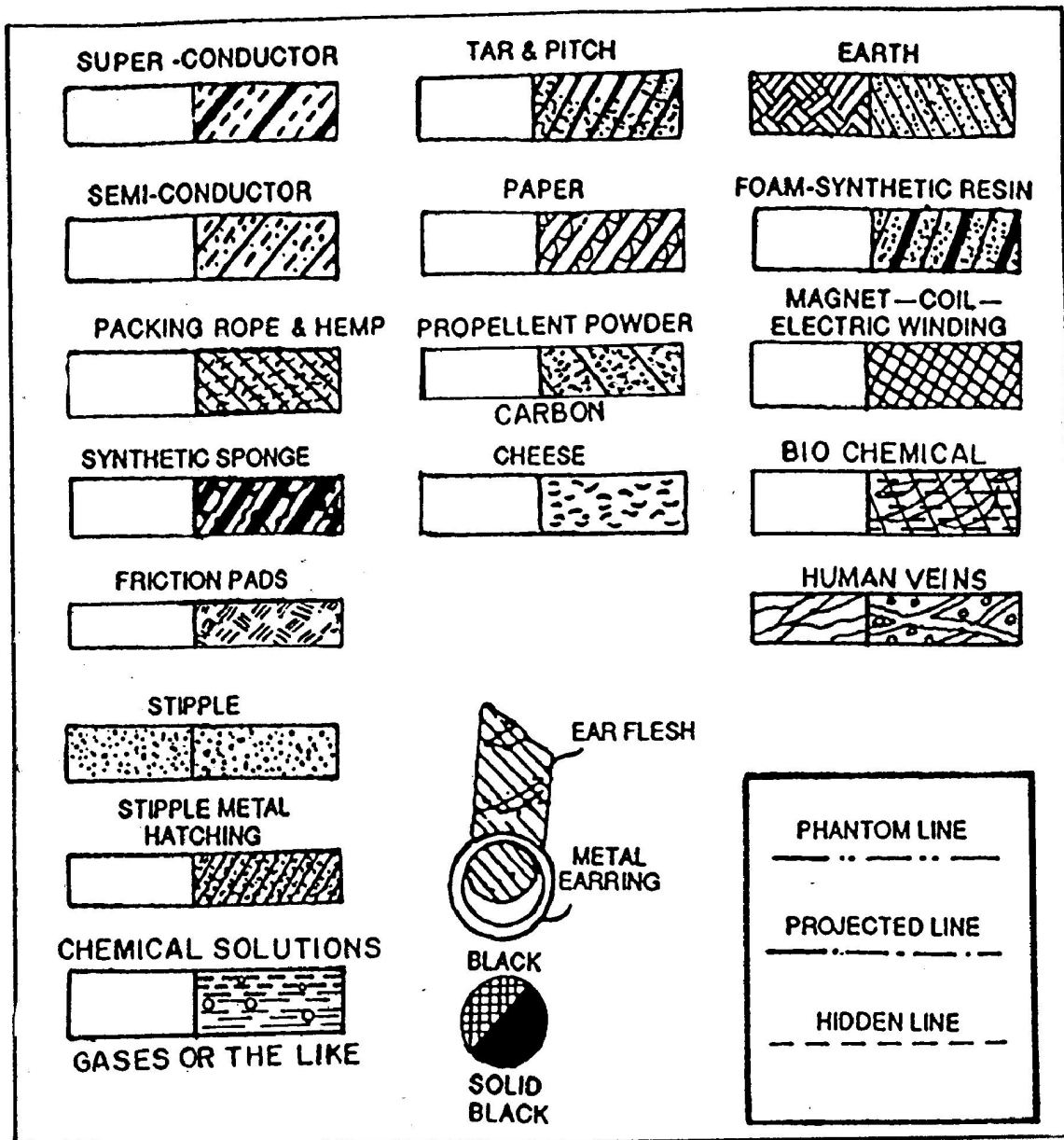
[37 CFR 1.84\(n\)](#) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate,

subject to approval by the Office. Also, suitable legends may be used, or may be required, in proper cases. The American National Standards Institute (ANSI) ([www.ansi.org](http://www.ansi.org)) and the International Organization for Standardization (ISO) ([www.iso.org](http://www.iso.org)) are organizations whose numerous publications include some that pertain to graphical symbols; the symbols therein are considered to be generally acceptable in patent drawings. Although ANSI and ISO documents and other published sources may be used as guides during the selection of graphic symbols for patent drawings, the Office will not “approve” any published collection of symbols as a group because their use and clarity must be decided on a case-by-case basis. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

Since design patents protect the appearance of an article, graphic drawing symbols in design patent applications should be used judiciously, as the drawing symbol may interfere with a clear showing of the design. See [MPEP § 1503.02](#), subsection V. In addition, because color drawings may now be filed in a design application without the need for a petition, applicants may prefer to represent color using color drawings instead of using graphic symbols. See [MPEP § 1503.02](#), subsection V, and [MPEP § 608.02](#), subsection VIII, for the submission of color drawings in design applications.

The following symbols should be used to indicate various materials where the material is an important feature of the invention. The use of conventional features is very helpful in making prior art searches.





**608.02(a) New Drawing — When Replacement is Required Before Examination [R-07.2015]**

See [MPEP § 608.02](#) for the procedure to follow when drawings have not been filed, but a drawing will aid in the understanding of the invention. See [MPEP § 601.01\(f\)](#) or [601.01\(g\)](#) for the procedures

to follow when applications appear to be missing drawing(s). Drawings in utility and plant applications will be reviewed by the Office of Patent Application Processing (OPAP) for compliance with certain requirements of [37 CFR 1.84](#). OPAP will send a Notice to File Corrected Application Papers if the drawings are unacceptable for purposes of publication. The notice will give applicant a time



period of two (2) months from the mailing date of the notice to file acceptable drawings. This time period for reply is extendable under [37 CFR 1.136\(a\)](#). OPAP will not release applications to the Technology Centers until acceptable drawings are filed in the applications.

If at the time of the initial assignment of an application to an examiner's docket, or if at the time the application is taken up for action, the supervisory patent examiner believes the drawings to be of such a condition as to not permit reasonable examination of the application, applicant should be required to immediately submit corrected drawings. However, if the drawings do permit reasonable examination and the supervisory patent examiner believes the drawings are of such a character as to render the application defective under [35 U.S.C. 112](#), examination should begin immediately with a requirement for corrected drawings and a rejection of the claims as not being in compliance with [35 U.S.C. 112\(a\)](#) being made.

If the drawings have been indicated by the applicant as "informal," but the drawings are considered acceptable by OPAP, the examiner should not require replacement of the drawings. If the examiner does make objections to the drawings, the examiner should require correction in reply to the Office action and not permit the objection to be held in abeyance. See [MPEP § 608.02\(b\)](#), [§ 608.02\(d\)](#) - [§ 608.02\(h\)](#) and [§ 608.02\(p\)](#) for further information on specific grounds for finding drawings informalities.

## I. UNTIMELY FILED DRAWINGS

If a drawing is not timely received in reply to a notice from the Office or a letter from the examiner who requires a drawing, the application becomes abandoned for failure to reply.

For the handling of replacement drawings, see [MPEP § 608.02\(h\)](#).

### 608.02(b) Acceptability of Drawings [R-10.2019]

#### *37 CFR 1.85 Corrections to drawings.*

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in [§ 1.215\(c\)](#), any patent

application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action ([§ 1.135\(c\)](#)). If a drawing in a design application meets the requirements of [§ 1.84\(e\), \(f\), and \(g\)](#) and is suitable for reproduction, but is not otherwise in compliance with [§ 1.84](#), the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with [§ 1.84](#) or an amended drawing submitted under [§ 1.121\(d\)](#) in a nonprovisional international design application does not comply with [§ 1.1026](#) at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with [§ 1.84](#) or [1.1026](#), as applicable, to avoid abandonment. This time period is not extendable under [§ 1.136](#) (see [§ 1.136\(c\)](#)).

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to in an examiner's action, and that the drawing is admitted for examination purposes only (see [MPEP § 707.07\(a\)](#)). To be fully responsive, an amendment must include corrected drawings. See [37 CFR 1.85\(c\)](#) and [37 CFR 1.121\(d\)](#). The objection to the drawings will not be held in abeyance.

## I. ACCEPTABILITY OF DRAWINGS

The Office no longer considers drawings as formal or informal. Drawings are either acceptable or unacceptable. Drawings will be accepted by the Office of Patent Application Processing (OPAP) if the drawings are readable and reproducible for publication purposes. See [MPEP § 507](#).

Examiners should review the drawings for disclosure of the claimed invention and for proper use of reference numerals. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance. A request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action ([37 CFR 1.135\(c\)](#)). Drawing corrections

should be made promptly before allowance of the application in order to avoid delays in issuance of the application as a patent or a reduction to any term adjustment. See [37 CFR 1.704\(c\)\(10\)](#).

## II. NOTIFYING APPLICANT

If the original drawings are unacceptable, applicant will be notified and informed of what the objections are and that new corrected drawings are required. In either case, the drawings will be accepted as satisfying the requirements of [37 CFR 1.51](#). The examiners are directed to advise the applicants (see [MPEP § 707.07\(a\)](#)) in the first Office action of the reasons why the drawings are unacceptable. If the examiner discovers a defect in the content of the drawing, one or more of the form paragraphs reproduced below may be used to notify applicant.

### ¶ 6.21 New Drawings, Competent Draftsperson

New corrected drawings in compliance with [37 CFR 1.121\(d\)](#) are required in this application because [1]. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office does not prepare new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ¶ 6.22 Drawings Objected To

The drawings are objected to because [1]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, insert the reason for the objection, for example, --the drawings do not show every feature of the invention specified in the claims-- or --the unlabeled rectangular box(es)

shown in the drawings should be provided with descriptive text labels--.

2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).

3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

### ¶ 6.26 Drawings Do Not Permit Examination

The drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per [37 CFR 1.84\(c\)](#)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a shortened statutory period of **TWO (2) MONTHS** to submit new drawings in compliance with [37 CFR 1.81](#). Extensions of time may be obtained under the provisions of [37 CFR 1.136\(a\)](#) but in no case can any extension carry the date for reply to this letter beyond the maximum period of SIX MONTHS set by statute ([35 U.S.C. 133](#)). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

#### Examiner Note:

1. Use of this form paragraph should be extremely rare and limited to those instances where no examination can be performed due to the poor quality of the drawings resulting in a lack of understanding of the claimed subject matter.

2. Use a PTOL-90 or PTO-90C form as a cover sheet for this communication.

### ¶ 6.27 Requirement for Marked-up Copy of Drawing Corrections

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See [37 CFR 1.121\(d\)\(1\)](#). Failure to timely submit the corrected drawing and marked-up copy will result in the abandonment of the application.

#### Examiner Note:

1. When this form paragraph is used by the examiner, the applicant must provide a marked-up copy of any amended drawing figure, including annotations indicating the changes made in the drawing replacement sheets. See [37 CFR 1.121\(d\)\(2\)](#).

2. Applicants should be encouraged to submit corrected drawings before allowance in order to avoid having any term adjustment reduced pursuant to [37 CFR 1.704\(c\)\(10\)](#).

### III. HANDLING OF REPLACEMENT DRAWINGS

In those situations where an application is filed with unacceptable drawings, applicants will be notified by OPAP to file new acceptable drawings complying with [37 CFR 1.84](#) and [1.121\(d\)](#) or [37 CFR 1.1026](#), as applicable. If the requirement for corrected drawings appears on the notice of allowability (PTOL-37), the drawings must be filed within three months of the date of mailing of the notice of allowability. Also, each sheet of the drawing should include the application number and the art unit in the upper center margin ([37 CFR 1.84\(c\)](#)) and labeled, in the header, “Replacement Sheet.”

In utility applications, the examination will normally be conducted using the originally presented drawings. The sufficiency of disclosure, as concerns the subject matter claimed, will be made by the examiner utilizing the original drawings. IT IS APPLICANT’S RESPONSIBILITY TO SEE THAT NO NEW MATTER IS ADDED when submitting replacement drawings after allowance since they will not normally be reviewed by an examiner. Of course, if the examiner notices new matter in the replacement drawings, appropriate action to have the new matter deleted should be undertaken.

#### 608.02(c) Location of Drawings [R-01.2024]

Black and white line drawings submitted in: (i) provisional applications under [35 U.S.C. 111\(b\)](#); (ii) nonprovisional utility patent applications under [35 U.S.C. 111\(a\)](#), including reissue utility patent applications; (iii) international applications (PCT) and national stage applications under [35 U.S.C. 371](#); and (iv) reexamination proceedings for utility patents will be converted into TIFF images and stored in IFW.

Black and white line drawings in design applications, including reissue design patent applications, international design applications, and reexamination proceedings for design patents will be stored in a content management system, and a black and white copy will be placed in the file wrapper along with a placeholder sheet.

Black and white photographs and grayscale drawings in: (i) provisional applications under [35 U.S.C. 111\(b\)](#); (ii) nonprovisional utility and design patent applications under [35 U.S.C. 111\(a\)](#), including reissue utility and design patent applications; (iii) national stage applications under [35 U.S.C. 371](#); (iv) international applications (PCT); (v) international design applications; (vi) reexamination proceedings for utility patents and design patents; and (vii) supplemental examination proceedings will be stored in a content management system, and a black and white copy will be placed in the file wrapper along with a placeholder sheet.

Color drawings and color photographs are not permitted in international applications (see [PCT Rule 11.13](#)). Except for international applications, color photographs and color drawings in utility and design applications and proceedings will be stored in a content management system and a black and white copy thereof will be placed in the file wrapper along with a placeholder sheet.

Originally submitted drawings on paper that are photographs or in color may be maintained in an artifact folder.

#### 608.02(d) Complete Illustration in Drawings [R-07.2015]

##### *37 CFR 1.83 Content of drawing.*

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). In addition, tables that are included in the specification and sequences that are included in sequence listings should not be duplicated in the drawings.

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of [§ 1.81\(d\)](#).

If an application filed under [35 U.S.C. 111](#) or under [35 U.S.C. 371](#) includes a sequence listing or a table, such a sequence listing or table should not be included in both the drawings and the descriptive portion of the specification. [37 CFR 1.83\(a\)](#) and [1.58\(a\)](#).

Any structural detail that is of sufficient importance to be described should be shown in the drawing. (*Ex parte Good*, 1911 C.D. 43, 164 OG 739 (Comm'r Pat. 1911).)

Form paragraph 6.22.01, 6.22.04, or 6.36, where appropriate, may be used to require illustration.

#### ¶ 6.22.01 Drawings Objected To, Details Not Shown

The drawings are objected to under [37 CFR 1.83\(a\)](#) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. [MPEP § 608.02\(d\)](#). Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, identify the structural details not shown in the drawings.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

#### ¶ 6.22.04 Drawings Objected to, Incomplete

The drawings are objected to under [37 CFR 1.83\(b\)](#) because they are incomplete. [37 CFR 1.83\(b\)](#) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. Supply a full explanation, if it is not readily apparent how the drawings are incomplete.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

#### ¶ 6.36 Drawings Do Not Show Claimed Subject Matter

The drawings are objected to under [37 CFR 1.83\(a\)](#). The drawings must show every feature of the invention specified in the claims. Therefore, the [1] must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to



be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

In bracket 1, insert the features that must be shown.

See also [MPEP § 608.02](#).

### 608.02(e) Examiner Determines Completeness and Consistency of Drawings [R-07.2015]

The examiner should ensure that the figures are correctly described in the brief description of the several views of the drawing section of the specification, that the reference characters are properly applied, that no single reference character is used for two different parts or for a given part and a modification of such part, and that there are no superfluous illustrations.

One or more of the following form paragraphs may be used to require correction.

**¶ 6.22.01 Drawings Objected To, Details Not Shown**

The drawings are objected to under [37 CFR 1.83\(a\)](#) because they fail to show [1] as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. [MPEP § 608.02\(d\)](#). Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

1. In bracket 1, identify the structural details not shown in the drawings.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

**¶ 6.22.02 Drawings Objected to, Different Numbers Refer to Same Part**

The drawings are objected to as failing to comply with [37 CFR 1.84\(p\)\(4\)](#) because reference characters “[1]” and [2] have both been used to designate [3]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

1. In brackets 1 and 2, identify the numbers which refer to the same part.
2. In bracket 3, identify the part which is referred to by different numbers.
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

**¶ 6.22.03 Drawings Objected to, Different Parts Referred to by Same Number**

The drawings are objected to as failing to comply with [37 CFR 1.84\(p\)\(4\)](#) because reference character “[1]” has been used to designate both [2] and [3]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,



even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

1. In bracket 1, identify the number which refers to the different parts.
2. In brackets 2 and 3, identify the parts which are referred to by the same number.
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

**¶ 6.22.06 Drawings Objected to, Reference Numbers Not in Drawings**

The drawings are objected to as failing to comply with [37 CFR 1.84\(p\)\(5\)](#) because they do not include the following reference sign(s) mentioned in the description: [1]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

1. In bracket 1, specify the reference characters which are not found in the drawings, including the page and line number where they first occur in the specification.
2. This form paragraph may be modified to require or allow the applicant to delete the reference character(s) from the description instead of adding them to the drawing(s).
3. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
4. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

**¶ 6.22.07 Drawings Objected to, Reference Numbers Not in Specification**

The drawings are objected to as failing to comply with [37 CFR 1.84\(p\)\(5\)](#) because they include the following reference character(s) not mentioned in the description: [1]. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#), or amendment to the specification to add the reference character(s) in the description in compliance with [37 CFR 1.121\(b\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

**Examiner Note:**

1. In bracket 1, specify the reference characters which are not found in the specification, including the figure in which they occur.
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

**608.02(f) Modifications in Drawings  
[R-08.2012]**

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. *Ex parte Badger*, 1901 C.D. 195, 97 OG 1596 (Comm’r Pat. 1901).

All modifications described must be illustrated, or the text canceled. (*Ex parte Peck*, 1901 C.D. 136, 96 OG 2409 (Comm’r Pat. 1901).) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

Form paragraph 6.22.05 may be used to require correction.

**¶ 6.22.05 Drawings Objected to, Modifications in Same Figure**

The drawings are objected to under [37 CFR 1.84\(h\)\(5\)](#) because Figure [1] show(s) modified forms of construction in the same

view. Corrected drawing sheets in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### Examiner Note:

1. In bracket 1, insert the appropriate Figure number(s).
2. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a bona fide attempt to advance the application to final action. See [37 CFR 1.85\(a\)](#).
3. This form paragraph may be followed by form paragraph 6.27 to require a marked up copy of the amended drawing figure(s) including annotations indicating the changes made in the corrected drawings.

### 608.02(g) Illustration of Prior Art [R-08.2012]

Figures showing the prior art are usually unnecessary and should be canceled. *Ex parte Elliott*, 1904 C.D. 103, 109 OG 1337 (Comm’r Pat. 1904). However, where needed to understand applicant’s invention, they may be retained if designated by a legend such as “Prior Art.”

If the prior art figure is not labeled, form paragraph 6.36.01 may be used.

#### ¶ 6.36.01 Illustration of “Prior Art”

Figure [1] should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See [MPEP § 608.02\(g\)](#). Corrected drawings in compliance with [37 CFR 1.121\(d\)](#) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per [37 CFR 1.84\(c\)](#)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

action in the next Office action. The objection to the drawings will not be held in abeyance.

### 608.02(h) Replacement Drawings [R-10.2019]

All sheets of replacement drawings will be routinely entered into the contents of the application. However, the examiner should not overlook such factors as new matter, the necessity for the replacement sheets and consistency with other sheets. If the examiner decides that the sheets should not be entered, the examiner should provide the applicant with the complete, explicit reasoning for the denial of entry. The entries previously made will be marked “not entered.”

Form paragraph 6.37 may be used to acknowledge replacement drawing sheets.

#### ¶ 6.37 Acknowledgment of Replacement Drawing Sheets

The drawings were received on [1]. These drawings are [2].

#### Examiner Note:

1. In bracket 2, insert either --acceptable-- or --unacceptable--.
2. Identify any drawing(s) not entered because they contain new matter and explain the correction(s) necessary to obtain entry upon resubmission.
3. If unacceptable because of noncompliance with [37 CFR 1.121\(d\)](#), an explanation must be provided. Form PTOL-324 may be used instead of this form paragraph to provide the explanation.

Alternatively, PTOL-326 Office Action Summary includes a block for acknowledgment of replacement drawings.

When an amendment is filed stating that replacement sheets of drawings are filed with the amendment and such drawings are not in the IFW, in the next communication by the examiner, the applicant must be notified that replacement drawings do not appear to have been received and thus have not been entered in the application.

Note that drawings will not be returned to the applicant. See [MPEP § 608.02\(y\)](#).

### 608.02(i) Transfer of Drawings From Prior Applications [R-11.2013]

Drawings cannot normally be transferred from a first pending application to another as the Office no longer considers drawings as formal or informal. Drawings that do not comply with all of the form requirements of [37 CFR 1.84](#) may be acceptable for the purposes of publication and examination if the drawings are readable and reproducible for publication purposes.

### 608.02(j) - 608.02(o) [Reserved]

### 608.02(p) Correction of Drawings [R-07.2015]

*37 CFR 1.121 Manner of making amendments in applications.*

\*\*\*\*\*

(d) *Drawings.* One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with [§ 1.84](#) or, for a nonprovisional international design application, in compliance with [§§ 1.84\(c\)](#) and [1.1026](#) and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as “New Sheet.” All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

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*37 CFR 1.85 Corrections to drawings.*

(a) A utility or plant application will not be placed on the files for examination until objections to the drawings have been corrected. Except as provided in [§ 1.215\(c\)](#), any patent application publication will not include drawings filed after the application has been placed on the files for examination. Unless applicant is otherwise notified in an Office action, objections to the drawings in a utility or plant application will not be held in abeyance, and a request to hold objections to the drawings in abeyance will not be considered a *bona fide* attempt to advance the application to final action ([§ 1.135\(c\)](#)). If a drawing in a

design application meets the requirements of [§ 1.84\(e\), \(f\), and \(g\)](#) and is suitable for reproduction, but is not otherwise in compliance with [§ 1.84](#), the drawing may be admitted for examination.

(b) The Office will not release drawings for purposes of correction. If corrections are necessary, new corrected drawings must be submitted within the time set by the Office.

(c) If a corrected drawing is required or if a drawing does not comply with [§ 1.84](#) or an amended drawing submitted under [§ 1.121\(d\)](#) in a nonprovisional international design application does not comply with [§ 1.1026](#) at the time an application is allowed, the Office may notify the applicant in a notice of allowability and set a three-month period of time from the mail date of the notice of allowability within which the applicant must file a corrected drawing in compliance with [§ 1.84](#) or [1.1026](#), as applicable, to avoid abandonment. This time period is not extendable under [§ 1.136](#) (see [§ 1.136\(c\)](#)).

See also [MPEP § 608.02\(b\)](#). For correction at allowance and issue, see [MPEP § 608.02\(w\)](#) and [MPEP § 1302.05](#).

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description of the view if a canceled figure is reinstated.

The following form paragraphs may be used to notify applicants of drawing corrections.

#### ¶ 6.39 USPTO Does Not Make Drawing Changes

The United States Patent and Trademark Office does not make drawing changes. It is applicant’s responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

#### Examiner Note:

This form paragraph is to be used whenever the applicant has filed a request for the Office to make drawing changes. Form paragraph 6.40 must follow.

#### ¶ 6.40 Information on How To Effect Drawing Changes

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with [37 CFR 1.84](#). An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to [37 CFR 1.121\(d\)](#). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as “amended.” If the changes to the drawing figure(s) are not

accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

#### Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

#### Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See [37 CFR 1.85\(a\)](#). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of [37 CFR 1.136](#) for filing the corrected drawings after the mailing of a Notice of Allowability.

#### ¶ 6.41 Reminder That USPTO Does Not Make Drawing Changes

Applicant is reminded that the U.S. Patent and Trademark Office does not make drawing changes and that it is applicant's responsibility to ensure that the drawings are corrected in accordance with the instructions set forth in the paper mailed on [1].

#### Examiner Note:

This form paragraph is to be used when the applicant has been previously provided with information on how to effect drawing changes.

#### ¶ 6.42 Reminder That Applicant Must Make Drawing Changes

Applicant is reminded that in order to avoid an abandonment of this application, the drawings must be corrected in accordance with the instructions set forth in the paper mailed on [1].

#### Examiner Note:

This form paragraph is to be used when allowing the application and when applicant has previously been provided with information on how to effect drawing changes.

#### ¶ 6.43 Drawings Contain Informalities, Application Allowed

The drawings filed on [1] are acceptable subject to correction of the informalities indicated below. In order to avoid

abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

#### Examiner Note:

1. Use this form paragraph when allowing the application, particularly at time of first action issue. Supply an explanation of drawings informalities (see [MPEP § 608.02\(b\)](#), [§ 608.02\(d\)](#) - [§ 608.02\(h\)](#) and [§ 608.02\(p\)](#)).

2. Form paragraph 6.40 or 6.41 must follow.

#### ¶ 6.47 Examiner's Amendment Involving Drawing Changes

The following changes to the drawings have been approved by the examiner and agreed upon by applicant: [1]. In order to avoid abandonment of the application, applicant must make these agreed upon drawing changes.

#### Examiner Note:

1. In bracket 1, insert the agreed upon drawing changes.

2. Form paragraphs 6.39 and 6.40 must follow.

#### 608.02(q) - 608.02(s) [Reserved]

#### 608.02(t) Cancellation of Figures [R-08.2012]

If a drawing figure is canceled, a replacement sheet of drawings must be submitted without the figure (see [37 CFR 1.121\(d\)](#)). If the canceled drawing figure was the only drawing on the sheet, then only a marked-up copy of the drawing sheet including an annotation showing that the drawing has been cancelled is required. The marked-up (annotated) copy must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section of the amendment document which explains the changes to the drawings (see [37 CFR 1.121\(d\)\(1\)](#)). The brief description of the drawings should also be amended to reflect this change.

#### 608.02(u) [Reserved]

#### 608.02(v) Drawing Changes Which Require Annotated Sheets [R-08.2012]

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a marked-up copy of the drawing should be filed with a replacement drawing. The marked-up copy must be clearly labeled as "Annotated Sheet."



See [37 CFR 1.84\(c\)](#) and [1.121\(d\)](#). Ordinarily, broken lines may be changed to full without a sketch.

Annotated sheets filed by an applicant and used for correction of the drawing will not be returned. All such annotated sheets must be in ink or permanent prints.

**608.02(w) Drawing Changes Which May Be Made Without Applicant's Annotated Sheets [R-11.2013]**

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare a letter to the applicant indicating the change to be made and may include a marked-up copy of the drawing showing the addition or alteration to be made. The marked-up copy of the drawing should be attached to the letter to the applicant made of record in the application file.

As a guide to the examiner, the following corrections are illustrative of those that may be suggested without requiring annotated sheets from the applicant:

- (A) Adding two or three reference characters or exponents.
- (B) Changing one or two numerals or figure ordinals.
- (C) Removing superfluous matter.
- (D) Adding or reversing directional arrows.
- (E) Changing Roman Numerals to Arabic Numerals to agree with specification.
- (F) Adding section lines or brackets, where easily executed.
- (G) Changing lead lines.
- (H) Correcting misspelled legends.

**608.02(x) Drawing Corrections or Changes Accepted Unless Notified Otherwise [R-08.2012]**

Drawing corrections or changes will be entered at the time they are presented, unless applicant is

notified to the contrary by the examiner in the action following the amended drawing submission.

**CORRECTION OR CHANGE NOT ACCEPTED**

Where the corrected or changed drawing is not accepted, for example, because the submitted corrections or changes are erroneous, or involve new matter or do not include all necessary corrections, the applicant will be notified and informed of any required corrective action in the next Office action. The examiner should explicitly and clearly set forth all the reasons for not approving the corrections to the drawings in the next communication to the applicant. See [MPEP § 608.02\(p\)](#) for suggested form paragraphs that may be used by examiners to notify applicants of drawing corrections.

**608.02(y) Return of Drawing [R-08.2012]**

Drawings will not be returned to the applicant.

**608.02(z) Allowable Applications Needing Drawing Corrections or Corrected Drawings [R-07.2015]**

If the drawings submitted in an application have been indicated by the applicant as "informal," but the drawings are considered acceptable by OPAP, the examiner should not require replacement of the drawings.

In IFW applications, generally, the most recently filed drawings will be used for printing, unless they have been indicated as "Not Entered."

If the examiner makes an objection to the drawings, the examiner should require correction in reply to the Office action that sets forth the objection. If an application is being allowed, and corrected drawings have not been filed, form PTOL-37 provides an appropriate check box for requiring corrected drawings.

Extensions of time to provide acceptable drawings in response to a notice of allowability are not permitted. If the Office of Data Management receives drawings that cannot be scanned or are otherwise unacceptable for publication, the Office



of Data Management will mail a requirement for corrected drawings, giving applicant a shortened statutory period of two months to reply. The drawings will ordinarily not be returned to the examiner for corrections.

## I. UTILITY PATENT APPLICATIONS RECEIVING REPLACEMENT DRAWINGS AFTER THE NOTICE OF ALLOWABILITY

Where replacement drawings are received in utility patent applications after the Notice of Allowability was mailed, the replacement drawings are handled by the Office of Data Management. Submission to the examiner is not necessary unless an amendment to the specification accompanies the drawings, such as an amendment where the description of figures is added or canceled. It is applicant's responsibility to see that no new matter is added when submitting replacement drawings after allowance because they will not normally be reviewed by an examiner.

## II. 37 CFR 1.312 AMENDMENTS

For information on handling amendments to drawings filed under [37 CFR 1.312](#), see [MPEP § 714.16](#).

### 608.03 Models, Exhibits, Specimens [R-08.2012]

#### 35 U.S.C. 114 Models, specimens.

The Director may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Director may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

#### *37 CFR 1.91 Models or exhibits not generally admitted as part of application or patent.*

(a) A model or exhibit will not be admitted as part of the record of an application unless it:

- (1) Substantially conforms to the requirements of [§ 1.52](#) or [§ 1.84](#);
- (2) Is specifically required by the Office; or
- (3) Is filed with a petition under this section including:
  - (i) The fee set forth in [§ 1.17\(h\)](#); and

(ii) An explanation of why entry of the model or exhibit in the file record is necessary to demonstrate patentability.

(b) Notwithstanding the provisions of paragraph (a) of this section, a model, working model, or other physical exhibit may be required by the Office if deemed necessary for any purpose in examination of the application.

(c) Unless the model or exhibit substantially conforms to the requirements of [§ 1.52](#) or [§ 1.84](#) under paragraph (a)(1) of this section, it must be accompanied by photographs that show multiple views of the material features of the model or exhibit and that substantially conform to the requirements of [§ 1.84](#).

Models or exhibits are generally not admitted as part of an application or patent unless the requirements of [37 CFR 1.91](#) are satisfied.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operability of a device. If operability of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he or she may choose his or her own way of so doing.

Models or exhibits that are required by the Office or filed with a petition under [37 CFR 1.91\(a\)\(3\)](#) must be accompanied by photographs that (A) show multiple views of the material features of the model or exhibit, and (B) substantially conform to the requirements of [37 CFR 1.84](#). See [37 CFR 1.91\(c\)](#). Material features are considered to be those features which represent that portion(s) of the model or exhibit forming the basis for which the model or exhibit has been submitted. Where a video or DVD or similar item is submitted as a model or exhibit, applicant must submit photographs of what is depicted in the video or DVD (the content of the material such as a still image single frame of a movie) and not a photograph of a video cassette, DVD disc, or compact disc.

#### *37 CFR 1.93 Specimens.*

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

See [MPEP Chapter 2400](#) regarding treatment of biological deposits.

### 608.03(a) Handling of Models, Exhibits, and Specimens [R-07.2015]

All models and exhibits received in the U.S. Patent and Trademark Office should be taken to the Technology Center (TC) assigned the related application for examination. The receipt of all models and exhibits which are to be entered into the application file record must be properly recorded on an artifact sheet.

A label indicating the application number, filing date, and attorney's name and address should be attached to the model or exhibit so that it is clearly identified and easily returned. The Office may return the model, exhibit, or specimen, at any time once it is no longer necessary for the conduct of business before the Office and return of the model or exhibit is appropriate. See [37 CFR 1.94](#).

If the model or exhibit cannot be conveniently stored in an artifact folder, it should not be accepted.

Models and exhibits may be presented for demonstration purposes during an interview. The models and exhibits should be taken away by applicant or his/her attorney or agent at the conclusion of the interview since models or exhibits are generally not permitted to be admitted as part of the application or patent unless the requirements of [37 CFR 1.91](#) are satisfied. See [MPEP § 713.08](#). A full description of what was demonstrated or exhibited during the interview must be made of record. See [37 CFR 1.133](#). Any model or exhibit that is left with the examiner at the conclusion of the interview, which is not made part of the application or patent, may be disposed of at the discretion of the Office.

#### ***37 CFR 1.94 Return of models, exhibits or specimens.***

(a) Models, exhibits, or specimens may be returned to the applicant if no longer necessary for the conduct of business before the Office. When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must arrange for the return of the model, exhibit, or specimen at the applicant's expense. The Office will dispose of perishables without notice to applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

(b) Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application. The provisions of this paragraph do not apply to a model or exhibit that substantially conforms to the requirements of [§ 1.52](#) or [§ 1.84](#), where the model or exhibit has been described by photographs that substantially conform to [§ 1.84](#), or where the model, exhibit or specimen is perishable.

(c) Where applicant is notified, pursuant to paragraph (a) of this section, of the need to arrange for return of a model, exhibit or specimen, applicant must arrange for the return within the period set in such notice, to avoid disposal of the model, exhibit or specimen by the Office. Extensions of time are available under [§ 1.136](#), except in the case of perishables. Failure to establish that the return of the item has been arranged for within the period set or failure to have the item removed from Office storage within a reasonable amount of time notwithstanding any arrangement for return, will permit the Office to dispose of the model, exhibit or specimen.

When applicant is notified that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and will be returned, applicant must make arrangements for the return of the model, exhibit, or specimen at applicant's expense. The Office may return the model, exhibit, or specimen at any time once it is no longer necessary for the conduct of business and need not wait until the close of prosecution or later. Where the model, exhibit, or specimen is a perishable, the Office will be presumed to have permission to dispose of the item without notice to applicant, unless applicant notifies the Office upon submission of the item that a return is desired and arrangements are promptly made for the item's return upon notification by the Office.

For models, exhibits, or specimens that are returned, applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application except where: (A) the model or exhibit substantially conforms to the requirements of [37 CFR 1.52](#) or [1.84](#); (B) the model or exhibit has been described by photographs that substantially conform to [37 CFR 1.84](#); or (C) the model, exhibit, or specimen is perishable. Applicant may be called upon to resubmit such returned model, exhibit, or specimen under appropriate circumstances, such as where a continuing application is filed.

The notification to applicant that a model, exhibit, or specimen is no longer necessary for the conduct of business before the Office will set a time period

within which applicant must make arrangements for a return of a model, exhibit, or specimen. The time period is normally two months from the mailing date of the notification, unless the item is perishable, in which case the time period will be shorter. Extensions of time are available under [37 CFR 1.136](#), except in the case of perishables. Failure by applicant to establish that arrangements for the return of a model, exhibit, or specimen have been made within the time period set in the notice will result in the disposal of the model, exhibit, or specimen by the Office.

Form paragraph 6.48 may be used to notify applicant that the model, exhibit, or specimen is no longer necessary for the conduct of business before the Office and that applicant must make arrangement for the return of the model, exhibit, or specimen.

**¶ 6.48 Model, Exhibit, or Specimen - Applicant Must Make Arrangements for Return**

The [1] is no longer necessary for the conduct of business before the Office. Applicant must arrange for the return of the model, exhibit or specimen at the applicant's expense in accordance with [37 CFR 1.94\(a\)](#).

Applicant is given TWO MONTHS from the mailing date of this letter to make arrangements for return of the above-identified model, exhibit, or specimen to avoid its disposal in accordance with [37 CFR 1.94\(c\)](#). Extensions of time are available under [37 CFR 1.136](#), except in the case of perishables.

Applicant is responsible for retaining the actual model, exhibit, or specimen for the enforceable life of any patent resulting from the application unless one of the exceptions set forth in [37 CFR 1.94\(b\)](#) applies.

**Examiner Note:**

1. In bracket 1, identify the model, exhibit, or specimen that is no longer needed by the Office.
2. The Office will dispose of **perishables** without notice to Applicant unless applicant notifies the Office upon submission of the model, exhibit or specimen that a return is desired and makes arrangements for its return promptly upon notification by the Office that the model, exhibit or specimen is no longer necessary for the conduct of business before the Office.

For plant specimens, see [MPEP § 1607](#) and [37 CFR 1.166](#).

**37 CFR 1.95 Copies of exhibits.**

Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except

in the custody of an employee of the Office specially authorized by the Director.

**608.04 New Matter [R-10.2019]**

**35 U.S.C. 132 Notice of rejection; reexamination.**

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

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**37 CFR 1.121 Manner of making amendments in applications.**

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(f) *No new matter.* No amendment may introduce new matter into the disclosure of an application.

\*\*\*\*\*

In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the claims present on the filing date of the application if their content justifies it. See [MPEP § 608.01\(I\)](#).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter (i.e., subject matter not present in the specification, claims, or drawings on the application filing date) is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected under [35 U.S.C. 112\(a\)](#).

When new matter is introduced into the specification, the amendment should be objected to under [35 U.S.C. 132](#) ([35 U.S.C. 251](#) if a reissue application) and a requirement made to cancel the new matter. The subject matter which is considered to be new matter must be clearly identified by the examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under [35 U.S.C. 112\(a\)](#) because the new matter is not described in the application as originally filed.

A “new matter” amendment of the drawing is ordinarily not entered; neither is an additional or

substitute sheet containing “new matter” even though provisionally entered by the TC technical support staff. See [MPEP § 608.02\(h\)](#).

The examiner’s holding of new matter may be petitionable or appealable. See [MPEP § 608.04\(c\)](#).

For new matter in reissue application, see [MPEP § 1411.02](#). For new matter in substitute specification, see [MPEP § 608.01\(q\)](#). For new matter in a continuation or divisional application, see [MPEP § 211.05](#).

**Note:** No amendment is permitted in a provisional application after it receives a filing date.

### **608.04(a) Matter Not Present in Specification, Claims, or Drawings on the Application Filing Date [R-10.2019]**

Matter not present on the filing date of the application in the specification, claims, or drawings that is added after the application filing is usually new matter. See [MPEP §§ 2163.06](#) and [2163.07](#) for guidance in determining whether an amendment adds new matter, and for a discussion of the relationship of new matter to [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112, first paragraph](#). See [MPEP § 2163.07\(a\)](#) to determine whether added characteristics such as chemical or physical properties, a new structural formula or a new use are inherent characteristics that do not introduce new matter.

New matter includes not only the addition of wholly unsupported subject matter, but may also include adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) and [MPEP § 2163.05](#) for guidance in determining whether the addition of specific percentages or compounds after a broader original disclosure constitutes new matter.

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. [35 U.S.C. 132\(a\)](#) should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting

to add new disclosure to that originally disclosed on filing. If new matter is added to the specification, it should be objected to by using Form Paragraph 7.28.

#### **¶ 7.28 Objection to New Matter Added to Specification**

The amendment filed [1] is objected to under [35 U.S.C. 132\(a\)](#) because it introduces new matter into the disclosure. [35 U.S.C. 132\(a\)](#) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: [2].

Applicant is required to cancel the new matter in the reply to this Office action.

#### **Examiner Note:**

1. This form paragraph is not to be used in reissue applications; use form paragraph 14.22.01 instead.
2. In bracket 2, identify the new matter by page and the line numbers and provide an appropriate explanation of your position. This explanation should address any statement by applicant to support the position that the subject matter is described in the specification as filed. It should further include any unresolved questions which raise a doubt as to the possession of the claimed invention at the time of filing.
3. If new matter is added to the claims, or affects the claims, a rejection under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112, first paragraph](#), using form paragraph 7.31.01 should also be made. If new matter is added only to a claim, an objection using this paragraph should not be made, but the claim should be rejected using form paragraph 7.31.01. As to any other appropriate prior art or [35 U.S.C. 112](#) rejection, the new matter must be considered as part of the claimed subject matter and cannot be ignored.

If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under [35 U.S.C. 112\(a\)](#) or [pre-AIA 35 U.S.C. 112, first paragraph](#), on the ground that it recites elements without support in the original disclosure. See *Waldemar Link, GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991)(A written-description question often arises when an applicant, after filing a patent application, subsequently adds “new matter” not present in the original application.); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See [MPEP § 608.01\(l\)](#). Replacement



drawings containing new matter should not be entered and the corrections necessary to obtain entry of the drawing(s) should be explained using form paragraph 6.37. See [MPEP § 608.02\(h\)](#).

For completeness of specification, see [MPEP § 608.01\(p\)](#). For trademarks and trade names, see [MPEP § 608.01\(v\)](#).

### **608.04(b) New Matter by Preliminary Amendment [R-10.2019]**

A preliminary amendment present on the filing date of the application (e.g., filed along with the filing of the application) is considered a part of the original disclosure. See [MPEP § 714.01\(e\)](#) and [§ 602](#). A preliminary amendment filed after the filing date of the application is not part of the original disclosure of the application. See [MPEP § 608.04\(a\)](#). For applications filed on or after September 21, 2004, the Office will automatically treat any preliminary amendment under [37 CFR 1.115\(a\)\(1\)](#) that is present on the filing date of the application as part of the original disclosure. Applicants can avoid the need to file a preliminary amendment by incorporating any desired amendments into the text of the specification, even where the application is a continuation or divisional application of a prior-filed application. Applicants are strongly encouraged to avoid submitting any preliminary amendments so as to minimize the burden on the Office in processing preliminary amendments and reduce delays in processing the application.

### **608.04(c) Review of Examiner’s Holding of New Matter [R-11.2013]**

Where the new matter is confined to amendments to the specification, review of the examiner’s requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. See also [MPEP § 2163.06](#).

### **608.05 “Sequence Listing,” “Large Tables,” or “Computer Program Listing Appendix” Submitted in ASCII Plain Text or a “Sequence Listing XML” Submitted as XML File Text [R-01.2024]**

*37 CFR 1.52 Language, paper, writing, margins, read-only optical disc specifications.*

(a)

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(5) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the USPTO patent electronic filing system requirements.

\*\*\*\*\*

(e) *Electronic documents submitted on a read-only optical disc that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application, reexamination, or supplemental examination proceeding.*

(1) The following documents may be submitted to the Office on a read-only optical disc in compliance with this paragraph (e):

(i) A “Computer Program Listing Appendix” (see [§ 1.96\(c\)](#));

(ii) A “Sequence Listing” (submitted under [§ 1.821\(c\)](#) in compliance with §§ [1.822](#) through [1.824](#)) or a “Sequence Listing XML” (submitted under [§ 1.831\(a\)](#) in compliance with §§ [1.832](#) through [1.834](#)); or

(iii) “Large Tables” (see [§ 1.58\(c\)](#)).

(2) Read-only optical disc as used in this part means a finalized disc, in conformance with International Organization for Standardization (ISO) 9660, on which the data is recorded so it is permanent and cannot be changed or erased, and is one of:

(i) Compact Disc-Read-Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R); or

(ii) Digital Video Disc-Recordable (DVD-R or DVD+R);

(3) Each read-only optical disc must conform to the following requirements:

(i) Computer compatibility: PC or Mac<sup>®</sup>;

(ii) Operating system compatibility: MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, MacOS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>;

(iii) The contents of each read-only optical disc must be in American Standard Code for Information Interchange (ASCII) plain text and if compressed, must be compressed in accordance with [§ 1.58](#) for “Large Tables,” with [§ 1.96](#) for a “Computer Program Listing Appendix,” or [§ 1.824](#) for a “Sequence Listing” or Computer Readable Form (CRF) of the “Sequence Listing,” as applicable; and

(iv) The contents of each read-only optical disc for a “Sequence Listing XML” must be in eXtensible Markup



Language (XML) file format, and if compressed, must be compressed in accordance with § 1.834.

(4) Each read-only optical disc must be enclosed in a hard case within an unsealed, padded, and protective mailing envelope, and must be accompanied by a transmittal letter in accordance with paragraph (a) of this section, including the following information:

- (i) First-named inventor (if known);
- (ii) Title of the invention;
- (iii) Attorney docket or file reference number (if applicable);
- (iv) Application number and filing date (if known);
- (v) The operating system (MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>) used to produce the disc; and
- (vi) The file(s) contained on the read-only optical disc, including the name of the file, the size of the file in bytes, and the date of creation.

(5) Each read-only optical disc must have a label permanently affixed thereto on which the following information has been hand-printed or typed:

- (i) First-named inventor (if known);
- (ii) Title of the invention;
- (iii) Attorney docket or file reference number (if applicable);
- (iv) Application number and filing date (if known);
- (v) Date on which the data were recorded on the read-only optical disc; and
- (vi) Disc order (e.g., “1 of X”), if multiple read-only optical discs are submitted.

(6) Read-only optical discs will not be returned to the applicant and may not be retained as part of the patent application file.

(7) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with § 1.58(g) for “Large Tables,” § 1.96(c)(5) for a “Computer Program Listing Appendix,” § 1.825(b) for a “Sequence Listing” or CRF of a “Sequence Listing,” and § 1.835(b) for a “Sequence Listing XML.”

(8) The specification must contain an incorporation by reference of the material on each read-only optical disc in a separate paragraph (§ 1.77(b)(5)), identifying the name of each file, their date of creation, and their size in bytes, except for an international application in the international stage. The Office may require the applicant to amend the specification to include the material incorporated by reference.

(9) If a file is unreadable, it will be treated as not having been submitted, and a notice will be issued to require a compliant submission.

(f) *Determining application size fees for applications containing electronic documents submitted on a read-only optical disc or via the USPTO patent electronic filing system—*

(1) *Submission on read-only optical discs.* The application size fee required by § 1.16(s) or § 1.492(j), for an application component submitted in part on a read-only optical disc in compliance with paragraph (e) of this section, shall be determined such that each three kilobytes of content submitted on a read-only optical disc shall be counted as a sheet of paper. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted on a read-only optical disc under paragraph (e) of this section containing:

(i) Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with § 1.821(c) or (e), or any “Sequence Listing XML” in compliance with § 1.831(a); or

(ii) Any “Computer Program Listing Appendix” in compliance with § 1.96(c).

(2) *Submission via the USPTO patent electronic filing system.* The application size fee required by § 1.16(s) or § 1.492(j), for an application submitted in whole or in part via the USPTO patent electronic filing system, shall be determined such that the paper size equivalent will be considered to be 75% of the number of sheets of paper present in the specification and drawings for the application when entered into the Office records after being rendered by the USPTO patent electronic filing system. Excluded from this determination is any ASCII plain text file or any XML file (as applicable) submitted via the USPTO patent electronic filing system containing:

(i) Any “Sequence Listing” or CRF of a “Sequence Listing” in compliance with § 1.821(c)(1) or (e), or any “Sequence Listing XML” in compliance with § 1.831(a); or

(ii) Any “Computer Program Listing Appendix” in compliance with § 1.96(c).

(3) *Oversized submission.* Any submission of a “Sequence Listing” in electronic form or a “Sequence Listing XML” of 300 MB–800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in § 1.21(o)(1). Any submission of a “Sequence Listing” in electronic form or a “Sequence Listing XML” that exceeds 800 MB filed in an application under 35 U.S.C. 111 or 371 will be subject to the fee set forth in § 1.21(o)(2).

### **37 CFR 1.77 Arrangement of application elements.**

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.
- (3) Application data sheet (see § 1.76).
- (4) Specification.
- (5) Drawings.
- (6) The inventor’s oath or declaration.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).

- (2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) An incorporation by reference statement regarding the material in:

(i) One or more ASCII plain text files, submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (*see* § [1.52\(e\)\(8\)](#)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes, for the following document types:

(A) A “Computer Program Listing Appendix” (*see* § [1.96\(c\)](#));

(B) A “Sequence Listing” (*see* § [1.821\(c\)](#));

or  
(C) “Large Tables” (*see* § [1.58\(c\)](#)).

(ii) An XML file for a “Sequence Listing XML” (*see* § [1.831\(a\)](#)), submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (*see* § [1.52\(e\)\(8\)](#)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes.

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the several views of the drawing.

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) “Sequence Listing,” required by § [1.821\(c\)](#), that is submitted as a Portable Document Format (PDF) file (as set forth in § [1.821\(c\)\(2\)](#)) via the USPTO patent electronic filing system or on physical sheets of paper (as set forth in § [1.821\(c\)\(3\)](#)).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

In view of lengthy data listings being submitted as part of the disclosure in some patent applications, the Office has established procedures for the presentation of “Large Tables” ([37 CFR 1.58](#)), a “Computer Program Listing Appendix” ([37 CFR 1.96\(c\)](#)), a “Sequence Listing” and a Computer Readable Form (CRF) of a “Sequence Listing” ([37 CFR 1.821\(c\)](#) and [\(e\)](#)), and a “Sequence Listing XML” ([37 CFR 1.831\(a\)](#)) in electronic form. Such listings are often several hundred pages or more in length. By filing and publishing such data listings in electronic form, substantial cost savings can result

to the applicants, the public, and the U.S. Patent and Trademark Office.

The following document types may be submitted as ASCII text files with a “.txt” extension via the USPTO patent electronic filing system or on read-only optical discs in compliance with [37 CFR 1.52\(e\)](#) and [1.58](#), [1.96\(c\)](#), or [1.821](#) *et seq.* provided the specification contains a statement in a separate paragraph that incorporates by reference the material in the ASCII text file identifying the name of the ASCII text file, the date of creation, and the size of the ASCII text file in bytes (except that an incorporation by reference statement is not required for a “Sequence Listing” properly submitted as an ASCII plain text file in an international application (PCT) during the international stage regardless of whether the application is currently in the international stage or the national stage):

(1) A “Computer Program Listing Appendix” (*see* [37 CFR 1.96\(c\)](#)). It is noted that a “Computer Program Listing Appendix” cannot be filed in ASCII plain text in an international application (PCT) during the international stage;

(2) A “Sequence Listing” (*see* [37 CFR 1.821\(c\)\(1\)](#)). Note that a CRF of a “Sequence Listing” filed pursuant to [37 CFR 1.821\(e\)](#) must be filed as an ASCII plain text file, but an incorporation by reference statement is required because a CRF is not part of the specification; or

(3) “Large Tables” (*see* [37 CFR 1.58\(c\)](#)).

It is noted that “Large Tables” cannot be filed in ASCII plain text in an international application (PCT) during the international stage (*see* [37 CFR 1.58\(c\)](#)).

A “Sequence Listing XML” may be submitted as a XML file with a “.xml” extension via the USPTO patent electronic filing system or as read-only optical discs in compliance with [37 CFR 1.52\(e\)](#) and [1.831](#) *et seq.* Such submission requires that applicant provide a statement in a separate paragraph that incorporates by reference the material in the XML file identifying the name of the XML file, the date of creation, and the size of the XML file in bytes (except that an incorporation by reference statement is not required for a Sequence Listing properly submitted as an XML file in an international

application during the international stage regardless of whether the application is currently in the international stage or the national stage).

The granted patent or pre-grant publication of an application that includes an ASCII plain text file or XML file, whether submitted on optical read-only discs or via the USPTO patent electronic filing system, may not include the actual contents of the ASCII plain text file or XML file in the printed document. The incorporation by reference is necessary to treat the material in the ASCII plain text file or XML file as part of the patent or publication and to alert the public that the granted patent or the pre-grant publication includes additional material that constitutes part of the patent or publication. See [37 CFR 1.52\(e\)\(8\)](#), [1.58\(d\)\(5\)](#), [1.77\(b\)\(5\)](#), [1.96\(c\)](#), [1.821\(c\)\(1\)](#), and [1.834\(c\)\(1\)](#) (provides the incorporation by reference requirement).

#### **I. TEXT FILES SUBMITTED VIA THE USPTO PATENT ELECTRONIC FILING SYSTEM**

A “Sequence Listing” under [37 CFR 1.821](#) through [1.825](#) may be submitted as an ASCII plain text file only in applications filed before July 1, 2022. The applicable filing date is either the filing date under [37 CFR 1.53](#) for applications submitted under [35 U.S.C. 111](#) or the international filing date under PCT Article 11 for applications submitted under [35 U.S.C. 371](#). For information on a “Sequence Listing XML” under [37 CFR 1.831](#) through [1.839](#) for applications filed on or after July 1, 2022, see subsection II below.

“Large Tables” (see [37 CFR 1.58\(c\)](#)), a “Computer Program Listing Appendix” (see [37 CFR 1.96\(c\)](#)), a “Sequence Listing” (see [37 CFR 1.821\(c\)\(1\)](#)), and a CRF of a “Sequence Listing” (see [37 CFR 1.821\(e\)\(1\)](#) or [\(e\)\(2\)](#)), and “Large Tables” (see [37 CFR 1.58\(c\)](#)) may be submitted as ASCII text files via the USPTO patent electronic filing system. Each plain text file must be in compliance with ASCII and have a file name with a “.txt” extension. See [37 CFR 1.58\(d\)\(4\)](#), [1.96\(c\)\(2\)](#), and [1.824\(a\)\(3\)](#), which provide all requirements for the file name.

Further, the specification must contain an incorporation by reference statement of the material

in the ASCII plain text file in a separate paragraph identifying the name of the ASCII plain text file, the date of creation, and the size of the ASCII text file in bytes (except for a “Sequence Listing” submitted in an international application (PCT) during the international stage regardless of whether the application is currently in the international stage or the national stage and a CRF of a “Sequence Listing” submitted in compliance with [37 CFR 1.821\(e\)](#)). See [37 CFR 1.52\(e\)\(8\)](#), [1.58\(d\)\(5\)](#), [1.77\(b\)\(5\)](#), [1.96\(c\)](#), and [1.821\(c\)\(1\)](#).

Form paragraphs 6.61.02 and 6.71.02 (reproduced in subsection II., below) may be used to indicate the need to add or amend an incorporation by reference statement for text files submitted via the USPTO patent electronic filing system.

##### **A. Information Specific to a “Sequence Listing”**

The Office recommends that a “Sequence Listing” filed via the USPTO patent electronic filing system be submitted in an ASCII plain text file ([37 CFR 1.821\(c\)\(1\)](#)). It is noted that while submission of the “Sequence Listing” as a PDF file ([37 CFR 1.821\(c\)\(2\)](#)) or on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) is permitted, the inclusion of such would be part of the specification and would count toward the calculation for application size fee in accordance with [37 CFR 1.16\(s\)](#). Should applicant file the “Sequence Listing” as a PDF file ([37 CFR 1.821\(c\)\(2\)](#)) or on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) in an application submitted under [35 U.S.C. 111\(a\)](#) or file the “Sequence Listing” as a PDF file ([37 CFR 1.821\(c\)\(2\)](#)) or on physical sheets of paper ([37 CFR 1.821\(c\)\(3\)](#)) and not also as an ASCII plain text file ([37 CFR 1.821\(c\)\(1\)](#)) in a national stage application submitted under [35 U.S.C. 371](#), a separate submission of a computer readable form (CRF) of the “Sequence Listing” would be required ([37 CFR 1.821\(e\)\(1\)](#) or [\(e\)\(2\)](#)). When a separate CRF is required under [37 CFR 1.821\(e\)\(1\)](#) or [\(e\)\(2\)](#), a statement that the sequence information contained in the CRF and the information in the “Sequence Listing” submitted as a PDF or on physical sheets of paper are identical is required ([37 CFR 1.821\(e\)\(1\)\(ii\)](#) or [37 CFR 1.821\(e\)\(2\)\(ii\)](#)). It is noted that an applicant can no longer request a CRF transfer from a parent application when applicant submitted a “Sequence Listing” under [37 CFR](#)

[1.821\(c\)\(2\)](#) or [1.821\(c\)\(3\)](#) (see “*Electronic Submission of a Sequence Listing, a Large Table, or a Computer Program Listing Appendix in Patent Applications*,” 86 FR 57035, 57038 (October 14, 2021)). Checker software that may be used to check a sequence listing for compliance with the requirements of [37 CFR 1.824](#) is available on the USPTO website at [www.uspto.gov/Checker4](http://www.uspto.gov/Checker4).

In situations where an applicant is adding a “Sequence Listing” via the USPTO patent electronic filing system in accordance with [37 CFR 1.825\(a\)](#) after the application filing date, the Office recommends submitting the “Sequence Listing” as an ASCII plain text file along with a request that the amendment be entered using an incorporation by reference statement ([37 CFR 1.825\(a\)\(2\)\(i\)](#)). The “Sequence Listing” must be accompanied by a statement that the submission does not include any new matter which goes beyond the disclosure of the application as filed ([37 CFR 1.825\(a\)\(4\)](#)) and a statement that identifies the basis for the amendment with specific references to particular parts of the application (specification, claims, drawings) for all sequence data in the “Sequence Listing” in the application as originally filed ([37 CFR 1.825\(a\)\(3\)](#)).

In situations where an applicant is filing an amendment to a “Sequence Listing” via the USPTO patent electronic filing system in accordance with [37 CFR 1.825\(b\)](#), the Office recommends filing a replacement “Sequence Listing” as an ASCII plain text file where the applicant requests that the replacement “Sequence Listing” text file be entered using an incorporation by reference statement ([37 CFR 1.825\(b\)\(2\)\(i\)](#)). The replacement “Sequence Listing” must be accompanied by: (1) a statement that the submission does not include any new matter ([37 CFR 1.825\(b\)\(5\)](#)); (2) a statement that identifies the basis for the amendment with specific references to particular parts of the application (specification, claims, drawings) as originally filed for all amended sequence data in the replacement “Sequence Listing” ([37 CFR 1.825\(b\)\(4\)](#)); and (3) a statement that identifies the location of all deletions, replacements, or additions to the “Sequence Listing” ([37 CFR 1.825\(b\)\(3\)](#)). See generally [37 CFR 1.825](#).

For international applications that contain a disclosure of one or more nucleotide and/or amino

acid sequences, [PCT Rule 5.2\(a\)](#) requires a sequence listing as a separate part of the description. When filing a sequence listing in an international application (PCT) that was filed before July 1, 2022 using the USPTO patent electronic filing system, the sequence listing part of the description may be submitted either as a single ASCII plain text file with a “.txt” extension (e.g., “seqlist.txt”) or as a PDF image file. Note that 100 megabytes is the size limit for submitting a sequence listing ASCII plain text file via the USPTO patent electronic filing system. See [MPEP § 2422.03\(a\)\(IV\)](#) for further information regarding filing a sequence listing in international applications via the USPTO patent electronic filing system.

#### **B. Application Size Fee**

Any “Sequence Listing” or CRF of a “Sequence Listing” submitted as an ASCII plain text file via the USPTO patent electronic filing system that is otherwise in compliance with [37 CFR 1.821\(c\)](#) or [\(e\)](#), will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#) or [1.492\(j\)](#) as per [37 CFR 1.52\(f\)\(1\)\(i\)](#). A “Sequence Listing” submitted as a PDF image file via the USPTO patent electronic filing system will not be excluded when determining the application size fee.

Any “Computer Program Listing Appendix” submitted as an ASCII plain text file via the USPTO patent electronic filing system that is otherwise in compliance with [37 CFR 1.96\(c\)](#) will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#) or [1.492\(j\)](#) as per [37 CFR 1.52\(f\)\(1\)\(ii\)](#).

For “Large Tables” submitted as an ASCII plain text file via the USPTO patent electronic filing system, the “Large Tables” will be considered as part of the rest of the specification and drawings such that the paper size equivalent will be considered to be 75% of the number of sheets of paper present in the specification and drawings in the application when entered into the electronic file wrapper after being rendered by the USPTO patent electronic filing system. See [37 CFR 1.52\(f\)\(2\)](#) and [MPEP § 607](#), subsection II.



### C. Size Limit for Text Files

One hundred (100) megabytes is the size limit for a “Sequence Listing” or a CRF of a “Sequence Listing” submitted as an ASCII plain text file via the USPTO patent electronic filing system; for nearly all other file types, 25 megabytes is the size limit. This includes a 25 megabytes size limit for ASCII plain text files for a “Computer Program Listing Appendix” and “Large Tables” (see [37 CFR 1.58\(c\)](#) and [1.96\(c\)](#)). This limit, however, may not prevent an entirely electronic submission. According to the Legal Framework for Patent Electronic System ([www.uspto.gov/PatentLegalFramework](#)), a user may be able to break up a file of a “Computer Program Listing Appendix” or “Large Tables” that is larger than 25 MB into multiple files that are no larger than 25 MB each and submit those smaller files via the USPTO patent electronic filing system. If the user chooses to break up a large “Computer Program Listing Appendix” or “Large Tables” file so it may be submitted electronically, the file names must indicate their order (e.g., “1 of X,” “2 of X”). Files above the 25 MB limit for “Large Tables” and a “Computer Program Listing Appendix” (unless capable of being divided) and above 100 MB for a “Sequence Listing” must be submitted on read-only optical discs.

Submission of a “Sequence Listing” or a CRF of a “Sequence Listing” as an ASCII plain text file, if it exceeds 100 MB, cannot be divided like a submission of a “Large Table” or a “Computer Program Listing Appendix.” Thus, any “Sequence Listing” or CRF of a “Sequence Listing” greater than 100 MB must be submitted on read-only optical discs. If a user submits an electronic copy of a file that exceeds these size limits on a read-only optical disc(s), it is recommended that the read-only optical disc(s) be submitted via Priority Mail Express® from the USPS in accordance with [37 CFR 1.10](#), or hand delivery, on the date of the corresponding USPTO patent electronic filing system filing in accordance with [37 CFR 1.52\(e\)](#) if the user wishes the electronic copy to be considered to be part of the application as filed.

See [MPEP § 2422.03\(a\)\(III\)](#) *et seq.* for further guidance on “Sequence Listing” size limits. See the Legal Framework for Patent Electronic System

([www.uspto.gov/PatentLegalFramework](#)) for additional information pertaining to limits on the number and size of files submitted via the USPTO patent electronic filing system. See also [MPEP § 502.05](#).

## II. XML FILES SUBMITTED VIA THE USPTO PATENT ELECTRONIC FILING SYSTEM

A “Sequence Listing XML” may be submitted as a XML file with a “.xml” extension via the USPTO patent electronic filing system or as read-only optical discs in compliance with [37 CFR 1.52\(e\)](#) and [1.831\(a\)](#). Such submission requires that applicant provide a statement in a separate paragraph that incorporates by reference the material in the XML file identifying the name of the XML file, the date of creation, and the size of the XML file in bytes (except that an incorporation by reference statement is not required for a sequence listing properly submitted as an XML file in an international application during the international stage regardless of whether the application is currently in the international stage or the national stage). A “Sequence Listing XML” under [37 CFR 1.831](#) through [1.839](#) may be submitted as an XML file only in applications filed on or after July 1, 2022. See *2022 Standard for Presentation of Nucleotide and Amino Acid Sequence Listings Using eXtensible Markup Language (XML) in Patent Applications To Implement WIPO Standard ST.26; Incorporation by Reference*, 87 FR 30806 (May 20, 2022). The applicable filing date is either the filing date under [37 CFR 1.53](#) for applications submitted under [35 U.S.C. 111](#) or the international filing date under [PCT Article 11](#) for applications submitted under [35 U.S.C. 371](#). For information on a “Sequence Listing” under [37 CFR 1.821](#) through [1.825](#) for applications filed before July 1, 2022, see subsection I above.

Applications filed on or after July 1, 2022 that contain disclosures of nucleotide and/or amino acid sequences as defined in [37 CFR 1.831\(b\)](#) must provide such sequence information as a “Sequence Listing XML” submitted as an XML file ([37 CFR 1.831\(a\)](#)), where the “Sequence Listing XML” complies with the requirements of [37 CFR 1.831-1.834](#). The “Sequence Listing XML” may be filed via the USPTO patent electronic filing system



using Patent Center which is available at [www.uspto.gov/PatentCenter](http://www.uspto.gov/PatentCenter).

In situations where an applicant is adding a “Sequence Listing XML” via the USPTO patent electronic filing system in accordance with [37 CFR 1.835\(a\)](#) after the application filing date, such as when a patent applicant receives a notice under [37 CFR 1.835\(d\)\(1\)](#), to comply with the “Sequence Listing XML” regulations ([37 CFR 1.831-1.834](#)), the applicant must submit the “Sequence Listing XML” as an XML file either via the USPTO patent electronic system or on read-only optical disc. Submission of a “Sequence Listing XML” after the filing date requires that the applicant provide: (1) a request to amend the specification to include an updated incorporation by reference statement of the material in the “Sequence Listing XML” ([37 CFR 1.835\(a\)\(2\)](#)); (2) a statement that identifies the basis for the amendment with specific references to particular parts of the application as originally filed (specification, claims, drawings) for all sequence data in the “Sequence Listing XML” in the application as originally filed ([37 CFR 1.835\(a\)\(3\)](#)); and (3) a statement of no new matter ([37 CFR 1.835\(a\)\(4\)](#)).

If the notice pursuant to [37 CFR 1.835\(d\)\(1\)](#) identifies an error in a previously submitted “Sequence Listing XML,” or applicant needs to revise the “Sequence Listing XML,” applicant can submit a replacement “Sequence Listing XML” along with: (1) a request to amend the specification to include an incorporation by reference statement of the material in the replacement “Sequence Listing XML” ([37 CFR 1.835\(b\)\(2\)](#)); (2) a statement that identifies the location of all additions, deletions, or replacements of sequence information relative to the replaced “Sequence Listing XML” ([37 CFR 1.835\(b\)\(3\)](#)); (3) a statement that identifies the basis for the additions, deletions, or replacements of the sequence information with specific references to particular parts of the application as originally filed (specification, claims, drawings) for all amended sequence data in the replacement “Sequence Listing XML” ([37 CFR 1.835\(b\)\(4\)](#)); and (4) a statement of no new matter ([37 CFR 1.835\(b\)\(5\)](#)). See generally [37 CFR 1.835](#).

#### A. Application Size Fee

Any “Sequence Listing XML” submitted as an XML file via the USPTO patent electronic filing system that is otherwise in compliance with [37 CFR 1.831\(a\)](#) will be excluded when determining the application size fee required by [37 CFR 1.16\(s\)](#) or [1.492\(j\)](#) as per [37 CFR 1.52\(f\)\(2\)\(i\)](#).

#### B. Size Limit for XML Files

One hundred (100) megabytes is the size limit for a “Sequence Listing XML” submitted as an XML file via the USPTO patent electronic filing system.

### III. SUBMISSIONS ON READ-ONLY OPTICAL DISC

A read-only optical disc submitted under [37 CFR 1.52\(e\)](#) is a finalized disc, in conformance with International Organization for Standardization (ISO) 9660, on which the data is recorded so it is permanent and cannot be changed or erased. A read-only optical disc must be one of a CD-ROM, a CD-R, a DVD-R, or a DVD+R. A CD-ROM is made by a process of pressing the disc from a master template; the data cannot be erased or rewritten. A CD-R, DVD-R, and DVD+R are read-only optical discs that have recording medium only capable of writing once. CD-RW, DVD-RW, and DVD+RW types of media are not acceptable because they are erasable and rewriteable. Limiting the media types to CD-ROM, CD-R, DVD-R, and DVD+R media will ensure the longevity and integrity of the data submitted. Additionally, the rules permit the use of DVD-R and DVD+R and non-self-extracting file compression (see [37 CFR 1.52\(e\)\(3\)\(iii\)](#)) to allow for higher-capacity read-only optical discs and to significantly reduce the number of physical media required to accommodate large files.

For “Large Tables,” a “Computer Program Listing Appendix,” a “Sequence Listing,” or a CRF of a “Sequence Listing,” the contents of each read-only optical disc must be in ASCII plain text file format. No non-ASCII characters or proprietary file formats are permitted. A text viewer is recommended for viewing ASCII plain text files. While virtually any word processor may be used to view an ASCII plain text file, care must be taken since a word processor

will often not distinguish ASCII and non-ASCII files when displayed. For example, a word processor normally does not display hidden proprietary non-ASCII characters used for formatting when viewing a non-ASCII word processor file. Also, each text file must have a file name with a “.txt” extension. See [37 CFR 1.58\(d\)\(4\)](#), [1.96\(c\)\(2\)](#), and [1.824\(a\)\(3\)](#) (providing the requirements for the file name). For a “Sequence Listing XML,” the contents of each read-only optical must be in XML file format, and if compressed, must be compressed in accordance with [37 CFR 1.834](#). A “Sequence Listing XML” must be encoded using Unicode UTF-8. All permitted printable characters (including the space character) and non-printable (control) characters are defined in paragraph 40 of the WIPO Standard ST.26 available at [www.wipo.int/export/sites/www/standards/en/pdf/03-26-01.pdf](http://www.wipo.int/export/sites/www/standards/en/pdf/03-26-01.pdf). Also, each XML file must have a file name with a “.xml” extension. See [37 CFR 1.834\(a\)](#) (providing the requirements for the file name).

Material on read-only optical disc(s) filed on the date that the application is accorded a filing date are generally to be treated as part of the originally filed disclosure even if the requisite “incorporation by reference” statement (see [37 CFR 1.77\(b\)\(5\)](#)) is omitted. However, in certain instances, the material on the read-only optical disc may not be treated as a part of the disclosure. For example, if a file is unreadable, it is treated as not having been submitted, and thus, it will not be treated as a part of the disclosure. It is noted that an incorporation by reference statement is not required for a “Sequence Listing” submitted as an ASCII plain text file or as an XML file (as applicable) in an international application during the international stage regardless of whether the application is currently in the international stage or the national stage. Also, an incorporation by reference statement is not required for a CRFs of a “Sequence Listings” submitted in compliance with [37 CFR 1.821\(e\)](#). See [37 CFR 1.52\(e\)\(8\)](#). The material on the read-only optical disc(s) is considered part of the original disclosure by virtue of its inclusion with the application on the date the application is accorded a filing date. If required, the incorporation by reference statement of the material on the read-only optical disc will need to be added via an amendment to be part of the specification so it is clear to the Office, the printer,

and the public that the application as originally filed includes material on the read-only optical disc. The examiner should require applicant(s) to insert this statement if it is omitted. See [37 CFR 1.58\(h\)](#), [1.96\(c\)\(6\)](#), [1.825\(c\)](#), and [1.835\(c\)](#). However, if the application would otherwise be in condition for allowance, the examiner may insert the statement by examiner’s amendment with a notice of allowance after receiving authorization from the applicant. See [MPEP § 1302.04](#) and [37 CFR 1.121\(g\)](#).

Each read-only optical disc must be compatible with PC or Mac<sup>®</sup> computers and with MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup> operating systems. The files contained on each read-only optical disc must be in ASCII plain text format (“Computer Program Listing Appendix”, “Large Tables” or “Sequence Listing”) or XML file format (“Sequence Listing XML”). If the ASCII plain text file is compressed, the file must be compressed in accordance with [37 CFR 1.58](#), [1.96](#), and [1.824](#). If the “Sequence Listing XML” file is compressed, the file must be compressed in accordance with [37 CFR 1.834](#). See [37 CFR 1.52\(e\)\(3\)](#).

[37 CFR 1.52\(e\)\(4\)](#) requires that each read-only optical disc must be enclosed in a hard case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter in accordance with [37 CFR 1.52\(e\)\(4\)](#). The transmittal letter must include the following information: 1) first-named inventor (if known); 2) title of the invention; 3) attorney docket or file reference number (if applicable); 4) application number and filing date (if known); 5) the operating system (MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>) used to produce the disc; and 6) the files contained on the read-only optical disc, including the name of the file, the size of the file in bytes, and the date of creation. Each read-only optical disc must have a permanent label affixed thereto on which the following information has been hand-printed or typed: 1) first-named inventor (if known); 2) title of the invention; 3) attorney docket or file reference number (if applicable); 4) application number and filing date (if known); 5) date on which the data were recorded on the

read-only optical disc; and 6) disc order (e.g., “1 of X”) if multiple read-only optical discs are submitted.

Read-only optical discs submitted to the Office will not be returned to the applicant and may not be retained as part of the patent application file. See [37 CFR 1.52\(e\)\(6\)](#). Read-only optical discs containing submitted “Large Tables” or a “Computer Program Listing Appendix” must be submitted in duplicate and labeled as “Copy 1” and “Copy 2,” respectively. See [37 CFR 1.58\(i\)](#) and [1.96\(c\)\(7\)](#). Read-only optical discs submitted for a “Sequence Listing,” CRF of a “Sequence Listing,” or a “Sequence Listing XML” are not required to be submitted in duplicate because a “Sequence Listing,” CRF of a “Sequence Listing,” or a “Sequence Listing XML” is processed differently than “Large Tables” or a “Computer Program Listing Appendix”.

If more than one read-only optical disc is required to hold all of the information, each read-only optical disc must have a label permanently affixed thereto with the disc order (e.g., “1 of X”). See [37 CFR 1.52\(e\)\(5\)](#) (includes other labeling requirements). Read-only optical disc(s) copies containing “Large Tables” and/or a “Computer Program Listing Appendix” should initially be routed to the Office of Patent Application Processing (OPAP), and read-only optical disc(s) discs containing a “Sequence Listing”, a CRF of a “Sequence Listing”, or a “Sequence Listing XML” Listings” should initially be routed to the Patent Legal Research Center (PLRC). Depending on the content in the read-only optical discs, the read-only optical discs will be checked by either OPAP or PLRC for viruses, readability, the presence of non-ASCII or non-XML files, and compliance with the file and disc labeling requirements. For “Large Tables” and a “Computer Program Listing Appendix” where duplicate disc copies are required, OPAP will retain one copy of the disc(s) and place the other copy in an artifact folder associated with the Office file wrapper. For a “Sequence Listing”, a CRF of a “Sequence Listing”, or a “Sequence Listing XML”, PLRC loads the “Sequence Listing”, the CRF of the “Sequence Listing”, or the “Sequence Listing XML” into the USPTO’s Sequence Listing Information Control (SLIC) system, and the physical media may be retained by PLRC. In the event that a file is unreadable, then the USPTO will treat the

submission as not ever having been submitted. See [37 CFR 1.52\(e\)\(9\)](#). A file is unreadable if, for example, it is of a format that does not comply with the requirements of [37 CFR 1.52\(e\)\(2\)](#), it is corrupted, or it is written onto a defective read-only optical disc. In such a case, OPAP will issue a notice indicating that the file is unreadable, and a replacement will be required.

Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with [37 CFR 1.58\(g\)](#) for “Large Tables”, [37 CFR 1.96\(c\)\(5\)](#) for a “Computer Program Listing Appendix”, and [37 CFR 1.825\(b\)](#) for a “Sequence Listing” or a CRF of a “Sequence Listing”, and [37 CFR 1.835\(b\)](#) for a “Sequence Listing XML”. See [37 CFR 1.52\(e\)\(7\)](#). When the information is filed on a read-only optical disc initially, amendments cannot be made to the information using the USPTO patent electronic filing system, but instead must be made using a replacement read-only optical disc. The amendment should include a corresponding amendment to the description of the incorporation by reference statement in the specification when an incorporation by reference is necessary or present. A replacement read-only optical disc containing the amended file(s) must also contain all of the files of the original read-only optical disc that were not amended (if any). This will ensure that the Office, printer, and public can quickly access all of the current files in an application or patent by referencing only the latest electronic version of the file(s) provided in the replacement read-only optical disc.

The following form paragraphs may be used to notify applicant of corrections needed with respect to read-only optical disc submissions.

**¶ 6.60.01 Read-only Optical Disc Requirements (No Statement that discs are Identical)**

This application is objected to under [37 CFR 1.58\(i\)](#) for “Large Tables” or [1.96\(c\)\(7\)](#) for a “Computer Program Listing Appendix” because it does not contain a statement in the transmittal letter that the two read-only optical discs are identical. Correction is required.

**¶ 6.60.02 Read-only Optical Disc Requirements (No Listing in Transmittal Letter)**

This application is objected to because it contains a data file on one or more read-only optical disc(s), however, the transmittal letter does not list for each read-only optical disc, the first named

inventor(if known), the title of the invention, the attorney docket or file reference number (if applicable), the operating system used to produce the disc, a list of files contained on the read-only optical disc(s) including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the read-only optical disc as required by [37 CFR 1.52\(e\)\(4\)](#). A statement listing the required information is required.

**¶ 6.61.01 Specification Lacking List of Read-only Optical Disc(s) and /or Associated Files**

Portions of this application are contained on read-only optical disc(s). When portions of an application are contained on a read-only optical disc, the paper portion of the specification must identify the read-only optical disc(s) and list the files including the name of the ASCII text file, the date of creation, and the size of the ASCII text file on each of the read-only optical discs, or the name of the XML file, the date of creation of the XML, and the size of the XML on each read-only optical disc (as applicable). See [37 CFR 1.52\(e\)](#). Read-only optical disc labeled [1] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including ASCII text file name or XML file name (as applicable), the date of creation and the size of the ASCII text file or XML file (as applicable).

**Examiner Note:**

In bracket 1, insert the name on the label of the read-only optical disc.

**¶ 6.61.02 Specification Lacking An Incorporation By Reference Statement for Read-only Optical Disc or Text File Submitted Via the USPTO Patent Electronic Filing System**

This application contains read-only optical disc(s) or text file(s) submitted via the USPTO patent electronic filing system as part of the originally filed subject matter, but does not contain an incorporation by reference statement for the read-only optical discs or text files. See [37 CFR 1.77\(b\)\(5\)](#) and [MPEP § 502.05](#). Applicant(s) is required to insert in the specification an appropriate incorporation-by-reference statement that includes the name of the ASCII text file or XML file (as applicable), the date of creation, and the size of the ASCII text file or XML files (as applicable).

**¶ 6.62 Data File on Read-only Optical Disc Not in ASCII File Format or XML File Format (only for a “Sequence Listing XML”)**

This application contains a data file on a read-only optical disc that is not in an ASCII file format or an XML file format (only for “Sequence Listing XML”). See [37 CFR 1.52\(e\)](#). File [1] is not in an ASCII format or XML format. Applicant is required to resubmit file(s) in ASCII format or XML format. No new matter may be introduced in presenting the file(s) in ASCII format or XML format.

**Examiner Note:**

1. This form paragraph must be used to indicate whenever a data file (“Large Table”, “Computer Program Listing Appendix”

or “Sequence Listing”) is submitted in a non-ASCII file format. The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file may contain non-ASCII characters.

2. In bracket 1, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters.

The following form paragraphs should be used to respond to amendments which include amended or substituted read-only optical discs.

**¶ 6.70.01 Read-only Optical Disc Requirements (Amendment Does Not Include Statement that Discs are Identical)**

The amendment filed [1] is objected to under [37 CFR 1.58\(i\)](#) for “Large Tables” or [1.96\(c\)\(7\)](#) for a “Computer Program Listing Appendix” because it does not contain a statement in the transmittal letter that the two read-only optical discs are identical. Correction is required.

**¶ 6.70.02 Read-only Optical Disc Requirements (No Listing in Transmittal Letter Submitted With Amendment)**

The amendment filed [1] contains data on read-only optical disc(s). Read-only optical disc labeled [2] is not identified in the transmittal letter and/or the transmittal letter does not list for each read-only optical disc, the first named inventor(if known), the title of the invention, the attorney docket or file reference number (if applicable), the operating system used to produce the disc, a list of files contained on the read-only optical disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the read-only optical disc as required by [37 CFR 1.52\(e\)\(4\)](#). A statement listing the specified information is required.

**Examiner Note:**

1. Use this form paragraph when the transmittal letter does not include a listing of the files and required information.
2. In bracket 1, insert the date of the amendment.
3. In bracket 2, insert the name on the label of the read-only optical disc.

**¶ 6.71.01 Specification Lacking List of Read-only optical Disc(s) and/or Associated Files (Amendment Filed With Read-only optical Disc(s))**

The amendment filed [1] contains data on read-only optical disc(s). Read-only optical disc labeled [2] is not identified in the paper portion of the specification with a listing of all of the files contained on the disc. Applicant is required to amend the specification to identify each disc and the files contained on each disc including the ASCII text file name, the date of creation and the size of the ASCII text file on each of the read-only optical discs. See [37 CFR 1.52\(e\)](#).

**Examiner Note:**

1. In bracket 1, insert the date of the amendment.



2. In bracket 2, insert the name on the label of the read-only optical disc.

**¶ 6.71.02 Specification Lacking Incorporation By Reference Statement for Amended or Added Read-only Optical Disc or Text File or XML File**

The amendment filed [1] amends or adds read-only optical disc(s) or text file(s) or XML file(s) (as applicable) submitted via the USPTO patent electronic filing system, but does not include an incorporation by reference statement for the read-only optical discs or the text files or XML files (as applicable). Applicant is required to update or insert an appropriate incorporation by reference statement in the specification that includes the name of the ASCII text file or XML file (as applicable), the date of creation, and the size of the ASCII text file or XML file (as applicable). See [37 CFR 1.77\(b\)\(5\)](#) and [1.52\(e\)\(8\)](#) and [MPEP § 502.05](#).

**Examiner Note:**

1. Use this form paragraph when a read-only optical disc or text file submitted via the USPTO patent electronic filing system is filed with an amendment, but the required incorporation-by-reference statement is neither amended nor added to the specification.

2. In bracket 1, insert the date of the amendment.

**¶ 6.72.01 Read-only Optical Disc Requirements (Discs Not Identical)**

The amendment filed [1] is objected to under [37 CFR 1.58\(i\)](#) for “Large Tables” or [1.96\(c\)\(7\)](#) for a “Computer Program Listing Appendix” because the two read-only optical discs are not identical. Providing a correct duplicate copy is required.

**Examiner Note:**

1. Use this form paragraph when the two read-only optical discs are not identical.

2. See also form paragraph 6.70.01 where the transmittal letter does not include a statement that the two read-only optical discs are identical.

**¶ 6.72.02 Data File, Submitted With Amendment, on Read-only Optical Disc Not in ASCII File Format or XML File Format (only for a “Sequence Listing XML” submission)**

The amendment filed [1] contains a data file on read-only optical disc that is not in an ASCII file format or an XML file format (only for a “Sequence Listing XML” submission). File [2] is not in an ASCII format or an XML file format. Applicant is required to resubmit file(s) in ASCII format or XML format as required by [37 CFR 1.52\(e\)\(3\)\(iii\)](#). No new matter may be introduced in presenting the file(s) in ASCII format or XML format.

**Examiner Note:**

1. This form paragraph must be used whenever a data file (“Large Tables,” a “Computer Program Listing Appendix,” a “Sequence Listing,” or a “Sequence Listing XML” (as applicable) is submitted in a non-ASCII file format or a non-XML file format (as applicable). The file may be in a file format that is proprietary, e.g., a Microsoft Word, Excel or Word Perfect file format; and/or the file contains non-ASCII characters

or fails to comply with the requirements for a “Sequence Listing XML” submitted under [1.52\(e\)](#).

2. In bracket 1, insert the date of the amendment.

3. In bracket 2, insert the name of the file and whether the file is a non-text proprietary file format and/or contains non-ASCII characters and/or contains non-XML characters (as applicable).

**¶ 6.72.03 Read-only Optical Discs Are Not Readable**

The amendment filed [1] contains a data file on read-only optical disc that is unreadable. Applicant is required to resubmit the file(s) in International Organization for Standardization (ISO) 9660 standard and American Standard Code for Information Interchange (ASCII) format as required by [37 CFR 1.52\(e\)\(2\)](#) and [1.52\(e\)\(3\)\(iii\)](#), respectively. No new matter may be introduced in presenting the file in ISO 9660 and ASCII format.

**¶ 6.72.04 Read-only Optical Disc Contains Viruses**

The amendment filed [1] is objected to because the read-only optical disc contains at least one virus. Correction is required.

**¶ 6.72.05 Read-only Optical Disc Requirements (Missing Files On Amended Read-only Optical Disc)**

The amendment to the application filed [1] is objected to because the newly submitted read-only optical disc(s) do not contain all of the unamended data file(s) together with the amended data file(s) that were on the original read-only optical disc. Since amendments to a read-only optical disc can only be made by providing a replacement read-only optical disc, the replacement disc must include all of the files, both amended and unamended, to be a complete replacement in accordance with [37 CFR 1.52\(e\)\(7\)](#).

**Examiner Note:**

Use this form paragraph when a replacement read-only optical disc is submitted that fails to include all of the files on the original read-only optical disc(s) that have not been cancelled by amendment.

For greater detail on submission of a read-only optical disc in a “Sequence Listing,” a “Sequence Listing XML,” “Large Tables,” or a “Computer Program Listing Appendix,” see MPEP § 608.05(a)-(c).

**608.05(a) Submission of a “Computer Program Listing Appendix” [R-01.2024]**

*37 CFR 1.96 Submission of computer program listings.*

(a) *General.* Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification. A computer program listing for the purpose of this section is defined as a document that lists, in appropriate sequence, the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language that will cause a computer to perform a desired



procedure or task such as solving a problem, regulating the flow of work in a computer, or controlling or monitoring events. Computer program listings may be submitted in patent applications, as set forth in paragraphs (b) and (c) of this section.

(b) *Material which will be printed in the patent:* If the computer program listing is contained in 300 lines or fewer, with each line of 72 characters or fewer, it may be submitted either as drawings or as part of the specification.

(1) *Drawings.* If the listing is submitted as drawings, it must be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.*

(i) If the listing is submitted as part of the specification, it must be submitted in accordance with the provisions of § 1.52.

(ii) Any listing having more than 60 lines of code that is submitted as part of the specification must be positioned at the end of the description but before the claims. Any amendment must be made by way of submission of a substitute sheet.

(c) *As an appendix that will not be printed:* Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted as an electronic document in ASCII plain text, whether submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with § 1.52(e). An electronic document containing such a computer program listing is to be referred to as a "Computer Program Listing Appendix." The "Computer Program Listing Appendix" will not be part of the printed patent. The specification must include an incorporation by reference of the "Computer Program Listing Appendix," in accordance with § 1.77(b)(5).

(1) A "Computer Program Listing Appendix" must conform to the following requirements:

- (i) Computer compatibility: PC or Mac<sup>®</sup>;
- (ii) Operating system compatibility: MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>;
- (iii) Line terminator: ASCII CRLF or LF only; and
- (iv) Control codes: The data must not be dependent on control characters or codes that are not defined in the ASCII character set.

(2) Each file must be named as \*.txt, where "\*" is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name.

(3) Each file containing a "Computer Program Listing Appendix" submitted via the USPTO patent electronic filing system must not exceed 25 MB, and file compression is not permitted.

(4) A "Computer Program Listing Appendix" submitted in compliance with § 1.52(e) must conform to the following requirements:

(i) A separate read-only optical disc containing a "Computer Program Listing Appendix" must be submitted for each applicable application;

(ii) Multiple computer program listings for a single application may be placed on a single read-only optical disc;

(iii) Multiple read-only optical discs, containing one or more computer program listings, may be submitted for a single application, if necessary;

(iv) Any computer program listing may, and a computer program listing having a nested file structure must, when submitted in compliance with § 1.52(e), be compressed into a single file using WinZip<sup>®</sup>, 7-Zip, or Unix<sup>®</sup>/Linux<sup>®</sup> Zip;

(v) Any compressed file must not be self-extracting; and

(vi) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts, in accordance with the target read-only optical disc size and labeled in compliance with § 1.52(e)(5)(vi).

(5) Any amendments to a "Computer Program Listing Appendix" in electronic form in ASCII plain text format must include:

(i) A replacement ASCII plain text file, in accordance with the requirements of this paragraph (c), submitted via the USPTO patent electronic filing system, or on a read-only optical disc, in compliance with § 1.52(e), where the replacement read-only optical disc must be submitted in duplicate, and the read-only optical discs must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day, and year of creation indicated) and "COPY 2 REPLACEMENT MM/DD/YYYY";

(ii) A request that the amendment be made by incorporation by reference of the material in the replacement ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph) identifying the name of the file, the date of creation, and the size of the file in bytes (*see* § 1.77(b)(5));

(iii) A statement that identifies the location of all deletions, replacements, or additions to the ASCII plain text file; and

(iv) A statement that the replacement ASCII plain text file contains no new matter.

(6) The specification of a complete application with a "Computer Program Listing Appendix" as an ASCII plain text file, filed on the application filing date, without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with § 1.77(b)(5).

(7) Any read-only optical disc for a "Computer Program Listing Appendix" must be submitted in duplicate. The read-only optical disc and duplicate copy must be labeled "Copy 1" and "Copy 2," respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical discs are not identical, the Office will use the read-only optical disc labeled "Copy 1" for further

processing. Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with § [1.96\(c\)\(5\)](#).

Special procedures for presentation of computer program listings as a “Computer Program Listing Appendix in the form of ASCII plain text files in U.S. national patent applications are set forth in [37 CFR 1.96](#). Submission via the USPTO patent electronic filing system or the use of read-only optical disc files is desirable in view of the number of computer program listings being submitted as part of the disclosure in patent applications. Such listings are often several hundred pages in length. By filing and publishing such computer program listings in electronic form rather than on physical sheets of paper, substantial cost savings can result to the applicants, the public, and the U.S. Patent and Trademark Office.

See [MPEP § 608.05](#), subsection I., for details pertaining to submission of ASCII plain text files via the USPTO patent electronic filing system, and subsection II., for details pertaining to submissions on read-only optical disc. Also, substantial details regarding submitting ASCII plain text files are incorporated into [37 CFR 1.96\(c\)](#), which are discussed more below in subsection III.

## I. BACKGROUND

A “computer program listing”, as used in these rules, means the document that lists, in proper order, the instructions, routines, and other contents of a program for a computer. The listing may be either in machine or machine-independent (object or source) programming language which will cause a computer to perform a desired procedure or task, such as solving a problem, regulating the flow of work in a computer, or controlling or monitoring events. The general description of the computer program listing will appear in the specification while the computer program listing may appear either directly in the specification or as a “Computer Program Listing Appendix” to the specification, submitted in an ASCII text file via the USPTO patent electronic filing system or on a read-only optical disc. The specification must include an incorporation by reference statement of the “Computer Program Listing Appendix” in accordance with [37 CFR 1.96\(c\)\(6\)](#) according to the arrangement of

application elements as outlined in [37 CFR 1.77\(b\)\(5\)](#).

Copies of publicly available computer program listings (including any “Computer Program Listing Appendix”) are available via Patent Center. The U.S. Patent and Trademark Office also provides publicly available computer program listings (including any “Computer Program Listing Appendix”) at the cost set forth in [37 CFR 1.19](#).

## II. DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

The USPTO prefers that specifications and drawings are submitted electronically via the USPTO patent electronic filing system. However, any specification and/or drawings submitted on physical sheets of paper should conform to the applicable provisions of [37 CFR 1.52](#) and [37 CFR 1.84](#), and will be subject to a non-electronic filing fee. See [37 CFR 1.16\(t\)](#). When lengthy computer program listings must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome. The cost of printing long computer programs in patent documents is also very expensive to the U.S. Patent and Trademark Office. In accordance with [37 CFR 1.96](#), a computer program listing contained on three hundred printout lines or less may be submitted either as drawings (in compliance with [37 CFR 1.84](#)), as part of the written specification (in compliance with [37 CFR 1.52](#)), as an ASCII text file on a read-only optical disc (in compliance with [37 CFR 1.52\(e\)](#)), or as an ASCII text file via the USPTO patent electronic filing system (in compliance with the Legal Framework for Patent Electronic System (see [MPEP § 502.05](#))). A computer program listing contained on three hundred and one (301) printout lines or more must be submitted as an ASCII plain text file on a read-only optical disc (in compliance with [37 CFR 1.52\(e\)](#)) or submitted via the USPTO patent electronic filing system. See [37 CFR 1.96\(c\)](#). Regardless of the number of printout lines a computer program listing has, any computer program listing which is filed as an ASCII plain text file on a read-only optical disc or submitted via the USPTO patent electronic filing system is referred to as a “Computer Program Listing Appendix”, and the “Computer Program Listing Appendix” will not be

printed in any patent application or part of the printed patent. See [37 CFR 1.96\(c\)](#).

Form paragraph 6.64.01 or 6.64.02 may be used to notify the applicant of this requirement.

**¶ 6.64.01 Computer Program Listing Appendix of More Than 300 Lines in Specification**

The specification of this application contains a computer program listing consisting of more than three hundred (300) lines. In accordance with [37 CFR 1.96\(c\)](#), a computer program listing of more than three hundred lines **must** be submitted as an appendix in text format. The “Computer Program Listing Appendix” may be submitted as a text file via the USPTO patent electronic filing system or on a read-only optical disc conforming to the standards set forth in [37 CFR 1.96\(c\)\(1\)](#). The “Computer Program Listing Appendix” must be appropriately referenced in the specification (see [37 CFR 1.77\(b\)\(5\)](#)). Accordingly, applicant is required to cancel the current computer program listing, file a “Computer Program Listing Appendix” as a text file via the USPTO patent electronic filing system or on a read-only optical disc in compliance with [37 CFR 1.96\(c\)](#), and insert an appropriate reference to the newly added “Computer Program Listing Appendix” at the beginning of the specification.

**Examiner Note:**

1. This form paragraph must be used whenever a computer program listing consisting of more than three hundred lines is included as part of the descriptive portion of the specification if the computer program listing was filed on or after September 8, 2000. See [MPEP § 608.05\(a\)](#).
2. In bracket 1, insert the range of page numbers of the specification which include the computer program listing.

**¶ 6.64.02 Computer Program Listing as Printout Within the Specification (More Than 60 Lines And Not More Than Three Hundred Lines)**

This application contains a computer program listing of over sixty (60) lines and less than three hundred and one (301) lines within the written specification. In accordance with [37 CFR 1.96\(b\)](#), a computer program listing contained on over sixty (60) lines and less than three hundred-one (301) lines must, if submitted as part of the specification, be positioned at the end of the specification and before the claims. Accordingly, applicant is required to cancel the computer program listing and either incorporate such listing in a text file submitted via the USPTO patent electronic filing system or on read-only optical disc in compliance with [37 CFR 1.96](#), or insert the computer program listing after the detailed description of the invention but before the claims.

**Examiner Note:**

This form paragraph must be used whenever a computer program listing consisting of a paper printout of more than 60 lines and no more than three hundred lines is included as part of the descriptive portion of the specification and the computer program listing was filed on or after September 8, 2000. See [MPEP § 608.05\(a\)](#).

**III. REQUIREMENTS FOR A “COMPUTER PROGRAM LISTING APPENDIX”**

[37 CFR 1.96\(c\)](#) lists several requirements of a “Computer Program Listing Appendix”. Specifically, a “Computer Program Listing Appendix” must be compatible with PC or Mac<sup>®</sup> computers and with MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup> operating systems. Also, a “Computer Program Listing Appendix” may only have ASCII CRLF or LF line terminators, and the data must not be dependent on control characters or codes that are not defined in the ASCII character set. See [37 CFR 1.96\(c\)\(1\)](#). Also, a “Computer Program Listing Appendix” must have a file name with a “.txt” extension. See [37 CFR 1.96\(c\)\(2\)](#) (provides the requirements for the file name).

There is a 25 MB size limit for “Computer Program Listing Appendix” files submitted via the USPTO patent electronic filing system with file compression not being permitted. See [37 CFR 1.96\(c\)\(3\)](#). It is noted that it may be possible to break up a “Computer Program Listing Appendix” file that is larger than 25 MB into multiple files that are 25 MB or less in size and submit those smaller files via the USPTO patent electronic filing system, as per the Legal Framework for Patent Electronic System ([www.uspto.gov](http://www.uspto.gov)). See also [MPEP § 608.05\(D\)\(C\)](#).

A “Computer Program Listing Appendix” submitted on a read-only optical disc in compliance with [37 CFR 1.52\(e\)](#) must be submitted as a separate read-only optical disc for each applicable application, and multiple computer program listings for a single application may be placed on a single read-only optical disc. Multiple read-only optical discs, containing one or more computer program listings, may be submitted for a single application. Any computer program listing may be compressed using WinZip<sup>®</sup>, 7-Zip, or Unix<sup>®</sup>/Linux<sup>®</sup> Zip, and the compressed file must not be self-extracting. However, a computer program listing which has a nested file structure is required to be compressed. If after compression, a compressed ASCII plain text file still does not fit on a single read-only optical disc, the compressed file may be split into multiple file parts in accordance with the target read-only

optical disc size and labeled in compliance with [37 CFR 1.52\(e\)\(5\)\(vi\)](#). See [37 CFR 1.96\(c\)\(4\)](#).

Read-only optical discs containing a “Computer Program Listing Appendix” must be submitted in duplicate and labeled as “Copy 1” and “Copy 2” respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical disc copies are not identical, the Office will use the read-only optical disc labeled “Copy 1” for further processing. See [37 CFR 1.96\(c\)\(7\)](#). Two discs would be considered not identical when, e.g., the files contained on those discs are not the same. Duplicate copies for a “Computer Program Listing Appendix” are required to be submitted since the OPAP keeps a first copy for record retention purposes and a second copy in an artifact folder for use by the examiner during the patent examination process. Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc in compliance with [37 CFR 1.96\(c\)\(5\)](#), as discussed immediately below.

In order to amend a “Computer Program Listing Appendix”, a replacement ASCII plain text file, in accordance with [37 CFR 1.96\(c\)](#), must be submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with [37 CFR 1.52\(e\)](#). Any replacement ASCII plain text file submitted on read-only optical discs must be submitted in duplicate and must be labeled as “COPY 1 REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated) and “COPY 2 REPLACEMENT MM/DD/YYYY”. When the information is filed on a read-only optical disc initially, amendments cannot be made to the information using the USPTO patent electronic filing system, but instead must be made using a replacement read-only optical disc. See [37 CFR 1.52\(e\)\(7\)](#). Also, a request must be made that the material in the replacement ASCII plain text file be incorporated by reference in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes. See [37 CFR 1.77\(b\)\(5\)](#). A statement must be provided that identifies the location of all deletions, replacements, or additions to the ASCII plain text

file so that the changes made to the information contained in the submission can be more easily and accurately identified. Another statement that the replacement ASCII plain text file contains no new matter must also be provided. See [37 CFR 1.96\(c\)\(5\)](#). The Office may also require that a replacement ASCII plain text file be submitted if, for example, the information on a read-only optical disc is corrupted.

A “Computer Program Listing Appendix” filed as an ASCII plain text file on the date that the application was accorded a filing date is to be treated as part of the originally filed disclosure even if the required “incorporation by reference” statement (see [37 CFR 1.77\(b\)\(5\)](#)) is omitted. Similarly, if a preliminary amendment accompanies the application when it is filed in the Office and the preliminary amendment includes a “Computer Program Listing Appendix” as an ASCII plain text file, the “Computer Program Listing Appendix” will be treated as part of the original disclosure. The “Computer Program Listing Appendix” is considered part of the original disclosure by virtue of its inclusion with the application on the date the application is accorded a filing date. The incorporation by reference statement of the material in the ASCII plain text file is required to be part of the specification so it is clear to the Office, the printer, and the public that the application as originally filed includes the “Computer Program Listing Appendix”. The examiner should require applicant(s) to insert this statement if it is omitted. See [37 CFR 1.96\(c\)\(6\)](#). Also, if the application would otherwise be in condition for allowance, the examiner may insert the statement by examiner’s amendment with a notice of allowance after receiving authorization from the applicant. See [MPEP § 1302.04](#) and [37 CFR 1.121\(g\)](#).

### **608.05(b) ASCII Plain Text Submissions of “Large Tables” and Treatment of Lengthy Tables in a Specification for Patents and Patent Application Publications [R-01.2024]**

*37 CFR 1.58 Chemical and mathematical formulas and tables.*

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(b) Chemical and mathematical formulas and tables must be presented in compliance with § [1.52\(a\) and \(b\)](#), except that chemical and mathematical formulas or tables may be placed



in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulas and tables must be chosen from a block (nonscript) type font or lettering style having capital letters that should be at least 0.422 cm (0.166 inches) high (*e.g.*, preferably Arial, Times Roman, or Courier, with a font size of 12 points), but may be no smaller than 0.21 cm (0.08 inches) high (*e.g.*, a font size of 6 points). A space at least 0.64 cm (0.25 inches) high should be provided between complex formulas and tables and the text. Chemical and mathematical formulas must be configured to maintain the proper positioning of their characters when displayed in order to preserve their intended meaning. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

(c) The following “Large Tables” may be submitted in electronic form in ASCII plain text via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with § 1.52(e), excluding an international application during the international stage:

(1) Any individual table that is more than 50 pages in length; or

(2) Multiple tables, if the total number of pages of all the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper, in conformance with paragraph (b) of this section.

(d) “Large Tables” submitted in electronic form in ASCII plain text must conform to the following requirements:

(1) Must maintain the spatial relationships (*e.g.*, alignment of columns and rows) of the table elements when displayed to visually preserve the relational information they convey;

(2) Must have the following compatibilities:

(i) Computer compatibility: PC or Mac<sup>®</sup>;

(ii) Operating system compatibility: MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup>.

(3) Must be in ASCII plain text, where:

(i) All printable characters (including the space character) are permitted;

(ii) No nonprintable (ASCII control) characters are permitted, except ASCII Carriage Return plus ASCII Line Feed (CRLF) or Line Feed (LF) as line terminators.

(4) Must be named as \*.txt, where “\*” is one character or a combination of characters limited to upper- or lowercase letters, numbers, hyphens, and underscores and does not exceed 60 characters in total, excluding the extension. No spaces or other types of characters are permitted in the file name; and

(5) Must be incorporated by reference in a separate paragraph of the specification, in accordance with § 1.77(b)(5).

(e) “Large Tables” submitted via the USPTO patent electronic filing system must not exceed 25 MB, and file compression is not permitted.

(f) “Large Tables” submitted in compliance with § 1.52(e) via read-only optical disc must meet the following requirements:

(1) The ASCII plain text file may be compressed using WinZip<sup>®</sup>, 7-Zip, or Unix<sup>®</sup>/Linux<sup>®</sup> Zip;

(2) A compressed file must not be self-extracting; and

(3) A compressed ASCII plain text file that does not fit on a single read-only optical disc may be split into multiple file parts in accordance with the target read-only optical disc size and labeled in compliance with § 1.52(e)(5)(vi).

(g) Any amendments to “Large Tables” in electronic form in ASCII plain text format must include:

(1) A replacement ASCII plain text file, in accordance with the requirements of paragraphs (d) through (f) of this section, submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with § 1.52(e), labeled as “REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated);

(2) A request that the amendment be made by incorporation by reference of the material in the replacement ASCII plain text file, in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes (*see* § 1.77(b)(5));

(3) A statement that identifies the location of all deletions, replacements, or additions to the ASCII plain text file; and

(4) A statement that the replacement ASCII plain text file contains no new matter.

(h) The specification of an application with “Large Tables” as an ASCII plain text file, present on the application filing date, without an incorporation by reference of the material contained in the ASCII plain text file, must be amended to contain a separate paragraph incorporating by reference the material contained in the ASCII plain text file, in accordance with § 1.77(b)(5).

(i) Any read-only optical disc for “Large Tables” must be submitted in duplicate. The read-only optical disc and duplicate copy must be labeled “Copy 1” and “Copy 2,” respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical disc copies are not identical, the Office will use the read-only optical disc labeled “Copy 1” for further processing.

(j) Any amendment to the information on a read-only optical disc must be by way of a replacement read-only optical disc, in compliance with paragraph (g) of this section, where the replacement read-only optical disc and copy must be labeled “COPY 1 REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated), and “COPY 2 REPLACEMENT MM/DD/YYYY,” respectively.

The USPTO prefers that specifications having tables are submitted electronically via the USPTO patent electronic filing system. However, any specification and/or tables submitted on physical sheets of paper should conform to the applicable provisions of [37 CFR 1.52](#) and [37 CFR 1.58](#) and will be subject to a



non-electronic filing fee. See 37 CFR 1.16(t). When tables must be disclosed in a patent application in order to provide a complete disclosure, use of paper copies can become burdensome. In the past, all disclosures forming part of a patent application were presented on paper with the exception of “Sequence Listings” and a “Computer Program Listing Appendix”. Under [37 CFR 1.58\(c\)](#) *et seq.*, several different methods for submitting “Large Tables” are set forth, including submitting ASCII plain text files on read-only optical disc(s) in the form of CD-ROM, CD-R, DVD-R, or DVD+R. Applicant(s) may also submit “Large Tables” as ASCII plain text files via the USPTO patent electronic filing system.

See [MPEP § 608.05](#), subsection I., for details pertaining to submission of ASCII plain text files via the USPTO patent electronic filing system, and subsection III., for details pertaining to submissions on read-only optical disc(s). Also, substantial details regarding submitting ASCII plain text files are incorporated into [37 CFR 1.58\(c\)](#) *et seq.*, which are discussed more in subsection I below, and subsection II below discusses the treatment of lengthy tables in a specification for patents and patent application publications.

#### **I. “LARGE TABLES” FILED IN ASCII PLAIN TEXT VIA THE USPTO PATENT ELECTRONIC FILING SYSTEM OR ON READ-ONLY OPTICAL DISC**

As defined in [37 CFR 1.58\(c\)](#), “Large Tables” that may be submitted in electronic form in ASCII plain text are 1) any individual table that is more than 50 pages in length, or 2) multiple tables, if the total number of pages of all the tables in an application exceeds 100 pages in length. A table page is a page printed on paper, in conformance with [37 CFR 1.58\(b\)](#). The presentation of a subheading to divide a large table into smaller sections of less than 51 pages should not be used to prevent an applicant from submitting the table in electronic form in ASCII plain text unless the subdivided tables are presented as numerous files so as to lose their relationship to the overall large table. A single table contained on 50 pages or less and multiple tables contained on 100 pages or less must be submitted either as drawings (in compliance with [37 CFR 1.84](#)) or as

part of the specification on physical sheets of paper (in compliance with [37 CFR 1.52](#)) or via the USPTO patent electronic filing system (in compliance with the Legal Framework for Patent Electronic System (see [MPEP § 502.05](#))). When submitting “Large Tables” as ASCII plain text files, each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein. It is noted that “Large Tables” cannot be filed in ASCII plain text in an international application during the international stage (see [37 CFR 1.58\(c\)](#)).

The text files submitted via the USPTO patent electronic filing system or stored on read-only optical disc(s) containing the “Large Tables” must contain only ASCII characters. All printable characters (including the space character) are permitted, but no nonprintable (ASCII control) characters are permitted, except ASCII Carriage Return plus ASCII Line FEED (CRLF) or Line Feed (LF) as line terminators. No special formatting characters or proprietary file formats are permitted. Accordingly, great care must be taken so that the spatial arrangement of the data in rows and columns is maintained in the table when the file is opened for viewing at the Office. This will allow the table to be viewed with virtually any text viewer. See [37 CFR 1.58\(d\)](#). “Large Tables” submitted in ASCII plain text must be compatible with PC or Mac<sup>®</sup> computers and with MS-DOS<sup>®</sup>, MS-Windows<sup>®</sup>, Mac OS<sup>®</sup>, or Unix<sup>®</sup>/Linux<sup>®</sup> operating systems. See [37 CFR 1.58\(d\)\(2\)](#). Also, “Large Tables” submitted in ASCII plain text must have a file name with a “.txt” extension. See [37 CFR 1.58\(d\)\(4\)](#), provides all the requirements for the file name. Further, “Large Tables” submitted in ASCII plain text must be incorporated by reference in a separate paragraph of the specification, in accordance with [37 CFR 1.77\(b\)\(5\)](#). See [37 CFR 1.58\(d\)\(5\)](#).

There is a 25 MB size limit for “Large Tables” files submitted in ASCII plain text via the USPTO patent electronic filing system with file compression not being permitted. See [37 CFR 1.58\(e\)](#). It is noted that it may be possible to break up a “Large Tables” file that is larger than 25 MB into multiple files that are 25 MB or less in size and submit those smaller files via the USPTO patent electronic filing system, as

per the Legal Framework for Patent Electronic System ([www.uspto.gov](http://www.uspto.gov)). See also [MPEP § 608.05\(I\)\(C\)](#).

While “Large Tables” files submitted in ASCII plain text via the USPTO patent electronic filing system cannot be compressed, “Large Tables” submitted in compliance with [37 CFR 1.52\(e\)](#) via read-only optical disc(s) are now able to be compressed. See [37 CFR 1.58\(f\)](#). Compression was allowed to significantly reduce the number of physical media required to accommodate large files. The “Large Tables” file may be compressed using WinZip<sup>®</sup>, 7-Zip, or Unix<sup>®</sup>/Linux<sup>®</sup> Zip, and the compressed file must not be self-extracting. If after compression, a compressed “Large Tables” file still does not fit on a single read-only optical disc, the compressed file may be split into multiple file parts in accordance with the target read-only optical disc size and labeled in compliance with [37 CFR 1.52\(e\)\(5\)\(vi\)](#).

In order to amend “Large Tables” in ASCII plain text format, a replacement ASCII plain text file, in accordance with [37 CFR 1.58\(d\)-\(f\)](#), must be submitted via the USPTO patent electronic filing system or on a read-only optical disc, in compliance with [37 CFR 1.52\(e\)](#). Any read-only optical disc with a replacement ASCII plain text file must be labeled as “REPLACEMENT MM/DD/YYYY” with the month, day, and year of creation indicated. When the information is filed on a read-only optical disc initially, amendments cannot be made to the information using the USPTO patent electronic filing system, but instead must be made using a replacement read-only optical disc. See [37 CFR 1.52\(e\)\(7\)](#) and [1.58\(j\)](#). Also, a request must be made that the material in the replacement ASCII plain text file be incorporated by reference in a separate paragraph of the specification (replacing any prior such paragraph, as applicable) identifying the name of the file, the date of creation, and the size of the file in bytes. See [37 CFR 1.77\(b\)\(5\)](#). A statement must be provided that identifies the location of all deletions, replacements, or additions to the ASCII plain text file so that the changes made to the information contained in the submission can be more easily and accurately identified. Another statement that the replacement ASCII plain text file contains no new matter must also be provided. See [37 CFR](#)

[1.58\(g\)](#). The Office may also require that a replacement ASCII plain text file be submitted if, for example, the information on a read-only optical disc is corrupted.

“Large Tables” filed as an ASCII plain text file on the date that the application was accorded a filing date are to be treated as part of the originally filed disclosure even if the requisite “incorporation by reference” statement (see [37 CFR 1.77\(b\)\(5\)](#)) is omitted. Similarly, if a preliminary amendment accompanies the application when it is filed in the Office and the preliminary amendment includes “Large Tables” as an ASCII plain text file, the “Large Tables” will be treated as part of the original disclosure. The “Large Tables” are considered part of the original disclosure by virtue of its inclusion with the application on the date the application is accorded a filing date. The incorporation by reference statement of the material in the ASCII plain text file is required to be part of the specification so it is clear to the Office, the printer, and the public that the application as originally filed includes the “Large Tables” in the ASCII plain text file. The examiner should require applicant(s) to insert this statement if it is omitted. See [37 CFR 1.58\(h\)](#). Also, if the application would otherwise be in condition for allowance, the examiner may insert the statement by examiner’s amendment with a notice of allowance after receiving authorization from the applicant. See [MPEP § 1302.04](#) and [37 CFR 1.121\(g\)](#).

Read-only optical discs containing “Large Tables” must be submitted in duplicate and labeled as “Copy 1” and “Copy 2” respectively. The transmittal letter that accompanies the read-only optical discs must include a statement that the two read-only optical discs are identical. In the event that the two read-only optical disc copies are not identical, the Office will use the read-only optical disc labeled “Copy 1” for further processing. See [37 CFR 1.58\(i\)](#). Two discs would be considered not identical when, e.g., the files contained on those discs are not the same. Duplicate copies for “Large Tables” are required to be submitted since the OPAP keeps a first copy for record retention purposes and a second copy in an artifact folder for use by the examiner during the patent examination process.

Any amendment to the information on a read-only optical disc containing “Large Tables” must be by way of replacement read-only optical discs submitted in duplicate in compliance with [37 CFR 1.58\(g\)](#). The replacement read-only optical disc and copy must be labeled “COPY 1 REPLACEMENT MM/DD/YYYY” (with the month, day, and year of creation indicated), and “COPY 2 REPLACEMENT MM/DD/YYYY,” respectively. When the information is filed on a read-only optical disc initially, amendments cannot be made to the information using the USPTO patent electronic filing system, but instead must be made using a replacement read-only optical disc. See [37 CFR 1.52\(e\)\(7\)](#) and [1.58\(j\)](#).

While most tables filed with patent applications are intended to be rendered in portrait mode, “Large Tables” are permitted to be in landscape orientation if they cannot be presented satisfactorily in portrait orientation. Viewing documents in Patent Center or by examiners in their desktop examination tools permit rotating pages from portrait to landscape and vice versa.

## II. TREATMENT OF LENGTHY TABLES IN A SPECIFICATION FOR PATENTS OR PATENT APPLICATION PUBLICATIONS

The cost of printing long tables in patent documents is very expensive to the U.S. Patent and Trademark Office. Accordingly, if tables on more than two hundred consecutive pages, or large numbers of tables (lengthy tables) are submitted on a read-only optical disc or as text files submitted via the USPTO patent electronic filing system as provided in [37 CFR 1.52\(e\)](#) and [1.58\(c\)](#), or in an electronic format (XML, tab-delimited text, Microsoft Excel, Microsoft Work, Corel WordPerfect) in response to a “Request to Voluntarily Supply Lengthy Table(s) in Electronic Format” from the Office of Data Management, these lengthy tables will not be published as part of a patent document (e.g., patent or patent application publication). The lengthy tables will be published separately on the sequence homepage of the USPTO website (<https://seqdata.uspto.gov>). See, for example, patent application publication nos. US 20030235811 A1 and US 20030237110 A9.

Should an applicant need to include numerous tables in the specification, and such tables are on more than two hundred consecutive pages or large numbers of tables (lengthy tables) are present in the specification, such tables may be submitted as “Large Tables” in ASCII plain text in accordance with [1.58\(c\)](#). If a lengthy table is embedded in the specification of a patent application, and if the lengthy table is available in an electronic form (either XML or a format convertible to XML), when the patent or patent application publication is published, the following single-column statement will be inserted in place of each replaced table in the document.

### LENGTHY TABLE

Lengthy table referenced here [Insert File Name]. Please refer to the end of the specification for access instructions.

When the lengthy tables are separately published on the USPTO website, there will be a standardized lengthy table statement, in the patent document following the detailed description (see [37 CFR 1.77\(b\)\(10\)](#)).

For a patent application publication, the following page-wide text would appear:

### LENGTHY TABLES

The patent application contains a lengthy table section. A copy of the table is available in electronic form from the USPTO web site ([https://seqdata.uspto.gov/?pageRequest=docDetail&DocID=\[publication number\]](https://seqdata.uspto.gov/?pageRequest=docDetail&DocID=[publication number])). An electronic copy of the table will also be available from the USPTO upon request and payment of the fee set forth in [37 CFR 1.19\(b\)\(3\)](#).

For a patent, the following page-wide text would appear:

### LENGTHY TABLES

The patent contains a lengthy table section. A copy of the table is available in electronic form from the USPTO web site ([https://seqdata.uspto.gov/?pageRequest=docDetail&DocID=\[patent number\]](https://seqdata.uspto.gov/?pageRequest=docDetail&DocID=[patent number])). An electronic copy of the table will also be available from the USPTO upon request and payment of the fee set forth in [37 CFR 1.19\(b\)\(3\)](#).

Form paragraphs 6.63.01 and 6.63.02 may be used to notify applicant of corrections needed to comply with the requirements of [37 CFR 1.52\(e\)](#) and [37 CFR 1.58\(c\)](#) *et seq.* with respect to tables.

**¶ 6.63.01 Table Less Than 51 Pages Submitted Only as Text File**

The description portion of this application contains a table consisting of less than fifty one (51) pages only in ASCII text format submitted either via the USPTO patent electronic filing system or on read-only optical disc. In accordance with [37 CFR 1.58\(c\)\(1\)](#), only a table of at least fifty one (51) pages may be submitted as an ASCII text file. Accordingly, applicant is required to cancel the references to the table in text format appearing in the specification on pages [1], file a paper version of the table in compliance with [37 CFR 1.52](#) or file a PDF version via the USPTO patent electronic filing system, and change all appropriate references to the former table in text format to the newly added paper or PDF version of the table in the remainder of the specification.

**Examiner Note:**

1. This form paragraph must be used whenever a table on a read-only optical disc or submitted as a text file via the USPTO patent electronic filing system consisting of less than fifty one (51) pages as part of the descriptive portion of the specification is filed on or after September 8, 2000. See [MPEP § 608.05\(b\)](#).
2. In bracket 1, insert the range of page numbers of the specification which reference the table.

**¶ 6.63.02 Table Column/Row Relationship Not Maintained**

This application contains a table in ASCII text format submitted either via the USPTO patent electronic filing system or on read-only optical disc. “Large Tables” submitted as an ASCII text file in compliance with [37 CFR 1.58\(d\)\(1\)](#) must maintain the spatial orientation of the cell entries. The table submitted does not maintain the data within each table cell in its proper row/column alignment. The data is misaligned in the table as follows: [1]. Applicant is required to submit a replacement text file via the USPTO patent electronic filing system or on read-only optical disc with the table data properly aligned.

**Examiner Note:**

1. This form paragraph must be used whenever the data in a table cannot be accurately read because the data in the table cells do not maintain their row and column alignments.
2. In bracket 1, insert the area of the table that does not maintain the row and column alignments.

**608.05(c) Submissions of Biological Sequence Listings [R-07.2022]**

Applications disclosing nucleotide and/or amino acid sequences, as defined in [37 CFR 1.821\(a\)](#) for applications filed before July 1, 2022 or as defined

in [37 CFR 1.831\(b\)](#) for applications filed on or after July 1, 2022, are required to provide the biological sequence information in a sequence listing.

For applications filed before July 1, 2022, the sequence listing can be a “Sequence Listing” (as an ACSII plain text file in compliance with [37 CFR 1.821-1.824](#)) submission must be submitted via the USPTO patent electronic filing system or on read-only optical disc. See [MPEP §§ 2420 et seq.](#) for detailed information.

For applications filed on or after July 1, 2022, the sequence listing must be a “Sequence Listing XML” (as an XML file in compliance with [37 CFR 1.831-1.834](#)) submission can be submitted via the USPTO patent electronic filing system or on read-only optical disc. See [MPEP §§ 2412-2419](#) for detailed information.

**609 Information Disclosure Statement [R-01.2024]**

*37 CFR 1.97 Filing of information disclosure statement.*

(a) In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with [§ 1.98](#) considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section.

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under [§ 1.53\(d\)](#);

(2) Within three months of the date of entry of the national stage as set forth in [§ 1.491](#) in an international application;

(3) Before the mailing of a first Office action on the merits;

(4) Before the mailing of a first Office action after the filing of a request for continued examination under [§ 1.114](#); or

(5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under [§ 1.113](#), a notice of allowance under [§ 1.311](#), or an action that otherwise closes prosecution in the application, and it is accompanied by one of:



(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in [§ 1.17\(p\)](#).

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

(1) The statement specified in paragraph (e) of this section; and

(2) The fee set forth in [§ 1.17\(p\)](#).

(e) A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in [§ 1.56\(c\)](#) more than three months prior to the filing of the information disclosure statement.

(f) No extensions of time for filing an information disclosure statement are permitted under [§ 1.136](#). If a *bona fide* attempt is made to comply with [§ 1.98](#), but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.

(g) An information disclosure statement filed in accordance with this section shall not be construed as a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in [§ 1.56\(b\)](#).

(i) If an information disclosure statement does not comply with either this section or [§ 1.98](#), it will be placed in the file but will not be considered by the Office.

**37 CFR 1.98 Content of information disclosure statement.**

(a) Any information disclosure statement filed under [§ 1.97](#) shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

(2) A legible copy of:

(i) Each foreign patent;

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and

(iv) All other information or that portion which caused it to be listed.

(3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in [§ 1.56\(c\)](#) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.

(ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in [§ 1.56\(c\)](#).

(b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.

(2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.

(3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.

(4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.

(5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

(c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.

(d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending



U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

(1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under [35 U.S.C. 120](#); and

(2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

Information Disclosure Statements (IDSs) are not permitted in provisional applications filed under [35 U.S.C. 111\(b\)](#). See [37 CFR 1.51\(d\)](#). Since no substantive examination is given in provisional applications, a disclosure of information is unnecessary. Any such statement filed in a provisional application will be returned or destroyed at the option of the Office.

In nonprovisional applications, applicants and other individuals substantively involved with the preparation and/or prosecution of the application have a duty to submit to the Office information which is material to patentability as defined in [37 CFR 1.56](#). The provisions of [37 CFR 1.97](#) and [37 CFR 1.98](#) provide a mechanism by which patent applicants may comply with the duty of disclosure provided in [37 CFR 1.56](#) using an IDS. The IDS may be filed using form PTO/SB/08. Applicants and other individuals substantively involved with the preparation and/or prosecution of the patent application also may want the Office to consider information for a variety of other reasons; e.g., to make sure that the examiner has an opportunity to consider the same information that was considered by these individuals, or by another patent office in a counterpart or related patent application filed in another country.

Third parties (individuals not covered by [37 CFR 1.56\(c\)](#)) cannot file information disclosure statements under [37 CFR 1.97](#) and [37 CFR 1.98](#). Third parties may only submit patents and publications in compliance with [37 CFR 1.290](#) in applications published under [35 U.S.C. 122\(b\)](#). See [MPEP § 1134.01](#). For unpublished, pending applications, any member of the public, including private persons, corporate entities, and government agencies, may file a protest under [37 CFR 1.291](#) prior to the mailing of a notice of allowance under [37 CFR 1.311](#). See [MPEP Chapter 1900](#). Alternatively, third parties

may provide information to the applicant who may submit the information to the Office in an IDS. See [37 CFR 1.56\(d\)](#). The Office will review any submission in an application filed by a third party to determine whether the submission is in compliance with [37 CFR 1.290](#) or [1.291](#). Any third-party submission that does not comply with the requirements of [37 CFR 1.290](#) or [37 CFR 1.291](#) will not be entered into the application file and will be discarded. Office personnel (including the Patent Examining Corps) are instructed to: (1) not reply to or act upon any third-party inquiry or other submission in an application, except those in compliance with [37 CFR 1.290](#) or [37 CFR 1.291](#); and (2) decline to accept oral or telephone comments or submissions about applications from third parties. See [MPEP § 1134.01](#).

An information disclosure statement filed in accordance with the provisions of [37 CFR 1.97](#) and [37 CFR 1.98](#) will be considered by the examiner assigned to the application. Individuals associated in a substantive way with the filing and prosecution of a patent application are encouraged to submit information to the Office so the examiner can evaluate its relevance to the claimed invention. The procedures for submitting an information disclosure statement under the rules are designed to encourage individuals to submit information to the Office promptly and in a uniform manner. These rules provide certainty for the public by defining the requirements for submitting information disclosure statements to the Office so that the Office will consider information contained therein before a patent is granted.

The filing of an information disclosure statement shall not be construed as a representation that a search has been made. [37 CFR 1.97\(g\)](#). There is no requirement that an applicant for a patent make a patentability search. Further, the filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in [37 CFR 1.56\(b\)](#). [37 CFR 1.97\(h\)](#). See [MPEP § 2129](#) regarding admissions by applicant.

In order to have information considered by the Office during the pendency of a patent application, an

information disclosure statement must be (1) in compliance with the content requirements of [37 CFR 1.98](#), (2) filed in accordance with the procedural requirements of [37 CFR 1.97](#) and (3) signed in compliance with [37 CFR 1.33\(b\)](#) (e.g., a separate signed page which references and accompanies the IDS). An eIDS submission in compliance with the Legal Framework for Patent Electronic System ([MPEP § 502.03](#)) would satisfy the signature requirement. The requirements as to content are discussed in [MPEP § 609.04\(a\)](#). The requirements based on the time of filing the statement are discussed in [MPEP § 609.04\(b\)](#). Examiner handling of information disclosure statements is discussed in [MPEP § 609.05](#). For discussion of IDS filed electronically (eIDS) via the USPTO patent electronic filing system, see [MPEP § 609.07](#). For discussion of electronic processing of IDS, see [MPEP § 609.08](#).

Once the minimum requirements of [37 CFR 1.97](#), [37 CFR 1.98](#), and [37 CFR 1.33\(b\)](#) are met, the examiner has an obligation to consider the information. There is no requirement that the information must be prior art references in order to be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO/SB/08 or its equivalent mean that the information has been considered by the examiner to the extent noted above. In addition, the following alternative electronic signature method may be used by examiners in information disclosure statements to indicate whether the information has been considered. Examiners will no longer initial each reference citation considered, but will continue to strikethrough each citation not considered. Each page of reference citations will be stamped by the examiner with the phrase “All references considered except where lined through” along with the examiner’s electronic initials, and the final page of reference citations will include the examiner’s electronic signature. Information submitted to the Office that does not comply with the requirements of [37 CFR 1.97](#), [37 CFR 1.98](#), and [37 CFR 1.33\(b\)](#)

will not be considered by the Office but will be placed in the application file.

Multiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements of [37 CFR 1.97](#), [37 CFR 1.98](#) and [37 CFR 1.33\(b\)](#). Use of form PTO/SB/08, “Information Disclosure Statement,” is encouraged as a means to provide the required list of information as set forth in [37 CFR 1.98\(a\)\(1\)](#). Applicants are encouraged to use the USPTO form PTO/SB/08 when preparing an information disclosure statement because this form is updated by the Office. The form PTO/SB/08 will enable applicants to comply with the requirement to list each item of information being submitted and to provide the Office with a uniform listing of citations and with a ready way to indicate that the information has been considered. A copy of form PTO/SB/08 is reproduced at the end of this section.

### 609.01 Examiner Checklist for Information Disclosure Statements [R-01.2024]

Examiners must check to see if an information disclosure statement (IDS) complies with:

(A) All the time-related requirements of [37 CFR 1.97](#), which are based on the time of the filing of the IDS. See [MPEP § 609.04\(b\)](#) for more information.

<b>Time when IDS is filed</b>	<b><a href="#">37 CFR 1.97</a> Requirements</b>
(1)(a) for national applications (not including CPAs), within three months of filing or before first Office action on the merits, whichever is later; (b) for national stage applications, within three months of entry into national stage or before first Office action on the merits, whichever is later; (c) for RCEs and CPAs before the first Office action on the merits; or (d) for international design applications, within three months of the date of publication of the international	None

<b>Time when IDS is filed</b>	<b><a href="#">37 CFR 1.97</a> <b>Requirements</b></b>
registration under Hague Agreement Article 10(3) or before first Office action on the merits, whichever is later.	
(2) After (1) but before final action, notice of allowance, or <i>Quayle</i> action	<a href="#">1.97(e)</a> statement or <a href="#">1.17(p)</a> fee.
(3) After (2) and before (or with) payment of issue fee.	<a href="#">1.97(e)</a> statement, and <a href="#">1.17(p)</a> fee.
(4) After payment of issue fee.	IDS will not be considered.

- (a) Each cited foreign patent document;
- (b) Each cited non-patent literature publication, or the portion therein which caused it to be listed;
- (c) Each cited U.S. pending application that is not stored in IFW;
- (d) All information cited (e.g., an affidavit or Office action), other than the specification, including claims and drawings, of a pending U.S. application; and
- (e) All other cited information or the portion which caused it to be listed.

(B) All content requirements of [37 CFR 1.98](#). See [MPEP § 609.04\(a\)](#) for more information.

(1) Requirements for the IDS listing:

(a) A separate section for citations of U.S. patents and U.S. patent application publications;

(b) The application number of the application in which the IDS is being submitted on each page of the listing, if known;

(c) A column that provides a blank space next to each citation for the examiner's initials when the examiner considers the cited document; and

(d) A heading on the listing that clearly indicates that the list is an Information Disclosure Statement;

(e) Proper identification of all cited references:

(i) U.S. patents cited by patent number, issue date and inventor(s);

(ii) U.S. patent application publications cited by publication number, publication date and inventor(s);

(iii) Pending U.S. applications cited by application number, filing date and inventor(s);

(iv) Foreign patent documents cited by document number, country and publication or issue date; and

(v) Non-patent literature cited by publisher, author (if any), title, relevant pages (when no page numbers are supplied, it is understood that all of the pages of the publication are the relevant pages), and date and place of publication.

(2) The requirement of copies for:

(3) For non-English documents that are cited, the following must be provided:

(a) A concise explanation of the relevance, as it is presently understood by the individual designated in [37 CFR 1.56\(c\)](#) most knowledgeable about the content of the information, unless a complete translation is provided; and/or

(b) A written English language translation of a non-English language document, or portion thereof, if it is within the possession, custody or control of, or is readily available to any individual designated in [37 CFR 1.56\(c\)](#).

After the examiner reviews the IDS for compliance with [37 CFR 1.97](#) and [1.98](#) (see [MPEP § 609.05](#)), the examiner should:

(A) Consider the information properly submitted in an IDS in the same manner that the examiner considers other documents in Office search files while conducting a search of the prior art in a proper field of search.

(1) For eIDS, use the eIDS icon on examiner's workstation to consider cited U.S. patents and U.S. patent application publications. See [MPEP § 609.07](#) for more information on eIDS.

(2) Initial the blank column next to the citation to indicate that the information has been considered by the examiner, or use the alternative electronic signature method by inserting on each page of reference citations the phrase "All references considered except where lined through" along with the examiner's electronic initials, and providing the examiner's electronic signature on the final page of reference citations.

(B) Draw a line through the citation to show that it has not been considered if the citation fails to comply with all the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#). The examiner should inform applicant the reasons why a citation was not considered. If a *bona fide* attempt is made to comply with the content requirements of [37 CFR 1.98](#), but part of the required content is inadvertently omitted, additional time may be given to enable full compliance pursuant to [37 CFR 1.97\(f\)](#). See [MPEP § 609.04\(b\)](#), subsection VI and form paragraph 6.51.

(C) Write “not considered” on an information disclosure statement if none of the information listed complies with the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#). The examiner will inform applicant the reasons why the IDS was not considered by using form paragraphs 6.49 through 6.49.10.

(D) Sign and date the bottom of the IDS listing, or use the alternative electronic signature method noted in item (A)(2) above.

(E) Ensure that a copy of the IDS listing that is signed and dated by the examiner is entered into the file and mailed to applicant.

For discussion of electronic processing of IDS, see [MPEP § 609.08](#).

## **609.02 Information Disclosure Statements in Continued Examinations or Continuing Applications [R-07.2015]**

### **I. CONSIDERATION OF PRIOR ART CITED IN A PARENT INTERNATIONAL APPLICATION**

When filing a continuing application that claims benefit under [35 U.S.C. 120](#) to a parent application (other than an international application that designated the U.S.), it will not be necessary for the applicant to submit an information disclosure statement in the continuing application that lists the prior art cited by the examiner in the parent application unless the applicant desires the information to be printed on the patent issuing from the continuing application (for continued prosecution applications filed under [37 CFR 1.53\(d\)](#), see subsection A.1. below). The examiner of the continuing application will consider information which has been considered by the Office in the parent application.

When filing a continuing application that claims benefit under [35 U.S.C. 120](#) to an international application that designated the U.S. (see [MPEP § 1895](#)), it will be necessary for the applicant to submit an information disclosure statement complying with [37 CFR 1.97](#) and [1.98](#) in the continuing application listing the documents cited in the international search report and/or the international preliminary examination report of the international application if applicant wishes to ensure that the information is considered by the examiner in the continuing application.

See [MPEP § 609.03](#) for consideration of documents cited in the international search report in a PCT national stage application.

### **II. IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS**

#### ***A. IDS That Has Been Considered (1) in the Parent Application, or (2) Prior to the Filing of a Request for Continued Examination (RCE)***

##### **1. Continued Prosecution Applications (CPAs) Filed Under 37 CFR 1.53(d)**

Information which has been considered by the Office in the parent application of a continued prosecution application (CPA) filed under [37 CFR 1.53\(d\)](#) will be part of the file before the examiner and need not be resubmitted in the continuing application to have the information considered and listed on the patent.

##### **2. Continuation Applications, Divisional Applications, or Continuation-in-Part Applications Filed Under 37 CFR 1.53(b)**

The examiner will consider information which has been considered by the Office in a parent application (other than an international application; see subsection I., above) when examining: (A) a continuation application filed under [37 CFR 1.53\(b\)](#), (B) a divisional application filed under [37 CFR 1.53\(b\)](#), or (C) a continuation-in-part application filed under [37 CFR 1.53\(b\)](#). A listing of the information need not be resubmitted in the



continuing application unless the applicant desires the information to be printed on the patent.

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in [37 CFR 1.98\(a\)\(1\)](#) and the timing requirements of [37 CFR 1.97](#). Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications. A completed PTO/SB/08 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application.

### **3. Requests for Continued Examination (RCE) Under 37 CFR 1.114**

Information which has been considered by the Office in the application before the filing of a RCE will be part of the file before the examiner and need not be resubmitted to have the information considered by the examiner and listed on the patent.

#### ***B. IDS That Has Not Been Considered (1) in the Parent Application, or (2) Prior to the Filing of a Request for Continued Examination***

#### **1. Continued Prosecution Applications Filed Under 37 CFR 1.53(d)**

Information filed in the parent application that complies with the content requirements of [37 CFR 1.98](#) will be considered by the examiner in the CPA. No specific request from the applicant that the previously submitted information be considered by the examiner is required.

#### **2. Continuation Applications, Divisional Applications, or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)**

For these types of applications, in order to ensure consideration of information previously submitted, but not considered, in a parent application, applicant must resubmit the information in the continuing application in compliance with [37 CFR 1.97](#) and [37 CFR 1.98](#). Pursuant to [37 CFR 1.98\(d\)](#), if the IDS submitted in the parent application complies with [37 CFR 1.98\(a\)](#) to [\(c\)](#), copies of the patents, publications, pending U.S. applications, or other information submitted in the parent application need not be resubmitted in the continuing application.

When resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in [37 CFR 1.98\(a\)\(1\)](#). Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications. A PTO/SB/08 form from another application may already have the application number of another application. This information will likely confuse the record.

#### **3. Requests for Continued Examination Under 37 CFR 1.114**

Information filed in the application in compliance with the content requirements of [37 CFR 1.98](#) before the filing of a RCE will be considered by the examiner after the filing of the RCE. For example, an applicant filed an IDS in compliance with [37 CFR 1.98](#) after the mailing of a final Office action, but the IDS did not comply with the requirements of [37 CFR 1.97\(d\)\(1\)](#) and [\(d\)\(2\)](#) and therefore, the IDS was not considered by the examiner. After applicant files a RCE, the examiner will consider the IDS filed prior to the filing of the RCE. For more details on RCE, see [MPEP § 706.07\(h\)](#).

### **609.03 Information Disclosure Statements in National Stage Applications [R-07.2022]**

When examining a PCT national stage application, the examiner will consider all U.S. patents, U.S. patent application publications, and U.S. pending applications cited in the international search report that are stored electronically in the USPTO's Image



File Wrapper (IFW) system. The examiner will consider other documents cited in the international search report when the Form PCT/DO/EO/903 in the national stage application indicates that both the international search report and the copies of the documents are present in the national stage file. In such a case, the examiner should consider the documents from the international search report and indicate by a statement in the first Office action that the information has been considered. There is no requirement that the examiner list the documents on a PTO-892 form and there is no requirement for the applicant to provide a separate listing of the references. However, the citations will not be printed on the face of the patent unless listed on a list that lends itself to easy capture of the necessary information by the Office printing contractor. See [MPEP § 609.06](#).

In a national stage application, the following form paragraphs may be used where appropriate to notify applicant regarding references listed in the search report of the international application:

**¶ 6.53 References Considered in 35 U.S.C. 371 Application Based Upon Search Report - Prior to Allowance**

The references cited in the PCT international search report by the [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with [37 CFR 1.98\(a\)\(1\)](#). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08 form, must be filed within the set period for reply to this Office action.

**Examiner Note:**

1. In bracket [1], identify the office (e.g., JPO, EPO, etc.) that issued the international search report and the date it issued.
2. This form paragraph may be used for national stage applications under [35 U.S.C. 371](#) where the examiner has obtained copies of the cited references or where copies of such references are not required under [37 CFR 1.98](#). If receipt of copies of references required under [37 CFR 1.98](#) is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply such copies for consideration. See [MPEP § 1893.03\(g\)](#).
3. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.
4. This form paragraph should only be used prior to allowance when a statutory period for reply is being set in the Office action.
5. If the application is being allowed, form paragraph 6.54 should be used with the Notice of Allowability instead of this form paragraph.

**¶ 6.54 References Considered in 35 U.S.C. 371 Application Based Upon Search Report - Ready for Allowance**

The references cited in the PCT international search report by the [1] have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with [37 CFR 1.98\(a\)\(1\)](#). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08 form, must be filed within ONE MONTH of the mailing date of this communication. NO EXTENSION OF TIME WILL BE GRANTED UNDER EITHER [37 CFR 1.136\(a\)](#) OR (b) to comply with this requirement.

**Examiner Note:**

1. In bracket [1], identify the office (e.g., JPO, EPO, etc.) that issued the international search report and the date it issued.
2. This form paragraph may be used for national stage applications under [35 U.S.C. 371](#) where the examiner has obtained copies of the cited references or where copies of such references are not required under [37 CFR 1.98](#). If receipt of copies of references required under [37 CFR 1.98](#) is not indicated on the PCT/DO/EO/903 form in the file, burden is on the applicant to supply such copies for consideration. See [MPEP § 1893.03\(g\)](#).
3. Instead of using this form paragraph, the examiner may list the references on a PTO-892, thereby notifying the applicant that the references have been considered and will be printed on any patent resulting from this application.

**¶ 6.55 References Not Considered in 35 U.S.C. 371 Application Based Upon Search Report**

The listing of references in the PCT international search report is not considered to be an information disclosure statement (IDS) complying with [37 CFR 1.98](#). [37 CFR 1.98\(a\)\(2\)](#) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see [37 CFR 1.98\(a\)\(1\) and \(b\)](#)), and [MPEP § 609.04\(a\)](#), subsection I. states, “the list ... must be submitted on a separate paper.” Therefore, the references cited in the international search report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all “statement” requirements of [37 CFR 1.97\(e\)](#). See [MPEP § 609.05\(a\)](#).

**Examiner Note:**

1. This form paragraph may be used in national stage applications under [35 U.S.C. 371](#).

2. Do not use this form paragraph when the missing references are U.S. patents, U.S. patent application publications, or U.S. pending applications that are stored in IFW.

## **609.04 Content and Timing Requirements for an Information Disclosure Statement [R-07.2022]**

### **609.04(a) Content Requirements for an Information Disclosure Statement [R-07.2022]**

An information disclosure statement (IDS) must comply with the provisions of [37 CFR 1.98](#) as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection I., II., and III. below. If a *bona fide* attempt is made to comply with the content requirements of [37 CFR 1.98](#), but part of the required content is inadvertently omitted, additional time may be given to enable full compliance pursuant to [37 CFR 1.97\(f\)](#). See [MPEP § 609.04\(b\)](#), subsection VI and form paragraph 6.51.

#### **I. LIST OF ALL PATENTS, PUBLICATIONS, U.S. APPLICATIONS, OR OTHER INFORMATION**

Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.

[37 CFR 1.98\(a\)\(1\)](#) requires the following format for an IDS listing: (A) a specified format/identification for each page of an IDS, and that U.S. patents and U.S. patent application publications be listed in a section separately from citations of other documents; (B) a column that provides a space next to each document listed to permit the examiner's initials; and (C) a heading that identifies the list as an IDS.

[37 CFR 1.98\(a\)\(1\)](#) specifically requires that U.S. patents and U.S. patent application publications be listed separately from the citations of other documents. The separation of citations will permit the Office to obtain the U.S. patent numbers and the U.S. patent application publication numbers by optical character recognition (OCR) from the

scanned documents such that the documents can be made available electronically to the examiner to facilitate searching and retrieval of the cited U.S. patents and U.S. patent application publications from the Office's search databases. Applicants will comply with this requirement if they use forms PTO/SB/08, which provide a separate section for listing U.S. patents and U.S. patent application publications. Applicants who do not use these forms for submitting an IDS must make sure that the U.S. patents and U.S. patent application publications are listed in a separate section from citations of other documents.

[37 CFR 1.98\(a\)\(1\)](#) also requires that each page of the list must clearly identify the application number of the application in which the IDS is being submitted, if known. In the past, the Office has experienced problems associated with lists that do not properly identify the application in which the IDS is being submitted (e.g., when applicants submit a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications). Even though the IDS cover sheet had the proper application number, each page of the list did not include the proper application number, but instead had the application numbers of the other applications. If the pages of the list became separated, the Office could not associate the pages with the proper application.

In addition, [37 CFR 1.98\(a\)\(1\)](#) requires that the list must include a column that provides a space next to each document listed in order to permit the examiner to enter their initials next to the citations of the documents that have been considered by the examiner. This provides a notification to the applicant and a clear record in the application to indicate which documents have been considered by the examiner in the application. Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 or PTO-892 forms from other applications. A completed PTO/SB/08 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide their initials, and the previously relevant

initials may be erroneously construed as being applied for the current application.

[37 CFR 1.98\(a\)\(1\)](#) also requires that each page of the list include a heading that clearly indicates that the list is an IDS. Since the Office treats an IDS submitted by the applicant differently than information submitted by a third party, a heading on each page of the list to indicate that the list is an IDS would promote proper treatment of the IDS submitted by the applicant and reduce handling errors.

[37 CFR 1.98\(b\)](#) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. The Office will also accept a citation in an IDS where a U.S. patent application publication is identified using the inventor instead of the applicant. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent or has been published, the applicant should list the patent or application publication in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, and date and place of publication. When no page numbers are supplied, it is understood that all of the pages of the publication are the relevant pages. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted

was published. See [MPEP § 707.05\(e\)](#), for more information on data that should be used when citing publications and electronic documents.

Pending U.S. applications that are being cited can be listed under the non-patent literature section or in a new section appropriately labeled. If applicant seeks consideration of documents other than the specification (including the claims) and drawings of an application, for example, Office actions, applicant must list such documents separately under the non-patent literature section or in a new section appropriately labeled. The USPTO would be understood to be the publisher/place of publication for a listed U.S. Office action or a U.S. application. Similarly, the foreign or international entity (*e.g.*, WIPO, EPO) would be understood to be the publisher/place of publication for a listed foreign or international search report.

For publications obtained from the internet, the uniform resource locator (URL) of the webpage that is the source of the publication must be provided for the place of publication (*e.g.*, "www.uspto.gov"). The publisher may be evident from the URL of the webpage. See [MPEP § 707.05\(e\)](#) for examples on listing documents retrieved from the internet, including social media posts and screen shots from videos. In particular, see examples 17 and 18. Further, for an internet publication obtained from a website that archives webpages, both the URL of the archived webpage submitted for consideration and the URL of the website from which the archived copy of the webpage was obtained should be provided on the document listing (*e.g.*, "Hand Tools , " w e b p a g e <<http://www.farmshopstore.com/handtools.html>>, 1 page, August 18, 2009, retrieved from Internet Archive Wayback Machine <<http://web.archive.org/web/20090818144217/http://www.farmshopstore.com/handtools.html>> on December 20, 2012). Where the actual publication date of a non-patent document is not known, the applicant must, at a minimum, provide a date of retrieval (*e.g.*, the date a webpage was retrieved) or a time frame (*e.g.*, a year, a month and year, a certain period of time ) when the document was available as a publication.

The list of information complying with the format requirements of [37 CFR 1.98\(a\)\(1\)](#) and the identification requirements of [37 CFR 1.98\(b\)](#) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A separate list will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered. Use of form PTO/SB/08, Information Disclosure Statement, to list the documents is encouraged.

## II. LEGIBLE COPIES

In addition to the list of information, each information disclosure statement must also include a legible copy of:

(A) Each foreign patent;

(B) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;

(C) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system. The requirement in [37 CFR 1.98\(a\)\(2\)\(iii\)](#) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system. *See Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications*, 1287 OG 163 (October 19, 2004); and

(D) All other information or that portion which caused it to be listed.

There is no requirement for a copy of each U.S. patent or U.S. patent application publication listed in an IDS unless required by the Office. [37 CFR 1.98\(a\)\(2\)](#).

[37 CFR 1.98\(a\)\(2\)\(iii\)](#) requires a copy of a pending U.S. application that is being cited in an IDS if (A) the cited information is not part of the specification, including the claims, and the drawings (e.g., an Office Action, remarks in an amendment paper, etc.), or (B) the cited application is not stored in the USPTO's IFW system. The requirement in [37 CFR 1.98\(a\)\(2\)\(iii\)](#) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system. This waiver is limited to the specification, including the claims, and drawings in the U.S. application (or portion of the application). If material other than the specification, including the claims, and drawings in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material.

A pending U.S. application only identified in the specification's background information rather than being cited separately on an IDS listing is not part of an IDS submission. Therefore, the requirements of [37 CFR 1.98\(a\)\(2\)\(iii\)](#) of supplying a copy of the pending application is not applicable. Pursuant to [37 CFR 1.98\(a\)\(2\)\(iii\)](#), applicant may choose to cite only a portion of a pending application including any claims directed to that portion rather than the entire application. There are exceptions to this requirement that a copy of the information must be provided. First, [37 CFR 1.98\(d\)](#) states that a copy of any patent, publication, pending U.S. application, or other information listed in an information disclosure statement is not required to be provided if: (A) the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under [35 U.S.C. 120](#); and (B) the IDS submitted in the earlier application complies with [37 CFR 1.98\(a\)-\(c\)](#). If both of these conditions are met, the examiner will consider the information previously cited or submitted to the Office and



considered by the Office in a prior application relied on under [35 U.S.C. 120](#). This exception to the requirement for copies of information does not apply to information which was cited in an international application under the Patent Cooperation Treaty. If the information cited or submitted in the prior application was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application. See subsection III. below.

Second, [37 CFR 1.98\(c\)](#) states that when the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications may be submitted without copies of the other patents or publications provided that a statement is made that these other patents or publications are cumulative. The examiner will then consider only the patent or publication of which a copy is submitted and will so indicate on the list, form PTO/SB/08, submitted, e.g., by crossing out the listing of the cumulative information. But see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1374, 54 USPQ2d 1001, 1005 (Fed. Cir. 2000) (Reference was not cumulative since it contained a more complete combination of the claimed elements than any other reference before the examiner. “A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references.” (citations omitted).).

[37 CFR 1.98\(a\)\(3\)\(ii\)](#) states that if a written English language translation of a non-English language document, or portion thereof, is within the possession, custody or control of, or is readily available to any individual designated in [37 CFR 1.56\(c\)](#), a copy of the translation shall accompany the statement. Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in

the same manner that non-English language information in Office search files is considered by examiners in conducting searches.

Electronic means or medium for filing IDSs are not permitted except for: (A) IDSs electronically submitted using the USPTO patent electronic filing system (see [MPEP § 609.07](#)); or (B) copies of large tables, computer program listings, and sequence listings submitted as a PDF file and a “Sequence Listing XML” submitted as an XML file on a read-only optical disc in compliance with [37 CFR 1.52\(e\)\(2\)](#) and [\(3\)](#) which are cited in a paper IDS. A read-only optical disc cannot be used to submit an IDS listing or copies of the documents cited in the IDS (except for large tables, a computer program listing, a sequence listing, and a “Sequence Listing XML”, discussed above). For example, published information, such as the visual output of a software program or a video, may be submitted only if reduced to writing, such as in the form of screen shots and/or a transcript.

### III. CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in [37 CFR 1.56\(c\)](#) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or part of the specification. If the concise explanation is part of the specification, the IDS listing should include the page(s) or line(s) numbers where the concise explanation is located in the specification.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in [37 CFR 1.56\(c\)](#) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. There is no requirement for the translation to be verified, including reliable machine translations. An



English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application being listed in an information disclosure statement. The English language equivalent application should be separately listed and identified as an English language equivalent in the information disclosure statement. Submission of an English language abstract of a reference, such as one generated by a foreign patent office, may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under [35 U.S.C. 120](#).

If information cited or submitted in a prior application relied on under [35 U.S.C. 120](#) was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) (“[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere

authorizes the applicant to intentionally omit altogether key teachings of the reference.”).

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The untranslated portions of the Japanese reference “contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO.” 204 F.3d at 1376, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. “The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner’s attention from the reference’s relevant teaching.” 204 F.3d at 1378, 54 USPQ2d at 1008.

Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

#### **609.04(b) Timing Requirements for an Information Disclosure Statement [R-07.2022]**

The procedures and requirements under [37 CFR 1.97](#) for submitting an information disclosure statement are linked to four stages in the processing of a patent application:

(1)(a) for national applications (not including CPAs), within three months of filing, or before the mailing of a first Office action on the merits, whichever is later;

(b) for international applications, within three months of the date of entry of the national stage as set forth in [37 CFR 1.491](#) or before the mailing of a first Office action on the merits in the national stage application, whichever is later;

(c) for continued examinations (i.e., RCEs filed under [37 CFR 1.114](#)) and CPAs filed under [37 CFR 1.53\(d\)](#), before the mailing of a first Office action on the merits;

(d) for international design applications, within three months of the date of publication of the international registration under Hague Agreement Article 10(3) or before first Office action on the merits, whichever is later;

(2) after the period in (1), but prior to the prosecution of the application closes, i.e., before the mailing of a final Office action, a Notice of Allowance, or an *Ex parte Quayle* action, whichever is earlier;

(3) after the period in (2) but on or before the date the issue fee is paid; and

(4) after the period in (3) and up to the time the patent application can be effectively withdrawn from issue under [37 CFR 1.313\(c\)](#).

These procedures and requirements apply to applications filed under [35 U.S.C. 111\(a\)](#) (utility), [161](#) (plants), [171](#) (designs), and [251](#) (reissue), as well as international applications entering the national stage under [35 U.S.C. 371](#).

The requirements based on the time when the information disclosure statement is filed are summarized in [MPEP § 609.01](#).

**I. INFORMATION DISCLOSURE STATEMENT FILED BEFORE FIRST ACTION ON THE MERITS OR WITHIN THREE (3) MONTHS OF ACTUAL FILING DATE, NATIONAL STAGE ENTRY DATE, OR PUBLICATION UNDER ARTICLE 10(3) OF THE HAGUE AGREEMENT (37 CFR 1.97(b))**

An information disclosure statement will be considered by the examiner if filed within any one of the following time periods:

(A) for national applications (not including CPAs), within three months of the filing date of the national application or before the mailing date of a first Office action on the merits;

(B) for international applications, within three months of the date of entry of the national stage as set forth in [37 CFR 1.491](#) or before the mailing date of a first Office action on the merits;

(C) for RCEs and CPAs, before the mailing date of a first Office action on the merits; or

(D) for international design applications, within three months of the date of publication of the international registration under Hague Agreement Article 10(3) or before first Office action on the merits, whichever is later

An information disclosure statement filed within one of these periods requires neither a fee nor a statement under [37 CFR 1.97\(e\)](#). An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of mailing if accompanied by a properly executed certificate of mailing or facsimile transmission under [37 CFR 1.8](#), or if it is in compliance with the provisions of Priority Mail Express® delivery under [37 CFR 1.10](#). If the last day of the three months period set forth in [37 CFR 1.97\(b\)\(1\)](#) and [\(b\)\(2\)](#) falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the IDS may be timely filed on the next succeeding business day which is not a Saturday, Sunday, or a federal holiday. See [37 CFR 1.7\(a\)](#). An Office action is mailed on the date indicated in the Office action.

It would not be proper to make final a first Office action in a continuing application or in an application after the filing of an RCE if the information submitted in the IDS during the time period set forth in [37 CFR 1.97\(b\)](#) is used in a new ground of rejection.

**A. National Applications, International Applications, and International Design Applications**

The term “national application” includes continuing applications (continuations, divisions, and continuations-in-part but not CPAs), so three months will be measured from the actual filing date of an application as opposed to the effective filing date of a continuing application. For international applications, the three months will be measured from the date of entry of the national stage. For international design applications, the three months will be measured from the date of publication of the

international registration under Hague Agreement Article 10(3).

All information disclosure statements that comply with the content requirements of [37 CFR 1.98](#) and are filed within three months of the filing date, will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action, a notice of allowance, or an *Ex parte Quayle* action is mailed prior to a date which is three months from the filing date, any information contained in a complete information disclosure statement filed within that three-month window will be considered by the examiner.

Likewise, an information disclosure statement will be considered if it is filed later than three months after the application filing date but before the mailing date of a first Office action on the merits. An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirement ([37 CFR 1.142](#)) or just a requirement for additional fees to have a claim considered ([37 CFR 1.16](#)). Thus, if an application was filed on January 2 and the first Office action on the merits was not mailed until six months later on July 2, the examiner would be required to consider any proper information disclosure statement filed prior to July 2.

#### **B. RCE and CPA**

The three-month window as discussed above does not apply to a RCE filed under [37 CFR 1.114](#) or a CPA filed under [37 CFR 1.53\(d\)](#) (effective July 14, 2003, CPAs are only available for design applications). An IDS filed after the filing of a RCE will be considered if the IDS is filed before the mailing date of a first Office action on the merits. A RCE is not the filing of an application, but merely the continuation of prosecution in the current application. After the mailing of a RCE, such application is treated as an amended application by the examiner and is subject to a short turnover time. Therefore, applicants are encouraged to file any IDS

with the filing of a RCE. See [MPEP § 706.07\(h\)](#) for details on RCEs.

Similarly, an IDS filed in a CPA will be considered if the IDS is filed before the mailing date of a first Office action on the merits. Applicants are encouraged to file any IDS in a CPA as early as possible, preferably at the time of filing of the CPA request.

If an IDS cannot be filed before the mailing of a first Office action on the merits (generally within two months from the filing of the RCE or CPA), applicants may request a three-month suspension of action under [37 CFR 1.103\(c\)](#) in an application at the time of filing of the RCE, or under [37 CFR 1.103\(b\)](#) in a CPA, at the time of filing of the CPA. Where an IDS is mailed to the Office shortly before the expiration of a three-month suspension under [37 CFR 1.103\(b\)](#) or (c), applicant is requested to make a courtesy call to notify the examiner as to the IDS submission.

#### **II. INFORMATION DISCLOSURE FILED AFTER I. ABOVE BUT BEFORE MAILING OF FINAL ACTION, NOTICE OF ALLOWANCE, OR AN EX PARTE QUAYLE ACTION (37 CFR 1.97(c))**

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection I. above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following):

a final action under [37 CFR 1.113](#), e.g., final rejection;

a notice of allowance under [37 CFR 1.311](#); or

an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action,

whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in [37 CFR 1.97\(e\)](#) (see the discussion in subsection V below); or (2) the fee set forth in [37 CFR 1.17\(p\)](#). If a final action, notice of allowance, or an *Ex parte Quayle* action is mailed in an application and later withdrawn, the application

will be considered as not having had a final action, notice of allowance, or an *Ex parte Quayle* action mailed for purposes of considering an information disclosure statement.

An *Ex parte Quayle* action is an action that closes the prosecution in the application as referred to in [37 CFR 1.97\(c\)](#). Therefore, an information disclosure statement filed on the same day as or after the mailing date of an *Ex parte Quayle* action must comply with the provisions of [37 CFR 1.97\(d\)](#).

The filing of a notice of appeal under [37 CFR 41.31](#) also closes prosecution of the application. Therefore, an information disclosure statement filed on the same day as or after the mailing date of a notice of appeal must comply with the provisions of [37 CFR 1.97\(d\)](#).

#### A. Information is Used in a New Ground of Rejection

##### 1. Final Rejection is Not Appropriate

If information submitted during the period set forth in [37 CFR 1.97\(c\)](#) with a statement under [37 CFR 1.97\(e\)](#) is used in a new ground of rejection on unamended claims, the next Office action will not be made final since in this situation it is clear that applicant has submitted the information to the Office promptly after it has become known and the information is being submitted prior to a final determination on patentability by the Office.

##### 2. Final Rejection Is Appropriate

The information submitted with a statement under [37 CFR 1.97\(e\)](#) can be used in a new ground of rejection and the next Office action can be made final, if the new ground of rejection was necessitated by amendment of the application by applicant. Where the information is submitted during this period with a fee as set forth in [37 CFR 1.17\(p\)](#), the examiner may use the information submitted, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See [MPEP § 706.07\(a\)](#).

### III. INFORMATION DISCLOSURE STATEMENT FILED AFTER II. ABOVE BUT PRIOR TO PAYMENT OF ISSUE FEE (37 CFR 1.97(d))

An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a final action under [37 CFR 1.113](#); a notice of allowance under [37 CFR 1.311](#); or an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

- (A) a statement as specified in [37 CFR 1.97\(e\)](#) (see the discussion in subsection V; and
- (B) the fee set forth in [37 CFR 1.17\(p\)](#).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee ([37 CFR 1.17\(p\)](#)) and submission of the appropriate statement ([37 CFR 1.97\(e\)](#)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of [37 CFR 1.98](#) are satisfied.

An information disclosure statement filed during this time period will be handled by the examiner as a “Printer Rush”. See [MPEP § 1309.02](#).

Form paragraph 6.52 may be used to inform the applicant that the information disclosure statement is being considered.

#### ¶ 6.52 Information Disclosure Statement Filed After Prosecution Has Been Closed

The information disclosure statement (IDS) submitted on [1] was filed after the mailing date of the [2] on [3]. The submission is in compliance with the provisions of [37 CFR 1.97](#). Accordingly, the information disclosure statement is being considered by the examiner.

##### Examiner Note:

1. In bracket 1, insert the date the IDS was filed.
2. In bracket 2, insert --final Office action--, --Notice of Allowance--, or an -- *Ex parte Quayle* action-- as appropriate.

The requirements of [37 CFR 1.97](#) provide for consideration by the Office of information which is submitted within a reasonable time, i.e., within three



months after an individual designated in [37 CFR 1.56\(c\)](#) becomes aware of the information or within three months of the information being cited in a communication from a foreign patent office in a counterpart foreign application. This undertaking by the Office to consider information would be available throughout the pendency of the application until the point where the patent issue fee was paid.

If an applicant chose not to comply, or could not comply, with the requirements of [37 CFR 1.97\(d\)](#), the applicant may file a RCE under [37 CFR 1.114](#), or a continuing application under [37 CFR 1.53\(b\)](#) (or [37 CFR 1.53\(d\)](#) if the application is a design application) to have the information considered by the examiner. If the applicant files a continuing application under [37 CFR 1.53\(b\)](#), the parent application could be permitted to become abandoned by not paying the issue fee required in the Notice of Allowance. If the prior application is a design application, the filing of a continued prosecution application under [37 CFR 1.53\(d\)](#) automatically abandons the prior application. See the discussion in [MPEP § 609.02](#).

#### **IV. INFORMATION DISCLOSURE STATEMENT FILED AFTER PAYMENT OF ISSUE FEE**

After the issue fee has been paid on an application, it is impractical for the Office to attempt to consider newly submitted information. Information disclosure statements filed after payment of the issue fee in an application will not be considered but will merely be placed in the application file. See [MPEP § 609.05\(b\)](#). The application may be withdrawn from issue at this point, pursuant to [37 CFR 1.313\(c\)\(2\)](#) or [1.313\(c\)\(3\)](#) so that the information can be considered in the application upon the filing of a RCE under [37 CFR 1.114](#) or in a continuing application filed under [37 CFR 1.53\(b\)](#) (or [37 CFR 1.53\(d\)](#) if the application is a design application). In this situation, a RCE, or a CPA (if the prior application is a design application), or a continuing application filed under [37 CFR 1.53\(b\)](#) could be filed even though the issue fee had already been paid. See [MPEP § 1308](#). Applicants are encouraged to file the petition under [37 CFR 1.313\(c\)\(2\)](#) with a RCE, or the petition under [37 CFR 1.313\(c\)\(3\)](#) with a CPA or continuing application under [37 CFR 1.53\(b\)](#), by the USPTO patent electronic filing system (see

[MPEP § 502.05](#)) or facsimile transmission to the Office of Petitions (see [MPEP § 502.01](#), subsection I.B. and [§ 1730](#) for the facsimile number). Alternatively, petitions to withdraw from issue may be hand-carried to the Office of Petitions (see [MPEP § 502](#)). The Office cannot ensure that any petition under [37 CFR 1.313\(c\)](#) will be acted upon prior to the date of patent grant. Applicants considering filing a petition under [37 CFR 1.313\(c\)](#) are encouraged to call the Office of Petitions to determine whether sufficient time remains before the patent issue date to consider and grant a petition under [37 CFR 1.313\(c\)](#). If a petition under [37 CFR 1.313\(c\)\(3\)](#) is being filed by facsimile transmission, the petition need not be accompanied by the information disclosure statement if the size of the statement makes its submission by facsimile impracticable, but the petition should indicate that an IDS will be filed in the continuing application if it does not accompany the petition under [37 CFR 1.313\(c\)\(3\)](#). The IDS should be filed before the mailing of a first Office action on the merits. If a design CPA is being filed and the IDS cannot be filed within this time period, applicants may request a three-month suspension of action under [37 CFR 1.103\(b\)](#) at the time of filing of the design CPA. See the discussion above in paragraph I.B. If a petition under [37 CFR 1.313\(c\)\(2\)](#) is being filed, the RCE must be accompanied by a proper submission in order for the RCE to be in compliance with [37 CFR 1.114](#). Therefore, the IDS must accompany the RCE and the petition under [37 CFR 1.313\(c\)\(2\)](#) if the IDS is the submission for the RCE.

In May of 2012 the Office launched the Quick Path Information Disclosure Statement (QPIDS) Pilot Program. This pilot program allows, under specific circumstances, for the submission of an IDS after payment of the issue fee but prior to patent grant. Information on the QPIDS Pilot Program can be found on the USPTO website [www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids](http://www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids).

Alternatively, for example, a petition pursuant to [37 CFR 1.313\(c\)\(1\)](#) could be filed if applicant states that one or more claims are unpatentable. This statement that one or more claims are unpatentable over the information must be unequivocal. A statement that a serious question as to patentability



of a claim has been raised, for example, would not be acceptable to withdraw an application from issue under [37 CFR 1.313\(c\)\(1\)](#). Form paragraph 13.09 may be used.

#### ¶ 13.09 Information Disclosure Statement, Issue Fee Paid

Applicant's information disclosure statement of [1] was filed after the issue fee was paid. Information disclosure statements filed after payment of the issue fee will not be considered, but will be placed in the file. However, the application may be withdrawn from issue in order to file a request for continued examination (RCE) under [37 CFR 1.114](#) upon the grant of a petition under [37 CFR 1.313\(c\)\(2\)](#), or a continuing application under [37 CFR 1.53\(b\)](#) (or a continued prosecution application (CPA) under [37 CFR 1.53\(d\)](#) if the CPA is for a design patent and the prior application of the CPA is a design application filed under 35 U.S.C. chapter 16) upon the grant of a petition filed under the provisions of [37 CFR 1.313\(c\)\(3\)](#). Alternatively, the other provisions of [37 CFR 1.313](#) may apply, e.g., a petition to withdraw the application from issue under the provisions of [37 CFR 1.313\(c\)\(1\)](#) may be filed together with an unequivocal statement by the applicant that one or more claims are unpatentable over the information contained in the statement. The information disclosure statement would then be considered upon withdrawal of the application from issue under [37 CFR 1.313\(c\)\(1\)](#).

#### Examiner Note:

1. For information disclosure statements submitted after the issue fee has been paid, use this form paragraph with form PTOL-90 or PTO-90C.
2. In bracket 1, insert the filing date of the IDS.

If an application has been withdrawn from issue under one of the provisions of [37 CFR 1.313\(c\)\(1\)-\(3\)](#), it will be treated as though no notice of allowance had been mailed and the issue fee had not yet been paid with regard to the time for filing information disclosure statements. Petitions under [37 CFR 1.313\(c\)](#) should be directed to the Office of Petitions in the Office of the Deputy Commissioner for Patents who oversees the Office of Petitions. See [MPEP § 1308](#).

#### V. STATEMENT UNDER 37 CFR 1.97(e)

A statement under [37 CFR 1.97\(e\)](#) must state either

- (1) that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or
- (2) that no item of information contained in the information disclosure statement was cited in a

communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in [37 CFR 1.56\(c\)](#) more than three months prior to the filing of the statement.

A statement under [37 CFR 1.97\(e\)](#) can contain either of two statements. One statement is that each item of information in an information disclosure statement was first cited in any communication, such as a search report, from a patent office outside the U.S. in a counterpart foreign application not more than three months prior to the filing date of the statement. Applicant would not be able to make a statement under [37 CFR 1.97\(e\)](#) where an item of information was first cited by a foreign patent office, for example, a year before the filing of the IDS, in a communication from that foreign patent office, and the same item of information is once again cited by another foreign patent office within three months prior to the filing of the IDS in the Office. Similarly, applicant would not be able to make a statement under [37 CFR 1.97\(e\)](#) where an item of information was cited in an examination report and the same item of information was previously cited more than three months prior to the filing of the IDS in the Office, in a search report from the same foreign patent office. Under this statement, it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. Note that compliance with the statement requirement of [37 CFR 1.97\(e\)](#) does not substitute for compliance with [37 CFR 1.704\(d\)](#) when attempting to avoid reduction of patent term adjustment.

The date on the communication by the foreign patent office begins the three-month period in the same manner as the mailing of an Office action starts a three-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the three-month period. The date which begins the three-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office,

or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under [37 CFR 1.8](#), or if it is in compliance with the provisions for Priority Mail Express® delivery under [37 CFR 1.10](#). If the last day of the three months period set forth in [37 CFR 1.97\(e\)\(1\)](#) and [\(e\)\(2\)](#) falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the statement under [37 CFR 1.97\(e\)\(1\)](#) or [\(e\)\(2\)](#) may be timely filed on the next succeeding business day which is not a Saturday, Sunday, or a federal holiday. See [37 CFR 1.7\(a\)](#).

The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application). Note, an international application filed under the Patent Cooperation Treaty, which designates the U.S., is not a counterpart foreign application for purposes of making the statement set forth in [37 CFR 1.97\(e\)](#). Therefore, applicant should, instead, consider the applicability of making a statement under [37 CFR 1.97\(e\)\(2\)](#) for information received in an international application.

Communications from foreign patent offices in foreign applications sometimes include a list of the family of patents corresponding to a particular patent being cited in the communication. The family of patents may include a United States patent or other patent in the English language. Some applicants submit information disclosure statements to the PTO which list and include copies of both the particular patent cited in the foreign patent office communication and the related United States or other English language patent from the family list. Since this is to be encouraged, the United States or other English language patent will be construed as being cited by the foreign patent office for purposes of a statement under [37 CFR 1.97\(e\)\(1\)](#). The examiner should consider the United States or other English language patent if [37 CFR 1.97](#) and [37 CFR 1.98](#) are complied with. Further, [37 CFR 1.97\(e\)\(1\)](#) is construed to include any information in a foreign patent office communication, including the

communication itself, such as an office action or search report.

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within three months of the date on the communication, the copy of the dated communication from the foreign patent office by itself will not be accepted as the required statement under [37 CFR 1.97\(e\)\(1\)](#) since it would not be clear from the dated communication whether the information in the IDS was “first cited” in any communication from a foreign patent office not more than three months prior to the filing of the IDS as required by [37 CFR 1.97\(e\)\(1\)](#).

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than three months prior to the filing of the statement. If an inventor of the U.S. application is also a named inventor of one of the items of information contained in the IDS, the [37 CFR 1.97\(e\)\(2\)](#) statement cannot be made for that particular item of information, and if made, will not be accepted.

The phrase “after making reasonable inquiry” makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being stated. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the statement under [37 CFR 1.97\(e\)\(2\)](#) without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under [37 CFR 1.97\(e\)\(2\)](#) to

the Office until a satisfactory response is received. The statement can be based on present, good faith knowledge about when information became known without a search of files being made.

A statement under [37 CFR 1.97\(e\)](#) need not be in the form of an oath or a declaration under [37 CFR 1.68](#). A statement under [37 CFR 1.97\(e\)](#) by a registered practitioner or any other individual that the statement was filed within the three-month period of either first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. For example, a statement under [37 CFR 1.97\(e\)](#) could read as follows:

I hereby state that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.,  
or

I hereby state that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Information Disclosure Statement was known to any individual designated in [37 CFR 1.56\(c\)](#) more than three months prior to the filing of this Information Disclosure Statement.

While use of the exact language of [37 CFR 1.97\(e\)\(1\)](#) and/or [37 CFR 1.97\(e\)\(2\)](#) is strongly encouraged, it is not required so long as the language applicant uses conveys the exact same meaning as the language of [37 CFR 1.97\(e\)\(1\)](#) and/or [37 CFR 1.97\(e\)\(2\)](#). Varying the language of the statements runs the risk that it does not convey the same meaning as the language of [37 CFR 1.97\(e\)\(1\)](#) and/or [37 CFR 1.97\(e\)\(2\)](#). If it is determined that the varying language does not (or may not) convey the same meaning, the information disclosure statement will not be accepted.

An information disclosure statement may include two lists and two statements, similar to the above examples, in situations where some of the information listed was cited in a communication from a foreign patent office not more than three months prior to filing the statement and some was not, but was not known more than three months prior to filing the statement. Alternatively, applicant may submit one list with two statements when applicant expressly designates which statement pertains to which citation(s) in the reference listing. If the information is being submitted in the time frame set forth in [37 CFR 1.97\(d\)](#) and applicant includes two statements with either one or two lists on the same day, only one fee is required.

A copy of the foreign search report need not be submitted with the statement under [37 CFR 1.97\(e\)](#), but an individual may wish to submit an English-language version of the search report to satisfy the requirement for a concise explanation where non-English language information is cited. The time at which information was known to any individual designated in [37 CFR 1.56\(c\)](#) is the time when the information was discovered in association with the application even if awareness of the materiality came later. The Office wishes to encourage prompt evaluation of the relevance of information and to have a date certain for determining if a statement under [37 CFR 1.97\(e\)](#) can properly be made. A statement on information and belief would not be sufficient. Examiners should not remind or otherwise make any comment about an individual's duty of candor and good faith. Questions about the adequacy of any statement received in writing by the Office should be directed to the Office of Patent Legal Administration.

#### **VI. EXTENSIONS OF TIME (37 CFR 1.97(f)) AND BONA FIDE ATTEMPT**

No extensions of time for filing an information disclosure statement are permitted under [37 CFR 1.136\(a\)](#) or [\(b\)](#). If a *bona fide* attempt is made to comply with the content requirements of [37 CFR 1.98](#), but part of the required content is inadvertently omitted, additional time may be given to enable full compliance. Form paragraph 6.51 may be used.

### ¶ 6.51 Time for Completing Information Disclosure Statement

The information disclosure statement filed on [1] does not fully comply with the requirements of [37 CFR 1.98\(b\)](#) because: [2]. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above-mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER [37 CFR 1.136\(a\)](#) OR [37 CFR 1.98\(b\)](#).** Failure to timely comply with this notice will result in the above-mentioned information disclosure statement being placed in the application file with the non-complying information **not** being considered. See [37 CFR 1.97\(i\)](#).

#### Examiner Note:

Use this form paragraph if an IDS complies with the timing requirements of [37 CFR 1.97](#) but part of the content requirements of [37 CFR 1.98\(b\)](#) has been inadvertently omitted.

This practice does not apply where there has been a deliberate omission of some necessary part of an Information Disclosure Statement or where the requirements based on the time of filing the statement, as set forth in [37 CFR 1.97](#), have not been complied with.

## 609.05 Examiner Handling of Information Disclosure Statements [R-08.2012]

Information disclosure statements will be reviewed for compliance with the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#) as discussed in [MPEP § 609.04\(a\)](#) and [§ 609.04\(b\)](#). Applicant will be notified of compliance and noncompliance with the rules as discussed in [MPEP § 609.05\(a\)](#) and [§ 609.05\(b\)](#).

### 609.05(a) Noncomplying Information Disclosure Statements [R-01.2024]

Pursuant to [37 CFR 1.97\(i\)](#), submitted information, filed before the grant of a patent, which does not comply with [37 CFR 1.97](#) and [37 CFR 1.98](#) will be placed in the file, but will not be considered by the Office. Information submitted after the grant of a patent must comply with [37 CFR 1.501](#).

If an information disclosure statement does not comply with the requirements based on the time of filing of the IDS as discussed in [MPEP § 609.04\(b\)](#), including the requirements for fees and/or statement under [37 CFR 1.97\(e\)](#), the IDS will be placed in the application file, but none of the information will be considered by the examiner. The examiner may use form paragraph 6.49 which is reproduced below to

inform applicant that the information has not been considered. Applicant may then file a new information disclosure statement or correct the deficiency in the previously filed IDS, but the date that the new IDS or correction is filed will be the date of the IDS for purposes of determining compliance with the requirements based on the time of filing of the IDS ([37 CFR 1.97](#)).

The examiner should write “not considered” on an information disclosure statement where none of the information listed complies with the requirements, e.g., the format requirements of [37 CFR 1.98\(a\)\(1\)](#) are not met. If none of the information listed on a PTO/SB/08 form is considered, a diagonal line or "X" should also be drawn across the form and the form made of record in the application file. The examiner will inform applicant that the information has not been considered and the reasons why by using form paragraphs 6.49 through 6.49.10. If the improper citation appears as part of another paper, e.g., an amendment, which may be properly entered and considered, the portion of the paper which is proper for consideration will be considered.

If an item of information in an IDS fails to comply with all the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#), that item of information in the IDS will not be considered and a line should be drawn through the citation to show that it has not been considered. However, other items of information that do comply with all the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#) will be considered by the examiner.

If information listed in the specification rather than in a separate paper, or if the other content requirements as discussed in [MPEP § 609.04\(a\)](#) are not complied with, the information need not be considered by the examiner, in which case, the examiner should notify applicant in the next Office action that the information has not been considered.

## FORM PARAGRAPHS

### ¶ 6.49 Information Disclosure Statement Not Considered

The information disclosure statement filed [1] fails to comply with the provisions of [37 CFR 1.97](#), [1.98](#) and [MPEP § 609](#) because [2]. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any resubmission of any item of information contained in this information



disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all requirements for statements under [37 CFR 1.97\(e\)](#). See [MPEP § 609.05\(a\)](#).

#### **Examiner Note:**

See [MPEP § 609.05\(a\)](#) for situations where the use of this form paragraph would be appropriate.

#### **¶ 6.49.01 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Statement**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(c\)](#) because it lacks a statement as specified in [37 CFR 1.97\(e\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

#### **¶ 6.49.02 Information Disclosure Statement Not Considered, After First Action, But Before the Prosecution of the Application Closes, No Fee**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(c\)](#) because it lacks the fee set forth in [37 CFR 1.17\(p\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

#### **¶ 6.49.03 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Statement**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(d\)](#) because it lacks a statement as specified in [37 CFR 1.97\(e\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

#### **¶ 6.49.05 Information Disclosure Statement Not Considered, After the Prosecution of the Application Closes, Issue Fee Not Paid, No Fee**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.97\(d\)](#) because it lacks the fee set forth in [37 CFR 1.17\(p\)](#). It has been placed in the application file, but the information referred to therein has not been considered.

#### **¶ 6.49.06 Information Disclosure Statement Not Considered, References Listed in Specification**

The listing of references in the specification is not a proper information disclosure statement. [37 CFR 1.98\(b\)](#) requires a list of all patents, publications, applications, or other information submitted for consideration by the Office, and [MPEP § 609.04\(a\)](#), subsection I, states, “the list may not be incorporated into the specification but must be submitted in a separate paper.” Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### **¶ 6.49.07 Information Disclosure Statement Not Considered, No Copy of References**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(2\)](#), which requires a legible copy of each cited foreign patent document; each non-patent literature

publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

#### **Examiner Note:**

Do not use this form paragraph when the missing reference(s) are U.S. patents, U.S. patent application publications, or U.S. pending applications (limited to the specification, including claims, and drawings) stored in IFW.

#### **¶ 6.49.08 Information Disclosure Statement Not Considered, Non-Compliant List of References**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(1\)](#), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner’s initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

#### **Examiner Note:**

If an IDS listing includes a copy of an initialed IDS listing from another application, the IDS listing would not comply with the requirements under [37 CFR 1.98\(a\)\(1\)](#). This form paragraph is applicable for such an IDS submission.

#### **¶ 6.49.09 Information Disclosure Statement Not Considered, No Explanation of Relevance of Non-English Language Information**

The information disclosure statement filed [1] fails to comply with [37 CFR 1.98\(a\)\(3\)\(i\)](#) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in [37 CFR 1.56\(c\)](#) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

#### **¶ 6.49.10 Information Disclosure Statement Not Considered, Non-acceptable Electronic Medium**

The information disclosure statement filed [1] was submitted on an electronic medium that was not acceptable. It has been placed in the application file, but the information referred to therein has not been considered. Note that U.S. patents, U.S. application publications, foreign patent documents and non-patent literature cited in an information disclosure statement may be electronically submitted in compliance with the USPTO patent electronic filing system requirements.



**Examiner Note:**

This form paragraph may be used when the IDS that includes patents and non-patent literature documents is submitted on read-only optical discs or any other electronic medium, except via the USPTO patent electronic filing system. Only “Large Tables,” “Sequence Listings,” a computer readable form of a “Sequence Listing” and a “Computer Program Listing Appendix” may be submitted on one or more read-only optical discs. See [37 CFR 1.52\(e\)](#).

**609.05(b) Complying Information Disclosure Statements [R-07.2022]**

The information contained in information disclosure statements which comply with both the content requirements of [37 CFR 1.98](#) and the requirements, based on the time of filing the statement, of [37 CFR 1.97](#) will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO/SB/08 or its equivalent mean that the information has been considered by the examiner to the extent noted above.

In addition, the following alternative electronic signature method may be used by examiners in information disclosure statements to indicate whether the information has been considered. Examiners will no longer initial each reference citation considered, but will continue to strikethrough each citation not considered. Each page of reference citations will be stamped by the examiner with the phrase “All references considered except where lined through” along with the examiner’s electronic initials, and the final page of reference citations will include the examiner’s electronic signature.

Examiners must consider all citations submitted in conformance with the rules, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO/SB/08 (or the examiner may use the alternative electronic signature method noted above) provides a clear record of which citations have been considered by the Office. The examiner must also fill in the examiner’s name and the date the information was

considered in blocks at the bottom of the PTO/SB/08 form. If any of the citations are considered, a copy of the submitted list, form PTO/SB/08, as reviewed by the examiner, will be returned to the applicant with the next communication. Those citations not considered by the examiner will have a line drawn through the citation. The original copy of the list, form PTO/SB/08, will be entered into the application file. The copy returned to applicant will serve both as acknowledgement of receipt of the information disclosure statement and as an indication as to which references were considered by the examiner. Forms PTO-326 and PTOL-37 include a box to indicate the attachment of form PTO/SB/08.

Information which complies with requirements as discussed in this section but which is in a non-English language will be considered in view of the concise explanation submitted (see [MPEP § 609.04\(a\)](#), subsection III.) and insofar as it is understood on its face, e.g., drawings, chemical formulas, in the same manner that non-English language information in Office search files is considered by examiners in conducting searches. The examiner need not have the information translated unless it appears to be necessary to do so. The examiner will indicate that the non-English language information has been considered in the same manner as consideration is indicated for information submitted in English. The examiner should not require that a translation be filed by applicant. The examiner should not make any comment such as that the non-English language information has only been considered to the extent understood, since this fact is inherent. See *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1377-78, 54 USPQ2d 1001, 1008 (Fed. Cir. 2000) (“[A]s MPEP Section 609C(2) reveals, the examiner’s understanding of a foreign reference is generally limited to that which he or she can glean from the applicant’s concise statement...Consequently, while the examiner’s initials require that we presume that he or she considered the [foreign] reference, this presumption extends only to the examiner’s consideration of the brief translated portion and the concise statement.”).

If an item of information in an IDS fails to comply with requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#),

a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#) will be considered by the examiner and will be appropriately initialed.

### **609.05(c) Documents Submitted as Part of Applicant's Reply to Office Action [R-07.2022]**

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of [37 CFR 1.97](#) and [37 CFR 1.98](#) in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action. However, consideration by the examiner of the document submitted as evidence directed to an issue of patentability raised in the Office action is limited to the portion of the document relied upon as rebuttal evidence; the entirety of the document may not necessarily be considered by the examiner.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (e.g., PTO-892 or PTO/SB/08) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in reply to the first Office action and also lists those patents on a PTO/SB/08 along

with two journal articles, but does not file a statement under [37 CFR 1.97\(e\)](#) or the fee set forth in [37 CFR 1.17\(p\)](#), it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO/SB/08 and to inform applicant that the information disclosure statement did not comply with [37 CFR 1.97\(c\)](#).

### **609.06 Information Printed on Patent [R-07.2022]**

A citation listed on form PTO/SB/08 and considered by the examiner will be printed on the patent. A citation listed in a separate paper, equivalent to but not on form PTO/SB/08, and considered by the examiner will be printed on the patent if the list lends itself to easy capture of the necessary information by the Office printing contractor, i.e., each item of information is listed on a single line, the lines are at least double-spaced from each other, and the information is uniform in format for each listed item. For patents printed after January 1, 2001, citations from information disclosure statements that are printed on the face of the patent will be distinguished from citations cited by the examiner on a form PTO-892. The citations cited by the examiner on a form PTO-892 will be marked with an asterisk. If an item of information is cited more than once in an IDS and on a form PTO-892, the citation of the item will be listed only once on the patent as a citation cited by the examiner.

If the applicant does not provide classification information for a citation, or if the examiner lines through incorrect classification data, the citation will be printed on the face of the patent without the classification information. If a U.S. patent application number is listed on a PTO/SB/08 form or its equivalent and the examiner considers the information and initials the form, the application number will be printed on the patent. Applicants may wish to list U.S. patent application numbers on other than a form PTO/SB/08 format to avoid the application numbers of pending applications being published on the patent. If a citation is not printed on the patent but has been considered by the examiner, the patented file will reflect that fact as noted in [MPEP § 609.05\(b\)](#).

### 609.07 IDSs Electronically Submitted (eIDS) Using Patent Center [R-01.2024]

Information disclosure statements may be submitted to the Office via the USPTO patent electronic filing system. Applicants can file an eIDS using Patent Center by (A) entering the references' citation information in an electronic data entry form, equivalent to the paper PTO/SB/08 form, and (B) transmitting the electronic data entry form to the Office. An eIDS filed via Patent Center may include citations of U.S. patents, U.S. patent application publications, foreign patent documents, and non-patent literature (NPLs). Copies of U.S. patents and U.S. patent application publications cited in the IDS are not required to be submitted by the applicants with the eIDS. If any references to foreign patent documents or NPLs or unpublished U.S. patent applications (that are not stored in the Office's Image File Wrapper (IFW) system) are to be cited, applicants must submit copies of these documents in PDF using Patent Center.

The electronic IDS form may be included with a new Patent Center electronic application filing, or it may be submitted for previously filed patent applications. An eIDS contains an electronic list of U.S. patent numbers, U.S. patent application publication numbers, foreign patent documents and non-patent literature (NPLs). An individual eIDS may contain a listing of (1) a combined total of 50 U.S. patents and U.S. patent application publications, (2) 50 foreign patent documents, and (3) 50 NPLs. Applicants are permitted to file more than one eIDS if these numbers are exceeded.

If more than one eIDS is necessary to file a complete IDS for which a fee is required under [37 CFR 1.17\(p\)](#), only a single fee under [37 CFR 1.17\(p\)](#) will be required under the following conditions:

(A) the fee required by [37 CFR 1.17\(p\)](#) is included with the first eIDS submission (since it will normally be processed first);

(B) all subsequent submissions making up the IDS should explicitly state that the fee was included in the earlier submission and request that the one fee be accepted for the second and any subsequent submission; and

(C) all subsequent submissions (electronic or paper) must be received by the Office on the same date as the first eIDS submission with which the fee was included.

A subsequent non-electronic submission is considered received by the Office on the same date as the first eIDS submission with which the fee was included for purposes of the fee due under [37 CFR 1.17\(p\)](#) if it is deposited in Priority Mail Express® under [37 CFR 1.10](#), deposited in the first class U.S. mail with a certificate of mailing in accordance with [37 CFR 1.8](#), or transmitted by facsimile with a certificate of transmission in accordance with [37 CFR 1.8](#), on the same date as the first eIDS submission with which the fee was included. If a subsequent eIDS submission is received by the Office on a date later than the date the fee was paid, the later submission will require an additional fee.

A copy of the eIDS form will be scanned to become part of the Image File Wrapper (IFW). In all applications, the eIDS will be added to the application file contents listing, and to the Patent Data Portal database record for the application.

If the eIDS complies with the requirements of [37 CFR 1.97](#), examiners must consider the eIDS and complete the eIDS form by initialing, signing, and dating the eIDS form entries. See [MPEP § 609.05\(b\)](#). Examiners may notice numbering gaps in the "Citation No." column on the printed eIDS form due to an applicant data entry error. This data entry error will not affect the eIDS and is not a sufficient reason not to consider the eIDS. A copy of the initialed eIDS form must be sent to the applicant. The completed copy of the eIDS form sent to an applicant should be made of record in the official file when the copy is sent to the applicant.

An electronic list of all U.S. patents and U.S. patent application publications on an eIDS form is available and accessible from the examiner's workstation by clicking on the eIDS icon, on the workstation desktop. Consideration of the eIDS may not be deferred and an examiner should not require an applicant to submit paper copies of eIDS references. It is most important that the U.S. patent and U.S. patent application publication numbers listed on the eIDS be accurate and devoid of transcription error since no copies of the documents listed on the eIDS

are provided in the file wrapper for the examiner to review. Instead the examiner will electronically retrieve the U.S. patents and U.S. patent application publications identified by the cited document numbers. The only mechanism for having the correct document reviewed and considered when an erroneous U.S. patent or U.S. patent application publication is cited in an eIDS will be by citing the correct citation number in a subsequent IDS that conforms to the requirements of [37 CFR 1.97](#) and [1.98](#).

Examiners can copy and paste U.S. patent and U.S. patent application publication numbers from the eIDS to PE2E Search for searching. Examiners should copy and paste U.S. patent and U.S. patent application publication numbers from the eIDS to PE2E Search to review the references that are listed in the eIDS.

Applicants and registered practitioners are permitted to sign portions of a Patent Center submission, including an IDS, with an electronic signature. See [37 CFR 1.4\(d\)\(3\)](#).

If the eIDS transmittal letter and list of references is missing from an application file, an examiner may request that the technical support staff obtain an additional printed copy of the letter and reference list from the Office of Patent Application Processing (OPAP).

### **609.08 Electronic Processing of Information Disclosure Statement [R-07.2022]**

The USPTO electronically processes the list of citations (e.g., form PTO/SB/08) submitted as part of an information disclosure statement (IDS) submitted in applications stored by the Office in image form. Examiners are provided with a tool to electronically annotate citations and electronically sign the IDS when reviewing the cited references. See [MPEP § 609.04\(b\)](#) for determining whether a cited reference has been considered by the examiner. The electronically processed IDS will be stored in the Office's official record as an entry in the application's image file wrapper (IFW) and a copy will be provided to applicant as part of an Office action.

PTO/SB/08a (07-09)

Approved for use through 05/31/2024. OMB 0651-0031

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 contains a valid OMB control number.

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(Use as many sheets as necessary)</i>	<b>Complete if Known</b>			
	Application Number			
	Filing Date			
	First Named Inventor			
	Art Unit			
	Examiner Name			
Sheet		of	Attorney Docket Number	

U. S. PATENT DOCUMENTS						
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)				
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FOREIGN PATENT DOCUMENTS								
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)						

Examiner Signature		Date Considered	
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<sup>1</sup>EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>2</sup> Applicant's unique citation designation number (optional). <sup>3</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>4</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>5</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>6</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>7</sup> Applicant is to place a check mark here if English language Translation is attached.

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If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 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. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013). <https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to: 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law; 2) a Federal, state, local, or international agency, in response to its request; 3) a contractor of the USPTO having need for the information in order to perform a contract; 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record; 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record; 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations; 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals; 8) 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)); 9) the Office of Personnel Management (OPM) for personnel research purposes; and 9) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

## Additional Uses

Additional USPTO uses of the information in this record may include disclosure to: 1) the International Bureau of the World Intellectual Property Organization, if the record is related to an international application filed under the Patent Cooperation Treaty; 2) the public i) after publication of the application pursuant to 35 U.S.C. 122(b), ii) after issuance of a patent pursuant to 35 U.S.C. 151, iii) 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 inspections, or an issued patent, or iv) without publication of the application or patent under the specific circumstances provided for by 37 CFR 1.14(a)(1)(v)-(vii); and/or 3) the National Archives and Records Administration, for inspection of records.

PTO/SB/08b (07-09)

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Substitute for form 1449/PTO  <h2 style="text-align: center; margin: 0;">INFORMATION DISCLOSURE STATEMENT BY APPLICANT</h2> <p style="text-align: center; font-size: small; margin-top: 10px;">(Use as many sheets as necessary)</p>	<p style="text-align: center; font-weight: bold; font-size: small;">Complete if Known</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 60%; padding: 2px;">Application Number</td> <td style="width: 40%;"></td> </tr> <tr> <td style="padding: 2px;">Filing Date</td> <td></td> </tr> <tr> <td style="padding: 2px;">First Named Inventor</td> <td></td> </tr> <tr> <td style="padding: 2px;">Art Unit</td> <td></td> </tr> <tr> <td style="padding: 2px;">Examiner Name</td> <td></td> </tr> <tr> <td style="padding: 2px;">Attorney Docket Number</td> <td></td> </tr> </table>	Application Number		Filing Date		First Named Inventor		Art Unit		Examiner Name		Attorney Docket Number	
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NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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