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601 Content of Provisional and Non-provisional Applications [R-7]

35 U.S.C. 111. Application

(a) IN GENERAL.—

(1) WRITTEN APPLICATION.—An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title;

and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH.—The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT.—Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.

(2) CLAIM.—A claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.

(3) FEE.—

(A) The application must be accompanied by the fee required by law.

(B) The fee may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(C) Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee was unavoidable or unintentional.

(4) **FILING DATE.**—The filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

(5) **ABANDONMENT.**—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) **OTHER BASIS FOR PROVISIONAL APPLICATION.**—Subject to all the conditions in this subsection and section 119(e) of this title, and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.**—A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

(8) **APPLICABLE PROVISIONS.**—The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157 of this title.

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.

(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) An oath or declaration, see §§ 1.63 and 1.68;
- (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 the first paragraph of 35 U.S.C. 112, 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 NON-PROVISIONAL 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 except that 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 (see 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 and 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 § 201.11).
- (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) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on

compact disc and an incorporation-by-reference of the material on the compact disc. For computer listings filed on or prior to March 1, 2001, reference to a "Microfiche appendix" (see former 37 CFR 1.96(c) for Microfiche appendix).

(F) 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.

(G) Brief summary of the invention. (See MPEP § 608.01(d)).

(H) Brief description of the several views of the drawing. (See MPEP § 608.01(f)).

(I) Detailed description of the invention. (See MPEP § 608.01(g)).

(J) Claim(s) (commencing on a separate sheet). (See MPEP § 608.01(i)-(p)).

(K) Abstract of the Disclosure (commencing on a separate sheet). (See MPEP § 608.01(b)).

(L) Sequence Listing, if on paper (see 37 CFR 1.821 through 1.825).

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 the first paragraph of 35 U.S.C. 112 and refer to drawings, where necessary for an understanding of the invention. Unlike an application filed under 35 U.S.C. 111(a), a provisional application does not need claims. Furthermore, no oath or declaration is required. See MPEP § 201.04(b).

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 un-

der 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(b) 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 under the heading "Paper Requirement."

Determination of completeness of an application is covered in MPEP § 506 and § 601.01 - § 601.01(g).

The elements of the application are secured together in a file wrapper, bearing appropriate identifying data including the application number and filing date (MPEP § 719).

Note

Provisional applications, MPEP § 201.04(b).

Divisional applications, MPEP § 201.06.

Continuation applications, MPEP § 201.07.

Continued prosecution applications, MPEP § 201.06(d).

Reissue applications, MPEP § 1401.

Design applications, MPEP Chapter 1500.

Plant applications, MPEP Chapter 1600.

Ex Parte Reexamination, MPEP Chapter 2200.

Inter Partes Reexamination, MPEP Chapter 2600.

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)).

All applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, or in the application data sheet after the title of the invention (see 37 CFR 1.76(b)(3)), for example “Proposed Class 2, subclass 129.”

601.01 Complete Application [R-3]

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

(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, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

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

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

(c) *Application filing requirements - Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute

and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by § 1.51(c)(1), which may be an application data sheet (§ 1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

- (i) Abandonment of the application filed under paragraph (b) of this section;
- (ii) Payment of the issue fee on the application filed under paragraph (b) of this section;
- (iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or
- (iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

(3) ***>*A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C. 112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A

request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

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

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

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119 or 365(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a)(4) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements - Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application that is complete as defined by § 1.51(b); and

(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 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, 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.<

(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 certain 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).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

37 CFR 1.53 relates to application numbers, filing dates, and completion of applications. 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). Effective July 14, 2003, CPA practice under 37 CFR 1.53(d) does not apply to utility and plant applications. CPAs can only be filed in design applications.

601.01(a) Nonprovisional Applications - Filed Under 35 U.S.C. 111(a) [R-3]

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. Under 37 CFR 1.53(b), 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 (USPTO). 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 continua-

tion-in-part) of a design application. The prior nonprovisional application must be a design application that is complete as defined by 37 CFR 1.51(b). 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. However, no amendment may introduce new matter into the disclosure of an application after its filing date.

37 CFR 1.53(e) provides for notifying applicant of any application which is incomplete under 37 CFR 1.53(b) or 37 CFR 1.53(d) and giving the applicant a time period to correct any omission. If the omission is not corrected within the time period given, the application will be returned or otherwise disposed of and a handling fee set forth in 37 CFR 1.21(n) will be retained from any refund of a filing fee.

37 CFR 1.53(f) provides that, where a filing date has been assigned to an application filed under 37 CFR 1.53(b) or 37 CFR 1.53(d), the applicant will be notified if a correspondence address has been provided and be given a period of time in which to file the missing *>fees<, oath or declaration, and to pay *>any< surcharge >(37 CFR 1.16(f))< due in order to prevent abandonment of the application. The time period usually set is 2 months from the mailing date of notification by the USPTO. This time period may be extended under 37 CFR 1.136(a).

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For applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if the search and/or examination fees are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is not required. For applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is required.<

If the required basic filing fee is not timely paid, or the processing and retention fee set forth in 37 CFR 1.21(l) is not paid during the pendency of the application, the application will be disposed of. >Effective July 1, 2005, the processing and retention fee (formerly 37 CFR 1.21(l)) practice has been eliminated. The basic filing fee (rather than just the processing and retention fee set forth in former 37 CFR 1.21(l)) must be paid within the pendency of a nonprovisional application in order to permit benefit of the application to be claimed under 35 U.S.C. 120, 121, or 365(c) in a subsequent nonprovisional or international application.< The notification under 37 CFR 1.53(f) may be made simultaneously with any notification pursuant to 37 CFR 1.53(e). If no correspondence address is included in the application, applicant has 2 months from the filing date to file the *>fee(s)<, oath or declaration and to pay the >required< surcharge as set forth in 37 CFR 1.16*>(f)< in order to prevent abandonment of the application.

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)). *>Prior to July 1, 2005, the< basic filing fee or the processing and retention fee must be paid in a nonprovisional application, if any claim for benefits under 35 U.S.C. 120, 121, or 365(c) based on that application is made in a subsequently filed copending nonprovisional application. **>Effective July 1, 2005, 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 or 365(c) in a subsequent nonprovisional or international application. See 37 CFR 1.78(a)(1).<

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. 37 CFR 1.53(j) indicates that international applications filed under the Patent Cooperation Treaty which designate the United States of America are considered to have a United States filing date under PCT Article 11(3), except as provided in 35 U.S.C. 102(e), on the date the requirements of PCT Article 11(1)(i) to (iii) are met.

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53(b), a filing date is granted to a nonprovisional application for patent, which includes at least a specification 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. 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 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 the notice(s) to file missing parts and the notice(s) of incomplete applications with the reply submitted to the U.S. Patent and Trademark Office. 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 2 months from the filing date before

abandonment occurs per 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 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 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. If an amendment is filed on the same day that the application filed under 37 CFR 1.53(b) is filed as 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.

601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b) [R-3]

A provisional application will be given a filing date in accordance with 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) parallel the requirements for a nonprovisional application set forth in 37 CFR 1.53(b), except that no claim is required. 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 paragraph (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 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 2 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. 37 CFR 1.78(a)(4).

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-7]

I. CONVERSION FROM A NONPROVISIONAL APPLICATION TO A PROVISIONAL APPLICATION

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

(c)(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in § 1.17(q) and be filed prior to the earliest of:

- (i) Abandonment of the application filed under paragraph (b) of this section;
- (ii) Payment of the issue fee on the application filed under paragraph (b) of this section;
- (iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; or
- (iv) The filing of a request for a statutory invention registration under § 1.293 in the application filed under paragraph (b) of this section.

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) (a provisional application filing fee is not required). 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, the expiration of 12 months after the filing date of the 37 CFR 1.53(b) application, or the filing of a request for a statutory invention registration under 37 CFR 1.293, 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, or 365. See MPEP § 201.04(b). 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.

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in § 1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under para-

graph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C.112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, an oath or declaration by the applicant pursuant to §§ 1.63, 1.162, or 1.175, and the surcharge required by § 1.16(f) if either the basic filing fee for a nonprovisional application or the oath or declaration was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

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

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 for the conversion of the provisional application to a nonprovisional application and the fee set forth in 37 CFR 1.17(i) as well as 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. 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-7]

The Office of Patent Application Processing (OPAP) reviews application papers to determine whether all of the pages of specification are present in the 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, OPAP will mail a “Notice of Omitted Items” 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 mailing of a “Notice of Omitted Item(s)” 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 2 months from the date of the “Notice of Omitted Item(s),” 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 (37 CFR 1.181(f)). 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 2-month period is not 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 2 months from the date of the “Notice of Omitted Item(s),” file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such 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 (37 CFR 1.181(f)). The 2-month period is not extendable under 37 CFR 1.136; or

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

(1) not filing a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the “Notice of Omitted Item(s)”. The failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 will be treated as constructive acceptance by the applicant of the application as deposited in the USPTO. 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. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted page(s). Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application, or

(2) filing an amendment under 37 CFR 1.57(a). 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(a). Such amendment should be by way of a preliminary amendment and the preliminary amendment must be submitted within 2 months from the date of the “Notice of Omitted Item(s).” The amendment should be identified as an amendment pursuant to 37 CFR 1.57(a) and must comply with the requirements of 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17. 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 2-month period is not extendable under 37 CFR 1.136.

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the “Notice of Omitted Item(s)” may be dismissed as untimely. 37 CFR 1.181(f). Under the adopted procedure, the USPTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted page(s) in a nonprovisional application and request the date of such submission as the application filing date as: (A) according the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and (B) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

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.

Applications in which a “Notice of Omitted Item(s)” has been mailed will be retained in *>OPAP< for a period of 2 months from the mailing

date of the notice. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate Technology Center for examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to the Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

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 in a nonprovisional application, accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the specification being submitted and accept the date of such submission as the application filing date; or

(C) submit an amendment under 37 CFR 1.57(a). 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 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(a). The amendment must be accompanied by a petition under 37 CFR 1.57(a)(3) along with the petition fee set forth in 37

CFR 1.17(f). See MPEP § 201.17. The amendment should be identified as an amendment pursuant to 37 CFR 1.57(a) and must comply with the requirements of 37 CFR 1.57(a) and 37 CFR 1.121. The 2-month period is not 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), or files a petition under 37 CFR 1.57(a)(3) 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 LOCATED IN A TECHNOLOGY CENTER

If it is discovered that an application, located in a Technology Center (TC), 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 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.

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 page(s) of the specification;

(B) file any omitted page(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the 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; 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, 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(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

Any petition filed in accordance with item B or C above should be filed with the TC. The TC will match the petition with the application file and forward the application file with the petition to the Office of Petitions, along with a brief explanation as to the page(s) of the specification that has been omitted on filing, for consideration of the petition in due course. For Image File Wrapper (IFW) processing, see IFW Manual section 5.3.

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-3]

35 U.S.C. 111(a)(2) requires that an application for patent include, *inter alia*, “a specification as prescribed by section 112 of this title,” and 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, first paragraph, provides, in part, that “[t]he specification shall contain a written description of the invention,” and 35 U.S.C. 112, second paragraph, 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), a claim is a statutory requirement for according a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that “[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application.” Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

If a nonprovisional 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). An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

If a nonprovisional 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).

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-7]

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 of this title" and 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." 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."

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 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 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. 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 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 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 may submit drawing(s) accompanied by an oath or declaration

in compliance with 37 CFR 1.63 and 1.64 referring to the drawing(s) being submitted and accept the date of such submission as the application filing date.

As an alternative to a petition under 37 CFR 1.53(e), if the drawing(s) was inadvertently omitted from an 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, or international 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(a). The amendment must be by way of a petition under 37 CFR 1.57(a)(3) accompanied by the petition fee set forth in 37 CFR 1.17(f). See MPEP § 201.17.

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) accompanied by an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 and accept the date of such submission as the application filing date. Applicant may also be able to file an amendment by way of a petition under 37 CFR 1.57(a)(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-7]

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 the 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, >OPAP< will mail a “Notice of Omitted Item(s)” 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.

The mailing of a “Notice of Omitted Item(s)” 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 2 months from the date of the “Notice of Omitted Item(s),” 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 (37 CFR 1.181(f)). 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 2-month period is not 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 2 months from the date of the “Notice of Omitted Item(s),” file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to such 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 (37 CFR 1.181(f)). The 2-month period is not extendable under 37 CFR 1.136; or

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

(1) not filing a petition under 37 CFR 1.53(e) or 37 CFR 1.182 (and the required petition fee) as discussed above within 2 months of the date of the “Notice of Omitted Item(s).” The failure to file a petition under 37 CFR 1.53(e) or 37 CFR 1.182 will be treated as constructive acceptance by the applicant of

the application as deposited in the USPTO. 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. Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application, or

(2) filing an amendment under 37 CFR 1.57(a). 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 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(a). Such amendment should be by way of a preliminary amendment and the preliminary amendment must be submitted within 2 months from the date of the “Notice of Omitted Item(s).” The amendment should be identified as an amendment pursuant to 37 CFR 1.57(a) and must comply with the requirements of 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17. 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 2-month period is not extendable under 37 CFR 1.136.

Any petition under 37 CFR 1.53(e) or 37 CFR 1.182 not filed within the 2-month period set in the “Notice of Omitted Item(s)” may be dismissed as untimely. 37 CFR 1.181(f). Under the adopted procedure, the USPTO may strictly adhere to the 2-month period set forth in 37 CFR 1.181(f), and dismiss as untimely any petition not filed within the 2-month period. This strict adherence to the 2-month period set forth in 37 CFR 1.181(f) is justified as such applications will now be forwarded for examination at the end of the 2-month period. It is further justified in instances in which applicant seeks to submit the omitted drawing(s) in a nonprovisional application and request the date of such submission as the application filing date as: (A) according the application a filing date later than the date of deposit may affect the date of expiration of any patent issuing on the application due to the changes to 35 U.S.C. 154 contained in Public Law 103-465, § 532, 108 Stat. 4809 (1994); and (B) the filing of a continuation-in-part application is a sufficiently equivalent mechanism for adding additional subject matter to avoid the loss of patent rights.

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.

Applications in which a “Notice of Omitted Item(s)” has been mailed will be retained in *>OPAP< for a period of 2 months from the mailing date of the notice. Nonprovisional applications that are complete under 37 CFR 1.51(b) will then be forwarded to the appropriate Technology Center for

examination of the application. Provisional applications that are complete under 37 CFR 1.51(c) will then be forwarded to the Files Repository. The current practice for treating applications that are not complete under 37 CFR 1.51(b) and (c) will remain unchanged (37 CFR 1.53(f) and (g)).

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. *>OPAP< will not mail a “Notice of Omitted Item(s)” if a figure which is referred to in the specification by a particular number cannot be located among the drawings, if the drawings include at least one figure labeled with that particular number in combination with a letter. 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, rather than an application filed without all figures of drawings.

APPLICATION LOCATED IN A TECHNOLOGY CENTER

If it is discovered that an application, located in a Technology Center (TC), was filed without all of the drawing figure(s) referred to in the specification, and a Notice of Omitted Items has not been mailed by the *>OPAP<, the examiner should review the application to determine whether the application is entitled to a filing date. An 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.

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) with an oath or declaration in compliance with 37 CFR 1.63

and 37 CFR 1.64 referring to the 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; 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 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 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) pursu-

ant to 37 CFR 1.57(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

Any petition filed in accordance with item (B) or (C) above should be filed with the TC. The TC will match the petition with the application file and forward the application file with the petition to the Office of Petitions, along with a brief explanation as to the drawing figure(s) that has been omitted on filing, for consideration of the petition in due course.

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 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.”

601.01(h) Forms [R-7]

The Office of **>Patent Application Processing (OPAP)< is no longer using pre-printed forms and is instead using individualized notices generated by a computer to notify applicants of defects.

601.02 Power of Attorney [R-7]

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. The prompt delivery of communications will thereby be facilitated.

A power of attorney may be incorporated in the oath or declaration form when the power of attorney is given by inventors. Otherwise, a separate power of attorney (e.g., PTO/SB/81) should be used. (See MPEP § 402.)

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PTO/SB/81 (07-08)

Approved for use through 12/31/2008. OMB 0651-0035

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.

POWER OF ATTORNEY OR REVOCAION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS	Application Number	
	Filing Date	
	First Named Inventor	
	Title	
	Art Unit	
	Examiner Name	
	Attorney Docket Number	

I hereby revoke all previous powers of attorney given in the above-identified application.

A Power of Attorney is submitted herewith.

OR

I hereby appoint Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

OR

I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number

Please recognize or change the correspondence address for the above-identified application to:

The address associated with the above-mentioned Customer Number.

OR

The address associated with Customer Number:

OR

<input type="checkbox"/> Firm or Individual Name			
Address			
City	State	Zip	
Country			
Telephone	Email		

I am the:

Applicant/Inventor.

OR

Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on _____.

SIGNATURE of Applicant or Assignee of Record

Signature	Date
Name	Telephone
Title and Company	

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*.

*Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 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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601.03 Change of Correspondence Address [R-7]

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 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).

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. 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 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 37 CFR 1.33(a). While business is to be conducted on the written record (37 CFR 1.2), a daytime telephone number would be useful in initiating contact that could later be reduced to writing. Any party who could change the correspondence address could also change the telephone number.

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 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 letter may also change the correspondence address. A patent practitioner named in a letterhead would not be considered as being named in the transmittal letter for purposes of chang-

ing the correspondence address. A clear identification of the individual as a representative would be 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 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 37 CFR 1.33(a)(1).

Where a correspondence address has been established on filing of the application or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of an executed oath or declaration under 37 CFR 1.63 by any of the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under 37 CFR 1.63 and can only be subsequently changed pursuant to 37 CFR 1.33(a)(2). Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 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 37 CFR 3.71(b), or (C) all of the applicants (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 37 CFR 3.71. See 37 CFR 1.33(a)(2).

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). See 37 CFR 11.11. The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

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 communica-

tions 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 to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02.

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 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. 37 CFR 1.63(d)(4).

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old 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.

The obligation (see 37 CFR 11.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

601.04 National Stage Requirements of the United States as a Designated Office

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-5]

37 CFR 1.76. Application Data Sheet

(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, as well as any foreign application having a filing date before that of the 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;

(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.

37 CFR 1.76 provides for the voluntary inclusion of an application data sheet in provisional and nonprovisional applications. A guide to preparing an application data sheet (Patent Application Bibliographic Data Entry Format) can be found on the U.S. Patent and Trademark Office (Office) Web site “<http://www.uspto.gov>”.

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. When an application data sheet is provided in a provisional or nonprovisional application, the application data sheet becomes part of the provisional or nonprovisional application and must comply with 37 CFR 1.52. While the use of an application data sheet is optional, the Office prefers its use to help facilitate the electronic capturing of this important data. For example, in a national stage application filed under 35 U.S.C. 371, the Office could look to the publication of the international application for the title (see MPEP § 1893.03(e)) and to other documents for the listing of inventors and the correspondence address, but it is more desirable for the Office to only refer to a single document, i.e., an application data sheet. 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 can, in fact, efficiently capture the data, the Office specifies a particular format to be used. The Office does not, however, provide an application data sheet paper form because of the variability in the data submitted (e.g., one application may have no domestic priority data and a single inventor, and others may have domestic priority data to a number of prior U.S. applications and have multiple joint inventors).

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. The ADS must be titled “Application Data Sheet” and any label (e.g., the label “Given Name” in the “Applicant Information” heading) that does not contain any corresponding data will be interpreted by the Office to mean that there is no corresponding data for that label anywhere in the application. By requiring an ADS to contain all seven section headings, and any appropriate data for the sections, the accuracy of bibliographic data in patent applications will be enhanced and the need for corrected filing receipts related to Office errors will be reduced.

Bibliographic data under 37 CFR 1.76(b) includes: (1) applicant information; (2) correspondence information; (3) application information; (4) representative information; (5) domestic priority information; (6) foreign priority information; and (7) assignee 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 37 CFR 1.63 (as is required by 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 (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 (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 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 is desired for both provisional and nonprovisional applications, the Office will not be bound to follow such information if submitted, as the Office will continue to follow its present procedures for classifying and assigning new applications. Similarly for the suggested drawing figure, the Office may decide to print another figure on the front page of any patent issuing from the application.

Application information also includes information about provisional applications, particularly their class and subclass, and the TC. Provisional applications are not examined or even processed (e.g., having a class and subclass assigned or being forwarded to a TC). Even though provisional applications are not examined, the TC and the class and subclass, if known to applicants, would be of benefit to the Office in giving an indication of where nonprovisional applications may be eventually received in the Office and their technologies so that the Office will be better able to plan for future workloads.

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 separate sections of the plant patent 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). 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 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). 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)(2) (iii) or (a)(5)(iii). 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. 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. 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(a). 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. 37 CFR 1.76(b)(6) does not apply to provisional applications.

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 37 CFR 1.63 or 1.67. See 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 (37 CFR 1.33(a)); and (3) citizenship changes (37 CFR 1.63 or 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 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.”

SUPPLEMENTAL ADS SUBMISSIONS

When submitting an application data sheet supplemental to the initial filing of the application, to correct, modify, or augment the original application data sheet, 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 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 footer information should include the word “Supplemental” in place of “Initial” and should also contain the Application Number and Filing Date.

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.

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, or 37 CFR 1.67) are addressed in 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. 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 37 CFR 1.63 or 37 CFR 1.67, except as provided by 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) (37 CFR 1.76(d)(1)).

If an application is filed with an application data sheet improperly identifying the residence of one of the inventors, inventor B, and an executed 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 37 CFR 1.76(c), with the name of inventor B and the corrected residence for inventor B.

Pursuant to 37 CFR 1.76(d)(3), the oath or declaration under 37 CFR 1.63 or 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 37 CFR 1.76(d)(3). Any change in the inventorship set forth in the oath or declaration under 37 CFR 1.63 must be by way of a request under 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 37 CFR 1.63 incorrectly sets forth the citizenship of one of the inventors, that inventor must submit a supplemental oath or declaration under 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, however, only a supplemental application data sheet is required. See MPEP § 605.04(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 (35 U.S.C. 115) or other rule (37 CFR 1.41(a)(1)). Where the oath or declaration under 37 CFR 1.63 or 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 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, however, only a supplemental

application data sheet is required. See MPEP § 605.04(b).

If an application is filed with an application data sheet correctly setting forth the citizenship of inventor B, and an executed 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 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 (37 CFR 1.76(d)(2)).

Although 37 CFR 1.76 does not change the practice in MPEP § 201.03 and § 605.04(b) regarding correction of a typographical or transliteration error in the spelling of an inventor's name whereby all that is required is notification of the error to the Office, the Office strongly encourages the filing of an application data sheet or a supplemental application data sheet to correct a typographical or transliteration error in the spelling of an inventor's name. A supplemental oath or declaration is not required.

If applicant merely files a statement notifying the Office of the typographical or transliteration error in the spelling of an inventor's name without submitting an application data sheet or a supplemental application data sheet, any patent to issue is less likely to reflect the correct spelling since the spelling of the inventor's name is taken from the oath or declaration, or any subsequently filed application data sheet.

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.

An application data sheet must be labeled “Application Data Sheet” and should provide the following information:

Applicant Information

Inventor One Given Name:

Family Name:

Name Suffix:

Mailing Address Line One:

Mailing Address Line Two:

City:

State or Province:

Postal or Zip Code:

City of Residence:

State or Prov. of Residence:

Country of Residence:

Citizenship Country:

[repeat for additional inventors]

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 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 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.”:

Given or Company Name of Applicant:

Family Name, if any:

Name Suffix:

Authority:

Mailing Address Line One:

Mailing Address Line Two:

City:

State or Province:

Postal or Zip Code:

City of Residence:

State or Prov. of Residence:

County of Residence:

Citizenship Country:

Correspondence Information

Name Line One:

Name Line Two:

Address Line One:

Address Line Two:

City:

State or Province:

Country:

Postal or Zip Code:

Telephone:

Fax:

Electronic Mail:

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

Application Information

Title Line One:

Title Line Two:

[Repeat for any additional lines]

Suggested classification:

Suggested Tech. Center:

Total Drawing Sheets:

Suggested Dwg. Figure for Pub.:

Docket Number:

Application Type: [Utility]

Licensed US Govt. Agency:

Contract or Grant Numbers One:

Contract or Grant Numbers Two:

Secrecy Order in Parent Appl.?

If plant patent app.,

Latin name of genus and species of plant claimed:

Representative Information

Registration Number One:

Registration Number Two:

[Repeat for extra registration numbers]

The representative information must list ten or fewer representatives or be indicated by reference to a Customer Number. See 37 CFR 1.32.

Domestic Priority Information

This application is a: [Continuation, Division, C-I-P, or National Stage of]

Application One:

Filing Date:

which is a:
 Application Two:
 Filing Date:
 [repeat as necessary]

Foreign Priority Information

Foreign Application One:
 Filing Date:
 Country:
 Priority Claimed: [Yes or No]

Assignee Information

Name of assignee:
 Address Line One:
 Address Line Two:
 City:
 State or Province:
 Country:
 Postal or Zip Code:

602 Original Oath or Declaration [R-7]

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.

35 U.S.C. 115. 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. 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.

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.

A provisional application does not require an oath or declaration to be complete. See 37 CFR 1.51(c).

I. OATH

A seal is usually impressed on an oath. See 37 CFR 1.66, MPEP § 604 and § 604.01. Documents with seals cannot be adequately scanned for retention in an Image File Wrapper, and since the Office maintains patent applications in an image form, the Office strongly encourages the use of declarations rather than oaths. However, oaths 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 MPEP § 604 for execution of an oath, and MPEP § 604.01 and § 604.02 for information regarding seals and venue.

II. STATUTORY DECLARATIONS

U.S. Patent and Trademark 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 that 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 to be supported, evidenced, established, or proved by 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).”

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. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration. It must, however, since it is an integral part of the application, be maintained together therewith.

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.”

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

The following form paragraphs may be used to notify applicant that the oath or declaration is defective because it was not properly executed.

¶ *6.05 Oath or Declaration Defective, Heading*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ *6.05.01 Improper Execution*

It was not executed in accordance with either 37 CFR 1.66 or 1.68.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ *6.05.17 Declaration Clause Omitted*

The clause regarding “willful false statements ...” required by 37 CFR 1.68 has been omitted.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

III. EARLIER FOREIGN APPLICATIONS

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, unless such information is included in an application data sheet. See 37 CFR 1.63(c)(2).

If all foreign applications have been filed within 12 months of the U.S. filing date, applicant is required only to recite the first such foreign application of which priority is claimed, and it should be clear that the foreign application referred to is the first filed foreign application. 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 the first filed foreign application.

If the information regarding the foreign application has not been included in an application data sheet, or in an oath or declaration, form paragraphs 6.05 and 6.05.08 may be used to notify applicant that the oath or declaration is defective because the prior foreign application has not been identified.

¶ *6.05.08 Identification of Foreign Applications Omitted*

It does not identify the foreign application for patent or inventor’s certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

IV. SOLE OR JOINT DESIGNATION

37 CFR 1.63 no longer requires the oath or declaration to state that the inventor is a sole or joint inventor of the invention claimed.

When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating

them by name. This may be done by stating that he or she does verily believe himself or herself to be the original, first and joint inventor together with “A” or “A & B, etc.” as the facts may be.

V. NEW MATTER ISSUES

For applications filed on or after September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application. For applications filed before September 21, 2004, a preliminary amendment that is present on the filing date of the application is part of the original disclosure of the application if the preliminary amendment was referred to in the first executed oath or declaration under 37 CFR 1.63 filed in the application. See MPEP § 608.04(b) and § 714.01(e).

If a preliminary amendment is present on the filing date of an application, and the oath or declaration under 37 CFR 1.63 does not refer to the preliminary amendment, the normal operating procedure is to not screen the preliminary amendment to determine whether it contains subject matter not otherwise included in the specification or drawings of the application as filed (i.e., subject matter that is “new matter” relative to the specification and drawings of the application). As a result, it is applicant’s obligation to review the preliminary amendment to ensure that it does not contain subject matter not otherwise included in the specification or drawings of the application as filed. If the preliminary amendment contains subject matter not otherwise included in the specification and drawings of the application, applicant must provide a supplemental oath or declaration under 37 CFR 1.67 referring to such preliminary amendment. The failure to submit a supplemental oath or declaration under 37 CFR 1.67 referring to a preliminary amendment that contains subject matter not otherwise included in the specification or drawings of the application as filed removes safeguards that are implied in the oath or declaration requirements that the inventor review and understand the contents of the application, and acknowledge the duty to disclose to the Office all information known to be material to patentability as defined in 37 CFR 1.56.

Applicants can avoid the need to file an oath or declaration referring to any preliminary amendment by incorporating any desired amendments into the text of

the specification including a new set of claims when filing the application instead of filing a preliminary amendment, even where the application is a continuation or divisional application of a prior-filed application. Furthermore, 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.

During examination, if an examiner determines that a preliminary amendment that is present on the filing date of the application includes subject matter not otherwise supported by the originally filed specification and drawings, and the oath or declaration does not refer to the preliminary amendment, the examiner may require the applicant to file a supplemental oath or declaration under 37 CFR 1.67 referring to the preliminary amendment. In response to the requirement, applicant must submit (A) an oath or declaration that refers to the preliminary amendment, (B) an amendment that cancels the subject matter not supported by the originally filed specification and drawings, or (C) a request for reconsideration.

For applications filed prior to September 21, 2004, a preliminary amendment that is present on the filing date of an application may be considered a part of the original disclosure if it is referred to in a first filed oath or declaration in compliance with 37 CFR 1.63. If the preliminary amendment was not referred to in the oath or declaration, applicant will be required to submit a supplemental oath or declaration under 37 CFR 1.67 referring to both the application and the preliminary amendment filed with the original application. A surcharge under 37 CFR 1.16(f) will also be required unless it has been previously paid.

If an oath or declaration improperly refers to an amendment filed after the filing date of the application and containing new matter, a supplemental oath or declaration will be required pursuant to 37 CFR 1.67(b), deleting the reference to the amendment containing new matter. See also MPEP § 608.04. If the application papers are altered prior to the 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.

See MPEP § 602.05(a) where a continuation application under 37 CFR 1.53(b) is filed with a copy of a

declaration from a prior application, but the continuation application is filed with a rewritten specification.

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath or declaration is required, 37 CFR 1.67, MPEP § 603.

VI. IDENTIFICATION OF APPLICATION

37 CFR 1.63 requires that an oath or declaration identify the specification to which it is directed. The declaration form suggested by the Office includes spaces for filling in the names of the inventors, title of the invention, application number, filing date, and foreign priority application information. While this information should be provided, it is not essential that all of these spaces be completed in order to adequately identify the specification in compliance with 37 CFR 1.63(b)(1).

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 a specification 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 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 oath or declaration in compliance with 37 CFR 1.63, the oath or declaration being filed later with a surcharge. 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 a specification 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) attorney docket number which was on the specification as filed;

(D) title of the invention which was on the specification as filed and reference to an attached specification which is both attached to the oath or declaration at the time of execution and submitted with the oath or declaration; or

(E) 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.

Form paragraphs 6.05 and 6.05.20 may be used to notify applicant that the oath or declaration is defective because the specification has not been adequately identified.

¶ 6.05.20 *Specification Not Identified*

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

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.

Supplemental oaths or declarations in accordance with 37 CFR 1.67 will be required in applications in which the oaths or declarations are not in compliance with the other requirements of 37 CFR 1.63 but contain sufficient information to identify the specifications to which they apply as detailed above.

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.

VII. COPIES OF OATHS OR DECLARATIONS ARE ENCOURAGED

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).

Note

See MPEP § 602.03 for other defects in the oath or declaration.

**>

Doc Code: OATH

PTO/SB/01 (05-08)

Approved for use through 06/30/2010. OMB 0651-0032

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

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63) <input type="checkbox"/> Declaration Submitted With Initial Filing OR <input type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (f)) required)	Attorney Docket Number	
	First Named Inventor	
	<i>COMPLETE IF KNOWN</i>	
	Application Number	
	Filing Date	
	Art Unit	
Examiner Name		

I hereby declare that: (1) Each inventor's residence, mailing address, and citizenship are as stated below next to their name; and (2) I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

(Title of the Invention)

the application of which

 is attached hereto
OR
 was filed on (MM/DD/YYYY) as United States Application Number or PCT International

 Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Authorization To Permit Access To Application by Participating Offices

If checked, the undersigned hereby grants the USPTO authority to provide the European Patent Office (EPO), the Japan Patent Office (JPO), and any other intellectual property offices in which a foreign application claiming priority to the above-identified application is filed access to the above-identified patent application. See 37 CFR 1.14(c) and (h). This box should not be checked if the applicant does not wish the EPO, JPO, or other intellectual property office in which a foreign application claiming priority to the above-identified application is filed to have access to the application.

In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the application-as-filed with respect to: 1) the above-identified application, 2) any foreign application to which the above-identified application claims priority under 35 USC 119(a)-(d) if a copy of the foreign application that satisfies the certified copy requirement of 37 CFR 1.55 has been filed in the above-identified US application, and 3) any U.S. application from which benefit is sought in the above-identified application.

In accordance with 37 CFR 1.14(c), access may be provided to information concerning the date of filing the Authorization to Permit Access to Application by Participating Offices.

[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 21 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.

PTO/SB/01 (05-08)

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

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

Claim of Foreign Priority Benefits

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

PTO/SB/01 (05-08)

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DECLARATION — Utility or Design Patent Application

Direct all correspondence to:	<input type="checkbox"/> The address associated with Customer Number:	<input type="checkbox"/> Correspondence address below
Name		
Address		
City	State	ZIP
Country	Telephone	Email
WARNING:		
<p>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. Petitioner/applicant is advised that documents which form the record of a patent application (such as the PTO/SB/01) are placed into the Privacy Act system of records DEPARTMENT OF COMMERCE, COMMERCE-PAT-7, System name: <i>Patent Application Files</i>. Documents not retained in an application file (such as the PTO-2038) are placed into the Privacy Act system of COMMERCE/PAT-TM-10, System name: <i>Deposit Accounts and Electronic Funds Transfer Profiles</i>.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p>		
NAME OF SOLE OR FIRST INVENTOR:		<input type="checkbox"/> A petition has been filed for this unsigned inventor
Given Name (first and middle [if any])		Family Name or Surname
Inventor's Signature		Date
Residence: City	State	Country
		Citizenship
Mailing Address		
City	State	Zip
		Country
<input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto.		

[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.

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

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

PTO/SB/01A (07-07)

Approved for use through 06/30/2010. OMB 0651-0032

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

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)**

Title of Invention	
<p>As the below named inventor(s), I/we declare that:</p> <p>This declaration is directed to:</p> <p><input type="checkbox"/> The attached application, or</p> <p><input type="checkbox"/> Application No. _____ filed on _____</p> <p><input type="checkbox"/> As amended on _____ (if applicable);</p> <p>I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;</p> <p>I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;</p> <p>I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.</p> <p align="center">WARNING:</p> <p>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.</p> <p>All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.</p>	

FULL NAME OF INVENTOR(S)	
Inventor one: _____	Date: _____
Signature: _____	Citizen of: _____
Inventor two: _____	Date: _____
Signature: _____	Citizen of: _____
<input type="checkbox"/> Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.	

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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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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602.01 Oath Cannot Be Amended

The wording of an oath or declaration cannot 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 must be required. 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(c)(1) and (c)(2).

For example, if the oath does not set forth evidence that the notary was acting within his or her jurisdiction at the time he or she administered the oath, a certificate of the notary that the oath was taken within his or her jurisdiction will correct the deficiency. See MPEP § 602 and § 604.02.

Applicant may be so advised by using form paragraph 6.03.

¶ 6.03 Oath, Declaration Cannot Be Amended

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. 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 is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

1. This form paragraph is intended primarily for use in *pro se* applications.
2. Use form paragraph 6.05 and one or more of form paragraphs 6.05.01 to 6.05.20 for a defective oath or declaration in a case where there is a power of attorney.
3. Some corrections may be made by an application data sheet. If the error is correctable by an application data sheet, applicant should be informed of the requirements of an application data sheet. See 37 CFR 1.76 and MPEP § 601.05.

¶ 6.05.16 Non-Initialed/Non-Dated Alterations

Non-initialed and/or non - dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

602.02 New Oath or Substitute for Original [R-2]

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the application number and the date of filing. Any one of the combinations of information identified in MPEP § 602 as acceptable for an oath or declaration filed after the filing date may be used.

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 Defective Oath or Declaration [R-7]

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that the same be remedied. Applicant may be informed of deficiencies in the declaration or oath by form paragraphs 6.05 and 6.05.01 - 6.05.20.

The following form paragraph 6.05 must be used to introduce one or more of Form Paragraphs 6.05.01 - 6.05.20, which explain errors in the oath or declaration. One or more of the following form paragraphs may be used to notify applicant of the objections to the oath or declaration due to a missing “reviewed and understands” statement, “original and first” statement, duty to disclose statement, or if the oath or declaration is not in permanent ink. See MPEP § 602 for defects in the execution of the oath or declaration, failure to properly reference to an earlier foreign application, or a failure to properly identify the application papers. See MPEP § 602.04 for a defective foreign executed oath and MPEP § 602.04(a) for an oath with an improperly attached ribbon.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.05 “Reviewed and Understands” Statement Omitted

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.06 Original and First Omitted

It does not 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.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

**>

¶ 6.05.07 Duty To Disclose Not Properly Acknowledged

It does not 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 37 CFR 1.56.”

Examiner Note:

1. This paragraph must be preceded by form paragraph 6.05.
2. Oaths or declarations acknowledging a duty to disclose information “material to the examination of the application in accordance with 37 CFR 1.56(a),” as was required by 37 CFR 1.63(b)(3) prior to March 16, 1992, are no longer acceptable. See 1327 OG 112 (February 12, 2008).

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¶ 6.05.15 Not in Permanent Ink

The [1] is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a)(1)(iv).

Examiner Note:

1. In bracket 1, insert either signature or oath/declaration.
2. This paragraph must be preceded by form paragraph 6.05.
3. If other portions of the disclosure are not in permanent ink, use form paragraph 6.32.

When an application is otherwise ready for issue, an examiner with full signatory authority may waive the following minor deficiencies:

Minor deficiencies in the body of the oath or declaration where the deficiencies are self-evidently cured

in the rest of the oath or declaration. *In re Searles*, 422 F.2d 431, 437, 164 USPQ 623, 628 (CCPA 1970).

If such a deficiency is waived, the examiner with full signatory authority should write in the margin of the declaration or oath a notation why the deficiency was waived, indicate that the application is ready for issue, and provide his or her initials and the date. For Image File Wrapper (IFW) processing, see IFW Manual.

Of course, requirements of the statute, e.g., that the applicant state his or her citizenship or believes himself or herself to be the original and first inventor or that the oath be administered before a person authorized to administer oaths or that a declaration pursuant to 35 U.S.C. 25 or contain the language required therein, cannot be waived.

If the defect cannot be waived, form paragraph 6.46 should be used when the application is allowable.

¶ 6.46 Application Allowed, Substitute Declaration Needed

Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth [1]. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the “Notice of Allowability” (PTO-37). Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136. Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the “Notice of Allowance” (PTOL-85) and the application number in the upper right hand corner.

Examiner Note:

In the bracket, insert appropriate information, e.g., --in this communication--, --in the Office action mailed _____--.

602.04 Foreign Executed Oath

An oath executed in a foreign country must be properly authenticated. See 37 CFR 1.66 and MPEP § 604.

Where the authority of the foreign officer is not certified, form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.13 may be used.

¶ 6.05.13 Authority of Foreign Officer Not Certified

It does not include an apostille, a consular certificate, or the position of authority of the officer signing an apostille or consular certificate, see 37 CFR 1.66(a).

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

602.04(a) Foreign Executed Oath Is Ribbed to Other Application Papers [R-7]

37 CFR 1.66. Officers authorized to administer oaths.

(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribbed or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Where the papers are not properly ribbed, use form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.14.

¶ 6.05.14 No Ribbon Properly Attached

It does not have a ribbon properly attached.

Examiner Note:

This paragraph applies only to foreign executed oaths and must be preceded by form paragraph 6.05.

U.S. ACCESSION TO HAGUE CONVENTION ABOLISHING THE REQUIREMENT OF LEGALIZATION FOR FOREIGN PUBLIC DOCUMENTS

On Oct. 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 web site of the Hague Conference on Private International Law at http://www.hcch.net/index_en.php by selecting “Apostille Section” under “International Legal Co-operation and Litigation” and then selecting “Status table of the Apostille Convention” under “Contracting States.”<

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:
.....	

Note that a declaration in lieu of application oath (37 CFR 1.68) need not be ribbed to the other papers. It must, however, be maintained together therewith.

602.05 Oath or Declaration — Date of Execution

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale (that is when the date of execution is more than 3 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.

602.05(a) Oath or Declaration in Continuation and Divisional Applications [R-7]

A continuation or divisional application filed 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 37 CFR 1.63(d)(1)(iv).

A copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application 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. See 37 CFR 1.52(c)(3). 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. The examiner should also (A) require a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(f); and (B) indicate that the application should be redesignated as a continuation-in-part.

A continuation or divisional application of a prior application accorded status under 37 CFR 1.47 will be accorded status under 37 CFR 1.47 if a copy of the decision according 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 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 non-signing inventor, unless a copy of the decision according status under 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 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 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), 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.

602.06 Non-English Oath or Declaration [R-3]

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-3]

See MPEP § 1893.01>(e)<.

603 Supplemental Oath or Declaration

37 CFR 1.67. 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]

37 CFR 1.67 requires in the supplemental oath or declaration substantially all the data called for in 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 (37 CFR 1.42, 1.43, or 1.47), or by only those inventor(s) or applicants (37 CFR 1.42, 1.43, or 1.47) to whom the corrections relates. See 37 CFR 1.67(a). A deficiency or inaccuracy relating to information required by 37 CFR 1.63(c) may also be corrected with an application data sheet (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 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 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 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 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).

A new oath may be required by using form paragraph 6.06.

¶ 6.06 *New Oath for Subject Matter Not Originally Claimed*

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP § 608.01(d) and 1302, and 37 CFR 1.73.

603.01 Supplemental Oath or Declaration Filed After Allowance [R-7]

Since the decision in *Cutter Co. v. Metropolitan Electric Mfg. Co.*, 275 F. 158 (2d Cir. 1921), many supplemental oaths and declarations covering the claims in the application have been filed after the applications were allowed. Such oaths and declarations may be filed as a matter of right and 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 Administration or Execution of Oath

37 CFR 1.66. *Officers authorized to administer oaths.*

(a) The 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.

See MPEP § 602.04(a) for foreign executed oath.

604.01 Seal [R-3]

Documents with seals cannot be adequately scanned for retention in an Image File Wrapper, and since the Office maintains patent applications in an image form **, the Office strongly encourages the use of declarations rather than oaths. 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 in MPEP § 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the examiner should require proof of authority. 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.

See also MPEP § 602.04(a) on foreign executed oath and seal. 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.

¶ 6.06 *New Oath for Subject Matter Not Originally Claimed*

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. [1]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Examiner Note:

Explain new claimed matter in bracket 1. The brief summary of the invention must be commensurate with the claimed invention and may be required to be modified. See MPEP § 608.01(d) and 1302, and 37 CFR 1.73.

¶ 6.05.11 *Notary Signature*

It does not include the notary's signature, or the notary's signature is in the wrong place.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

¶ 6.05.12 *Notary Seal and Venue Omitted*

It does not include the notary's seal and venue.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

604.02 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, must be required. *Ex parte Delavoye*, 1906 C.D. 320, 124 O.G. 626 (Comm'r Pat. 1906); *Ex parte Irwin*, 1928 C.D. 13, 367 O.G. 701 (Comm'r Pat. 1928).

Form paragraph 6.07 may be used where the venue is not shown.

¶ 6.07 *Lack of Venue*

The oath lacks the statement of venue. Applicant is required to furnish either a new oath or declaration in proper form, identifying the application by application number and filing date, or a certificate by the officer before whom the original oath was taken stating that the oath was executed within the jurisdiction of the officer before whom the oath was taken when the oath was administered. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Where the seal and venue differ, applicant should be notified by using the “Notice of Informal Application” form.

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

(A) All judge advocates of the Army and Air Force;

(B) All law specialists;

(C) All summary courts-martial;

(D) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;

(E) All commanding officers of the Navy and Coast Guard;

(F) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and

(G) All other persons designated by regulations of the armed forces or by statute.

(H) The signature without seal of any such person acting as notary, together with the title of his office, shall be *prima facie* evidence of his authority.

604.04 Consul

On Oct. 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 conventions. See MPEP § 604.04(a).

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, MPEP § 604. 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.

604.04(a) Consul – Omission of Certificate [R-2]

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 (see MPEP § 602.04(a)), the application is nevertheless accepted for purposes of examination. The examiner, in the first Office action, should note this informality and require **>a new properly authenticated< oath by an appropriate diplomatic or consular officer, the filing of proper apostille, or a declaration (37 CFR 1.68). >The Office no longer returns improperly authenticated oaths for proper authentication.<

Form paragraph 6.08 may be used to notify applicant.

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¶ 6.08 *Consul-Omission of Certificate*

The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

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604.06 By Attorney in Application

The language of 37 CFR 1.66 and 35 U.S.C. 115 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, the proper action is to require a new oath or declaration and refer the file to the Office of Enrollment and Discipline. (*Riegger v. Beierl*, 1910 C.D. 12, 150 O.G. 826 (Comm'r Pat. 1910)). See 37 CFR 1.66 and MPEP § 604.

605 Applicant [R-2]

37 CFR 1.41. 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.

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(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. 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.

37 CFR 1.41 and 37 CFR 1.53 were amended effective December 1, 1997, to remove the requirement that the name(s) of the inventor(s) be identified in the application papers in order to accord the application a filing date. 37 CFR 1.41(a)(1) now defines the inventorship of a nonprovisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63, except as provided for in 37 CFR 1.53(d)(4) and 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 37 CFR 1.41(a) 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.

The name, residence, and citizenship of each person believed to be an actual inventor should be provided as an application identifier when application papers under 37 CFR 1.53(b) are filed without an oath or declaration, or application papers under 37 CFR 1.53(c) are filed without a cover sheet. See 37 CFR 1.41(a)(3). 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.

For correction of inventorship, see MPEP § 201.03.

This section concerns filing by the actual inventor. If the application is filed by another, see MPEP § 409.03.

For assignments of application by inventor, see MPEP § 301. For an inventor who is dead or insane, see MPEP § 409.

605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant, in a nonprovisional application, to state his or her citizenship. Where an applicant 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.

Form paragraphs 6.05 and 6.05.03 may be used to notify applicant that the applicant's citizenship is omitted.

¶ 6.05 Oath or Declaration Defective, Heading

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Examiner Note:

1. One or more of the appropriate form paragraphs 6.05.01 to 6.05.20 must follow this paragraph.
2. If none of the form paragraphs apply, then an appropriate explanation of the defect should be given immediately following this paragraph.

¶ 6.05.03 Citizenship Omitted

It does not identify the citizenship of each inventor.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05

605.02 Applicant's Residence [R-7]

Applicant'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 applicant 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(b). Applicant'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 the residence is not included in the executed oath or declaration filed under 37 CFR 1.63, the Office of Patent Application Processing (OPAP) will normally so indicate on a "Notice of Informal Application," so as to require the submission of the residence information within a set period for reply. If the exam-

iner notes that the residence has not been included in the oath or declaration or in an application data sheet, form paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.02 should be used.

¶ 6.05.02 *Residence Omitted*

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or a supplemental oath or declaration.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

605.03 Applicant's Mailing or Post Office Address [R-7]

Each applicant's mailing or post office address is required to be supplied on the oath or declaration, if not stated in an application data sheet. Applicant's mailing address means that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the mailing address. The mailing address should include the ZIP Code designation. Since the term "post office address" as previously used in 37 CFR 1.63 may be confusing, effective November 7, 2000, 37 CFR 1.63 was amended to use the term "mailing address" instead.

The object of requiring each applicant's mailing address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant 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, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

If an oath or declaration was filed prior to December 1, 1997 and the post office address was incomplete or omitted from the oath or declaration, "Notice of Informal Application" or form paragraph 6.09.01 may be used to notify applicant of the deficiency of the post office address.

¶ 6.09.01 *Post Office Address Omitted, Residence Given*

Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

Examiner Note:

1. This form paragraph should only be used where the Post Office address has been omitted in an oath or declaration filed prior to December 1, 1997. Use form paragraphs 6.05 and 6.05.19 if the oath or declaration was filed on or after December 1, 1997.
2. If both the post office address and residence are incomplete, not uniform or omitted, use form paragraphs 6.05 and 6.05.02.

Oaths or declarations filed on or after December 1, 1997 must include the mailing or post office address of each inventor. Effective November 7, 2000 the mailing address of each inventor may be provided in an application data sheet. See 37 CFR 1.63(c) and 37 CFR 1.76. In an application filed before November 29, 2000, the Office of Patent Application Processing (OPAP) will normally indicate the omission of an inventor's mailing address on a "Notice of Informal Application," requiring a new oath or declaration when the form is sent out with an Office action. For utility and plant applications filed on or after November 29, 2000, applicant's mailing address may be needed for any patent application publication. 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. If the examiner notes that the mailing or post office address has not been included in an oath or declaration filed on or after December 1, 1997, and the mailing address is not provided in an application data sheet, form paragraphs 6.05 (reproduced in MPEP § 605.01) and 6.05.19 may be used to notify applicant that the mailing or post office address has been omitted from the oath or declaration.

¶ 6.05.19 *Mailing Address Omitted*

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Examiner Note:

This paragraph must be preceded by form paragraph 6.05.

605.04(a) Applicant's Signature and Name [R-7]

37 CFR 1.64. Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

I. EXECUTION OF OATHS OR DECLARATIONS OF PATENT APPLICATIONS

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 § 605.04(d). If applicant signs his or her name using non-English characters, then such a signature will be accepted.

Applications filed through the 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 a specification and/or claims.

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. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. >Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration (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 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)(1) states that “[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.” 37 CFR 1.52(c)(2) states that after the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by 37 CFR 1.121. An application submitted through the electronic filing system (EFS) may include scanned images of a declaration executed by the inventor. The reformatting of an application in submitting the specification of the application using EFS, is not an “alteration of the application papers” requiring a substitute oath or declaration. It is acceptable to print out a copy of the specification prepared using traditional word processing software for the inventor to review as he or she signs the oath or declaration, and then cut and paste from the electronic document to prepare the EFS version of the specification

and to submit a scanned copy of the declaration with the EFS submission.

In summary, it is emphasized that the application filed must be the application executed by the applicant and it is improper for anyone, including counsel, to alter, rewrite, or partly fill in any part of the application, including the oath or declaration, after execution of the oath or declaration by the applicant. This provision should particularly be brought to the attention of foreign applicants by their United States counsel since the United States law and practice in this area may differ from that in other countries.

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office ** will require a new oath or declaration >if the alterations are not initialed and dated<. Form paragraph 6.02.01 may be used to call noninitialed and/or nondated alterations to applicant's attention.

**>

¶ 6.02.01 *Non-Initialed and/or Non-Dated Alterations in Application Papers*

The application is objected to because of alterations which have not been initialed and/or dated as is required by 37 CFR 1.52(c). A properly executed oath or declaration which complies with 37 CFR 1.67(a) and identifies the application by application number and filing date is required.

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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) to § 714.01(d).

II. EXECUTION OF OATH OR DECLARATION ON BEHALF OF INVENTOR

The oath or declaration required by 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 37 CFR 1.64, MPEP § 409.01 and § 409.02. 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.).

605.04(b) One Full Given Name Required [R-7]

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.

Form paragraphs 6.05 (reproduced in MPEP § 602.03) and 6.05.18 may be used to notify applicant that the oath or declaration is defective because the full given name of each inventor has not been adequately stated.

¶ 6.05.18 *Full Given Name Is Not Set Forth*

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

Examiner Note:

This paragraph must be preceded by paragraph 6.05.

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. Without such a statement, the examiner should treat the singular letter(s) as an abbreviation of the inventor's given name and should object to the oath or declaration using the appropriate form paragraphs. Applicant may overcome this objection by filing a responsive statement that the singular letter(s) is/are the inventor's given name(s).

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 his or her legal name. Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee. Since amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the name of the inventor cannot be granted if filed after the payment of the issue fee. The petition should be directed to the attention of the Office of Petitions. Upon granting of the petition, if the application is maintained in paper, the left margin of the original oath or declaration should be marked in red ink "See paper No. ___ for correction of the inventor's name," and the application should be sent to the Office of Patent Application Processing (OPAP) for correction of its records, unless the application is an application with an application data sheet (e.g., an 09/ series application), in which case the Office of Petitions will correct the Office computer records and print a new bibliographic data sheet. If the application is assigned, it will be forwarded by OPAP or the Office of Petitions to the Assignment Division for a change in the assignment record.

When a typographical or transliteration error in the spelling of an inventor's name is discovered during

pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. However, applicants are strongly encouraged to use an application data sheet such that any patent to issue will reflect the correct spelling of the inventor's name. Without an application data sheet with the corrected spelling, any patent to issue is less likely to reflect the correct spelling since the spelling of the inventor's name is taken from the oath or declaration, or any subsequently filed application data sheet.

If the error 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 to correct the spelling of the inventor's name submitted with a request for continued examination (RCE) under 37 CFR 1.114, or (B) a certificate of correction must be filed after the patent issues requesting correction of the spelling of the inventor's name.

When any correction or change is effected, the Office computer records must be changed. If the application is maintained in paper, the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. ___ for inventorship changes." See MPEP §§ 201.03 and 605.04(g). If the application is an Image File Wrapper (IFW) application, after the Office records are corrected, a new bib-data sheet must be printed and added to the IFW.

605.04(c) Inventor Changes Name [R-7]

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. Applicants are also strongly encouraged to submit an application data sheet (37 CFR 1.76) showing the new name. The petition should be directed to the attention of the Office of Petitions. The petition must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order.

Since amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the name of the inventor can-

not be granted if filed after the payment of the issue fee.

If an application data sheet is not submitted, the petition may still be granted, but the patent may not reflect the correct spelling of the inventor's name.

If the petition is granted, if the application is maintained in paper with a file jacket label (i.e., the application is an 08/ or earlier series application), the original declaration must be marked in red ink, in the left margin "See paper No. _ for correction of inventor name" and the application should be sent to the Office of Patent Application Processing (OPAP) for change of name on the file wrapper and in the PALM database. If the petition is granted in an Image File Wrapper (IFW) application or if the application is an 09/ or later series application, the spelling of the inventor's name should be changed in the Office computer records and a new PALM bib-data sheet should be printed. 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 Division for a change in the assignment record.

605.04(d) Applicant Unable to Write

If the applicant is unable to write, his or her 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.

605.04(e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr.", in connection with his or her signature. The title will not appear in the printed patent.

605.04(f) Signature on Joint Applications - Order of Names [R-7]

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. Since the particular

order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. Applicants are strongly encouraged to submit an application data sheet showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue. 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. When the Office of Petitions grants a petition to change the order of the names of the inventors, the Office of Petitions will change the order of the names in the Office computer records and print a new bib-data sheet, unless the application is an 08/ or earlier series application, in which case, the application should be sent to the Office of Patent Application Processing (OPAP) for correction on the file wrapper label and the PALM database. Since a change to the order of the inventor's names is an amendment to the application and amendments are not permitted after the payment of the issue fee (37 CFR 1.312), a petition under 37 CFR 1.182 to change the order of the inventor's name cannot be granted if filed after the payment of the issue fee.

In those instances where the joint applicants file separate oaths or declarations, 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.

605.04(g) Correction of Inventorship [R-7]

When a request is granted to add or delete inventors under 37 CFR 1.48, the change should be noted in red ink in the left margin of the original oath or declaration, if the application is maintained in paper. The notation should read "See Paper No. ____ for inventorship changes." For Image File Wrapper (IFW) processing, see IFW Manual. The application (other than 09/ or later series applications) should be sent to the Office of Patent Application Processing (OPAP) for correction on the file wrapper label and the PALM database regarding the inventorship. A

brief explanation on an “Application Division Data Base Routing Slip” (available from the Technology Center (TC) technical support staff) should accompany the application file to >OPAP<. For 09/ or later series applications, the examiner should have the TC’s technical support staff enter the correction in the PALM database and print a new PALM bib-data sheet, which will then be placed in the file wrapper, if correction of the database and printing of a new PALM bib-data sheet was not already done by the Office of Petitions.

605.05 Administrator, Executor, or Other Legal Representative

In an application filed by a legal representative of the inventor, the specification should not be written in the first person.

For prosecution by administrator or executor, see MPEP § 409.01(a).

For prosecution by heirs, see MPEP § 409.01(a) and § 409.01(d).

For prosecution by representative of legally incapacitated inventor, see MPEP § 409.02.

For prosecution by other than inventor, see MPEP § 409.03.

605.07 Joint Inventors

35 U.S.C. 116. Inventors

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.

35 U.S.C. 116, as amended by Public Law 98-622, 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 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.

Items (A) and (B) adopt the rationale stated in decisions such as *Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967).

Item (C) adopts the rationale of cases such as *SAB Industrie AB v. Bendix Corp.*, 199 USPQ 95 (E.D. Va. 1978).

With regard to item (A), see *Kimberly-Clark Corp. v. Procter & Gamble Distributing Co.*, 973 F.2d 911, 916-17, 23 USPQ 2d 1921, 1925-26 (Fed. Cir. 1992) (some quantum of collaboration or connection is required in order for persons to be “joint” inventors under 35 U.S.C. 116, and thus individuals who are completely ignorant of what each other has done until years after their individual independent efforts cannot be considered joint inventors).

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 more than one invention is included in the application, the examiner may require the application to be restricted to one of the inventions. 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.

It is possible that different claims of an application or patent may have different dates of inventions even though the patent covers only one independent and distinct invention within the meaning of 35 U.S.C. 121. When necessary, the U.S. Patent and Trademark Office or a court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

GUIDELINES

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.

Since 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.

The significant features resulting from the amendments to 35 U.S.C. 116 by Public Law 98-622 are the following:

(A) The 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 by signing the same; this is a clarification, but not a change in current practice.

(B) Inventors may apply for a patent jointly even though “they did not work together or at the same time,” thereby clarifying (a) that it is not necessary that the inventors physically work together on a project, and (b) that one inventor may “take a step at one time, the other an approach at different times.” (*Monsanto Co. v. Kamp*, 269 F. Supp. 818, 824, 154 USPQ 259, 262 (D.D.C. 1967)).

(C) Inventors may apply for a patent jointly even though “each did not make the same type or amount of contribution,” thereby clarifying the “fact that each of the inventors play a different role and that the contribution of one may not be as great as that of another does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem.” *Monsanto Co. v. Kamp*, 269 F. Supp. at 824, 154 USPQ at 262.

(D) Inventors may apply for a patent jointly even though “each did not make a contribution to the subject matter of every claim of the patent.”

(E) Inventors may apply for a patent jointly as long as each inventor made a contribution, i.e., was an inventor or joint inventor, of the subject matter of at least one claim of the patent; there is no requirement that all the inventors be joint inventors of the subject matter of any one claim.

(F) 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.

(G) The amendment to 35 U.S.C. 116 increases the likelihood that different claims of an application or patent may have different dates of invention; when necessary the Office or court may inquire of the patent applicant or owner concerning the inventors and the invention dates for the subject matter of the various claims.

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 through error without any deceptive intention on the part of the person being added as an inventor. This is specially covered in 37 CFR 1.48(c).

Under 35 U.S.C. 116, an examiner may reject claims under 35 U.S.C. 102(f) only in circumstances where a named inventor is not the inventor of at least one claim in the application; no rejection under 35 U.S.C. 102(f) is appropriate if a named inventor made a contribution to the invention defined in any claim of the application.

Under 35 U.S.C. 116, considered in conjunction with 35 U.S.C. 103(c), a rejection may be appropriate under 35 U.S.C. 102(f)/103 where the subject matter, i.e., prior art, and the claimed invention were not owned by, or subject to an obligation of assignment to, the same person at the time the invention was made.

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.

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.

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. If inventors of subject matter, not commonly owned at the time of the later invention, file a joint application, applicants have an obligation pursuant to 37 CFR 1.56 to point out the inventor and invention dates of each claim and the lack of common ownership at the time the later invention was made in order that the examiner may consider the applicability of 35 U.S.C. 102(e)/103, 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103. The examiner should assume, unless there is evidence to the contrary, that applicants are complying with their duty of disclosure. It should be pointed out that 35 U.S.C. 119(a) benefit may be claimed to any foreign application as long as the U.S. named inventor was the inventor of the foreign application invention and 35 U.S.C. 119(a)-(d) requirements are met. Where two or more foreign applications are combined in a single U.S. application, to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, the U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the foreign applications provided all the requirements of 35 U.S.C. 119(a)-(d) are met. One of the conditions for benefit under 35 U.S.C. 119(a) is that the foreign application must be for “the same invention” as the application in the United States. Therefore, a claim in the U.S. application which relies on the combination of prior foreign applications may not be entitled to the benefit under 35 U.S.C. 119(a) if the subject matter of the claim is not sufficiently disclosed in the prior foreign application. *Cf. Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 42 USPQ2d 1674 (Fed. Cir. 1997). For example:

If foreign applicant A invents X and files a foreign application; foreign applicant B invents Y and files separate foreign application. A+B combine inventions X+Y and A and B are proper joint inventors under 35 U.S.C. 116 and file U.S. application to X+Y. The U.S. application may claim benefit under 35 U.S.C. 119(a) to each of the for-

ign applications provided the requirements of 35 U.S.C. 119(a)-(d) are met.

606 Title of Invention [R-5]

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.

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. Inasmuch as the words >“new,”< “improved,” “improvement of,” and “improvement in” 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. >Similarly, the articles “a,” “an,” and “the” should not be included as the first words 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.<

606.01 Examiner May Require Change in Title [R-2]

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 examiner's amendment. If the change in the title is the only change being made by the examiner at the time of allowance, and the application is maintained in paper, a separate examiner's amendment need not be prepared. The examiner is to indicate the change in the title on the file label (or bib-data sheet in 09/ series applications) using BLACK ink and place his or her initials and the date in the margin. For Image File Wrapper (IFW) applications, informal examiner's amendments are not permitted and a separate examiner's amendment must be prepared, and a copy of the bib-data sheet must be added to the IFW. 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-5]

Patent application filing fees are set in accordance with 35 U.S.C. 41 and are listed in 37 CFR 1.16.

I. BASIC FILING, SEARCH, AND EXAMINATION FEES

The Consolidated Appropriations Act, 2005 (Consolidated Appropriations Act), effective December 8, 2004, provides for a separate filing fee, search fee, and examination fee during fiscal years 2005 and 2006. 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)(1), (b)(1), (c)(1) or (e)(1); 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, if applicable (see subsection II. below); and excess claims fees, if applicable (see subsection III. below).

For nonprovisional applications filed under 35 U.S.C. 111(a) before December 8, 2004 (including reissue applications), the following fees are required: basic filing fee as set forth in 37 CFR 1.16(a)(2),

(b)(2), (c)(2) or (e)(2)); and excess claims fees, if applicable (see subsection III. below). No search and examination fees are required for nonprovisional applications filed under 35 U.S.C. 111(a) before December 8, 2004.

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 applications filed on or after December 8, 2004 but prior to July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if the search and/or examination fees are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is not required. For applications filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(b) or (d), if any of the basic filing fee, the search fee, or the examination fee are paid on a date later than the filing date of the application, the surcharge under 37 CFR 1.16(f) is required.

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).

See also MPEP § 1415 for reissue application fees.

II. APPLICATION SIZE FEE

The Consolidated Appropriations Act also provides for an application size fee. 37 CFR 1.16(s) sets forth the application size fee for any application (including any provisional applications and any reissue applications) filed under 35 U.S.C. 111 on or after December 8, 2004 the specification (including claims) and drawings of which, excluding a sequence listing or computer program listing filed in an electronic medium in compliance with the rules (see 37 CFR 1.52(f)), exceed 100 sheets of paper. The application size fee does not apply to any applications filed before December 8, 2004. The application size fee applies

for each additional 50 sheets or fraction thereof over 100 sheets of paper. Any sequence listing in an electronic medium in compliance with 37 CFR 1.52(e) and 37 CFR 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s).

For purposes of determining the application size fee required by 37 CFR 1.16(s), for an application the specification >(including claims)< and drawings of which, excluding any sequence listing in compliance with 37 CFR 1.52(e) and 37 CFR 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with 37 CFR 1.52(e) and 37 CFR 1.96, are submitted in whole or in part on an electronic medium other than the Office electronic filing system, each three kilobytes of content submitted on an electronic medium 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 Office 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 Office electronic filing system for purposes of computing the application size fee required by 37 CFR 1.16(s). Any sequence listing in compliance with 37 CFR 1.821(c) or (e), and any computer program listing in compliance with 37 CFR 1.96, submitted via the Office 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 American Standard Code for Information Interchange (ASCII) text as part of an associated file of the application. See 37 CFR 1.52(f)(2). Sequence listings or computer program listings submitted via the Office electronic filing system in Portable Document Format (PDF) as part of the specification or as Tagg(ed) Image File Format (TIFF) drawing files would not be excluded when determining the application size fee required by 37 CFR 1.16(s).

For international applications entering the national stage where the basic national fee was not paid before December 8, 2004, see 37 CFR 1.492(j).

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 Consolidated Appropriations Act provides that the excess claims fees specified in 35 U.S.C. 41(a)(2) shall apply only as to those claims (independent or dependent) that, after taking into account any claims that have been canceled, are in excess of the number of claims for which the excess claims fee specified in 35 U.S.C. 41 was paid before December 8, 2004. Thus, the Office will charge the excess claims fees specified in 37 CFR 1.16(h) and (i) if an applicant in an application filed before and pending on or after December 8, 2004, adds a claim (independent or total) in excess of the number of claims (independent or total) for which the excess claims fee was previously paid (under the current or previous fee schedule). The excess claims fees specified in 37 CFR 1.16(h) and (i) apply to any excess claims fee paid on or after December 8, 2004, 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 pending on or after December 8, 2004. Under 35 U.S.C. 41(a)(2) as amended by the Consolidated Appropriations Act, 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 on or after December 8, 2004, and for each claim (whether independent or dependent) in excess of twenty that is presented in a reissue application on or after December 8, 2004.

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.

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 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 on or after December 8, 2004 during a reexamination proceeding.

IV. 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 application size fee (37 CFR 1.16(s));
- (3) the late filing surcharge (37 CFR 1.16(f));
- (4) the processing fee for an application filed in a language other than English (37 CFR 1.17(i));
- (5) the search fee (37 CFR 1.16(k), (l), (m), or (n));
- (6) the examination fee (37 CFR 1.16(o), (p), (q), or (r)); and
- (7) 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 new 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.

607.02 Returnability of Fees [R-7]

35 U.S.C. 42. Patent and Trademark Office funding

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

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, for *ex parte* reexaminations filed under § 1.510, a refund of \$1,690 will be made to the reexamination requester. For *inter partes* reexaminations filed under § 1.913, a refund of \$7,970 will be made to the reexamination requester. The reexamination requester should indicate the form in which any refund should be made (*e.g.*, by check, electronic funds transfer, credit to a deposit account, etc.). Generally, reexamination refunds will be issued in the form that the original payment was provided.

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

Effective November 7, 2000, 37 CFR 1.26(a) was amended to authorize 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 non-extendable time limit set forth in 37 CFR 1.26(b).

III. FEES PAID BY DEPOSIT ACCOUNT

Effective November 7, 2000, the Office no longer treats authorizations to charge a deposit account as being received by the Office on the date the deposit account is actually debited for purposes of refund payments under 37 CFR 1.26 and 37 CFR 1.28. Payment by authorization to charge a deposit account will be treated for refund purposes the same as payments by other means (e.g., check or credit card charge authorization), with each being treated as paid on the date of receipt in the Office as defined by 37 CFR 1.6. 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 Express Mail under 37 CFR 1.10 is used, the “date-in” on the Express Mail 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

Effective March 10, 2006, the Office may refund the search fee and any excess claims fee paid in an application filed under 35 U.S.C. 111(a) on or after December 8, 2004, 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, 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-2]

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which protection is sought. All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. 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 the Rules of Practice. 37 CFR 1.3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that 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, on like authority.

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.

608.01 Specification [R-7]

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 any) 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 (35 U.S.C. 103(c)(2)(C)).

(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:

