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201 Types of Applications [R-07.2015]

35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 161 Patents for plants.

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

35 U.S.C. 171 Patents for designs.

(a) IN GENERAL.—Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

(b) APPLICABILITY OF THIS TITLE.—The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

(c) FILING DATE.—The filing date of an application for patent for design shall be the date on which the specification as prescribed by section 112 and any required drawings are filed.

Patent applications can be directed to three broad types of subject matter:

(A) applications for patents as provided for by 35 U.S.C. 101 relating to a "new and useful process, machine, manufacture, or composition of matter," etc.;

(B) applications for plant patents as provided for by 35 U.S.C. 161; and

(C) applications for design patents as provided for by 35 U.S.C. 171.

The first type of patent application is sometimes referred to as a "utility" patent applications when being contrasted with a plant or design patent application. The specialized procedure which pertains to the examination of applications for design and plant patents are treated in detail in Chapters 1500 and 1600, respectively.

201.01 National Applications [R-08.2017]

35 U.S.C. 111 Application.

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

(a) IN GENERAL.—

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

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112;

(B) a drawing as prescribed by section 113; and

(C) an oath or declaration as prescribed by section 115.

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

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

(b) PROVISIONAL APPLICATION.—

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

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

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

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

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

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

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

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

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.—A provisional application shall not be entitled to the right of priority of any other application under section 119, 365(a), or 386(a) or to the benefit of an earlier filing date in the United States under section 120, 121, 365(c), or 386(c).

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

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

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

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

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

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

(a) IN GENERAL.—

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

(2) CONTENTS.—Such application shall include—

(A) a specification as prescribed by section 112;

(B) a drawing as prescribed by section 113; and

(C) an oath or declaration as prescribed by section 115.

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

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

(b) PROVISIONAL APPLICATION.—

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

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

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

(3) FEE.—

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

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

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

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

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

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

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

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

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

37 CFR 1.9 Definitions.

(a)(1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

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(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to "design application" or "application for a design patent" in this chapter includes an international design application that designates the United States.

I. APPLICATIONS FILED UNDER 35 U.S.C. 111

Applications filed under 35 U.S.C. 111(a) include original nonprovisional utility, plant, design, divisional, continuation, and continuation-in-part applications filed under 37 CFR 1.53(b), reissue applications filed under 37 CFR 1.53(b), and design patent continued prosecution applications (CPAs) filed under 37 CFR 1.53(d). See MPEP § 601.01(a) for an overview of the procedures and requirements for filing applications under 35 U.S.C. 111(a).

For details regarding reissue, design, and plant patent applications, see MPEP Chapters 1400, 1500, and 1600, respectively. For details regarding divisional, continuation, and continuation-in-part applications, see MPEP §§ 201.06 et seq., 201.07, and 201.08, respectively. See MPEP § 201.06(d) for a discussion of continued prosecution applications filed under 37 CFR 1.53(d).

Effective December 18, 2013, the Patent Law Treaties Implementation Act of 2012 (PLTIA) amended the patent laws to implement the provisions of the Patent Law Treaty in title II. Notable changes included the filing date requirements for nonprovisional applications filed under 35 U.S.C. 111(a). Unless the application is for a design patent, nonprovisional applications filed under 35 U.S.C. 111(a) on or after December 18, 2013, are no longer required to include at least one claim or any drawings in order to receive a filing date for the application. See MPEP §§ 601.01(e) and 601.01(f). The filing date of an application for a design patent is the date on which the Office receives the specification including at least one claim and any required drawings. See 35 U.S.C. 171(c). In addition, as

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provided in 35 U.S.C. 111(c), a nonprovisional application filed under 35 U.S.C. 111(a) on or after December 18, 2013, may be filed by a reference to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. See MPEP § 601.01(a), subsection III.

Applications filed under 35 U.S.C. 111(b) are provisional applications for patent and are filed under 37 CFR 1.53(c). Significant differences between nonprovisional applications filed under 35 U.S.C. 111(a) and provisional applications filed under 35 U.S.C. 111(b) include the following:

(A) No claim is required in a provisional application.

(B) No oath or declaration is required in a provisional application.

(C) Provisional applications will not be examined for patentability.

(D) A provisional application is not entitled to claim priority to any foreign application or the benefit of any earlier filed national application.

(E) A design patent application is not entitled to claim the benefit of a provisional application (See 35 U.S.C. 172 and 37 CFR 1.53(c)(4)).

See MPEP § 201.04 for detailed information regarding provisional applications.

For applications not filed under 35 U.S.C. 111, see MPEP Chapters 1800 and 2900 for details regarding international applications (PCT) and international design applications, respectively.

II. INTERNATIONAL APPLICATION DESIGNATING THE UNITED STATES

35 U.S.C. 363 International application designating the United States: Effect.

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office.

37 CFR 1.9(a)(1) defines a national application as a U.S. application which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

Note that 37 CFR 1.9(b) defines an international application for patent as one filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

Treatment of a national application under 35 U.S.C. 111 and a national stage application (a national application which entered the national stage from an international application in which the conditions of 37 CFR 1.9(a)(1) have been satisfied) are similar but not identical.

See MPEP § 1893.03 et seq. for examination of international applications in the national stage, and MPEP § 1896 for a description of the differences between a nonprovisional application filed under 35 U.S.C. 111(a) and an international application filed under the Patent Cooperation Treaty that entered the national stage. Note in particular the following examples:

(A) Restriction practice as explained in MPEP § 806 et seq. is applied to national applications under 35 U.S.C. 111(a) while unity of invention practice as explained in MPEP §§ 1850 and 1893.03(d) is applied to national stage applications.

(B) National nonprovisional applications filed under 35 U.S.C. 111(a) without an executed oath or declaration, basic filing fee, search fee, or examination fee are governed by the notification practice set forth in 37 CFR 1.53(f), as are utility and plant patent applications filed on or after December 18, 2013, without a claim. Incomplete national stage applications are governed by the notification practice set forth in 37 CFR 1.495.

III. INTERNATIONAL DESIGN APPLICATION DESIGNATING THE UNITED STATES

35 U.S.C. 385 Effect of international design application.

An international design application designating the United States shall have the effect, for all purposes, from its filing date determined in accordance with section 384, of an application

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for patent filed in the Patent and Trademark Office pursuant to chapter 16.

37 CFR 1.9 Definitions.

(a)(1) A national application as used in this chapter means either a U.S. application for patent which was filed in the Office under 35 U.S.C. 111, an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means either a U.S. national application for patent which was filed in the Office under 35 U.S.C. 111(a), an international application filed under the Patent Cooperation Treaty in which the basic national fee under 35 U.S.C. 41(a)(1)(F) has been paid, or an international design application filed under the Hague Agreement in which the Office has received a copy of the international registration pursuant to Hague Agreement Article 10.

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(l) Hague Agreement as used in this chapter means the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva, Switzerland, on July 2, 1999, and Hague Agreement Article as used in this chapter means an Article under the Hague Agreement.

(m) Hague Agreement Regulations as used in this chapter means the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement, and Hague Agreement Rule as used in this chapter means one of the Hague Agreement Regulations.

(n) An international design application as used in this chapter means an application for international registration of a design filed under the Hague Agreement. Unless otherwise clear from the wording, reference to "design application" or "application for a design patent" in this chapter includes an international design application that designates the United States.

Title I of the Patent Law Treaties Implementation Act of 2012 (PLTIA), Public Law 112-211, 126 Stat. 1527 (Dec. 18, 2012) implemented the Hague Agreement Concerning International Registration of Industrial Designs. The Hague Agreement is an international agreement that enables an applicant to file a single international design application which may have the effect of an application for protection for the design(s) in countries and/or intergovernmental organizations that are parties to the Hague Agreement (the "Contracting Parties") designated in the application. The United States is a Contracting Party to the Hague Agreement, which took effect with respect to the United States on May 13, 2015. The Hague Agreement is administered by the International Bureau of the World Intellectual Property Organization ("the International Bureau").

See MPEP Chapter 2900 for information regarding international design applications.

201.02 General Terms Used to Describe Applications [R-07.2015]

See 37 CFR 1.9(a) for definitions of the terms "national application," "provisional application," and "nonprovisional application;" see 37 CFR 1.9(b) for the definition of "international application;" and see 37 CFR 1.9(n) for the definition of "international design application." See also MPEP § 201.01.

"Original" application is used in the patent statutes and rules to refer to an application which is not a reissue application. An original application may be a first filing or a continuing application.

A continuing application is a continuation, divisional, or continuation-in-part application filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and 37 CFR 1.78.

A "substitute" application is in essence the duplicate of an application by the same applicant abandoned before the filing of the later application. Current practice does not require applicant to insert in the specification reference to the earlier application; however, attention should be called to the earlier application. A substitute application does not obtain the benefit of the filing date of the prior application. Use form paragraph 2.07 to remind applicant of possible substitute status.

¶ 2.07 Definition of a Substitute

Applicant refers to this application as a "substitute" of Application No. **[1]**, filed **[2]**. The term "substitute" is used to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later application. A "substitute" does not obtain the benefit of the filing date of the prior application.

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201.03 [Reserved]

[Editor Note: Information pertaining to correction of inventorship, name of inventor, and order of names in an application has been moved to MPEP § 602.01(c) et seq.]

201.04 Provisional Application [R-08.2017]

I. PROVISIONAL APPLICATION FILED ON OR AFTER DECEMBER 18, 2013

35 U.S.C. 111 Application.

[Editor Note: Applicable to any patent application filed on or after December 18, 2013. See 35 U.S.C. 111 (pre-PLT) for the law applicable to provisional applications filed under 35 U.S.C. 111(b) before December 18, 2013.]

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(b) PROVISIONAL APPLICATION.—

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

(A) a specification as prescribed by section 112(a); and

(B) a drawing as prescribed by section 113.

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

(3) FEE.—The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

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

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

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

(7) NO RIGHT OF PRIORITY OR BENEFIT OF EARLIEST FILING DATE.—A provisional application shall not be entitled to the right of priority of any other application under section 119, 365(a), or 386(a) or to the benefit of an earlier filing date in the United States under section 120, 121, 365(c), or 386(c).

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

37 CFR 1.9 Definitions.

(a)

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(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

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

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013.]

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(c) *Application filing requirements — Provisional application.* The filing date of a provisional application is the date on which a specification, with or without claims, is received in the Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

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

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

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

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

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

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

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

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. 119, 365(a), or 386(a) or § 1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121, 365(c), or 386(c) or § 1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or § 1.78(a) may be made in a design application based on a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

Effective December 18, 2013, the Patent Law Treaties Implementation Act of 2012 (PLTIA), title II, amended 35 U.S.C. 111(b) to more closely align the corresponding provisions for nonprovisional applications in 35 U.S.C. 111(a) and provisional applications in 35 U.S.C. 111(b). The corresponding provision in 37 CFR 1.53(c) was revised accordingly.

The parts of a provisional application that are required are set forth in 37 CFR 1.51(c) and MPEP § 601.01(b). The filing date of a provisional application filed on or after December 18, 2013, is the date on which a specification as prescribed by 35 U.S.C. 112(a), with or without claims, is filed in the United States Patent and Trademark Office. Although the application will be accorded a filing date regardless of whether any drawings are submitted, applicants are advised to file any drawing required by 37 CFR 1.81(a) with the application. 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.

A provisional application must include a cover sheet required by 37 CFR 1.51(c)(1), which may be an application data sheet (37 CFR 1.76), the Office's form SB/16, Provisional Application for Patent Cover Sheet (available at **www.uspto.gov/patent/forms/forms-patent-applications-filed-or-after-september-16-2012**),or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under 37 CFR 1.53(b). The filing fee is set forth in 37 CFR 1.16(d).

II. PROVISIONAL APPLICATION FILED BEFORE DECEMBER 18, 2013

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

[Editor Note: 35 U.S.C. 111(b) as reproduced herein is applicable to any patent application filed before December 18, 2013. See 35 U.S.C. 111 for the law applicable to provisional applications filed under 35 U.S.C. 111(b) on or after December 18, 2013.]

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(b) PROVISIONAL APPLICATION.—

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

(A) a specification as prescribed by section 112; and

(B) a drawing as prescribed by section 113.

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

(3) FEE.—

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

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

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

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

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

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

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

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

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37 CFR 1.9 Definitions.

(a)

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(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

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

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 before December 18, 2013.]

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

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

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

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; or

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

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

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(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 35 U.S.C. 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(a) 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.

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The parts of a provisional application that are required are set forth in 37 CFR 1.51(c) and MPEP § 601.01(b). The filing date of a provisional application is the date on which a specification as prescribed by 35 U.S.C. 112(a) and any drawing required by 37 CFR 1.81(a) are filed in the U.S. 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.

A provisional application must also include the cover sheet required by 37 CFR 1.51(c)(1), which may be an application data sheet (37 CFR 1.76), the Office's form SB/16, Provisional Application for Patent Cover Sheet (available at **www.uspto.gov/patent/forms/forms**),or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under 37 CFR 1.53(b). The filing fee is set forth in 37 CFR 1.16(d).

III. PROVISIONAL APPLICATION - IN GENERAL

One of the provisions of the Uruguay Round Agreements Act (effective as of June 8, 1995), is the establishment of a domestic priority system. The Act provides a mechanism to enable domestic applicants to quickly and inexpensively file provisional applications. Under the provisions of 35 U.S.C. 119(e), applicants are entitled to claim the benefit of priority in a given application in the United States. The domestic priority period will not count in the measurement of the 20-year patent term. See 35 U.S.C. 154(a)(3). Thus, domestic applicants are placed on equal footing with foreign applicants with respect to the patent term.

A provisional application is a regular national filing that starts the Paris Convention priority year. Foreign filings must be made within 12 months of the filing date of the provisional application if applicant wishes to rely on the filing date of the provisional application in the foreign filed application.

NOTE:

(A) No claim is required in a provisional application.

(B) No oath or declaration is required in a provisional application.

(C) Provisional applications will not be examined for patentability.

(D) A provisional application is not entitled to claim priority to any foreign application or the benefit of any earlier filed national application.

A provisional application will automatically be abandoned 12 months after its filing date and will not be subject to revival to restore it to pending status thereafter. See 35 U.S.C. 111(b)(5). The period of pendency of a provisional application is extended to the next succeeding business day if the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or federal holiday within the District of Columbia. See 35 U.S.C. 119(e)(3) and 37 CFR 1.7(b). For example, if a provisional application was filed on January 15, 1999, the last day of pendency of the provisional application under 35 U.S.C. 111(b)(5) and 35 U.S.C. 119(e)(3) would be extended to January 18, 2000 (January 15, 2000 was a Saturday and Monday, January 17, 2000 was a federal holiday and therefore, the next succeeding business day would be Tuesday, January 18, 2000). A nonprovisional application claiming the benefit of the provisional application must have been filed no later than January 18, 2000.

Effective December 18, 2013, a nonprovisional application that was filed more than 12 months after the filing date of the provisional application, but within 14 months after the filing date of the

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provisional application, may have the benefit of the provisional application restored by filing a grantable petition to restore the benefit under 37 CFR 1.78(b). See MPEP § 211.01(a).

A provisional application is not entitled to claim priority to, or the benefit of, any other application under 35 U.S.C. 119, 120, 121, 365, or 386. If applicant attempts to claim the benefit of an earlier U.S. application or priority to a foreign application in a provisional application, the filing receipt will not reflect the improper benefit or priority claim. Moreover, if a nonprovisional application claims the benefit of the filing date of a provisional application, and states that the provisional application relies upon the filing date of an earlier application, the claim for benefit or priority earlier than the filing date of the provisional application will be disregarded.

An application filed under 37 CFR 1.53(b) may be converted to a provisional application provided a request for conversion is submitted along with the fee as set forth in 37 CFR 1.17(q). The request and fee must be submitted in the nonprovisional application prior to the earlier of the abandonment of the nonprovisional application, the payment of the issue fee, or the expiration of 12 months after the filing date of the nonprovisional application. The grant of any such request will not entitle applicant to a refund of the fees which were properly paid in the application filed under 37 CFR 1.53(b). See MPEP § 601.01(c). 35 U.S.C. 111(b)(5) permits a provisional application filed under 37 CFR 1.53(c) to be converted to a nonprovisional application filed under 37 CFR 1.53(b). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in 37 CFR 1.17(i) and an amendment including at least one claim as prescribed by 35 U.S.C. 112, unless the provisional application otherwise contains at least one such claim. The request must be filed in the provisional application prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. The filing fee, search fee, and examination fee for a nonprovisional application and the surcharge under 37 CFR 1.16(f), if appropriate, are also required. For provisional applications filed before December 18, 2013, if the inventor's oath or declaration was not filed with the provisional application, it must be submitted with the request for conversion. The grant of any such request will not entitle applicant to a refund of the fees which were properly paid in the application filed under 37 CFR 1.53(c). Conversion of a provisional application to a nonprovisional application will result in the term of any patent issuing from the application being measured from at least the filing date of the provisional application. This adverse patent term impact can be avoided by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e), rather than requesting conversion of the provisional application to a nonprovisional application. See 37 CFR 1.53(c)(3).

Design applications may not claim the benefit of a provisional application under 35 U.S.C. 119(e). See 35 U.S.C. 172 and 37 CFR 1.78(a).

201.05 Reissue Application [R-11.2013]

A reissue application is an application for a patent to take the place of an unexpired patent that is defective. A detailed treatment of reissue applications can be found in MPEP Chapter 1400.

201.06 Divisional Application [R-08.2017]

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

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(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

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(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such

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prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

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A later application for an independent or distinct invention, carved out of a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application. The divisional application should set forth at least the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application. A continuation-in-part application should not be designated as a divisional application. The Court of Appeals for the Federal Circuit has concluded that the protection of 35 U.S.C. 121 does not extend to continuation-in-part applications, stating that "the protection afforded by section 121 to applications (or patents issued therefrom) filed as a result of a restriction requirement is limited to divisional applications." *Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc.,* 518 F.3d 1353, 1362, 86 USPQ2d 1001, 1007-1008 (Fed. Cir. 2008). Thus the disclosure presented in a divisional application must not include any subject matter which would constitute new matter if submitted as an amendment to the parent application.

A divisional application is often filed as a result of a restriction requirement made by the examiner. The divisional application may be filed under 37 CFR 1.53(b) (or 37 CFR 1.53(d) if the application is a design application, but not an international design application). The inventorship in the divisional application must include at least one inventor named in the prior-filed application, and the divisional application must claim the benefit of the prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c). See 37 CFR 1.78, especially paragraphs (d) and (e), and MPEP § 211 *et seq.* for additional requirements and more information regarding entitlement to the benefit of the filing date of a prior-filed copending application.

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "divisional" of the provisional application. See 37 CFR 1.78, especially paragraphs (a)-(c), and MPEP § 211 *et seq.* for requirements and information pertaining to entitlement to the benefit of the filing date of a provisional application.

It is no longer appropriate to include the U.S. Patent and Trademark Office classification of the divisional application and the status and assigned art unit of the parent application in the application data sheet. See MPEP § 601.05.

Use form paragraph 2.01 to remind applicant of possible divisional status.

¶ 2.01 Possible Status as Divisional

This application, which discloses and claims only subject matter disclosed in prior Application No. **[1],** filed **[2]**, appears to claim only subject matter directed to an invention that is independent and distinct from that claimed in the prior application, and names the inventor or at least one joint inventor named in the prior application. Accordingly, this application may constitute a divisional application. Should applicant desire to claim the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120, 37 CFR 1.78, and MPEP § 211 *et seq* .

Examiner Note:

1. In brackets 1 and 2, insert the application number (series code and serial number) and filing date of the prior application, respectively.

2. This form paragraph should only be used if it appears that the application may be a divisional, but a benefit claim has not been properly established.

3. An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "divisional" of the prior application.

A design application may be considered to be a divisional of a utility application (but not of a provisional application), and is entitled to the filing date thereof if the drawings of the earlier filed utility application show the same article as that in the design application sufficiently to comply with 35 U.S.C. 112(a). However, such a divisional design application may only be filed under the procedure

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set forth in 37 CFR 1.53(b), and not under 37 CFR 1.53(d). See MPEP § 1504.20.

While a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to "new matter" if introduced by amendment into the parent application. Compare MPEP § 201.08 and MPEP § 211 et seq.

For notation to be put in the file history by the examiner in the case of a divisional application, see MPEP § 202.

201.06(a) Former 37 CFR 1.60 Divisional Continuation Procedure [R-08.2012]

37 CFR 1.60 was deleted effective December 1, 1997. See 1203 O.G. 63, October 21, 1997. A continuation or divisional application filed under 37 CFR 1.60 on or after December 1, 1997, will automatically be treated as an application filed under 37 CFR 1.53(b). All continuation and divisional applications filed under 37 CFR 1.60 prior to December 1, 1997 will continue to be processed and examined under the procedures set forth in former 37 CFR 1.60. For more information pertaining to practice and procedure under former 37 CFR 1.60, see MPEP § 201.06(a) in the MPEP 8th Edition, Rev. 1 (February 2003)(available on the USPTO website at www.uspto.gov/web/offices/pac/mpep/mpep.htm).

201.06(b) Former 37 CFR 1.62 File Wrapper Continuing Procedure [R-08.2012]

37 CFR 1.62 was deleted effective December 1, 1997. See 1203 O.G. 63, October 21, 1997. A request for a continuation or divisional application filed under former 37 CFR 1.62 on or after December 1, 1997, in an application that was filed on or after June 8, 1995, will be treated as a request for continued examination (RCE) under 37 CFR 1.114, see MPEP 706.07(h), paragraph IV. A request filed on or after December 1, 1997, under former 37 CFR 1.62 for a continuation-in-part (CIP) application, or for a continuation or divisional of an application having a filing date before June 8, 1995, will be treated as an improper application.

All continuation, divisional and CIP applications filed under former 37 CFR 1.62 prior to December 1, 1997, will continue to be processed and examined under the procedures set forth in former 37 CFR 1.62. For more information pertaining to practice and procedure under former 37 CFR 1.62, see MPEP § 201.06(b) in the MPEP 8th Edition, Rev. 1 (February 2003)(available on the USPTO website at www.uspto.gov/web/offices/pac/mpep/mpep.htm).

201.06(c) 37 CFR 1.53(b) and 37 CFR 1.63(d) Divisional-Continuation Procedure [R-08.2017]

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

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 on or after December 18, 2013.]

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(b) *Application filing requirements— Nonprovisional application.* The filing date of an application for patent filed under this section, other than an application for a design patent or a provisional application under paragraph (c) of this section, is the date on which a specification, with or without claims, is received in the Office. The filing date of an application for a design patent filed under this section, except for a continued prosecution application under paragraph (d) of this section, is the date on which the specification as prescribed by 35 U.S.C. 112, including at least one claim, and any required drawings are received in the Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121, 365(c), or 386(c) and § 1.78.

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

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

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

[Editor Note: Applicable to patent applications filed under 35 U.S.C. 111 (pre-PLT) before December 18, 2013.]

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

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

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

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I. IN GENERAL

37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (A) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.495; (B) a provisional application under 35 U.S.C. 111(b) and 37 CFR 1.53(c); (C) a continued prosecution application (CPA) of a design application under 37 CFR 1.53(d); or (D) a nonprovisional international design application. Applications submitted under 37 CFR 1.53(b), as well as CPAs submitted under 37 CFR 1.53(d), are applications filed under 35 U.S.C. 111(a). An application filed under 37 CFR 1.53(b) may be an original or a reissue, a continuation, a divisional, a continuation-in-part, or a substitute. (See MPEP § 201.02 for substitute application.) The application may be for a utility patent under 35 U.S.C. 101, a design patent under 35 U.S.C. 171, a plant patent under 35 U.S.C. 161, or a reissue under 35 U.S.C. 251. An application will be treated as one filed under 37 CFR 1.53(b) unless otherwise designated.

For applications filed on or after December 18, 2013, the filing date of a nonprovisional application filed under 35 U.S.C. 111(a), other than a design patent application, is the date on which a specification, with or without claims, is received in the Office. Effective December 18, 2013, utility and plant patent applications filed under 35 U.S.C. 111(a) are no longer required to include at least one claim or any drawings in order to receive a filing date for the application. See MPEP § 601.01(a), subsection I. The filing date of an application for a design patent is the date on which the Office receives the specification including at least one claim and any required drawings. 35 U.S.C. 171(c). In addition, as provided in 35 U.S.C. 111(c), a nonprovisional application filed under 35 U.S.C. 111(a) on or after December 18, 2013, may be filed by a reference to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. See MPEP § 601.01(a), subsection III.

In order to be complete for filing date purposes, all applications filed under 37 CFR 1.53(b) before December 18, 2013, must include a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing required by 37 CFR 1.81(a).

For applications filed on or after September 16, 2012, the basic filing fee, search fee, examination fee and application size fee, and the inventor's oath or declaration in compliance with 37 CFR 1.63 (and 37 CFR 1.64 (for a substitute statement), 37 CFR 1.175 (for a reissue) or 37 CFR 1.162 (for a plant patent)) are also required by 37 CFR 1.51(b) for a complete application. However, the filing of the basic filing fee, search fee, examination fee, application size fee and inventor's oath or declaration may be filed after the application filing date upon payment of the surcharge set forth in 37 CFR 1.16(f). Additionally, the filing of the inventor's oath or declaration may be postponed until payment of the issue fee where the application contains an application data sheet under 37 CFR 1.76 identifying each inventor by the inventor's legal name, and a mailing address where each inventor customarily receives mail, and residence, if the inventor lives at a location which is different from where the inventor customarily receives mail.

For applications filed prior to September 16, 2012, the statutory filing fee and an oath or declaration in

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compliance with 37 CFR 1.63 (and 37 CFR 1.175 (if a reissue) or 37 CFR 1.162 (if for a plant patent)) are also required by 37 CFR 1.51(b) for a complete application, but the filing fee and oath or declaration may be filed after the application filing date upon payment of the surcharge set forth in 37 CFR 1.16(f). See 37 CFR 1.53(f) and MPEP § 607.

Unless an application is submitted with a statement that the application is a continuation or divisional application, see 37 CFR 1.78(d)(2), the Office will process the application as a new non-continuing application. Applicants are advised to clearly designate any continuation, divisional, or continuation-in-part application as such by submitting a reference to the prior-filed application with the appropriate relationship (i.e., continuation, divisional, or continuation-in-part) in compliance with 37 CFR 1.78(d)(2) (i.e., in an application data sheet for an application filed on or after September 16, 2012, or in the first sentence(s) of the specification or in an application data sheet for an application filed prior to September 16, 2012) to avoid the need for a petition to accept an unintentionally delayed claim under 37 CFR 1.78(e) and the petition fee set forth in 37 CFR 1.17(m), and the issuance of a filing receipt that does not indicate that the application is a continuation, divisional, or continuation-in-part. See MPEP § 211 et seq.

II. OATH/DECLARATION

37 CFR 1.63 Oath or Declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012.]

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

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

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

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37 CFR 1.63 (pre-AIA) Oath or Declaration.

[Editor Note: Not applicable to patent applications filed under 35 U.S.C. 111, 363, or 385 on or after September 16, 2012.]

(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.

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(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.

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A copy of an oath or declaration from a prior application may be submitted with a continuation or divisional application, or with a continuation-in-part application filed on or after September 16, 2012, even if the oath or declaration identifies the application number of the prior application. However, if such a copy of the oath or declaration is filed after the filing date of the continuation or divisional application and an application number has been assigned to the continuation or divisional application (see 37 CFR 1.5(a)), the cover letter accompanying the oath or declaration should identify the application number of the continuation or divisional application. The cover letter should also indicate that the oath or declaration submitted is a copy of the oath or declaration from a prior application to avoid the oath or declaration being incorrectly matched with the prior application file. Furthermore, applicant should also label the copy of the oath or declaration with the application number of the continuation or divisional application in the event that the cover letter is separated from the copy of the oath or declaration.

A copy of the oath or declaration from a prior nonprovisional application may be filed in a continuation or divisional application even if the specification for the continuation or divisional application is different from that of the prior application, in that revisions have been made to clarify the text to incorporate amendments made in the prior application, or to make other changes provided the changes do not constitute new matter relative to the prior application. If the examiner determines that the continuation or divisional application contains new matter relative to the prior application, the examiner should so notify the applicant in the next Office action and indicate that the application should be redesignated as a continuation-in-part.

For applications filed on or after September 16, 2012, a continuing application, including a continuation-in-part application, may be filed with a copy of an oath or declaration or substitute statement from the prior nonprovisional application, provided that the oath or declaration is in compliance with 37 CFR 1.63 or the substitute statement is in compliance with 37 CFR 1.64. See 37 CFR 1.63(d)(1). It should be noted that a copy of the inventor's oath or declaration submitted in a continuing application filed on or after September 16, 2012 must comply with requirements of 35 U.S.C. 115 and 37 CFR 1.63 or 1.64 in effect for applications filed on or after September 16, 2012. For example, the inventor's oath or declaration must include a statement that the inventor is an original inventor of the claimed application and a statement that the application was made or was authorized to be made by the person executing the oath or declaration. Accordingly, a new inventor's oath or declaration may need to be filed in a continuing application filed on or after September 16, 2012, where the prior application was filed before September 16, 2012, in order to meet the requirements of 35 U.S.C. 115 and 37 CFR 1.63 (or 1.64) in effect for applications filed on or after September 16, 2012. See MPEP § 602.05(a) for additional details regarding oaths or declarations in continuing applications filed on or after September 16, 2012.

For applications filed prior to September 16, 2012, a newly executed oath or declaration is required in a continuation or divisional application filed under 37 CFR 1.53(b) naming an inventor not named in the prior application, and in a continuation-in-part application. See MPEP § 602.05(b) for additional details regarding oaths or declarations in continuing applications filed before September 16, 2012.

III. SPECIFICATION AND DRAWINGS

A continuation or divisional application may be filed under 35 U.S.C. 111(a) using the procedures set forth in 37 CFR 1.53(b), by providing: (A) a new specification and drawings and a copy of the signed oath or declaration as filed in the prior application

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provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application; or (B) a new specification and drawings and a newly executed oath or declaration provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. For continuing applications filed on or after September 16, 2012, claiming the benefit of an application filed before September 16, 2012, a copy of the inventor's oath or declaration filed in the earlier-filed application can only be submitted in the continuing application if the oath or declaration complies with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012. For applications filed on or after September 16, 2012, to claim the benefit of a prior application under 35 U.S.C. 120, 121, 365(c), or 386(c) applicant must include a reference to the prior application in compliance with 37 CFR 1.78(d)(2) in an application data sheet. For applications filed prior to September 16, 2012, the reference to the prior application must be in the first sentence(s) of the specification or in an application data sheet. See MPEP § 211 et seq.

The new specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) may include changes to the specification and drawings originally filed in the prior application in the manner that an applicant may file a substitute specification, see 37 CFR 1.125, or amend the drawings of an application so long as it does not result in the introduction of new matter. Applicant should file a new set of claims as the original claims of the continuing application instead of filing a copy of the claims from the prior application and a preliminary amendment to those claims. It is the applicant's responsibility to review any new specification or drawings submitted for a continuation or divisional application under 37 CFR 1.53(b) to determine that it contains no new matter. For applications filed before September 16, 2012, an applicant is advised to simply file a continuing application with a newly executed oath or declaration when it is questionable as to whether the continuing application adds material that would have been new matter if presented in the prior application. In addition, for applications filed prior to September 16, 2012, if one or more claims are allowed in the continuation or divisional application which are directed to matter shown and described in the prior nonprovisional application but not claimed in the prior application, the applicant should be required to file a supplemental oath or declaration under pre-AIA 37 CFR 1.67(b). For applications filed on or after September 16, 2012, pursuant to 37 CFR 1.67(b), no supplemental oath or declaration will be required.

If a continuation or divisional application as filed contains subject matter that would have been new matter in the prior application, the applicant is required to delete the benefit claim or change the relationship (continuation or divisional application) to continuation-in-part. Form paragraph 2.10.01 may be used to require the applicant to correct the relationship of the applications. See MPEP § 211 et seq.

Any utility or plant patent application, including any continuing application, that will be published pursuant to 35 U.S.C. 122(b) should be filed under 37 CFR 1.53(b) with a specification that includes any claim(s) and drawings that the applicant would like to have published. This is important because under 35 U.S.C. 154(d), a patentee may obtain provisional rights if the invention claimed in a patent is substantially identical to the invention claimed in the patent application publication and the Office will generally publish the specification (including the claims) and drawings as filed. Filing a continuing application under 37 CFR 1.53(b) with a preliminary amendment (which makes all the desired changes to the specification, including adding, deleting or amending claims) is NOT recommended. 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. If a preliminary amendment is filed in a format that cannot be included in the publication, the Office of Patent Application Processing (OPAP) will issue a notice to the applicant requiring the applicant to submit the amendment in a format usable for publication purposes. See 37 CFR 1.115(a)(1) and 1.215. The only format for an amendment to the specification (other than the claims) that is usable for publication is a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125. As noted above, a continuation or divisional application filed under 37

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CFR 1.53(b) may be filed with a new specification and corrected drawings, along with a copy of an oath or declaration from a prior (parent) application, provided the new specification and drawings do not contain any subject matter that would have been new matter in the prior application. Thus, the new specification and corrected drawings may include some or all of the amendments entered during the prosecution of the prior application(s), as well as additional amendments submitted for clarity or contextual purposes, and a new set of claims. In order to have a patent application publication of a continuation or divisional application contain only a desired set of claims, rather than the set of claims in the prior application, it is strongly recommended that the continuation or divisional application be filed under 37 CFR 1.53(b) with a new specification containing only the desired set of claims.

See subsection II., above and MPEP § 602.05 et seq. for requirements pertaining to filing a copy of an oath or declaration from a prior application in a continuing application.

IV. INCORPORATION BY REFERENCE

An applicant may incorporate by reference the prior application by including, in the continuing application-as-filed, an explicit statement that such specifically enumerated prior application or applications are "hereby incorporated by reference." The statement must appear in the specification. See 37 CFR 1.57(c) and MPEP § 608.01(p). The inclusion of this incorporation by reference statement will permit an applicant to amend the continuing application to include subject matter from the prior application(s), without the need for a petition provided the continuing application is entitled to a filing date notwithstanding the incorporation by reference. For applications filed prior to September 21, 2004, the incorporation by reference statement may appear in the transmittal letter or in the specification. Note that for applications filed prior to September 21, 2004, if applicants used a former version of the transmittal letter form provided by the USPTO, the incorporation by reference statement could only be relied upon to add inadvertently omitted material to the continuation or divisional application.

For applications filed on or after September 21, 2004, a claim under 35 U.S.C. 120, 121, 365(c), or 386(c) and 37 CFR 1.78(d) for benefit of a prior-filed nonprovisional application, international application designating the United States, or international design application designating the United States that was present on the filing date of the continuing application is considered an incorporation by reference of the prior-filed application as to inadvertently omitted material, subject to the conditions and requirements of 37 CFR 1.57(b). Note that pursuant to 37 CFR 1.57(b)(4), any amendment to an international design application pursuant to 37 CFR 1.57(b)(1) is effective only as to the United States and will only be acted upon after the international design application becomes a nonprovisional application.

Effective December 18, 2013, 37 CFR 1.57(b) was amended to contain the provisions of former 37 CFR 1.57(a). The purpose of 37 CFR 1.57(b) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are) inadvertently omitted from an application. For applications filed on or after September 21, 2004, applicants are encouraged to provide an explicit incorporation by reference statement to the prior-filed application(s) for which benefit is claimed under 35 U.S.C. 120 if applicants do not wish the incorporation by reference to be limited to inadvertently omitted material pursuant to 37 CFR 1.57(b). See 37 CFR 1.57(c) and MPEP § 608.01(p) for discussion regarding explicit incorporation by reference. See MPEP § 217 for more detailed information pertaining to incorporation by reference pursuant to 37 CFR 1.57(b).

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior

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application. See *Dart Indus. v. Banner,* 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112(a). *In re de Seversky,* 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). As noted above, however, for applications filed on or after September 21, 2004, 37 CFR 1.57(b) provides that a claim for the benefit of a prior-filed application under 37 CFR 1.78 is considered an incorporation by reference as to inadvertently omitted material. See MPEP § 217.

A. Application NOT Entitled to a Filing Date

Material needed to accord an application a filing date may not be incorporated by reference unless an appropriate petition under 37 CFR 1.53(e) or under 37 CFR 1.182 is granted. Until such a petition has been granted, the application will **not** be entitled to a filing date.

For an application filed on or after September 21, 2004, if the material needed for a filing date is completely contained within a prior-filed application to which benefit is claimed, applicant may file a petition under 37 CFR 1.53(e) along with the fee set forth in 37 CFR 1.17(f) and an amendment with the inadvertently omitted material requesting that the amendment be entered and the application be accorded a filing date as of the original date of deposit of the application papers. See 37 CFR 1.57(b)(3) and MPEP § 217 .

In an application containing an explicit incorporation by reference statement in the specification or in a transmittal letter (if the transmittal letter was filed prior to September 21, 2004), a petition for the granting of a filing date may be made under 37 CFR 1.182. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuing application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuing application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

B. Application Entitled to a Filing Date

If a continuing application as originally filed on or after September 21, 2004 does not include an explicit incorporation by reference statement and is entitled to a filing date despite the inadvertent omission of a portion of the prior application(s), applicant may be permitted to add the omitted material by way of an amendment under 37 CFR 1.57(b). Such an amendment must be made within any time period set by the Office. See 37 CFR 1.57(b)(1).

If an application as originally filed included a proper explicit incorporation by reference statement (or an explicit incorporation by reference statement that has been made effective under 37 CFR 1.57(h)), the omitted specification page(s) and/or drawing figure(s) may be added by amendment provided the omitted item(s) contains only subject matter in common with a document that has been properly incorporated by reference. If the Office identified the omitted item(s) in a "Notice of Omitted Item(s)," applicant must respond to the "Notice of Omitted Item(s)" by filing an appropriate amendment. See MPEP § 601.01(d) and § 601.01(g).

V. INVENTORSHIP IN A CONTINUING APPLICATION

A. Applications Filed On or After September 16, 2012

For applications filed on or after September 16, 2012, the filing of a continuing application by all or by fewer than all of the inventors named in a prior application without a newly executed oath or declaration is permitted provided that an oath or declaration in compliance with 37 CFR 1.63, or a substitute statement under 37 CFR 1.64, was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such oath, declaration, or substitute statement showing the signature or an indication thereon that

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it was executed, is submitted in the continuing application. Note, in order to submit a copy of the inventor's oath or declaration from the earlier-filed application into a continuation or divisional application filed on or after September 16, 2012, the oath or declaration from the earlier-filed application must comply with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012. Specifically, the inventor's oath or declaration must state that the inventor (1) is an original inventor of the claimed invention; and (2) authorized the filing of the patent application for the claimed invention. The inventor's oath or declaration also must contain an acknowledgement that any willful false statement made in such declaration is punishable under section 1001 of U.S. Code title 18 by fine or imprisonment of not more than 5 years, or both.

37 CFR 1.63(d)(2) provides that the inventorship of a continuing application filed under 35 U.S.C. 111(a) is the inventor or joint inventors specified in the application data sheet filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application. If an application data sheet is not filed before or concurrently with the copy of the inventor's oath or declaration from the earlier-filed application, the inventorship is the inventorship set forth in the copy of the inventor's oath or declaration from the earlier-filed application, unless the copy of the inventor's oath or declaration is accompanied by a statement signed pursuant to 37 CFR 1.33(b) stating the name of each inventor in the continuing application. 37 CFR 1.63(d)(3) provides that any new joint inventor named in the continuing application must provide an oath or declaration in compliance with 37 CFR 1.63, except as provided for in 37 CFR 1.64.

37 CFR 1.63(f) provides that with respect to an application naming only one inventor, any reference to the inventor's oath or declaration in this chapter includes a substitute statement executed under 37 CFR 1.64. With respect to an application naming more than one inventor, any reference to the inventor's oath or declaration in this chapter means the oaths, declarations, or substitute statements that have been collectively executed by or with respect to all of the joint inventors, unless otherwise clear from the context.

See also MPEP § 602.01(c) regarding correction of inventorship by filing a continuing application.

B. Applications Filed Prior to September 16, 2012

For applications filed prior to September 16, 2012, applicant has the option of filing: (A) a newly executed oath or declaration signed by the inventors for the continuation or divisional application; or (B) a copy of the oath or declaration filed in the prior application accompanied by a statement from applicant, applicant's representative or other authorized party requesting the deletion of the name(s) of the person or persons who are not inventors in the continuation or divisional application. See pre-AIA 37 CFR 1.63(d) (in effect on September 15, 2012). Where the continuation or divisional application and a copy of the oath or declaration from the prior application are filed without a statement from an authorized party requesting deletion of the name(s) of any person or persons named in the prior application, the continuation or divisional application will be treated as naming as inventor(s) the person or persons named in the copy of the executed oath or declaration from the prior application. Accordingly, if a petition or request under 37 CFR 1.48(a) or (c) was granted in the prior application, the oath or declaration filed in a continuation or divisional application pursuant to 37 CFR 1.53(b) and pre-AIA 37 CFR 1.63(d) should be a copy of the oath or declaration executed by the added inventor(s) filed in the prior application. The statement requesting the deletion of the name(s) of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to 37 CFR 1.33(b) to sign an amendment in the continuation or divisional application.

A newly signed oath or declaration in compliance with pre-AIA 37 CFR 1.63 is required where an inventor who was not named as an inventor in the signed oath or declaration filed in the prior application is to be named in a continuation or divisional application filed under 37 CFR 1.53(b). The newly signed oath or declaration must be signed by all the inventors.

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See also MPEP § 602.01(c)(3) regarding requests for correction of inventorship filed before September 16, 2012.

VI. SUBSTITUTE STATEMENT AND RULE 47 ISSUES

A. Substitute Statement

Under 37 CFR 1.63(d)(1) a newly executed substitute statement under 37 CFR 1.64 is not required under 37 CFR 1.51(b)(2) and 37 CFR 1.53(f) or under 37 CFR 1.497 and 1.1021(d) for an inventor in a continuing application that claims the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) in compliance with 37 CFR 1.78 of an earlier-filed application, provided a substitute statement under 37 CFR 1.64 was executed by or with respect to such inventor and was filed in the earlier-filed application, and a copy of such substitute statement showing the signature or an indication thereon that it was executed is submitted in the continuing application.

B. Pre-AIA 37 CFR 1.47 Issues

For applications filed prior to September 16, 2012, pre-AIA 37 CFR 1.63(d)(3) provides for the situation in which 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 37 CFR 1.47. 37 CFR 1.63(d)(3)(i) requires that the copy of the executed oath or declaration must be accompanied by a copy of any decision granting a petition to accord 37 CFR 1.47 status to such application, unless all nonsigning inventor(s) or legal representative(s) (pursuant to 37 CFR 1.42 or 1.43) have filed an oath or declaration to join in an application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c). 37 CFR 1.63(d)(3)(ii) also requires that where one or more, but not all, nonsigning inventor(s) or legal representative(s) (pursuant to 37 CFR 1.42 or 1.43) subsequently joins in any application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c), a copy of any oath or declaration filed by the inventor or legal representative who subsequently joined in such application must also accompany the copy of the executed oath or declaration.

Continuation or divisional applications filed under 37 CFR 1.53(b) prior to September 16, 2012, which contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 CFR 1.47 status in the prior application, should be forwarded by the Office of Patent Application Processing (OPAP) to the Office of Petitions before being forwarded to the Technology Center (TC). The Office of Petitions will mail applicant a letter stating that "Rule 47" status has been accorded to the continuation or divisional application, but will not repeat the notice to the nonsigning inventor nor the announcement in the *Official Gazette* . See 37 CFR 1.47(c).

It is important to note that if the filing date of the continuing application is on or after September 16, 2012, the oath or declaration must comply with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012, even though the continuing application may claim the benefit of an application filed before September 16, 2012. Specifically, the inventor's oath or declaration in the continuing application filed on or after September 16, 2012, must state that the inventor (1) is an original inventor of the claimed invention; and (2) authorized the filing of the patent application for the claimed invention. The inventor's oath or declaration also must contain an acknowledgement that any willful false statement made in such declaration is punishable under section 1001 of U.S. Code title 18 by fine or imprisonment of not more than 5 years, or both.

VII. CHANGE OF ATTORNEY/CORRESPONDENCE ADDRESS

For applications filed on or after September 16, 2012, 37 CFR 1.32(d) provides that a power of attorney from a prior national application for which benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in a continuing application may have effect in the continuing application if a copy of the power of attorney from the prior application is filed in the continuing application unless:

(1) The power of attorney was granted by the inventor; and

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(2) The continuing application names an inventor who was not named as an inventor in the prior application.

Filing a copy of the power of attorney in the continuing application in all situations (even where a change in power of attorney did not occur in the prior application) will make the record clear with respect to who has power of attorney. The Office recommends that the power of attorney should be from the assignee where one exists, but for applications filed on or after September 16, 2012, the power of attorney may only be signed by the applicant (see 37 CFR 1.42) or patent owner (for reissue applications).

With respect to the correspondence address for applications filed on or after September 16, 2012, 37 CFR 1.33(f) provides that where application papers from a prior application are used in a continuing application and the correspondence address was changed during the prosecution of the prior application, an application data sheet or separate paper identifying the correspondence address to be used for the continuing application must be submitted. Otherwise, the Office may not recognize the change of correspondence address effected during the prosecution of the prior application.

For applications filed prior to September 16, 2012, pre-AIA 37 CFR 1.63(d)(4) provides that 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 which occurred during the prosecution of the prior application.

VIII. SMALL ENTITY OR MICRO ENTITY STATUS

If small entity status has been established in a parent application and is still proper and desired in a continuation, continuation-in-part, or divisional application filed under 37 CFR 1.53(b), a new assertion as to the continued entitlement to small entity status under 37 CFR 1.27 is required. See MPEP § 509.03.

The refiling of an application under 37 CFR 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under 37 CFR 1.53(d) (design applications only)), requires a new certification of entitlement to micro entity status in the continuing application. See 37 CFR 1.29(e) and MPEP § 509.04.

IX. COPIES OF AFFIDAVITS

Affidavits or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the prior nonprovisional application do not automatically become a part of a continuation or divisional application filed under 37 CFR 1.53(b). Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make such remarks of record in the 37 CFR 1.53(b) application and include a copy of the original affidavit or declaration filed in the prior nonprovisional application.

Use form paragraph 2.03 for instructions to applicant concerning affidavits or declarations filed in the prior application.

¶ 2.03 Affidavits or Declarations in Prior Application

Applicant refers to an affidavit or declaration filed in the prior application. Affidavits or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132, filed during the prosecution of the prior application do not automatically become a part of this application. Where it is desired to rely on an earlier-filed affidavit or declaration, the applicant should make the remarks of record in this application and include a copy of the original affidavit or declaration filed in the prior application.

Examiner Note:

This form paragraph is to be used in applications filed under 37 CFR 1.53(b). Do not use this form paragraph in applications filed under 37 CFR 1.53(d) since affidavits and/or declarations, such as those submitted under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application automatically become a part of the 37 CFR 1.53(d) application.

X. EXTENSIONS OF TIME

If an extension of time is necessary to establish continuity between the prior application and the continuing application filed under 37 CFR 1.53(b),

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the petition for an extension of time must be filed as a separate paper directed to the prior nonprovisional application. Under 37 CFR 1.136(a)(3), an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time for its timely submission. A continuing application filed under 37 CFR 1.53(b) is a new application which is assigned a new application number and filing date and is maintained separately from the file of the prior application. The filing of a continuing application is not a paper directed to, or placed in, the file of the prior application and is not a "reply" to the last Office action in the prior application. Thus, a petition for an extension of time and the fee set forth in 37 CFR 1.17 are required to be filed as a separate paper in the prior application. Any petition for an extension of time directed to the prior application must be accompanied by its own certificate of mailing under 37 CFR 1.8 (if mailed by first class mail) or under 37 CFR 1.10 (if mailed by Priority Mail Express®), if the benefits of those rules are desired.

XI. ABANDONMENT OF THE PRIOR NONPROVISIONAL APPLICATION

Under 37 CFR 1.53(b) practice, the prior nonprovisional application is not automatically abandoned upon filing of the continuing application. If the prior nonprovisional application is to be expressly abandoned, such a paper must be signed in accordance with 37 CFR 1.138. A registered patent practitioner not of record acting in a representative capacity under 37 CFR 1.34 may also expressly abandon a prior nonprovisional application as of the filing date granted to a continuing application when filing such a continuing application.

If the prior nonprovisional application which is to be expressly abandoned has a notice of allowance issued therein, the prior nonprovisional application can become abandoned by the nonpayment of the issue fee. However, once an issue fee has been paid in the prior application, even if the payment occurs following the filing of a continuing application under 37 CFR 1.53(b), a petition to withdraw the prior nonprovisional application from issue must be filed before the prior nonprovisional application can be abandoned (37 CFR 1.313). See MPEP § 711.01.

If the prior nonprovisional application which is to be expressly abandoned is before the Patent Trial and Appeal Board (Board), a separate notice should be forwarded by the appellant to the Board, giving them notice thereof.

After a decision by the Court of Appeals for the Federal Circuit (CAFC) in which the rejection of all claims is affirmed, the proceeding is terminated when the mandate is issued by the Court.

XII. EXAMINATION

The practice relating to making first action rejections final also applies to continuation and divisional applications filed under 37 CFR 1.53(b). See MPEP § 706.07(b).

Any preliminary amendment that is present on the filing date of an application filed under 37 CFR 1.53(b) is part of the original disclosure. Amendments must be filed in compliance with the requirements of 37 CFR 1.121 (e.g., the amendment must include a complete claim listing whenever a claim is added, canceled, or amended). See MPEP § 714. The Office may require a substitute specification for preliminary amendments. See MPEP § 714.01(e). Applications should be classified and assigned to the proper Technology Center (TC) by taking into consideration the claims that will be before the examiner upon entry of such a preliminary amendment. Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require applicant to delete the benefit claim or redesignate the application as a continuation-in-part. See subsection III., above and MPEP § 211. See MPEP § 608.04(b) when new matter is contained in a preliminary amendment. If the filing date of the continuing application is on or after September 16, 2012, the inventor's oath or declaration must comply with the requirements of 35 U.S.C. 115 as revised

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effective September 16, 2012, even though the continuing application may claim the benefit of an application filed before September 16, 2012. Specifically, the inventor's oath or declaration in the continuing application filed on or after September 16, 2012, must state that the inventor (1) is an original inventor of the claimed invention; and (2) authorized the filing of the patent application for the claimed invention. The inventor's oath or declaration also must contain an acknowledgement that any willful false statement made in such declaration is punishable under section 1001 of U.S. Code title 18 by fine or imprisonment of not more than 5 years, or both.

If the examiner finds that pages of the specification or drawings figures described in the specification are missing and the application is a continuation or divisional application filed prior to September 21, 2004 under 37 CFR 1.53(b) using a copy of the oath or declaration filed in the prior application under pre-AIA 37 CFR 1.63(d), the examiner must check to determine whether the continuation or divisional application, as originally filed, includes a statement incorporating by reference the prior application(s). For applications filed prior to September 21, 2004, the statement could appear in the application transmittal letter (or the specification, rather than only in the specification). The inclusion of this incorporation by reference of the prior application(s) was necessary in these applications to permit applicant to amend the continuation or divisional application to include subject matter in the prior application(s) without the need for a petition. See also the subsection above regarding "Incorporation by Reference." If the continuation or divisional application filed prior to September 21, 2004 under 37 CFR 1.53(b) does not include the incorporation by reference statement in the application papers (in the specification or in the transmittal letter) as originally filed and applicant has not been informed of the omitted items, the application should be returned to OPAP for mailing of a "Notice of Omitted Item(s)." For applications filed on or after September 21, 2004, see 37 CFR 1.57(b) and MPEP § 217 .

201.06(d) 37 CFR 1.53(d) Continued Prosecution Application (CPA) Practice [R-08.2017]

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

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

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

(i) The application is for a design patent;

(ii) The prior nonprovisional application is a design application, but not an international design application, that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

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

(i) Must identify the prior application;

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

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

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

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

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

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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.

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

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(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

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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.

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I. CPA PRACTICE ELIMINATED AS TO UTILITY AND PLANT APPLICATIONS

Effective July 14, 2003, continued prosecution application (CPA) practice was eliminated as to utility and plant applications. Henceforth, applicants who wish to continue examination of the same claimed invention after the prosecution of a utility or plant application is closed should consider filing a request for continued examination (RCE) under 37 CFR 1.114. For more information on RCE practice, see MPEP § 706.07(h). Applicants who wish to file a continuation, divisional, or continuation-in-part application should file an application under 37 CFR 1.53(b). See MPEP § 201.06(c). CPAs filed prior to July 14, 2003, are processed and examined under the procedures set forth in prior 37 CFR 1.53(d). Any request for a CPA filed on or after July 14, 2003, in a utility or plant application is improper, regardless of the filing date of the utility or plant application in which the CPA is filed.

The Office will not convert an improper CPA into an application under 37 CFR 1.53(b) unless the applicant shows that there are extenuating circumstances that warrant the burdensome process of such conversion.

If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the Technology Center (TC) who will reprocess the CPA and correct the application records as appropriate.

A. Applications Filed on or After June 8, 1995

If a utility or plant application has a filing date on or after June 8, 1995, an improper CPA filed on or after July 14, 2003 is treated as a request for continued examination (RCE) under 37 CFR 1.114. See MPEP § 706.07(h) and form paragraph 7.42.15. If the improper CPA does not satisfy the requirements of 37 CFR 1.114 (e.g., the request lacks a submission or the fee under 37 CFR 1.17(e), or the prosecution of the application is not closed), the Office treats the improper CPA as an improper RCE, and the time period set in the last Office action (or notice) will continue to run. The Office will send the applicant a Notice of Improper Request for Continued Examination (RCE), PTO-2051. If the time period for reply to the last Office action (or notice) has expired, the application is abandoned and the applicant must file a petition under 37 CFR 1.137 and the required petition fee to revive the abandoned application. Unless prosecution in the application was not closed, the petition must be accompanied by a submission as defined by 37 CFR 1.114(c) and the fee set forth in 37 CFR 1.17(e), unless previously filed. If the last Office action is a notice of allowance, the issue fee must also be paid at the time of filing the petition to revive. If prosecution in the application was not closed, the petition must be accompanied by a reply to the non-final Office action.

Applicants cannot, as a matter of right, obtain continued examination on claims that are independent and distinct from the invention previously claimed (i.e., applicants cannot switch inventions when filing an RCE). See 37 CFR 1.145.

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Therefore, if applicants file a request for a divisional CPA on or after July 14, 2003 and the request satisfies all the requirements in 37 CFR 1.114 (e.g., the request is accompanied by the fee as set forth in 37 CFR 1.17(e) and a submission), the Office will treat the improper divisional CPA as a proper RCE. However, any amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention will be treated as nonresponsive. See MPEP § 821.03. Any newly submitted claims that are directed to an invention distinct from and independent of the invention previously claimed will be withdrawn from consideration. Applicants should be notified by using form paragraph 8.04 or 8.26.

B. Applications Filed Before June 8, 1995

If a utility or plant application has a filing date before June 8, 1995, the Office cannot treat an improper CPA filed on or after July 14, 2003 as an RCE because RCE practice does not apply to applications filed before June 8, 1995. The Office will notify the applicant of the improper CPA by mailing a notice of improper CPA. The time period for reply set in the last Office action (or notice) will continue to run. Applicant may file a continuing application under 37 CFR 1.53(b). If the time period for reply has expired, the application is abandoned. If the application in which the improper CPA is filed is abandoned when a continuing application is filed, applicant would need to file a petition under 37 CFR 1.137 to revive the prior application to establish copendency with the continuing application under 37 CFR 1.53(b).

II. FILING AND INITIAL PROCESSING OF CPAs FOR DESIGN APPLICATIONS

A. In General

In addition to the provisions of 37 CFR 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 CFR 1.53(d) if the prior application is a design application, but not an international design application, that is complete as defined by 37 CFR 1.51(b), except for the inventor's oath or declaration if the CPA is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) (i.e., an application data sheet indicating the name, residence, and mailing address of each inventor). A continuation or divisional application filed under 37 CFR 1.53(d) is called a "Continued Prosecution Application" (CPA). A CPA has a number of advantages compared to a continuation or divisional application filed under 37 CFR 1.53(b). For example, the papers required to be filed in the U.S. Patent and Trademark Office in order to secure a filing date under 37 CFR 1.53(d) are minimal compared to 37 CFR 1.53(b). In addition, the Office will not normally issue a new filing receipt for a CPA. See 37 CFR 1.54(b). The time delay between the filing date and the first Office action should be less for a CPA than for an application filed under 37 CFR 1.53(b). For examination priority purposes only, the USPTO will treat continuation CPAs as if they were "amended" applications (as of the CPA filing date) and not as "new" applications. This treatment is limited to CPAs in which the prior application has an Office action issued by the examiner. If no Office action has been issued in the prior application, the CPA will be treated, for examination purposes, like a "new" application unless a petition to make special under 37 CFR 1.102 or a request for expedited examination under 37 CFR 1.155 is filed in the CPA. As "amended" applications generally have a shorter time frame for being acted on by examiners than "new" applications, the treatment of a CPA as an "amended" application will result in a first Office action being mailed in the CPA much sooner than if it had been filed as a continuation application under 37 CFR 1.53(b) (or under former 37 CFR 1.60 or 1.62). Therefore, applicants are strongly encouraged to file any preliminary amendment in a CPA at the time the CPA is filed. See 37 CFR 1.115 and MPEP § 714.03(a).

A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 CFR 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 CFR 1.53(b). If applicant wants the USPTO to disregard a previously filed request for a CPA filed in a design application (and not recognize its inherent request to expressly abandon the prior application) and to treat the paper as the filing of an

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application under 37 CFR 1.53(b), the applicant must file a petition under 37 CFR 1.182. A request to expressly abandon an application is not effective until the abandonment is acknowledged, including the express abandonment of the prior application of a CPA that occurs by operation of 37 CFR 1.53(d)(2)(v). The express abandonment of the prior application is acknowledged and becomes effective upon processing and entry of the CPA into the file of the prior application. Thus, such a petition under 37 CFR 1.182 should be filed expeditiously since the petition will not be granted once the request for a CPA has been entered into the prior application (and the inherent request to expressly abandon the prior application has been acknowledged). If the request for a CPA has been entered into the prior application by the time the petition under 37 CFR 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied. It is noted, however, that if the applicant intended to file a second application (either a continuation or a divisional) without abandoning the prior application, applicant can still achieve that result without loss of the benefit of the original filing date by: (A) continuing the prosecution of the original application via the CPA; and (B) filing a new continuation/divisional under 37 CFR 1.53(b) claiming benefit of the CPA and its parent applications under 35 U.S.C. 120 during the pendency of the CPA.

Since no new matter may be introduced in a CPA, the procedure set forth in 37 CFR 1.53(d) is not available for filing a continuation-in-part application. All continuation-in-part applications must be filed under 37 CFR 1.53(b) and a newly executed oath or declaration is required.

Under the CPA procedure, the continuation or divisional application will utilize the file wrapper and contents of the prior nonprovisional application, including the specification, drawings and oath or declaration from the prior nonprovisional application, and will be assigned the same application number as the prior nonprovisional application. Any changes to the continuation or divisional application desired when filing the CPA must be made in the form of an amendment to the prior application as it existed prior to filing the CPA, see 37 CFR 1.53(d)(5). Any new specification filed with the CPA request will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with 37 CFR 1.125. However, the applicant must comply with the requirements of 37 CFR 1.125(b) before the substitute specification will be entered into the CPA. Since 37 CFR 1.125(b) requires that a substitute specification be accompanied by, inter alia, a statement that the substitute specification includes no new matter, any substitute specification containing new matter will be denied entry by the examiner. Any preliminary amendment to the written description and claims, other than a substitute specification, filed with a CPA request will ordinarily be entered. Any new matter which is entered, however, will be required to be canceled pursuant to 35 U.S.C. 132 from the descriptive portion of the specification. Further, any claim(s) which relies upon such new matter for support will be rejected under 35 U.S.C. 112(a). See MPEP § 2163.06. In the event that a substitute specification or preliminary amendment containing new matter was filed with a request for a CPA, applicant may file a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the request for a CPA and substitute specification/preliminary amendment were filed. Of course, a request for a CPA is not improper simply because the request is accompanied by a substitute specification or preliminary amendment containing new matter. Thus, an applicant will not be entitled to a refund of the filing fee paid in a proper CPA as a result of the granting of a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file.

A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 CFR 1.51(b) (except for the inventor's oath or declaration if the prior CPA contained an application data sheet indicating the name, residence, and mailing address of each inventor) and is a design application. There is no other limit to the number of CPAs that may be filed in a chain of continuing applications. However, only

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one CPA may be pending at one time based on the same prior nonprovisional application.

Under 37 CFR 1.53(d), the specification, claims, and drawings, and any amendments entered in the prior nonprovisional application are used in the CPA. A new basic filing fee, search fee, and examination fee are required in accordance with 35 U.S.C. 41 and 37 CFR 1.16. No search and examination fees are required for a CPA filed before December 8, 2004. The only other statutory requirement under 35 U.S.C. 111(a) is a signed oath or declaration. Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under the statute and rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration (if any) will be considered to be the oath or declaration of the CPA. However, for continuing applications (including CPAs) filed on or after September 16, 2012, the oath or declaration must comply with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012.

The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter.

If application papers for a design application are in any way designated as a CPA filing under 37 CFR 1.53(d) (e.g., contain a reference to 37 CFR 1.53(d), CPA, or continued prosecution application), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even if the application papers also contain other inconsistent designations (e.g., if the papers are also designated as an application filed under 37 CFR 1.53(b) or include a reference to a "continuation-in-part CPA"). If application papers for a utility or plant application are in any way designated as a CPA filing under 37 CFR 1.53(d), the application papers will be treated as a request for continued examination (RCE) under 37 CFR 1.114. See subsection I., above.

B. Conditions for Filing a CPA

A continuation or divisional application may be filed under 37 CFR 1.53(d), if the prior nonprovisional application is a design application, but not an international design application, that is complete as defined by 37 CFR 1.51(b). The term "prior nonprovisional application" in 37 CFR 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 CFR 1.51(b) must contain, inter alia, the appropriate filing fee (including the basic filing fee, search fee, and examination fee) and a signed oath or declaration under 37 CFR 1.63(d). If the CPA is filed on or after September 16, 2012, the inventor's oath or declaration is not required to have been filed in the prior application if the prior application contains an application data sheet indicating the name, residence, and mailing address of each inventor. The inventor's oath or declaration must be submitted no later than payment of the issue fee.

In addition, a continuation or divisional 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.

Note that request for continued examination (RCE) practice under 37 CFR 1.114 is not available in design applications. Any improper RCE filed in a design application will not be treated as a CPA. An improper RCE filed in a design application will not toll the running of any time period for reply.

C. Initial Processing

A CPA request will be initially processed by the TC assigned the prior application. The TC will verify that (A) the prior application is a design application, but not an international design application, (B) the correct application number of the prior nonprovisional application is identified in the request, (C) the request is properly signed, (D) the prior nonprovisional application was pending on,

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and that the issue fee has not been paid in the prior nonprovisional application on or prior to, the filing date of the CPA request, (E) the prior nonprovisional application was complete under 37 CFR 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under 37 CFR 1.63 has been filed in the prior application), except for the inventor's oath or declaration if the CPA is filed on or after September 16, 2012, and the prior application contains an application data sheet indicating the name, residence, and mailing address of each inventor, and (F) the proper filing fee has been paid in the CPA. If one or more other conditions for filing a CPA have not been satisfied or the proper basic filing fee, search fee, and examination fee have not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper fees have been submitted. See 37 CFR 1.53(h). If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the TC who will reprocess the CPA and correct the application records.

D. Incorrect Patent Application Number Identified

A request for a CPA must identify the prior nonprovisional application (37 CFR 1.53(d)(2)(i)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the TC should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the TC is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the TC to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the U.S. Patent and Trademark Office with the correct application number within two weeks of the mail date on the cover letter, the original date of receipt of the CPA request will be considered by the U.S. Patent and Trademark Office as the date of receipt of the CPA request. See 37 CFR 1.5(a). A copy of the returned CPA request and a copy of the date-stamped cover letter should be retained by the TC. Applicants may use either the Certificate of Mailing or Transmission procedure under 37 CFR 1.8 or the Priority Mail Express® procedure under 37 CFR 1.10 for resubmissions of returned CPA requests if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned CPA request is not resubmitted within the two-week period with the correct application number, the TC should cancel the original "Office Date" stamp on the CPA request and re-stamp the returned CPA request with the date of receipt of the resubmission or with the date of deposit as Priority Mail Express® with the United States Postal Service, if the CPA request is resubmitted under 37 CFR 1.10. Where the CPA request is resubmitted later than two weeks after the return mailing by the U.S. Patent and Trademark Office, the later date of receipt or date of deposit as Priority Mail Express® of the resubmission will be considered to be the filing date of the CPA request. The two-week period to resubmit the returned CPA request is not extendible. See 37 CFR 1.5(a).

In addition to identifying the application number of the prior application, applicant is urged to furnish in the request for a CPA the following information relating to the prior application to the best of applicant's ability: (A) title of invention; (B) name of applicant(s); and (C) correspondence address. See 37 CFR 1.53(d)(8).

E. Signature Requirement

A CPA is a request to expressly abandon the prior application (37 CFR 1.53(d)(2)(v)) and, therefore, must be properly signed. For a listing of the individuals who may properly sign a CPA request, see 37 CFR 1.33(b). A CPA request filed on or after September 16, 2012, must be signed by:

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(1) A patent practitioner of record appointed in compliance with 37 CFR 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34; or

(3) The applicant (37 CFR 1.42). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

A CPA request filed prior to September 16, 2012, must be signed by

(1) A patent practitioner of record appointed in compliance with 37 CFR 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34;

(3) An assignee as provided for under 37 CFR 3.71(b); or

(4) 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.

In a joint application with no attorney or agent, all applicants must sign the CPA request in order for the CPA request to be considered properly signed. An unsigned or improperly signed CPA request will be placed in the file of the prior application, and is entitled to an application filing date, but is ineffective to abandon the prior application. A CPA will NOT be examined until the CPA request is properly signed.

A request for a CPA may be signed by a registered practitioner acting in a representative capacity under 37 CFR 1.34. However, correspondence concerning the CPA will be sent by the Office to the correspondence address as it appears in the prior nonprovisional application until a new power of attorney, or change of correspondence address signed by an attorney or agent of record in the prior application, is filed in the CPA.

A request for a CPA filed prior to September 16, 2012 may also be signed by the assignee or assignees of the entire interest. However, the request must be accompanied by papers establishing the assignee's ownership under pre-AIA 37 CFR 3.73(b), unless such papers were filed in the prior application and ownership has not changed.

F. Filing Date

The filing date of a CPA is the date on which a request for a CPA on a separate paper for a CPA is filed. A request for a CPA cannot be submitted as a part of papers filed for another purpose, see 37 CFR 1.53(d)(2), (e.g., the filing of a request for a CPA within an amendment after final for the prior application is an improper request for a CPA).

A paper requesting a CPA may be filed via EFS-Web. CPA requests are filed as follow-on documents, and may only be filed by registered e-filers. See MPEP § 502.05 for additional information regarding filing correspondence via EFS-Web. The date of receipt accorded to a CPA request submitted via EFS-Web is the date the complete request is received by the Office. See 37 CFR 1.6(a)(4).

A request for a CPA may also be sent to the U.S. Patent and Trademark Office by mail (see MPEP § 501), facsimile transmission (see MPEP § 502.01) or hand delivery to the USPTO Customer Service Window in Alexandria, VA 22314. The date of receipt accorded to a CPA request sent by facsimile transmission is the date the complete transmission is received by an Office facsimile unit, unless the transmission is completed on a Saturday, Sunday, or federal holiday within the District of Columbia. Correspondence for which transmission was completed on a Saturday, Sunday, or federal holiday within the District of Columbia, will be accorded a receipt date of the next succeeding day which is not a Saturday, Sunday, or federal holiday within the District of Columbia. See 37 CFR 1.6(a)(3).

Applicants filing a CPA by facsimile transmission may include a “Receipt for Facsimile Transmitted CPA” (PTO/SB/29A) containing a mailing address and identifying information (e.g., the prior application number, filing date, title, first named inventor) with the request for a CPA. The USPTO will: (A) separate the “Receipt for Facsimile Transmitted CPA” from the CPA request papers; (B) date-stamp the “Receipt for Facsimile

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Transmitted CPA"; (C) verify that the identifying information provided by the applicant on the "Receipt for Facsimile Transmitted CPA" is the same information provided on the accompanying request for a CPA; and (D) mail the "Receipt for Facsimile Transmitted CPA" to the mailing address provided on the "Receipt for Facsimile Transmitted CPA." The "Receipt for Facsimile Transmitted CPA" cannot be used to acknowledge receipt of any paper(s) other than the request for a CPA. A returned "Receipt for Facsimile Transmitted CPA" may be used as prima facie evidence that a request for a CPA containing the identifying information provided on the "Receipt for Facsimile Transmitted CPA" was filed by facsimile transmission on the date stamped thereon by the USPTO. As the USPTO will verify only the identifying information contained on the request for a CPA, and will not verify whether the CPA was accompanied by other papers (e.g., a preliminary amendment), the "Receipt for Facsimile Transmitted CPA" cannot be used as evidence that papers other than a CPA were filed by facsimile transmission in the USPTO. Likewise, applicant-created "receipts" for acknowledgment of facsimile transmitted papers (whether created for the acknowledgment of a CPA or other papers) cannot be used as evidence that papers were filed by facsimile in the USPTO. Applicants are cautioned not to include information on a "Receipt for Facsimile Transmitted CPA" that is intended for retention in the application file, as the USPTO does not plan on retaining a copy of such receipts in the file of the application.

If an applicant filing a CPA by facsimile does not include an authorization to charge the basic filing fee, search fee, and examination fee to a deposit account or to a credit card using PTO-2038 (See MPEP § 509), the application will be treated under 37 CFR 1.53(f) as having been filed without the appropriate fees (as fees cannot otherwise be transmitted by facsimile).

37 CFR 1.6(f) provides for the situation in which the Office has no evidence of receipt of a CPA transmitted to the Office by facsimile transmission. 37 CFR 1.6(f) requires that a showing thereunder include, inter alia, a copy of the sending unit's report confirming transmission of the application or evidence that came into being after the complete transmission of the application and within one business day of the complete transmission of the application.

The Certificate of Mailing Procedure under 37 CFR 1.8 does not apply to filing a request for a CPA, since the filing of such a request is considered to be a filing of national application papers for the purpose of obtaining an application filing date (37 CFR 1.8(a)(2)(i)(A)). Thus, if (A) the Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to reply and (B) a petition for a three-month extension of time (and the fee) and a CPA are received in the Office on January 5, 1998 (Monday), accompanied by a certificate of mailing under 37 CFR 1.8 dated January 2, 1998 (Friday), then the prior application was abandoned on January 3, 1998, and the CPA is improper because the CPA was not filed before the abandonment of the prior application. As a further example, if (A) the Office mails a final Office action on July 2, 1997 (Wednesday), with a shortened statutory period of 3 months to reply and (B) applicant submits a petition for a three-month extension of time (and the fee) and a CPA request via facsimile transmission accompanied by a certificate of transmission under 37 CFR 1.8 at 9:00 PM Pacific Time on January 2, 1998 (Friday), but the Office does not receive the complete transmission until 12:01 AM Eastern Time on January 3, 1998 (Saturday), then the CPA is improper because the CPA request was not filed until January 5, 1998, see 37 CFR 1.6(a)(3), which is after the abandonment (midnight on Friday, January 2, 1998) of the prior application.

G. Filing Fee

The filing fees for a CPA are the basic filing fee as set forth in 37 CFR 1.16(b), the search fee as set forth in 37 CFR 1.16(l), and the examination fee as set forth in 37 CFR 1.16(p). See 37 CFR 1.53(d)(3).

A general authorization to charge fees to a deposit account which was filed in the prior application carries over from the prior nonprovisional application to a CPA. Thus, where a general authorization to charge fees to a deposit account was filed in the prior application the Office should charge

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the necessary filing fee of the CPA to the deposit account.

Where a general authorization to charge fees to a deposit account was filed in the prior application and applicant desires to file a CPA without paying the filing fee on the filing date of the application, applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application.

Where a filing date has been assigned to a CPA, but the basic filing fee, search fee, and examination fee are insufficient or have been omitted, applicant will be so notified by the Office and given a period of time in which to file the missing fee(s) and to pay the surcharge set forth in 37 CFR 1.16(f) in order to prevent abandonment of the application. For CPAs 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(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 CPAs filed on or after July 1, 2005, which have been accorded a filing date under 37 CFR 1.53(d), if any of the basic filing fee, search fee, or examination fee are paid on a date later than the filing date of the CPA, the surcharge under 37 CFR 1.16(f) is required. For CPAs filed on or after September 16, 2012, if the prior application does not contain the inventor's oath or declaration, the surcharge under 37 CFR 1.16(f) is required (unless the inventor's oath or declaration is being filed with the CPA). The time period usually set is 2 months from the date of notification. This time period is subject to the provisions of 37 CFR 1.136(a). A CPA will not be placed upon the files for examination until all of its required parts, including the basic filing fee, search fee, examination fee, and any necessary surcharge, are received. See 37 CFR 1.53(h). Thus, it would be inappropriate to conduct an interview or to issue an action on the merits in the CPA until the basic filing fee, search fee, examination fee, and any necessary surcharge, are received.

H. Small Entity or Micro Entity Status

Small entity status established in the parent application does not automatically carry over to a CPA. Status as a small entity must be specifically established in every application in which the status is available and desired. 37 CFR 1.27(c)(4) provides that the refiling of an application as a continued prosecution application under 37 CFR 1.53(d) requires a new assertion of continued entitlement to small entity status. Similarly, pursuant to 37 CFR 1.29(e), the refiling of an application under 37 CFR 1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under § 1.53(d)) requires a new certification of entitlement to micro entity status for the continuing application. See also MPEP § 509.04.

Because small entity status and micro entity status do not automatically carry over from the prior application to the CPA, unless the request for a CPA specifically indicates that the filing fee is to be charged in the small entity or micro entity amount, or otherwise includes an assertion of entitlement to small entity or micro entity status, the regular undiscounted entity filing fee should be charged.

I. Extensions of Time

If an extension of time is necessary to establish continuity between the prior application and the CPA, the petition for extension of time should be filed as a separate paper directed to the prior nonprovisional application. However, a CPA is not improper simply because the request for a CPA is combined in a single paper with a petition for extension of time. The "separate paper" requirement of 37 CFR 1.53(d)(2) is intended to preclude an applicant from burying a request for a CPA in a paper submitted primarily for another purpose, e.g., within an amendment after final for the prior application.

While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application, a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (i.e., expressly abandon) the prior application. Thus, it will be considered a "reply" for purposes of 37 CFR 1.136(a)(3). As a result, an authorization in the prior application to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees to a deposit account or to a

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credit card (See MPEP § 509) will be treated as a constructive petition for an extension of time in the prior application for the purpose of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

If an extension of time directed to the prior application is filed as a separate paper, it must be accompanied by its own certificate of mailing under 37 CFR 1.8 (if mailed by first class mail) or under 37 CFR 1.10 (if mailed by Priority Mail Express®), if the benefits of those rules are desired.

J. Notice of CPA Filing

Since a "Notice of Abandonment" is not mailed in the prior application as a result of the filing of a CPA nor is a filing receipt normally mailed for a CPA, the examiner should advise the applicant that a request for a CPA has been granted by including form paragraph 2.30 in the first Office action of the CPA.

¶ 2.30 CPA Status Acceptable (for Design Applications)

The request filed on **[1]** for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. **[2]** is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this form paragraph in the first Office action of a CPA to advise the applicant that a request for a CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § 706.07(h).

2. In bracket 1 insert the filing date of the request for a CPA.

3. In bracket 2 insert the Application Number of the parent application.

A "conditional" request for a CPA will not be permitted. Any "conditional" request for a CPA submitted as a separate paper with an amendment after final in an application will be treated as an unconditional request for a CPA of the application. This will result (by operation of 37 CFR 1.53(d)(2)(v)) in the abandonment of the prior application, and (if so instructed in the request for a CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. The examiner should advise the applicant that a "conditional" request for a CPA has been treated as an unconditional request for a CPA and has been accepted by including form paragraph 2.35 in the first Office action of the CPA.

¶ 2.35 CPA Status Acceptable - Conditional Request (for Design Applications)

Receipt is acknowledged of the "conditional" request for a Continued Prosecution Application (CPA) filed on **[1]** under 37 CFR 1.53(d) based on prior Application No. **[2]**. Any "conditional" request for a CPA submitted as a separate paper is treated as an unconditional request for a CPA. Accordingly, the request for a CPA application is acceptable and a CPA has been established. An action on the CPA follows.

Examiner Note:

1. Use this form paragraph in the first Office action of a CPA to advise the applicant that a "conditional" request for a CPA is treated as an unconditional request and the CPA is acceptable and that a CPA has been established. This notice should be given, since applicant is not notified of the abandonment of the parent nor is a filing receipt normally sent for a CPA. If the request for a CPA in a utility or plant application is improper and the CPA has been treated as an RCE, do not use this form paragraph (use form paragraph 7.42.15 instead). See MPEP § 706.07(h).

2. In bracket 1 insert the filing date of the request for a CPA.

3. In bracket 2 insert the Application Number identified in the CPA request.

Where the examiner recognizes that a paper filed in the prior application contains a request for a CPA, but the request is not in a separate paper, the examiner should, if possible, contact applicant by telephone to notify applicant that the request for a CPA is ineffective or notify the applicant in the next Office action that the CPA request is ineffective by using form paragraph 2.31.

¶ 2.31 CPA Status Not Acceptable - Request Not on Separate Paper (for Design Applications)

Receipt is acknowledged of the request for a Continued Prosecution Application (CPA) filed on **[1]** under 37 CFR 1.53(d) based on Application No. **[2]**. However, because the request was not submitted on a separate paper as required by 37 CFR 1.53(d)(2) , the request is not acceptable and no CPA has been established.

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Examiner Note:

1. Use this form paragraph to inform applicant that a request for a CPA in a design application is not in compliance with 37 CFR 1.53(d)(2) and, therefore, no CPA has been established.

2. In bracket 1 insert the filing date of the paper containing the request for a CPA.

3. In bracket 2 insert the Application Number identified in the CPA request.

K. Inventorship

The inventive entity set forth in the prior nonprovisional application automatically carries over into the CPA UNLESS the request for a CPA is accompanied by or includes on filing 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 CPA. 37 CFR 1.53(d)(4).

The statement requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application must be signed by person(s) authorized pursuant to 37 CFR 1.33(b) to sign an amendment in the continuation or divisional application. For applications filed on or after September 16, 2012, the statement must be signed by:

(1) A patent practitioner of record appointed in compliance with 37 CFR 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34; or

(3) The applicant (37 CFR 1.42). Unless otherwise specified, all papers submitted on behalf of a juristic entity must be signed by a patent practitioner.

For applications filed prior to September 16, 2012, the statement must be signed by:

(1) A patent practitioner of record appointed in compliance with 37 CFR 1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of 37 CFR 1.34;

(3) An assignee as provided for under 37 CFR 3.71(b); or

(4) 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.

The examiner should acknowledge receipt of a statement filed with a CPA requesting the deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the CPA in the first Office action in the CPA by using form paragraph 2.32.

¶ 2.32 Request To Delete a Named Inventor in CPA (for Design Applications)

Receipt is acknowledged of the statement requesting that **[1]** be deleted as a named inventor which was filed with the Continued Prosecution Application (CPA) on **[2]**. The inventorship has been corrected as requested.

Examiner Note:

1. Use this form paragraph where a Continued Prosecution Application (CPA) is filed 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. Any request to delete a named inventor in a CPA filed after the CPA is filed must be accompanied by a request under 37 CFR 1.48.

2. In bracket 1 insert the name or names of the inventor(s) requested to be deleted.

3. In bracket 2 insert the filing date of the CPA.

After the first Office action is mailed, the application file should be sent to OPAP for revision of its records to reflect the change of inventorship. Any request by applicant for a corrected filing receipt to show the change in inventorship should not be submitted until after the examiner has acknowledged the change in inventorship in an Office action. Otherwise, the "corrected" filing receipt may not show the change in inventorship.

The inventive entity of the CPA will be the same as the inventive entity of the prior application even if the CPA papers include a transmittal letter or a new oath or declaration naming an inventor not named in the prior application. However, the new oath or declaration will be placed in the application file. Upon review of the application, the examiner will notify the applicant in the first Office action using form paragraph 2.33 that the inventive entity of the prior application has been carried over into the CPA. If the inventive entity set forth in the transmittal letter of the new oath or declaration is desired, then

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a request under 37 CFR 1.48 along with the required fee set forth in 37 CFR 1.17(i) must be filed. See MPEP § 602.01(c)(1) for requests under 37 CFR 1.48 filed on or after September 16, 2012. For requests filed before September 16, 2012, see MPEP § 602.01(c)(3). No new oath or declaration need be filed with the later-filed request under 37 CFR 1.48 if such was submitted on filing of the CPA. For continuing applications filed on or after September 16, 2012, the oath or declaration must comply with the requirements of 35 U.S.C. 115 as revised effective September 16, 2012 even though the application may claim the benefit of an application filed before September 16, 2012. Specifically, the inventor's oath or declaration in the continuing application filed on or after September 16, 2012, must state that the inventor (1) is an original inventor of the claimed invention; and (2) authorized the filing of the patent application for the claimed invention. The inventor's oath or declaration also must contain an acknowledgement that any willful false statement made in such declaration is punishable under section 1001 of U.S. Code title 18 by fine or imprisonment of not more than 5 years, or both. For the oath or declaration requirements in applications filed prior to September 16, 2012 see MPEP § 602.01(b).

If a request under 37 CFR 1.48 is not filed, it should be noted that the filing in a CPA of a transmittal letter or a new oath or declaration containing an inventor not named in the prior nonprovisional application may result in the claims in the CPA being rejected under pre-AIA 35 U.S.C. 102(f).

¶ 2.33 New Inventor Identified in CPA (for Design Applications)

It is noted that **[1]** identified as a named inventor in the Continued Prosecution Application (CPA) filed under 37 CFR 1.53(d) on **[2]**, but no request under 37 CFR 1.48, as is required, was filed to correct the inventorship. Any request to add an inventor must be in the form of a request under 37 CFR 1.48. Otherwise, the inventorship in the CPA shall be the same as in the prior application.

Examiner Note:

1. Use this form paragraph where a request for a Continued Prosecution Application (CPA) identifies one or more inventors who were not named as inventors in the prior application on the filing date of the CPA.

2. In bracket 1 insert the name or names of the inventor(s) requested to be added followed by either --was-- or --were--, as appropriate.

3. In bracket 2 insert the filing date of the CPA.

III. EXAMINATION OF CPAs

A. Benefit of Earlier Filing Date

A request for a CPA is a specific reference under 35 U.S.C. 120 to every application assigned the application number identified in the request, and 37 CFR 1.78(d)(4) provides that a request for a CPA is the specific reference under 35 U.S.C. 120 to the prior application. That is, the CPA includes the request for an application under 37 CFR 1.53(d) and the recitation of the application number of the prior application in such request is the "specific reference to the earlier filed application" required by 35 U.S.C. 120. No further amendment to the specification of the CPA nor a reference in the CPA's application data sheet is required by 35 U.S.C. 120 or 37 CFR 1.78(d) to identify or reference the prior application, as well as any other application assigned the application number of the prior application (e.g., in instances in which a CPA is the last in a chain of CPAs).

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See *Sampson v. Ampex Corp.,* 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.,* 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); *Hovlid v. Asari,* 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 211 et seq. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application.

In the situation in which there is a chain of CPAs, each CPA in the chain will, by operation of 37 CFR 1.53(d)(7), contain the required specific reference to its immediate prior application, as well as every other application assigned the application number identified in such request. Put simply, a specific reference to a CPA by application number and filing date will constitute a specific reference to: (A) the non-continued prosecution application originally assigned such application number (the prior application as to the first CPA in the chain); and (B)

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every CPA assigned the application number of such non-continued prosecution application.

Where the non-continued prosecution application originally assigned such application number itself claims the benefit of a prior application or applications under 120, 121, or 386(c), 37 CFR 1.78(d)(2) continues to require that the non-continued prosecution application originally assigned such application number contain a reference to any such prior application(s). As a CPA uses the application file of the prior application, a specific reference in the prior application (as to the CPA) will constitute a specific reference in the CPA, as well as every CPA in the event that there is a chain of CPAs.

Where an applicant in an application filed under 37 CFR 1.53(b) seeks to claim the benefit of a CPA under 35 U.S.C. 120 or 121 (as a continuation, divisional, or continuation-in-part), 37 CFR 1.78(d)(2) requires a reference to the CPA by application number in an application data sheet or, for applications filed before September 16, 2012, in the first sentence of the specification. 37 CFR 1.78(d)(4) provides that "[t]he identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number." Thus, where a referenced CPA is in a chain of CPAs, this reference will constitute a reference under 35 U.S.C. 120 and 37 CFR 1.78(d)(4) to every CPA in the chain as well as the non-continued prosecution application originally assigned such application number.

Therefore, regardless of whether an application is filed under 37 CFR 1.53(b) or (d), a claim under 35 U.S.C. 120 to the benefit of a CPA is, by operation of 37 CFR 1.53(d)(7) and 37 CFR 1.78(d)(4), a claim to every application assigned the application number of such CPA. In addition, applicants will not be permitted to delete such a benefit claim as to certain applications assigned that application number (e.g., for patent term purposes). See 37 CFR 1.53(d)(7).

Further, an applicant in a CPA is not permitted to amend the first sentence(s) of the specification to provide the specific reference to the prior application, or to provide such a reference in an application data sheet. Any such amendment will not be entered. The applicant should be advised in the next Office action that any such amendment to the specification or reference in the application data sheet has not been entered by using form paragraph 2.34.

¶ 2.34 Reference in CPA to Prior Application (by Amendment to the Specification; for Design Applications)

The amendment filed **[1]** requesting that the specification be amended to refer to the present Continued Prosecution Application (CPA) as a **[2]** application of Application No. **[3]** has not been entered. As set forth in 37 CFR 1.53(d)(7), a request for a CPA is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. Thus, there is no need to amend the first sentence(s) of the specification to refer back to the prior application and any such amendment shall be denied entry.

Examiner Note:

1. Use this form paragraph to inform the applicant that an amendment to the first sentence(s) of the specification referring to the CPA as a continuing application of the prior application has not been entered and will not be entered if submitted again.

2. In bracket 1, insert the filing date of the amendment.

3. In bracket 2, insert either --continuation-- or --divisional--.

4. In bracket 3, insert the Application Number of the prior nonprovisional application.

Priority claims under 35 U.S.C. 119(a)-(d) made in a parent application will automatically carry over to a CPA.

B. Terminal Disclaimer

A terminal disclaimer filed in the parent application carries over to a CPA. The terminal disclaimer filed in the parent application carries over because the CPA retains the same application number as the parent application, i.e., the application number to which the previously filed terminal disclaimer is directed. If applicant does not want the terminal disclaimer to carry over to the CPA, applicant must file a petition under 37 CFR 1.182 along with the required petition fee, requesting the terminal disclaimer filed in the parent application not be carried over to the CPA. See MPEP § 1490, "Withdrawing a Recorded Terminal Disclaimer," subheading entitled "A. Before Issuance of Patent."

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C. Prior Election

An election in reply to a restriction requirement made in the prior application carries over to the CPA only if all of the following conditions are met: (A) the CPA is designated as a continuation or is not designated at all (i.e., the CPA is NOT designated as a divisional); (B) there was an express election by the applicant in reply to a restriction requirement in the prior application; (C) the CPA presents claim(s) drawn only to invention(s) claimed in the prior application; and (D) the CPA does not contain an indication that a shift in election is desired.

Where all of the conditions are met, the examiner's first action should repeat the restriction requirement made in the prior application to the extent it is still applicable in the CPA and include a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application.

D. Information Disclosure Statements and Preliminary Amendments

All information disclosure statements filed in the prior application that comply with the content requirements of 37 CFR 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.

In addition, all information disclosure statements that comply with the content requirements of 37 CFR 1.98 and are filed before the mailing of a first Office action on the merits will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution. Therefore, applicants are encouraged to file any information disclosure statement in a CPA as early as possible, preferably at the time of filing the CPA. For further discussion of information disclosure statements, see MPEP § 609.

Applicants are also encouraged to file all preliminary amendments at the time of filing a CPA because the entry of any preliminary amendment filed after the filing date of the CPA could be denied under 37 CFR 1.115 if the preliminary amendment unduly interferes with the preparation of a first Office action. See MPEP § 714.03(a). In a situation where the applicant needs more time to prepare a preliminary amendment or to file an information disclosure statement, applicant can request a three-month suspension of action under 37 CFR 1.103(b). The three-month suspension of action under 37 CFR 1.103(b) must be filed at the time of filing a CPA. See MPEP § 709.

E. Copies of Affidavits

Affidavits and declarations, such as those under 37 CFR 1.130, 1.131 and 1.132 filed during the prosecution of the parent nonprovisional application, automatically become a part of the CPA. Therefore, no copy of the original affidavit or declaration filed in the parent nonprovisional application need be filed in the CPA.

IV. PUBLIC ACCESS TO CPAs

A. Waiver of Confidentiality

A CPA is 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 37 CFR 1.14 to obtain access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of 37 CFR 1.53(d) may be given similar access to, copies of, or similar information concerning, the other application(s) in the application file. 37 CFR 1.53(d)(6).

B. Certified Copy

A certified copy of a CPA will be prepared by the Certification Branch upon request. The certified copy will consist of a copy of the most recent non-continued prosecution application in the chain of CPAs. The filing date of the CPA will be shown in the certified copy as the filing date of the most recent non-continued prosecution application in the chain of CPAs.

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V. FORMS

Form PTO/SB/29, "For Design Applications Only: Continued Prosecution Application (CPA) Request Transmittal," may be used by applicant for filing a CPA under 37 CFR 1.53(d). The form is available on the Office website at **www.uspto.gov/patent/patents-forms**.

201.07 Continuation Application [R-08.2017]

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

*****

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

*****

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

*****

A continuation application is an application for the invention(s) disclosed in a prior- filed copending nonprovisional application, international application designating the United States, or international design application designating the United States. The disclosure presented in the continuation must not include any subject matter which would constitute new matter if submitted as an amendment to the parent application.

The continuation application may be filed under 37 CFR 1.53(b) (or 1.53(d) if the application is a design application, but not an international design application). The inventorship in the continuation application must include at least one inventor named in the prior-filed application, and the continuation application must also claim the benefit of the prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c). See 37 CFR 1.78, especially paragraphs (d) and (e), and MPEP § 211 *et seq.* for additional requirements and more information regarding entitlement to the benefit of the filing date of a prior-filed copending application.

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "divisional" of the provisional application. See 37 CFR 1.78, especially paragraphs (a)-(c), and MPEP § 211 *et seq.* for requirements and information pertaining to entitlement to the benefit of the filing date of a provisional application.

At any time before the patenting, abandonment, or termination of proceedings on an earlier application, an applicant may have recourse to filing a continuation application under 37 CFR 1.53(b) in order to introduce into the application a new set of claims and to establish a right to further examination by the Office. A continued prosecution application (CPA) under 37 CFR 1.53(d) (available only for design applications, but not international design applications), however, must be filed prior to payment of the issue fee unless a petition under 37 CFR 1.313(c) is granted in the prior application. In addition, a continuation or divisional application may only be filed under 37 CFR 1.53(d) if the prior application is a nonprovisional design application, but not an international design application, that is complete as defined by 37 CFR 1.51(b) (except for the inventor's oath or declaration if the CPA is filed on or after September 16, 2012), and the prior nonprovisional application contains an application data sheet indicating the name, residence, and mailing address of each inventor. Use form paragraph 2.05 to remind applicant of possible continuation status.

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¶ 2.05 Possible Status as Continuation

This application discloses and claims only subject matter disclosed in prior Application No. **[1]**, filed **[2]**, and names the inventor or at least one joint inventor named in the prior application. Accordingly, this application may constitute a continuation or divisional. Should applicant desire to claim the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120, 37 CFR 1.78, and MPEP § 211 *et seq*.

Examiner Note:

1. In brackets 1 and 2, insert the application number (series code and serial number) and filing date of the prior application, respectively.

2. This form paragraph should only be used if it appears that the application may be a continuation, but a benefit claim has not been properly established.

3. An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation" of the provisional application.

201.08 Continuation-in-Part Application [R-08.2017]

37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

*****

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

*****

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

*****

A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the earlier nonprovisional application. A continuation-in-part application may only be filed under 37 CFR 1.53(b). The continuation-in-part application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120, 121, 365(c), or 386(c). For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 211 et seq. A continuation-in-part application CANNOT be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a “continuation-in-part” of the provisional application because an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

The mere filing of a continuation-in-part application does not itself create a presumption that the applicant acquiesces in any rejections which may be outstanding in the copending national nonprovisional application or applications upon which the continuation-in-part application relies for benefit.

A continuation-in-part application that has a sole inventor may also derive from an earlier application that has joint inventors and discloses only a portion of the subject matter of the later application, subject to the conditions set forth in 35 U.S.C. 120 and 37 CFR 1.78. Subject to the same conditions, a continuation-in-part application that has joint inventors may derive from an earlier application that has a sole inventor.

The Office does not need to make a determination as to whether the requirement of 35 U.S.C. 120 that the earlier nonprovisional application discloses the invention of the second application in the manner

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provided by 35 U.S.C. 112(a) is met unless the filing date of the earlier nonprovisional application is relied upon in a proceeding before the Office. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the other requirements of 35 U.S.C. 120 and 37 CFR 1.78, such as:

(A) The first application and the alleged continuation-in-part application were filed with the same inventor or at least one common joint inventor;

(B) The alleged continuation-in-part application was "filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application"; and

(C) The alleged continuation-in-part application "contains or is amended to contain a specific reference to the earlier filed application." (For applications filed on or after September 16, 2012, the specific reference must be included in an application data sheet. For applications filed prior to September 16, 2012, the specific reference must be submitted either in the first sentence(s) of the specification or in an application data sheet (see 37 CFR 1.76(b)(5)).)

See MPEP § 211 et seq. for more information on claiming the benefit of a prior nonprovisional application.

For notation to be put in the file history by the examiner in the case of a continuation-in-part application see MPEP § 202. See MPEP § 708 for order of examination.

Use form paragraph 2.06 to remind applicant of possible continuation-in-part status.

¶ 2.06 Possible Status as Continuation-in-Part

This application repeats a substantial portion of prior Application No. **[1]**, filed **[2]**, and adds disclosure not presented in the prior application. Because this application names the inventor or at least one joint inventor named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to claim the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120, 37 CFR 1.78, and MPEP § 211 *et seq* .

Examiner Note:

1. In brackets 1 and 2, insert the application number (series code and serial number) and filing date of the prior application, respectively.

2. This form paragraph should only be used if it appears that the application may qualify as a continuation-in-part, but no benefit claim has been properly established.

3. An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application.

202 Cross-Noting [R-08.2017]

I. NOTATION IN FILE HISTORY REGARDING PRIOR U.S. APPLICATIONS, INCLUDING PROVISIONAL APPLICATIONS

The front page of a printed patent identifies all prior applications for which benefits are claimed under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) in continuation-in-part, continuation, divisional, and reissue applications. Therefore, the identifying data of all prior applications for which benefits are claimed should be reviewed by the examiner to ensure that the data is accurate and provided in an application data sheet for applications filed on or after September 16, 2012, or provided in either the first sentence(s) of the specification or in an application data sheet for applications filed prior to September 16, 2012. See 37 CFR 1.78(a)(3) and (d)(2) and MPEP § 211 et seq. For example, the reference to a prior nonprovisional application must include the appropriate relationship (e.g., continuation, divisional, or continuation-in-part) between the nonprovisional applications.

The front page of a printed patent issuing on a continued prosecution application (CPA) filed under 37 CFR 1.53(d) will identify the application number and filing date of the most recent noncontinued prosecution application (but not the filing date of the CPA) as well as all prior applications from which benefit was claimed in the most recent noncontinued prosecution application.

Where prior application data, including provisional application data, is preprinted on the PALM bib-data sheet, the examiner should check that data for accuracy, including whether the application is, in fact, copending with the prior nonprovisional application or applications for which benefit is

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claimed. Similarly, the application number of any provisional application for which benefit is claimed should be printed on the PALM bib-data sheet. If applicant claims benefit under 35 U.S.C. 119(e) to a prior provisional application, and states that the provisional application claims the benefit of, or priority to, earlier domestic or foreign application(s), the earlier application(s) should not be reflected on the PALM bib-data sheet because a provisional application is not entitled to the benefit of, or right of priority to, of any other application. See 35 U.S.C. 111(b)(7).

Where the data is correct, the examiner should initial the PALM bib-data sheet in the provided space. Should there be an error in the preprinted prior application data, the correction or entry of the data in the PALM data base can be made by technical support staff of the Technology Center, if appropriate. Upon entry of the data, a new PALM bib-data sheet should be printed and scanned into the file. If the error was an applicant error, the examiner should require correction via a corrected or supplemental application data sheet or an amendment, as appropriate. See MPEP § 601.05 et seq. and MPEP § 211.02(a). A petition for an unintentionally delayed benefit claim may also be required. See MPEP § 211.04.

The inclusion of prior application information in the patent does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date. See MPEP § 2136.03 and MPEP § 2154.01(b) for additional information. See MPEP § 306 for information pertaining to the assignment of applications claiming a benefit under 35 U.S.C. 119(e) or 120 to the filing date of an earlier filed application. In the situation in which there has been no reference to a prior application because the benefit of its filing date is not desired, no notation as to the prior application is made on the PALM bib-data sheet.

II. NOTATION IN FILE HISTORY REGARDING FOREIGN PRIORITY APPLICATION

If a foreign application listed on the oath or declaration (for applications filed prior to September 16, 2012) or application data sheet is not listed on the PALM bib-data sheet, the examiner should provide the information regarding the foreign application number, the country, and the filing date on the PALM bib-data sheet and forward the marked-up PALM bib-data sheet to the Legal Instrument Examiner for correction in the Office computer systems. Applications listed on the PALM bib-data sheet but filed in countries not qualifying for benefits under 35 U.S.C. 119(a)-(d) should be lined through. A listing of countries qualifying for benefits under 35 U.S.C. 119(a)-(d) appears at MPEP § 213.01.

Where foreign applications are listed on the pre-AIA 37 CFR 1.63 oath or declaration (for applications filed prior to September 16, 2012) or application data sheet, the examiner should check that such foreign applications are properly listed on the PALM bib-data sheet. A PALM bib-data sheet should include the application number, country (or intellectual property authority), day, month, and year of each foreign application that the U.S. application is claiming the priority of. The examiner should check this information for accuracy. Should there be an error on the oath or declaration, or application data sheet itself, the examiner should require a new oath or declaration, or application data sheet, where appropriate. A petition for an unintentionally delayed claim for priority may also be required. See MPEP § 214.02. If the oath or declaration or the application data sheet is accurate, but there is an error on the PALM bib-data sheet, the examiner should make the appropriate corrections directly on the PALM bib-data sheet, and have the information corrected in the Office computer systems by forwarding the information to the examiner's Legal Instrument Examiner, with an explanation of the correction to be made. The examiner should initial the PALM bib-data sheet in the "VERIFIED" space provided when the information is correct or has been amended to be correct. However, the examiner must still indicate in the Office action and on the PALM bib-data sheet whether the conditions of 35 U.S.C. 119(a)-(d) or (f) have been met.

If the filing dates of several foreign applications are claimed and the certified copy of each foreign application has been received, information regarding each of the foreign applications is to be entered on the PALM bib-data sheet.

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The front page of the patent when it is issued, and the listing in the Official Gazette, will refer to the claim of priority, giving the country, the filing date, and the number of the foreign application in those applications in which the PALM bib-data sheet has been endorsed.

203 Status of Applications [R-11.2013]

203.01 New [R-11.2013]

A "new" application is a nonprovisional application that has not yet received an action by the examiner. An amendment filed prior to the first Office Action does not alter the status of a "new" application. Note that a request for continued examination (RCE)(see 37 CFR 1.114) is not a type of new application filing. See MPEP § 706.07(h).

203.02 Rejected [R-08.2012]

A nonprovisional application which, during its prosecution in the examining group and before allowance, contains an unanswered examiner's action is designated as a "rejected" application. Its status as a "rejected" application continues as such until acted upon by the applicant in reply to the examiner's action (within the allotted reply period), or until it becomes abandoned.

203.03 Amended [R-08.2012]

An "amended" nonprovisional application is one that having been acted on by the examiner, has in turn been acted on by the applicant in reply to the examiner's action. The applicant's reply may be confined to an election, a traverse of the action taken by the examiner or may include an amendment of the application.

203.04 Allowed or in Issue [R-07.2015]

An "allowed" nonprovisional application or an application "in issue" is one which has been examined and determined to meet all statutory requirements, and in which a notice of allowance has been sent to the applicant. Its status as an "allowed" application continues from the date of the notice of allowance until it issues as a patent, unless it is withdrawn from issue (37 CFR 1.313), or becomes abandoned for failure to pay the issue fee and any required publication fee (37 CFR 1.314 and 1.316).

203.05 Abandoned [R-11.2013]

An abandoned application is, inter alia, one which is removed from the Office docket of pending applications:

(A) through formal abandonment by the applicant or by the attorney or agent of record;

(B) through failure of applicant to take appropriate action at some stage in the prosecution of a nonprovisional application;

(C) for failure to pay the issue fee (MPEP § 711 to § 711.05); or

(D) in the case of a provisional application, no later than 12 months after the filing date of the provisional application (see MPEP § 711.03(c) and 35 U.S.C. 111(b)(5)).

203.06 Incomplete [R-08.2012]

An application that is not entitled to a filing date (e.g., for lacking some of the essential parts) is termed an incomplete application. (MPEP § 506 and § 601.01(d)-(g)).

203.07 [Reserved]

203.08 Status Inquiries [R-08.2017]

I. IN GENERAL

Status information relating to patent applications is available through the Patent Application Information Retrieval (PAIR) system. There is both a public and private interface to PAIR. In public PAIR, information is available relating to issued patents, published patent applications, and applications to which a patented or published application claims domestic benefit. In private PAIR, an applicant (or applicant's registered patent attorney or registered patent agent) can securely track the progress of applicant's application(s) through the USPTO.

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Private PAIR makes available information relating to unpublished patent applications, but the applicant must associate a Customer Number with the application to obtain access. See MPEP § 403 for Customer Number practice.

Applicants and other persons seeking status information regarding an application should check the PAIR system on the Office website at **www.uspto.gov/patents-application-process/checking-application-status/check-filing-status-your-patent-application**. Alternatively, the requester may contact the Application Assistance Unit (AAU) (see MPEP § 1730, subsection VI.C.). The AAU will check the relevant Office records and will inform the requester whether the application has been published or has issued as a patent. If the application has been published, the AAU will inform the requester of the publication number and publication date, and if the application has issued as a patent, the AAU will inform the requester of the patent number, issue date and classification. If the application has not been published, but is pending or abandoned then the AAU determines whether the requester is entitled to such information. See MPEP § 102 for additional information.

Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Office of Patent Application Processing to the TCs for direct action. Such letters will be stamped "Status Letters."

If the correspondent is not entitled to the information, in view of 37 CFR 1.14, the correspondent should be so informed.

For Congressional and other official inquiries, see MPEP § 203.08(a).

II. NEW APPLICATION

A Notice of Allowability, Form PTOL-37, is routinely mailed in every application determined to be allowable. Thus, the mailing of a form PTOL-37 in addition to a formal Notice of Allowance and Fee(s) Due (PTOL-85) in all allowed applications would seem to obviate the need for status inquiries even as a precautionary measure where the applicant may believe the new application may have been passed to issue on the first examination. However, as an exception, a status inquiry would be appropriate where a Notice of Allowance (PTOL-85) is not received within three months from receipt of form PTOL-37.

Current examining procedures aim to minimize the spread in dates among the various examiner dockets of each art unit and TC with respect to actions on new applications. Accordingly, the dates of the "oldest new applications" appearing in the Official Gazette are fairly reliable guides as to the expected time frames of when the examiners reach the applications or action.

III. AMENDED APPLICATIONS

Amended applications are expected to be taken up by the examiner and an action completed within two months of the date the examiner receives the application. Accordingly, a status inquiry is not in order after reply by the attorney until 5 or 6 months have elapsed with no response from the Office. However, in the event that a six month period has elapsed, and no response from the Office is received, applicant should inquire as to the status of the application to avoid potential abandonment.

Applicants are encouraged to use PAIR to make status inquiries. See subsection I, above. A stamped postcard receipt or Electronic Acknowledgement Receipt for replies to Office actions, adequately and specifically identifying the papers filed, will be considered prima facie proof of receipt of such papers. See MPEP § 503. Where such proof indicates the timely filing of a reply, the submission of a copy of the postcard or Electronic Acknowledgement Receipt with a copy of the reply will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely reply to a final action will obviate the need for a petition to revive only if the reply was in compliance with 37 CFR 1.113.

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203.08(a) Congressional and Other Official Inquiries [R-08.2017]

Correspondence and inquiries from the White House, Members of Congress, embassies, and heads of Executive departments and agencies normally are cleared by the USPTO's Office of Policy and International Affairs and/or the Office of Governmental Affairs.

Inquiries referred to in this section such as correspondence from embassies, the Office of the U.S. Trade Representative, and the Department of State should immediately be transmitted to the Administrator of the Office of Policy and International Affairs, and a staff member of that office should be notified by phone that such correspondence has been received at 571-272-9300. Inquiries referred to in this section such as correspondence from Congress or the White House should immediately be transmitted to the Director of the Office of Governmental Affairs, and a staff member of that office should be notified by phone that such correspondence has been received at 571-272-7300.

This procedure is used so that there will be uniformity in the handling of contacts from the indicated sources, and also so that compliance with directives of the Department of Commerce is attained.

204-209 [Reserved]

210 Priority to, or the Benefit of, the Filing Date of a Prior-Filed Application [R-08.2017]

Under certain conditions and on fulfilling certain requirements, a later-filed application for patent filed in the United States may claim the benefit of, or priority to, a prior application filed in the United States (see 35 U.S.C. 119(e), 120, 121, 365(c), and 386(c); see also 37 CFR 1.78) or in a foreign country (see 35 U.S.C. 119(a)-(d) and (f), 365(a) and (b), and 386(a) and (b); see also 37 CFR 1.55).

As a result of recent changes to the applicable laws and rules, the procedural requirements and time frames for claiming priority to, or the benefit of, an earlier-filed application may vary based on the filing date of the later-filed nonprovisional application.

Note that effective December 18, 2013, the Patent Law Treaties Implementation Act of 2012 (PLTIA) amended the patent laws to implement the provisions of the Patent Law Treaty (PLT) in title II; corresponding revisions to title 37 of the Code of Federal Regulations also became effective on December 18, 2013. Notable changes to the law and rules included the restoration of the right of priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application. In addition, title I of the PLTIA became effective May 13, 2015, along with corresponding revisions to the rules. Notable changes included the ability to file international design applications and to claim priority to, and the benefit of, international design applications in nonprovisional applications.

I. REQUIREMENTS OF 37 CFR 1.78 (CLAIMING THE BENEFIT OF AN EARLIER NATIONAL APPLICATION)

The following is an overview of the substantive changes to 37 CFR 1.78 resulting from implementation of Public Law 112-29, 125 Stat. 284 (Leahy Smith America Invents Act (AIA)) and implementation of Public Law 112-211, 126 Stat. 1527 (titles I and II of the Patent Law Treaties Implementation Act (PLTIA)). See MPEP § 211 et seq. for the detailed requirements for claiming (and entitlement to), the benefit of an earlier-filed application under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c).

Whether an application was filed before, on, or after March 16, 2013, statutory provisions require that for a later-filed application to be entitled to the benefit of an earlier-filed national application, the later-filed application must contain a specific reference to the earlier-filed application. 35 U.S.C. 119(e), 120.

The inventor's oath or declaration provisions of Public Law 112-29, sec. 4, 125 Stat. 284 (the Leahy-Smith America Invents Act) and the rules

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related thereto became effective September 16, 2012. In implementing these provisions the Office revised 37 CFR 1.78 to require that a benefit claim under 35 U.S.C. 119(e), 120, 121, or 365(c) must be in the application data sheet (37 CFR 1.76). Thus for all applications filed on or after September 16, 2012, the specific reference to the prior application must be in the application data sheet; for applications filed prior to September 16, 2012, the specific reference to the prior application must be in an application data sheet or in the first sentence(s) of the specification.

In implementing the Patent Law Treaties Implementation Act (PLTIA), the Office reorganized and revised 37 CFR 1.78 effective May 13, 2015. All versions of 37 CFR 1.78 in effect prior to May 13, 2015, have been consolidated in the current version of 37 CFR 1.78. The following is a summary of the provisions of 37 CFR 1.78.

(A) 37 CFR 1.78(a) contains provisions relating to claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application;

(B) 37 CFR 1.78(b) contains provisions relating to restoration of the right to claim the benefit of a provisional application under 35 U.S.C. 119(e) when the delay in filing the subsequent application was unintentional.

(C) 37 CFR 1.78(c) contains provisions relating to delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application;

(D) 37 CFR 1.78(d) contains provisions relating to claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application;

(E) 37 CFR 1.78(e) contains provisions relating to delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application;

(F) 37 CFR 1.78(f) contains provisions relating to applications containing patentably indistinct claims;

(G) 37 CFR 1.78(g) contains provisions relating to applications or patents under reexamination naming different inventors and containing patentably indistinct claims;

(H) 37 CFR 1.78(h) provides for situations where the specific reference to a prior filed application may be presented in the first sentence(s) of the specification in applications filed before September 16, 2012;

(I) 37 CFR 1.78(i) provides for situations where a petition under 37 CFR 1.78(b), (c), or (e) required in an international application can be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application;

(J) 37 CFR 1.78(j) provides that benefit under 35 U.S.C. 386(c) with respect to an international design application can only be claimed in nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon; and

(K) 37 CFR 1.78(k) provides that the time periods set forth in 37 CFR 1.78 are not extendable, but are subject to 35 U.S.C. 21(b) (and 37 CFR 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

37 CFR 1.78(a)(6) and (d)(6) set forth provisions that are only applicable to nonprovisional applications filed on or after March 16, 2013 that claim the benefit of the filing date of a provisional or nonprovisional application filed prior to March 16, 2013. Specifically, the paragraphs require that if the later filed application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the time periods set forth in the rule. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in 37 CFR 1.56(c) that the later filed nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013. An applicant is also not required to provide such a statement if the application claims the benefit of an earlier application in which a statement that the earlier application contains, or contained at any time, a claim to a claimed invention that has an

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effective filing date on or after March 16, 2013 has been filed. See MPEP § 211.01 for additional information.

II. REQUIREMENTS OF 37 CFR 1.55 (CLAIMING PRIORITY TO AN EARLIER FOREIGN APPLICATION)

The following is an overview of the substantive changes to 37 CFR 1.55 resulting from implementation of Public Law 112-29, 125 Stat. 284 (Leahy Smith America Invents Act (AIA)) and implementation of Public Law 112-211, 126 Stat. 1527 (titles I and title II of the Patent Law Treaties Implementation Act (PLTIA)). See MPEP § 213 et seq. for the detailed requirements for claiming (and entitlement to), priority to of an earlier filed foreign application under 35 U.S.C. 119(a)-(d) or (f), 35 U.S.C. 365(a) or (b), or 386(a) or (b).

Whether an application was filed before, on, or after March 16, 2013, 35 U.S.C. 119(b)(1) requires a claim for priority identifying the foreign application. Prior to September 16, 2012, 37 CFR 1.55 and 1.63 required the claim for priority to be identified on an application data sheet or in the oath or declaration.

The inventor's oath or declaration provisions of Public Law 112-29, sec. 4, 125 Stat. 284 (the Leahy-Smith America Invents Act) and the rules related thereto became effective September 16, 2012. In implementing these provisions the Office revised 37 CFR 1.55 to require that a claim for foreign priority must be presented in the application data sheet (37 CFR 1.76). Thus for all applications filed on or after September 16, 2012, a claim for priority under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) or (b) to the prior application must be presented in the application data sheet; for applications filed prior to September 16, 2012, the claim for priority to the foreign application must be identified in an application data sheet or in the oath or declaration.

In implementing the Patent Law Treaties Implementation Act (PLTIA), the Office reorganized and revised 37 CFR 1.55 effective May 13, 2015. All versions of 37 CFR 1.55 in effect prior to May 13, 2015, have been consolidated in the current version of 37 CFR 1.55. The following is a summary of the provisions of 37 CFR 1.55.

(A) 37 CFR 1.55(a) provides generally that a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b);

(B) 37 CFR 1.55(b) contains provisions relating to the time for filing a nonprovisional application claiming priority to a foreign application under 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b);

(C) 37 CFR 1.55(c) contains provisions relating to the restoration of the right of priority under35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b);

(D) 37 CFR 1.55(d) contains provisions relating to the time for filing a priority claim in an application filed under 35 U.S.C. 111(a) and in an application entering the national stage under 35 U.S.C. 371;

(E) 37 CFR 1.55(e) contains provisions relating to delayed claims for priority under 35 U.S.C. 119(a) through (d) and (f), 365(a) or (b), and 386(a) or (b);

(F) 37 CFR 1.55(f) contains provisions relating to the time for filing the certified copy of a foreign application in an application filed under 35 U.S.C. 111(a) and in an application entering the national stage under 35 U.S.C. 371;

(G) 37 CFR 1.55(g) contains provisions relating to the filing of a priority claim, certified copy of the foreign application, and translation of a non-English language foreign application in any application;

(H) 37 CFR 1.55(h) contains provisions relating to when the requirement for a certified copy will be considered satisfied based on a certified copy filed in another U.S. patent or application;

(I) 37 CFR 1.55(i) contains provisions relating to the priority document exchange agreement;

(J) 37 CFR 1.55(j) contains provisions relating to the filing of an interim copy of a foreign application;

(K) 37 CFR 1.55(k) contains provisions relating to requirements for certain applications filed on or after March 16, 2013;

(L) 37 CFR 1.55(l) contains provisions relating to inventor's certificates; and

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(M) 37 CFR 1.55(m) contains provisions relating to the time for the filing of a priority claim and certified copy of the foreign application in an international design application designating the United States;

(N) 37 CFR 1.55(n) provides for situations where a foreign priority claim may be presented in the oath or declaration in applications filed before September 16, 2012;

(O) 37 CFR 1.55(o) provides that right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon; and

(P) 37 CFR 1.55(p) provides that the time periods set forth in 37 CFR 1.55 are not extendable, but are subject to 35 U.S.C. 21(b) (and 37 CFR 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

III. REQUIREMENT FOR A STATEMENT UNDER 37 CFR 1.55 OR 1.78 FOR FIRST INVENTOR TO FILE TRANSITION APPLICATIONS

The first inventor to file provisions of Public Law 112-29, sec. 3, 125 Stat. 284 (the Leahy-Smith America Invents Act) and the rules related thereto became effective March 16, 2013. These provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined under section 100(i) of title 35, United States Code, that is on or after March 16, 2013; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim. See 35 U.S.C. 100 (note)

As a result, the effective filing date of each claimed invention determines whether an application is subject to examination under 35 U.S.C. 102 and 103 as effective on March 16, 2013 or under 35 U.S.C. 102 and 103 in effect on March 15, 2013 (i.e., pre-AIA 35 U.S.C. 102 or 103).

Title I of the PLTIA amended the definition of effective filing date in 35 U.S.C. 100(i) to provide for priority claims under 35 U.S.C. 386(a) or (b) and benefit claims under 35 U.S.C. 386(c).

The effective filing date for a claimed invention in a patent or application (except in an application for reissue or reissued patent) is set forth in 35 U.S.C. 100(i)(1) as:

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

For an application for reissue or a reissued patent, the effective filing date for a claimed invention, as set forth in 35 U.S.C. 100(i)(2), is determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

In implementing the first inventor to file provision of the AIA, the Office added a statement requirement to 37 CFR 1.55 and 1.78 for transition applications. See 37 CFR 1.55(k) and 1.78(a)(6) and (d)(6). Note that the statement requirement for transition applications does not apply to nonprovisional international design applications.

A. Transition Applications

Transition applications are nonprovisional applications that:

(A) are filed on or after March 16, 2013; ***and***

(B) claim foreign priority to, or domestic benefit of, an application filed before March 16, 2013.

Transition applications are either pre-AIA first-to-invent applications or AIA first-inventor-to-file applications depending on the effective filing date of the claimed invention(s).

The statement provisions of 37 CFR 1.55 and 1.78 require that if the later-filed transition application

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contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect (unless the later-filed application is a nonprovisional international design application). The statement must be provided within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in 37 CFR 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. Nonprovisional international design applications are excluded from the transition provisions of 37 CFR 1.55(k) and 1.78(a)(6) and (d)(6).

For a nonprovisional application filed on or after March 16, 2013 that claims priority to, or the benefit of, the filing date of an earlier filed application, the applicant would **not** be required to provide any statement if:

(A) The nonprovisional application discloses only subject matter also disclosed in a priority or domestic benefit application filed prior to March 16, 2013; or

(B) the nonprovisional application claims only priority to, or the benefit of, the filing date of an application filed on or after March 16, 2013.

An applicant is not required to provide such a statement under 37 CFR 1.78 in a continuing transition application if the application claims the benefit of a nonprovisional application in which such a statement under 37 CFR 1.55 or 1.78 has been filed. See 37 CFR 1.78(d)(6)(i).

An applicant is not required to provide such a statement under 37 CFR 1.55 or 1.78 if the applicant reasonably believes on the basis of information already known to the individuals designated in 37 CFR 1.56(c) that the later-filed transition application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

Applicant is not required to identify how many or which claims in the transition application have an effective filing date on or after March 16, 2013, or identify the subject matter in the transition application not also disclosed in the priority or benefit application. Applicant is only required to state that there is a claim in the transition application that has an effective filing date on or after March 16, 2013. The Office may issue a requirement for information under 37 CFR 1.105 if an applicant takes conflicting positions on whether an application contains, or contained at any time, a claim to a claimed invention having an effective filing date on or after March 16, 2013. For example, the Office may require the applicant to identify where there is written description support under 35 U.S.C. 112(a) in the pre-AIA application for each claim to a claimed invention if an applicant provides the statement under 37 CFR 1.78(a)(6), but later argues that the application should have been examined as a pre-AIA application because the application does not actually contain a claim to a claimed invention having an effective filing date on or after March 16, 2013.

B. Application Data Sheet and Filing Receipt

The application data sheet (ADS, Form PTO/AIA/14) and the transmittal letter for 35 U.S.C. 371 national stage filing (Form PTO- 1390) are available for an applicant to make the 37 CFR 1.55/1.78 statement by marking a check box on the forms. The presence or absence of the 37 CFR 1.55/1.78 statement is reflected on the filing receipt. If applicant receives a filing receipt with incorrect information regarding the 37 CFR 1.55/1.78 statement, applicant may request a corrected filing receipt. Therefore, applicants should carefully and promptly review their filing receipts in order to ensure that their applications will be examined under the correct statutory framework.

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35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement

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to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

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(e)(1) An application for patent filed under section 111(a) or section 363 for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b), if the application for patent filed under section 111(a) or section 363 is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this subsection.

(2) A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day. For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351.

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37 CFR 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* An applicant in a nonprovisional application, other than for a design patent, or an international application designating the United States may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

(1) The nonprovisional application or international application designating the United States must be:

(i) Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of this section (a subsequent application); or

(ii) Entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of this section.

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

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(i) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet (§ 1.76(b)(5)) eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) *Delayed filing of the subsequent nonprovisional application or international application designating the United States.* If the subsequent nonprovisional application or international application designating the United States has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1)(i) of this section but within two months from the expiration of the period set forth in paragraph (a)(1)(i) of this section, the benefit of the provisional application may be restored under PCT Rule 26 *bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent nonprovisional application or international application designating the United States within the period set forth in paragraph (a)(1)(i) of this section was unintentional.

(1) A petition to restore the benefit of a provisional application under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, and any petition to restore the benefit of a provisional application under this paragraph must include:

(i) The reference required by 35 U.S.C. 119(e) to the prior-filed provisional application in an application data sheet (§ 1.76(b)(5)) identifying it by provisional application number (consisting of series code and serial number), unless previously submitted;

(ii) The petition fee as set forth in § 1.17(m); and

(iii) A statement that the delay in filing the subsequent nonprovisional application or international application designating the United States within the twelve-month period set forth in paragraph (a)(1)(i) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(2) The restoration of the right of priority under PCT Rule 26 *bis*.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

(c) *Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* An applicant in a nonprovisional application (including a nonprovisional application resulting from an international application or international design application), an international application designating the United States, or an international design application designating the United States may claim the benefit of one or more prior-filed copending nonprovisional applications, international applications designating the United States, or international design applications designating the United States under the conditions set forth in 35 U.S.C. 120, 121, 365(c), or 386(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the

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inventor or a joint inventor. In addition, each prior-filed application must either be:

(i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States;

(ii) An international design application entitled to a filing date in accordance with § 1.1023 and designating the United States; or

(iii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in § 1.53(b) or (d) for which the basic filing fee set forth in § 1.16 has been paid within the pendency of the application.

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application, international application designating the United States, or international design application designating the United States that claims the benefit of one or more prior-filed nonprovisional applications, international applications designating the United States, or international design applications designating the United States must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), international application number and international filing date, or international registration number and filing date under § 1.1023. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application.

(3)

(i) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application.

(ii) If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the prior-filed application.

(4) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see § 1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§ 1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims the benefit of the filing date of a nonprovisional application or an international application designating the United States filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior-filed application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the later-filed application. An applicant is not required to provide such a statement if either:

(i) The application claims the benefit of a nonprovisional application in which a statement under § 1.55(k), paragraph (a)(6) of this section, or this paragraph that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013 has been filed; or

(ii) The applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the later filed application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(7) Where benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) to an international application or an international design application which designates but did not originate in the United States, the Office may require a certified copy of such application together with an English translation thereof if filed in another language.

(e) *Delayed claims under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed nonprovisional application, international application, or international design application.* If the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is presented after the time period provided by paragraph (d)(3) of this section, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed copending nonprovisional application, international application designating the United States, or international design application designating the United States may be accepted if the reference required by

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paragraph (d)(2) of this section was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be accompanied by:

(1) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section to the prior-filed application, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (d)(3) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Applications containing patentably indistinct claims.* Where two or more applications filed by the same applicant or assignee contain patentably indistinct claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

(g) *Applications or patents under reexamination naming different inventors and containing patentably indistinct claims.* If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain patentably indistinct claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the Office may require the applicant or assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person on such date, and if not, indicate which named inventor is the prior inventor, as applicable. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person on the effective filing date (as defined in § 1.109), or on the date of the invention, as applicable, of the later claimed invention, the patentably indistinct claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

(h) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (a)(3) and (d)(2) of this section that any specific reference to a prior-filed application be presented in an application data sheet (§ 1.76), this requirement in paragraph (a)(3) and (d)(2) of this section will be satisfied by the presentation of such specific reference in the first sentence(s) of the specification following the title in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any specific reference submitted for a petition under paragraph (b) of this section to restore the benefit of a provisional application.

(i) *Petitions required in international applications.* If a petition under paragraph (b), (c), or (e) of this section is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then such petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as having been filed in the international application.

(j) *Benefit under 35 U.S.C. 386(c).* Benefit under 35 U.S.C. 386(c) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(k) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

There are several procedural requirements for a later-filed application to claim the benefit of the filing date of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c) or, provided the later-filed application is not a design application (see 35 U.S.C. 172), under 35 U.S.C. 119(e). These requirements are briefly summarized below, followed by a cross-reference to the MPEP section where the requirement is discussed in greater detail.

(A) The prior-filed application must be entitled to a filing date and meet additional requirements as discussed in MPEP § 211.01.

(B) The later-filed application must name the inventor or at least one joint inventor named in the prior-filed application for a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) (see MPEP § 211.01).

(C) For a benefit claim under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c), the later-filed application must contain a reference to the prior-filed application (see MPEP § 211.02).

(D) The reference to the prior-filed application must be submitted within the time periods set forth in 37 CFR 1.78. See MPEP § 211.03. However, the Office will accept an unintentionally delayed benefit claim in certain circumstances. See MPEP § 211.04.

(E) In order to be entitled to the benefit of the prior-filed application, the earlier application must disclose the claimed invention of the later-filed application in the manner provided by 35 U.S.C. 112(a) except for the best mode requirement. See MPEP § 211.05.

(F) If a nonprovisional application, other than a nonprovisional international design application, filed on or after March 16, 2013, claims the benefit of the filing date of a provisional or nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a

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claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within a specified time period. See 37 CFR 1.78(a)(6) and (d)(6) and MPEP § 210, subsection III. If the claims in the later-filed application are not entitled to the benefit of an earlier filing date, the examiner should:

(1) Notify applicant that the claims in the later-filed application are not entitled to the benefit of an earlier filing date because one or more conditions for receiving the benefit of an earlier filing date have not been satisfied (the examiner may use form paragraph 2.09 and other appropriate form paragraphs provided in the following subsections); and

(2) Conduct a prior art search based on the actual filing date of the application instead of the earlier filing date. The examiner may use an intervening reference in a rejection until applicant corrects the benefit claim or shows that the conditions for entitlement to the benefit of the prior application have been met.

211.01 Requirements Related to the Prior-Filed Application [R-07.2015]

I. THE PRIOR-FILED APPLICATION MUST BE ENTITLED TO A FILING DATE

If the prior-filed application is a nonprovisional application filed under 35 U.S.C. 111(a), the application must be entitled to a filing date as set forth in 37 CFR 1.53(b) or (d), and the basic filing fee as set forth in 37 CFR 1.16 must have been paid within the pendency of the application. See 37 CFR 1.78(d)(1)(iii). If the prior-filed application is an international application designating the United States, the prior-filed application must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(d)(1)(i). If the prior-filed application is an international design application designating the United States, the prior-filed application must be entitled to a filing date in accordance with 37 CFR 1.1023. See 37 CFR 1.78(d)(1)(ii).

If the prior-filed application is a provisional application, the provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee of the provisional application must have been paid within the time period set in 37 CFR 1.53(g). See 37 CFR 1.78(a)(2).

Form paragraph 2.40 may be used to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.

¶ 2.40 Prior-Filed Application Not Entitled to a Filing Date or Basic Filing Fee Was Not Paid

This application claims the benefit of prior-filed application No. **[1]** under 120, 121, 365(c), or 386(c) or under 35 U.S.C. 119(e). If the prior-filed application is an international application designating the United States, it must be entitled to a filing date in accordance with PCT Article 11; if the prior-filed application is an international design application designating the United States, it must be entitled to a filing date in accordance with 37 CFR 1.1023; and if the prior-filed application is a nonprovisional application under 35 U.S.C. 111(a), the prior-filed application must be entitled to a filing date as set forth in 37 CFR 1.53(b) or 1.53(d) and include the basic filing fee set forth in 37 CFR 1.16. See 37 CFR 1.78(d)(1). If the prior-filed application is a provisional application, the prior-filed application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee must be paid within the time period set forth in 37 CFR 1.53(g). See 37 CFR 1.78(a)(2).

This application is not entitled to the benefit of the prior-filed application because the prior-filed application **[2]**. Applicant is required to delete the benefit claim to the prior-filed application from the Application Data Sheet (ADS) or, for applications filed before September 16, 2012, from the ADS or the first sentence(s) of the specification as appropriate.

Examiner Note:

1. Use this form paragraph to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.

2. In bracket 1, insert the application number of the prior-filed application.

3. In bracket 2, insert "was not entitled to a filing date"; "did not include the basic filing fee"; or "was not entitled to a filing date and did not include the basic filing fee".

II. SAME INVENTOR OR A COMMON JOINT INVENTOR

The statute requires that applications claiming benefit of the earlier filing date under 35 U.S.C. 119(e) or 120 name the inventor or at least one joint inventor named in the previously filed application or provisional application. Note that to be entitled to the benefit of any prior-filed application(s), in addition to naming the inventor or at least one

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common joint inventor, the invention claimed in the later-filed application must be supported in the manner provided by the 35 U.S.C. 112(a), except for the best mode requirement. See MPEP § 211.05.

III. TRANSITION APPLICATION STATEMENT

If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional or nonprovisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within a specified time period. See 37 CFR 1.78(a)(6) and (d)(6) and MPEP § 210, subsection III. Nonprovisional international design applications are excluded from the transition provisions of 37 CFR 1.78(a)(6) and (d)(6).

IV. ADDITIONAL REQUIREMENTS

See MPEP § 211.01(a) for additional information and requirements specific to claiming the benefit of a provisional application.

See MPEP § 211.01(b) for additional information and requirements specific to claiming the benefit of an earlier-filed nonprovisional application.

211.01(a) Claiming the Benefit of a Provisional Application [R-08.2017]

I. IN GENERAL

When a later-filed application is claiming the benefit of a prior-filed provisional application under 35 U.S.C. 119(e), the nonprovisional application must be filed not later than 12 months after the date on which the provisional application was filed, unless the benefit of the provisional application has been restored. See 37 CFR 1.78(a)(1) and (b) and subsection II, below. If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or federal holiday within the District of Columbia, the nonprovisional application may be filed on the next succeeding business day. See 35 U.S.C. 21(b), 37 CFR 1.7(b), and MPEP § 201.04 and § 505.

In addition, each prior-filed provisional application must have the same inventor or at least one joint inventor in common with the later-filed application and must be entitled to a filing date as set forth in 37 CFR 1.53(c), and the basic filing fee set forth in 37 CFR 1.16(d) must have been paid for such provisional application within the time period set forth in 37 CFR 1.53(g). See 37 CFR 1.78(a)(2) and MPEP § 211.01.

If benefit is being claimed to a provisional application which was filed in a language other than English, (A) an English language translation of the provisional application, and (B) a statement that the translation is accurate, are required to be filed in the provisional application. If the translation and statement were not filed in the provisional application, the applicant will be notified in the nonprovisional application and given a period of time within which to file the translation and statement in the provisional application, and a reply in the nonprovisional application confirming that the translation and statement were filed in the provisional application. See 37 CFR 1.78(a)(5). In the alternative, applicant may delete the benefit claim to the provisional application from the Application Data Sheet (ADS) or, for applications filed before September 16, 2012, from the ADS or the first sentence(s) of the specification, as appropriate. See MPEP § 601.05(a) or (b), as appropriate, for additional details on the requirements for a corrected or supplemental ADS. In a pending nonprovisional application, failure to timely reply to such notice will result in the abandonment of the nonprovisional application. Form paragraph 2.38 may be used to notify applicant that an English translation of the non-English language provisional application is required.

¶ 2.38 Claiming Benefit to a Non-English Language Provisional Application

This application claims benefit to provisional application No. **[1]**, filed on **[2]**, in a language other than English. An English translation of the non-English language provisional application and a statement that the translation is accurate must be filed in provisional application No. **[3]**. See 37 CFR 1.78. The **[4]** required by 37 CFR 1.78 is missing. Accordingly, applicant must supply 1) the missing **[5]** in provisional application No. **[6]** and 2) in the present application, a confirmation that the translation and statement were filed in the provisional application. If 1) and 2) are not filed (or if the benefit claim is not withdrawn) prior to the expiration of the time period set in

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this Office action, the present application will be abandoned. See 37 CFR 1.78.

Examiner Note:

1. Use this form paragraph to notify applicant that an English translation of the non-English language provisional application and/or a statement that the translation is accurate is required. Do not use this form paragraph if a translation of the provisional application and a statement that the translation was accurate were filed in the nonprovisional application (the present application) before November 25, 2005.

2. In brackets 1 and 3, insert the application number of the non-English language provisional application.

3. In bracket 2, insert the filing date of the prior provisional application.

4. In brackets 4 and 5, insert --English translation and a statement that the translation is accurate-- or --statement that the translation is accurate--, where appropriate.

Applicant may claim the benefit of a provisional application by claiming the benefit of an intermediate copending nonprovisional application. The later-filed application must claim the benefit of the intermediate nonprovisional application under 35 U.S.C. 120, 121, or 365(c); the intermediate application must be filed not later than 12 months after the filing date of the provisional application (in which the basic filing fee was timely filed) unless the benefit of the provisional application has been restored (see 37 CFR 1.78(b) and subsection II., below); and in the later-filed application,the intermediate application must be clearly identified as claiming the benefit of the provisional application under 35 U.S.C. 119(e). See also MPEP § 211.01(b), subsection II. Design applications may not claim the benefit of a provisional application under 35 U.S.C. 119(e). See 35 U.S.C. 172. Thus, where a design patent application claims benefit under 35 U.S.C. 120 to an intermediate nonprovisional utility patent application that directly claims the benefit of a provisional application, the design application cannot claim the benefit of the filing date of the provisional application.

II. RESTORING THE BENEFIT OF A PROVISIONAL APPLICATION

Effective December 18, 2013, title II of the Patent Law Treaties Implementation Act (PLTIA) provides for restoration of the right to claim benefit of a provisional application filed after the expiration of the twelve-month period in 35 U.S.C. 119(e). If a nonprovisional application or an international application designating the United States has a filing date which is after the expiration of the twelve-month period but within two months from the expiration of the period, the benefit of the provisional application may be restored under PCT Rule 26bis.3 for an international application, or upon petition under 37 CFR 1.78(b), if the delay in filing the nonprovisional application or the international application was unintentional. Thus, an application may now validly claim the benefit of a provisional application filed up to fourteen months earlier. As a result of the implementation of title I of the PLTIA, 37 CFR 1.78(a) and (b) were amended effective May 13, 2015, to provide that a petition filed on or after May 13, 2015 to restore the benefit of a provisional application must be filed in the subsequent application, and to clarify that the subsequent application is the application required to be filed within the period set forth in 37 CFR 1.78(a)(1)(i). For purposes of 37 CFR 1.78(a)(1)(ii), the subsequent application may be a nonprovisional application or an international application designating the United States. Where a petition under 37 CFR 1.78(b) is required in an international application that was not filed in the United States Receiving Office and is not a nonprovisional application, then the petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, or 365(c) to the international application and will be treated as being filed in the international application. See 37 CFR 1.78(i).

A petition under 37 CFR 1.78(b) requires:

(A) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78 to the prior-filed provisional application, which must be included in application data sheet (unless previously submitted in an application data sheet);

(B) the petition fee as set forth in 37 CFR 1.17(m); and

(C) a statement that the delay in filing the nonprovisional application or international application designating the United States within the twelve-month period set forth in 37 CFR 1.78(a)(1)(i) was unintentional.

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The Director may require additional information where there is a question whether the delay was unintentional.

If a petition under 37 CFR 1.78(b) to restore benefit of a provisional application is granted, a further petition under 37 CFR 1.78(b) is not required in an application entitled to claim benefit under 35 U.S.C. 120, 121, or 365(c) of the subsequent application (i.e., the application required to be filed within the period set forth in 37 CFR 1.78(a)(1)(i)) for which benefit of the provisional application was restored. A copy of the decision granting the petition should be filed with any application that claims the benefit of the subsequent application and the provisional application to facilitate recognition of the benefit claim to the provisional application.

Use form paragraphs 2.09 and 2.11.01 to indicate that the later-filed application must be filed not later than 12 months after the filing date of the provisional application for which a benefit is sought unless the benefit of the provisional application has been restored (37 CFR 1.78(b)).

¶ 2.11.01 Application Must Be Filed Within 12 Months From the Provisional Application Unless Petition Granted

This application is claiming the benefit of provisional application No. **[1]** under 35 U.S.C. 119(e). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application or international application designating the United States that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application. In addition, no petition under 37 CFR 1.78(b) or request under PCT Rule 26 *bis*.3 to restore the benefit of the provisional application has been granted.

Applicant is required to delete the claim to the benefit of the prior-filed provisional application, unless applicant can establish that this application, or an intermediate nonprovisional application or international application designating the United States, was filed within 12 months of the filing date of the provisional application. See 35 U.S.C. 119(e)(3). Alternatively, applicant may wish to file a petition to restore the benefit of the provisional application under 37 CFR 1.78 in the subsequent nonprovisional application or international application designating the United States if the subsequent application was filed within two months from the expiration of the twelve-month period and the delay was unintentional. A petition under 37 CFR 1.78(b) to restore the benefit of the provisional application must include: (1) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78 to the prior-filed provisional application (unless previously submitted); (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a statement that the delay in filing the subsequent nonprovisional application or international application designating the United States within the twelve-month period was unintentional. A petition to restore the benefit of a provisional application must be filed in the subsequent application. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.

2. In bracket 1, insert the application number of the prior-filed provisional application.

211.01(b) Claiming the Benefit of a Nonprovisional Application [R-08.2017]

I. COPENDENCY

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. 120, 121, 365(c), or 386(c), the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application. Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application. If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. See *Immersion Corp. v. HTC Corp.,* 826 F.3d 1357, 1359, 119 USPQ2d 1083, 1084 (Fed. Cir. 2016), holding that a child application was entitled to the benefit of a parent application where the child application was filed on the same day that a patent issued on the parent application. Patents usually will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed.

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If the prior application is abandoned, the later-filed application must be filed before the abandonment in order for it to be copending with the prior application. The term "abandoned," refers to abandonment for failure to prosecute (MPEP § 711.02), express abandonment (MPEP § 711.01), abandonment for failure to pay the issue fee (37 CFR 1.316), and abandonment for failure to notify the Office of a foreign filing after filing a nonpublication request under 35 U.S.C. 122(b)(2)(B)(iii) (MPEP § 1124). The expression "termination of proceedings" includes the situations when an application is abandoned or when a patent has been issued, and hence this expression is the broadest of the three copendency definitions.

After a decision by the Court of Appeals for the Federal Circuit in which the rejection of all claims is affirmed, the proceeding is terminated when the mandate is issued by the Court. There are several other situations in which proceedings are terminated as is explained in MPEP § 711.02(c).

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications naming the same inventor or at least one joint inventor in common. The later-filed application may be referred to as a continuing application when the prior application is not a provisional application. Continuing applications include divisional, continuation, and continuation-in-part applications. The statute is so worded that the prior application may disclose more than the later-filed application, or the later-filed application may disclose more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112(a), except for the best mode requirement.

A later-filed application which is not copending with the prior application (which includes those called "substitute" applications as set forth in MPEP § 201.02) is not entitled to the benefit of the filing date of the prior application. Therefore, prior art against the claims of the later-filed application is determined based on the filing date of the later-filed application. An applicant should not refer to such prior application(s) in an application data sheet (see 37 CFR 1.76) and is not required to refer to the prior application in the specification of the later-filed application, but is required to otherwise call the examiner's attention to the prior application if it or its contents or prosecution is material to patentability of the later-filed application as defined in 37 CFR 1.56(b).

Use form paragraphs 2.09 and 2.11 to indicate the benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c) is improper because there is no copendency between the applications.

¶ 2.11 Application Must Be Copending With Parent

This application is claiming the benefit of prior-filed application No. **[1]** under 35 U.S.C. 120, 121, 365(c), or 386(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed application is improper. Applicant is required to delete the claim to the benefit of the prior-filed application, unless applicant can establish copendency between the applications.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.

2. Do not use this form paragraph for benefit claims under 35 U.S.C. 119(e) to provisional applications.

3. In bracket 1, insert the application number of the prior-filed application.

See MPEP § 711.03(c), subsection II, for a discussion of petitions to revive an abandoned application to provide copendency between the abandoned application and a subsequently filed application.

II. BENEFIT CLAIMS TO MULTIPLE PRIOR APPLICATIONS

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending

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application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. See *Sticker Indus. Supply Corp. v. Blaw-Knox Co.,* 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) and *Hovlid v. Asari,* 305 F.2d 747, 134 USPQ 162 (9th Cir. 1962). The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. See MPEP § 211.02 for guidance regarding properly referencing prior applications.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See *In re Henriksen,* 399 F2.d 253, 158 USPQ 224 (CCPA 1968). But see MPEP § 2190 (prosecution laches).

A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application unless the benefit of the provisional application has been restored. See 37 CFR 1.78(b) and MPEP § 211.01(a), subsection II. Although an application that itself directly claims the benefit of a provisional application is not required to specify the relationship to the provisional application, if the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application so that the Office can determine whether the intermediate nonprovisional application was filed within 12 months of the provisional application and thus, whether the claim is proper. Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be indicated. See MPEP § 211.02 for guidance regarding properly referencing prior applications.

If a benefit claim to a provisional application is submitted without an indication that an intermediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period (or 14 month period if the benefit of the provisional application has been restored pursuant to 37 CFR 1.78(b)) or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim and will not include the benefit claim on the filing receipt. Therefore, a petition under 37 CFR 1.78(c) and the petition fee set forth in 37 CFR 1.17(m) will be required if the intermediate application and the relationship of each nonprovisional application are not indicated within the period set forth in 37 CFR 1.78. See MPEP § 201.04.

211.01(c) Claiming the Benefit of an International Application Designating the United States [R-07.2015]

Pursuant to 35 U.S.C. 365(c), a regular national application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) may claim the benefit of the filing date of an international application which designates the United States without completing the requirements for entering the national stage under 35 U.S.C. 371. See MPEP §§ 1895 and 1895.01. Thus, rather than submitting a national stage application under 35 U.S.C. 371, applicant may file a continuation, divisional, or continuation-in-part of an international (PCT) application under 35 U.S.C. 111(a). Such applications are often referred to as "bypass" applications. To claim the benefit of the filing date of an international application, the international application must designate the United States and be entitled to a filing date in accordance with PCT Article 11, and the later-filed application must be filed during the pendency (e.g., prior to the abandonment) of the international application.

The ability to take such action is based on provisions of the United States patent law. 35 U.S.C. 363 provides that "[a]n international application designating the United States shall have the effect,

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from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office." 35 U.S.C. 371(d) indicates that failure to timely comply with the requirements of 35 U.S.C. 371(c) "shall be regarded as abandonment of the application by the parties thereof." It is therefore clear that an international application which designates the United States has the effect of a pending U.S. application from the international application filing date until its abandonment as to the United States. The first sentence of 35 U.S.C. 365(c) specifically provides that "[i]n accordance with the conditions and requirements of section 120,... a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States." The condition of 35 U.S.C. 120 relating to the time of filing requires the later application to be "filed before the patenting or abandonment of or termination of proceedings on the first application...."

211.01(d) Claiming the Benefit of an International Design Application Designating the United States [R-07.2015]

Pursuant to 35 U.S.C. 386(c), in accordance with the conditions and requirements of 35 U.S.C. 120, a nonprovisional application is entitled to the benefit of a prior international design application designating the United States. See MPEP §§ 211 and 2920.05(e). 37 CFR 1.78(j) provides that benefit under 35 U.S.C. 386(c) with respect to an international design application can only be claimed in nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon. To obtain benefit of the filing date of a prior international design application designating the United States, the international design application must be entitled to a filing date in accordance with 37 CFR 1.1023. See 37 CFR 1.78(d)(1)(ii).

See MPEP § 2920.05(e) for additional information pertaining to benefit claims under 35 U.S.C. 386(c).

211.02 Reference to Prior Application(s) [R-08.2017]

I. APPLICATION DATA SHEET

Both 35 U.S.C. 119(e) and 120 include the requirement that the later-filed application must contain a specific reference to the prior application.

For applications filed on or after September 16, 2012, the specific reference to the prior application must be included in an application data sheet (37 CFR 1.76). For applications filed prior to September 16, 2012, the specific reference to the prior application must be in an application data sheet (37 CFR 1.76(a)) and/or in the first sentence(s) of the specification following the title, although the Office prefers the use of an application data sheet. If applicant is claiming the benefit of multiple prior applications, and the reference to the prior applications is in the specification, the reference may be in a continuous string of multiple sentences at the beginning of the specification. The multiple sentences must begin as the first sentence after the title, and any additional sentence(s) including a benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim. If the specific reference is only contained in the application data sheet, then the benefit claim information will be included on the front page of any patent or patent application publication, but will not be included in the first sentence(s) of the specification.

For applications filed on or after September 21, 2004, a claim under 35 U.S.C. 119(e) or 120 and 37 CFR 1.78 for benefit of a prior-filed provisional application, nonprovisional application, international application designating the United States, or international design application designating the United States that was present on the filing date of the continuation or divisional application, or the nonprovisional application claiming benefit of a prior-filed provisional application, is considered an incorporation by reference of the prior-filed application as to inadvertently omitted material, subject to the conditions and requirements of 37 CFR 1.57(b). The purpose of 37 CFR 1.57(b) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are)

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inadvertently omitted from an application. See MPEP § 201.06 and 217. However, applicants are encouraged to provide in the specification an explicit incorporation by reference statement to the prior-filed application(s) for which benefit is claimed under 35 U.S.C. 119(e) or 120 if applicants do not wish the incorporation by reference to be limited to inadvertently omitted material pursuant to 37 CFR 1.57(b). See 37 CFR 1.57(c). See also MPEP §§ 217 and MPEP § 608.01(p).

When a benefit claim is submitted after the filing of an application, and the later-filed application as filed did not incorporate the prior-filed application by reference, applicant cannot add an incorporation by reference statement of the prior application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). See *Dart Indus. v. Banner* , 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). See also 37 CFR 1.57(b).

If an applicant includes a benefit claim elsewhere in the application but not in the manner specified by 37 CFR 1.78 (e.g., if the claim is not present in the proper place but is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78, the Office will not require a petition under 37 CFR 1.78 and the petition fee under 37 CFR 1.17(m) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the first filing receipt. If, however, a claim is not included in an ADS in compliance with 37 CFR 1.76 (or for applications filed prior to September 16, 2012 in the first sentence(s) of the specification or in an ADS in compliance with pre-AIA 37 CFR 1.76) and is not recognized by the Office as shown by its absence on the first filing receipt, the Office will require a petition under 37 CFR 1.78 and the petition fee to correct the claim if the correction is sought after expiration of the time period set in 37 CFR 1.78. The Office may not recognize any benefit claim where, for example, there is no indication of the relationship between the nonprovisional applications, or no indication of an intermediate nonprovisional application that is directly claiming the benefit of a provisional application. See subsection II, below. Even if the Office has recognized a benefit claim by entering it into the Office's database and including it on any of applicant's filing receipts, the benefit claim is not a proper benefit claim under 35 U.S.C. 119(e) or 35 U.S.C. 120 and 37 CFR 1.78 unless the reference is included in an ADS in compliance with 37 CFR 1.76 or, for applications filed prior to September 16, 2012, included in an ADS in compliance with pre-AIA 37 CFR 1.76 or in the first sentence(s) of the specification, and all other requirements are met.

In view of this requirement for a specific reference in the later-filed application, the right to rely on a prior application may be waived by an applicant if a proper reference to the prior application is not included in the later-filed application. If the examiner is aware of the fact that an application may be entitled to claim the benefit of a prior application or the applicant fails to submit the reference to the prior application in compliance with 37 CFR 1.78 (e.g., the reference was submitted in the transmittal letter but not in an ADS in compliance with 37 CFR 1.76 (or for applications filed prior to September 16, 2012 in the first sentence(s) of the specification or an ADS in compliance with pre-AIA 37 CFR 1.76)), the examiner should merely call attention to this in an Office action by using the wording of form paragraph 2.15.

¶ 2.15 Reference to Prior Application, 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) Benefit

This application makes reference to or appears to claim subject matter disclosed in Application No. **[1]**, filed **[2]**. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), 120, 121, 365(c) or 386(c), the instant application must contain, or be amended to contain, a specific reference to the prior-filed application in compliance with 37 CFR 1.78. If the application was filed before September 16, 2012, the specific reference must be included in the first sentence(s) of the specification following the title or in an application data sheet (ADS) in compliance with pre-AIA 37 CFR 1.76; if the application was filed on or after September 16, 2012, the specific reference must be included in an ADS in compliance with 37 CFR 1.76. For benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a), the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a national stage application under 35 U.S.C. 371, the specific reference must be submitted during the

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pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(4) for benefit claims under 35 U.S.C. 119(e) and 37 CFR 1.78(d)(3) for benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121, 365(c), and 386(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e) (see 37 CFR 1.78(c)) or under 35 U.S.C. 120, 121, 365(c), or 386(c) (see 37 CFR 1.78(e)). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and by 37 CFR 1.78 to the prior application (unless previously submitted), (2) the petition fee under 37 CFR 1.17(m), and (3) a statement that the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78 but was not included in the location in the application required by the rule (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78 and the petition fee under 37 CFR 1.17(m) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78 by filing an ADS in compliance with 37 CFR 1.76 with the reference (or, if the application was filed before September 16, 2012, by filing either an amendment to the first sentence(s) of the specification or an ADS in compliance with pre-AIA 37 CFR 1.76). See MPEP § 211.02.

Examiner Note:

1. Use this paragraph when an application does not claim the benefit of a prior-filed application, but makes a reference to, or appears to claim subject matter disclosed in, the prior-filed application.

2. In bracket 1, insert the application number of the prior-filed application.

3. In bracket 2, insert the filing date of the prior-filed application.

4. In a continued prosecution application (CPA) filed under 37 CFR 1.53(d) (design applications under 35 U.S.C. chapter 16 only), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA. 37 CFR 1.53(d)(2)(iv) and 1.53(d)(7).

If the examiner is aware of a prior application, the examiner should note it in an Office action, as indicated above, but should not require the applicant to call attention to the prior application.

For notations to be placed in the file history in the case of continuing applications, see MPEP § 202 and § 1302.09.

II. REFERENCE TO PRIOR NONPROVISIONAL APPLICATIONS

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, 365(c), and 386(c) must identify the prior application by application number, by international application number and international filing date, or by international registration number and international filing date under 37 CFR 1.1023, and indicate the relationship between the applications. See 37 CFR 1.78. The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. For international design applications, the required reference can identify the nonprovisional application number instead of the international registration number and filing date under 37 CFR 1.1023 once the international design application becomes a nonprovisional application. Identifying the prior international design application by the nonprovisional application number is preferable to the Office.

Where the reference to a prior nonprovisional application appears in the specification of an application as permitted for applications filed before September 16, 2012, an example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78, since the relationship between the applications is not stated. In addition, a benefit claim that merely states that "this application is a continuing application of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78 since the proper relationship, which includes the type of continuing

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(i.e., continuation, divisional, or continuation-in-part) application, is not stated.

A request for a CPA filed under 37 CFR 1.53(d) (available only for design applications, but not international design applications) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78 to every application assigned the same application number identified in the request. (Note: The CPA is assigned the same application number as the prior application.) In a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and may not be made. Any such reference should be deleted. No amendment in a CPA may delete the specific reference to the prior application assigned the same application number. A specific reference to an application not assigned the same application number, but relied on for benefit under 35 U.S.C. 120 and 37 CFR 1.78 is required. Cross references to other related applications not assigned the same application as the CPA may be made when appropriate.

When a nonprovisional application (other than a CPA) filed on or after September 16, 2012 is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, the reference must be included in an application data sheet. For applications filed prior to September 16, 2012, the benefit claim must appear either in the application data sheet, or as a statement in the first sentence(s) of the specification. An example of such a statement is "This is a divisional (or continuation, or continuation-in-part, as appropriate) application of Application No. ---, filed ---." In the case of a design application filed under 37 CFR 1.53(b) as a divisional, continuation or continuation-in-part of a CPA, there should be only one reference to the series of applications assigned the same application number, with the filing date cited being that of the original non-continued application. See MPEP § 1504.20 for additional information pertaining to benefit claims in design applications.

Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application under 35 U.S.C. 371, the appropriate relationship must be indicated on an application data sheet for applications filed on or after September 16, 2012. For applications filed prior to September 16, 2012, the specific reference to the prior application must be in an application data sheet (pre-AIA 37 CFR 1.76) and/or in the first sentence(s) specification. Where the reference to the prior-filed national stage application appears in the specification, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, which was the National Stage of International Application No. PCT/DE95/---, filed ---."

Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in an application data sheet (for an application filed on or after September 16, 2012), or in the application data sheet or the first sentence(s) of the specification (for an application filed prior to September 16, 2012). As a result, publication of the application may not be scheduled on the basis of the prior application's filing date. If the Office does not recognize a benefit claim under 35 U.S.C. 120 because it does not contain the required reference and the time period set forth in 37 CFR 1.78 for submitting the required reference has expired, applicant must submit a petition under 37 CFR 1.78 and the petition fee set forth in 37 CFR 1.17(m) in order for the Office to accept the unintentionally delayed claim under 35 U.S.C. 120 because the application will not have been scheduled for publication on the basis of the prior application's filing date.

To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application. Note that the terms are exclusive. An application cannot be, for example, both a continuation and a divisional or a continuation and a continuation-in-part of the same application. Moreover, if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed

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applications. For example, where the reference to a prior nonprovisional application appears in the specification of an application as permitted for applications filed before September 16, 2012, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---.

III. REFERENCE TO PRIOR PROVISIONAL APPLICATIONS

When a nonprovisional application filed on or after September 16, 2012 is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), the reference must be included in an application data sheet. For applications filed prior to September 16, 2012, the reference to the provisional application must be in an application data sheet (37 CFR 1.76(a)) and/or in the first sentence(s) specification. Where the reference to a prior provisional application appears in the first sentence(s) of the specification a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/---, filed ---." should appear as the first sentence(s) of the description. In addition, where a nonprovisional application benefit claim appears in the specification of an application filed before September 16, 2012 and the application is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---.". Note that a design application cannot claim the benefit of a provisional application. See MPEP § 1504.20 for benefit information specific to design applications and MPEP § 2920.05(e) for benefit information specific to international design applications.

The relationship (i.e., continuation, divisional, or continuation-in-part) is not required and should not be specified when the benefit of a prior provisional application is being claimed under 35 U.S.C. 119(e). No relationship should be specified because whenever a benefit claim to a provisional application under 35 U.S.C. 119(e) is made, it is implicit that the relationship is "nonprovisional application of a provisional application." If a relationship between a prior provisional application and the nonprovisional application is submitted, it may be unclear whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. Thus, applicants seeking to claim the benefit of a provisional application under 35 U.S.C. 119(e) should not state that the application is a "continuation" of a provisional application or that the application claims 35 U.S.C. 120 benefit to a provisional application. Although 35 U.S.C. 120 does not preclude a benefit claim to a provisional application, it is not recommended that applicants claim the benefit to a provisional application under 35 U.S.C. 120 since such a claim could have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. 154(a)(2).

211.02(a) Correcting or Adding a Benefit Claim After Filing [R-08.2017]

I. CORRECTED FILING RECEIPT

If applicant receives a filing receipt with missing or incorrect benefit claim information, applicant may request a corrected filing receipt. The Office will not grant a request for a corrected filing receipt to include a benefit claim unless the proper reference to the prior application is included (i) in an ADS (for applications filed on or after September 16, 2012) or (ii) in the first sentence(s) of the specification or an ADS (for applications filed prior to September 16, 2012) within the time period required by 37 CFR 1.78 with a few exceptions. See MPEP § 211.03. If the proper reference was previously submitted in an application filed on or after September 16, 2012, the request for a corrected filing receipt should indicate that the reference was properly and timely made in the ADS. If the proper reference was previously submitted in an application filed prior to September 16, 2012, the request for a corrected filing receipt

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should indicate that the reference was properly and timely made and where such reference is located (i.e., the specification, an amendment to the specification, or an ADS). The Office may notify applicants on or with the filing receipt that a benefit claim may not have been recognized because the benefit claim was improper but applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition (37 CFR 1.78) and the petition fee.

II. ADDING BENEFIT CLAIMS

If a benefit claim is added after the time period required by 37 CFR 1.78, a petition and the petition fee are required. See MPEP § 211.04. Any petition under 37 CFR 1.78 must be accompanied by a corrected ADS in compliance with 37 CFR 1.76(c) (for applications filed on or after September 16, 2012), or by an amendment to the specification or a supplemental ADS in compliance with pre-AIA 37 CFR 1.76(c) (for applications filed prior to September 16, 2012) unless the proper reference was previously submitted. In addition to the petition under 37 CFR 1.78 and ADS or amendment, to add a benefit claim it may be necessary for applicant to file one of the following, depending on the status of the application:

(A) a request for continued examination (RCE) under 37 CFR 1.114, if the application is under a final rejection or has been allowed (see MPEP § 706.07(h)). An amendment or ADS filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively; or

(B) a reissue application or a request for a certificate of correction under 37 CFR 1.323, if appropriate (see MPEP §§ 1402 and 1481), if the application has issued as a patent.

When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement specifying of the prior application unless an incorporation by reference statement specifying of the prior application was presented upon filing of the application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)).

III. DELETING BENEFIT CLAIMS

In certain circumstances, applicants may choose to delete a benefit claim. For applications filed on or after September 16, 2012, applicant may do so by filing a corrected application data sheet in compliance with 37 CFR 1.76(c) that deletes the reference to the prior-filed application. For applications filed prior to September 16, 2012, applicant may do so by amending the specification (if the benefit claim is in the specification) or by submitting a supplemental application data sheet in compliance with pre-AIA 37 CFR 1.76(c) to delete any references to prior applications.

The examiner should consider whether any new prior art may now be available if a benefit claim is deleted. If an applicant is submitting an amendment to the specification or an ADS to delete a benefit claim after final rejection or action, the amendment or ADS will be treated under 37 CFR 1.116 (see MPEP § 714.12 and § 714.13). If the amendment or ADS to delete a benefit claim is submitted after the application has been allowed, the amendment or ADS will be treated under 37 CFR 1.312 (see MPEP § 714.16). A deletion of a benefit claim will not delay the publication of the application unless the amendment or ADS is recognized by the Office within nine weeks prior to the projected publication date that was originally calculated based on the benefit claim.

A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional. The correction or entry of the data in the PALM data

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base can be made by technical support staff of the TC. Upon entry of the data, a new PALM bib-data sheet should be placed in the file. See also MPEP § 707.05 and § 1302.09.

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), no amendment may delete the specific reference to a prior application assigned the same application number. (Note: In the CPA, the request is the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78 to every application assigned the same application number identified in the request. Further, in a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and should not be made.)

211.03 Time Period for Making a Claim for Benefit Under 37 CFR 1.78 [R-08.2017]

37 CFR 1.78 specifies: (A) a time period within which a benefit claim to a prior nonprovisional application, international application, international design application, or provisional application must be stated or it is considered waived; and (B) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional application, international application, international design application, or provisional application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a), the benefit claim of the prior application under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, the benefit claim must be made within the later of: (1) four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f); (2) four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage; or (3) sixteen months from the filing date of the prior application. This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121, 365(c), and 386(c) unless a petition to accept an unintentionally delayed benefit claim is granted. See MPEP § 211.04.

If the application is a design application, the claim under 35 U.S.C. 120, 121, 365(c), or 386(c) for the benefit of a prior-filed application must be submitted during the pendency of the later-filed application.

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78 (e.g., if the benefit claim is not present in the proper place but is included in an oath or declaration, or the application transmittal letter, or in the first sentence(s) of the specification for an application filed on or after September 16, 2012) within the time period set forth in 37 CFR 1.78, the Office will not require a petition and the petition fee under 37 CFR 1.17(m) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on the first filing receipt. This is because the application will have been scheduled for publication on the basis of such information concerning the benefit claim. Applicant must still submit the benefit claim in the manner specified in 37 CFR 1.78 (i.e., in an ADS in compliance with 37 CFR 1.76 (or for applications filed prior to September 16, 2012 by an amendment to the first sentence(s) of the specification or in an ADS in compliance with pre-AIA 37 CFR 1.76) to have a proper claim under 35 U.S.C. 120 or 119(e) and 37 CFR 1.78 to the benefit of a prior application. If, however, an applicant includes a benefit claim elsewhere in the application and the claim is not recognized by the Office as shown by its absence on the first filing receipt, the Office will require a petition and the petition fee under 37 CFR 1.17(m) to correct the benefit claim if the correction is sought after expiration of the time period set in 37 CFR 1.78. This is because the application will not have been scheduled for publication on the basis of the information concerning the benefit claim contained elsewhere in the application.

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A petition under 37 CFR 1.78 and the petition fee would not be required for correcting a timely submitted benefit claim for the following situations:

(A) Changing the relationship of the applications (e.g., changing from "continuation" or "divisional" to "continuation-in-part" or from "continuation-in-part" to "continuation" or "divisional");

(B) Changing the filing date of a prior-filed nonprovisional or provisional application; and

(C) Changing a benefit claim of a prior-filed provisional application under 35 U.S.C. 120 (e.g., "This application is a continuation of prior-filed provisional application No. ---") to a benefit claim of the same provisional application under 35 U.S.C. 119(e) (e.g., "This application claims the benefit of prior-filed provisional application No. ---") during the pendency of the later-filed application. Note, however: If the later-filed application has issued as a patent, the correction cannot be made by a certificate of correction and would not be effective in a reissue application because the term of a patent is measured from the prior application's filing date and removing the benefit claim under 35 U.S.C. 120, 121, 365(c), or 386(c) would have the effect of lengthening the term of the patent.

If a benefit claim is filed after the required time period and without a petition as required by 37 CFR 1.78, the applicant should be informed that the benefit claim was not entered and that a petition needs to be filed using form paragraph 2.39.

¶ 2.39 35 U.S.C. 119(e), 120, 121, or 365(c), or 386(c) Benefit Claim is Untimely

The benefit claim filed on **[1]** was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78. If the application is an application filed under 35 U.S.C. 111(a), the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior application. If the application was filed before September 16, 2012, the reference must be included in the first sentence(s) of the specification following the title or in an application data sheet; if the application was filed on or after September 16, 2012, the specific reference must be included in an application data sheet. For benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. See 37 CFR 1.78(a) for benefit claims under 35 U.S.C. 119(e) and 37 CFR 1.78(d) for benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c).

If applicant desires the benefit under 35 U.S.C. 119(e), 120, 121, 365(c) or 386(c) based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(c) for benefit claims under 35 U.S.C. 119(e) or under 37 CFR 1.78(e) for benefit claims under 35 U.S.C. 120, 121, 365(c), or 386(c). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78 to the prior application (unless previously submitted); (2) a petition fee under 37 CFR 1.17(m); and (3) a statement that the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for original applications filed under 35 U.S.C. 111(a) on or after November 29, 2000 and for national stage applications under 35 U.S.C. 371. DO NOT use for design applications.

2. In bracket 1, insert the filing date of the amendment or paper containing the benefit claim.

3. Do not use this form paragraph if the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78, but not in the location of the application as required by 37 CFR 1.78 (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt. In this situation, the petition under 37 CFR 1.78 and the petition fee under 37 CFR 1.17(m) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78 by filing an amendment to the first sentence(s) of the specification (only if the application was filed before September 16, 2012) or an ADS. The reference is required in the ADS if the application was filed on or after September 16, 2012. See MPEP § 210, subsection I and MPEP § 211.03.

211.04 Delayed Benefit Claims [R-08.2017]

If the reference required by 35 U.S.C. 120 and 37 CFR 1.78 is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 120 and 37 CFR 1.78 to the prior application

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(unless previously submitted); (B) a petition fee under 37 CFR 1.17(m); and (C) a statement that the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(e).

Effective May 13, 2015, 37 CFR 1.78(d)(3) was amended to make the procedures under 37 CFR 1.78(e) to accept an unintentionally delayed benefit claim applicable to design applications where the benefit claim was not submitted during the pendency of the design application. Thus, a petition under 37 CFR 1.78(e) may be filed along with a request for certificate of correction after patent grant. See MPEP § 1481.03.

Likewise, if the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78 is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78 to the prior provisional application (unless previously submitted); (B) a petition fee under 37 CFR 1.17(m); and (C) a statement that the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(c).

Effective December 18, 2013,35 U.S.C. 119(e)(1) no longer requires that the amendment containing the specific reference to the earlier filed provisional application be submitted during the pendency of the application. Therefore, a petition to revive is no longer required to add or correct a benefit claim under 35 U.S.C. 119(e) in an abandoned nonprovisional application filed on or after November 29, 2000. Applicant may simply file a petition under 37 CFR 1.78 to accept an unintentionally delayed claim for the benefit of a prior-filed provisional application in the abandoned nonprovisional application. It may be necessary to correct the benefit in the abandoned nonprovisional application so that the benefit claims in a later filed nonprovisional application claiming benefit of the abandoned nonprovisional application are proper.

Petitions for an unintentionally delayed benefit claim should be forwarded to the Office of Petitions. See MPEP § 1002.02(b).

DELAYED SUBMISSION OF BENEFIT CLAIM IN INTERNATIONAL APPLICATION

A petition under 37 CFR 1.78 for accepting an unintentionally delayed benefit claim and the petition fee under 37 CFR 1.17(m) are required to add a benefit claim under 35 U.S.C. 120 and 365(c) in an abandoned international application designating the United States, even when the international application did not enter the national stage under 35 U.S.C. 371. For example, when filing a "bypass" continuation application under 35 U.S.C. 111(a) that claims the benefit of an international application designating the United States that could have but did not claim the benefit of an earlier U.S. application, and the benefit claim is to be added to the international application, a petition under 37 CFR 1.78 must be filed in the international application.

If a petition under 37 CFR 1.78(c) or (e) is required in an international application that was not filed with the United States Receiving Office and is not a nonprovisional application, then the petition may be filed in the earliest nonprovisional application that claims benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the international application and will be treated as having been filed in the international application. See 37 CFR 1.78(i).

211.05 Sufficiency of Disclosure in Prior-Filed Application [R-08.2017]

I. DISCLOSURE REQUIREMENT

To be entitled to the benefit of the filing date of an earlier-filed application, the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or earlier-filed nonprovisional application or provisional application for which benefit is claimed); the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of 35

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U.S.C. 112(a) except for the best mode requirement. See *Transco Prods., Inc. v. Performance Contracting, Inc.,* 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Accordingly, the disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112(a) except for the best mode requirement.

A. Claiming the Benefit of Provisional Applications

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.,* 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the benefit date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. 112¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

In *New Railhead,* the patented drill bit was the subject of a commercial offer for sale. A provisional application was filed after the sale offer, but well within the one year grace period of 35 U.S.C. 102(b). A nonprovisional application, which issued as Patent No. 5,899,283, was filed within one year of the filing of the provisional application but more than one year after the sale offer. If the '283 patent was not afforded the benefit date of the provisional application, the patent would be invalid under 35 U.S.C. 102(b) since it was filed more than one year after the commercial offer for sale. The court looked at claim 1 of the '283 patent which recites a bit body being angled with respect to the sonde housing. The court then reviewed the provisional application and concluded that nowhere in the provisional application is the bit body expressly described as "being angled with respect to the sonde housing" as recited in claim 1 of the '283 patent. The court held that the disclosure of the provisional application does not adequately support the invention claimed in the '283 patent as to the angle limitation and therefore, the '283 patent is not entitled to the filing date of the provisional application under 35 U.S.C. 119(e)(1) and the '283 patent is invalid under 35 U.S.C. 102(b).

A claim is not required in a provisional application. However, for a claim in a later filed nonprovisional application to be entitled to the benefit of the filing date of the provisional application, the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter of the claim in the later filed nonprovisional application. If a claim in the nonprovisional application is not adequately supported by the written description and drawing(s) (if any) of the provisional application (as in *New Railhead*), that claim in the nonprovisional application is not entitled to the benefit of the filing date of the provisional application. If the filing date of the earlier provisional application is necessary, for example, in the case of an interference or to overcome a reference, care must be taken to ensure that the disclosure filed as the provisional application adequately provides (1) a written description of the subject matter of the claim(s) at issue in the later filed nonprovisional application, and (2) an enabling disclosure to permit one of ordinary skill in the art to make and use the claimed invention in the later filed nonprovisional application without undue experimentation.

B. Claiming the Benefit of Nonprovisional Applications

The disclosure of a continuation application must be the same as the disclosure of the prior-filed application; i.e., the continuation must not include anything which would constitute new matter if inserted in the original application. See MPEP § 201.07. The disclosure of a divisional application must be the same as the disclosure of the prior-filed application, or include at least that portion of the disclosure of the prior-filed application that is germane to the invention claimed in the divisional application. See MPEP § 201.06. The disclosure of a continuation or divisional application cannot include anything which would constitute new matter if inserted in the prior-filed application. A continuation-in-part application may include matter

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not disclosed in the prior-filed application. See MPEP § 201.08. Only the claims of the continuation-in-part application that are disclosed in the manner provided by 35 U.S.C. 112(a) in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by 35 U.S.C. 112(a) in order for the later-filed application to be entitled to the benefit of the earliest filing date.

Under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112(a) except for the best mode requirement, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.,* 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber,* 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112(a) except for the best mode requirement for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.,* 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997).

A claim in the later-filed application is not entitled to the benefit of the filing date of the prior-filed application if the disclosure of the prior-filed application does not enable one skilled in the art to "use" the claimed invention. See *In re Hafner,* 410 F.2d 1403, 1406, 161 USPQ 783, 786 (CCPA 1969) ("[T]o be entitled to the benefits provided by [35 U.S.C. 120], the invention disclosed in the "previously filed" application must be described therein in such a manner as to satisfy *all* the requirements of the first paragraph of [35 U.S.C.] 112, including that which requires the description to be sufficient to enable one skilled in the art to *use* the [invention].").

Where the prior application (a nonprovisional application) is found to be fatally defective because of insufficient disclosure to support allowable claims, a later-filed application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. *Hunt Co. v. Mallinckrodt Chemical Works,* 177 F.2d 583, 587, 83 USPQ 277, 281 (2d Cir. 1949) and cases cited therein. Any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application. See, e.g., *In re Chu,* 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.,* 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Van Lagenhoven,* 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972).

By way of further illustration, if the claims of a continuation-in-part application which are only entitled to the continuation-in-part filing date "read on" published, publicly used or sold, or patented subject matter (e.g., as in a genus-species relationship) a rejection under 35 U.S.C. 102 would be proper. Cases of interest in this regard are as follows: *Mendenhall v. Cedarapids Inc.,* 5 F.3d 1557, 28 USPQ2d 1081 (Fed. Cir. 1993); *In re Lukach,* 442 F.2d 967, 169 USPQ 795 (CCPA 1971); *In re Hafner,* 410 F.2d 1403, 161 USPQ 783 (CCPA 1969); *In re Ruscetta,* 255 F.2d 687, 118 USPQ 101 (CCPA 1958); *In re Steenbock,* 83 F.2d 912, 30 USPQ 45 (CCPA 1936); and *Ex parte Hageman,* 179 USPQ 747 (Bd. App. 1971).

Form paragraphs 2.09 and 2.10 should be used where the claims of the later-filed application are not adequately disclosed or enabled by the disclosure of the prior application.

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¶ 2.09 Heading for Conditions for Benefit Claims Under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c)

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, 365(c), or 386(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. **[1]** as follows:

Examiner Note:

1. In bracket 1, insert the appropriate statutory section(s).

2. One or more of form paragraphs 2.10 to 2.11.01 or 2.38 to 2.40 must follow depending upon the circumstances.

¶ 2.10 Disclosure of Prior-Filed Application Does Not Provide Support for Claimed Subject Matter

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or earlier-filed nonprovisional application or provisional application for which benefit is claimed). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of 35 U.S.C. 112(a) or the first paragraph of pre-AIA 35 U.S.C. 112, except for the best mode requirement. See *Transco Products, Inc. v. Performance Contracting, Inc*., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. **[1]**, fails to provide adequate support or enablement in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for one or more claims of this application. **[2]**

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.

2. This form paragraph may be used when there is lack of support or enablement in the prior-filed application for the claims in the application that is claiming the benefit of the prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c) or under 35 U.S.C. 119(e). The prior-filed application can be a provisional application, a nonprovisional application, an international application (PCT) that designates the United States, or an international design application that designates the United States.

3. In bracket 1, insert the application number of the prior-filed application.

4. In bracket 2, provide an explanation of lack of support or enablement. If only some of the claims are not entitled to the benefit of the filing date of the prior application, the examiner should include a list of those claims after the explanation (e.g., "Accordingly, claims 1-10 are not entitled to the benefit of the prior application.").

Form paragraph 2.10.01 should be used where applicant is claiming the benefit of a prior nonprovisional application under 35 U.S.C. 120, 121, or 365(c) and the relationship (continuation or divisional) of the applications should be changed to continuation-in-part because the disclosure of the later-filed application contains matter not disclosed in the prior-filed nonprovisional application.

¶ 2.10.01 Continuation or Divisional Application Contains New Matter Relative to the Prior-Filed Application

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to delete the benefit claim or change the relationship (continuation or divisional application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: **[1]**.

Examiner Note:

1. This form paragraph should be used when an application, which claims the benefit of a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 386(c) contains new matter relative to the prior-filed application, and purports to be a "continuation," "division," or "divisional application" of the prior-filed application. Do not use this form paragraph if the applicant is claiming the benefit of a provisional application under 35 U.S.C. 119(e).

2. In bracket 1, provide an example of the matter not disclosed in the prior-filed application.

II. CRITICAL REFERENCE DATE OF PATENT CLAIMING THE BENEFIT OF AN EARLIER FILED APPLICATION

See MPEP § 2154.01(b) and MPEP § 2136.03 for discussion of when an issued patent, patent application publication under 35 U.S.C. 122(b), or application deemed published under 35 U.S.C. 122(b) is available as a reference under 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e) as of a prior provisional or nonprovisional application's filing date.

212 [Reserved]

213 Right of Priority of Foreign Application [R-08.2017]

Under certain conditions and on fulfilling certain requirements, an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country. The conditions are specified in 35 U.S.C. 119(a)-(d) and (f), 172, 365(a) and (b), and 386(a) and (b), and 37 CFR 1.55.

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35 U.S.C. 119 Benefit of earlier filing date; right of priority.

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7) , pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

*****

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

*****

37 CFR 1.55 Claim for foreign priority.

(a) *In general.* An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) and (b), and 386(a) and (b) and this section.

(b) *Time for filing subsequent application.* The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) *Delayed filing of subsequent application.* If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26 *bis*.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b) , or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) *Time for filing priority claim—*

(1) *Application under 35 U.S.C. 111(a).* The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in

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paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) *Application under 35 U.S.C. 371.* The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

(e) *Delayed priority claim.* Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or 386(b), or 386(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Time for filing certified copy of foreign application—*

(1) *Application under 35 U.S.C. 111(a).* A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.*

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

(h) *Certified copy in another U.S. patent or application.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered

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satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

(i) *Foreign intellectual property office participating in a priority document exchange agreement.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

(j) *Interim copy.* The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

(k) *Requirements for certain applications filed on or after March 16, 2013.* If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(l) *Inventor's certificates.* An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor’s certificate, had the option to file an application for either a patent or an inventor’s certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application designating the United States, the claim for priority

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may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

(n) *Applications filed before September 16, 2012.* Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§ 1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under § 1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

(o) *Priority under 35 U.S.C. 386(a) or (b).* The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

(p) *Time periods in this section.* The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

Implementation of Public Law 112-211, 126 Stat. 1527 (titles I and title II of the Patent Law Treaties Implementation Act (PLTIA)), necessitated changes to the procedural requirements relating to claims for priority to an earlier-filed foreign application and to the submission of a certified copy of the priority document. The conditions for claiming priority to an earlier-filed foreign application are summarized below:

(A) The foreign application must be one filed in "a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States or in a WTO member country." See MPEP § 213.01.

(B) The foreign application must have been filed by the same applicant as the applicant in the United States, or by applicant's legal representatives or assigns. Consistent with longstanding Office policy, this is interpreted to mean that the U.S. and foreign applications must name the same inventor or have at least one joint inventor in common. See MPEP § 213.02.

(C) The application, or its earliest parent United States application under 35 U.S.C. 120, must have been filed in a "recognized" country (see MPEP § 213.01) within 12 months from the date of the earliest foreign filing unless the right of priority has been restored (see MPEP § 213.03). However, the period of 12 months specified in this section is 6 months in the case of designs pursuant to 35 U.S.C. 172. See MPEP §§ 1504.10 and 2920.05(d).

(D) The foreign application must be for the same invention as the application in the United States.

(E) For an original application filed under 35 U.S.C. 111(a) (other than a design application), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. See MPEP § 214.01.

(F) For applications entering the national stage under 35 U.S.C. 371 from an international application, the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set forth in the PCT Articles and Regulations.

(G) For a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet during the pendency of the application. See 37 CFR 1.55(m). In addition, the right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application can only be claimed in a nonprovisional, international, or international design application filed on or after May 13, 2015. See 37 CFR 1.55(o).

(H) In the case where the basis of the claim is an application for an inventor's certificate, the requirements of 37 CFR 1.55(l) must also be met. See MPEP § 213.05.

(I) A certified copy of the foreign application must be filed within the time period set forth in 37 CFR 1.55. See MPEP § 215.02 *et seq*. for applications filed on or after March 16, 2013, and MPEP § 215.03 for applications filed before March

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16, 2013. The claim for priority and the certified copy of the foreign application must, in any event, be filed within the pendency of the application and before the patent is granted. See MPEP § 213.04.

(J) If a nonprovisional application (other than a nonprovisional international design application) filed on or after March 16, 2013, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date (as defined in 35 U.S.C. 100(i)) on or after March 16, 2013, the applicant must provide a statement to that effect within a specified time period. See 37 CFR 1.55(k) and MPEP § 210, subsection III.

Applicant may be informed of possible priority rights under 35 U.S.C. 119(a)-(d) and (f) by using the wording of form paragraph 2.18.

¶ 2.18 Right of Priority Under 35 U.S.C. 119(a)-(d) and (f)

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d) and (f), wherein an application for patent filed in the United States may be entitled to claim priority to an application filed in a foreign country.

213.01 Recognized Countries and Regional Patent Offices of Foreign Filing [R-08.2017]

The right to rely on a foreign application is known as the right of priority in international patent law and this phrase has been adopted in the U.S. statute. The right of priority originated in a multilateral treaty of 1883, to which the United States adhered in 1887, known as the Paris Convention for the Protection of Industrial Property (Paris Convention). The treaty is administered by the World Intellectual Property Organization (WIPO) at Geneva, Switzerland. This treaty has been revised several times, the latest revision in effect being written in Stockholm in July 1967 (copy at Appendix P of this Manual). Articles 13-30 of the Stockholm Revision became effective on September 5, 1970. Articles 1-12 of the Stockholm Revision became effective on August 25, 1973. One of the many provisions of the Paris Convention requires each of the adhering countries to accord the right of priority to the nationals of the other countries and the first United States statute relating to this subject was enacted to carry out this obligation. A foreign country may also provide for this right by reciprocal legislation.

I. LIST OF RECOGNIZED COUNTRIES

Following is a table of states, i.e., countries, with respect to which the right of priority referred to in 35 U.S.C. 119(a)-(d) has been recognized. The table indicates whether a basis for priority is that the state is party to the Patent Cooperation Treaty (PCT) or the Paris Convention for the Protection of Industrial Property (Paris), or a member of the World Trade Organization (WTO). See 35 U.S.C. 119(a). See **www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_paris_wto.pdf** for the most current version of the table reproduced below. See also **www.wto.org/english/thewto_e /whatis_e/tif_e/org6_e.htm** for a current list of WTO member countries along with their dates of membership. Applications for plant breeder's rights filed in WTO member countries and foreign UPOV contracting parties may be relied upon for priority pursuant to 35 U.S.C. 119(f). See MPEP §§ 1612 and 1613.

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States Party to the PCT and the Paris Convention and Members of the World Trade Organization[1]
(status on 27 February 2017)

States/Members	PCT (151)	Paris (177)	WTO[2] (164)	States/Members	PCT	Paris	WTO
Afghanistan (AF)	–	X[3]	X	Canada (CA)	X	X	X
Albania (AL)	X	X	X	Central African Republic (CF)	X	X	X
Algeria (DZ)	X	X	–	Chad (TD)	X	X	X
Andorra (AD)	–	X	–	Chile (CL)	X	X	X
Angola (AO)	X	X	X	China (CN)	X[4]	X[4,5]	X
Antigua and Barbuda (AG)	X	X	X	Colombia (CO)	X	X	X
Argentina (AR)	–	X	X	Comoros (KM)	X	X	–
Armenia (AM)	X	X	X	Congo (CG)	X	X	X
Australia (AU)	X	X	X	Costa Rica (CR)	X	X	X
Austria (AT)	X	X	X	Côte d'Ivoire (CI)	X	X	X
Azerbaijan (AZ)	X	X	–	Croatia (HR)	X	X	X
Bahamas (BS)	–	X	–	Cuba (CU)	X	X	X
Bahrain (BH)	X	X	X	Cyprus (CY)	X	X	X
Bangladesh (BD)	–	X	X	Czech Republic (CZ)	X	X	X
Barbados (BB)	X	X	X	Democratic People's Republic of Korea (KP)	X	X	–
Belarus (BY)	X	X	–	Democratic Republic of the Congo (CD)	–	X	X
Belgium (BE)	X	X	X	Denmark (DK)	X	X	X
Belize (BZ)	X	X	X	Djibouti (DJ)	X	X	X
Benin (BJ)	X	X	X	Dominica (DM)	X	X	X
Bhutan (BT)	–	X	–	Dominican Republic (DO)	X	X	X
Bolivia (Plurinational State of) (BO)	–	X	X	Ecuador (EC)	X	X	X
Bosnia and Herzegovina (BA)	X	X	–	Egypt (EG)	X	X	X
Botswana (BW)	X	X	X	El Salvador (SV)	X	X	X
Brazil (BR)	X	X	X	Equatorial Guinea (GQ)	X	X	–
Brunei Darussalam (BN)	X	X	X	Estonia (EE)	X	X	X
Bulgaria (BG)	X	X	X	European Union (EU)	–	–	X
Burkina Faso (BF)	X	X	X	Fiji (FJ)	–	–	X
Burundi (BI)	–	X	X	Finland (FI)	X	X	X
Cabo Verde (CV)	–	–	X	France (FR)	X	X	X
Cambodia (KH)	X	X	X	Gabon (GA)	X	X	X
Cameroon (CM)	X	X	X	Gambia (GM)	X	X	X

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States Party to the PCT and the Paris Convention and Members of the World Trade Organization
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States/Members	PCT	Paris	WTO	States/Members	PCT	Paris	WTO
Georgia (GE)	X	X	X	Lesotho (LS)	X	X	X
Germany (DE)	X	X	X	Liberia (LR)	X	X	X
Ghana (GH)	X	X	X	Libya (LY)	X	X	–
Greece (GR)	X	X	X	Liechtenstein (LI)	X	X	X
Grenada (GD)	X	X	X	Lithuania (LT)	X	X	X
Guatemala (GT)	X	X	X	Luxembourg (LU)	X	X	X
Guinea (GN)	X	X	X	Macao, China (MO)	–	–[5]	X
Guinea–Bissau (GW)	X	X	X	Madagascar (MG)	X	X	X
Guyana (GY)	–	X	X	Malawi (MW)	X	X	X
Haiti (HT)	–	X	X	Malaysia (MY)	X	X	X
Holy See (VA)	–	X	–	Maldives (MV)	–	–	X
Honduras (HN)	X	X	X	Mali (ML)	X	X	X
Hong Kong, China (HK)	–[4]	–[4]	X	Malta (MT)	X	X	X
Hungary (HU)	X	X	X	Mauritania (MR)	X	X	X
Iceland (IS)	X	X	X	Mauritius (MU)	–	X	X
India (IN)	X	X	X	Mexico (MX)	X	X	X
Indonesia (ID)	X	X	X	Monaco (MC)	X	X	–
Iran (Islamic Republic of) (IR)	X	X	–	Mongolia (MN)	X	X	X
Iraq (IQ)	–	X	–	Montenegro (ME)	X	X	X
Ireland (IE)	X	X	X	Morocco (MA)	X	X	X
Israel (IL)	X	X	X	Mozambique (MZ)	X	X	X
Italy (IT)	X	X	X	Myanmar (MM)	–	–	X
Jamaica (JM)	–	X	X	Namibia (NA)	X	X	X
Japan (JP)	X	X	X	Nepal (NP)	–	X	X
Jordan (JO)	–	X	X	Netherlands (NL)	X	X	X
Kazakhstan (KZ)	X	X	X	New Zealand (NZ)	X	X	X
Kenya (KE)	X	X	X	Nicaragua (NI)	X	X	X
Kuwait (KW)	X	X	X	Niger (NE)	X	X	X
Kyrgyzstan (KG)	X	X	X	Nigeria (NG)	X	X	X
Lao People's Democratic Republic (LA)	X	X	X	Norway (NO)	X	X	X
Latvia (LV)	X	X	X	Oman (OM)	X	X	X
Lebanon (LB)	–	X	–	Pakistan (PK)	–	X	X

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(status on 27 February 2017)

States/Members	PCT	Paris	WTO	States/Members	PCT	Paris	WTO
Panama (PA)	X	X	X	Sudan (SD)	X	X	–
Papua New Guinea (PG)	X	X	X	Suriname (SR)	–	X	X
Paraguay (PY)	–	X	X	Swaziland (SZ)	X	X	X
Peru (PE)	X	X	X	Sweden (SE)	X	X	X
Philippines (PH)	X	X	X	Switzerland (CH)	X	X	X
Poland (PL)	X	X	X	Syrian Arab Republic (SY)	X	X	–
Portugal (PT)	X	X	X	Taiwan Province of China (TW)[6]	–	–	X
Qatar (QA)	X	X	X	Tajikistan (TJ)	X	X	X
Republic of Korea (KR)	X	X	X	Thailand (TH)	X	X	X
Republic of Moldova (MD)	X	X	X	The former Yugoslav Republic of Macedonia (MK)	X	X	X
Romania (RO)	X	X	X	Togo (TG)	X	X	X
Russian Federation (RU)	X	X	X	Tonga (TO)	–	X	X
Rwanda (RW)	X	X	X	Trinidad and Tobago (TT)	X	X	X
Saint Kitts and Nevis (KN)	X	X	X	Tunisia (TN)	X	X	X
Saint Lucia (LC)	X	X	X	Turkey (TR)	X	X	X
Saint Vincent and the Grenadines (VC)	X	X	X	Turkmenistan (TM)	X	X	–
Samoa (WS)	–	X	X	Uganda (UG)	X	X	X
San Marino (SM)	X	X	–	Ukraine (UA)	X	X	X
Sao Tome and Principe (ST)	X	X	–	United Arab Emirates (AE)	X	X	X
Saudi Arabia (SA)	X	X	X	United Kingdom (GB)	X	X	X
Senegal (SN)	X	X	X	United Republic of Tanzania (TZ)	X	X	X
Serbia (RS)	X	X	–	United States of America (US)	X	X	X
Seychelles (SC)	X	X	X	Uruguay (UY)	–	X	X
Sierra Leone (SL)	X	X	X	Uzbekistan (UZ)	X	X	–
Singapore (SG)	X	X	X	Vanuatu (VU)	–	–	X
Slovakia (SK)	X	X	X	Venezuela (Bolivarian Republic of) (VE)	–	X	X
Slovenia (SI)	X	X	X	Viet Nam (VN)	X	X	X
Solomon Islands (SB)	–	–	X	Yemen (YE)	–	X	X
South Africa (ZA)	X	X	X	Zambia (ZM)	X	X	X
Spain (ES)	X	X	X	Zimbabwe (ZW)	X	X	X
Sri Lanka (LK)	X	X	X				

1. Under PCT Rule 4.10(a), it is possible to claim in an international application the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property, or in or for any Member of the World Trade Organization (WTO) that is not party to that Convention.
2. WTO Members cannot necessarily become party to the Paris Convention or the PCT.
3. Will become party to the Paris Convention on 14 May 2017.
4. China has notified the Director General of WIPO that the Paris Convention and the PCT apply also to Hong Kong, China.
5. China has notified the Director General of WIPO that the Paris Convention applies also to Macao, China.
6. Also referred to by the WTO as “Chinese Taipei” or “Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu”.

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Note that the United States and Taiwan signed an agreement on priority for patent and trademark applications on April 10, 1996, and as of that date Taiwan is a country for which the right of priority is recognized in the United States. Taiwan became a member of the WTO on January 1, 2002.

If any applicant asserts the benefit of the filing date of an application filed in a country not on this list, the examiner should contact the Office of Policy and International Affairs to determine if there has been any change in the status of that country. It should be noted that the right is based on the *country* of the foreign filing and not upon the citizenship of the applicant.

II. RIGHT OF PRIORITY BASED UPON AN INTERNATIONAL APPLICATION FILED UNDER THE PATENT COOPERATION TREATY

35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional 2-month period specified under section 119(a) or the treaty and Regulations.

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35 U.S.C. 365(a) provides that a national application shall be entitled to the right of priority based on a prior international application of whatever origin, which designated any country other than, or in addition to, the United States. Of course, the conditions prescribed by 35 U.S.C. 119(a)-(d), which deals with the right of priority based on earlier filed foreign applications, must be complied with.

35 U.S.C. 365(b) provides that an international application designating the United States shall be entitled to the right of priority of a prior foreign application which may either be another international application or a regularly filed foreign application. The international application upon which the claim of priority is based can either have been filed in the United States or a foreign country; however, it must contain the designation of at least one country other than, or in addition to, the United States.

As far as the actual place of filing is concerned, for the purpose of 35 U.S.C. 365(a) and (b) and 35 U.S.C. 119(a)-(d) and (f), an international application designating a country is considered to be a national application regularly filed in that country on the international filing date irrespective of whether it was physically filed in that country, in another country, or in an intergovernmental organization acting as Receiving Office for a country.

III. RIGHT OF PRIORITY BASED UPON AN INTERNATIONAL DESIGN APPLICATION

35 U.S.C. 386 Right of priority.

(a) NATIONAL APPLICATION.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.

(b) PRIOR FOREIGN APPLICATION.—In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

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Pursuant to 35 U.S.C. 386(a) and 37 CFR 1.55, a nonprovisional application may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 with respect to a prior international design application that designates at least one country other than the United States. Pursuant to 35 U.S.C. 386(b) and 37 CFR 1.55, an international design application designating the United States may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 and the Hague Agreement and Regulations thereunder with respect to a prior foreign application,

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international application (PCT) designating at least one country other than the United States, or a prior international design application designating at least one country other than the United States. The provisions of 35 U.S.C. 386(a) and (b) apply to nonprovisional applications, international applications (PCT) and international design applications filed on or after May 13, 2015, and patents issued therefrom. See 37 CFR 1.55(o) and MPEP §§ 213 *et seq.* and 1504.10.

See MPEP § 2920.05(d) for additional information pertaining to the right of priority based upon an international design application.

IV. RIGHT OF PRIORITY (35 U.S.C. 119(a)-(d), 365(a)-(b), AND 386(a)-(b)) BASED ON A FOREIGN APPLICATION FILED UNDER A BILATERAL OR MULTILATERAL TREATY

Under Article 4A of the Paris Convention for the Protection of Industrial Property, a right of priority may be based on an application for a patent or for the registration of a utility model or an industrial design filed under the national law of a foreign country adhering to the Convention, or on a foreign application filed under a bilateral or multilateral treaty concluded between two or more such countries. Examples of such treaties pertaining to the protection of designs are The Hague Agreement Concerning the International Registration of Industrial Designs, the Benelux Designs Convention, and the Office for Harmonization in the Internal Market (OHIM) as created under European Union law. Treaties pertaining to utility and/or plant patents include The Convention on the Grant of European Patents (which established the European Patent Office), the Patent Cooperation Treaty, and the International Convention for the Protection of New Varieties of Plants (UPOV).

In addition to the list of recognized countries set forth in subsection I, above, applicants may claim priority under 35 U.S.C. 119(a)-(d) to applications filed in foreign regional patent offices having member states who are contracting states under the Patent Cooperation Treaty (PCT). These include the African Regional Intellectual Property Organization (ARIPO), the Eurasian Patent Office (EAPO), the European Patent Office (EPO), and the African Intellectual Property Organization (known under the acronym OAPI for its French name, *Organisation Africaine de la Propriété Intellectuelle*).

213.02 Formal Requirements Relating to Foreign Priority Application [R-08.2017]

I. IDENTIFICATION OF FOREIGN APPLICATION

For original applications filed under 35 U.S.C. 111(a), the claim for foreign priority must identify the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. For international applications entering the national stage as to the Unites States, see MPEP § 213.06. For international design applications designating the United States, see MPEP § 2920.05(d).

For applications filed under 35 U.S.C. 111(a) on or after September 16, 2012, the claim for priority must be presented in an application data sheet. See 37 CFR 1.55(d)(1). 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. In an international application entering the national stage under 35 U.S.C. 371, the claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(d)(2). Note that it is permissible, but not required, to present the claim for priority in an application data sheet in an international application entering the national stage under 35 U.S.C. 371. For international design applications designating the United States, the claim for priority must be presented in an application data sheet unless the priority claim was made in accordance with the Hague Agreement and the Hague Agreement Regulations. See 37 CFR 1.55(m).

For applications filed prior to September 16, 2012, the claim to priority need be in no special form, and may be made by a person authorized to sign correspondence under 37 CFR 1.33(b). No special language is required in making the claim for priority, and any expression which can be reasonably interpreted as claiming the benefit of the foreign application is accepted as the claim for priority. For applications filed prior to September 16, 2012, the

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claim for priority must appear in the oath or declaration under 37 CFR 1.63 or in an application data sheet (37 CFR 1.76). See 37 CFR 1.55(n).

For applications filed on or after September 21, 2004, a claim under 37 CFR 1.55 for priority of a prior-filed foreign application that was present on the filing date of the application is considered an incorporation by reference of the prior-filed foreign priority application as to inadvertently omitted material, subject to the conditions and requirements of 37 CFR 1.57(b). The purpose of 37 CFR 1.57(b) is to provide a safeguard for applicants when all or a portion of the specification and/or drawing(s) is (are) inadvertently omitted from an application. See MPEP §§ 201.06(c) and 217. However, applicants are encouraged to provide an explicit incorporation by reference statement to the prior-filed foreign priority application(s) for which priority is claimed under 37 CFR 1.55 if applicants do not wish the incorporation by reference to be limited to inadvertently omitted material pursuant to 37 CFR 1.57(b). See 37 CFR 1.57(c). Thus, the incorporation by reference statement can be relied upon to permit the entering of a portion of the foreign priority application into the U.S. application when a portion of the foreign priority application has been inadvertently omitted from the U.S. application, or to permit the correction of translation error in the U.S. application where the foreign priority application is in a non-English language. See MPEP § 217 for additional information regarding 37 CFR 1.57(b), and MPEP § 608.01(p) for information regarding incorporation by reference statements. For information regarding 37 CFR 1.57(a) and filing by reference to a previously filed application, see MPEP § 601.01(a), subsection III.

II. THE SAME INVENTOR OR AT LEAST ONE COMMON JOINT INVENTOR

Pursuant to 35 U.S.C. 119(a), the foreign application must have been filed by the same applicant as the applicant in the United States, or by applicant's legal representatives or assigns. Consistent with longstanding Office policy, this is interpreted to mean that the U.S. and foreign applications must name the same inventor or have at least one joint inventor in common. For example, a right of priority does not exist in the case of an application of sole inventor A in the foreign country and sole inventor B in the United States, even though the two applications may be owned by the same party. The application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor, rather than by the inventor, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. Joint inventors A and B in a nonprovisional application filed in the United States Patent and Trademark Office may properly claim the benefit of an application filed in a foreign country by A and another application filed in a foreign country by B, i.e., A and B may each claim the benefit of their foreign filed applications. See MPEP § 602.09.

III. TRANSITION APPLICATION STATEMENT

If a nonprovisional application filed on or after March 16, 2013, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date (as defined in 35 U.S.C. 100(i)) on or after March 16, 2013, the applicant must provide a statement to that effect within a specified time period. See 37 CFR 1.55(k) and MPEP § 210, subsection III. Nonprovisional international design applications are excluded from the transition provision of 37 CFR 1.55(k), as such applications can only be filed on or after May 13, 2015.

213.03 Time for Filing U.S. Nonprovisional Application [R-08.2017]

The United States nonprovisional application must be filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, unless the right of priority has been restored, or the nonprovisional application must be entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of an application that was filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, unless the right of priority has been restored. See 37 CFR 1.55(c) and subsection III, below. This twelve-month period is subject to 35 U.S.C. 21(b) (and 37 CFR 1.7(a)) and PCT Rule 80.5, and the six month period is subject to 35 U.S.C.

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21(b), 37 CFR 1.7(a), and Hague Agreement Rule 4(4).

35 U.S.C. 21(b) and 37 CFR 1.7(a) provide that when the day, or the last day, for taking an action (e.g., filing a nonprovisional application within twelve months of the date on which the foreign application was filed) or paying a fee in the Office falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day. PCT Rule 80.5 has similar provisions relating to the expiration of any period during which any document or fee in an international application must reach a national Office or intergovernmental organization. Hague Agreement Rule 4(4) provides that if the period expires on a day on which the International Bureau or the office concerned is not open to the public, the period shall expire on the first subsequent day on which the International Bureau or the office concerned is open to the public.

In computing this twelve months (or six months in the case of a design application), the first day is not counted; thus, if an application was filed in Canada on January 3, 1983, the U.S. nonprovisional application may be filed on January 3, 1984. The Paris Convention specifies in Article 4C(2) that "the day of filing is not counted in this period." (This is the usual method of computing periods, for example a 6-month period for reply to an Office action dated January 2 does not expire on July 1, but the reply may be made on July 2.) If the last day of the twelve months is a Saturday, Sunday, or federal holiday within the District of Columbia, the U.S. non-provisional application is in time if filed on the next succeeding business day; thus, if the foreign application was filed on September 4, 1981, the U.S. nonprovisional application is in time if filed on September 7, 1982, since September 4, 1982, was a Saturday and September 5, 1982 was a Sunday and September 6, 1982 was a federal holiday. In view of 35 U.S.C. 21, and the Paris Convention which provides "if the last day of the period is an official holiday, or a day on which the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day" (Article 4C(3)), if the twelve months expires on Saturday, the U.S. application may be filed on the following Monday. Note *Ex parte Olah,* 131 USPQ 41 (Bd. App. 1960). See, e.g., *Dubost v. U.S. Patent and Trademark Office,* 777 F.2d 1561, 1562, 227 USPQ 977, 977 (Fed. Cir. 1985).

I. FILING OF PAPERS DURING UNSCHEDULED CLOSINGS OF THE U.S. PATENT AND TRADEMARK OFFICE

37 CFR 1.9(h) provides that the definition of "Federal holiday within the District of Columbia" includes an official closing of the Office. When the entire U.S. Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open. In addition, 37 CFR 1.6(a)(1) provides "[t]he U.S. Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or Federal holiday within the District of Columbia" to clarify that any day that is a Saturday, Sunday or federal holiday within the District of Columbia is a day that the U.S. Patent and Trademark Office is not open for the filing of applications within the meaning of Article 4C(3) of the Paris Convention. Note further that in accordance with 37 CFR 1.6(a)(2), even when the Office is not open for the filing of correspondence on any day that is a Saturday, Sunday or federal holiday within the District of Columbia, correspondence deposited as Priority Mail Express® with the USPS in accordance with 37 CFR 1.10 or filed via EFS-Web will be considered filed on the date of its deposit, regardless of whether that date is a Saturday, Sunday or federal holiday within the District of Columbia (under 35 U.S.C. 21(b) or 37 CFR 1.7).

When the U.S. Patent and Trademark Office is open for business during any part of a business day between 8:30 a.m. and 5:00 p.m., papers are due on that day even though the Office may be officially closed for some period of time during the business day because of an unscheduled event. The procedures of 37 CFR 1.10 may be used for filing applications. Information regarding whether or not the Office is officially closed on any particular day

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may be obtained by calling 1-800-PTO-9199 or (571) 272-1000.

II. FIRST FOREIGN APPLICATION

The twelve months is from earliest foreign filing except as provided in 35 U.S.C. 119(c). If an inventor has filed an application in France on October 4, 1981, and an identical application in the United Kingdom on March 3, 1982, and then files in the United States on February 2, 1983, the inventor is not entitled to the right of priority at all; the inventor would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and the inventor would not be entitled to the benefit of the date of the United Kingdom application since this application is not the first one filed. *Ahrens v. Gray,* 1931 C.D. 9, 402 O.G. 261 (Bd. App. 1929). If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose. 35 U.S.C. 119(c) extends the right of priority to "subsequent" foreign applications if one earlier filed had been withdrawn, abandoned, or otherwise disposed of, under certain conditions.

The United Kingdom and a few other countries have a system of "post-dating" whereby the filing date of an application is changed to a later date. This "post-dating" of the filing date of the application does not affect the status of the application with respect to the right of priority; if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application. See *In re Clamp,* 151 USPQ 423 (Comm'r Pat. 1966).

If an applicant has filed two foreign applications in recognized countries, one outside the year and one within the year, and the later application discloses additional subject matter, a claim in the U.S. application specifically limited to the additional disclosure would be entitled to the date of the second foreign application since this would be the first foreign application for that subject matter.

III. RESTORING THE RIGHT OF PRIORITY

Effective December 18, 2013, title II of the Patent Law Treaties Implementation Act (PLTIA) provides for restoration of the right of priority under 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) or (b). As provided in 37 CFR 1.55(c), if the subsequent application has a filing date which is after the expiration of the twelve-month period (or six-month period in the case of a design application), but within two months from the expiration of the period, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application, or upon petition under 37 CFR 1.55(c), if the delay in filing the subsequent application within the period was unintentional. Thus, an application may now validly claim priority under 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) or (b), or 386(a) or (b) to a foreign application filed up to fourteen months earlier (or eight months earlier in the case of a design application). As a result of title I of the PLTIA, 37 CFR 1.55(c) was amended effective May 13, 2015, to provide that restoration of the right of priority is available for priority claims under 35 U.S.C. 386(a) or (b). In addition, 37 CFR 1.55(c) was amended to provide that a petition to restore the right of priority filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application.

A petition under 37 CFR 1.55(c) requires:

(A) the priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet, identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing (unless previously submitted in an application data sheet);

(B) the petition fee as set forth in 37 CFR 1.17(m); and

(C) a statement that the delay in filing the subsequent application within the twelve-month period (or six-month period in the case of a design application) set forth in 37 CFR 1.55(b) was unintentional.

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The Director may require additional information where there is a question whether the delay was unintentional.

Where the subsequent application is not a nonprovisional application, the Office may not have an application file established for the subsequent application. This would occur, for example, where an international application designating the United States was filed in a foreign Receiving Office and the applicant filed a continuation of an international application under 35 U.S.C. 111(a) rather than entering the national stage under 35 U.S.C. 371. Thus, in this situation, the petition under 37 CFR 1.55(c) may be filed in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application. However, the statement required under 37 CFR 1.55(c)(3) must still relate to the unintentional delay in filing the subsequent application, i.e., the international application.

If a petition under 37 CFR 1.55(c) to restore the right of priority is granted, a further petition under 37 CFR 1.55(c) is not required in an application entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of the subsequent application for which the right of priority was restored. A copy of the decision granting the petition should be filed with any application claiming the benefit of the subsequent application and the foreign application to ensure that the Office recognizes that the right of priority has been restored.

It should be noted that although an application may now validly claim priority under 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) or (b), or 386(a) or (b) to a foreign application filed up to fourteen months earlier (or eight months earlier in the case of a design application) in view of the restoration provision of 37 CFR 1.55(c), an application subject to examination under pre-AIA first to invent laws (rather than the first inventor to file provisions of the AIA) would still be subject to the 12-month statutory time periods in pre-AIA 35 U.S.C. 102(b) and (d) which are measured from the U.S. filing date. Thus, the application may still be subject to a rejection under pre-AIA 35 U.S.C. 102(b) or (d) despite the priority claim. See MPEP §§ 2133 and 2135 et seq.

213.04 Requirement to File Priority Claim and Certified Copy During Pendency of Application [R-07.2015]

37 CFR 1.55 Claim for foreign priority.

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(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.*

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

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37 CFR 1.55(g) sets forth the requirements for filing a priority claim, certified copy of foreign application, and translation that are applicable in all applications. 37 CFR 1.55(g)(1) specifies that the claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under 37 CFR 1.55(e) or (f), or with a petition accompanied by the fee set forth in 37 CFR

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1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. These provisions do not in any way supersede the timing requirements elsewhere in 37 CFR 1.55 for filing a claim for priority and the certified copy of the foreign application. 37 CFR 1.55(g)(1) simply indicates that the claim for priority and the certified copy of the foreign application must be filed in or received by the Office within the pendency of the application in all situations, unless an appropriate petition is filed.

If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323.

In the following situations, the Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in 37 CFR 1.55 (see 37 CFR 1.55(g)(2)), or that an English translation of a non-English language foreign application be filed (see 37 CFR 1.55(g)(3)):

(1) When the application is involved in an interference (see 37 CFR 41.202) or derivation (see 37 CFR part 42) proceeding;

(2) When necessary to overcome the date of a reference relied upon by the examiner; or

(3) When deemed necessary by the examiner.

If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

213.05 Right of Priority Based Upon an Application for an Inventor's Certificate [R-08.2017]

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

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(d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

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37 CFR 1.55 Claim for foreign priority.

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(l) *Inventor's certificates.* An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

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37 CFR 1.55(l) contains the provisions relating to claiming priority to inventor's certificates. An inventor's certificate may form the basis for rights of priority under 35 U.S.C. 119(d) only when the country in which it is filed gives to applicants, at their discretion, the right to apply, on the same invention, either for a patent or for an inventor's certificate. The affidavit or declaration specified under 37 CFR 1.55(l) is only required for the purpose of ascertaining whether, in the country where the application for an inventor's certificate originated, this option generally existed for applicants with respect to the particular subject matter of the invention involved. The requirements of 35 U.S.C. 119(d) and 37 CFR 1.55(l) are not intended, however, to probe into the eligibility of the particular applicant to exercise the option in the particular priority application involved.

It is recognized that certain countries that grant inventors' certificates also provide by law that their own nationals who are employed in state enterprises may only receive inventors' certificates and not patents on inventions made in connection with their employment. This will not impair their right to be granted priority in the United States based on the filing of the inventor's certificate.

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Accordingly, affidavits or declarations filed pursuant to 37 CFR 1.55(l) need only show that in the country in which the original inventor's certificate was filed, applicants generally have the right to apply at their own option either for a patent or an inventor's certificate as to the particular subject matter of the invention. Priority rights on the basis of an inventor's certificate application will be honored only if the applicant had the option or discretion to file for either an inventor's certificate or a patent on the invention in applicant's home country. Certain countries which grant both patents and inventor's certificates issue only inventor's certificates on certain subject matter, generally pharmaceuticals, foodstuffs, and cosmetics.

To ensure compliance with the treaty and statute, 37 CFR 1.55(l) provides that at the time of claiming priority to an inventor's certificate, the applicant must submit an affidavit or declaration stating that the applicant when filing the application for the inventor's certificate had the option either to file for a patent or an inventor's certificate as to the subject matter forming the basis for the claim of priority.

213.06 Claiming Priority and Filing a Certified Copy in a National Stage Application (35 U.S.C. 371) [R-08.2017]

37 CFR 1.55 Claim for foreign priority.

*****

(d) *Time for filing priority claim—*

*****

(2) *Application under 35 U.S.C. 371.* The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

*****

(f) *Time for filing certified copy of foreign application—*

*****

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

*****

PCT Rule 4

The Request (Contents)

*****

4.10 Priority Claim

(a) Any declaration referred to in Article 8(1) ("priority claim") may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of the Organization for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.

(d) If, on September 29, 1999, paragraphs (a) and (b) as amended with effect from January 1, 2000, are not compatible with the national law applied by a designated Office, those paragraphs as in force until December 31, 1999, shall continue to apply after that date in respect of that designated Office for as long as the said paragraphs as amended continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by October 31, 1999. The information received shall be promptly published by the International Bureau in the Gazette.

*****

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PCT Rule 17

The Priority Document

17.1. Obligation to Submit Copy of Earlier National or International Application

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed ("the priority document"), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b -*bis*), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(b -*bis*) Where the priority document is, in accordance with the Administrative Instructions, made available to the International Bureau from a digital library prior to the date of international publication of the international application, the applicant may, instead of submitting the priority document, request the International Bureau, prior to the date of international publication, to obtain the priority document from such digital library.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

17.2. Availability of Copies

(a) Where the applicant has complied with Rule 17.1(a), (b) or (b -*bis*), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

(i) the international application was withdrawn,

(ii) the relevant priority claim was withdrawn or considered, under Rule 26 *bis*.2(b), not to have been made.

37 CFR 1.451 The priority claim and priority document in an international application.

(a) The claim for priority must, subject to paragraph (d) of this section, be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application or international application filed with the United States Receiving Office is claimed in an international application, the applicant may request in the Request or in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office or in a separate letter filed in the United States Receiving Office not later than 16 months after the priority date, that the United States Patent and Trademark Office prepare a certified copy of the prior application for transmittal to the International Bureau (PCT Article 8 and PCT Rule 17). The fee for preparing a certified copy is set forth in § 1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or, if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

(d) The applicant may correct or add a priority claim in accordance with PCT Rule 26 *bis*.1.

37 CFR 1.55(d)(2) and (f)(2) pertain to the time for filing a priority claim and the time for filing a certified copy of a foreign application in an international application entering the national stage under 35 U.S.C. 371.

In an international application entering the national stage under 35 U.S.C. 371, the claim for priority must be made and a certified copy of the foreign application must be filed within the time limit set

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forth in the PCT and the Regulations under the PCT with limited exceptions. See MPEP §§ 214.02 and 215.02. Note that it is permissible, but not required, to present the claim for priority in an application data sheet in an international application entering the national stage under 35 U.S.C. 371.

An international application which seeks to establish the right of priority must comply with the conditions and requirements as prescribed by the Treaty and the PCT Regulations, in order to avoid rejection of the claim to the right of priority. Reference is especially made to the requirement of making a declaration of the claim of priority at the time of filing of the international application (Article 8(1) of the Treaty and Rule 4.10 of the PCT Regulations) or correcting or adding a priority claim (PCT Rule 26 *bis*.1) and the requirement of either filing a certified copy of the priority document with the international application, or submitting a certified copy of the priority document to the International Bureau at a certain time (Rule 17 of the PCT Regulations). The submission of the priority document to the International Bureau is only required in those instances where priority is based on an earlier filed foreign *national* application. With respect to the requirements of 37 CFR 1.55 as they pertain to applications entering the national stage under 35 U.S.C. 371, if the applicant submitted a certified copy of the foreign priority document in compliance with PCT Rule 17 during the international phase, the International Bureau will forward a copy of the certified priority document to each Designated Office that has requested a copy of the foreign priority document and the copy received from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document. See MPEP § 1893.03(c). If, however, the International Bureau is unable to forward a copy of the certified priority document because the applicant failed to submit a certified copy of the foreign priority document during the international phase, the applicant will need to provide a certified copy of the priority document or have the Office retrieve the priority application in accordance with the priority document exchange program during the national stage to fulfill the requirements of 37 CFR 1.55.

If the priority document is an earlier national application and did not accompany the international application when filed with the Receiving Office, an applicant must submit such document to the International Bureau not later than 16 months after the priority date. However, should an applicant request early processing of the international application in accordance with Article 23(2) of the Treaty, the priority document may not be available to the Office at that time (Rule 17.2(a) of the PCT Regulations). Applicants are encouraged to check the Patent Application Information Retrieval (PAIR) system to verify that the certified copy has been received from the International Bureau. The formal requirements for obtaining the right of priority under 35 U.S.C. 365 differ somewhat from those imposed by 35 U.S.C. 119(a)-(d) and (f), however, the substantive right of priority is the same, in that it is derived from Article 4 of the Paris Convention for the Protection of Industrial Property (Article 8(2) of the Treaty).

35 U.S.C. 365(c) recognizes the benefit of the filing date of an earlier application under 35 U.S.C. 120. Any international application designating the United States, whether filed with a Receiving Office in this country or abroad, and even though other countries may have also been designated, has the effect of a regular national application in the United States, as of the international filing date. As such, any later filed national application, or international application designating the United States, may claim the benefit of the filing date of an earlier international application designating the United States, if the requirements and conditions of 35 U.S.C. 120 are fulfilled. Under the same circumstances, the benefit of the earlier filing date of a national application may be obtained in a later filed international application designating the United States. See MPEP § 211.01(c).

In those instances, where the applicant relies on an international application designating, but not originating in, the United States the Director may require submission of a copy of such application together with an English translation, since in some instances, and for various reasons, a copy of that international application or its translation might not otherwise be filed in the U.S. Patent and Trademark Office.

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213.07 Claiming Priority and Filing a Certified Copy in a Nonprovisional International Design Application [R-07.2015]

37 CFR 1.55 Claim for foreign priority.

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(m) *Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.* In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application, the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

*****

(o) *Priority under 35 U.S.C. 386(a) or (b).* The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

*****

Pursuant to 35 U.S.C. 386(a) and 37 CFR 1.55, a nonprovisional application may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 with respect to a prior international design application that designates at least one country other than the United States. Pursuant to 35 U.S.C. 386(b) and 37 CFR 1.55, an international design application designating the United States may make a claim of foreign priority in accordance with the conditions and requirements of 35 U.S.C. 119(a)-(d) and 172 and the Hague Agreement and Regulations thereunder with respect to a prior foreign application, international application (PCT) designating at least one country other than the United States, or a prior international design application designating at least one country other than the United States. The provisions of 35 U.S.C. 386(a) and (b) apply to nonprovisional applications, international applications (PCT) and international design applications filed on or after May 13, 2015, and patents issued therefrom. See 37 CFR 1.55(o).

See MPEP § 2920.05(d) for additional information pertaining to the right of priority based upon an international design application.

214 Formal Requirements of Claim for Foreign Priority [R-08.2017]

Under the statute (35 U.S.C. 119(b)), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specified. If these requirements are not complied with the right of priority is lost and cannot thereafter be asserted.

The maximum time limit specified in the statute is that the claim for priority and the priority papers must be filed before the patent is granted, but the statute gives the Director authority to set this time limit at an earlier time during the pendency of the application. As a result of implementation of Public Law 112-211, 126 Stat. 1527 (titles I and title II of the Patent Law Treaties Implementation Act (PLTIA)), the procedural requirements relating to claims for priority to an earlier-filed foreign application and to the submission of a certified copy of the priority document were revised. The procedural requirements and the time relating to claims for priority of an earlier filed foreign application are set forth in 37 CFR 1.55. See MPEP § 214.01 for procedural requirements pertaining to filing a claim for priority. See MPEP §§ 215.02-215.03 for timing requirements for submitting a certified copy of the priority application. See MPEP § 213.06 for claiming foreign priority and filing a certified copy of the priority document in a national stage application and MPEP § 213.07 for claiming foreign priority and filing a certified copy of the priority document in a nonprovisional international design application.

Where a claim for priority under 35 U.S.C. 119(b) has not been made in a parent application, the claim for priority may be made in a continuing application provided the parent application has been filed within twelve months from the date of the earliest foreign filing (six months for design applications). See *In re Tangsrud,* 184 USPQ 746 (Comm'r Pat. 1973). Where the requirements for perfecting priority under 35 U.S.C. 119(a)-(d) or (f) have not been met before the issuance of patent, see 37 CFR 1.55(g) and

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MPEP § 216.01 for an explanation of when the deficiencies are correctable by a certificate of correction or reissue.

It should be particularly noted that the certified copy must be filed in all cases even though it may not be necessary during the pendency of the application to overcome the date of any reference. The statute also gives the Director authority to require a translation of the foreign documents if not in the English language and such other information as the Director may deem necessary. See MPEP § 213.04 for additional information.

214.01 Time for Filing Priority Claim [R-07.2015]

37 CFR 1.55 Claim for foreign priority.

*****

(d) *Time for filing priority claim—*

(1) *Application under 35 U.S.C. 111(a).* The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

(i) An application for a design patent; or

(ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

(2) *Application under 35 U.S.C. 371.* The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371, except as provided in paragraph (e) of this section.

*****

37 CFR 1.55(d)(1) sets forth the time periods for filing a priority claim in an application filed under 35 U.S.C. 111(a). See 37 CFR 1.55(d)(2) and MPEP § 213.06 for the time period for claiming priority in an application entering the national stage. The time periods set forth in 37 CFR 1.55(d) do not apply to design applications.

For original applications filed under 35 U.S.C. 111(a), the requirements of the statute are that the applicant must (a) file a claim for the right of priority and (b) identify the original foreign application by specifying the application number of the foreign application, the intellectual property authority or country in which the application was filed and the date of filing of the application. 35 U.S.C. 119(b)(1) specifies that the claim for priority and the required identification information must be filed at such time during the pendency of the application as set by the Director. For applications other than design applications, the Director has by rule set this time period as the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(d)(1). This time period is not extendable. In an application that entered the national stage from an international application after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(d)(2) and MPEP § 213.06. In a design application, a claim for priority may be made at any time during the pendency of the application. See 37 CFR 1.55(g). See also MPEP §§ 1504.10 and 2920.05(d) for additional information pertaining to priority claims in design applications.

Claims for foreign priority not presented within the time period specified in 37 CFR 1.55 are considered to have been waived. If a claim for priority under 35 U.S.C. 119(a) - (d) or (f), 365(a) or (b), or 386(a) or (b) is presented after the time period set in 37 CFR 1.55, the claim may be accepted if it includes the required identification information and is accompanied by a grantable petition to accept the unintentionally delayed claim for priority. See MPEP § 214.02 for the treatment of unintentionally delayed priority claims.

For applications filed under 35 U.S.C. 111(a) on or after September 16, 2012, 37 CFR 1.55(d)(1) requires the claim for priority to be presented in an application data sheet. For applications filed under 35 U.S.C. 111(a) prior to September 16, 2012, unless provided in an application data sheet, the oath or declaration under 37 CFR 1.63 must identify the

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foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications 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. See 37 CFR 1.55(n).

214.02 Unintentionally Delayed Priority Claims [R-08.2017]

37 CFR 1.55 Claim for foreign priority.

*****

(e) *Delayed priority claim.* Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

*****

Where a priority claim under 37 CFR 1.55(g) was not timely made, 37 CFR 1.55(g) allows the priority claim and the certified copy required under 37 CFR 1.55 to be filed pursuant to a petition under 37 CFR 1.55(e) even if the application is not pending (e.g., a patented application). Thus, a petition under 37 CFR 1.55(e) may be filed along with request for a certificate of correction after patent grant. See MPEP § 216.01.

If a claim for foreign priority is presented after the time period set in 37 CFR 1.55, the claim may be accepted if it is accompanied by a grantable petition to accept the unintentionally delayed claim for priority. In addition, a petition to accept an unintentionally delayed claim for foreign priority is necessary to correct any error in a foreign priority claim if the correction is sought after expiration of the time period set forth in 37 CFR 1.55.

In all applications, a grantable petition to accept an unintentionally delayed claim for priority must include: (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) or (b) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a certified copy of the foreign application, unless previously submitted or an exception in 37 CFR 1.55(h), (i), or (j) applies; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

37 CFR 1.55(e)(2) requires that a petition to accept a delayed claim for priority be accompanied by a certified copy of the foreign application, unless previously submitted or an exception in 37 CFR 1.55(h), (i), or (j) applies. 37 CFR 1.55(h) contains provisions relating to when the requirement for a certified copy will be considered satisfied based on a certified copy filed in another U.S. patent or application (see also MPEP § 215, subsection III); 37 CFR 1.55(i) contains provisions relating to the priority document exchange agreement (see also MPEP §§ 215.01 and 215.02(a)); and 37 CFR 1.55(j) contains provisions relating to the filing of an interim copy of a foreign application (see also MPEP § 215.02(b)).

Priority claims and certified copies of foreign applications filed after payment of the issue fee and before the patent grant will be placed in the application file but will not be reviewed.

Before May 13, 2015, no procedures were established for accepting an unintentionally delayed priority claim in a design application. Effective May 13, 2015, 37 CFR 1.55(e) provides for the filing of a petition for acceptance of an unintentionally

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delayed priority claim in a design application where the foreign priority claim was not submitted during the pendency of the design application. Thus, a petition under 37 CFR 1.55(e) may be filed along with request for a certificate of correction after patent grant in utility, plant, and design applications. See MPEP § 216.01.

214.03 Office Acknowledgement of Priority Claims [R-08.2017]

I. UNTIMELY CLAIM FOR PRIORITY

If the foreign priority claim in an original application filed under 35 U.S.C. 111(a) (other than a design application) is submitted after the time period set in 37 CFR 1.55 and without a petition under 37 CFR 1.55, the examiner may use form paragraph 2.21.01 to notify applicant that the foreign priority claim will not be entered.

¶ 2.21.01 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) Foreign Priority Claim is Untimely

The foreign priority claim filed on **[1]** was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55. For original applications filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the time period is during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. In addition, if the application was filed on or after September 16, 2012, the claim for foreign priority must be presented in an application data sheet. See 37 CFR 1.55(d)(1). For national stage applications under 35 U.S.C. 371, the claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(d)(2). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f), 365(a) or (b), or 386(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(e). The petition must be accompanied by (1) the priority claim under 35 U.S.C. 119(a)-(d), (f), 365(a) or (b), or 386(a) in accordance with 37 CFR 1.55 identifying the prior foreign application to which priority is claimed, unless previously submitted; (2) a certified copy of the foreign application, unless previously submitted or an exception under 37 CFR 1.55 applies; (3) the petition fee under 37 CFR 1.17(m); and (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55 and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for original applications filed under 35 U.S.C. 111(a) on or after November 29, 2000 and for national stage applications under 35 U.S.C. 371. DO NOT use for design applications.

2. In bracket 1, insert the date the amendment or paper containing the foreign priority claim was filed.

II. NO IRREGULARITIES AND PRIORITY CLAIM TIMELY

When the claim for foreign priority and the certified copy of the foreign application are received within the time period set forth in 37 CFR 1.55, if applicable, they are entered into the application file history. Assuming that the papers are timely and regular in form and that there are no irregularities in dates, the examiner in the next Office action will advise the applicant that the papers have been received on form PTOL-326 or by use of form paragraph 2.26.

¶ 2.26 Claimed Foreign Priority - Certified Copy Filed

Receipt is acknowledged of certified copies of papers required by 37 CFR 1.55.

Where the foreign priority papers have been filed in a parent application, use form paragraph 2.27.

¶ 2.27 Acknowledge Certified Copy of Foreign Priority Paper in Parent

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a) -(d). The certified copy has been filed in parent Application No. **[1]**, filed on **[2]**.

Examiner Note:

1. For problems with foreign priority, see form paragraphs 2.18 to 2.23.

2. In bracket 1, insert series code and serial no. of parent.

III. FOREIGN APPLICATION FILED MORE THAN A YEAR BEFORE EARLIEST EFFECTIVE U.S. FILING

Where the earlier foreign application was filed more than 12 months prior to the U.S. application and priority has not been restored under PCT Rule 26bis.3 for an international application or upon a granted petition under 37 CFR 1.55(c), use form paragraph 2.23.

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¶ 2.23 Foreign Filing More Than 12 Months Earlier, No Petition to Restore Priority Granted

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) based upon an application filed in **[1]** on **[2]**. The claim for priority cannot be based on said application, because the subsequent nonprovisional or international application designating the United States was filed more than twelve months thereafter and no petition under 37 CFR 1.55 or request under PCT Rule 26 *bis*.3 to restore the right of priority has been granted.

Applicant may wish to file a petition under 37 CFR 1.55(c) to restore the right of priority if the subsequent application was filed within two months from the expiration of the twelve-month period and the delay was unintentional. A petition to restore the right of priority must include: (1) the priority claim under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) in an application data sheet, identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing (unless previously submitted); (2) the petition fee set forth in 37 CFR 1.17(m); and (3) a statement that the delay in filing the subsequent application within the twelve-month period was unintentional. The petition to restore the right of priority must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for original applications filed under 35 U.S.C. 111(a) on or after November 29, 2000 and for national stage applications under 35 U.S.C. 371. DO NOT use for design applications.

2. In bracket 1, insert the country name.

3. In bracket 2, insert the filing date of the foreign application.

IV. SOME FOREIGN APPLICATIONS FILED MORE THAN A YEAR BEFORE U.S. FILING

For example, where a British provisional specification was filed more than a year before a U.S. application, but the British complete application was filed within the year, and certified copies of both were submitted, language similar to the following should be used: "Receipt is acknowledged of papers filed on September 18, 1979, purporting to comply with the requirements of 35 U.S.C. 119(a)-(d). It is not seen how the claim for priority can be based on the British specification filed January 23, 1978, because the instant application was filed more than one year thereafter. However, the printed heading of the patent will note the claimed priority date based on the complete specification; i.e., November 1, 1978, for such subject matter as was not disclosed in the provisional specification."

V. APPLICATION IN ISSUE

When the claim for foreign priority or the certified copy of the foreign application is filed after the date of payment of the issue fee but prior to the date of grant of the patent, the foreign priority claim or certified copy will be placed in the file record but there will be no review of the papers and the patent when published will not include the priority claim. A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the foreign priority claim or certified copy considered after publication of the patent. In addition, for original applications filed under 35 U.S.C. 111(a) or international applications entering the national stage under 35 U.S.C. 371, a grantable petition to accept an unintentionally delayed claim for priority under 37 CFR 1.55and the petition fee must be filed with the certificate of correction. See MPEP § 216.01.

214.04 Proper Identification of Priority Application in Foreign Priority Claim [R-08.2017]

To ensure an accurate and complete citation of a foreign priority application, applicants should review the list of the various intellectual property offices and the recommended presentation of a foreign application number for each, which can be found in the tables of the online WIPO Handbook on Industrial Property Information and Documentation (**www.wipo.int/standards/en/**), Part 7: Examples and Industrial Property Offices Practices (**www.wipo.int/standards/en/part_07.html**), including Part 7.2.1: Presentation of Application Numbers (**www.wipo.int/standards/en/pdf/_07-02-01.pdf**).The tables should enable applicants, examiners and others to extract from the various formats the minimum required data which comprises a proper citation. The "Minimum Significant Part of the Number" identified in the tables should be used in United States Patent and Trademark Office records. Proper identification of priority applications is essential to establishing accurate and complete relationships

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among various patent documents, especially in the context of electronic priority document exchange programs (see MPEP § 215.01).

The tables set forth below include only a partial list of recommended presentations of foreign application numbers. A complete updated list of the recommended presentation of a foreign application number based on the numbering system used by the foreign intellectual property office is maintained by the WIPO and can be found in the online WIPO Handbook on Industrial Property Information and Documentation as explained above. See also **www.wipo.int/export/sites/www/standards/en/pdf_/07-02-06.pdf** for a survey of current practices regarding the numbering of applications and priority applications.

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TABLE I COUNTRIES OR OGRANIZATIONS HAVING ANNUAL SERIES OF APPLICATION NUMBERS, in effect December 2005

Country or Organization	Example of Application Number	Minimum Significant Part of Number	Recommended Presentation in Abbreviated Form as a Priority Application Number	Remarks
AR Argentina	P950103456 M950103456	P950103456 M950103456	P950103456 M950103456	Position 1 = application type: P is patent application; and, M is utility model application Positions 2 to 3 = year Positions 4 to 5 = receiving office code Position 6 to 10 = serial number
AT Austria	A 733/2003 GM 158/2003	A 733/2003 GM 158/2003	A 733/2003 GM 158/2003	Position(s) 1 = application type: A is patent application; and, GM is utility model application Positions 2 to 4 = serial number Positions 5 to 8 = year
AU Australia	2002901123 2002200345 2001100123	2002901123 2002200345 2001100123	2002901123 2002200345 2001100123	Positions 1 to 4 = year Position 5 = application type: 1 is innovation patent application; 2-7 is standard patent application; and, 9 is provisional application Positions 6 to 10 = serial number
BE Belgium	2000/0624	2000/0624	2000/0624	Positions 1 to 4 = year Positions 5 to 8 = serial number
BR Brazil	PI 8300014-3 MU 6100132-2	8300014 6100132	8300014 6100132 U	Position 1 to 2 = year of filing and type of IP right: first digit is the decade minus control digit where PI=0 and MU=2 Position 3 to 7 = serial number Position 8 = error control digit
CH Switzerland	01234/96-2	1234/96	1234/96	Positions preceding slant = serial number Positions following slant = year Application number includes check digit following the dash
CN China	2005 1 0123456	2005 1 0123456	2005 1 0123456	Positions 1 to 4 = year Position 5 = type of application: 1 is patent application for invention; 2 is patent application for utility model; 3 is patent application for design; 8 is PCT patent application for invention entering CN national phase; and, 9 is PCT patent application for utility model entering CN national phase Positions 6 to 12 = serial number
CU Cuba	1/85	1/85	1/85	Position 1 = serial number Positions 2 to 3 = year

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DE Germany	10 2004 000 001.7 20 2004 000 001.3 50 2004 000 001.4 60 2004 000 001.9	10 2004 000 001 20 2004 000 001 50 2004 000 001 60 2004 000 001	10 2004 000 001 20 2004 000 001 U	Pos. 1-2: type of IP right 10 = DE patent application; 11 = PCT patent application in the national phase; 12 = SPC application; 20 = Utility models; 21 = Utility models resulting from PCT applications; 22 = topographies; 50 = Patents granted by EPO, filed in German; 60 = Patents granted by EPO, filed in English or French. Pos. 3-6: year of filing Pos. 7-12: serial number Pos. 13: check digit
DK Denmark	PA 1998 01234 BA 1998 00123	PA 1998 01234 BA 1998 00123	1998 01234 1998 00123 U	Application number includes application type: PA is patent application; and, BA is utility model application
EE ESTONIA	P 200300001 U 200300001	200300001 200300001	200300001 200300001 U	P = letter code indicating a patent application number. U = letter code indicating utility model application number. Positions 1-4 = year of filing Positions 5 to 0 = serial number
EG Egypt	1996010001	1996010001	1996010001	Positions 1 to 4 = year Positions 5 to 6 = month of filing Positions 7 to 10 = serial number
EP European Patent Office	79100953.3	79100953	79100953	Positions 1 to 2 = year Positions 3 to 4 = place of filing Positions 5 to 8 = serial number Application number includes check digit after decimal
ES Spain	P 200100123 (1) U 200100123 (1) P 200150001 (7) U 200150001 (7)	200100123 200100123 200150001 200150001	200100123 200100123 U 200150001 200150001 U	Positions 1 to 4 = year Positions 5 to 9 = serial number, where PCT begins with 5
FI Finland	20031234 U20031234	20031234 20031234	20031234 20031234 U	Positions 1 to 4 = year Positions 5 to 8 = serial number U = utility model application
FR France	96 11800	96 11800	96 11800	Positions 1 to 2 = year Positions 3 to 7 = national registration number, also number of granted patent
GB United Kingdom	8912345.1	8912345	8912345.1	Positions 1 to 2 = year Application number includes check digit after decimal
GR Greece	960100177 960200188	960100177 960200188	960100177 960200188	Positions 1 to 2 = year Positions 3 to 4 = application type: 01 is patent application; and, 02 is utility model application Positions 5 to 9 = serial number

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HU Hungary	P 9300684 U 9300266	P 9300684 U 9300266	P 9300684 U 9300266	Position 1 = application type: P is patent application; and U, is utility model application Positions 2 to 3 = year
IE Ireland	2000/0123 S2001/0311	2000/0123 S2001/0311	2000/0123 S2001/0311	S = short-term application
IT Italy	MI91A000231 MI94U000225	MI91A0231 MI94U0225	MI91A0231 MI94U0225	Positions 1 to 2 = place where application was filed Positions 3 to 4 = year Position 5 = application type: A = patent application; and, U = utility model application Positions 6 to 9 = serial number
JP Japan	ss2000-312828 ss2001-8488	2000-312828 2001-8488	2000-312828 or 2000/312828 2001-8488 U or 2001/8488 U	Position 1 to 4 = year Position 5 to 10 = application number Application number is preceded by two symbols (not shown) that characterize patent application or utility model application
KR Republic of Korea	10-2002-0123456 10-2002-7012345 20-2002-0123456 20-2002-7012345	10-2002-0123456 10-2002-7012345 20-2002-0123456 20-2002-7012345	10-2002-0123456 10-2002-7012345 20-2002-0123456 20-2002-7012345	Positions 1 to 2 = type of application: 10 is patent; 20 is utility model; 30 is industrial design; 40-75 is trademark Positions 3 to 6 = year Positions 7 to 12 = serial number: 7 in position 7 is PCT application
MX Mexico	GT/a/2003/000001 GT/f/2003/001234 GT/t/2003/00321 GT/u/2003/123456	GT/a/2003/000001 GT/f/2003/001234 GT/t/2003/00321 GT/u/2003/123456	GT/a/2003/000001 GT/f/2003/001234 GT/t/2003/00321 GT/u/2003/123456	Positions 1 to 2 = receiving office: GT; JL; NL; PA; YU Position 3 = type of application: a is patent application; f is industrial design or model application; t is layout design of integrated circuits; u is utility model application Positions 4 to 7 = year Positions 8 to 13 = serial number
NO Norway	19885850	19985850	19985850	Positions 1 to 4 = year Positions 5 to 8 = serial number
OA African Intellectual Property Organization (OAPI)	1 2005 01234 2 2005 01234	1 2005 01234 2 2005 01234	1 2005 01234 2 2005 01234	Position 1 = application type: 1 is patent application; and, 2 is utility model application Positions 2 to 5 = year Positions 6 to 10 = serial number
PH Philippines	1-1998-00001 1-1999-500001 2-1998-00001 2-1999-500001	1-1998-00001 1-1999-500001 2-1998-00001 2-1999-500001	1-1998-00001 1-1999-500001 2-1998-00001 2-1999-500001	Position 1 = application type: 1 is patent; 2 is utility model; and, 3 is industrial design Positions 2 to 5 = year Positions following the second dash = serial number beginning 00001 for patent applications and 500001 for PCT applications

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	3-1998-00001	3-1998-00001	3-1998-00001	
RO Romania	92-0884	92-0884	92-0884	Positions 1 to 2 = year
RU Russian Federation	2001111546	2001111546	201111546	Positions 1 to 4 = year Position 5 = type of application: 1-4 is invention and utility model
SE Sweden	7300001-0	7300001	7300001	Positions 1 to 2 = year Digit after the dash in application number is for computer control
SK Slovakia	PP 1234/2000 PÚV 123/2000	1234-2000 123-2000	1234-2000 123-2000 U	PP = patent application PÚV = utility model application
ZA South Africa	70/4865	70/4865	70/4865	
ZM Zambia	142/70	142/70	142/70	

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TABLE II COUNTRIES OR ORGANIZATIONS HAVING OTHER THAN ANNUAL SYSTEMS, in effect December 2005

Country or Organization	Example of Application Number	Minimum Significant Part of Number	Recommended Presentation in Abbreviated Form as a Priority Application Number	Remarks
BG Bulgaria	100116 183	100116 183	100116 183	Continuous numbering for patents for inventions and for utility models Continuous numbering for plant varieties and animal breeds
CA Canada	2103828	2103828	2103828	Numbering system for applications filed on or after October 1, 1989, starting with 2000001
CO Columbia	126050	126050	126050	
DE Germany	AP C07D / 2273 773 WP E21C/ 2269 623	2273 773 2269 623	2273 773 2269 623	AP = Ausschliessungspatent WP = Wirtschaftspatent The other symbols before the slash are classification symbols. Last position = check digit
IL Israel	53125	53125	53125	
LU Luxembourg	60093	60093	60093	
MC Monaco	PV 908	908	908	
NZ New Zealand	201732	201732	201732	
PO Poland	P 214461 W 36746	214461 36746	214461 36746 U	Patent application Utility model application
PT Portugal	52555 5607	52555 5607	52555 5607 U	Patent application Utility model application

TABLE OF OTHER COUNTRIES OR ORGANIZATIONS NOT APPEARING IN TABLE II THAT PARTICIPATE IN THE WIPO DIGITAL ACCESS SERVICE (WIPO DAS), in effect December 2016

Country or Organization	Example of Application Number	Minimum Significant Part of Number	Recommended Presentation in Abbreviated Form as a Priority Application Number	Remarks
MA Morocco	38379	38379	38379	

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215 Certified Copy of Foreign Application [R-08.2017]

I. REQUIREMENT FOR CERTIFIED COPY

35 U.S.C. 119(b)(3) authorizes the Office to require the applicant to furnish a certified copy of the foreign priority application, and the Office requires such a copy pursuant to 37 CFR 1.55. The filing of the foreign priority papers under 35 U.S.C. 119(a)-(d) makes the record of the file of the United States patent complete. The U.S. Patent and Trademark Office does not normally examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority, except when the application is involved in an interference or derivation proceeding, when necessary to overcome the date of a reference relied upon by the examiner, or when deemed necessary by the examiner. See MPEP § 216. When the claim to priority and the certified copy of the foreign application are received while the application is pending before the examiner, the examiner should review the certified copy to see that it contains no obvious formal defects and that it corresponds in number, date and country to the application identified in the application data sheet for an application filed on or after September 16, 2012, or oath or declaration or application data sheet for an application filed prior to September 16, 2012.

II. MEANING OF "CERTIFIED COPY"

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the applications as filed with a certificate of the foreign patent office giving certain information. Certified copies include those retrieved by the Office in accordance with a priority document exchange program. See MPEP § 215.01. A copy of the certified copy filed by applicant, including a copy filed via EFS Web, will not satisfy the requirement in 37 CFR 1.55(g) for a certified copy. See MPEP § 502.02, subsection V. "Application" in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed.

III. CERTIFIED COPY FILED IN PARENT OR RELATED APPLICATION

37 CFR 1.55 Claim for foreign priority.

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(h) *Certified copy in another U.S. patent or application.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

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Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application, and a certified copy of the foreign application has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. See 37 CFR 1.55(h). A reminder of this provision is found in form paragraph 2.20. The applicant when making such claim for priority may simply identify the application containing the certified copy. In such cases, the examiner should acknowledge the claim on form PTOL-326. Note copy in MPEP § 707.

If the applicant fails to call attention to the fact that the certified copy is in the parent or related application and the examiner is aware of the fact that a claim for priority under 35 U.S.C. 119(a)-(d) or (f) was made in the parent application, the examiner should call applicant's attention to these facts in an Office action, so that if a patent issues on the later or reissue application, the priority data will appear in the patent. In such cases, the language of form paragraph 2.20 should be used.

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¶ 2.20 Certified Copies of Priority Papers in Parent or Related (Reissue Situation) - Application

Applicant is reminded that in order for a patent issuing on the instant application to obtain priority under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) or (b), based on priority papers filed in a parent or related Application No. **[1]** (to which the present application claims the benefit under 35 U.S.C. 120, 121, 365(c)), or 386(c) or is a reissue application of a patent issued on the related application), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55 for a certified copy of the foreign application, applicant may simply identify the parent nonprovisional application or patent for which reissue is sought containing the certified copy.

Where the benefit of a foreign filing date, based on a foreign application, is claimed in a later filed application or in a reissue application and a certified copy of the foreign application, as filed, has not been filed in a parent or related application, a claim for priority may be made in the later application. *In re Tangsrud,* 184 USPQ 746 (Comm'r Pat. 1973). When such a claim is made in the later application and a certified copy of the foreign application is placed therein, the examiner should acknowledge the claim on form PTOL-326. Note copy in MPEP § 707.

IV. FOREIGN PRIORITY DOCUMENT INCONSISTENT WITH A TIMELY FOREIGN PRIORITY CLAIM OR NO CLAIM FOR FOREIGN PRIORITY

For applications filed on or after September 16, 2012, the claim for foreign priority must be presented in an application data sheet. For applications filed prior to September 16, 2012, any foreign priority claim must be identified in either the oath or declaration or in an application data sheet. Where applicant has filed a certified copy that does not correspond to the foreign application identified in the foreign priority claim by its application number, country (or intellectual property authority), day month, and year of its filing, the applicant should be notified by using form paragraph 2.22. Applicant must submit an application data sheet in compliance with 37 CFR 1.76(c), (or, for applications filed prior to September 16, 2012, a supplemental application data sheet or a new oath or declaration) that correctly sets forth the priority claim. See MPEP §§ 601.05(a) and (b). If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55, the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition under 37 CFR 1.55(e) to accept an unintentionally delayed claim for priority and the petition fee.

Where applicant has filed a certified copy of a foreign application but has not made a claim for foreign priority, applicant should be notified using form paragraph 2.22.

¶ 2.22 Certified Copy Filed, But Proper Claim Not Made

Receipt is acknowledged of a certified copy of foreign application **[1]**, however the present application does not properly claim priority to the submitted foreign application. If this copy is being filed to obtain priority to the foreign filing date under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a), applicant must also file a claim for such priority as required by 35 U.S.C. 119(b) or 365(b), and 37 CFR 1.55. If the application was filed before September 16, 2012, the priority claim must be made in either the oath or declaration or in an application data sheet; if the application was filed on or after September 16, 2012, the claim for foreign priority must be presented in an application data sheet.

If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(d)(1). If the application being examined is a national stage application under 35 U.S.C. 371, the claim for priority must be made within the time limit set forth in the PCT and Regulations under the PCT. See 37 CFR 1.55(d)(2). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f), 365(a) or (b), or 386(a) not presented within the time period set forth in 37 CFR 1.55 is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55, the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition under 37 CFR 1.55(e) to accept an unintentionally delayed claim for priority and the petition fee.

Examiner Note:

1. Use this form paragraph only for original applications filed under 35 U.S.C. 111(a) on or after November 29, 2000 and for national stage applications under 35 U.S.C. 371. DO NOT use for design applications.

2. In bracket 1, insert the application number of the foreign application.

V. APPLICATION IN ISSUE

When the claim for foreign priority or the certified copy of the foreign application is filed after the date of payment of the issue fee but prior to the date of grant of the patent, the foreign priority claim or

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certified copy will be placed in the file record but there will be no review of the papers and the patent when published will not include the priority claim. A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the foreign priority claim or certified copy considered after publication of the patent. In addition, for original applications filed under 35 U.S.C. 111(a) or international applications entering the national stage under 35 U.S.C. 371, a grantable petition under 37 CFR 1.55(e) to accept an unintentionally delayed claim for priority and the petition fee must be filed with the certificate of correction. See MPEP § 216.01.

VI. NO CERTIFIED COPY

Where priority is claimed but no certified copy of the foreign application has been filed, use form paragraph 2.25.

¶ 2.25 Claimed Foreign Priority, No Papers Certified Copy Filed

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in **[1]** on **[2]**. It is noted, however, that applicant has not filed a certified copy of the **[3]** application as required by 37 CFR 1.55.

Examiner Note:

1. In bracket 1, insert the country name.
2. In bracket 2, insert the filing date of the foreign application.
3. In bracket 3, insert the application number of the foreign application.

Any unusual situation may be referred to the Technology Center (TC) Director.

VII. RETURN OF CERTIFIED COPY

Certified copies that have been entered into the application file will not be returned to applicant.

215.01 Electronic Priority Document Exchange [R-08.2017]

Electronic Priority Document Exchange (PDX) agreements provide for the electronic transmission of priority documents to and from participating foreign intellectual property offices. The Office treats a proper priority claim under 37 CFR 1.55 to an application filed in a participating foreign intellectual property office as a request that the Office obtain a copy of the foreign application from the participating intellectual property office. A separate written request may be used when the applicant wishes the Office to retrieve a foreign application from a foreign intellectual property office that becomes a participating foreign intellectual property office after the foreign priority has been claimed, so long as the time period set in 37 CFR 1.55 has not expired. A separate written request is required in the situation where the foreign application is not originally filed in a participating office, but a certified copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office. Applicants can use Form PTO/SB/38 (Request to Retrieve Electronic Priority Application(s)) to file such a request.

An improper, incomplete, or inconsistent citation of a foreign priority application and/or its filing date will result in a delay or prevent retrieval under the Priority Document Exchange program. In particular, any foreign priority claim that is incomplete will prevent successful electronic retrieval of the priority application. Applicants are strongly encouraged to cite the foreign application using an acceptable format (see MPEP § 214.04) and use proper and consistent citation format throughout the U.S. application.

In general, an attempt to retrieve an eligible foreign application to which priority is claimed in a U.S. application will be made by the USPTO when the application is docketed to an examiner. In any case the USPTO will not attempt electronic retrieval until the Office of Patent Application Processing has completed its review of the application. Applicants are encouraged to check the Patent Application and Information Retrieval (PAIR) to determine whether the foreign priority application has been successfully retrieved. A successful request to retrieve an electronic foreign priority application takes approximately 1 week to complete.

The Office will not send a notice setting a time period for filing a certified copy of the priority document. Upon receipt of a Notice of Allowance, applicants should check to see whether the Office has received a copy of the foreign application under the priority document exchange program because

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successful retrieval of priority documents cannot be guaranteed. To be entitled to priority, the Office must receive a copy of the foreign application from the participating foreign intellectual property office within the pendency of the application and before the patent is granted, or receive a paper certified copy of the foreign application during that time period. If a certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by the processing fee set forth in 37 CFR 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323. See MPEP § 215.02(a) for information pertaining to meeting the timeliness requirement for filing a certified copy by using PDX.

The USPTO will attempt retrieval of foreign applications to which priority is claimed in a U.S. design application where possible. The Spanish Patent and Trademark Office deposits certain ES industrial design applications for access by the USPTO via the WIPO DAS. Therefore, when the applicant claims foreign priority to an ES industrial design application and provides the WIPO DAS access code, the USPTO will attempt retrieval via the WIPO DAS. The USPTO will automatically attempt retrieval of international applications filed under the PCT where the receiving office is RO/AU, RO/DK, RO/ES, RO/FI, RO/IB, RO/MA or RO/SE and the applicant has provided the required WIPO DAS access code for the international application to which foreign priority is claimed.

The Office website provides additional information concerning the priority document exchange program (**www.uspto.gov/patents-getting-started/international-protection/electronic-priority-document-exchange-pdx**). This information includes the intellectual property offices that participate in the priority document exchange program, as well as the information necessary for each participating foreign intellectual property office to provide the Office with access to the foreign application.

215.02 Time For Filing Certified Copy – Application Filed On or After March 16, 2013 [R-07.2015]

[Editor Note: See MPEP § 215.03 for information regarding the time for filing a certified copy in an application filed before March 16, 2013.]

37 CFR 1.55 Claim for foreign priority

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(f) *Time for filing certified copy of foreign application—*

(1) *Application under 35 U.S.C. 111(a).* A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

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For applications filed under 35 U.S.C. 111(a) on or after March 16, 2013, 37 CFR 1.55(f)(1) sets forth the time period for filing a certified copy of the foreign application. The time period in 37 CFR 1.55(f)(1) does not apply in design applications. 37 CFR 1.55(f)(1) requires that a certified copy of the foreign application be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application with three exceptions. For

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international applications entering the national stage under 35 U.S.C. 371, 37 CFR 1.55(f)(2) sets forth the time period for filing a certified copy of the foreign application. 37 CFR 1.55(f)(2) requires a certified copy of the foreign application be filed within the time limit set forth in the PCT and the Regulations under the PCT, and if a certified copy is not filed during international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, of sixteen months from the filing date of the prior foreign application with three exceptions. As provided in 37 CFR 1.55(h), (i), or (j), the time period requirement in 37 CFR 1.55(f)(1)or (f)(2) does not apply if:

(1) a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c) or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application, or in the case of a reissue application, if the patent for which reissue is sought satisfies the requirement for a certified copy and such patent is identified as containing the certified copy (see 37 CFR 1.55(h) and MPEP § 215, subsection III);

(2) the priority application was filed in a participating foreign intellectual property office, or if a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, and the Office either receives a copy of the foreign application from the participating foreign intellectual property office or a certified copy of the foreign application during the pendency of the application and before the patent is granted (see 37 CFR 1.55(i) and MPEP § 215.02(a)); or

(3) the applicant provides an interim copy of the original foreign application within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application, and files a certified copy of the foreign application within the pendency of the application and before the patent is granted (see 37 CFR 1.55(j) and MPEP § 215.02(b)).

Because U.S. patent application publications (as well as U.S. patents) will have a prior art effect as of the earliest priority date (for subject matter disclosed in the priority application) with respect to applications subject to AIA 35 U.S.C. 102, the Office needs to ensure that it has a copy of the priority application by the time of publication. The time period of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application is consistent with the international norm for when the certified copy of the foreign application needs to be filed in an application. See PCT Rule 17.1(a).

If a certified copy of the foreign application is not filed within the time period specified in 37 CFR 1.55(f)(1) or (f)(2), as appropriate, and the exceptions in 37 CFR 1.55(h), (i), and (j) are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in 37 CFR 1.17(g). This provision for the belated filing of a certified copy of the foreign application obviates the need for a petition under 37 CFR 1.183 to waive or suspend a requirement of the regulations in such a situation. 37 CFR 1.55(f) provides a lower standard (good and sufficient cause versus an extraordinary situation) and lower fee ($200 petition fee set forth in 37 CFR 1.17(g) versus the $400 petition fee set forth in 37 CFR 1.17(f)) than petitions under 37 CFR 1.183.

See MPEP § 213.06 for additional information regarding filing a certified copy in a national stage application (35 U.S.C. 371).

215.02(a) Timeliness Requirement – Met By Priority Document Exchange [R-07.2015]

37 CFR 1.55 Claim for foreign priority.

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(i) *Foreign intellectual property office participating in a priority document exchange agreement.* The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a

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bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

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37 CFR 1.55(i) provides that the requirement in 37 CFR 1.55(f) and (g) for a certified copy of the foreign application to be filed within the time limit set forth in 37 CFR 1.55(f) and (g) will be considered satisfied if the Office receives a copy of the priority document through the priority document exchange program during the pendency of the application and before the patent is granted. 37 CFR 1.55(i) specifically provides that this requirement for a timely filed certified copy of the foreign application will be considered satisfied if: (1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office); (2) the claim for priority is presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and including the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application; and (3) the copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the time period set forth in 37 CFR 1.55(g)(1)).

37 CFR 1.55(i) also provides that if the foreign application was not filed in a participating foreign intellectual property office, but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy, the applicant must also file a request **in a separate document** that the Office obtain a copy of the foreign application from the participating intellectual property office. This request must identify the participating intellectual property office and the application number and filing date of the subsequent application in which a copy of the foreign application was filed, and be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (37 CFR 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under 37 CFR 1.55(e) or (f). Applicants can use Form PTO/SB/38 (Request to Retrieve Electronic Priority Application(s)) to file such a request.

The Office website provides information concerning the priority document exchange program (**www.uspto.gov/patents-getting-started/international-protection/electronic-priority-document-exchange-pdx**). See also MPEP § 215.01. This information includes the intellectual property offices that participate in the priority document exchange program, as well as the information necessary for each participating foreign intellectual property office to provide the Office with access to the foreign application. The Office appreciates that an applicant may discover

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that the Office will not receive a copy of a foreign application through the priority document exchange program until after the expiration of the time frame specified in 37 CFR 1.55(f). In this situation, an applicant who otherwise meets the conditions of 37 CFR 1.55(i) may satisfy the requirement of 37 CFR 1.55(i)(3) by filing a certified copy of the foreign application in the Office within the pendency of the application and before the patent is granted.

Note that the Office cannot obtain a copy of a design application to which priority is claimed, or a foreign application to which priority is claimed in a design application, through the priority document exchange program. In addition, note that the Office can obtain a PCT application to which priority is claimed through the priority document exchange program for PCT applications filed in a limited number of PCT Receiving Offices (currently, RO/DK (Denmark), RO/FI (Finland), RO/IB (International Bureau), and RO/SE (Sweden)).

Applicants continue to bear the ultimate responsibility for ensuring that the priority document is filed during the pendency of the application and before the patent is issued. Accordingly, applicants are encouraged to check as necessary to confirm receipt by the Office of appropriate documents. Priority documents retrieved from a participating foreign intellectual property office will bear the document description: "Priority documents electronically retrieved by USPTO from a participating IP Office." Furthermore, 37 CFR 1.55(i)(4) provides that, under specified conditions, if the foreign application was not filed in a participating foreign intellectual property office, the applicant can file a request in a separate document that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy. Applicants can use Form PTO/SB/38 (Request to Retrieve Electronic Priority Application(s)) to file such a request. If the Office receives a copy of the foreign application from the participating foreign intellectual property office within the pendency of the application and before the patent is granted, the applicant need not file a certified paper copy of the foreign application. As a specific example, Germany is not currently a participating foreign intellectual property office, however a DE application may be retrieved via the priority document exchange program if it is identified in the claim for priority on the application data sheet, a subsequent application filed in the European Patent Office (EPO) or the Japan Patent Office (JPO) contains a certified copy of the DE application, and the applicant timely files a separate request for the Office to obtain from the EPO or JPO a copy of the certified copy of the DE application, wherein the request identifies the DE application and the subsequent EP or JP application by their application number, country, day, month, and year of their filing.

The Office treats a proper priority claim under 37 CFR 1.55 to an application filed in a participating foreign intellectual property office as a request that the Office obtain a copy of the foreign application from the participating intellectual property office. A separate written request may be used when the applicant wishes the Office to retrieve a foreign application from a foreign intellectual property office that becomes a participating foreign intellectual property office after the foreign priority has been claimed, so long as the time period set in 37 CFR 1.55(f) has not expired. A separate written request is required in the situation where the foreign application is not originally filed in a participating office, but a certified copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office.

215.02(b) Timeliness Requirement – Met By Interim Copy of Foreign Application [R-07.2015]

I. TRUE COPY OF FOREIGN APPLICATION AS FILED

37 CFR 1.55 Claim for foreign priority.

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(j) *Interim copy.* The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the

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original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

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37 CFR 1.55(j) permits an applicant to provide an "interim copy" of the original foreign application from the applicant's own records to provide for the situation in which the applicant cannot obtain a certified copy of the foreign application within the time limit set forth in 37 CFR 1.55(f), although there is no requirement that an applicant be unable to obtain a certified copy of the foreign application within the time limit set forth in 37 CFR 1.55(f) to use 37 CFR 1.55(j). The requirement for a certified copy of the foreign application to be filed within the time limit set forth in 37 CFR 1.55(f) will be considered satisfied if the applicant files a copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based with the time period specified in 37 CFR 1.55(j). 37 CFR 1.55(j) also provides that the interim copy of the foreign application must be filed together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority). 37 CFR 1.55(i) also provides that the interim copy of the foreign application and cover sheet must be filed within the later of sixteen months from the filing date of the prior foreign application or four months from the actual filing date of an application under 35 U.S.C. 111(a), within four months from the later of the date of commencement (37 CFR 1.491(a)) or the date of the initial submission under 35 U.S.C. 371 in an application entering the national stage under 35 U.S.C. 371, or with a petition under 37 CFR 1.55(e) or (f). 37 CFR 1.55(j) finally provides that a certified copy of the foreign application ultimately must be filed within the period specified in 37 CFR 1.55(g)(1). Thus, providing an interim copy of a foreign application under 37 CFR 1.55(j) satisfies the requirement for a certified copy of the foreign application to be filed within the time limit set forth in 37 CFR 1.55(f), but a certified copy of the foreign application must still be filed during the pendency of the application, unless filed with a petition under 37 CFR 1.55(e), (f), or (g) as appropriate.

An interim copy of a foreign priority application will be entered into the file wrapper of the application in which it was filed and labeled as "Interim copy of Foreign Priority Document."

II. FILING INTERIM COPY VIA EFS-WEB

If not provided as a single paper document, the main parts of the interim copy of the foreign priority application, i.e., Abstract, Drawings, Specification, Claims, and where applicable, Sequence Listing or Computer Program Listings, along with the separate cover sheet required by 37 CFR 1.55(j), may be filed as a single PDF file via EFS-Web. The PDF file will be stored in the Image File Wrapper of the application, and applicants must select the document description "Interim Copy of the Foreign Priority Application" to index this document when filing online.

Application parts that were filed in a foreign patent office only as plain text computer files (e.g. TXT file), such as a Sequence Listing, lengthy Tables(s), or Computer Program Listing appendix, may be filed as a TXT file via EFS-Web (or on compact disc). When filing online via EFS-Web, applicants must select the document description "Interim Copy of the Foreign Priority (text file)" to index a plain text file part of the application. See MPEP § 502.05 for additional information regarding filing documents via EFS-Web.

215.03 Time For Filing Certified Copy – Application Filed Before March 16, 2013 [R-08.2017]

[Editor Note: See MPEP § 215.02 for information regarding the time for filing a certified copy in an application filed on or after March 16, 2013.]

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37 CFR 1.55 Claim for foreign priority.

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(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.*

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

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35 U.S.C. 119(b)(3) authorizes the Office to require the applicant to furnish a certified copy of priority papers. Pursuant to 37 CFR 1.55, applicants are required to submit the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323. See 37 CFR 1.55(g)(1). Certification by the authority empowered under a bilateral or multilateral treaty to receive applications which give rise to a right of priority under Article 4A(2) of the Paris Convention will be deemed to satisfy the certification requirement. See MPEP § 214.01 for the time period for claiming priority to a foreign application.

If a claim for foreign priority has been made, the latest time at which the certified copy of the foreign application may be filed in order for the patent to include the priority claim without the need for a certificate of correction is the date of the payment of the issue fee. Under certain circumstances, the certified copy may be required at an earlier date. These circumstances are specified in 37 CFR 1.55(g)(2) as:

(A) when the application is involved in an interference or derivation proceeding;

(B) when necessary to overcome the date of a reference relied on by the examiner; and

(C) when specifically required by the examiner.

The claim for foreign priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed before the patent is granted. If the claim for foreign priority or the certified copy of the foreign application is filed after the date of payment of the issue fee but prior to the date of grant of the patent, the priority claim or certified copy will be placed in the file record but there will be no review of the papers and the patent when published will not include the priority claim. A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 can be filed to have the priority claim or certified copy considered after publication of the patent. In addition, for original applications filed under 35 U.S.C. 111(a) (other than a design application), where the priority claim was not timely filed, a grantable petition to accept an unintentionally delayed claim for priority under 37 CFR 1.55(e) and the petition fee must also be filed with the certificate of correction. Furthermore, where the priority claim was timely filed but was not included on the patent because the certified copy was not submitted, a grantable petition under 37 CFR 1.55(f) and the petition fee or, in the case of a design application, a grantable petition under 37 CFR 1.55(g) and the petition fee must also be filed with the certificate of correction unless the exception in 37 CFR 1.55(h) is applicable. See MPEP § 216.01.

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In view of the shortened periods for prosecution leading to allowances, it is recommended that priority papers be filed as early as possible. Although 37 CFR 1.55(g)(1) permits the filing of priority papers up to and including the date for payment of the issue fee, it is advisable that such papers be filed promptly after filing the application. Frequently, priority papers are found to be deficient in material respects, such as for example, the failure to include the correct certified copy, and applicants should ensure that there is sufficient time to remedy any defects. For applications filed prior to September 16, 2012, where the priority claim is presented in the oath or declaration, a new oath or declaration may be necessary where the original oath or declaration omits the reference to the foreign filing date for which the benefit is claimed. The early filing of priority papers would thus be advantageous to applicants in that it would afford time to explain any inconsistencies that exist or to supply any additional documents that may be necessary. It is important to note that for applications filed on or after September 16, 2012, the claim for foreign priority must be presented in an application data sheet (37 CFR 1.76(b)(6)).

It is suggested that a notation of the application number of the corresponding U.S. application be placed on the priority papers when such papers are not submitted via a priority document exchange program. Such notation should be placed directly on the priority papers themselves even where a cover letter is attached bearing the U.S. application data. Experience indicates that cover letters and priority papers occasionally become separated, and without the suggested notations on the priority papers, correlating them with the corresponding U.S. application becomes exceedingly difficult, frequently resulting in severe problems for both the Office and applicant. Adherence to the foregoing suggestion for making a notation on the priority document of the U.S. application data will result in a substantial lessening of the problem.

216 Entitlement to Priority [R-08.2017]

When the claim to priority and the certified copy of the foreign application are received while the application is pending before the examiner, the examiner generally makes no examination of the papers except to see that they contain no obvious formal defects and correspond in number, date and country to the application identified in the application data sheet for an application filed on or after September 16, 2012, or oath or declaration or application data sheet for an application filed prior to September 16, 2012. In addition, for original applications filed under 35 U.S.C. 111(a) (other than design applications) and international applications entering the national stage under 35 U.S.C. 371, the examiner should make sure that the claim for foreign priority is timely. Examiners may use form paragraph 2.21.01 to notify applicant that the foreign priority claim is untimely. See also MPEP § 214.03.

The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof. The only times during *ex parte* prosecution that the examiner considers the merits of an applicant's claim of priority is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States and when an interference situation is under consideration. If at the time of making an action the examiner has found such an intervening reference, the examiner simply rejects whatever claims may be considered unpatentable thereover, without paying any attention to the priority date (assuming the certified copy of the priority papers has not yet been filed). The applicant in reply may argue the rejection if it is of such a nature that it can be argued, or present the foreign papers for the purpose of overcoming the date of the reference. If the applicant argues the reference, the examiner, in the next action in the application, may specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or the examiner may merely continue the rejection.

Form paragraph 2.19 may be used in this instance.

¶ 2.19 Overcome Rejection by Translation

Applicant cannot rely upon the certified copy of the foreign priority application to overcome this rejection because a translation of said application has not been made of record in accordance with 37 CFR 1.55. See MPEP §§ 215 and 216.

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Examiner Note:

This paragraph should follow a rejection based on an intervening reference.

In those cases where the applicant files the certified copy of the foreign application for the purpose of overcoming the effective date of a reference, a translation is required if the certified copy is not in the English language. When the examiner requires the filing of the certified copy, the translation should also be required at the same time. This translation must be filed together with a statement that the translation of the certified copy is accurate. When the necessary certified copy and translation are filed to overcome the date of the reference, the examiner's action, if the examiner determines that the applicant is not entitled to the priority date, is to repeat the rejection on the reference, stating the reasons why the applicant is not considered entitled to the date. If it is determined that the applicant is entitled to the date, the rejection is withdrawn in view of the priority date.

If the certified copy, and translation if necessary, is already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the certified copy, if it is in the English language, to determine if the applicant is entitled to the priority date. If the applicant is found to be entitled to the priority date, the reference is not relied upon as prior art, but may be cited to applicant on form PTO-892. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the certified copy is not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date.

The foreign application may have been filed by and in the name of the assignee or legal representative or agent of the inventor, as applicant. In such cases, if the certified copy of the foreign application corresponds with the one identified in an application data sheet, or for applications filed prior to September 16, 2012, in an application data sheet or in the oath or declaration filed under 37 CFR 1.63 (see 37 CFR 1.55(n)) and no discrepancies appear, it may be assumed that the nonprovisional application is entitled to claim priority to the foreign application. If the nonprovisional application and the certified copy of the foreign application do not name the same inventor or do not have at least one joint inventor in common, the priority date should be refused until the inconsistency is resolved. See also MPEP § 213.02.

The most important aspect of the examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications. The foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that applicant would be entitled to under U.S. laws and practice. The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112 as well as to determine if there is a basis for the claims sought.

In applications filed from the United Kingdom there may be submitted a certified copy of the "provisional specification," which may also in some cases be accompanied by a copy of the "complete specification." The nature and function of the United Kingdom provisional specification is described in an article in the Journal of the Patent Office Society of November 1936, pages 770-774. According to United Kingdom law the provisional specification need not contain a complete disclosure of the invention in the sense of 35 U.S.C. 112, but need only describe the general nature of the invention, and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important. If it is found that the United Kingdom provisional specification is insufficient for lack of disclosure, reliance may then be had on the complete specification and its date, if one has been presented, the complete specification then being treated as a different application than the provisional specification. In some instances, the specification and drawing of the foreign application may have been filed at a date subsequent to the filing of the petition in the foreign country. Even though the petition is called the application and the filing date of this petition is the filing date of the application in a particular country, the date accorded here is the

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date on which the specification and drawing were filed.

A nonprovisional application may be found entitled to the filing date of the foreign application with respect to some claims and not with respect to others. In addition, an applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

216.01 Perfecting Claim for Priority Under 35 U.S.C. 119(a)-(d) or (f) After Issuance of a Patent [R-08.2017]

35 U.S.C. 119 Benefit of Earlier Filing Date; Right of Priority.

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(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

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37 CFR 1.55 Claim for foreign priority.

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(e) *Delayed priority claim.* Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or 386(b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(f) *Time for filing certified copy of foreign application—*

(1) *Application under 35 U.S.C. 111(a).* A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

(2) *Application under 35 U.S.C. 371.* A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

(g) *Requirement for filing priority claim, certified copy of foreign application, and translation in any application.*

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for

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priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

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The failure to perfect a claim to foreign priority prior to issuance of the patent may be cured via a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323, provided the requirements of 37 CFR 1.55 are met, or by filing a reissue application.

Except in certain situations, a certificate of correction can generally be used to perfect a claim to foreign priority where a petition under 37 CFR 1.55(e) to accept an unintentionally delayed priority claim is filed with a request for a certificate of correction in an issued patent. In situations where further examination would be required, the petition should not be granted. For example, further examination would be required where grant of the petition would cause the patent to be subject to a different statutory framework, e.g., where the foreign application has a pre-March 16, 2013 filing date in a patent that was examined under the first inventor to file (FITF) provisions of the AIA. In such situations, the filing of a reissue application with a petition for an unintentionally delayed priority claim would be required.

I. PERFECTING PRIORITY CLAIM VIA CERTIFICATE OF CORRECTION

Effective May 13, 2015, 37 CFR 1.55(g) provides that the claim for priority and the certified copy of the foreign application must be filed within the pendency of the application, unless filed with a petition under 37 CFR 1.55(e), (f), or (g) as appropriate. 37 CFR 1.55(g) eliminates the need in many instances to file a reissue application in order to perfect a claim for foreign priority. Specifically,

(A) Where the priority claim required under 37 CFR 1.55 was timely filed in the application but was not included on the patent because the requirement under 37 CFR 1.55 for a certified copy was not satisfied, the patent may be corrected to include the priority claim via a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323, accompanied by a grantable petition under 37 CFR 1.55(f) or, in the case of a design application, a grantable petition under 37 CFR 1.55(g). In this situation, a petition under 37 CFR 1.55(e) to accept an unintentionally delayed priority claim is not needed. A grantable petition under 37 CFR 1.55(f) or (g) must include the fee set forth in 37 CFR 1.17(g) and a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application; and

(B) Where a priority claim under 37 CFR 1.55 was not timely made, 37 CFR 1.55(g) allows the priority claim and the certified copy required under 37 CFR 1.55 to be filed pursuant to a petition under 37 CFR 1.55(e) even if the application is not pending (e.g., a patented application) in situations where the correction sought would not require further examination.

37 CFR 1.55(h) provides that the requirement for a certified copy of the foreign application will be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and the prior-filed nonprovisional application is identified as containing a certified copy of the foreign application. Thus, applicant may request a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 where the prior-filed nonprovisional application is identified as containing a certified copy of the foreign application and where the priority claim was timely made in the application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) and the certified copy of the foreign application was timely filed in the parent application.

As an example of when a request to issue a certificate of correction may be used in order to perfect a claim to foreign priority benefits, see *In re Van Esdonk,* 187 USPQ 671 (Comm'r Pat. 1975). In *In re Van Esdonk,* a claim to foreign priority benefits had not been filed in the application prior to issuance of the patent. However, the application was a continuation of an earlier application in which the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied. Accordingly, the Commissioner held that the "applicants' perfection of a priority claim under 35 U.S.C. 119 in the parent application will satisfy the statute with respect to their continuation application."

Although *In re Van Esdonk* involved the patent of a continuation application filed under former 37 CFR

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1.60, it is proper to apply the holding of that case in similar factual circumstances to any patented application having benefits under 35 U.S.C. 120. This is primarily because a claim to foreign priority benefits in a continuing application, where the claim has been perfected in the parent application, constitutes in essence a mere affirmation of the applicant's previously expressed desire to receive benefits under 35 U.S.C. 119(a)-(d) or (f) for subject matter common to the foreign, parent, and continuing applications.

In summary, a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patent if (1) the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the patented application or in a parent application prior to issuance of the patent, (2) the requirements of 37 CFR 1.55 are met, and (3) the correction sought would not require further examination.

II. PERFECTING PRIORITY CLAIM VIA REISSUE

As an alternative to requesting a certificate of correction, a claim to foreign priority benefits can be perfected by way of a reissue application in accordance with the rationale set forth in *Brenner v. State of Israel,* 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). In circumstances where a claim to foreign priority benefits cannot be perfected via a certificate of correction because the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance, and the requirements of 37 CFR 1.55 are not met, or where the correction sought would require further examination (e.g., where the foreign application has a pre-March 16, 2013 filing date in a patent that was examined under the first inventor to file (FITF) provisions of the AIA) the claim to foreign priority benefits can be perfected only by way of a reissue application. Note that 37 CFR 1.55(h) provides that the requirement for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application.

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37 CFR 1.57 Incorporation by reference.

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(b) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii) Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii) Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to PCT Rule 20.8(b), must be submitted in accordance with PCT Rule 20.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to § 1.53(e) accompanied by the fee set forth in § 1.17(f).

(4) Any amendment to an international design application pursuant to paragraph (b)(1) of this section shall be effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international design application

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will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

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I. IN GENERAL

37 CFR 1.57(b) (formerly 37 CFR 1.57(a)) provides that if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, international, or international design application that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim for priority or benefit shall be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawings.

The purpose of 37 CFR 1.57(b) is to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawing(s), or a portion thereof, is (are) inadvertently omitted from an application, such as through a clerical error. It allows inadvertently omitted material to be added to the application by way of a later-filed amendment if the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application even though there is no explicit incorporation by reference of the prior-filed application. For a discussion of explicit incorporation by reference statements, see MPEP § 608.01(p).

II. CONDITIONS AND REQUIREMENTS OF 37 CFR 1.57(b)

The following conditions and requirements need to be met for an applicant to add omitted material to an application pursuant to 37 CFR 1.57(b):

(A) the application must have been filed on or after September 21, 2004;

(B) all or a portion of the specification or drawing(s) must have been inadvertently omitted from the application;

(C) a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, international, or international design application, must have been present on the filing date of the application;

(D) the inadvertently omitted portion of the specification or drawing(s) must be completely contained in the prior-filed application;

(E) applicant must file an amendment to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier;

(F) if the application is not otherwise entitled to a filing date, applicant must also file a petition under 37 CFR 1.53(e) accompanied by the petition fee set forth in 37 CFR 1.17(f);

(G) applicant must supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(H) applicant must supply an English language translation of any prior-filed application that is in a language other than English; and

(I) applicant must identify where the inadvertently omitted portion of the specification or drawing(s) can be found in the prior-filed application.

A. Application Filed On or After September 21, 2004

The provisions set forth in 37 CFR 1.57(b) became effective on September 21, 2004 and apply to applications filed on or after that date. Thus, an application that inadvertently omits material must have been filed on or after September 21, 2004 in order for 37 CFR 1.57(b) to apply. Applicants may, however, rely on prior-filed applications filed before September 21, 2004 to supply inadvertently omitted material to applications filed on or after September 21, 2004.

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B. Material Must Be Inadvertently Omitted

There is no requirement for applicant to submit a declaration stating that the omission was inadvertent or to submit proof that a particular omission was inadvertent at the time of filing of the application. If applicant submits an amendment to add the omitted material pursuant to 37 CFR 1.57(b), it would constitute a certification under 37 CFR 11.18(b) that the omission was inadvertent. The Office, however, may inquire as to inadvertence where the record raises such issue.

C. Claim Under 37 CFR 1.55 or 1.78 Present on Filing Date

The priority claim under 37 CFR 1.55 or the benefit claim under 37 CFR 1.78 of the prior-filed application must be present on the filing date of the later-filed application in order for it to be considered an incorporation by reference of the prior-filed application under 37 CFR 1.57(b). The later-filed application claiming benefit of the prior-filed application can be a continuation, divisional, or continuation-in-part application of the prior-filed application.

D. Omitted Material Completely Contained in Prior-filed Application

The phrase "completely contained" in 37 CFR 1.57(b) requires that the material to be added to the later-filed application under 37 CFR 1.57(b) must be expressly, as opposed to implicitly, disclosed in the prior-filed application. Furthermore, the material to be added must be completely contained in the prior-filed application **as filed** since it is the prior application as filed which is being incorporated under 37 CFR 1.57(b).

E. Amendment to Add Inadvertently Omitted Material

The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined in 37 CFR 1.114(b), or the abandonment of the application, whichever occurs earlier. If the Office of Patent Application Processing (OPAP) mails a "Notice of Omitted Item(s)" indicating that a portion of the specification or drawings have been omitted, any amendment pursuant to 37 CFR 1.57(b) should be submitted within the two month time period set in the notice and should be identified as an amendment under 37 CFR 1.57(b). The amendment must be in compliance with 37 CFR 1.57(b) and 1.121. See MPEP § 601.01(d) and § 601.01(g). While an amendment to include inadvertently omitted material may be submitted in reply to a final Office action which first raises the issue of the omitted material, such an amendment does not have a right of entry as it would be considered as an amendment under 37 CFR 1.116. If the application is abandoned or the prosecution is closed, applicant may file a petition to revive an application under 37 CFR 1.137 and/or a request for continued examination under 37 CFR 1.114, as appropriate, in order to restore the application to pending status and/or reopen prosecution in the application. If, however, an application has been patented, a certificate of correction or a reissue application could not be used to add inadvertently omitted material to that patent via 37 CFR 1.57(b).

In order for the omitted material to be included in the application, and hence considered to be part of the disclosure, the application must be amended to include the omitted portion. Therefore, applicants can still intentionally omit material contained in the prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference of 37 CFR 1.57(b). Applicants can maintain their intent by simply not amending the application to include the intentionally omitted material.

In addition to filing the amendment to add the inadvertently omitted material, applicant is also required to: (A) supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111; (B) supply an English-language translation of any prior-filed application that is in a language other than English; and (C) identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

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F. Petition Requirement

If an application is not otherwise entitled to a filing date under 37 CFR 1.53(b), the amendment must be by way of petition under 37 CFR 1.53(e) accompanied by the fee set forth in 37 CFR 1.17(f). If OPAP mails a "Notice of Incomplete Application" indicating that the application lacks a specification or drawings, applicant should file a petition under 37 CFR 1.57(b) in response to the notice if applicant wants to rely on 37 CFR 1.57(b). See MPEP § 601.01(d) and § 601.01(f).

G. International Applications

Any amendment to an international application pursuant to 37 CFR 1.57(b)(1) will be effective only as to the United States and shall have no effect on the international filing date of the application. The incorporation by reference relief provided in 37 CFR 1.57(b) cannot be relied upon to accord an international filing date to an international application that is not otherwise entitled to a filing date under PCT Article 11, and it cannot be relied upon to alter the international filing date accorded under PCT Article 11. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (37 CFR 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application.

H. International Design Applications

Any amendment to an international design application pursuant to 37 CFR 1.57(b)(1) will be effective only as to the United States and shall have no effect on the filing date of the application. In addition, no request to add the inadvertently omitted portion of the specification or drawings in an international design application will be acted upon by the Office prior to the international design application becoming a nonprovisional application.

III. EXAMPLES

Example 1:

The Office of Patent Application Processing (OPAP) noticed that Figure 3 was omitted from the application during the initial review of the application although the specification included a description of Figure 3. The application as originally filed contained a claim under 37 CFR 1.78 for the benefit of a prior-filed application that included the appropriate Figure 3. OPAP mailed a Notice of Omitted Item(s) notifying the applicant of the omission of Figure 3 and providing a two-month period for reply.

Applicant may rely on the incorporation by reference provided by 37 CFR 1.57(b) to amend the application to add Figure 3. Applicant, however, must file the amendment to add the inadvertently omitted drawing figure in compliance with 37 CFR 1.57(b) within the time period set forth in the Notice of Omitted Item(s).

Example 2:

Applicant discovered that the last page of the specification is inadvertently omitted after the prosecution of the application has been closed (e.g., a final Office action, an *Ex Parte Quayle* action, or a notice of allowance has been mailed to the applicant). The application, as originally filed, contained a claim under 37 CFR 1.78 for the benefit of a prior-filed application that included the last page of the specification.

If applicant wishes to amend the specification to include the inadvertently omitted material, applicant must reopen the prosecution by filing a Request for Continued Examination (RCE) under 37 CFR 1.114 accompanied by the appropriate fee and an amendment in compliance with 37 CFR 1.57(b) within the time period for reply set forth in the last Office action (e.g., prior to payment of the issue fee, unless applicant also files a petition to withdraw the application from issue).

Example 3:

Applicant filed a (third) application that includes a claim under 37 CFR 1.78 for the benefit of a (second) prior-filed application and a (first) prior-filed application. The second application was a continuation application of the first application and the second application was abandoned after the filing of the third application. Subsequently, the applicant discovered the last page of the specification was inadvertently omitted from the third application and the second application.

If the benefit of the filing date of first application for the omitted subject matter is required (for example, the omitted material is required to provide support for the claimed subject matter of the third application and there is an intervening reference that has a prior art date prior to the filing date of the third application, but after the filing date of the first application), applicant must amend the specification of the second application and the specification of the third application to include the inadvertently omitted material in compliance with 37 CFR 1.57(b) (note: the second and third applications must be filed on or after September

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21, 2004. Since the second application is abandoned, applicant must file a petition to revive under 37 CFR 1.137 in the second application only for the purpose of correcting the specification under 37 CFR 1.57(b) along with the amendment in compliance with 37 CFR 1.57(b).

IV. FORM PARAGRAPHS

Examiners may use form paragraph 6.19.02 set forth below to notify applicant that an amendment to add inadvertently omitted material pursuant to 37 CFR 1.57(b) is not in compliance with 37 CFR 1.57(b). If the amendment is made to the specification and/or drawings and introduces new matter into the disclosure, form paragraph 7.28 must also be used to object to the new matter added to the disclosure, and if the amendment adds new matter to the claims or affects the claims, form paragraph 7.31.01 must also be used to reject the claims under 35 U.S.C. 112(a).

¶ 6.19.02 Amendment Not in Compliance with 37 CFR 1.57(b)

The amendment to add inadvertently omitted material pursuant to 37 CFR 1.57(b) filed **[1]** is not in compliance with 37 CFR 1.57(b) because **[2]**.

Examiner Note:

1. In bracket 1, insert the date the amendment was filed.

2. In bracket 2, insert the reason why the amendment has not been entered. For example: (1) the present application was filed before September 21, 2004, the effective date of the provisions now in 37 CFR 1.57(b) (the provisions were formerly in 37 CFR 1.57(a)); (2) the claim for priority/benefit of the prior-filed application was not present on the filing date of the present application; (3) the inadvertently omitted portion is not completely contained in the prior-filed application; (4) a copy of the prior-filed application (except where the prior-filed application is an application filed under 35 U.S.C. 111) was not submitted; (5) an English language translation of the prior-filed non-English language application was not submitted; or (6) applicant did not identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

3. This form paragraph must be followed by form paragraph 7.28, where the amendment is made to the specification and/or drawings and introduces new matter into the disclosure, and/or form paragraph 7.31.01, where the amendment adds new matter to the claims or affects the claims.

4. If the amendment is an after-final amendment, an advisory action should be issued indicating that the amendment raises new issues because it is not in compliance with 37 CFR 1.57(b).

5. This form paragraph should <u>not</u> be used if there is an express incorporation by reference since applicant would not need to comply with the requirements of 37 CFR 1.57(b).

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