# Chapter 200 Types, Cross-Noting, and Status of Application



## 201 Types of Applications

Patent applications fall into three broad types, viz., applications for "*mechanical*", *design*, and *plant* patents. The term "mechanical", as here employed, embraces all applications and patents which are directed to a "new and useful art, machine, manufacture, or composition of matter, or to any new and useful improvement thereof." The specialized procedure which pertains to the examination of applications for design and plant patents will be treated in detail in Chapters 1500 and 1600, respectively.

## 201.01 Sole

An application wherein the invention is presented as that of a single person is termed a sole application.

## 201.02 Joint

A joint application is one in which two or more persons have taken oath that they are the joint inventors of the claimed subject matter.

## 201.03 Convertibility From a Joint to a Sole Application

*Rule 45 (Second Paragraph) Joint Inventors.* (b) If an application for patent has been made inadvertently or by mistake and without fraudulent intention by two or more persons as joint inventors when they were not in fact joint inventors, the application may be amended to remove the names of those not inventors upon filing a statement of the facts verified by all of the original applicants, and an oath as required by rule 65 by the applicant who is the actual inventor, provided the amendment is diligently made. An application can not be amended to add the name of a joint inventor who

was omitted, but a new independent application must be filed.

The conversion of a joint application into a sole application may also be effected by filing a sole application to take the place of the joint application, subject to the requirements of Rule 45. This would be equivalent to amending the original joint application.

When a joint application is amended to a sole application, the file should be sent to the Application Branch for a revision of its record.

See In re Roberts, 1920 C. D. 158; 273 O. G. 410, for a general discussion of the conversion of a joint to a sole application.

See McGavack v. Strube, 50 U. S. P. Q. 513 for situations which may arise when the several joint applicants seek to file individual sole applications based on the original joint application.

The conversion of a sole into a joint application is not permitted. Ex parte Benes, 1925 C. D. 75; 339 O. G. 499.

For the procedure to be followed when the joint application is involved in an interference, see 1111.07 and 1112.09 (m) to 1112.09 (p).

## 201.04 Original or Parent

The terms *original* and *parent*, are interchangeably applied to the first of a series of applications of an inventor, all disclosing a given invention. Such invention may or may not be claimed in the first application.

## 201.05 Reissue

A reissue application is an application for a patent to take the place of an unexpired patent that is defective in some one or more particulars. A detailed treatment of reissues will be found in chapter 1400.

## 201.06 Divisional

A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming nothing not disclosed in the earlier or parent application, is known as a divisional application. Both the parent and the divisional application must be by the same applicant, except when the divisional application is a sole application converted from a prior joint application. (See below.) The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

While a divisional application may depart from the phraseology used in the parent case there may be no departure therefrom in substance or variation in the drawing that would amount to "new matter" if introduced by amendment into the parent case.

A divisional application is also referred to as a "division" of the parent case.

*Rule 147. Separate application for invention not elected.* The non-elected inventions, those not elected after a requirement for division (rule 142), may be made the subjects of separate applications, which must conform to the rules applicable to original applications and which will be examined in the same manner as original applications. However, if such an application is filed before the original application is patented or becomes abandoned, and if it is identical with the original application as filed, the drawings being identical and the papers constituting an exact copy of the original papers which were signed and executed by the applicant, signing and execution by the applicant may be omitted; such application may consist of the filing fee, a copy of the drawings complying to rules relating to drawings and a certified typewritten copy of the original application as filed, together with a proposed amendment, cancelling the irrelevant claims or other matter.

For notation to be put on the file jacket by the Examiner in the case of a divisional application see 202.02.

Since a joint application may, when the facts warrant it, be transformed into a sole application, a sole application may be a division of a joint application if the joint application contained an invention which was solely that of one of the joint applicants.

However, the following conditions must be present:

(a) It must appear that the joint application was filed "by mistake and without fraudulent intention."

(b) On discovery of the mistake the party filing the sole application "must act with reasonable diligence and must assume the burden of establishing his good faith."

(c) There must be filed in the sole application a disclaimer under oath by each of the other parties of the joint application.

A later joint application, however, may not be termed a division of a prior application filed by one of the joint inventors. This follows from the doctrine of Ex parte Benes, 1925 C. D. 75; 339 O. G. 499.

## 201.07 Continuation

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned. The applicant in the continuing application must be the same as in the prior application, unless the continuation is a sole converted from a joint application. The disclosure presented in the continuation must be the same as that of the original application, i. e., the continuation should not include anything which would con-

stitute new matter if inserted in the original application.

Where an application has been prosecuted to a final rejection an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the Primary Examiner.

A sole application may be a continuation of a joint application which was erroneously jointly filed. (Union Switch & Signal Co. v. Kodel et al., 1932 C. D. 530; 416 O. G. 3.) See conditions stated under 201.06 for a division.

For notation to be put on the file jacket by the Examiner in the case of a continuation application see 202.02.

## 201.08 Continuation-in-Part

A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in the said earlier case. (In re Klein, 1930, C. D. 2; 393 O. G. 519.)

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated in the case of a sole divisional application stemming from a joint application (201.06) and the further condition that the applicant present an exact line of division between matters of joint invention and sole invention. (In re Perrin, 1944 C. D. 380; 565 O. G. 151.)

For notation to be put on the file jacket by the Examiner in the case of a continuation-in-part application see 202.02.

## 201.09 Substitute

The use of the term "Substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case, finds official recognition in the decision, Ex parte Komenak, 1940 C. D. 1; 512 O. G. 739.

For notation to be put on the file jacket by the Examiner in the case of a substitute application see 202.02.

## 201.10 Re-file

No official definition has been given the term Re-file, though it is sometimes used as an alternative for the term Substitute.

If the applicant designates his application as "re-file" and the Examiner finds that the application is in fact a duplicate of a former application by the same party which was abandoned prior to the filing of the second case, the Examiner should require the substitution of the word *substitute* for "re-file", since the former term has official recognition. The endorsement on the file wrapper that the case is a "substitute" will result in the further endorsement by the Assignment Branch of any assignment of the parent case that may have been made.

## 201.11 Continuity Between Applications: When Entitled to Filing Date

A division, continuation, or continuation-in-part is linked by co-pendency with the original or parent application; and contains, in whole or in part, identical disclosure in common with the original application. Such applications are entitled to the effective filing date of the original application for only the common subject matter disclosed.

A division, continuation, or continuation-in-part may be filed at any time during the pendency of the parent application. Such continuing application may be filed, for example, after an appeal to the Board or to the Court, provided the parent application has not become abandoned (1215); or after the application has gone to issue (In re Febrey, 1943, C. D. 510; 554 O. G. 377). In the latter case the period of pendency includes the three months' extension where the final fee is paid and a three months' extension for the issuance of the patent is obtained.

A substitute application is not linked by co-pendency with the original application and is not entitled to the effective filing date of the latter. As a matter of public policy, however, all substitute applications are required to include a reference to the original application. This makes the original application accessible to the public for a fuller understanding of the basis for the allowance of claims in the substitute application, and facilitates investigations pertaining to questions of ownership, in case the parent case has been assigned. (201.12.) Such reference to the parent application also enables the Examiner to compare his action in the substitute application with those made in the parent application and to avoid the adoption of an inconsistent position.

A substitute is not entitled to the benefit of the filing date of the original application for a constructive reduction to practice. (In re Spitteler et al., 1908 C. D. 374; 134 O. G. 1301.) At most, such filing date can be availed of only as the date of conception, leaving to be determined the question of diligence as bridging any gap between the date of a reference and the filing date of the substitute application.

Any public use or patent or printed publication prior to the filing date of the substitute even

though subsequent to the earlier application, if it discloses the subject matter of the claims, is a proper citation in the substitute application.

## 201.12 Assignment Carries Title

Assignment of an original application carries title to any divisional, continuation, substitute or reissue application stemming from the original application and filed after the date of assignment.

## 201.13 International Convention for the Protection of Industrial Property

SEC. 4887 R. S., 35 U. S. C. 32 (second paragraph). An application for patent for an invention or discovery . . . filed in this country by any person who has previously regularly filed an application for a patent for the same invention [or] discovery . . . in a foreign country, which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and 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 [or] discovery . . . was first filed in such foreign country, provided the application in this country is filed within twelve months . . . from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery . . . which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing.

In the case of designs, the period is six months instead of twelve.

The second paragraph of the statute accords what is known as a "right of priority" to applicant under certain conditions, which conditions are defined by an international treaty or agreement known as the *International Convention for the Protection of Industrial Property*. There are now forty countries, including the United States, adhering to this convention.

One of the primary objects of the Convention is stated to be the equal treatment of the nationals of all participating countries. The convention also establishes certain rights in favor of these nationals. One of these rights is the so-called right of priority, which means that a filing of an application in any country which adheres to the convention is treated as having the legal, or constructive, effect of a filing in all countries, provided it is followed up, within twelve months, by an actual filing there.

Under the provisions of Sec. 4887 R. S., 35 U. S. C. 32, the inventor's priority rights under the convention are based, not upon his citizenship, but upon the status of the *country* in which the earliest foreign filing was made as a party to the International Convention.

## 201.14 Proving of Foreign Filing for "Normal" Priority

*Extract from Rule 65. Oath of Applicant.* If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representative or assigns, prior to his application in this country, he shall state the country or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

No proof of the earlier filing is required unless a reference is brought to light which has an effective date *earlier* than applicant's United States filing date but later than the date of his foreign filing under the convention. Where the applicant acknowledges in his oath a *first* filed foreign application less than twelve months prior to his U. S. filing date, but antedating the reference, such foreign application will serve to avoid the reference if a certified copy of the foreign application is filed, together with a sworn translation if the copy be not in English. Ex parte Mattlet, 1926 C. D. 62; 347 O. G. 1047.

## 201.15 Examiner's Determination of Foreign Filing

The most important aspect of the Examiner's action pertaining to a right of priority because of a foreign filing is the determination of the identity of invention between the U. S. and the foreign application. If it is for the same invention, the foreign application may be considered in the same manner that a duplicate U. S. Application filed on the same date would be considered and applicant is entitled to any claims based on such application that he would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the description under R. S. 4888, 35 U. S. C. 33, as well as to determine if there is a basis for the claims sought. In some cases the matter of sufficiency of disclosure in the sense of having a sufficient basis for certain types of claims, as in chemical cases, may arise.

In applications filed from Great Britain there may be submitted a certified copy of the British "provisional specification", which may also in some cases be accompanied by a copy of the "complete Specification". The nature and function of the British provisional specification is described in an article in the Journal of the Patent Office Society for November 1936, pages 770–774. According to British law the provisional specification does not need to contain a complete disclosure of the invention in the sense

of R. S. 4888, 35 U. S. C. 33, 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 British provisional specification is insufficient, for lack of disclosure or other reason, reliance may then be had on the complete specification if one has been presented, the latter being treated as a different application.

It may occasionally happen that the U. S. application will be found entitled to the filing date of the foreign application with respect to some claims and not with respect to others. In such a case, the examiner's letter will state that the applicant is considered entitled to the foreign date with respect to certain named claims and is not so entitled with respect to other claims, with the reasons for the latter statement being given.

Occasionally, an applicant may rely on two different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to the other, with respect to other claims. In such a case, the Examiner's letter will specify the claims relating to each of the applications.

## 201.16 Public Law 690

201.16 to 201.16 (u) are a combination of the Notices of August 30, 1946, Circular of May 1, 1947, Memorandum of November 12, 1947, and Notice of May 19, 1948, with a few revisions.

Public Law 690 (79th Congress, approved Aug. 8, 1946) was enacted for the purpose of restoring, to a certain extent, priority rights which may have been lost as a result of war conditions. This act extends, if certain conditions are met, the twelve months' period (six months in the case of designs) provided in the second paragraph of Sec. 4887 R. S. 35 U. S. C. 32. In addition to all other legal requirements, the *citizenship* of the inventor becomes material; that is, he must either be a citizen of the United States or a citizen of a country which grants reciprocal privileges to citizens of the United States. The decision as to the inclusion of a given country is determined by the Commissioner of Patents after consultation with the State Department, and notices are issued and published from time to time in the Official Gazette listing countries which have been added. The list, to date (Feb. 1949), is given in 201.16 (b).

## 201.16 (a) Time Limits for Obtaining Benefit of Law

The extreme limit of the benefit of Public Law 690 (as extended by Public Law 220) applies to cases filed abroad after Sept. 8, 1938, and in this country on or before Feb. 29, 1948. See 201.16 (b) for shorter periods in some cases. Request for priority under the Act may be filed at any time during the pendency of the U. S. application.

Although Feb. 29, 1948, fell on a Sunday, the Patent Office has ruled that applications filed on the next following day, i. e., March 1, 1948, are not entitled to the priority benefits of the Act.

## 201.16 (b) Countries Granting Reciprocity

| Country: | *Time Limit for filing applications in United States* | |
|---|---|---|
| Australia | February 29, 1948 | |
| Austria | February 29, 1948 | |
| Belgium | February 29, 1948 | |
| Brazil | December 31, 1946 | |
| Bulgaria | February 29, 1948 | (1) |
| Canada | November 15, 1947 | |
| Czechoslovakia | February 29, 1948 | |
| Denmark | February 29, 1948 | |
| Finland | February 29, 1948 | |
| France | February 29, 1948 | |
| Great Britain | February 29, 1948 | |
| Holland | December 31, 1947 | |
| Hungary | February 29, 1948 | (1) |
| Italy | February 29, 1948 | (1) |
| Ireland | February 29, 1948 | |
| Luxembourg | February 29, 1948 | |
| New Zealand | February 29, 1948 | |
| Norway | December 31, 1947 | |
| Palestine | February 29, 1948 | |
| Phillippines | February 29, 1948 | |
| Poland | February 29, 1948 | |
| Roumania | February 29, 1948 | (1) |
| Spain | February 29, 1948 | |
| Sweden | February 29, 1948 | |
| Switzerland | February 29, 1948 | |
| Union of South Africa | February 29, 1948 | |

(1) In the case of citizens or subjects of Bulgaria, Hungary, Italy, and Roumania, the benefits are limited to applications filed abroad after December 8, 1940. This date was fixed by Public Law 380 which removed the disability imposed on these enemy aliens by Public Law 690, Sec. 14.

## 201.16 (c) Allegation as to Citizenship in Reciprocating Country

An allegation as to citizenship in a country granting reciprocal privileges is sufficient. Proof is not required unless there is some inconsistency.

## 201.16 (d) Proof of the Contents of Foreign Application

In addition to citizenship, other conditions are imposed. As contrasted with the procedure in the "*normal*" right of priority, proof of the contents of

the foreign application must be advanced by the applicant.

## 201.16 (e) Effect on Term of Patent

Section 10 of Public Law 690 provides for the shortening of the term of the United States patent so that it will expire not later than twenty years from the filing date of the earliest application in *any* country disclosing the same invention. In any of these cases where the priority date may be different for different claims, the term of the patent as a whole will be determined by the earliest foreign application, since section 10 reads: "twenty years from the filing date of the first application" and the Patent Office will not specify different terms for different claims in the same patent.

## 201.16 (f) When No Papers Have Been Filed

The Act specifically requires the applicant to request the extended period of priority and to supply certain papers. Until and unless the required material is furnished, examiners will act on applications in the usual way, that is, they will cite and use whatever references and grounds of rejection may be applicable, considering the actual filing date of the application in the United States as the only date to which it is entitled. However, if it appears that the applicant is attempting or intends to obtain the extended period of priority but is unaware of the conditions, his attention may be called to such conditions.

In some cases there may be a statement that the applicant relies on a foreign filing date. The Examiner should mention in his action that no reliance can be placed on the foreign filing date until and unless the requirements of Section 1 of Public Law 690 are met.

## 201.16 (g) Actions Must Be Responded To. Filing of Papers Does Not Excuse a Reply to An Action

While the papers may be filed during the pendency of the application, applicants are not relieved of the necessity of replying to Office actions within the statutory time limit and of making as complete a response as is ordinarily required.

## 201.16 (h) Requirements of the Statute

The statute requires of those who wish the extended period of priority under Section 1 the following:

(a) A request in writing;
(b) A copy of the original foreign application, certified to by the country in which filed;
(c) A sworn translation thereof if not in the English language;
(d) An affidavit by the inventor in certain cases.

## 201.16 (i) Requirements, the Request in Writing

The written request for the extended period of priority need not be a formal paper signed by the inventor. It may be contained in the letter of the attorney transmitting the papers or in some other letter and no specific form is necessary. It must appear definitely and not merely by implication that the applicant is seeking the benefit of Section 1 of the Act, and preferably it should specify the foreign application and date, the benefit of whose filing date is requested.

## 201.16 (j) Requirements, Certified Copy of Foreign Application

The copy of the foreign application presented under Section 1 of Public Law 690 must be an accurate copy of the foreign application as filed, and the certificate by the foreign patent office must make this evident, as has been customary. In some instances a printed copy of the patent as issued may be used. This is not sufficient unless the certificate indicates that it is a true copy of the application as filed. In French cases, the printed patent is practically always a duplicate of the application as filed since substantial amendments are not permitted. Most countries, however, permit amendment of the application and hence a copy of the patent is not proof of the application as filed.

Section 1 of Public Law 690 permits other evidence in lieu of a certified copy of the original application if the original foreign application has been destroyed. Generally, the only "other evidence" which has been considered is a certified copy of a certified copy. For example, a copy of a German application certified by the German Patent Office in the proper manner may have been filed in the Swiss or Dutch Patent Office. A copy of these papers, certified to by the Patent Office of Switzerland or Holland as being a true copy of the papers there filed, has been accepted in appropriate cases. Cases in which "other evidence" is offered should be referred to the Supervisory Examiners for consideration.

## 201.16 (k) Requirements, Sworn Translation

A sworn translation if the foreign application is not in the English language is also required. This means a translation which is sworn to and not a translation made by a so-called "sworn translator", which phrase is used in some countries. Oaths taken in foreign countries for use in this country should be authenticated by a diplomatic or consular officer of the United States if not taken before such officer.

## 201.16 (l) Requirements, Affidavit of Inventor

The statute further requires:

If the foreign application was not made by the inventor himself, an affidavit by the applicant [in the U. S.] or patentee [in the U. S.] stating that such application was filed for his [the inventor's] benefit or on his behalf and that such procedure is in accordance with the procedure in the foreign country. (Bracketed matter added.)

The purpose of this requirement is to take care of the situation in which the foreign application was not filed by the inventor but by an agent or representative as is permitted in some countries. In such cases the inventor, who is the applicant here, must make the required affidavit.

Cases also arise in which the foreign application was made by the assignee of the inventor. The affidavit by the inventor is likewise required in such cases; the phrase "for his benefit or on his behalf" then meaning that the application was filed by the assignee in place of the inventor as permitted by the law of the country.

In some instances the foreign application may have been filed jointly by the inventor and the assignee as joint applicants as is permitted in some countries. An affidavit will not be required in these cases; the word "himself" is not taken to mean "alone". If the relationship of the foreign applicants is not evident, an explanation may be required.

## 201.16 (m) Examiner Must Determine Right To Rely on Foreign Application

Even when determination of the right to rely on the foreign application may not be necessary for the purpose of overcoming a reference, so far as the examiner knows, such determination is required in each instance where applicant includes papers pertaining to Public Law 690, because the Act imposes various restrictions on the patent, e. g., Section 10 provides that the term of the patent be appropriately adjusted.

## 201.16 (n) Action by the Examiner

When papers are received in an application pending before the examiner (including those applications awaiting action by the applicant), such papers are to be entered in the file and are to be considered by the examiner at the time of the next regular action Usually no acknowledgment need be made at the time of receipt; but if, for any reason, acknowledgment is found to be necessary it should not count as an action in the case. When the case comes up for regular action the examiner should examine the papers for formal compliance with the requirements.

In the case of applications filed by citizens of countries with respect to which reciprocity has not yet been announced, the examiner should check the status of the country with the Supervisory Examiner and act in accordance with the latter's instructions.

Until the case is ready for issue or all the claims allowed (ex parte Quayle 1935 C. D. 11; 453 O. G. 213), the Examiner need not determine whether the foreign application is for the "same invention" as applied for in the United States unless any statutory bar or pertinent reference is found which would be eliminated by the priority date. If any such statutory bar or reference is found, a complete action on the right of priority as to all the claims should be given.

## 201.16 (o) Action by Examiner, Examiner's Letter

The next regular Office letter following filing of the papers should include a statement with reference to the papers under Public Law 690 and said statement should appear at the beginning of the letter. Where the papers do not meet the formal requirements the particular deficiencies should be noted. In those cases where the formal requirements are satisfied but no ruling is made on the question of "same invention", the following form is suggested:

> Receipt is acknowledged of papers filed on _____, 194__, under Section 1 of Public Law 690. These papers have been placed on record in the file as complying with the formal requirements of the Act. Determination of whether the claims herein are for the same invention as that disclosed in the foreign application is not made at this time.

## 201.16 (p) Action by Examiner, Date Refused or Granted

In those cases where a ruling on the matter of priority is made and the date is refused, the reasons should be stated. Where the applicant is found to be entitled to the foreign filing date, a statement should be incorporated in the letter that the applicant is entitled to the filing date of a particular foreign application for all or certain specified claims. A form for such statement could be as follows:

> Applicant having complied with the provisions of Sections 1, Public Law 690, approved August 8, 1946, this application is considered entitled to a priority date corresponding to the filing date of the application filed in _____ on _____, as to claims_____.

In those cases where a ruling on the right of priority is not made until the case is ready for issue or all the claims allowed, the Examiner should at

that time state whether or not the applicant is entitled to the priority date. If the date is refused, the reasons for so holding should be stated. If granted, a statement such as that embraced in the suggested form set forth in the immediately preceding paragraph should be employed. This statement may be sent with the notice of allowance, and it should be combined with the examiner's amendment when such amendment is included.

## 201.16 (q) Action by Examiner, Allowed Applications

If an application is in issue when the papers are received, the examiner should, if the final fee has not been paid, borrow the file from the Issue and Gazette Branch and treat it in the same manner as described above [201.16 (p)]. If the final fee has been paid the examiner should, if there is time, examine the papers promptly and write a letter in the same manner. Deferment of the issue of the patent may be requested if it is still possible. If the papers are received too late to take any of the above actions, they should be referred to the Supervisory Examiners.

## 201.16 (r) Action by Examiner, Application on Appeal

If papers are filed after an appeal is taken, appropriate action may be taken by the examiner if the examiner's answer has not been written, and any rejection withdrawn or the appeal forwarded as may be appropriate. If the examiner's answer has been mailed the application will be remanded by the Board for consideration of the papers.

## 201.16 (s) Action by Examiner, Applications in Interference

If the papers are received while an application is involved in interference, they are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken after the termination of the interference, if necessary.

If the papers are to be relied on for proof of priority in any interference, the party must act in the interference in accordance with interference rules and is subject to whatever rules relating to motions, notices, production of testimony, etc., may be applicable.

## 201.16 (t) Action by Examiner, Application Oath

When the extended priority date is granted, certain informalities or variations in the customary application oath may be permitted. The date of execution of the oath may become immaterial and variations as to the allegation of one year publication, use, etc., corresponding to the last paragraph of Section 1 of Public Law 690 may be encountered. An oath such as follows, as well as the customary oath, would ordinarily be acceptable:

> _____, the above petitioner, being duly sworn, deposes and says that he is a citizen of _____ and a resident of _____, that he verily believes himself to be the original, first and sole inventor of the improvement in _____ _____ described and claimed in the annexed specification; that he does not know and does not believe that said invention was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or prior to the filing of the application in (specify country) upon which the right of priority of the present application is based, or in public use or on sale in the United States prior to the filing of said application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns and that no application for patent on said invention has been filed by him or said representatives or assigns in any country foreign to the United States, except as follows: (List all foreign applications and patents).

## 201.16 (u) Action by Examiner, Submission of Cases to Supervisory Examiner

Applications wherein action is taken on a request for the benefits of section 1 of Public Law 690 should be submitted to the Supervisory Examiner for review (before mailing of the examiner's letter) in the following instances:

(1) If the action is one granting the priority benefits; and

(2) If the action is one withdrawing previously allowed benefits.

Applications in which the applicant seeks to withdraw or cancel a request for the extended priority date or the papers submitted, should be submitted to the Supervisory Examiner before any action is taken by the examiner.

Applications should not be submitted to the Supervisory Examiner wherein an action is made refusing the benefits under Public Law 690, provided that no prior grant of such benefits has been made.

If the application is placed in condition for allowance, having once been given the benefit of the priority date and all the claims still relate to the "same invention", it may be passed to issue by the Examiner without again referring it to the Supervisory Examiner for approval.

(201.16 to 201.16 (u) above are a combination of the Notice of August 30, 1946, Circular of May 1, 1947, Memorandum of November 12, 1947 and Notice of May 19, 1948 with a few revisions.)

### 201.17 Fee-Exempt, Government Owned

The terms "fee-exempt" and "Government Owned" as well as "Act of 1883 application", apply to applications for which no fee is required, according to the provisions of the Act of March 3, 1883, as amended. See 607 and 607.01.

## 202 Cross-Noting

### 202.01 In Specification

*Extract from Rule 78. Cross-references to other applications.* (a) When an applicant files an application claiming an invention disclosed in a prior filed application of the same applicant, the second application must contain a reference to the prior application, identifying it by serial number and filing date and indicating the relationship of the applications. When an applicant files, or a common assignee owns, two or more applications relating to the same subject matter of invention, with one or more of the applications disclosing unclaimed matter that is disclosed and claimed in another of the applications, the applications not claiming it must refer to and identify the application claiming it. Cross-reference to other related applications may be made when appropriate. See rule 14 (b).

When an application is filed which in the opinion of the Examiner is a division of, a continuation of, a continuation-in-part of, or a substitute for a previously filed application, but which contains no reference in the specification to such prior application, the Examiner will require applicant to insert the proper reference to the prior application in the specification. If, when the case is otherwise in condition for allowance, this requirement has not been complied with, nor shown to have been improperly made, the proper reference to the prior application will be made by an Examiner's amendment and the application passed to issue forthwith. (Order No. 2822.)

There is seldom a reason for one application to refer to the application of another applicant not assigned to a common assignee. Such reference ordinarily should not be permitted.

### 202.02 Notation as to Parent Application on Jacket and in File of a Divisional, Continuation, Continuation-in-Part, or Substitute Application

The identifying data of a parent or prior application must be given in the specification and must be inserted by the Examiner on the left margin of the file jacket in the case of a DIVISION, a CONTINUATION, or a SUBSTITUTE Application. The file jacket bears on the left hand margin, the legend: "Division of Application No. ____, filed _____, 19__." This is to be filled in at the time of the first action with the serial number and date of any prior application of which the one in question is a division, a continuation, or a substitute, the word "Division" being replaced by *Continuation*, and the words "Division of" replaced by *Substitute for abandoned*, as may be required. If the prior application has issued as a patent, the patent number and date should also be supplied. If the application at hand is a division of a division, the data of all cases involved should be given. (Order No. 1832, Revised.)

In the case of a continuation-in-part the identifying data of the parent or prior application must be given in the specification and the Examiner must stamp only the letter C-P. on the file jacket.

One of the reasons for these notations being put on the file jacket is that they indicate to the Docket Clerk when an application is a DIVISION, CONTINUATION, CONTINUATION-IN-PART, or a SUBSTITUTE. These four types of applications must be sent to the Assignment Branch for a title search when in condition for allowance. (Order No. 3411, Revised.) See 306 for work done by the Assignment Branch pertaining to these particular types of applications.

Only the letters C–P. (without data) are placed on the file jacket in the case of a continuation-in-part because the printer does not use the data of the prior application in setting up the heading when printing a continuation-in-part patent.

### 202.03 On File Wrapper When Foreign Application is Acknowledged

Where applicant acknowledges a prior foreign application, the country where filed and the date of filing are noted at the bottom of the face of the file wrapper. Where there are two or more such earlier foreign applications, only the earliest filed of these is noted, except that all foreign applications filed more than twelve months prior to the U. S. application must be noted on the file wrapper. (Six months in the case of designs.)

This notation in cases which have been given the benefit of the Boykin Act (Public Law 690) is replaced by the label pasted on the face of the file wrapper. See 1302.06.

### 202.04 Foreign Patent Granted After Date of Specification

An applicant will not be required in any case to file a statement setting forth the data of any foreign

patent granted him, or to others with his knowledge or consent between the date of execution of his specification and the date of the payment of the final fee. (Order No. 1239.)

### 202.05 In Oath

As will be noted by reference to 201.14, Rule 65 requires that the oath include a list of the foreign countries in which applications have been filed by applicant's representative. If no applications for patent have been filed in any foreign country, the oath should so state.

### 202.06 In Case of Reissues

Rule 179 requires that a notice be placed in the file of an original patent for which an application for reissue has been filed. For the form employed for this notice see Clerk's Manual, Sec. 50.

## 203 Status of Applications

### 203.01 New

A "new" application is one 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.

### 203.02 Rejected

An application which, during its prosecution in the examining division 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 response to the examiner's action (within the allotted response period), or until it becomes abandoned.

### 203.03 Amended

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

### 203.04 Allowed or in Issue

An "allowed" application or an application "in issue" is one which, having been examined, is passed for issue as a patent subject to payment of the final fee. Its status as an "allowed" case continues from the date of allowance until it is withdrawn from issue or until it issues as a patent or becomes forfeited.

The files of allowed cases are kept in the Issue and Gazette Branch, arranged in the order of dates of allowance.

### 203.05 Abandoned

An abandoned application is, *inter alia*, one which is removed from the Office docket of pending cases through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or through failure of applicant to take appropriate action at some stage in the prosecution of the case. (711 to 711.02 (b))

### 203.06 Incomplete

An application lacking some of the essential parts and not accepted for filing is termed an incomplete application. (506 and 506.01)

### 203.07 Forfeited

A forfeited application is one which had the status of an allowed case for six months and on which the final fee was not paid. See Rule 316 in 712.

### 203.08 Examiners To Answer "Status Letters"

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 Register, Correspondence and Mail Branch, to the examining divisions for direct action. Such letters will be stamped "Status Letters."

If the correspondent is not entitled to the information, in view of Rule 14, he should be so informed.

If the inquiry is directed to an application awaiting action by the Office, a prediction should be made of the probable date of reaching the case for action. The examiner's reply should be typed on the letter of inquiry whenever possible, and signed by the Primary Examiner. The original letter of inquiry should be returned to the correspondent together with the reply. Such reply does not count as an action in the case. This prediction of a date is not to be considered as binding upon the examiner in making his next action.

In cases of allowed applications, a memorandum should be pinned to the inquiry with a statement of date of notice of allowance, and transmitted to the Issue Branch for its appropriate action. This Branch will notify the inquirer of the date of the notice of allowance and the status of the application with respect to payment of the final fee and forfeiture.

In those instances where the letter of inquiry goes beyond mere matters of inquiry, it should not be marked as a "status letter", or returned to the correspondent. Such letters must be entered in the application file as a permanent part of the record. The inquiry should be answered by the examiner, however, and in a manner consistent with the provisions of Rule 14. (Notices of June 22, 1921, and May 6, 1948, revised.)