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

201 Types of Applications

Patent applications fall under three broad types: (1) applications for patent under 35 U.S.C. 101 relating to a "new and useful process, machine, manufacture, or composition of matter, etc."; (2) applications for plant patents under 35 U.S.C. 161; and (3) applications for design patents under 35 U.S.C. 171. The first type of patents are sometimes referred to as "utility" patents or "mechanical" patents when being contrasted with plant or design patents. 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 the invention is presented as that of two or more persons.

201.03 Convertibility of Application [R–49]

37 CFR 1.45. (b) If an application for patent has been made through error and without any deceptive 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 or declaration as required by § 1.65 by the applicant who is the actual inventor, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

The required "statement of the facts verified by all of the original applicants" must include at the least, a recital of the circumstances, including the relevant dates, of (1) the misjoinder and (2) the discovery of the misjoinder. Without such a showing of circumstances, no basis exists for a conclusion that the application had been made in the names

of the original sole or joint applicant(s) "through error and without any deceptive intention", and no foundation is supplied for a ruling that the amendment to remove the names of those not inventors or include those to be added as inventors was "diligently made."

On the matter of diligence, attention is directed to the decision of the C.C.P.A. in Van Otteren v. Hafner et al., 757 O.G. 1026; 126 USPQ 151.

It is possible to file a sole application to take the place of the joint application, subject to the requirements of § 1.45.

For the procedure to be followed when the joint application is involved in an interference, see § 1111.07.

Conversion from a sole to a joint application is permitted by 35 U.S.C. 116.

37 CFR 1.45. (c). If an application for patent has been made through error and without any deceptive intention by less than all the actual joint inventors, the application may be amended to include all the joint inventors upon filing a statement of the facts verified by, and an oath or declaration as required by § 1.65 executed by, all the actual joint inventors, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

Any attempt to effect a second conversion, of either type or to effect both types of conversion, in a given application, must be referred to the group director. The provisions of 37 CFR 1.312 apply to attempted conversions after allowance and before issue. When any conversion is effected, the file should be sent to the Application Division for a revision of its records.

An application which was filed by A and amended to add B to form joint applicants AB, cannot be again amended to make B the sole applicant.

Where a person is added or removed as an inventor during the prosecution of an application before the Patent and Trademark Office, problems may occur upon applicant claiming U.S. priority in a foreign filed case. Therefore, examiners should acknowledge any addition or removal of inventors made in accordance with the practice under § 1.45 and include the following statement in the next communication to applicant or his attorney.

> "In view of the papers filed _____, it has been found that this application, as filed, through error and without any deceptive intention (failed to include _____ as an actual joint inventor; or included _____ as a joint inventor who was not in fact a joint inventor) and accordingly, this application has been corrected in compliance with 37 CFR 1.45."

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 Division [R–49]

A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division". Except as provided in 37 CFR 1.45 both must be by the same applicant. (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.

In the interest of expediting the processing of newly filed divisional applications, filed as a result of a restriction requirement, applicants are requested to include the appropriate Patent and Trademark Office classification of the divisional application and the status and location of the parent application, on the papers submitted. The appropriate classification for the divisonal application may be found in the office communication of the parent case wherein the requirement was made. It is suggested that this classification designation be placed in the upper right hand corner of the letter of transmittal accompanying these divisional applications.

A design application is not to be considered to be a division of a utility application, and is not entitled to the filing date thereof, even though the drawings of the earlier filed utility application show the same article as that in the design application. In re Campbell, 1954 C.D. 191; 101 USPQ 406; Certiorari denied 348 U.S. 858.

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. Compare §§ 201.08 and 201.11.

37 CFR 1.45

Since § 1.45(b) permits the conversion of a joint application to a sole, it follows that a new application, restricted to divisible subject matter, filed during the pendency of the joint application by one of the joint applicants, in place of restricting and converting the joint case, may properly be identified as a division of the joint application. In like manner under 37 CFR 1.45 (c), a new joint application for divisible subject matter present in a sole application may be identified as a division if filed by the sole applicant and another during the pendency of the sole. See § 201.11

However, the following conditions must be satisfied in each of the foregoing situations,

(a) It must appear that the parent application was filed "through error and without any deceptive intention".

(b) On discovery of the mistake the new application must be diligently filed and the burden of establishing good faith rests with the new applicant or applicants.

(c) There must be filed in the new application the verified statement of facts required by 37 CFR 1.45.

(d) A statement must be filed in the parent application indicating that § 1.45 papers relating to the inventorship thereof have been filed in a particular continuing application.

For notation to be put on the file wrapper by the examiner in the case of a divisional application see § 202.02.

The 37 CFR 1.147 divisional practice has been superseded by the 37 CFR 1.60 practice which became effctive on September 1, 1971. See § 201.06(a).

201.06(a) Division-Continuation Program [R–49]

37 CFR 1.60. Continuing application for invention disclosed and claimed in a prior application. A continuation or divisional applicatin (filed under the conditions specified in 35 U.S.C. 120 or 121), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted provided the copy either is prepared and certified by the Patent and Trademark Office or is prepared by the applicant and verified by an affidavit or declaration by the applicant, his attorney or agent, stating that it is a true copy of the prior application as filed. Certification may be omitted if the copy is prepared by and does not leave the custody of the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

The former 37 CFR 1.147 division practice and streamline continuation practice have been superseded by the change in the Rules of Practice establishing 37 CFR 1.60, which became effective on September 1, 1971.

RULE 1.60 PRACTICE

The rule 1.60 practice was developed to provide a procedure for filing a continuation or divisional application where hardships existed in obtaining the signature of the inventor on such an application during the pendency of the prior application. It is suggested that the use of the rule 1.60 practice be limited to such instances in view of the additional work required by the Office to make copies and enter preliminary amendments.

Rule 1.60 practice permits persons having authority to prosecute a prior copending application to file a continuation or divisional application without requiring the inventor to again execute an oath or declaration under 35 U.S.C. 115, if the continuation or divisional application is an exact copy of the prior application as executed and filed. It is not necessary to file a new oath or declaration which includes a reference to the non-filing of an application for an inventor's certificate in rule 1.60 applications filed after May 1, 1975. Where the immediate prior application was not signed (for example, where it was filed under the former rule 1.147 or current rule 1.60 practice), a copy of the most recent application having a signed oath or declaration in the chain of copending prior applications under 35 U.S.C. 120 must be used.

The basic concept of rule 1.60 practice is that since the inventor has already made the affirmation required by 35 U.S.C. 115, it is not necessary to make another affirmation in a later application that discloses and claims only the same subject matter. It is for this reason that a rule 1.60 application must be an exact duplicate of an earlier application executed by the inventor. It is permissible to retype pages to provide clean copies.

RULE 1.60 APPLICATION CONTENT

As mentioned previously, a rule 1.60 application must consist of a copy of an executed application as filed (specification, claims, drawings and oath or declaration). The use of transmittal form 3.54 is urged since it acts as a checklist for both applicant and the Office.

Although a copy of all original claims in the prior application must appear in the rule 1.60 application, some of the claims may be canceled by request in the rule 1.60 application in order to

reduce the filing fee (see form 3.54, item 6). Any preliminary amendment presenting additional claims (claims not in the prior application as filed) should accompany the request for filing an application under rule 1.60, but such an amendment will not be entered until after the filing date has been granted. Any claims added by amendment should be numbered consecutively beginning with the number next following the highest numbered original claim in the prior executed application. Amendments made in the prior application do not carry over into the rule 1.60 application. Any preliminary amendment should accompany the rule 1.60 application and be directed to "the accompanying rule 1.60 application" and not to the prior application.

All application copies must comply with 37 CFR 1.52 and must be on paper which permits entry of amendments thereon in ink.

Copies of the application should be prepared and submitted by the applicant, his attorney or agent, and be verified to be true copies by him. The copy of the oath or declaration need not show a copy of the inventor's or notary's signature provided that all other data is shown and an indication is made that the oath or declaration has been signed.

The Patent and Trademark Office will prepare copies of the prior application without charge if the applicant is unable to supply them.

Claims for priority rights under 35 U.S.C. 119 must be made in rule 1.60 applications if it is desired to have the foreign priority data appear on the issued patent. In re Van Esdonk, 187 USPQ 671 (Comm'r Pat. 1975). Reference should be made to certified copies filed in a prior application if reliance thereon is made.

If the claims presented by amendment in a rule 1.60 application are directed to matter shown and described in the prior application but not substantially embraced in the statement of invention or claims originally presented, the applicant should file a supplemental oath or declaration under § 1.67 as promptly as possible.

In view of the fact that rule 1.60 applications are limited to continuations and divisions, no new matter may be introduced in a rule 1.60 application, 35 U.S.C. 132.

A statement to the effect that the verifier believes the submitted copy to be a true copy of the prior application as filed to the best of his information and belief is a sufficient verification, if an explanation is made as to why the statement must be based only on belief.

If the inventorship shown on the original oath or declaration has been changed and approved during the prosecution of the prior application, the rule 1.60 application papers must indicate such a change has been made and approved in order that the changed inventorship may be indicated in the rule 1.60 application. The rule 1.60 application papers should also include any additions or changes in an inventor's citizenship, residence or post office address made and approved in the prior application.

Formal Drawings Required

Formal bristolboard drawings are required in rule 1.60 applications as in other applications. Transfer of drawings from abandoned applications is permitted. If informal drawings are filed with the application papers, a ten dollar comparison fee will be charged at the time when new formal drawings are filed.

Any drawing corrections requested but not made in the prior application should be repeated in the rule 1.60 application if such changes are still desired. If the drawings were changed during the prosecution of the prior application, such drawings may be transferred, however, a copy of the drawings as originally filed must be included in the rule 1.60 application papers to indicate the original content.

Affidavits and declarations, such as those under §§ 1.131 and 1.132 filed during the prosecution of the prior application do not automatically become a part of the rule 1.60 application. Where it is desired to rely on an earlier filed affidavit, the applicant should make his remarks of record in the rule 1.60 application and include a copy of the original affidavit filed in the prior application.

Abandonment of the Prior Application

Under rule 1.60 practice the prior application is not automatically abandoned upon filing of the rule 1.60 application. If the prior application is to be expressly abandoned, such a paper must be signed by the applicant himself, the assignee of record or the attorney or agent of record, § 1.138. A registered attorney or agent not of record acting in a representative capacity under § 1.34(a) may not expressly abandon an application.

If the prior application which is to be expressly abandoned has a notice of allowance issued therein, the prior application can become abandoned by the nonpayment of the base issue fee. However, once a base issue fee has been paid in the prior application, even if the payment occurs following the filing of a continuation application under rule 1.60, a petition to withdraw the prior application from issue must be filed before the prior application can be abandoned (§ 1.313). The checking of box 8 on form 3.54 is not sufficient to expressly abandon an application having a notice of allowance issued

therein and the base issue fee submitted (see § 608.02(i)).

If the prior application which is to be expressly abandoned is before the Board of Appeals or the Board of Interferences, a separate notice should be forwarded by the applicant to such Board, giving notice thereof.

After a decision by the CCPA in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the Patent and Trademark Office, Continental Can Company, Inc., et al. v. Schuyler, 168 USPQ 625 (D.C.D.C. 1970). See § 1216.01.

EXAMINATION

The practice relating to making first action rejections final applies also to rule 1.60 applications, see § 706.07(b).

Where the rule 1.60 application has reached the examining group without a copy of the oath or declaration from the prior application, a copy should be made at the time the prior application is reviewed during examination of the rule 1.60 application.

Any preliminary amendment filed with a rule 1.60 application which is to be entered after granting of the filing date should be entered by the clerical personnel of the examining group where the application is finally assigned to be examined. Accordingly, these applications should be classified and assigned to the proper examining group by taking into consideration the claims that will be before the examiner upon entry of such a preliminary amendment.

If the examiner finds that a filing date has been granted erroneously because the application was incomplete, the application should be returned to the Application Division via the Office of the Assistant Commissioner for Patents.

Form 3.54 is designed as an aid for use by both applicant and the Patent and Trademark Office and should simplify filing and processing of applications under 37 CFR 1.60.

Form 3.54 (modified) Division-continuation program application transmittal form.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. _____

Anticipated Classification of this application:

Class ____ Subclass ____

Prior application:

Examiner _____

Art Unit _____

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231.

SIR: This is a request for filing a ☐ continuation ☐ divisional application under 37 CFR 1.60, of pending prior application serial no. _____ filed on _____
(date)
of _____
(inventor currently of record in prior application)
for _____.
(title of invention)

1. ☐ Enclosed is a copy of the prior application, including the oath or declaration as originally filed and an affidavit or declaration verifying it as a true copy. (See 8 and 8*a* for drawing requirements.)
2. ☐ Prepare a copy of the prior application.
3. ☐ The filing fee is calculated below:

CLAIMS AS FILED IN THE PRIOR APPLICATION, LESS ANY CLAIMS CANCELLED BY AMENDMENT BELOW

For	Number filed	Number extra	Rate	Basic fee $65
Total claims		−10=	× $2=	
Independent claims		− 1=	× 10=	
Total filing fee				

4. ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Account No. _____. A duplicate copy of this sheet is enclosed.
5. ☐ A check in the amount of $ _____ is enclosed.
6. ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
7. ☐ Amend the specification by inserting before the first line the sentence: —This is a ☐ continuation, ☐ division, of application serial no. _____, filed _____.
8. ☐ Transfer the drawings from the prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate copy copy of this sheet is enclosed for filing in the prior application file. (May only be used if signed by person authorized by § 1.138 and before payment of base issue fee.)

8*a*. ☐ New formal drawings are enclosed.

8*b*. ☐ Priority of application serial no. _____ filed on _____ in _____
(country)
is claimed under 35 U.S.C. 119.
☐ The certified copy has been filed in prior application serial no. _____, filed _____.

9. ☐ The prior application is assigned of record to _____.
10. ☐ The power of attorney in the prior application is to _____.
(name, registration number, and address)

a. ☐ The power appears in the original papers in the prior application.

b. ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.

c. ☐ Address all future communications to _____. (May only be completed by applicant, or attorney or agent of record.)

11. ☐ A preliminary amendment is enclosed. (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

12. ☐ I hereby verify that the attached papers are a true copy of prior application serial no. _____ as originally filed on _____. (date)

The undersigned declare further that all statements made herein of his own knowledge are true and that *all statements made on information and belief are believed to be true;* and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

_____ _____
(date) (signature)

Address of signator:
_____
_____

☐ Inventor(s)
☐ Assignee of complete interest
☐ Attorney or agent of record
☐ Filed under § 1.34(a)

201.07 Continuation [R–49]

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned. Except as provided in 37 CFR 1.45, the applicant in the continuing application must be the same as in the prior 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 constitute new matter if inserted in the original application.

At any time before the patenting or abandonment of or termination of proceedings on his earlier application, 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.

For notation to be put on the file wrapper by the examiner in the case of a continuation application see § 202.02.

The Streamlined Continuation Program has been superseded by the rule 1.60 practice which became effective on September 1, 1971 (36 F.R. 12689). See § 201.06(a).

201.08 Continuation-in-Part [R–33]

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). Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

For notation to be put on the file wrapper by the examiner in the case of a continuation-in-part application see § 202.02. See § 708 for order of examination.

201.09 Substitute [R–25]

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. Current practice does not require applicant to insert in the specification reference to the earlier case. The notation on the file wrapper (See § 202.02) that one case is a "Substitute" for another is printed in the heading of the patent copies. See § 201.11.

As is explained in § 201.11 a "Substitute" does not obtain the benefit of the filing date of the prior application.

201.10 Refile [R–33]

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

If the applicant designates his application as "refile" 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 "refile," 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 Division of any assignment of the parent case that may have been made.

201.11 Continuity Between Applications: When Entitled to Filing Date [R–49]

Under certain circumstances an application for patent is entitled to the benefit of the filing date of a prior application of the same inventor. The conditions are specified in 35 U.S.C. 120.

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 the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor 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.**

There are three conditions in addition to the basic requirement that the two applications be by the same inventor:

1. The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or original application); the disclosure of invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See In re Ahlbrecht, 168 USPQ 293 (CCPA 1971).

2. The continuing application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application.

3. The continuing application must contain a specific reference to the prior application(s) in the specification.

The term "same inventor" has been construed in *In re Schmidt*, 1961 C.D. 542; 130 USPQ 404, to include a continuing application of a sole inventor derived from an application of joint inventors where a showing was made that the joinder involved error without any deceptive intent (35 U.S.C. 116). See § 201.06.

Copendency

Copendency is defined in the clause which requires that the second application must be filed before (a) the patenting, or (b) the abandonment of, or (c) the termination of proceedings in the first application.

If the first application issues as a patent, it is sufficient for the second application to be copending with it if the second application is filed on the same date, or before the date the patent issues on the first application. Thus, the second application may be filed while the first is still pending before the examiner, while it is in issue, or even between the time the issue fee is paid and the patent issues.

If the first application is abandoned, the second application must be filed before the abandonment in order for it to be copending with the first. The term "abandoned," refers to abandonment for failure to prosecute (§ 711.02), express abandonment (§ 711.01), and abandonment for failure to pay the issue fee (§ 712). If an abandoned application is revived (§ 711.03 (c)) or a petition for late payment of the issue fee (§ 712) is granted by the Commissioner, it becomes reinstated as a pending application and the preceding period of abandonment has no effect.

The expression "termination of proceedings" is new in the statute, although not new in practice. Proceedings in an application are obviously terminated when it is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

After a decision by the Court of Customs and Patent Appeals in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the Patent and Trademark Office. Continental Can Company, Inc. et al. v. Schuyler, 168 USPQ 625 (D.C.D.C. 1970). There are several other situations in which proceedings are terminated as is explained in § 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 of the same inventor, and the second application may be referred to as a continuing application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter.

Reference to First Application

The third requirement of the statute is that the second (or subsequent) application must contain a specific reference to the first application. This should appear as the first sentence of the specification following the title and abstract, preferably as a separate paragraph. Status of the parent applications (whether it is patented or abandoned) should also be included. If a parent application has become a patent, the expression ", Patent No. ———" should follow the filing date of the parent application. If a parent application has become abandoned, the expression ", abandoned" should follow the filing date of the parent application. In the case of design applications, it should appear as set forth in § 1503.01. In view of this requirement, the right to rely on a prior application may be waived or refused by an applicant by refraining from inserting a reference to the prior application in the specification of the later one. If the examiner is aware of the fact that an application is a continuing application of a prior one, he should merely call attention to this in an Office action, for example, in the following language:

"It is noted that this application appears to claim subject matter disclosed in applicant's prior copending application Serial No. ------, filed ----------. A reference to this prior application must be inserted in the specification of the present application if applicant intends to rely on the filing date of the prior application. 37 CFR 1.78."

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

In rule 1.60 cases, applicant, in his amendment canceling the nonelected claims, should include directions to enter "This is a division (continuation) of application Serial No. ------, filed ----------" as the first sentence following the abstract. Where the applicant has inadvertently failed to do this and the rule 1.60 case is otherwise ready for allowance, the examiner should insert the quoted sentence by examiner's amendment.

Applications are sometimes filed with a division, continuation, or continuation-in-part oath or declaration, in which the oath or declaration refers back to a prior application. If there is no reference in the specification, in such cases, the examiner should merely call attention to this fact in his Office action, utilizing, for example, the language suggested in the first paragraph of this subsection.

Where the applicant has inadvertently failed to make a reference to the parent case in an application filed under 37 CFR 1.60 which is otherwise ready for issue, the examiner should insert the required reference by examiner's amendment.

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 desires that the pending application have the benefit of the filing date of the first filed application he must, besides making reference in the specification to the intermediate application, also make reference in the specification to the first application. See Hovlid v. Asari et al., 134 USPQ 162; 305 F. 2d 747 and Sticker Industrial Supply Corp. v. Blaw-Knox Co. et al., 160 USPQ 177.

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, 158 USPQ 224; 853 O.G. 17.

A second application which is not copending with the first application, which includes those called substitutes in § 201.09, is not entitled to the benefit of the filing date of the prior application and the bars to the grant of a patent are computed from the filing date of the second application. An applicant is not required to refer to such applications in the specification of the later filed application. If the examiner is aware of such a prior abandoned application he should make a reference to it in an Office action in order that the record of the second application will show this fact.

If an applicant refers to a prior noncopending abandoned application in the specification, the manner of referring to it should make it evident that it was abandoned before filing the second.

For notations to be placed on the file wrapper in the case of continuing applications see §§ 202.02 and 1302.09.

When Not Entitled To Benefit of Filing Date

Where the first application is found to be fatally defective because of insufficient disclosure to support allowable claims, a second 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, 83 USPQ 277 at 281 and cases cited therein. [R–46]

201.12 Assignment Carries Title [R–24]

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. See § 306.

201.13 Right of Priority of Foreign Application [R–46]

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, to overcome an intervening reference or for similar purposes. The conditions are specified in 35 U.S.C. 119.

35 U.S.C. 119. Benefit of earlier filing date in foreign country; right to priority. 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, 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 twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any 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 more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

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.

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. (effective August 25, 1973) Public Law 92-358, July 28, 1972.

The period of twelve months specified in this section is six months in the case of designs, 35 U.S.C. 172. See § 1506.

The conditions, for benefit of the filing date of a prior application filed in a foreign country, may be listed as follows:

1. 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."

2. The foreign application must have been filed by the same applicant (inventor) as the applicant in the United States, or by his legal representatives or assigns.

3. The application, or its earliest parent United States application under 35 U.S.C. 120, must have been filed within twelve months from the date of the earliest foreign filing in a "recognized" country as explained below.

4. The foreign application must be for the same invention as the application in the United States.

5. In the case where the basis of the claim is an application for an inventor's certificate, the requirements of rule 55(c) must also be met.

Recognized Countries of Foreign Filing

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 our statute. The right of priority originated in a multilateral treaty of 1883, to which the United States adhered in 1887, known as the International Convention for the Protection of Industrial Property 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 852 O.G. 511). 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 treaty 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. There is another treaty between the United States and some Latin American countries which also provides for the right of priority. A foreign country may also provide for this right by reciprocal legislation.

Note: Following is a list of countries with respect to which the right of priority referred to in 35 U.S.C. 119 has been recognized. The authority in the case of these countries is the International Convention for the Protection of Industrial Property (613 O.G. 23, 53 Stat. 1748), indicated by the letter I following the name of the country; the Inter-American Convention relating to Inventions, Patents, Designs and Industrial Models, signed at Buenos Aires, August 20, 1910 (207 O.G. 935, 38 Stat. 1811), indicated by the letter P after the name of the country; or reciprocal legislation in the particular country, indicated by the letter L following the name of the country. Algeria (I), Argentina (I), Australia (I), Austria (I), Belgium (I), Brazil (I, P), Bulgaria (I), Cameroon (I), Canada (I), Central African Republic (I), Chad, Republic of (I), Congo, (I), Costa Rica (P), Cuba (I, P), Cyprus (I), Czechoslovakia (I), Dahomey (I), Denmark (I), Dominican Republic (I, P), Ecuador (P), Egypt (I), Finland (I), France (I), Gabon (I), German Democratic Republic (I) effective December 4, 1975, Germany, Federal Republic of (I), Greece (I), Guatemala (P), Haiti (I, P), Holy See (I), Honduras (P), Hungary (I), Iceland (I), Indonesia (I), Iran (I), Ireland (I), Israel (I), Italy (I), Ivory Coast, Republic of (I), Japan (I), Jordan (I), Kenya (I), Korea (L), Lebanon (I), Liechtenstein (I), Luxembourg (I), Malagasy, Republic of (I), Malawi (I), Malta (I), Mauritania (I), Mexico (I), Monaco (I), Morocco (I), Netherlands (I), New Zealand (I), Nicaragua (P), Niger (I), Nigeria, Federation of (I), Norway (I), Panama (P), Paraguay (P), Philippines (I), Poland (I), Portugal (I), Romania (I), San Marino (I), Senegal, Republic of (I), South Africa, Republic of (I), Southern Rhodesia (I), Spain (I), Sri Lanka (formerly Ceylon) (I), Sweden (I), Switzerland (I), Syrian Arab Republic (I), Togo (I) Trinidad and Tobago (I), Tunisia (I), Turkey (I), Uganda (I), U.S.S.R. (I), United Kingdom (I), United Republic of Tanzania (I), Upper Volta, Republic

of (I), Uruguay (I, P), Viet-Nam, Republic of (I), Yugoslavia (I), Zaire (I), Zambia (I).

Thirteen African Countries have joined together to create a common patent office and to promulgate a common law for the protection of inventions, trademarks, and designs. The common patent office is called "Office Africain et Malgache de la Propriete Industrielle" (OAMPI) and is located in Yaounde, Cameroon. The member countries using the OAMPI Patent Office are Cameroon; Central African Republic; Congo, Republic of; Chad, Republic of; Dahomey; Gabon; Ivory Coast, Republic of; Malagasy, Republic of; Mauritania; Niger; Senegal, Republic of; Togo; and Upper Volta, Republic of. Since all these countries adhere to the International Convention for the Protection of Industrial Property, priority under 35 U.S.C. 119 may be claimed of an application filed in the OAMPI Patent Office.

If any applicant asserts the benefit of the filing date of an application filed in a country not on this list, the examiner should inquire 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.

Identity of Inventors

The inventors of the U.S. application and of the foreign application must be the same, for a right of priority does not exist in the case of an application of inventor A in the foreign country and inventor B in the United States, even though the two applications may be owned by the same party. However the application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor which is permitted in some foreign countries, rather than by the inventor himself, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. An indication of the identity of inventors made in the oath or declaration accompanying the U.S. application by identifying the foreign application and stating that the foreign application had been filed by the assignee, or the legal representative, or agent, of the inventor, or on behalf of the inventor, as the case may be, is acceptable.

Time for Filing U.S. Application

The United States application, or its earliest parent application under 35 U.S.C. 120, must have been filed within twelve months of the foreign filing. In computing this twelve months, the first day is not counted; thus, if an application was filed in Canada on January 2, 1975, the U.S. application may be filed on January 2, 1976. The 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 six 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 Sunday or a holiday within the District of Columbia, the U.S. application is in time if filed on the next succeeding business day; thus, if the foreign application was filed on September 6, 1952, the U.S. application is in time if filed on September 8, 1953, since September 6, 1953 was a Sunday and September 7, 1953 was a holiday. Since January 1, 1953, the Office has not received applications on Saturdays and, in view of 35 U.S.C. 21, and the 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 4C3), if the twelve months expires on Saturday, the U.S. application may be filed on the following Monday.

First Foreign Application

The twelve months is from the earliest foreign filing except as provided in the second to the last paragraph of 35 U.S.C. 119. If an inventor has filed an application in France on January 2, 1952, and an application in the United Kingdom on March 3, 1952, and then files in the United States on February 2, 1953, he is not entitled to the right of priority at all; he 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 he would not be entitled to the benefit of the date of the United Kingdom application since this application is not the first one filed. 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.

Public Law 87–333 extended the right of priority to "subsequent" foreign applications if one earlier filed had been withdrawn, abandoned or otherwise disposed of, under certain conditions and for certain countries only.

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.

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.

EFFECT OF RIGHT OF PRIORITY

The right to rely on the foreign filing extends to overcoming the effects of intervening references or uses, but there are certain restrictions. For example the one year bar of 35 U.S.C. 102(b) dates from the U.S. filing date and not from the foreign filing date; thus if an invention was described in a printed publication, or was in public use in this country, in November 1974, a foreign application filed in January 1975, and a U.S. application filed in December 1975, granting a patent on the U.S. application is barred by the printed publication or public use occurring more than one year prior to its actual filing in the U.S.

The right of priority can be based upon an application in a foreign country for a so-called "utility model," called Gebrauchsmuster in Germany.

201.13(a) Right of Priority based upon an Application for an Inventor's Certificate [R–46]

Until August 25, 1973, the Patent and Trademark Office did not recognize a right of priority based upon an application for an Inventors' Certificate such as used in the U.S.S.R. However, a claim for priority and a certificated copy of an application for Inventors' Certificate were entered in the file of the U.S. application and were retained therein. This allowed the applicant to urge the right of priority in possible later court action.

On August 25, 1973, Articles 1–12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, came into force with respect to the United States and apply to applications filed thereafter in the United States. A fourth paragraph to 35 U.S.C. 119 (enacted by Public Law 92–358, July 28, 1972) (copy at § 201.13) and a new paragraph (c) to rule 55 (905 O.G. 684) also became effective on August 25, 1973.

Rule 55. **Serial number and filing date of application.**

* * * * *

(c) An applicant may under certain circumstances claim priority on the basis of an application for an inventor's certificate in a country granting both inventor's certificates and patents. When an applicant wishes to claim the right of priority as to a claim or claims of the application on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119, last paragraph (as amended July 28, 1972), the applicant or his attorney or agent, when submitting a claim for such right as specified in paragraph (b) of this rule, shall include an affidavit or declaration including a specific statement that, upon an investigation, he has satisfied himself that to the best of his knowledge the applicant, when filing his application for the inventor's certificate, had the option to file an application either for 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.

An inventor's certificate may form the basis for rights of priority under 35 U.S.C. 119 only in countries maintaining patents and inventor's certificates as alternative systems for the recognition and reward of inventive contributions where an applicant has the right to apply at his discretion for either grant. Some countries such as Bulgaria, Rumania, and the Soviet Union provide alternatively for either patents or inventor's certificates on some types of inventions for some inventors.

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 his invention in his 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 insure compliance with the treaty and statute, rule 55(c) provides that at the time of claiming the benefit of priority for an inventor's certificate, the applicant or his attorney must submit an affidavit or declaration stating that the applicant when filing his 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.

Effective Date

Rule 55(c) went into effect on August 25, 1973, which is the date on which the international treaty entered into force with respect to the United States. The rights of priority based on an earlier filed inventor's certificate shall be granted only with respect to U.S. patent applications where *both* the earlier application and the U.S. patent application were filed in their

respective countries following this effective date.

201.14 Right of Priority, Formal Requirements [R–46]

Under the statute (35 U.S.C. 119, second paragraph), 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 requirements of the statute are (a) that the applicant must file a claim for the right and (b) he must also file a certified copy of the original foreign application; these papers must be filed within a certain time limit. The maximum time limit specified in the statute is that the papers must be filed before the patent is granted, but the statute gives the Commissioner authority to set this time limit at an earlier time during the pendency of the application. If the required papers are not filed within the time limit set the right of priority is lost. A reissue was granted in Brenner v. State of Israel, 862 O.G. 661; 158 USPQ 584, where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted.

It should be particularly noted that these papers must be filed in all cases even though they may not be necessary during the pendency of the application to overcome the date of any reference. The statute also gives the Commissioner authority to require a translation of the foreign documents if not in the English language and such other information as he may deem necessary.

Rule 65 requires that the oath or declaration shall state whether or not any application for patent or inventors' certificate on the same invention has been filed in any foreign country either by the applicant or by his legal representatives or assigns; if any foreign application has been filed the applicant must state the country and the date of filing of the earliest such application and he must also identify every foreign application which was filed more than twelve months before the filing of the application in this country. If all foreign applications have been filed within twelve months of the U.S. filing the applicant is required to recite only the first such application and it should be clear in the recitation that the foreign application referred to is the first filed foreign application.

The requirements for recitation of foreign applications in the oath or declaration, while serving other purposes as well, are used in connection with the right of priority.

201.14(a) Right of Priority, Time for Filing Papers [R–39]

The time for filing the priority papers required by the statute is specified in the second paragraph of rule 55.

Rule 55(b). An applicant may claim the benefit of the filing date of a prior foreign application under the conditions specified in 35 U.S.C. 119. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by rule 65. The claim for priority and the certified copy of the foreign application specified in the second paragraph of 35 U.S.C. 119 must be filed in the case of interference (rule 224); when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, and in all other cases they must be filed not later than the date the issue fee is paid. If the papers filed are not in the English language, a translation need not be filed except in the three particular instances specified in the preceding sentence, in which event a sworn translation or a translation certified as accurate by a sworn or official translator must be filed.

It should first be noted that the Commissioner has by rule specified an earlier ultimate date than the date the patent is granted for filing a claim and a certified copy. The latest time at which the papers may be filed is the date of the payment of the issue fee, except that, under certain circumstances, they are required at an earlier date. These circumstances are specified in the rule as (1) in the case of interferences in which event the papers must be filed within the time specified in the interference rules, (2) when necessary to overcome the date of a reference relied upon by the examiner, and (3) when specifically required by the examiner.

In view of the shortened periods for prosecution leading to allowances, it is recommended that priority papers be filed as early as possible. Although rule 55 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 there is not sufficient time to remedy the defect. Occasionally 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 also suggested that a pencil notation of the serial number of the corresponding U.S. application be placed on the priority papers.

Priority papers filed after the date of payment of the base issue fee will be accepted and acknowledged only if a petition under rule 183 to suspend rule 55 is filed and granted. Such petitions are granted only in extraordinary situations, when justice requires and where the printing of the patent has not yet taken place. Ex parte Bueche-Roose, 100 USPQ 439; In re Inoue, 171 USPQ 634.

201.14(b) Rights of Priority, Papers Required [R–46]

The filing of the priority papers under 35 U.S.C. 119 makes the record of the file of the United States patent complete. The Patent and Trademark Office does not 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 as described in § 201.15 and in cases of interferences.

The papers required are the claim for priority and the certified copy of the foreign application. The claim to priority need be in no special form, and may be made by the attorney or agent at the time of transmitting the certified copy if the foreign application is the one referred to in the oath or declaration of the U.S. application. 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. The claim for priority may appear in the oath or declaration with the recitation of the foreign application.

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 application as filed with a certificate of the foreign patent office giving certain information. "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. A French patent stamped "Service De La Propriété Industrielle—Conforme Aux Piéces Déposées A L' Appui de La Demande" and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application.

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 make no examination of the papers except to see that they correspond in date and country to the application identified in the oath or declaration and contain no obvious formal defects. 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.

During Interference

If priority papers are filed in an interference, it is not necessary to file an additional certified copy in the application file. The interference examiner will place them in the application file.

Later Filed Applications, Reissues

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 as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. 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 § 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 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 following exemplary language should be used:

> "Applicant is reminded that in order for a patent issuing on the instant application, to contain the priority data based on priority papers filed in parent application Serial No. ------ under 35 U.S.C. 119, a claim for such priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers."

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 § 707.

201.14(c) Right of Priority, Practice [R-49]

Before going into the practice with respect to those instances in which the priority papers are used to overcome a reference, there will first be described the practice when there is no occasion to use the papers, which will be in the majority of cases. In what follows in this section it is assumed that no reference has been cited which requires the priority date to be overcome.

No Irregularities

When the papers under 35 U.S.C. 119 are received they are to be endorsed on the contents page of the file as "Letter (or amendment) and foreign application". Assuming that the papers are 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, note copy in § 707.

The examiner will enter the information specified in § 202.03 on the face of the file wrapper.

If application is in interference when papers under 35 U.S.C. 119 are received see § 1111.10.

Papers Inconsistent

If the certified copy filed does not correspond to the application identified in the application oath or declaration, or if the application oath or declaration does not refer to the particular foreign application, the applicant has not complied with the requirements of the rule relating to the oath or declaration. In such instances the examiner's letter, after acknowledging receipt of the papers, should require the applicant to explain the inconsistency and to file a new oath or declaration stating correctly the facts concerning foreign applications required by § 1.65. A letter in such cases may read:

[2] "Receipt is acknowledged of papers filed _____, based on an application filed in _____ on _____. Applicant has not complied with the requirements of 37 CFR 1.65(a), since the (*oath or declaration*) does not acknowledge the filing of any foreign application. A new (*oath or declaration*) is required."

Other situations requiring some action by the examiner are exemplified by the following sample letters.

No Claim for Priority

[3] "Receipt is acknowledged of a certified copy, filed _____, of the _____ application referred to in the (oath or declaration). If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119, applicant should also file a claim for priority as required by said section."

Note: Where the accompanying letter states that the certified copy is filed for priority purposes or for the convention date, it is accepted as a claim for priority.

Foreign Applications All More Than a Year Before Earliest Effective U.S. Filing

[4] "Receipt is acknowledged of the filing on _____, of a certified copy of the _____ application referred to in the (*oath or declaration*). A claim for priority can not be based on said application, since the United States application was filed more than twelve months thereafter." The papers are accordingly being returned."

Some Foreign Applications More Than a Year Before U.S. Filing

For example, British provisional specification filed more than a year before U.S. application, but British complete filed within the year, and certified copies of both submitted.

[5] "Receipt is acknowledged of papers filed on September 18, 1953, purporting to comply with the requirements of 35 U.S.C. 119. It is not seen how the claim for priority can be based on the British specification filed January 23, 1948, 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, 1948, for such subject matter as was not disclosed in the provisional specification."

Certified Copy Not the First Filed Foreign Application

[6] "Receipt is acknowledged of papers filed on _____ (date), purporting to comply with the requirements of 35 U.S.C. 119 and they have been placed of record in the file.

Attention is directed to the fact that the date for which priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration. However, the priority date claimed which will appear in the printed heading of the patent will be _____ (date claimed)."

No Certified Copy

[7] "Acknowledgment is made of applicant's claim for priority based on an application filed in _____ on _____. It is noted, however, that applicant has not filed a certified copy of the _____ application as required by 35 U.S.C. 119."

The above letters are merely typical ones which have been used, and any unusual situation may be referred to the group director.

Application in Issue

When priority papers for applications which have been sent to the Patent Issue Division are received, the priority papers should be sent to the Patent Issue Division. The Patent Issue Division will acknowledge receipt of all such priority papers.

Return of Papers

It is sometimes necessary for the examiner to return papers filed under 35 U.S.C. 119 either upon request of the applicant, for example, to obtain a sworn translation of the certified copy of the foreign application, or because they fail to meet a basic requirement of the statute, such as where all foreign applications were filed more than a year prior to the U.S. filing date.

Where the papers have not been given a paper number and endorsed on the file wrapper, it is not necessary to secure approval of the Commissioner for their return but they should be sent to the group director for cancellation of the Office stamps. Where the papers have been made of record in the file (given a paper number and endorsed on the file wrapper), a request for permission to return the papers should be addressed to the Commissioner of Patents and Trademarks and forwarded to the group director for approval. Where the return is approved, the written approval should be placed in the file wrapper. Any questions relating to the return of papers filed under 35 U.S.C. 119 should be directed to the Office of the Deputy Assistant Commissioner for Patents.

201.14(d) Proper Identification of Priority Application [R-43]

In order to help overcome problems in determining the proper identification of priority applications for patent documentation and printing purposes, the following tables have been prepared which set out for 43 countries the forms of acceptable presentation of application numbers.

The tables should enable applicants, examiners and others to extract from the various formats the minimum required data which comprises a proper citation.

Proper identification of priority applications is essential to establishing accurate and complete relationships among various patent documents which reflect the same invention. Knowledge of these relationships is essential to search file management, technology documentation and various other purposes.

The tables show the forms of presentation of application numbers as used in the records of the source or orginating patent office. They also show, under the heading "Minimum Significant Part of the Number", the simplified form of presentation which should be used in United States Patent and Trademark Office records.

Note particularly that in the simplified format that:

(1) Alpha symbols preceding numerals are eliminated in all cases except Hungary.

(2) A decimal character and numerical subset as part of a number is eliminated in all cases except France.

(3) Use of the dash (—) is reduced, but is still an essential element of application numbers, in the case of Czechoslovakia, Japan, and Venezuela.

MINIMUM SIGNIFICANT PART OF AN APPLICATION NUMBER PROVIDING UNIQUE IDENTIFICATION OF AN APPLICATION

TABLE I—*Countries Using Annual Application Number Series*

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Austria [OE]	A 12116/69	12116/69	The letter A is common to all patent applications.
Czechoslovakia [CS]	PV3628-72	3628-72	PV is an abbreviation meaning "application of invention".
Denmark [DK]	2986/68	2986/68	
Egypt [ET]	487 1968	487 1968	
Finland [SF]	3032/69	3032/69	
France [FR]	69.38066	69.38066	
Germany, Fed. Rep. of [DT]	P 1940738.6-24	1940738	P=Patent. The first two digits of the number represent the last two digits of the year of Application less 50 (e.g., 1969 less 50=19; 1973 less 50=23). The first digit after the period is an error control digit. The two digits following the dash indicate the examining division.

See footnotes at end of table.

TABLE I.—*Countries Using Annual Application Number Series*—Continued

Country #	Example of application number at source	Minimum significant part of the number	Remarks
	G 6947580.5	*6947580	G=Gebrauchsmuster. The first two digits represent the last two digits of the year of the application. The difference in numbering scheme of the first two digits affords unique identification of this type of application. However, see note below (*). The digit after the period is for error control.
India [IN]	643/58	643/58	
Ireland [EI]	1152/69	1152/69	
Italy [IT]	28039-A/70	28039/70	Application numbers are not presented on published patent documents or given in an official gazette. An exclusive block of application numbers is given annually to each of 93 provincial bureaus where patent applications may be filed. In 1973, 90,000 numbers were allotted, whereas an estimated total of 30,000 applications are expected to be filed. While, as a consequence, gaps will exist in the ultimately used numbers, each application has a unique number. For this purpose, neither the dash nor the letter identifying the receiving bureau, which follow the application number, is needed.
Japan [JA]	46-69807 46-81864	46-69807 *46-81864	The two digits before the dash indicate the year of the Emperor's reign in which the application was filed (46=1971). Patent and utility model applications are numbered in separate series. The examples given were filed on the same day.
Netherlands [NL]	7015038	7015038	First two digits indicate year of application.
Norway [NO]	1748/70	1748/70	
Pakistan [PK]	1031/65	1031/65	
South Africa [ZA]	70/4865	70/4865	
Sweden [SW]	16414/70 (old system). 7300001-0 (new system).	16414/70 7300001	The new numbering system was introduced January 1, 1973. First two digits indicate year of application. The digit after the dash is used for computer control.
Switzerland [CH]	15978/70	15978/70	
United Kingdom [GB]	41352/70	41352/70	
Venezuela [VE]	2122-68	2122-68	
Yugoslavia [YU]	P1135/66	1135/66	
Zambia [ZB]	142/70	142/70	

#ICIREPAT Country Code is indicated in brackets; e.g., Austria [OE].

*In order to distinguish utility model applications from patent applications, it is necessary to identify them as to type of application in citations or references. This may be done either by using the name of the application type in conjunction with the number or by using the symbol "U" in brackets or other enclosure following the number.

TABLE II.—*Countries Using Other Than An Annual Application Number Series*

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Argentina [AR]	231790	231790	
Australia [AU]	59195/69	59195/69	Long series spread over several years. New series started in 1970.
Belgium [BE]	96469	96469	Application numbers are not presented on published patent documents or given in an official gazette. A series of parallel numbers is provided to each of 10 offices which, respectively, may receive applications (control office +9 provincial bureaus) and assign application numbers. Present series was started in 1958. Since an application number does not uniquely identify a BE document, the patent number is often cited as the "priority application number"
Brazil [BR]	222986	222986	
Bulgaria [BG]	11572	11572	
Canada [CA]	103828	103828	
Colombia [CO]	126050	126050	
Cuba [CU]	33384	33384	
German (Dem. Rep.) [DL]	AP84c/137355. WP35b/147203	137355 147203	AP=Ausschliessungspatent; WP=Wirtschaftspatent. The other symbols before the slash are classification symbols. A single numbering series covers both AP and WP applications.
Greece [GR]	44114	44114	
Hungary [HU]	OE 107	OE 107	The letters preceding the number are essential for identifying the application. They are the first letter and the first following vowel of the applicant's name. There is a separate numbering series for each pair of letters.
Israel [IL]	35691	35691	
Luxembourg [LU]	60093	60093	
Mexico [MX]	123723	123723	
Monaco [MC]	908	908	
New Zealand [NZ]	161732	161732	
OAPI	52118	52118	
Philippines [RP]	11929	11929	
Poland [PO]	P144826 44987	144826 *44987	
Portugal [PT]	52555 5607	52555 *5607	
Romania [RU]	65211	65211	
Soviet Union [SU]	1397205/30-15	1397205	The numbers following the slash denote the examination division and a processing number.
United States [US]	889877	889877	The highest number assigned in the series of numbers started in January 1960. New series started January 1970.

#ICIREPAT Country Code is indicated in brackets; e.g. [AR].

*In order to distinguish utility model applications from patent applications, it is necessary to identify them as to type of application in citations or references. This may be done either by using the name of the application type in conjuction with the number or by using the symbol "U" in brackets or other enclosure following the number.

201.15 Right of Priority, Overcoming a Reference [R–24]

The only time 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. If at the time of making an action the examiner has found such a reference, he simply rejects whatever claims may be considered unpatentable thereover, without paying any attention to the priority date (assuming the papers have not yet been filed). The applicant in his response may argue the rejection if it is of such a nature that it can be argued, or he may present the foreign papers for the purpose of overcoming the date of the reference. If the applicant argues the reference, the examiner, in his next action in the case, may, if he so desires, specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or he may merely continue the rejection. In those cases where the applicant files the foreign papers for the purpose of overcoming the effective date of a reference a translation is required, if the foreign papers are not in the English language. When the examiner requires the filing of the papers, the translation should also be required at the same time. This translation must be a sworn translation or a translation certified as accurate by a sworn or official translator. When the necessary papers are filed to overcome the date of the reference, the examiner's action, if he 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 he is entitled to the date, the rejection is withdrawn in view of the priority date.

If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. If the applicant is found to be entitled to the date, the reference is simply not used. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are 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 the assignee or legal representative or agent of the inventor, in his or its own name as applicant. In such cases, if the certified copy of the foreign application corresponds with the one identified in the oath or declaration as required by rule 65 and no discrepancies appear, it may be assumed that the inventors are the same. If there is disagreement as to inventors on the certified copy, the priority date should be refused until the inconsistency or disagreement is resolved.

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 he would be entitled to under our 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 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 of November 1936, pages 770–774. According to British 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 British 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.

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 date on which the specification and drawing were filed.

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. Occasionally 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.

201.16 Extension of Period of Priority, Public Law 690 [R–24]

On August 8, 1946, Congress passed an act, Public Law 690 (sometimes referred to as the Boykin Act), providing for extensions of the period to take care of delays during the war. Public Law 220, July 23, 1947, Public Law 380, August 6, 1947, and Public Law 619, November 16, 1954, supplement the original enactment. These laws are reprinted in the back of the Patent Laws pamphlet.

201.17 Government Cases [R–24]

The term "Act of 1883 application" was used in referring to applications of government employees filed without fee under an act dated March 3, 1883, which was amended April 30, 1928. This act became 35 U.S.C. 266, which was repealed October 25, 1965. Beginning with this date, there are no longer any applications which are exempt from the filing fee or issue fee. Such applications are not always owned by the government. Other applications, not inventions of government employees, may be assigned to and owned by the government. See § 607.01.

202 Cross-Noting

202.01 In Specification [R–31]

Rule 78. Cross-references to other applications. (a) When an applicant files an application claiming an invention disclosed in a prior filed copending application of the same applicant, the second application must contain or be amended to contain in the first sentence of the specification following the title and abstract a reference to the prior application, identifying it by serial number and filing date and indicating the relationship of the applications, if the benefit of the filing date of the prior application is to be claimed. Cross-references to other related applications may be made when appropriate. (See rule 14(b).)

See also rule 79 and § 201.11.

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 on File Wrapper of a Divisional, Continuation, Continuation-in-Part, or Substitute Application [R–36]

The heading of a printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, substitute, and reissue applications. Therefore, the identifying data of all parent or prior applications, when given in the specification must be inserted by the examiner in black ink on the file wrapper in the case of a DIVISION, a CONTINUATION, a CONTINUATION-IN-PART and, whether given in the specification or not, in the case of a SUBSTITUTE Application. The "None" boxes must be marked when no parent or prior application information is present on the file wrappers containing such boxes. This should be done no later than the first action.

The inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

See § 306 for work done by the Assignment Division pertaining to these particular types of applications.

In the unlikely situation that there has been no reference to a parent application because the benefit of its filing date is not desired, no notation as to the parent case is made on the face of the file wrapper.

202.03 On File Wrapper When Priority Is Claimed for Foreign Application [R–31]

In accordance with § 201.14(c) the examiner will fill in the spaces concerning foreign applications on the face of the older file wrappers.

The information to be written on the face of the file wrapper consists of the country, application date (filing date), and if available, the application and patent numbers. In some instances, the particular nature of the foreign application such as "utility model" (Germany (Gebrauchsmuster) and Japan) must be written in parentheses before the application number. For example: Application Number (utility model) B62854.

At the present time, the computer printed file wrapper labels include the prior foreign application information. However, the examiner must still indicate whether the conditions of 35 U.S.C. 119 have been met.

If the filing dates of several foreign applications are claimed (see § 201.15, last paragraph) and satisfactory papers have been received for each, information respecting each of the foreign applications is to be entered on the face of the file wrapper.

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 application in those cases in which the face of the file has been endorsed.

In the case of designs, only the country and filing date are to be used. [R–44]

202.04 In Oath or Declaration [R–44]

As will be noted by reference to § 201.14, rule 65 requires that the oath or declaration include certain information concerning applications filed in any foreign country. If no applications for patent or inventor's certificate have been filed in any foreign country, the oath or declaration should so state.

202.05 In Case of Reissues [R–31]

Rule 179 requires that a notice be placed in the file of an original patent for which an application for reissue has been filed. See § 1401.03.

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 [R–22]

An 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 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 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–44]

An "allowed" application or an application "in issue" is one which, having been examined, is passed to issue as a patent, subject to payment of the issue fee. Its status as an "allowed" case continues from the date of the notice of allowance until it is withdrawn from issue or until it issues as a patent or becomes abandoned, as provided in rule 316. See § 712.

The files of allowed cases are kept in the Patent Issue Division, arranged numerically by serial number.

203.05 Abandoned [R–22]

An abandoned application is, *inter alia*, one which is removed from the Office docket of pending cases (1) through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or by the attorney or agent of record, (2) through failure of applicant to take appropriate action at some stage in the prosecution of the case, or (3) for failure to pay the issue fee. (§§ 203.07, 711 to 711.05, 712)

203.06 Incomplete [R–23]

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

203.07 Abandonment for Failure to Pay Issue Fee [R–44]

An allowed application in which the Base Issue Fee is not paid within three months after the Notice of Allowance is abandoned for that reason. The issue fee may however be accepted by the Commissioner on a verified showing that the delay in payment was unavoidable, in which case the patent will issue as though no abandonment had occurred (§ 712).

203.08 Status Inquiries [R–31]

In an effort to sharply reduce the volume and need for status inquiries, the past policy that diligence must be established by making timely status requests in connection with petitions to revive has been discontinued.

When an application has been abandoned for an excessive period before the filing of a petition to revive, an appropriate terminal disclaimer may be required. It should also be recognized that a petition to revive must be accompanied by the proposed response unless it has been previ-

ously filed (rule 137). Also, under rule 113, "Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form."

New Application

Current examining procedures now provide for the routine mailing from the examining groups of Form POL–327 in *every* case of allowance of an application except where an Examiner's Amendment is promptly mailed. Thus, the separate mailing of a form POL–327 or an Examiner's Amendment in addition to a formal Notice of Allowance (POL–85) in all allowed cases would seem to obviate the need for status inquiries even as a precautionary measure where the applicant may believe his 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 is not received within three months from receipt of either a form POL–327 or an Examiner's Amendment.

Current examining procedures also aim to minimize the spread in dates among the various examiner dockets of each art unit and group 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 cases for action.

Therefore, it should be rarely necessary to query the status of a new application.

Amended Applications

Amended cases are expected to be taken up by the examiner and an action completed within two months of the amendment date. Accordingly, a status inquiry is not in order after response by the attorney until five or six months have elapsed with no response from the Office. A post card receipt for responses to Office actions, adequately and specifically identifying the papers filed, will be considered *prima facie* proof of receipt of such papers. Where such proof indicates the timely filing of a response, the submission of a copy of the post card with a copy of the response will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely response to a final action will obviate the need for a petition to revive only if the response was in compliance with rule 113.

In General

Such status inquiries as may be still necessary may be more expeditiously processed by the Office if each inquiry includes the application Serial Number, filing date, name of the applicant, name of the examiner who prepared the most recent Office action, and group art unit (taken from the most recent Office communication) in addition to the last known status of the application, and is accompanied by a stamped return-addressed envelope.

Status replies will be made by the Office clerical support force and will only indicate whether the application is awaiting action by the examiner or the applicant's response to an Office action. In the latter instance the mailing date of the Office action will also be given.

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 Correspondence and Mail Division, to the examining groups 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.

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

The original letter of inquiry should be returned to the correspondent together with the reply. The reply to an inquiry which includes a self-addressed, postage-paid postcard should be made on the postcard without placing it in an envelope.

In cases of allowed applications, a memorandum should be pinned to the inquiry with a statement of date it was forwarded to the Patent Issue Division by way of the Security Group, and transmitted to the Patent Issue Division for its appropriate action. This Division will notify the inquirer of the date of the notice of allowance and the status of the application with respect to payment of the issue fee and abandonment for failure to pay the issue fee.

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.

Another type of inquiry is to be distinguished from ordinary status letters. When a U.S. application is referred to in a foreign patent (for priority purposes, for example), inquiries as to the status of said application (abandoned, pending, patented) should be forwarded to the Application Division (§ 102).

Telephone inquiries regarding the status of applications, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. Inasmuch as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners.

203.08(a) Congressional and Other Official Inquiries [R–44]

Correspondence and inquiries from the White House, Members of Congress, embassies, and heads of Executive departments and agencies normally are cleared through the Commissioner's Office.

When persons from the designated official sources request services from the Office, or information regarding the business of the Office, they should, under long-standing instructions, be referred, at least initially, to the Commissioner's Office.

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.

Inquiries referred to in this section, particularly correspondence from Congress or the White House, should immediately be transmitted to the Commissioner's Office by special messenger, and the Commissioner's Office should be notified by phone that such correspondence has been received.