

Appendix 3 – Examples of when to list a provisional application on the PTO-892 form

Example 1: Filing date of provisional application is needed for rejection:

If the earliest effective filing date of the application being examined is November 1, 2002, and the applied reference is a PGPub of a U.S. patent application filed on January 10, 2003 with a proper benefit claim under 35 U.S.C. 119(e) to a provisional application filed January 10, 2002, then:

The provisional application filed January 10, 2002 must be listed as a Non-Patent Document on the PTO-892 as the provisional application's filing date must be relied upon for the applied reference to qualify as prior art under 35 U.S.C. 102(e).

Example 2: Filing date of provisional application is not needed for rejection: If the earliest effective filing date of the application being examined is September 5, 2001, and the applied reference is a U.S. patent of an application filed on May 10, 2002, claiming the benefit under 35 U.S.C. 120 (as a continuation) of an application filed March 15, 2001, and the benefit under 35 U.S.C. 119(e) to a provisional application filed on March 15, 2000, then:

the provisional application filed March 15, 2000 should not be listed on the PTO-892 because the 35 U.S.C. 120 benefit date (March 15, 2001) antedates the effective filing date (September 5, 2001) of the application being examined. (The provisional application filing date is not needed in this example as the 35 U.S.C. 120 benefit date is sufficient to qualify the applied reference as prior art under 35 U.S.C. 102(e)).

Example 3: Filing date of provisional application is needed for rejection but reference may not qualify under § 102(e): If the earliest effective filing date of the application being examined is September 1, 2000, and the reference under consideration is the June 3, 2002 publication by WIPO under PCT Article 21(2) of an international application filed in French, the international application designated the U.S. and properly claimed (foreign) priority to a U.S. provisional application filed on February 1, 2000, then:

A) If the WIPO publication under consideration is in **English** and the international application was filed **on or after November 29, 2000**, the provisional application filed February 1, 2000 must be listed as a Non-Patent Document on the PTO-892 as the WIPO publication may be applied in a rejection under 35 U.S.C. 102(e) with an effective prior art date as of the U.S. provisional application filing date (February 1, 2000), which antedates the effective filing date (September 1, 2000) of the application being examined; or

B) If the WIPO publication is in a language other than English, or if the international application was filed before November 29, 2000, the provisional application filed February 1, 2000 should not be listed on the PTO-892 as the WIPO publication is not prior art under 35 U.S.C. 102(e). Further, the WIPO publication cannot be applied as prior art under 35 U.S.C. 102(a) or (b) because its publication date is after the effective date of the application being examined.

Example 4: In response to Office action in which the filing date of provisional application was not needed for rejection, applicant swears behind the filing date applied, but not the filing date of the provisional application: If applicant attempts to swear behind the filing date applied but not the filing date of the provisional application(s), the examiner must then list the provisional application(s) on (the bottom of) a PTO-892 form in the Office action responding to the communication by applicant containing the showing under 37 CFR 1.131.