

Manual of PATENT EXAMINING PROCEDURE

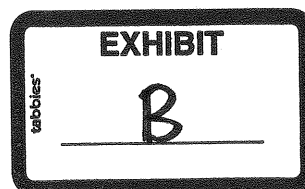
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APPENDIX B



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Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (*) where a single word was deleted and by two asterisks (**) where more than one word was deleted. The use of three or five asterisks in the body of the laws, rules, treaties, and administrative instructions indicates a portion of the law, rule, treaty, or administrative instruction which was not reproduced.

First Edition, November 1949
Second Edition, November 1953
Third Edition, November 1961
Fourth Edition, June 1979
Fifth Edition, August 1983
Sixth Edition, January 1995
Seventh Edition, July 1998
Eighth Edition, August 2001
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MPEP 201.08

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201.07 Continuation Application [R-3]

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) (or 1.53(d) if the application is a design application). The applicant in the continuation application must include at least one inventor named in the prior nonprovisional 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. The continuation application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c). >For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 201.11.<

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

At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the primary examiner. *>A continued prosecution< application >(CPA)< under 37 CFR 1.53(d) >(available only for design applications)<, however, must be filed prior to payment of the issue fee unless a petition under 37 CFR 1.313(c) is granted in the prior application. In addition, a continuation or divisional application may only be filed under 37 CFR 1.53(d) if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b).

For notation to be put in the file history by the examiner in the case of a continuation application, see MPEP § 202.02.

Use form paragraph 2.05 to remind applicant of possible continuation status.

¶ 2.05 Possible Status as Continuation

This application discloses and claims only subject matter disclosed in prior application no [1], filed [2], and names an inventor or inventors named in the prior application. Accordingly, this application may constitute a continuation or division. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Examiner Note:

1. This form paragraph should only be used if it appears that the application may be a continuation, but priority has not been properly established.
2. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

201.08 Continuation-in-Part Application [R-3]

A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application. (*In re Klein*, 1930 C.D. 2, 393 O.G. 519 (Comm'r Pat. 1930)). The continuation-in-part application may only be filed under 37 CFR 1.53(b). The continuation-in-part application must claim the benefit of the prior nonprovisional application under 35 U.S.C. 120 or 365(c). >For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 201.11.<

A continuation-in-part application CANNOT be filed as a continued prosecution application (CPA) under 37 CFR 1.53(d).

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

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

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applications upon which the continuation-in-part application relies for benefit.

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 set forth in 35 U.S.C. 120 and 37 CFR 1.78. Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

Unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the ****>other<** requirements of 35 U.S.C. 120 **>**and 37 CFR 1.78, such as \langle :

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

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

(C) The alleged continuation-in-part application “contains or is amended to contain a specific reference to the earlier filed application.” (The specific reference ****>**must be submitted either in the first sentence(s) of the specification or in an application data sheet (see 37 CFR 1.76(b)(5)).)

See MPEP § 201.11 for more information on claiming the benefit of a prior nonprovisional application. \langle

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

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

¶ 2.06 *Possible Status as Continuation-in-Part*

This application repeats a substantial portion of prior Application No. [1], filed [2], and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Examiner Note:

1. This form paragraph should only be used when it appears that the application may qualify as a continuation-in-part, but no priority claim has been perfected.
2. An application claiming the benefits of a provisional application under 35 U.S.C. 119(e) should not be called a “continuation-in-part” of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, **not** a continuation, division, or continuation-in-part of the provisional application.

201.09 Substitute Application [R-5]

The use of the term “Substitute” to designate any application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later application, finds official recognition in the decision *Ex parte Komenak*, 45 USPQ 186, 1940 C.D. 1, 512 O.G. 739 (Comm’r Pat. 1940). Current practice does not require applicant to insert in the specification reference to the earlier application; however, attention should be called to the earlier application. The notation in the file history (see MPEP § 202.02) that one application is a “Substitute” for another is printed in the heading of the patent copies. See MPEP § 202.02.

As is explained in MPEP § 201.11, a “Substitute” does not obtain the benefit of the filing date of the prior application.

Use form paragraph 2.07 to remind applicant of possible substitute status.

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¶ 2.07 *Definition of a Substitute*

Applicant refers to this application as a “substitute” of Application No. [1], filed [2]. 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*, 45 USPQ 186, 1940 C.D. 1, 512 O.G. 739 (Comm’r Pat. 1940). The notation on the file wrapper (See MPEP § 202.02) that one case is a “substitute” for another is printed in the

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heading of the patent copies. A "substitute" does not obtain the benefit of the filing date of the prior application.

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201.10 Refile [R-2]

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 or her 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 application, the examiner should require the substitution of the word "substitute" for "refile", since the former term has official recognition.

Use form paragraph 2.08 to remind applicant of possible refile status.

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¶ 2.08 Definition of a Refile

It is noted that applicant refers to this application as a "refile." No official definition has been given the term "refile," though it is sometimes used as an alternative for the term "substitute." Since this application appears to be in fact a duplicate of a former application which was abandoned prior to the filing of the second case, the substitution of the word "substitute" for "refile" is required since the term "substitute" has official recognition. Applicant is required to make appropriate corrections.

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201.11 Claiming the Benefit of an Earlier Filing Date Under 35 U.S.C. 120 and 119(e) [R-5]

Under certain circumstances a later-filed application for patent is entitled to the benefit of the filing date of a prior-filed nonprovisional application or provisional application which has at least one common inventor. The conditions are specified in 35 U.S.C. 120 and 37 CFR 1.78(a)(1) – (a)(3) for the benefit claim of a prior nonprovisional application and 35 U.S.C. 119(e) and 37 CFR 1.78(a)(4) – (a)(6) for the benefit claim of a prior provisional application.

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, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same

effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

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

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

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

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

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

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonpro-

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visional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

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

(ii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

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

(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification

must contain or be amended to contain such reference in the first sentence(s) following the title.

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

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

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

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must be paid within the time period set forth in § 1.53(g).

(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance

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with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

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

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

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(iv) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an amendment or Supplemental Application Data Sheet withdrawing the benefit claim, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.<

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

There are several conditions for a later-filed application to receive the benefit of the filing date of a prior-filed application under 35 U.S.C. 120, 121, or 365(c), or, provided the later-filed application is not a design application (see 35 U.S.C. 172), under 35 U.S.C. 119(e). The conditions are briefly summarized as follows:

(A) The prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112 for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(B) The later-filed application must be copending with the prior-filed nonprovisional application for a benefit claim under 35 U.S.C. 120, 121, or 365(c). For a benefit claim under 35 U.S.C. 119(e), the later-filed application must be filed not later than 12 months after the filing date of the prior provisional application.

(C) The later-filed application must contain a reference to the prior-filed application in the first sentence(s) of the specification or in an application data sheet, for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(D) The later-filed application must be filed by an inventor or inventors named in the prior-filed application for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

(E) If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a) (e.g., during the pendency of the later-filed application and within the later of 4 months from the actual filing date of the later-filed application or 16 months from the filing date of the prior-filed application) for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for benefit claim under 35 U.S.C. 119(e).

(F) If the prior-filed application is a provisional application filed in a language other than English, a benefit claim under 35 U.S.C. 119(e) *>requires the following to be filed in the provisional application<:
(1) an English language translation of the provisional

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application; and (2) a statement that the translation is accurate. See 37 CFR 1.78(a)(5)(iv).

(G) If the prior-filed application was an international application designating the United States of America, it must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(a)(1)(i).

(H) If the prior-filed application was filed under 35 U.S.C. 111, the prior-filed application must be entitled to a filing date and the basic filing fee of the prior-filed application must have been paid. See 37 CFR 1.78(a)(1)(ii) regarding a benefit claim under 35 U.S.C. 120, 121, or 365(c), and see 37 CFR 1.78(a)(4) regarding a benefit claim under 35 U.S.C. 119(e).

More information for each condition is provided in the subsections below.

If the claims in the later-filed application are not entitled to the benefit of an earlier filing date, the examiner should:

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

(B) Conduct a prior art search based on the actual filing date of the application instead of the earlier filing date. The examiner may use an intervening reference in a rejection until applicant corrects the benefit claim or shows that the conditions for claiming the benefit of the prior application have been met. The effective filing date of the later-filed application is the actual filing date of the later-filed application, not the filing date of the prior-filed application. See MPEP § 706.02.

I. DISCLOSURE REQUIREMENT

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d

1077 (Fed. Cir. 1994). The prior-filed application must disclose the common named inventor's invention claimed in the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. See 37 CFR 1.78(a)(1). Accordingly, the disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. 112, first paragraph.

A. Claiming the Benefit of Provisional Applications

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

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

invention claimed in the '283 patent as to the angle limitation and therefore, the '283 patent is not entitled to the filing date of the provisional application under 35 U.S.C. 119(e)(1) and the '283 patent is invalid under 35 U.S.C. 102(b).

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

B. Claiming the Benefit of Nonprovisional Applications

The disclosure of a continuation application must be the same as the disclosure of the prior-filed application. See MPEP § 201.07. The disclosure of a divisional application must be the same as the disclosure of the prior-filed application, or include at least that portion of the disclosure of the prior-filed application that is germane to the invention claimed in the divisional application. See MPEP § 201.06. The disclosure of a continuation or divisional application cannot include anything which would constitute new matter if inserted in the prior-filed application. A continuation-in-part application may include matter not disclosed in the prior-filed application. See MPEP § 201.08. Only the claims of the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-

filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date.

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

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

Where the prior application (a nonprovisional application) is found to be fatally defective because of insufficient disclosure to support allowable claims, a later-filed application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. *Hunt Co. v. Mallinckrodt Chemical Works*, 177 F.2d 583, 587, 83 USPQ 277, 281 (2d Cir. 1949) and cases cited therein.

Any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. 112 in the parent nonprovisional application is entitled to the benefit of the filing date of the parent nonprovisional application. However, if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application, such a claim is entitled only to the filing date of the continuation-in-part application; *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995); *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994); *In re Van Lagenhoven*, 458 F.2d 132, 136, 173 USPQ 426, 429 (CCPA 1972); and *Chromalloy American Corp. v. Alloy Surfaces Co., Inc.*, 339 F. Supp. 859, 874, 173 USPQ 295, 306 (D. Del. 1972).

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

C. Form Paragraphs

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

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

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more con-

ditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

Examiner Note:

1. In bracket 1, insert either or both --119(e)-- or --120--.
2. One or more of form paragraphs 2.10 to 2.11.01 or 2.38 to 2.40 must follow depending upon the circumstances.

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

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

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

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. This form paragraph may be used when there is lack of support or enablement in the prior-filed application for the claims in the application that is claiming the benefit of the prior-filed application under 35 U.S.C. 120, 121, or 365(c) or under 35 U.S.C. 119(e). The prior-filed application can be a provisional application or a nonprovisional application.
3. In bracket 1, insert the application number of the prior-filed application.
4. In bracket 2, provide an explanation of lack of support or enablement. If only some of the claims are not entitled to the benefit of the filing date of the prior application, the examiner should include a list those claims after the explanation (e.g., "Accordingly, claims 1-10 are not entitled to the benefit of the prior application.>").

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

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

Applicant states that this application is a continuation or divisional application of the prior-filed application. A continuation or divisional application cannot include new matter. Applicant is required to change the relationship (continuation or divisional

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application) to continuation-in-part because this application contains the following matter not disclosed in the prior-filed application: [1].

Examiner Note:

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

II. TIME FOR FILING LATER-FILED APPLICATIONS**A. Claiming the Benefit of Provisional Applications**

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

Public Law 106-113 amended 35 U.S.C. 119(e)(2) to eliminate the copendency requirement for a nonprovisional application claiming benefit of a provisional application. 35 U.S.C. 119(e)(2) as amended by Public Law 106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999. Although a nonprovisional application claiming the benefit of a provisional application is not required to be copending with the provisional application, abandonment of a provisional application for failure to pay the basic filing fee would indicate that the nonprovisional application could not claim the benefit of the provisional application because the basic filing fee was not paid within the time period set forth in 37 CFR 1.53(g) as required by 37 CFR 1.78(a)(4).

Applicant may claim the benefit of a provisional application by claiming the benefit of an intermediate

copending nonprovisional application. The later-filed application must claim the benefit of the intermediate nonprovisional application under 35 U.S.C. 120, 121, or 365(c); the intermediate application must be filed not later than 12 months after the filing date of the provisional application; and both the later-filed application and the intermediate application must claim the benefit of the provisional application under 35 U.S.C. 119(e).

B. Claiming the Benefit of Nonprovisional Applications — Copendency

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c), the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application. Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. Thus, the later-filed application may be filed under 37 CFR 1.53(b) while the prior application is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. Patents usually will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed.

If the prior application is abandoned, the later-filed application must be filed before the abandonment in order for it to be copending with the prior application. The term "abandoned," refers to abandonment for failure to prosecute (MPEP § 711.02), express abandonment (MPEP § 711.01), abandonment for failure to pay the issue fee (37 CFR 1.316), and abandonment for failure to notify the Office of a foreign filing after filing a nonpublication request under 35 U.S.C. 122(b)(2)(B)(iii) (MPEP § 1124).

The expression "termination of proceedings" includes the situations when an application is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

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

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

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor. The later-filed application may be referred to as a continuing application when the prior application is not a provisional application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. The statute is so worded that the prior application may contain more than the later-filed application, or the later-filed application may contain more than the prior application, and in either case the later-filed application is entitled to the benefit of the filing date of the prior application as to the common subject matter disclosed in compliance with 35 U.S.C. 112, first paragraph.

A later-filed application which is not copending with the prior application (which includes those called "substitute" applications as set forth in MPEP § 201.09) is not entitled to the benefit of the filing date of the prior application. Therefore, prior art against the claims of the later-filed application is determined based on the filing date of the later-filed application. An applicant is not required to refer to such prior application(s) in an application data sheet or in the specification of the later-filed application, but is required to otherwise call the examiner's attention to the prior application if it or its contents or prosecution is material to patentability of the later-filed application as defined in 37 CFR 1.56(b).

C. Form Paragraphs

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

¶ 2.11 Application Must Be Copending With Parent

This application is claiming the benefit of prior-filed nonprovisional application No. [1] under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Examiner Note:

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. Do not use this form paragraph for benefit claims under 35 U.S.C. 119(e) to provisional applications.
3. In bracket 1, insert the application number of the prior-filed nonprovisional application.

Use form paragraphs 2.09 and 2.11.01 and to indicate that the later-filed application must be filed not later than 12 months after the filing date of the provisional application for which a benefit is sought.

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

This application is claiming the benefit of provisional application No. [1] under 35 U.S.C. 119(e). However, this application was not filed within twelve months from the filing date of the provisional application, and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application.

Note: If the day that is 12 months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the nonprovisional application claiming the benefit of the provisional application may be filed on the next succeeding business day.

Applicant is required to delete the reference to the prior-filed provisional application from the first sentence(s) of the specification or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish that this application, or an intermediate nonprovisional application, was filed within 12 months of the filing date of the provisional application.

Examiner Note:

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

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

III. REFERENCE TO PRIOR APPLICATION(S)

The third requirement of the statute is that the later-filed application must contain a specific reference to the prior application. This should appear as the first sentence(s) of the specification following the title preferably as a separate paragraph (37 CFR 1.78(a)) and/or in an application data sheet (37 CFR 1.76). If the specific reference is only contained in the application data sheet, then the benefit claim information will be included on the front page of any patent or patent application publication, but will not be included in the first sentence(s) of the specification. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application, unless an incorporation by reference statement of the prior application was presented upon filing of the application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

A. Reference to Prior Nonprovisional Applications

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated. In addition, a benefit claim that merely states that "this application is a continuing application of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) since the proper relationship, which in-

cludes the type of continuing (i.e., continuation, divisional, or continuation-in-part) application, is not stated.

A request for a CPA filed under 37 CFR 1.53(d) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. (Note: The CPA is assigned the same application number as the prior application.) In a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and may not be made. Any such reference should be deleted. No amendment in a CPA may delete the specific reference to the prior application assigned the same application number. A specific reference to an application not assigned the same application number, but relied on for benefit under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is required. Cross references to other related applications not assigned the same application as the CPA may be made when appropriate.

When a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as "This is a divisional (or continuation, or continuation-in-part, as appropriate) application of Application No. ---, filed ---" should appear as the first sentence(s) of the specification or in an application data sheet, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. In the case of an application filed under 37 CFR 1.53(b) as a divisional, continuation or continuation-in-part of a CPA, there should be only one reference to the series of applications assigned the same application number, with the filing date cited being that of the original noncontinued application. Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application under 35 U.S.C. 371, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, which was the National Stage of International Application No. PCT/DE95/---, filed ---."

Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit

claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in the first sentence(s) of the specification or an application data sheet. As a result, publication of the application may not be scheduled as a function of the prior application's filing date. If the Office does not recognize a benefit claim under 35 U.S.C. 120 because it does not contain the required reference and the time period set forth in 37 CFR 1.78(a)(2)(ii) for submitting the required reference has expired, applicant must submit a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t) in order for the Office to accept the unintentionally delayed claim under 35 U.S.C. 120 since the application will not have been scheduled for publication on the basis of the prior application's filing date.

To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application. Note that the terms are exclusive. An application cannot be, for example, both a continuation and a divisional or a continuation and a continuation-in-part of the same application. Moreover, if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications. For example, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---."

B. Reference to Prior Provisional Applications

When the nonprovisional application is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/---, filed ---." should appear as the first sentence(s) of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35

U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 10/---, filed ---, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---." In the case of design applications, it should appear as set forth in MPEP § 1504.20.

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

C. Benefit Claims to Multiple Prior Applications

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. See *Sticker Indus. Supply Corp. v. Blaw-*

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Knox Co., 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) and *Hovlid v. Asari*, 305 F. 2d 747, 134 USPQ 162 (9th Cir. 1962). The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See *In re Henriksen*, 399 F.2d 253, 158 USPQ 224 (CCPA 1968).

A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application. Although an application that itself directly claims the benefit of a provisional application is not required to specify the relationship to the provisional application, if the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application so that the Office can determine whether the intermediate nonprovisional application was filed within 12 months of the provisional application and thus, whether the claim is proper. Applicant must state, for example, "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---." A benefit claim that merely states "this application claims the

benefit of nonprovisional Application Nos. C and B, and provisional Application No. A" would be improper. Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be indicated. Applicant must state, for example, "this application is continuation of Application No. D, filed ---, which is a continuation-in-part of Application No. C, filed ---, Application No. D claims the benefit of provisional Application No. B, filed ---, and Application No. C claims the benefit of provisional Application No. A, filed ---." If a benefit claim to a provisional application is submitted without an indication that an intermediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim and will not include the benefit claim on the filing receipt. Therefore, a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t) will be required if the intermediate application and the relationship of each nonprovisional application are not indicated within the period set forth in 37 CFR 1.78(a).

D. Reference Must Be Included in the Specification or an Application Data Sheet (ADS)

The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an ADS or the specification must contain or be amended to contain such reference in the first sentence(s) following the title. If applicant is claiming the benefit of multiple prior applications, the reference to the prior applications may be in a continuous string of multiple sentences at the beginning of the specification. The multiple sentences must begin as the first sentence after the title, and any additional sentence(s) including a benefit claim must follow the first sentence and not be separated from the first sentence by any other sentence not making a benefit claim. If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to

correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt. If, however, a claim is not included in the first sentence(s) of the specification or in an ADS and is not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition under 37 CFR 1.78(a) and the surcharge to correct the claim. The Office may not recognize any benefit claim where there is no indication of the relationship between the nonprovisional applications or no indication of the intermediate nonprovisional application that is directly claiming the benefit of the provisional application. Even if the Office has recognized a benefit claim by entering it into the Office's database and including it on applicant's filing receipt, the benefit claim is not a proper benefit claim under 35 U.S.C. 119(e) or 35 U.S.C. 120 and 37 CFR 1.78 unless the reference is included in an ADS or in the first sentence(s) of the specification and all other requirements are met.

E. Examiners Should Require the Reference if Missing

In view of this requirement, the right to rely on a prior application may be waived by an applicant if a reference to the prior application is not included in the later-filed application. If the examiner is aware of the fact that an application is a continuing application of a prior application or the applicant fails to submit the reference to the prior application in compliance with 37 CFR 1.78(a) (e.g., the reference was submitted in the transmittal letter but not in the first sentence(s) of the specification or in an application data sheet), he or she should merely call attention to this in an Office action by using the wording of form paragraphs 2.15 or 2.16.

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

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. [1], a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual fil-

ing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Examiner Note:

1. In bracket 1, insert --119(e)-- or --120--.
2. In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA. 37 CFR 1.53(d)(2)(iv) and (d)(7).

¶ 2.16 Reference to a Prior Application

It is noted that this application appears to claim subject matter disclosed in prior Application No. [1], filed [2]. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or

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365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmitted letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11

Examiner Note:

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

If the examiner is aware of a prior application he or she should note it in an Office action, as indicated

above, but should not require the applicant to call attention to the prior application.

For notations to be placed in the file history in the case of continuing applications, see MPEP § 202.02 and § 1302.09.

F. Correcting or Adding a Benefit Claim After Filing

The Office will not grant a request for a corrected filing receipt to include a benefit claim unless the proper reference to the prior application is included in the first sentence(s) of the specification or an ADS within the time period required by 37 CFR 1.78(a) with a few exceptions. See subsection V., "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)". If the proper reference was previously submitted, a copy of the amendment, the first page of the specification, or the ADS containing the benefit claim should be included with the request for a corrected filing receipt. The Office plans to notify applicants on or with the filing receipt that a benefit claim may not have been recognized because the benefit claim was improper but applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition (37 CFR 1.78(a)(3) or (a)(6)) and the surcharge.

If a benefit claim is added after the time period required by 37 CFR 1.78(a), a petition and the surcharge are required. See subsection V. "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT 37 CFR 1.78(a)(2) AND (a)(5)." Any petition under 37 CFR 1.78(a)(3) or (a)(6) must be accompanied by an amendment to the specification or an ADS unless the proper reference was previously submitted. In addition to the petition under 37 CFR 1.78 and the amendment or ADS, to add a benefit claim it may be necessary for applicant to file one of the following, depending on the status of the application:

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

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

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

G Deleting Benefit Claims

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications.

The examiner should consider whether any new prior art may now be available if a benefit claim is deleted. If an applicant is submitting an amendment to the specification or an ADS to delete a benefit claim after final rejection or action, the amendment or ADS will be treated under 37 CFR 1.116 (see MPEP § 714.12 and § 714.13). If the amendment or ADS to delete a benefit claim is submitted after the application has been allowed, the amendment or ADS will be treated under 37 CFR 1.312 (see MPEP § 714.16). A deletion of a benefit claim will not delay the publica-

tion of the application unless the amendment or ADS is recognized by the Office within nine weeks prior to the projected publication date that was originally calculated based on the benefit claim.

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

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), no amendment may delete the specific reference to a prior application assigned the same application number. (Note: In the CPA, the request is the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. Further, in a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and should not be made.) The correction or entry of the data in the PALM data base can be made by technical support staff of the TC. Upon entry of the data, a new PALM bib-data sheet should be printed and placed in the file. See also MPEP § 707.05 and § 1302.09.

IV. SAME INVENTOR OR INVENTORS

The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. 119(e) or 120 be filed by an inventor or inventors named in the previously filed application or provisional application. 37 CFR 1.78(a)(1) and (a)(4) require that each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

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V. TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)

The time period requirement under 37 CFR 1.78(a)(2) and (a)(5) is only applicable to utility or plant applications filed on or after November 29, 2000.

The American Inventors Protection Act of 1999 (AIPA), Public Law 106-113, amended 35 U.S.C. 119 and 120 to provide that the Office may set a time period for the filing of benefit claims and establish procedures to accept an unintentionally delayed benefit claim. The Office has implemented these statutory changes, in part, by amending 37 CFR 1.78 to include: (A) a time period within which a benefit claim to a prior nonprovisional or provisional application must be stated or it is considered waived; and (B) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional or provisional application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the benefit claim of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the benefit claim must be made within the later of: (1) four months from the date on which the national stage commenced under 37 U.S.C. 371(b) or (f); or (2) sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c).

If the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to the prior application (unless previously submitted); (B) a sur-

charge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(3).

Likewise, if the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition for an unintentionally delayed benefit claim must be submitted during the pendency of the nonprovisional application. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) to the prior provisional application (unless previously submitted); (B) a surcharge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(6).

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

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of such information concerning the benefit claim. Applicant must still submit the benefit claim in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (i.e., by an amendment in the first sentence(s) of the specification or in an ADS) to have a proper claim under 35 U.S.C. 120 or 119(e) and 37 CFR 1.78 to the benefit of a prior application. If, however, an applicant

includes a benefit claim elsewhere in the application and not in the manner specified in 37 CFR 1.78(a), and the claim is not recognized by the Office as shown by its absence on a filing receipt (e.g., if the benefit claim is in a part of the application where benefit claims are not conventionally located, such as the body of the specification), the Office will require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the benefit claim contained elsewhere in the application.

A petition under 37 CFR 1.78(a)(3) and the surcharge would not be required for correcting a timely submitted benefit claim for the following situations:

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

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

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

If a benefit claim is filed after the required time period and without a petition as required by 37 CFR 1.78(a)(3) or (a)(6), the applicant should be informed that the benefit claim was not entered and that a petition needs to be filed using form paragraph 2.39.

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

The benefit claim filed on [1] was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted dur-

ing the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires the benefit under 35 U.S.C. [2] based upon a previously filed application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Examiner Note:

1. Use this form paragraph only for utility or plant applications filed on or after November 29, 2000.
2. In bracket 1, insert the filing date of the amendment or paper containing the benefit claim.
3. In bracket 2, insert --119(e)--, --120--, --121--, or --365(c)--.
4. Do not use this form paragraph if the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or in an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt. In this situation, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filling an amendment to the first sentence(s) of the specification or an ADS, if the reference has not been previously submitted. See MPEP § 201.11.

VI. ENGLISH TRANSLATION

If benefit is being claimed to a provisional application which was filed in a language other than English, (A) an English language translation of the provisional application, and (B) a statement that the translation is accurate, are required to be filed * in the provisional application **. >If a nonprovisional application claims the benefit of the filing date of a non-English language provisional application, a translation of the

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provisional application and a statement that the translation was accurate required by 37 CFR 1.78(a)(5)(iv) will not be required to be filed in the provisional application, if the translation and statement were filed in the nonprovisional application before November 25, 2005. < If the translation and statement were not * filed in the provisional application or >in< the nonprovisional application >before November 25, 2005,< the applicant will be notified in the nonprovisional application and given a period of time within which to file the translation and statement >in the provisional application, and a reply in the nonprovisional application confirming that the translation and statement were filed in the provisional application. In the alternative, applicant may reply to the notice by filing an amendment or a supplemental application data sheet (37 CFR 1.76(c)) withdrawing the benefit claim<. In a pending nonprovisional application, failure to timely reply to such notice will result in the abandonment of the nonprovisional application.

Form paragraph 2.38 may be used to notify applicant that an English translation of the non-English language provisional application is required.

**>

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

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

Examiner Note:

1. Use this form paragraph to notify applicant that an English translation of the non-English language provisional application and/or a statement that the translation is accurate is required. Do not use this form paragraph if a translation of the provisional application and a statement that the translation was accurate were filed in the nonprovisional application (the present application) before November 25, 2005.
2. In brackets 1 and 3, insert the application number of the non-English language provisional application.

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

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

<

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

If the prior-filed application is a nonprovisional application filed under 35 U.S.C. 111(a), the application must be entitled to a filing date as set forth in 35 CFR 1.53(b) or (d), and the basic filing fee as set forth in 37 CFR 1.16 must have been paid within the pendency of the application. See 37 CFR 1.78(a)(1). If the prior-filed application is an international application designating the United States of America, the prior-filed application must be entitled to a filing date in accordance with PCT Article 11. If the prior-filed application is a provisional application, the provisional application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee of the provisional application must have been paid within the time period set in 37 CFR 1.53(g) (the filing fee is paid within the time period set in 37 CFR 1.53(g) if an extension of time was filed to make a response to a notice to file missing parts requiring the filing fee timely).

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

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

This application claims the benefit of prior-filed application No. [1] under 35 U.S.C. 120, 121, or 365(c) or under 35 U.S.C. 119(e). If the prior-filed application is an international application designating the United States of America, it must be entitled to a filing date in accordance with PCT Article 11. See 37 CFR 1.78(a)(1)(i). If the prior-filed application is a nonprovisional application, the prior-filed application must be entitled to a filing date as set forth in 37 CFR 1.53(b) or 1.53(d) and include the basic filing fee set forth in 37 CFR 1.16. See 37 CFR 1.78(a)(1)(ii). If the prior-filed application is a provisional application, the prior-filed application must be entitled to a filing date as set forth in 37 CFR 1.53(c) and the basic filing fee must be paid within the time period set forth in 37 CFR 1.53(g). See 37 CFR 1.78(a)(4).

201.11(a)

MANUAL OF PATENT EXAMINING PROCEDURE

This application is not entitled to the benefit of the prior-filed application because the prior-filed application [2]. Applicant is required to delete the reference to the prior-filed application.

Examiner Note:

1. Use this form paragraph to notify applicant that the application is not entitled to the benefit of the prior-filed application because the prior-filed application was not entitled to a filing date and/or did not include the basic filing fee.
2. In bracket 1, insert the application number of the prior-filed application.
3. In bracket 2, insert "was not entitled to a filing date"; "did not include the basic filing fee"; or "was not entitled to a filing date and did not include the basic filing fee".

201.11(a) Filing of Continuation or Continuation-in-Part Application During Pendency of International Application Designating the United States [R-3]

It is possible to file a U.S. national application under 35 U.S.C. 111(a) and 37 CFR 1.53(b) during the pendency (prior to the abandonment) of an international application which designates the United States without completing the requirements for entering the national stage under 35 U.S.C. 371(c). See MPEP §1895. The ability to take such action is based on provisions of the United States patent law. 35 U.S.C. 363 provides that "An international application designating the United States shall have the effect from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office...". 35 U.S.C. 371(d) indicates that failure to timely comply with the requirements of 35 U.S.C. 371(c) "shall be regarded as abandonment by the parties thereof...". It is therefore clear that an international application which designates the United States has the effect of a pending U.S. application from the international application filing date until its abandonment as to the United States. The first sentence of 35 U.S.C. 365(c) specifically provides that "In accordance with the conditions and requirements of section 120 of this title,... a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States." The condition of 35 U.S.C. 120 relating to the time of filing requires the later application to be "filed before the patenting

or abandonment of or termination of proceedings on the first application...".

DELAYED SUBMISSION OF BENEFIT CLAIM IN INTERNATIONAL APPLICATION

A petition under 37 CFR 1.78(a)(3) for accepting an unintentionally delayed benefit claim and the surcharge under 37 CFR 1.17(t) are required to add a benefit claim under 35 U.S.C. 120 and 365(c) in an abandoned international application designating the United States filed on or after November 29, 2000, even when the international application did not enter the national stage under 35 U.S.C. 371. For example, when filing a "bypass" continuation application under 35 U.S.C. 111(a) that claims the benefit of an international application designating the United States with a filing date on or after November 29, 2000 that could have but did not claim the benefit of an earlier U.S. application, and the benefit claim is to be added to the international application, a petition under 37 CFR 1.78(a)(3) must be filed in the international application.

201.12 **Title to an Application Claiming Benefit of an Earlier Application [R-3]

**>The assignment records of the USPTO will only reflect an assignment of a divisional application or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed. < See MPEP § 306. When the assignment is in a provisional application, see MPEP § 306.01.

201.13 Right of Priority of Foreign Application [R-3]

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(a)-(d) and (f)>, and 37 CFR 1.55<.

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

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or

MPEP 706.02(b)

706.02(b)

MANUAL OF PATENT EXAMINING PROCEDURE

Revised 35 U.S.C. 102(e) eliminated the reference to fulfillment of the 35 U.S.C. 371(c)(1), (2) and (4) requirements. As a result, United States patents issued directly from international applications filed on or after November 29, 2000 will no longer be available as prior art under 35 U.S.C. 102(e) as of the date the requirements of 35 U.S.C. 371(c)(1), (2) and (4) have been satisfied. Under 35 U.S.C. 102(e)(2), as amended by the AIPA and Pub. L. 107-273, an international filing date which is on or after November 29, 2000 is a United States filing date for purposes of determining the earliest effective prior art date of a patent if the international application designated the United States and was published in the English language under PCT Article 21(2) by WIPO.

No international filing dates prior to November 29, 2000 may be relied upon as a prior art date under 35 U.S.C. 102(e) in accordance with the last sentence of the effective date provisions of Pub. L. 107-273. Patents issued directly, or indirectly, from international applications filed before November 29, 2000 may only be used as prior art based on the provisions of 35 U.S.C. 102(e) in effect before November 29, 2000. Thus, the 35 U.S.C. 102(e) date of such a prior art patent is the earliest of the date of compliance with 35 U.S.C. 371(c)(1), (2) and (4), or the filing date of the later-filed U.S. continuing application that claimed the benefit of the international application. Publications of international applications filed before November 29, 2000 (which would include WIPO publications and U.S. publications of the national stage (35 U.S.C. 371)) do not have a 35 U.S.C. 102(e) date at all (however, such publications are available as prior art under 35 U.S.C. 102(a) or (b) as of the publication date). Specifically, under revised 35 U.S.C. 374, the international application must be filed on or after November 29, 2000 for its WIPO publication to be "deemed a publication under section 122(b)" and thus available as a possible prior art reference under 35 U.S.C. 102(e) as amended by the AIPA.

C. 35 U.S.C. 102(a)

Even if the reference is prior art under 35 U.S.C. 102(e), the examiner should still consider 35 U.S.C. 102(a) for two reasons. First, if the reference is a U.S. patent or patent application publication of, or claims benefit of, an international application, the publication of the international application under PCT Article

21(2) may be the earliest prior art date under 35 U.S.C. 102(a) for the disclosure. Second, references that are only prior art under 35 U.S.C. 102(e), (f), or (g) and applied in a rejection under 35 U.S.C. 103(a) are subject to being disqualified under 35 U.S.C. 103(c) if the reference and the application were commonly owned, or subject to an obligation of common assignment, at the time the invention was made. For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work.

706.02(b) Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-6]

A rejection based on 35 U.S.C. 102(b) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Perfecting benefit under 35 U.S.C. 120, within the time period set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. See MPEP § 201.11 and § 706.02; or

(D) Perfecting benefit claim under 35 U.S.C. 119(e) by complying with the requirements of 37 CFR 1.78(a) (see item (C) above). Since a provisional application could not have been filed more than one year prior to the filing of a nonprovisional application that claims benefit to the provisional application, **>once the benefit claim under 35 U.S.C. 119(e) is perfected, the rejection must be reconsidered to determine whether the prior art still qualifies as prior art under 35 U.S.C. 102(b) or whether the prior art qualifies as prior art under 35 U.S.C. 102(a). If the prior art qualifies as prior art under 35 U.S.C. 102(a), see below as to how to overcome the 35 U.S.C. 102(a) rejection.<

EXAMINATION OF APPLICATIONS

706.02(c)

A rejection based on 35 U.S.C. 102(e) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(D) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a). See MPEP § 715 for more information on 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection. Under these circumstances, the examiner must determine whether a double patenting rejection or interference is appropriate. If there is a common assignee or inventor between the application and patent, a double patenting rejection must be made. See MPEP § 804. If there is no common assignee or inventor and the rejection under 35 U.S.C. 102(e) is the only possible rejection, the examiner must determine whether an interference should be declared. See MPEP Chapter 2300 for more information regarding interferences;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) within the time period set in 37 CFR 1.55(a)(1) or filing a grantable petition under 37 CFR 1.55(c). See MPEP § 201.13. The foreign priority filing date must antedate the reference and be perfected. The filing date of the priority document is not perfected unless applicant has filed a certified priority document in the application (and an English language translation, if the document is not in English) (see 37 CFR 1.55(a)(3)) and the examiner has established that the priority document satisfies the enablement and description requirements of 35 U.S.C. 112, first paragraph; or

(F) Perfecting benefit under 35 U.S.C. 119(e) or 120, within the time periods set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the application to con-

tain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph. See MPEP § 201.11 and § 706.02.

A rejection based on 35 U.S.C. 102(a) can be overcome by:

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art;

(B) Amending the claims to patentably distinguish over the prior art;

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a). See MPEP § 715 for information on the requirements of 37 CFR 1.131 affidavits. When the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not appropriate to overcome the rejection.

(D) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10;

(E) Perfecting a claim to priority under 35 U.S.C. 119(a)-(d) as explained in reference to 35 U.S.C. 102(e) above;

(F) Perfecting benefit under 35 U.S.C. 119(e) or 120 as explained in reference to 35 U.S.C. 102(e) above.

706.02(c) Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale

An applicant may make an admission, or submit evidence of sale of the invention or knowledge of the invention by others, or the examiner may have personal knowledge that the invention was sold by applicant or known by others in this country. The language "in this country" means in the United States only and does not include other WTO or NAFTA member

MPEP 1481

1480.01

MANUAL OF PATENT EXAMINING PROCEDURE

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1480.01 Expedited Issuance of Certificates of Correction - Error Attributable to Office [R-2]

In an effort to reduce the overall time required in processing and granting Certificate of Correction requests, the Office will expedite processing and granting of patentee requests where such requests are accompanied by evidence to show that the error is attributable solely to the Office (i.e., requests filed pursuant to 37 CFR 1.322 only).

The following requirements must be met for consideration of expedited issuance of Certificates of Correction:

The text of the correction requested should be submitted on a Certificate of Correction form, PTO/SB/44 (also referred to as PTO 1050). Submission of this form in duplicate is not necessary. The location of the error in the printed patent should be identified on form PTO/SB/44 by column and line number or claim and line number. See also MPEP § 1485.

Where the correction requested was incurred through the fault of the Office, and the matter is clearly disclosed in the records of the Office, and is accompanied by documentation that unequivocally supports the patentee's assertion(s), a Certificate of Correction will be expeditiously issued. Such supporting documentation can consist of relevant photocopied receipts, manuscript pages, correspondence dated and received by the Office, photocopies of Examiners' responses regarding entry of amendments, or any other validation that supports the patentee's request so that the request can be processed without the patent file.

Where only part of a request can be approved, the appropriate modifications will be made on the form PTO/SB/44 and the patentee then notified by mail. Further consideration will be given to initially rejected requests upon a request for reconsideration. In this instance, however, or in the case where it is determined that the Office was not responsible for the error(s) cited by the patentee, accelerated issuance of Certificates of Correction cannot be anticipated (although the Office will make every effort to process the request expeditiously).

As in the case of a request for a Certificate of Correction, a Request for Expedited Issuance of Certificate of Correction should be addressed to:

ATTN: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450<

1481 Certificates of Correction - Applicant's Mistake [R-3]

35 U.S.C. 255. Certificate of correction of applicant's mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

37 CFR 1.323. Certificate of correction of applicant's mistake.

**>The Office may issue a certificate of correction under the conditions specified in 35 U.S.C. 255 at the request of the patentee or the patentee's assignee, upon payment of the fee set forth in § 1.20(a). If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.<

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See *Novo Industries, L.P. v. Micro Molds Corporation*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

CORRECTION OF PATENTS

1481.02

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:

- (1) of a clerical nature,
- (2) of a typographical nature, or
- (3) a mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

- (1) constitute new matter or
- (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

The fee for providing a correction of applicant's mistake, other than inventorship, is set forth in 37 CFR 1.20(a). The fee for correction of inventorship in a patent is set forth in 37 CFR 1.20(b).

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1481.01 Correction of Assignees' Names [R-3]

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The **>Fee(s)< Transmittal Form portion (PTOL-85B) of the Notice of Allowance provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. Unless an assignee's name and address are identified in the appropriate space for specifying the assignee, (i.e., item 3 of the **>Fee(s)< Transmittal Form PTOL-85B), the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

**>Any request for the issuance of an application in the name of the assignee submitted after the date of

payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee must:

(A) state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;

(B) include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and

(C) include the processing fee set forth in 37 CFR 1.17(i).

See 37 CFR 3.81(b).<

1481.02 Correction of Inventors' Names [R-7]

35 U.S.C. 256. *Correction of named inventor.*

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to 35 U.S.C. 256, a copy of the court order and a Certificate of Correction under 37 CFR 1.323 should be submitted to the Certificates of Corrections Branch.

37 CFR 1.324. *Correction of inventorship in patent, pursuant to 35 U.S.C. 256.*

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the