

Exhibit A

MPEP 1481.03, entitled “Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits”

Manual of PATENT EXAMINING PROCEDURE

Original Eighth Edition, August 2001

Latest Revision July 2010



U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

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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...").

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

inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

(c) For correction of inventorship in an application, see §§ 1.48 and 1.497.

(d) In a contested case before the Board of Patent Appeals and Interferences under part 41, subpart D, of this title, a request for correction of a patent must be in the form of a motion under § 41.121(a)(2) or § 41.121(a)(3) of this title.

The petition to correct inventorship under 37 CFR 1.324 must include the statements and fee required by 37 CFR 1.324(b).

Under 37 CFR 1.324(b)(1), a statement is required from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part. In order to satisfy this, a statement such as the following is sufficient:

“The inventorship error of failing to include John Smith as an inventor of the patent occurred without any deceptive intention on the part of John Smith.”

Nothing more is required. The examiner will determine only whether the statement contains the required language; the examiner will not make any comment as to whether or not it appears that there was in fact deceptive intention (see MPEP § 2022.05).

Under 37 CFR 1.324(b)(2), all current inventors who did not submit a statement under 37 CFR 1.324(b)(1) must submit a statement either agreeing to the change of inventorship, or stating that they have no disagreement with regard to the requested change. “Current inventors” include the inventor(s) being retained as such and the inventor(s) to be deleted. These current inventors need not make a statement as to whether the inventorship error occurred without deceptive intention.

If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, *because* the inventor’s statement is not required for a non-broadening reissue application to correct inventorship. See MPEP § 1412.04.

Under 37 CFR 1.324(b)(3), a statement is required from the assignee(s) of the patent agreeing to the change of inventorship in the patent. The assignee statement agreeing to the change of inventorship must be accompanied by a proper statement under 37 CFR 3.73(b) establishing ownership, unless a proper 37 CFR 3.73(b) statement is already in the file. See MPEP § 324 as to the requirements of a statement under 37 CFR 3.73(b).

While a request under 37 CFR 1.48 is appropriate to correct inventorship in a nonprovisional *application*, a petition under 37 CFR 1.324 is the appropriate vehicle to correct inventorship in a *patent*. If a request under 37 CFR 1.48(a), (b), or (c) is inadvertently filed in a patent, the request may be treated as a petition under 37 CFR 1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

Similarly, if a request under 37 CFR 1.48(a), (b), or (c) is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under 37 CFR 1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48. 35 U.S.C. 256 requires “on application of all the parties and assignees,” while 35 U.S.C. 116 does not have the same requirement. Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted (see, e.g., MPEP § 201.03, under the heading “Statement of Lack of Deceptive Intention”). This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived. Correction of inventorship requests under 37 CFR 1.324 should be directed to the Supervisory Patent Examiner whose unit handles the subject matter of the patent. Form paragraphs 10.13 through 10.18 may be used.

¶ 10.13 *Petition Under 37 CFR 1.324, Granted*

In re Patent No. [1] :
 Issue Date: [2] : **DECISION**
 Appl. No.: [3] : **GRANTING**
 Filed: [4] : **PETITION**
 For: [5] : 37 CFR 1.324

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

[7]
 Supervisory Patent Examiner,
 Art Unit [8],
 Technology Center [9]
 [10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. In bracket 10, insert the correspondence address of record.
3. This form paragraph is printed with the USPTO letterhead.
4. Prepare Certificate using form paragraph 10.15.

¶ 10.14 *Treatment of Request Under 37 CFR 1.48 Petition Under 37 CFR 1.324, Petition Granted*

In re Patent No. [1] :
 Issue Date: [2] : **DECISION**
 Appl. No.: [3] : **GRANTING**
 Filed: [4] : **PETITION**
 For: [5] : 37 CFR 1.324

This is a decision on the request under 37 CFR 1.48, filed [6]. In view of the fact that the patent has already issued, the request under 37 CFR 1.48 has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

[7]
 Supervisory Patent Examiner,
 Art Unit [8],
 Technology Center [9]
 [10]

Examiner Note:

1. Petitions to correct inventorship of an issued patent are decided by the Supervisory Patent Examiner, as set forth in the Commissioner's memorandum dated June 2, 1989.
2. This form paragraph is printed with the USPTO letterhead.
3. Prepare Certificate using form paragraph 10.15.
4. In bracket 10, insert the correspondence address of record.

¶ 10.15 *Memorandum - Certificate of Correction (Inventorship)*

DATE: [1]
 TO: Certificates of Correction Branch
 FROM: [2], SPE, Art Unit [3]
 SUBJECT: Request for Certificate of Correction

Please issue a Certificate of Correction in U. S. Letters Patent No. [4] as specified on the attached Certificate.

[5], SPE
 Art Unit [6]

**UNITED STATES PATENT AND TRADEMARK OFFICE
 CERTIFICATE**

Patent No. [7]
 Patented: [8]

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

[9]

[10], Supervisory Patent Examiner
 Art Unit [11]

Examiner Note:

1. In bracket 9, insert the full name and residence (City, State) of each actual inventor.
2. This is an internal memo, not to be mailed to applicant, which accompanies the patented file to Certificates of Correction Branch as noted in form paragraphs 10.13 and 10.14.
3. In brackets 5 and 10, insert name of SPE; in brackets 6 and 11 the Art Unit and sign above each line.
4. Two separate pages of USPTO letterhead will be printed when using this form paragraph.

¶ 10.16 *Petition Under 37 CFR 1.324, Dismissed*

In re Patent No. [1] :
 Issue Date: [2] : **DECISION**
 Appl. No.: [3] : **DISMISSING**
 Filed: [4] : **PETITION**
 For: [5] : 37 CFR 1.324

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is dismissed.

A petition to correct inventorship as provided by 37 CFR 1.324 requires (1) a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part, (2) a statement from the current named inventors (including any "inventor" being deleted) who have not submitted a statement as per "(1)" either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change, (3) a statement from all assignees of the parties submitting a statement under "(1)" and "(2)"

agreeing to the change of inventorship in the patent; such statement must comply with the requirements of 37 CFR 3.73(b); and (4) the fee set forth in 37 CFR 1.20(b). This petition lacks item(s) [7].

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. If each of the four specified items has been submitted but one or more is insufficient, the petition should be denied. See paragraph 10.17. However, if the above noted deficiency can be cured by the submission of a renewed petition, a dismissal would be appropriate.
2. If the petition includes a request for suspension of the rules (37 CFR 1.183) of one or more provisions of 37 CFR 1.324 that are required by the statute (35 U.S.C. 256), form paragraph 10.18 should follow this form paragraph.
3. In bracket 7, pluralize as necessary and insert the item number(s) which are missing.
4. In bracket 11, insert correspondence address of record.
5. This form paragraph is printed with the USPTO letterhead.

¶ 10.17 Petition Under 37 CFR 1.324, Denied

In re Patent No. [1] :
 Issue Date: [2] : **DECISION DENYING PETITION**
 Appl. No.: [3] : 37 CFR 1.324
 Filed: [4] :
 For: [5] :

This is a decision on the petition filed [6] to correct inventorship under 37 CFR 1.324.

The petition is denied.

[7]

[8]

Supervisory Patent Examiner,

Art Unit [9],

Technology Center [10]

[11]

Examiner Note:

1. In bracket 7, a full explanation of the deficiency must be provided.
2. If the petition lacks one or more of the required parts set forth in 37 CFR 1.324, it should be dismissed using form paragraph 10.14 or 10.20, rather than being denied.
3. In bracket 11, insert correspondence address of record.
4. This form paragraph is printed with the USPTO letterhead.

¶ 10.18 Waiver of Requirements of 37 CFR 1.324 Under 37 CFR 1.183, Dismissed

Suspension of the rules under 37 CFR 1.183 may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, 35 U.S.C. 256 requires [1].

Accordingly, the petition under 37 CFR 1.183 is dismissed as moot.

Examiner Note:

1. This form paragraph should follow form paragraph 10.16 whenever the petition requests waiver of one or more of the provisions of 37 CFR 1.324 that are also requirements of 35 U.S.C. 256.
2. If the petition requests waiver of requirements of 37 CFR 1.324 that are not specific requirements of the statute (i.e., the fee or the oath or declaration by all inventors), the application must be forwarded to a petitions attorney in the Office of the Deputy Commissioner for Patent Examination Policy for decision.

1481.03 Correction of 35 U.S.C. 119 and 35 U.S.C. 120 Benefits [R-7]

I. CORRECTION TO PERFECT CLAIM FOR 35 U.S.C. 119 (a)-(d) AND (f) BENEFITS

See MPEP § 201.16 for a discussion of when 35 U.S.C. 119 (a)-(d) and (f) benefits can be perfected by certificate of correction.

II. CORRECTION AS TO 35 U.S.C. 120 AND 35 U.S.C. 119(e) BENEFITS

A. For Applications Filed ****>Before< November 29, 2000**

For applications filed ****>before< November 29, 2000**, it is the version of 37 CFR 1.78, which was in effect as of November 29, 2000, that applies. The pre-November 29, 2000 version reads as follows:

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

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior 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) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain a reference to each such prior 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. Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title. 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 application. The identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number. Cross-references to other related applications may be made when appropriate (see § 1.14(a)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be entitled to a filing date as set forth in § 1.53(c), have any required English-language translation filed therein within the time period set forth in § 1.52(d), and have paid therein the basic filing fee set forth in § 1.16(k) within the time period set forth in § 1.53(g).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number). Unless the reference required by this paragraph is included in an application data sheet (§ 1.76), the specification must contain or be amended to contain such reference in the first sentence following any title.

Under certain conditions specified below, a Certificate of Correction can be used, with respect to 35 U.S.C. 120 and 119(e) priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2) and (a)(4).

For all situations other than where priority is based upon 35 U.S.C. 365(c), the conditions are as follows:

(A) for 35 U.S.C. 120 priority, all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) for 35 U.S.C. 119(e) priority, all requirements set forth in 37 CFR 1.78(a)(3) must have been met in the application which became the patent to be corrected; and

(C) it must be clear from the record of the patent and the parent application(s) that priority is appropriate. See MPEP § 201.11 for requirements under 35 U.S.C. 119(e) and 120.

Where 35 U.S.C. 120 and 365(c) priority based on an international application is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and

(C) the patentee must submit with the request for the certificate copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate. See MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application.

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application. Note *In re Schuurs*, 218 USPQ 443 (Comm'r Pat. 1983) which suggests that a Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior copending application. Also, note *In re Lambrech*, 202 USPQ

620 (Comm'r Pat. 1976), citing *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 - § 1460) would be appropriate to pursue the desired correction of the patent.

B. For Applications Filed on or After November 29, 2000

For applications filed on or after November 29, 2000, the version of 37 CFR 1.78 reproduced below applies (note that amendments to 37 CFR 1.78 took effect on November 29, 2000, December 28, 2001, May 1, 2003, January 21, 2004, September 21, 2004, December 8, 2004, * July 1, 2005>, and November 25, 2005<).

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 nonprovisional 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 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.

(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.

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

(c) If an application or a patent under reexamination and at least one other application naming different inventors are owned by the same person and contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.

Under no circumstances can a Certificate of Correction be employed to correct an applicant's mistake by adding or correcting a priority claim under 35 U.S.C. 119(e) for an application filed on or after November 29, 2000.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

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 section *during the pendency of the application*. (emphasis added)

A Certificate of Correction is NOT a valid mechanism for adding or correcting a priority claim under 35 U.S.C. 119(e) after a patent has been granted on an application filed on or after November 29, 2000.

Under certain conditions as specified below, however, a Certificate of Correction can still be used, with respect to 35 U.S.C. 120 priority, to correct:

(A) the failure to make reference to a prior copending application pursuant to 37 CFR 1.78(a)(2); or

(B) an incorrect reference to a prior copending application pursuant to 37 CFR 1.78(a)(2).

Where priority is based upon 35 U.S.C. 120 to a **national application**, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and

(C) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

Where 35 U.S.C. 120 and 365(c) priority based on **an international application** is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:

(A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;

(B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11);

(C) the patentee must submit together with the request for the certificate, copies of documentation showing designation of states and any other informa-

tion needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate (see MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application; and

(D) a grantable petition to accept an unintentionally delayed claim for the benefit of a prior application must be filed, including a surcharge as set forth in 37 CFR 1.17(t), as required by 37 CFR 1.78(a)(3).

If all the above-stated conditions are satisfied, a Certificate of Correction can be used to amend the patent to make reference to a prior copending application, or to correct an incorrect reference to the prior copending application, for benefit claims under 35 U.S.C. 120 and 365(c).

If any of the above-stated conditions is not satisfied, the filing of a reissue application (see MPEP § 1401 - § 1460) may be appropriate to pursue the desired correction of the patent for benefit claims under 35 U.S.C. 120 and 365(c).

1485 Handling of Request for Certificates of Correction [R-7]

A request for a Certificate of Correction should be addressed to:

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

Requests for Certificates of Correction will be forwarded to the Certificate of Correction Branch of the Office of Patent Publication, where they will be listed in a permanent record book.

If the patent is involved in an interference, a Certificate of Correction under 37 CFR 1.324 will not be issued unless a corresponding motion under 37 CFR 41.121(a)(2) or 41.121(a)(3) has been granted by the administrative patent judge. Otherwise, determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a Certificate of Correction will be made by the Certificate of Correction Branch. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making