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

201 Types of Applications

Patent applications fall under three broad types: (1) applications for patent under 35 U.S.C. 101 relating to a "new and useful process, machine, manufacture, or composition of matter, etc."; (2) applications for plant patents under 35 U.S.C. 161; and (3) applications for design patents under 35 U.S.C. 171. The first type of patents are sometimes referred to as "utility" patents or "mechanical" patents when being contrasted with plant or design patents. The specialized procedure which pertains to the examination of applications for design and plant patents will be treated in detail in Chapters 1500 and 1600, respectively.

201.01 Sole

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

201.02 Joint

A joint application is one in which the invention is presented as that of two or more persons.

201.03 Convertibility of Application [R–26]

Rule 45. Joint Inventors (Second Paragraph). **(b)** If an application for patent has been made through error and without any deceptive intention by two or more persons as joint inventors when they were not in fact joint inventors, the application may be amended to remove the names of those not inventors upon filing a statement of the facts verified by all of the original applicants, and an oath or declaration as required by rule 65 by the applicant who is the actual inventor, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

The required "statement of the facts verified by all of the original applicants" must include at the least, a recital of the circumstances, including the relevant dates, of (1) the misjoinder and (2) the discovery of the misjoinder. Without such a showing of circumstances, no basis exists for a conclusion that the application had been made in the names of the original sole or joint applicant(s) "through error and without any deceptive intention", and no foundation is supplied for a ruling that the amendment to remove the names of those not inventors or include those to be added as inventors was "diligently made."

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

It is possible to file a sole application to take the place of the joint application, subject to the requirements of Rule 45.

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

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

Rule 45. (Third Paragraph) Joint Inventors. If an application for patent has been made through error and without any deceptive intention by less than all the actual joint inventors, the application may be amended to include all the joint inventors upon filing a statement of the facts verified by, and an oath or declaration as required by Rule 65 executed by, all the actual joint inventors, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

Any attempt to effect a second conversion, of either type or to effect both types of conversion, in a given application, must be referred to the Group Director. The provisions of Rule 312 apply to attempted conversions after allowance and before issue. When any conversion is effected, the file should be sent to the Application Branch for a revision of its records. Adding an inventor's name on the drawing is done at applicant's request and expense. Cancelling a name is ordinarily done without charge.

Where a person is added or removed as an inventor during the prosecution of an application before the Patent Office, problems may occur upon applicant claiming U.S. priority in a foreign filed case. Therefore Examiners should acknowledge any addition or removal of inventors made in accordance with the practice under Rule 45 and include the following statement in the next communication to applicant or his attorney.

> "In view of the papers filed _____, it has been found that this application, as filed, through error and without any deceptive intention (failed to include _____ as an actual joint inventor; or included _____ as a joint inventor who was not in fact a joint inventor) and accordingly, this application has been corrected in compliance with Rule 45."

201.04 Original or Parent

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

201.05 Reissue

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

201.06 Division [R-26]

A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division". Except as provided in Rule 45, both must be by the same applicant. (See below.) The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

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

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

While a divisional application may depart from the phraseology used in the parent case there may be no departure therefrom in substance or variation in the drawing that would amount to "new matter" if introduced by amendment into the parent case. Compare §§ 201.08 and 201.11.

Rule 147. Separate application for invention not elected. The nonelected inventions, those not elected after a requirement for restriction (rule 142), may be made the subjects of separate applications, which must conform to the rules applicable to original applications and which will be examined in the same manner as original applications. However, if such an application is filed before the patenting or abandon-

ment of or termination of proceedings on the original application, and if the drawings are identical and the application papers comprise a copy of the original application as filed, prepared and certified by the Patent Office, together with a proposed amendment cancelling the irrelevant claims or other matter, signing and execution by the applicant may be omitted.

Since the language of Rule 147 "prepared and certified" contemplates that the papers will not leave the custody of this Office, the request for the certified copy should be submitted to this Office with the other pertinent parts, and if the requirements under that Rule are fully met, the application will be given a filing date of the date on which the *request and parts are received.* The "proposed amendment" should add to the specification, "This is a division of application Serial No. __, filed __", and should be the first sentence of the paragraph following the abstract except in design applications (see § 1503.01).

Rule 147 is clearly restricted by its terms to divisional applications directed to "nonelected inventions, those not elected after a requirement for restriction." It is thus more limited than 35 U.S.C. 121, on which it is based, and applies only to divisional applications which are necessitated by a requirement for restriction in the parent case.

It is further to be noted that a Rule 147 application comprises (1) a copy of the original application *as filed*, prepared and certified by the Patent Office and (2) a proposed amendment canceling the irrelevant claims or other matter. The sole justification for the use of unexecuted copies in the divisional application is that their subject matter has already been executed in the parent case. Accordingly, an application under Rule 147 should not, either as filed or by a preliminary amendment prior to the time when it is accorded a filing date, contain anything whatever that was not present in the parent application *as filed.* The Patent Office cannot undertake, prior to giving a filing date, to decide whether differences between the parent and divisional case involve matters of substance or of form only. It follows that any proposed amendments to the divisional application should be withheld until it has received a filing date. However, an amendment stating that the Rule 147 application is a division of the parent case may accompany the application, but no amendments to the specification or drawing other than this and cancellation of the other claims or other matter should be requested until the application has received its serial number and filing date. See § 201.11 for entry of the reference to the parent case by Examiner's Amendment in Rule 147 cases.

Note that execution and signing of the divisional case may be omitted, under Rule 147, only if restriction had been required as to the claims originally filed. See In re Application Papers of Kopf et al., 779 O.G. 290. Since a Rule 147 application must be based on the parent case as filed and must be directed to nonelected inventions, the claims which it is sought to include in such an application must be original claims of the parent case and must have been present in that case *in their original form* when the restriction requirement was made; but if that condition is satisfied, it is not material that other claims were amended or new claims were added prior to the requirement so long as no such amended or added claim is to be included in the Rule 147 application.

Since Rule 147 is limited by its terms to cases in which the parent application is still pending when the divisional case is filed, it is necessary that all requirements of the rule be satisfied prior to abandonment or patenting of the parent application.

Since Rule 45 (second paragraph) permits the conversion of a joint application to a sole, it follows that a new application, restricted to divisible subject matter, filed during the pendency of the joint application by one of the joint applicants, in place of restricting and converting the joint case, may properly be

identified as a division of the joint application. In like manner under Rule 45(c), a new joint application for divisible subject matter present in a sole application may be identified as a division if filed by the sole applicant and another during the pendency of the sole. See § 201.11.

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

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

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

(c) There must be filed in the new application the verified statement of facts required by Rule 45.

For notation to be put on the file wrapper by the Examiner in the case of a divisional application see § 202.02. [R–22]

201.07 Continuation [R–22]

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned. Except as provided in Rule 45, the applicant in the continuing application must be the same as in the prior application. The disclosure presented in the continuation must be the same as that of the original application, i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.

At any time before the patenting or abandonment of or termination of proceedings on his earlier application, an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the Primary Examiner.

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

Streamlined Continuation

If the drawings and specification of a new application are to be identical with those of a pending application of the same applicant, and if the claims are to be directed to the same invention as that prosecuted in the pending application, the application papers of the earlier case, excepting the claims but including the drawing, may be used in the new case. A request for the use of such papers must be made and such request will be considered a waiver of the right to further prosecution of the earlier application and will terminate proceedings therein as of the filing date accorded the new application. The streamlined continuation application will be considered as having been filed before the abandonment of the earlier application (35 U.S.C. 120). A new set of claims directed to the same invention as that prosecuted in the pending application is required. The filing fee will be that appropriate to all the claims to be included in the new case. The entire file wrapper contents of the earlier application will be included in the file of the new one but the Office actions in the former will not be regarded as actions in the latter and the prosecution of the new application will be conducted in the same manner as if new application papers had been filed. A new serial number and filing date will be accorded but the effective filing date will be that of the earlier application.

A suggested format for transmitting a new set of claims and requesting the use of the contents of an earlier filed application for a streamlined continuation application is set forth below.

Request for Streamlined Continuation Application Under Commissioner's Order 824 O.G. 1

Earlier copending application:

Applicant(s) _____

Serial No. _____

Filed _____

Title _____

Enclosed are:

1. A new set of claims.
2. Filing Fee of $_____ (or*), to cover—

Total Number of Claims _____

Independent Claims _____

Please use the contents (specification and drawings) of the above application in the new application since it meets all the requirements of the above Commissioner's Order dated February 11, 1966. The specification (and drawings) of the new application are identical with the earlier application, and the new claims are directed to the same invention.

*"Authorization letter (2 copies) for use of funds in my Deposit Account No. _____ for the filing fee of $_____, to cover—

Total Number of Claims _____

Independent Claims _____

The streamlined continuation application procedure may not be used when at the time of filing the continuation application: (1) the parent application has been allowed and the issue fee has been paid; (2) the parent application is, or has been, involved in court action; (3) the parent application has been abandoned; or (4) the parent application is, or has been, involved in an interference declared prior to the date of filing the streamlined continuation application. If a continuation application having one of the above defects (as determined by the clerical personnel as soon as the application

is received in the Examining Group) is filed, it is returned to Application Branch for cancellation of the serial number and filing date, and applicant notified accordingly.

If there is a defect in the format of a streamlined continuation application which can be corrected, such as failure to include claims drawn to the same invention prosecuted in the parent application, failure to grant a power of attorney in either application to the person filing the continuation application, or some other minor defect, applicant will be given one month to correct the defect. Failure to do so will result in the cancellation of the continuation application.

The Primary Examiner makes an initial review, the main function of which is to determine that the new case is a proper continuation and how to treat the case if it is not proper.

While the conditions of the streamlined practice require that "the claims are to be directed to the same invention as that prosecuted in the pending application," the inclusion of one such claim will be acceptable to preserve the serial number and filing date. Claims to the same invention in continuation cases are claims which cannot be properly restricted from the claims prosecuted in the parent application and are fully supported by that disclosure.

The Examiner will notify applicant by telephone of a defective or unacceptable application. Form POL–324 will be completed and signed by the Primary Examiner in each instance where a streamlined continuation is defective or not accepted and a copy mailed to applicant. The defect, if correctible, must be corrected within one month from the mailing date of the form.

When examining a streamlined continuation that includes claims (1) having matter not supported by the original disclosure or (2) directed to an invention other than that prosecuted in the parent case, these claims will be rejected by the Examiner on 35 U.S.C. 132 and 121, respectively. These rejections should indicate that the claims are not in accordance with the conditions set out in the Notice of February 11, 1966 (824 O.G. 1), instituting the streamlined continuation practice.

Although the filing of a defective streamlined continuation will not operate to abandon the parent case, neither will it prevent the parent case from becoming abandoned by operation of law. On the other hand, in situations where the parent case is awaiting action by the Office, no action will be taken while the streamlined continuation application is being reviewed for acceptability of its filing date.

Where the applicant has inadvertently omitted a reference to the parent case in a streamlined continuation, as required by 35 U.S.C. 120, the reference may be inserted by Examiner's Amendment if the case is otherwise ready for allowance (see § 201.11).

All foreign priority information under 35 U.S.C. 119 and continuing application data under 35 U.S.C. 120 must be entered on the file wrapper of the streamlined continuation.

201.08 Continuation-in-Part [R–22]

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

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated in the case of a sole divisional application stemming from a joint application (§ 201.06). Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

For notation to be put on the file wrapper by the Examiner in the case of a continuation-in-part application see § 202.02. [R–25]

201.09 Substitute [R–25]

The use of the term "Substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case, finds official recognition in the decision, Ex parte Komenak, 1940 C.D. 1; 512 O.G. 739. Current practice does not require applicant to insert in the specification reference to the earlier case. The notation on the file wrapper (See § 202.02) that one case is a "Substitute" for another is printed in the heading of the patent copies. See § 201.11.

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

201.10 Re-file

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

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

201.11 Continuity Between Applications: When Entitled to Filing Date [R–25]

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

35 U.S.C. 120. Benefit of earlier filing date in the United States. An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

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

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

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

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

The term "same inventor" has been construed in *In re Schmidt*, 1961 C.D. 542; 772 O.G. 897, to include a continuing application of a sole inventor derived from an application of joint inventors where a showing was made that the joinder involved error without any deceptive intent (35 U.S.C. 116). See § 201.06.

Copendency

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

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

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

The expression "termination of proceedings" is new in the statute, although not new in practice. Proceedings in an application are obviously terminated when it is abandoned or

when a patent has been issued, and hence this expression is the broadest of the three. There are several other situations in which proceedings are terminated as is explained in § 711.02(c).

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

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor, and the second application may be referred to as a continuing application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter.

Reference to First Application

The third requirement of the statute is that the second (or subsequent) application must contain a specific reference to the first application. This should appear as the first sentence of the specification following the title and abstract. In the case of design applications, it should appear as set forth in § 1503.01. In view of this requirement, the right to rely on a prior application may be waived or refused by an applicant by refraining from inserting a reference to the prior application in the specification of the later one. If the Examiner is aware of the fact that an application is a continuing application of a prior one, he should merely call attention to this in an Office action, for example, in the following language:

"It is noted that this application appears to claim subject matter disclosed in applicant's prior copending application Serial No. ------, filed ----------. A reference to this prior application must be inserted in the specification of the present application if applicant intends to rely on the filing date of the prior application, Rule 78."

In Rule 147 (certified copy) divisional cases, applicant, in his amendment canceling the nonelected claims, should include directions to enter "This is a division of application Serial No. ------, filed ----------" as the first sentence following the abstract. Where the applicant has inadvertently failed to do this and the Rule 147 divisional case is otherwise ready for allowance, the Examiner should insert the quoted sentence by Examiner's Amendment.

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

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

Where the applicant has inadvertently failed to make a reference to the parent case in a streamlined continuation which is otherwise ready for issue the Examiner should insert the required reference by Examiner's Amendment.

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant desires that the pending application have the benefit of the filing date of the first filed application he must, besides making reference in the specification to the intermediate application, also make reference in the specification to the first application. See Hovlid v. Asari et al., 134 USPQ 162; 305 F. 2d 747 and Sticker Industrial Supply Corp. v. Blaw-Knox Co. et al., 160 USPQ 177.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See In re Henriksen, 158 USPQ 224; 853 O.G. 17.

A second application which is not copending with the first application, which includes those called substitutes in § 201.09, is not entitled to the benefit of the filing date of the prior application and the bars to the grant of a patent are computed from the filing date of the second application. An applicant is not required to refer to such applications in the specification of the later filed application. If the Examiner is aware of such a prior abandoned application he should make a reference to it in an Office action in order that the record of the second application will show this fact. In the case of a "Substitute" application, the notation on the file wrapper is printed in the heading of the patent copies and thus calls attention to the relationship of the two cases.

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

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

When Not Entitled To Benefit of Filing Date

Where the first application is found to be fatally defective because of insufficient disclosure to support allowable claims, a second application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. Hunt Co. v. Mallinckrodt Chemical Works, 83 USPQ 277 at 281 and cases cited therein. [R-24]

201.12 Assignment Carries Title [R-24]

Assignment of an original application carries title to any divisional, continuation, substitute or reissue application stemming from the original application and filed after the date of assignment. See § 306.

201.13 Right of Priority of Foreign Application [R-24]

Under certain conditions and on fulfilling certain requirements, an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country, to overcome an intervening reference or for similar purposes. The conditions are specified in 35 U.S.C. 119.

35 U.S.C. 119. Benefit of earlier filing date in foreign country; right to priority. An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

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

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

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

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

1. The foreign application must be one filed in "a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States."
2. The foreign application must have been filed by the same applicant (inventor) as the applicant in the United States, or by his legal representatives or assigns.
3. The application in the United States must be filed within twelve months from the date of the earliest foreign filing in a "recognized" country as explained below.
4. The foreign application must be for the same invention as the application in the United States.

Recognized Countries of Foreign Filing

The right to rely on a foreign application is known as the right of priority in international patent law and this phrase has been adopted in our statute. The right of priority originated in a multilateral treaty of 1883, to which the United States adhered in 1887, known as the International Convention for the Protection of Industrial Property. This treaty has been revised several times, the latest revision in effect being written in Lisbon in 1958. The treaty was last revised in Stockholm in July, 1967 (copy at 852 O.G. 511) but this revision has not yet become effective. One of the many provisions of the treaty requires each of the adhering countries to accord the right of priority to the nationals of the other countries and the first United States statute relating to this subject was enacted to carry out this obligation. There is another treaty between the United States and some Latin American countries which also provides for the right of priority, and a foreign country may also provide for this right by reciprocal legislation.

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

If any applicant asserts the benefit of the filing date of an application filed in a country not on this list, the Examiner should inquire to determine if there has been any change in the status of that country. It should be noted that the right is based on the *country* of the foreign filing and not upon the citizenship of the applicant.

Identity of Inventors

The inventors of the U.S. application and of the foreign application must be the same, for a

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

Time for Filing U.S. Application

The United States application must be filed within twelve months of the foreign filing. In computing this twelve months, the first day is not counted; thus, if an application was filed in Canada on January 2, 1952, the U.S. application may be filed on January 2, 1953. The Convention specifies in Article 4C (2) that "the day of filing is not counted in this period." (This is the usual method of computing periods, for example the six months for reply to an Office action dated January 2 does not expire on July 1 but the reply may be made on July 2.) If the last day of the twelve months is a Sunday or a holiday within the District of Columbia, the U.S. application is in time if filed on the next succeeding business day; thus, if the foreign application was filed on September 6, 1952, the U.S. application is in time if filed on September 8, 1953. since September 6, 1953 was a Sunday and September 7, 1953 was a holiday. After January 1, 1953, the Patent Office has not received applications on Saturdays and, in view of 35 U.S.C. 21, and the Convention which provides "if the last day of the period is a legal holiday, or a day on which the Patent Office is not open to receive applications in the country where protection is claimed, the period shall be extended until the next working day" (Article 4C3), if the twelve months expires on Saturday, the U.S. application may be filed on the following Monday.

First Foreign Application

The twelve months is from the earliest foreign filing. If an inventor has filed an application in France on January 2, 1952, and an application in Great Britain on March 3, 1952, and then files in the United States on February 2, 1953, he is not entitled to the right of priority at all; he would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and he would not be entitled to the benefit of the date of the British application since this application is not the first one filed. If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose.

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

Great Britain and a few other countries have a system of "post-dating" whereby the filing date of an application is changed to a later date. This "post-dating" of the filing date of the application does not affect the status of the application with respect to the right of priority; if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application.

If an applicant has filed two foreign applications in recognized countries, one outside the year and one within the year, and the later application discloses additional subject matter, a claim in the U.S. application specifically limited to the additional disclosure would be entitled to the date of the second foreign application since this would be the first foreign application for that subject matter.

Effect of Right of Priority

The right to rely on the foreign filing extends to overcoming the effects of intervening references or uses, but there are certain restrictions. For example the one year bar of 35 U.S.C. 102(b) dates from the U.S. filing date and not from the foreign filing date; thus if an invention was described in a printed publication, or was in public use in this country, in November 1952, a foreign application filed in January 1953, and a U.S. application filed in December 1953, granting a patent on the U.S. application is barred by the printed publication or public use occurring more than one year prior to its actual filing in the U.S.

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

INVENTORS' CERTIFICATES

At present, the Patent Office does not recognize a right of priority based upon an application for an Inventors' Certificate such as used in the U.S.S.R. However, a claim for priority and a certificated copy of an application for Inventors' Certificate are entered in the file of the U.S. application and are retained therein. This allows the applicant to urge the right of priority in possible later court action.

201.14 Right of Priority, Formal Requirements [R–24]

Under the statute (35 U.S.C. 119, second paragraph), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specified. If these requirements are not complied with the right of priority is lost and cannot thereafter be asserted.

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

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

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

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

201.14(a) Right of Priority, Time for Filing Papers [R–24]

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

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

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

In view of the shortened periods for prosecution leading to allowances, it is recommended that priority papers be filed as early as possible. Although Rule 55 permits the filing of priority papers up to and including the date for payment of the issue fee, it is advisable that such papers be filed promptly after filing the application. Frequently, priority papers are found to be deficient in material respects, such as, for example, the failure to include the cor-

rect certified copy, and there is not sufficient time to remedy the defect. Occasionally a new oath or declaration may be necessary where the original oath or declaration omits the reference to the foreign filing date for which the benefit is claimed. The early filing of priority papers would thus be advantageous to applicants in that it would afford time to explain any inconsistencies that exist or to supply any additional documents that may be necessary.

It is also suggested that a pencil notation of the Serial Number of the corresponding U.S. application be placed on the priority papers.

201.14(b) Rights of Priority, Papers Required [R-22]

The main purpose in amending the statute to require the filing of the priority papers was to make the record of the file of the United States patent complete. The Patent Office does not examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority, except as described in § 201.15 and in cases of interferences.

The papers required are the claim for priority and the certified copy of the foreign application. The claim to priority need be in no special form, and may be made by the attorney or agent at the time of transmitting the certified copy if the foreign application is the one referred to in the oath or declaration of the U.S. application. No special language is required in making the claim for priority and any expression which can be reasonably interpreted as

claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration with the recitation of the foreign application.

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the application as filed with a certificate of the foreign patent office giving certain information. Application in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed. A French patent stamped "Service De La Propriété Industrielle—Conforme Aux Piéces Déposées A L' Appui de La Demande" and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application.

When the claim to priority and the certified copy of the foreign application are received while the application is pending before the Examiner, the Examiner should make no examination of the papers except to see that they correspond in date and country to the application identified in the oath and contain no obvious formal defects. The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof.

During Interference

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

Continuing Applications, Reissues

Where the benefit of a foreign filing date is claimed in a continuing application or in a reissue application and a certified copy has been received in the parent case, it is not necessary to file an additional certified copy in the later case. The applicant when making the claim for priority may simply call attention to the fact that the certified copy is in the parent application. In such cases the Examiner should acknowledge the claim with a statement as follows:

[1] "Applicant's claim for priority, based on papers filed in parent application Serial No. ------, submitted under 35 U.S.C. 119, is acknowledged."

This sentence appears on work sheet form PO–1002 as statement No. 4.

If the applicant fails to call attention to the fact that the certified copy is in the parent application and the Examiner is aware of the fact that the parent of a continuing application has fully complied with the requirements of 35 U.S.C. 119 and is therefore entitled to the benefit of the filing date of an earlier filed foreign application, he should direct it to the applicant's attention in an Office action, as in the following exemplary language:

[2] "Applicant is reminded that in order to be entitled to priority based on papers filed in parent application Serial No. ------ under 35 U.S.C. 119, a claim for such priority must be made in this application. In making such claim, applicant may simply call attention to the fact that a certified copy of the foreign application is in the parent application. (M.P.E.P. 201.14(b).)" [R–20]

201.14(c) Right of Priority, Practice [R–20]

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

No Irregularities

When the papers under 35 U.S.C. 119 are received they are to be endorsed on the contents page of the file as "Letter (or amendment) and foreign application". Assuming that the papers are regular in form and that there are no irregularities in dates, the Examiner in the next Office action will advise the applicant that the papers have been received. The form of acknowledgment may be as follows:

[1] "Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file."

This sentence appears on work sheet form PO–1002 as statement 3.

The Examiner will enter the information specified in section 202.03 on the face of the file wrapper.

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

Papers Inconsistent

If the certified copy filed does not correspond to the application identified in the application oath or declaration, or if the application oath or declaration does not refer to the particular foreign application, the applicant has not complied with the requirements of the rule relating to the oath or declaration. In such instances the Examiner's letter, after acknowledging receipt of the papers, should require the applicant to explain the inconsistency and to file a new oath or declaration stating correctly the facts concerning foreign applications required by Rule 65. A letter in such cases may read:

[2] "Receipt is acknowledged of papers filed ----------, based on an application filed in ---------- on ----------. Applicant has not complied with the requirements of Rule 65(a), since the (*oath or declaration*) does not acknowledge the filing of any foreign application. A new (*oath or declaration*) is required."

This paragraph appears on work sheet form PO–1002 as statement 7.

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

No Claim for Priority

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

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

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

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

This paragraph appears as statement 6 on work sheet form PO–1002.

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

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

[5] "Receipt is acknowledged of papers filed on September 18, 1953, purporting to comply with the requirements of 35 U.S.C. 119. It is not seen how the claim for priority can be based on the British specification filed January 23, 1948, because the instant application was filed more than one year thereafter. However, the printed heading of the patent will note the claimed priority date based on the complete specification; i.e., November 1, 1948, for such subject matter as was not disclosed in the provisional specification."

Certified Copy Not the First Filed Foreign Application

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

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

No Certified Copy

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

The above paragraph appears as statement 5 on work sheet form PO–1002.

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

Application in Issue

The priority papers may be received while the application is in issue. When the papers are apparently regular in form and correspond to the earliest foreign application recited in the oath or declaration and this application is not too old, the Issue Branch will enter the papers, acknowledge their receipt, and make the notation on the face of the file. If irregular priority papers are received while the applica-

tion is in issue, the Issue Branch will take appropriate action. If foreign application papers are received after the Issue fee has been paid, they will be left in the file wrapper and the applicant notified by the Issue Branch that the papers were received too late to be admitted.

Return of Papers

It is sometimes necessary for the Examiner to return papers filed under 35 U.S.C. 119 either upon request of the applicant or because they fail to meet a basic requirement of the statute, for example, all foreign applications were filed more than a year prior to the U.S. filing date.

Where the papers have not been made of record in the file, it is not necessary to secure approval of the Commissioner for their return but they should be sent to the Group Director for cancellation of the Office stamps. Where the papers have been made of record in the file, a request for permission to return the papers should be addressed to the Commissioner of Patents and forwarded to the Group Director for approval. [R-25]

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

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

If the priority papers are already in the file when the Examiner finds a reference with the intervening effective date, the Examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. If the applicant is found to be entitled to the date, the reference is simply not used. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are not in the English language and there is no translation, the Examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date.

The foreign application may have been filed by the assignee or legal representative or agent of the inventor, in his or its own name as applicant. In such cases, if the certified copy of the foreign application corresponds with the one identified in the oath or declaration as required by Rule 65 and no discrepancies appear, it may be assumed that the inventors are the same. If there is disagreement as to inventors on the certified copy, the priority date should be refused until the inconsistency or disagreement is resolved.

The most important aspect of the Examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications The foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that he would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought.

In applications filed from Great Britain there may be submitted a certified copy of the British "provisional specification," which may also in some cases be accompanied by a copy of the "complete specification." The nature and function of the British provisional specification is decribed in an article in the Journal of the Patent Office Society of November 1936, pages 770–774. According to British law the provisional specification need not contain a complete disclosure of the invention in the sense of 35 U.S.C. 112, but need only describe the general nature of the invention, and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important. If it is found that the British provisional specification is insufficient for lack of disclosure, reliance may then be had on the complete specification and its date, if one has been presented, the complete specification then being treated as a different application.

In some instances the specification and drawing of the foreign application may have been filed at a date subsequent to the filing of the petition in the foreign country. Even though the petition is called the application and the filing date of this petition is the filing date of the application in a particular country, the date accorded here is the date on which the specification and drawing were filed.

It may occasionally happen that the U.S. application will be found entitled to the filing

date of the foreign application with respect to some claims and not with respect to others. Occasionally an applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

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

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

201.17 Government Cases [R–24]

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

202 Cross-Noting

202.01 In Specification [R–24]

See Rule 78(a), Rule 79 and § 201.11.

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

202.02 Notation on File Wrapper of a Divisional, Continuation, Continuation-in-Part, or Substitute Application [R–24]

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

The status of the parent or prior application as "abandoned" is not written on the file wrapper.

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

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

In the unlikely situation that there has been no reference to a parent application because the benefit of its filing date is not desired, no notation as to the parent case is made on the face of the file wrapper. [R–22]

202.03 On File Wrapper When Priority Is Claimed for Foreign Application [R–22]

In accordance with § 201.14(c) the Examiner will fill in the spaces concerning foreign applications provided for on the face of the file wrapper.

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

The file wrappers used during the filing period July 1964 to September 1966 contain separate boxes for the application and patent numbers, and a box for checking if no claim for priority has been made.

File wrappers in use from September 1966 to the present further include an additional box labeled "B" for the Examiner to use for indicating compliance of applicant with 35 U.S.C. 119.

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

The heading of the printed specification of the patent when it is issued, and the listing in the Official Gazette, will refer to the claim of priority, giving the country, the filing date, and the number of the application (and the patent number in some instances) in those cases in which the face of the file has been endorsed.

In the case of designs, only the country and filing date are to be used.

202.04 In Oath or Declaration [R–22]

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

202.05 In Case of Reissues

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

203 Status of Applications

203.01 New

A "new" application is one that has not yet received an action by the Examiner. An amendment filed prior to the first Office Action does not alter the status of a "new" application.

203.02 Rejected [R–22]

An application which, during its prosecution in the Examining Group and before allowance, contains an unanswered Examiner's action is designated as a "rejected" application. Its status as a "rejected" application continues as such until acted upon by the applicant in response to the Examiner's action (within the allotted response period), or until it becomes abandoned.

203.03 Amended

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

203.04 Allowed or in Issue [R–22]

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

The files of allowed cases are kept in the Issue and Gazette Branch, arranged numerically by serial number.

203.05 Abandoned [R–22]

An abandoned application is, *inter alia*, one which is removed from the Office docket of

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

203.06 Incomplete [R–23]

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

203.07 Abandonment for Failure to Pay Issue Fee [R–23]

An allowed application in which the Base Issue Fee is not paid within three months after the Notice of Allowance is abandoned for that reason. The issue fee may however be accepted by the Commissioner within a further period of three months on a verified showing of sufficient cause in which case the patent will issue as though no abandonment had occurred.

203.08 Status Inquiries [R–23]

Duty of Inquiry as to Status of Pending Applications

The question as to applicant's diligence in checking the status of an application is considered in connection with petitions to revive applications which become abandoned through failure to respond to an Office action which is mailed but not received. For new applications, no lack of diligence will be attributed if inquiry as to the status of the application is received by the Patent Office within either of the two following periods, whichever expires later:

a. Twenty-one (21) months from the filing date of the application, or

b. A reasonable period after the Official Gazette indicates that the filing date of the oldest new case awaiting action in the Group to which the application is assigned, is more recent than the filing date of the application.

For amended cases, the applicant will be considered to have exercised diligence in connection with a petition to revive an application abandoned for failure to respond to a second or subsequent action if inquiry as to the status of the application is received by the Patent Office within six (6) months after the filing of a response to which no reply from the Patent Office has been received.

When an application has been abandoned for an excessive period before the filing of a petition to revive, an appropriate terminal disclaimer may be required.

Replies to inquiries regarding the status of both new and amended applications may be more expeditiously processed by the Patent Office if each inquiry is accompanied by a stamped returned-addressed envelope. Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Correspondence and Mail Branch, to the Examining Groups for direct action. Such letters will be stamped "Status Letters."

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

If the inquiry is directed to an application awaiting action by the Office, a prediction should be made of the probable date of reaching the case for action. The clerical force stamps status letters with a stamp provided in each Group and submits them to the Examiner having jurisdiction of the application who fills in the blanks. The original letter of inquiry should be returned to the correspondent together with the reply. The reply to an inquiry which includes a self-addressed, postage-paid postcard should be made on the postcard without placing it in an envelope. The reply does not count as an action in the case. This prediction of a date is not to be considered as binding upon the Examiner in making his next action.

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

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

Inquiries from Members of Congress concerning the status of pending applications should not be answered by the Examiner but should be referred promptly to the Commissioner's Office for answer with a report as to when a particular case will be reached for further action on the part of the office.

Another type of inquiry is to be distinguished from ordinary status letters. When a U.S. ap-

plication is referred to in a foreign patent (for priority purposes, for example), inquiries as to the status of said application (abandoned, pending, patented) should be forwarded to the Application Branch.

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