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Via Electronic Mail

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cc: `Hiram.Bernstein@uspto.gov`

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Comments on Changes to Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act
Notice of Proposed Rulemaking January 6, 2012

Attn: Hiram H. Bernstein, Senior Legal Advisor, Office of Patent Administration, Office of the Associate Commissioner for Patent Examination Policy

Dear Director Kappos,

Eli Lilly and Company appreciates the opportunity to comment on the United States Patent and Trademark Office's (USPTO's) proposed rule changes concerning the Inventor's Oath or Declaration (35 U.S.C. §115) and Assignee Filing (35 U.S.C. §118).

Introduction: Harmonization as One Context for USPTO Rulemaking

At the outset, Lilly would like to note the following with respect to at least one context for the USPTO's rulemaking.

The Leahy-Smith America Invents Act (AIA) represents a sea change in U.S. patent law. One promise of the new patent law is greater international patent harmonization. More uniform global patent laws and patent practices will create opportunities for both inventors and companies seeking patents and for patent offices around the world.

The AIA is more, however, than an effort directed to patent harmonization. It has been repeatedly noted that Congress sought to make the new U.S. patent law more transparent, objective, predictable, and simple, in effect, a global model for a 21st century patent law. The U.S. law was not only changed to produce a more transparent definition for prior art, to make the enforceability of a U.S. patent more predictable and to provide important new avenues in the USPTO for challenging questionable patents, but key sections of the new law were specifically directed to the simplification of the more formal aspects of applying for a patent – specifically, who may apply for a U.S. patent and what verification is needed from the applicant for a patent with respect to the applicant’s right to seek the patent.

The simplification of the so-called “oath or declaration” provisions of U.S. patent law, as well as the explicit authorization for the inventor’s assignee to be the applicant for patent were clearly part of a broad Congressional intent to modernize both U.S. patent law and the practices by applicants and the USPTO for filing and processing patents. The United States has for many years been an outlier with its requirement for filing patent applications in the name of the inventor only.

For example, the United States is the only country out of 144 PCT member states that do not yet permit filing in the name of the assignee. When the AIA provision amending §118 takes effect later this year, the United States patent law should be indistinguishable in its practical impact from the patent laws of the remaining 143 PCT member states. Thus, a critical accomplishment of USPTO rulemaking relating to the §115 and §118 changes to the patent statute should be the simplest and best implementation of this harmonizing change to U.S. patent law.

As part of the comprehensive changes to §115 and §118 enacted as part of the AIA, Congress – in a subtle but fundamental manner – replaced the old §115 requirement for a formal “oath” of the inventor that must accompany the filing of a patent application with a new requirement for the applicant for patent to name the inventor as part of a complete application for patent. Indeed, for the vast majority of patent applications that are filed in the future, the AIA is premised on the assumption that there will be neither the old §115 inventor’s “oath” to be filed nor any other statement or representation by the inventor. The AIA eliminated the requirement for any statement by or from the inventor in continuing applications for patent, including continuation-in-part applications, and eliminated the existing practice of providing supplemental statements in situations where the subject matter claimed in the application for patent changes during patent examination.

Thus, while Congress imposed on patent applicants a specific requirement that the inventor be named, and whenever necessary inventorship corrected, in every application filed with the USPTO, the §115 requirements for a statement from the inventor is a one-time requirement that exists only with respect to an original nonprovisional patent filing. Once the one-time statement from the inventor or a joint inventor has been made in satisfaction of §115, the new statute imposes no requirement that it ever need be updated, modified, supplemented or otherwise corrected.

The AIA itself explains why the §115 requirements imposed on the inventor were limited in each of the respects described above. In an assignee-filed application for patent, the inventor was to be heard to solely affirm its status as an original inventor and to authorize the assignee’s patent filing. Having been

so heard once, the inventor, under the AIA's provisions, need not be heard again in order for the patent application to proceed to grant. Indeed, Congress appears to have been careful in drafting the AIA to emphasize that the §115 requirements on the inventor were no longer to be tied to the filing of an assignee's application for patent – superseding that requirement with an application filing requirement imposed on the assignee to name the inventor as part of the complete application for patent – by explicitly affording assignees the right to file the §115 statement from the inventor at any time prior to the Notice of Allowance.

The new statutory framework provides the opportunity for a win-win outcome for the USPTO and assignee-applicants. The naming of the inventor will take place at the time of patent filing, with the USPTO regulations imposing on the assignee-applicant the requirement to provide a complete identification of the inventor or each joint inventor either within the application as filed or in response to a notification of “missing parts.” Because (as with the old §115 “oath” requirement), inventor identification early in the patent process remains important in determining patentability, the rules of the USPTO – consistent with §115 – can and should consider inventor identification as a filing requirement.

The “win” for patent applicants comes in part from the fact that a U.S. national patent filing, or a PCT filing in which the U.S. national stage will be entered, can proceed in the United States in exactly the same manner and with exactly the same formalities as will exist in each of the other 143 PCT member states. The other part of the “win” for assignee-applicants lies in the explicit provisions of §115 that permit the statements required of the inventor to be placed in their most natural place – not in the file of the application to be examined, but in the assignment that is recorded in the USPTO and kept separate from the USPTO's application file wrapper. Again, the benefit for assignee-applicants is that adding several lines to a patent assignment document will be all that is necessary to comply with U.S. formalities – and, having complied with U.S. formalities in this manner the assignee-applicant will be in compliance with global application formalities.

Realizing the “win” for the assignee-applicant, however, rests on rulemaking. It requires a global harmonization focus that imposes no more requirements on the assignee-applicant than Congress mandated. If additional requirements beyond what is dictated under the AIA – and unique to the United States – are to be imposed, there should be a compelling policy justification for imposing any requirements here that are not observed in 143 other PCT countries. Given the dearth of circumstances in which an assignee-applicant's right to apply for a patent is ever questioned, the hurdle for finding such a justification should be high.

Assignee filing, as practiced throughout the world, and as intended by Congress under the AIA, recognizes the realities of modern industrial research. With the AIA's provisions coming into effect, the legal and beneficial owner of the technology sought to be patented takes the responsibility for applying for the patent and, at the same time, providing the identification of the individual or individuals who are the inventor in order to both assure that their status is recognized in the application and to provide the predicate for affirming that the assignee has secured the right to seek the patent from the inventor. Looking globally, the applicant for patent is rarely the inventor, with the vast majority of global patent

filings being undertaken by the inventor's assignee. Making this change in U.S. law, and implementing it in a manner that maximizes its opportunities for assignee-applicants and the USPTO, will by itself comprise a major advance to global patent harmonization.

Lilly, as a multi-national biopharmaceutical company dedicated to bringing new medicines to market, conducts its multi-billion dollar research efforts on a global basis. The massive investments needed to undertake this type of global research typically require decade-long commitments – often longer – to bring a new medicine to patients. Our patent practices, except in the United States, proceed with Eli Lilly and Company as the assignee-applicant and without formalities required of the inventor other than an affirmation of inventorship status and authorization of Lilly to file as the assignee. The United States is today the only country where this simplicity and economy both for patent office and patent applicant has not been possible. The AIA now affords the opportunity for the USPTO to fully join the global patent community in the present rulemaking. Lilly is pleased to have the opportunity to comment on the proposed implementation of the provisions of the AIA regarding §115 inventor statements and §118 assignee filing, with the intent that the comments below may further the realization of the opportunity Congress has provided.

The Provisions of the Proposed Rules That Should be Addressed in the Final Rulemaking

The proposed rules, as Lilly understands them and their import for assignee-applicants, appear contrary to the intent of Congress, perhaps even the letter of the new statute, in three critical areas. They are:

- Who is entitled to file the application
- The required content of the inventor's statement under §115
- The required timing of the inventor's statement or a substitute statement

Given Lilly's views, as described more fully below, we are offering for USPTO consideration a set of very specific rule changes that we believe will more accurately carry out the Congressional intent, will better comport with the patenting procedures employed in connection with the overwhelming majority of patent filings, and will achieve optimal consistency with global patent-formality norms. As suggested in the introduction above, Lilly views the congressional intent of the §115 and §118 changes under the AIA as being unmistakably clear: the prior practice of not considering a patent filing to be complete without filing an "oath" in which the inventor avers that it was the original and first inventor of a claimed invention for which a patent was being sought has been replaced with a requirement that the applicant for patent (which typically will not be the inventor) must properly name the inventor and that, unconnected with the patent filing but prior to the Notice of Allowance, each individual named as the inventor (or a joint inventor, as the case may be) must make two brief statements regarding inventorship and the applicant's authorization to file the application. In short, Congress imposed in the AIA nothing more from an assignee-applicant than what has long been the practice in the rest of the patent world.

Who May File an Application for Patent under §115/§118?

The only reading of the AIA as a whole that Lilly believes can be made is that Congress allowed assignees to file patent applications, as the “applicant for patent,” and that the changes to both §115 and §118 under the AIA do not permit a contrary interpretation.

In newly enacted §115, the original provision requiring that the *applicant* indicate in an oath a belief that “*he is the inventor*” has been deleted in favor of a provision noting that the “*application*” filed with the USPTO “*shall include, or be amended to include, the name of the inventor*” and that the inventor needs to execute a two-part statement, *i.e.*, that the application was authorized to be made by the affiant or declarant, and that the individual believes himself or herself to be the original inventor or an original joint inventor. Whether done by oath or declaration, the statement must be made with an acknowledgement of the penalties for false statements. §115(i). The two-part statement, as noted earlier, can be included in the inventor’s assignment document. §115(e). Thus, nothing in §115 requires that it be filed in the application for patent itself, *i.e.*, patent assignments are typically not filed with the patent applications to which they relate, but filed with the Assignment Recordation Branch in the USPTO’s Public Records Division. 37 C.F.R. §3.11. It need only be filed with the USPTO by the time of the Notice of Allowance. §115(f). Again, as noted above, continuing applications for patent (even those with newly disclosed and claimed inventions) do not require the execution or filing of a new statement from the inventor. §115(g)(1). Similarly, other supplemental statements are not required once a statement in compliance with §115 has been filed by the inventor. §115(h)(2).

Newly enacted §118 expressly states that “A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent.” The provision goes on to note that persons who otherwise show sufficient proprietary interest in the matter may *also* make an application on behalf of an inventor. Further, this new language in §118 replaced the language in the prior provision which limited such filings to situations where the inventor was unwilling or unavailable to file the application. Clearly, by replacing the prior provision with the broader language, Congress could not have intended to limit the situations in which an assignee of the subject matter could file a patent application to those that existed previously.

Taken together, these two provisions of the AIA clearly indicate that Congress fully opened the door to a simplified and globally harmonized process under which assignee-applicants can seek patents. The gist of the new filing regime under §115/§118 is that the assignee, as the applicant for patent will fully comply with §115 by identifying the inventor in the patent application as filed and, before the Notice of Allowance is mailed, will record an assignment from the inventor that includes the inventor’s affirmations both that it is an original inventor and it authorized the assignee’s patent filing.

This simplified, harmonized approach to implementation comports with the Congressional intent. Indeed, as noted in Committee Report 112-98:

The U.S. patent system, when first adopted in 1790, contemplated that individual inventors would file their own patent applications, or would have a patent practitioner do so on their

behalf. It has become increasingly common for patent applications to be assigned to corporate entities, most commonly the employer of the inventor. [Citing studies showing up to an 85% assignment rate.]

...

Current law still reflects the antiquated notion that it is the inventor who files the application, not the company-assignee. For example, every inventor must sign an oath as part of the patent application stating that the inventor believes he or she is the true inventor of the invention claimed in the application. By the time an application is eventually filed, however, the applicant filing as an assignee may have difficulty locating and obtaining every inventor's signature for the statutorily required oath. **Although the USPTO has adopted certain regulations to allow filing of an application when the inventor's signature is unobtainable, many have advocated that the statute be modernized to facilitate the filing of applications by assignees. The Act updates the patent system by facilitating the process by which an assignee may file and prosecute patent applications.** It provides similar flexibility for a person to whom the inventor is obligated to assign, but has not assigned, rights to the invention (the "obligated assignee"). [Emphasis added.]

The background section of the January 6 Notice states that:

"The changes to 35 U.S.C. 115 and 118 do not mean that a person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent *in all circumstances.*"

However, §115 and §118 do not admit of *any circumstances* where the assignee of an invention does not have the right to patent the invention – including where the inventor is unavailable or unwilling to make a §115 statement. Simply, there is no exception indicated in §118 that would limit the right of an assignee of the inventor to make the application for patent. Thus, we urge that the proposed rules be amended to permit assignee filing in all circumstances as intended by Congress.

Content of the Oath or Declaration

As noted, 35 USC 115 (b) requires only a single statement with two representations to be made by the inventor – and only requires them to be made in connection with the *initial* nonprovisional patent filing, including in an assignment document that need not be filed in the USPTO with the application for patent, but rather at any time before the application proceeds to allowance:

1. That the application was made or authorized to be made by the affiant or declarant, and
2. That the individual believes himself or herself to be an original inventor or co-inventor of a claimed invention in the application.

While §115 (c) notes that the Director may specify additional requirements for the inventor's statement, consideration of simplicity, advancing greater global patent harmonization, reducing burdens on patent applicants, reducing the administrative processes in the USPTO, and the greater public interest in a more efficient and objective patent system, would all argue that no additional representations from inventors are desirable, much less necessary.

However, the Office has proposed adding requirements for representation that the person making the oath or declaration has reviewed and understands the application and a further representation regarding obligations under current 37 C.F.R. §1.56. No explanation of the need for these additional statements is provided. Indeed, in light of the purpose of the legislative changes, requiring these latter two statements from the inventor in an assignee-filed application for patent is neither desirable nor warranted to protect the public interest, *particularly given the authority of the USPTO to require the applicant to make such further or additional representations with respect to the application for patent that might be dictated by the public interest.*

In a system where the vast majority of the applications will be filed by assignees, the only significant inventor representations are that the application was authorized by the inventor and that the individual making the representation believes he or she is the original inventor or an original joint inventor. Since applicants (assignees) should be represented by registered practitioners (and we propose language in 37 CFR 1.32 to make this clear), the concerns apparently being addressed by the additional statements will be best handled by the registered attorney or agent, acting on behalf of the assignee.

Timing of Filing of the Inventor's Statement

In the background of the notice, it states that “the change to 35 USC 115 does not alter the statutory authorization in 35 USC 111(a) and 371 for requiring the oath or declaration to be submitted prior to examination of the application.” That interpretation is inconsistent with both the intent of Congress and, more importantly, with the actual language in the new statute. Section 115(a) does impose a timing requirement on naming the inventor – making it part of the application for patent. The first sentence of §115(a) provides that the USPTO can both deem an application for patent incomplete if the inventor is not named and hold the application abandoned if the name of the inventor is not provided once this “missing part” is noticed to the applicant. Under the new statute, therefore, complete inventor identification must be provided at the same time – and through an analogous mechanism – through which the pre-AIA statute secured the inventor’s oath in connection with the application as filed.

The second sentence of §115(a) contains nothing with reference to the filing of the application for patent or a requirement in connection with the filing. It merely makes a requirement that a named inventor must then execute a §115 statement *in connection with the application*, not *in connection with the filing* of the application. The only provision in §115 dealing with the submission of the statement lies in §115(f) limiting the right to secure a Notice of Allowance if the filing of the §115 statement has not been accomplished.

Even if §115 could be read to permit the inventor’s §115 statement to be considered as a *patent filing* requirement, rather than a *patent issuance* requirement, why would such timing be necessary for any purpose related to the processing and examination of the application for patent? Lilly would submit that there is no imperative for negating statutory intent, if not the statutory language itself, so long as the USPTO takes full advantage of its rulemaking authority with respect to the assignee-applicant itself. Most specifically, if the proper inventors are named by the applicant on filing of the application (or

promptly thereafter pursuant to a “missing parts” notification), the Office can begin examination. Indeed, in 143 other PCT member states, this is precisely how the processing of the application for patent and the trigger for commencement of examination are conducted.

The notice indicates that the Office considered allowing later filing of the oath or declaration until the case is in condition for allowance, but “considers it better for the examination process and patent pendency to continue to require the oath or declaration during pre-examination.”

The Office’s rationale for requiring an early filing (during pre-examination) includes the following:

1. The Office needs to know who the inventors are to prepare patent application publications and publish applications at eighteen months.
2. The Office needs to know the inventors to conduct examination (e.g., to determine what prior art applies, for both current law and prior art effects after AIA, and for possible double patenting rejections.)
3. Delaying the filing would add to patent application pendency.

As for the first two concerns, naming of the inventors in the Application Data Sheet (ADS) by a registered patent attorney or agent acting on behalf of the applicant (assignee) , would be sufficient. The ADS requires proper identification of the inventors, and thus provides all that is necessary for examination of the prior art and publication of the application. Further, as claims are amended, the registered patent attorney will be in the best position to inform the Office of the proper inventorship.

While the office indicated that under 37 CFR 1.41, inventorship in an application is not set until an oath or declaration is filed, that is not the requirement of the new law, but an Office rule based on interpreting the pre-AIA law in which only the *inventor* could be the *applicant*. We are proposing new language for 37 CFR 1.41 carrying out the intent of the statutory changes.

Nothing prevents the USPTO from requiring the assignee-applicant to make a statement *in connection with the assignee’s patent filing* that it has authority under the statute as assignee to make application for patent and that it will file with the USPTO, before a Notice of Allowance is mailed, the inventor’s statement required under §115. Indeed, for a complete examination of the application itself, the naming of the inventor and the above representation on the part of the applicant should constitute everything required to examine the application for patent and have the application proceed to grant.

As for application pendency concerns, it should be noted that in most cases, the assignment will be executed on filing, or shortly thereafter, for a variety of reasons. In the overwhelming majority of cases, the assignment will have been executed prior to national entry for a PCT application. Thus, if the required statements are made in the assignment, this can be readily filed by the assignee-applicant well in advance of the notice of allowance, thus avoiding any need for an *Ex parte Quayle* action.

Indeed, Lilly believes that the USPTO, if it secured the required representation from the assignee-applicant on authority to file and obligation to submit the inventor’s §115 statement prior to allowance, should simply shift the burden of compliance to the applicant. If a Notice of Allowance is mailed prior to

the assignee-applicant having filed with the USPTO the inventor's §115 statement, then it would be the responsibility of the applicant to petition for withdrawal from allowance for the purpose of filing the statement, a petition for which would be required to include the statement itself.

In addition, the USPTO has the ability to issue a Notice of Allowance with additional formality requirements, with shorter deadlines than the payment of the issue fee. Moreover, any formality delays in pendency caused by the applicant can be excluded from any patent term adjustment (PTA) the patent may otherwise receive. All of these factors, and the associated fees that the USPTO would set for the additional processing required, would provide powerful incentives for the applicant to submit the statement in a timely fashion.

The Notice indicates that for PCT applications, under 35 USC 371(c), the "oath or declaration" must be received before national phase processing can begin. And proposed 37 CFR 1.497 mentions that the "oath or declaration" need only have the two statements as required by the AIA. It also mentions (in 37 CFR 1.497(c)) that if the declaration under 1.497 does not also satisfy 1.63, a supplemental statement may be needed. In light of the comments above, we believe that proposed 37 CFR 1.497(c) be deleted as unnecessary. We note that 35 USC 371(d) does permit the Director to allow filing of the declaration later. However, the reality is that in the overwhelming majority of cases, essentially all of them, for a variety of reasons involving, e.g., right to priority and the like, applicants will have the assignments completed well in advance of the national entry. The overwhelming majority of applicants will have completed them at the time of PCT filing. Clearly, the inventor and applicants will have been named and properly identified in the PCT request prior to national entry.

Thus, we believe that as long as the inventors are named at the time of filing, there need be no delay in examination or processing of the application.

Alternative Implementation of the AIA Provisions under §115 and §118

The manner in which Lilly would urge the AIA provisions amending §115 and §118 be implemented would thus involve the following elements:

1. An applicant, which would mean, in the majority of cases, the assignee of a claimed invention, would file a patent application with the USPTO;
2. The inventorship would be fully identified in the application data sheet;
 - a. The applicant would, in the overwhelming majority of cases, provide the Office the statements required by §115(b) in the assignment document for the application (i.e., that the application was made or was authorized to be made by the affiant or declarant; and such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application); with an acknowledgement of penalties for making willful false statements.
 - b. The §115 statement, thus, would not be filed in the actual application file, but would appear only in the Assignment Recordation Branch, where the only review would be for the required formalities.
 - c. This §115 statement could be filed at any time prior to receiving a Notice of Allowance, without fee or penalty. In most cases, it would be submitted well in advance of this

event. It would be the responsibility of the applicant to insure this statement is submitted prior to notice of allowance.

3. The USPTO could elect to require by rule that an assignee-applicant affirm that it had the right to file for a patent as assignee under §118 and that it had filed or would file prior to the mailing of a Notice of Allowance the inventor's statement under §115.
4. The USPTO would have the option of not duplicating the inventor's §115 statement in the application file or, alternatively the USPTO could then scan the inventor's statement or assignment complying with §115 into any application file in which it wished for the statement to appear. In any continuing application, the USPTO would merely require the applicant-assignee to affirm that a statement complying with §115 had been filed in a parent patent filing or, if not, impose the same requirements as would apply to any initial nonprovisional application filing. In this manner, where compliance with §115 was achieved in the parent patent filing, no additional requirement would be present in any later-filed patent application naming an inventor or a joint inventor and claiming benefit to the earlier-filed application under section 120, 121, or 365(c).

Summary of the Proposed Changes

Section 1.9 (d) is proposed to be amended to conform the definition of inventor to the AIA.

Section 1.17 is proposed to be amended to eliminate fees for petitions for filing by others than the inventor, supplying names of inventors later, and correcting inventorship.

Section 1.27(c)(2)(ii) is proposed to be amended to eliminate a reference to an executed oath or declaration.

Sections 1.31, 1.32, 1.33 and 1.36 have been amended to clarify the representation of non-inventor applicants.

Section 1.41 is proposed to be amended to clarify the applicant and relation to the inventor in light of the AIA changes and to indicate the new role of the applicant for the patent in relation to the inventor.

Sections 1.42 and 1.43 have been amended to clarify the conditions for a substitute statement under newly proposed 1.64.

Section 1.45 is proposed to be amended to clarify the conditions for naming joint inventors.

Section 1.46, which specified conditions for grant of patents under the old system, is proposed to be deleted.

Section 1.47 is proposed to be amended to specify the conditions for filing when a joint owner or inventor refuses to join the application or cannot be reached.

Section 1.48 is proposed to be amended to specify conditions under which an applicant may correct the inventorship of an application. The process is greatly simplified in a system of assignee filing.

Section 1.51 is proposed to be amended to specify that a complete application need only have a name of the inventor and the required statement under 35 USC 115 and newly proposed 37 CFR 1.63. It also is proposed to be amended to clarify the need to provide the correspondence address of the applicant.

Section 1.52(b) is proposed to be amended to delete the requirement of an oath or declaration is a part of the application, that changes after signing may require additional statements as specified in proposed amended 37 CFR 1.67 .

Section 1.53 is proposed to be amended to clarify that a Continued Prosecution application can be filed with additional and in 1.53 (f) clarifies that completion of an application filed without naming the inventors requires only identifying the inventors (not filing of a declaration or oath).

Section 1.63 is proposed to be amended to more closely match the intent of new 35 USC 115. Many of the prior requirements for oaths have been removed. Instead, the provision specifies how to identify the inventors, and sets forth the required statements, and indicates that the statements need not be repeated in a continuation or continuation in part.

Section 1.64 is proposed to be amended by setting forth the conditions under which a substitute statement can be submitted for an unavailable or unwilling inventor.

Section 1.66 is proposed to be amended to indicate the conditions under which the statements under 1.63 and 1.64 may be made under oath.

Section 1.67 is proposed to be amended to replace the concept of supplement oath or declaration with an additional statement to correct any deficiencies in the original statements under 1.63 or 1.64 with regard to any individual.

Section 1.68 is proposed to be amended to indicate the conditions under which the statements under 1.63 and 1.64 may be made via declaration under 18 USC 1001.

Section 1.76 is proposed to be amended to indicate the means of identifying the applicant, including a juristic entity (assignee) in the application data sheet as well as the inventor or joint inventor

Section 1.77 is proposed to be amended to indicate that an oath or declaration is not part of the elements of the application.

Section 1.78 is proposed to be amended to indicate that a prior filed provisional application from which priority is claimed must name at least one inventor that is named in the later filed application.

Section 1.495 and 1.497 are proposed to be amended to conform the PCT declaration requirements tot the changes in 1.63, since both sections should have the identical requirements, i.e., only the two statements required by 35 USC 115(b).

Conclusion

Lilly appreciates the PTO's efforts at implementing the AIA. These are exciting times for users of the patent system. We urge the PTO to use the rulemaking process to achieve a "win-win" result for the USPTO and assignee applicants as envisioned by the AIA. We appreciate the opportunity to comment.

Respectfully Submitted,

Lawrence T. Welch
Assistant General Patent Counsel
Eli Lilly and Company

PART 1—RULES OF PRACTICE IN PATENT CASES

Sec. 1.9 Definitions.

(a)

(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35

U.S.C. 371.(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(b) An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

(c) A published application as used in this chapter means an application for patent which has been published under 35 U.S.C. 122(b).

(d) The term “inventor” is a reference to the inventive entity, that is the individual (or, if a joint invention, the individuals collectively) who invented or discovered the subject matter of an invention. A joint inventor is any 1 of the individuals who invented or discovered the subject matter of a joint invention. See 35 U.S.C. 100(g) and 35 U.S.C. 100(h).

(e) The term ‘claimed invention’ means the subject matter defined by a claim in a patent or an application for a patent. See 35 U.S.C. 100

-(f) [Reserved]

(g) For definitions in Board of Patent Appeals and Interferences proceedings, see part 41 of this title.

(h) A *Federal holiday within the District of Columbia* as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day.

(i) National security classified as used in this chapter means specifically authorized under criteria established by an Act of Congress or Executive Order to be kept secret in the interest of national defense or foreign policy and, in fact, properly classified pursuant to such Act of Congress or Executive Order.

(j) Director as used in this chapter, except for part 10 of this section, means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

(k) Paper as used in this chapter means a document that may exist in electronic form, or in physical form, and therefore does not necessarily imply physical sheets of paper.

Comment [n1]: Since the statute now defines the terms “inventor” and “joint inventor,” it is essential that the USPTO rules conform to the same terminology. Placing the definition in the rules assists in assuring that there is no confusion as to whether the rules now incorporate the new statutory definition.

Comment [n2]: The term “claimed invention” is now statutorily defined and use of the same term in the rules will assure greater clarity and economy. Adding a definition assures there will be no confusion as to the relationship between the term used in the statute and in the rules.

Sec. 1.17 Patent application and reexamination processing fees.

(a) Extension fees pursuant to §1.136(a):

(1) For reply within first month: By a small entity (§1.27(a))—\$60.00. By other than a small entity—\$120.00.

(2) For reply within second month: By a small entity (§1.27(a)) By other than a small entity

(3) For reply within third month: By a small entity (§1.27(a)) By other than a small entity

(4) For reply within fourth month:

By a small entity (§1.27(a))

By other than a small entity

(5) For reply within fifth month: By a small entity (§1.27(a)) By other than a small entity

(b) For fees in proceedings before the Board of Patent Appeals and Interferences, see §41.20 of this title.

(c)-(d) [Reserved]

(e) To request continued examination pursuant to §1.114:

By a small entity (§1.27(a))

By other than a small entity

(f) For filing a petition under one of the following sections which refers to this paragraph: \$400.00

§1.36(a)—for revocation of a power of attorney by fewer than all of the applicants.

§1.53(e)—to accord a filing date.

§1.57(a)—to accord a filing date.

§1.78(d)(1)(vi)—for a continuing application not provided for in §§1.78(d)(1)(i) through (d)(1)(v).

§1.114(g)—for a request for continued examination not provided for in §1.114(f). §1.182—for decision on a question not specifically provided for.

§1.183—to suspend the rules.

§1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.

§1.741(b)—to accord a filing date to an application under §1.740 for extension of a patent term.

(g) For filing a petition under one of the following sections which refers to this paragraph: \$200.00.

§1.12—for access to an assignment record.

§1.14—for access to an application.

~~§1.47—for filing by other than all the inventors or a person not the inventor.~~

Comment [n3]: The new assignee filing regime renders the fee moot.

§1.59—for expungement of information.

§1.103(a)—to suspend action in an application.

§1.136(b)—for review of a request for extension of time when the provisions of §1.136(a) are not available.

§1.295—for review of refusal to publish a statutory invention registration.

§1.296—to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.

§1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.

§1.550(c)—for patent owner requests for extension of time in *ex parte* reexamination proceedings.

§1.956—for patent owner requests for extension of time in *inter partes* reexamination proceedings.

§5.12—for expedited handling of a foreign filing license.

§5.15—for changing the scope of a license. §5.25—for retroactive license.

(h) For filing a petition under one of the following sections which refers to this paragraph: \$130.00.

§1.19(g)—to request documents in a form other than that provided in this part.

§1.84—for accepting color drawings or photographs. §1.91—for entry of a model or exhibit.

§1.102(d)—to make an application special.

§1.138(c)—to expressly abandon an application to avoid publication.

§1.313—to withdraw an application from issue.

§1.314—to defer issuance of a patent.

(i) Processing fee for taking action under one of the following sections which refers to this paragraph: \$130.00.

§1.28(c)(3)—for processing a non-itemized fee deficiency based on an error in small entity status.

§1.41—for supplying or correcting the ~~name or names of the inventor or inventorship~~ after the filing date ~~without an oath or declaration as prescribed by §1.63~~, except in provisional applications.

§1.48—for correcting inventorship, except in provisional applications.

§1.52(d)—for processing a nonprovisional application filed with a specification in a language other than English.

§1.53(b)(3)—to convert a provisional application filed under §1.53(c) into a nonprovisional application under §1.53(b).

§1.55—for entry of late priority papers.

§1.71(g)(2)—for processing a belated amendment under §1.71(g).

§1.99(e)—for processing a belated submission under §1.99.

Comment [n4]: The new statute, unlike the pre-AIA law, does not require an “inventor’s oath,” to have a complete application filing. It merely requires the naming of the inventor by the applicant for patent, which in the vast majority of situations will be the assignee, not the inventor. The amendment here requires a fee for belated naming of the inventor by the applicant for patent or for any correcting of the naming of the inventor. The reference to the “oath or declaration” is no longer apt.

§1.103(b)—for requesting limited suspension of action, continued prosecution application for a design patent (§1.53(d)).

§1.103(c)—for requesting limited suspension of action, request for continued examination (§1.114). §1.103(d)—for requesting deferred examination of an application.

§1.217—for processing a redacted copy of a paper submitted in the file of an application in which a redacted copy was submitted for the patent application publication.

§1.221—for requesting voluntary publication or republication of an application. §1.291(c)(5)—for processing a second or subsequent protest by the same real party in interest.

§1.497(d)—for ~~filing an oath or declaration pursuant to 35 U.S.C. 371(c)(4)~~ naming an inventive entity different from the inventive entity set forth in the international stage.

§3.81—for a patent to issue to assignee, assignment submitted after payment of the issue fee.

(j) For filing a petition to institute a public use proceeding under §1.292—\$1,510.00.

(k) For filing a request for expedited examination under §1.155(a)—\$900.00.

(l) For filing a petition for the revival of an unavoidably abandoned application under 35 U.S.C. 111, 133, 364, or 371, for the unavoidably delayed payment of the issue fee under 35 U.S.C. 151, or for the revival of an unavoidably terminated reexamination proceeding under 35 U.S.C. 133 (§1.137(a)):

By a small entity (§1.27(a))

By other than a small entity

(m) For filing a petition for the revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§1.137(b)):

By a small entity (§1.27(a))

By other than a small entity

(n) For requesting publication of a statutory invention registration prior to the mailing of the first examiner's action pursuant to §1.104—\$920.00 reduced by the amount of the application basic filing fee paid.

(o) For requesting publication of a statutory invention registration after the mailing of the first examiner's action pursuant to §1.104—\$1,840.00 reduced by the amount of the application basic filing fee paid.

(p) For an information disclosure statement under §1.97(c) or (d) or a submission under §1.99: \$180.00.

(q) Processing fee for taking action under one of the following sections which refers to this paragraph—\$50.00.

§1.41—to supply the name or names of the inventor or a joint inventors after the filing date without a cover sheet as prescribed by §1.51(c)(1) in a provisional application.

§1.48—for supplying or ~~correcting~~ of inventorship in a provisional application.

§1.53(c)(2)—to convert a nonprovisional application filed under §1.53(b) to a provisional application under §1.53(c).

Comment [n5]: See the preceding comment. The criticality here is the applicant's naming of the inventor has changed.

Comment [n6]: This technical correction is required given the new definition for the terms "inventor" and "joint inventor."

Comment [n7]: The new text provides a closer correspondence with the corresponding provision relating to nonprovisional applications.

(r) For entry of a submission after final rejection under §1.129(a):

By a small entity (§1.27(a))

By other than a small entity

(s) For each additional invention requested to be examined under §1.129(b):

By a small entity (§1.27(a))

By other than a small entity

(t) For the acceptance of an unintentionally delayed claim for priority under 35

U.S.C. 119, 120, 121, or 365(a) or (c) (§§1.55 and 1.78) or for filing a request for the restoration of the right of priority under §1.452.....\$1,410.00.

Sec. 1.27 Definition of small entities and establishing status as a small entity to permit payment of small entity fees; when a determination of entitlement to small entity status and notification of loss of entitlement to small entity status are required; fraud on the Office.

(a) *Definition of small entities.* A small entity as used in this chapter means any party (person, small business concern, or nonprofit organization) under paragraphs (a)(1) through (a)(3) of this section.

(1) *Person.* A person, as used in paragraph (c) of this section, means any inventor or other individual (*e.g.*, an individual to whom an inventor has transferred some rights in the invention) who has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention. An inventor or other individual who has transferred some rights in the invention to one or more parties, or is under an obligation to transfer some rights in the invention to one or more parties, can also qualify for small entity status if all the parties who have had rights in the invention transferred to them also qualify for small entity status either as a person, small business concern, or nonprofit organization under this section.

(2) *Small business concern.* A small business concern, as used in paragraph

(c) of this section, means any business concern that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify for small entity status as a person, small business concern, or nonprofit organization; and

(ii) Meets the size standards set forth in [13 CFR 121.801] 13 CFR

121.801 through 121.805 to be eligible for reduced patent fees. Questions related to standards for a small business concern may be directed to: Small Business Administration, Size Standards Staff, 409 Third Street, SW., Washington, DC 20416.

(3) *Nonprofit Organization.* A nonprofit organization, as used in paragraph (c) of this section, means any nonprofit organization that:

(i) Has not assigned, granted, conveyed, or licensed, and is under no obligation under contract or law to assign, grant, convey, or license, any rights in the invention to any person, concern, or organization which would not qualify as a person, small business concern, or a nonprofit organization; and

(ii) Is either:

(A) A university or other institution of higher education located in any country;

(B) An organization of the type described in section 501(c)(3) of the Internal Revenue Code of 1986 (26 U.S.C. 501(c)(3)) and exempt from taxation under section 501(a) of the Internal Revenue Code (26 U.S.C. 501(a));

(C) Any nonprofit scientific or educational organization qualified under a nonprofit organization statute of a state of this country (35 U.S.C. 201(i)); or

(D) Any nonprofit organization located in a foreign country which would qualify as a nonprofit organization under paragraphs (a)(3)(ii)(B) of this section or (a)(3)(ii)(C) of this section if it were located in this country.

(4) *License to a Federal agency.*

(i) For persons under paragraph (a)(1) of this section, a license to the Government resulting from a rights determination under Executive Order 10096 does not constitute a license so as to prohibit claiming small entity status.

(ii) For small business concerns and nonprofit organizations under paragraphs (a)(2) and (a)(3) of this section, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license for the purposes of paragraphs (a)(2)(i) and (a)(3)(i) of this section.

(5) *Security Interest.* A security interest does not involve an obligation to transfer rights in the invention for the purposes of paragraphs (a)(1) through (a)(3) of this section unless the security interest is defaulted upon.

(b) *Establishment of small entity status permits payment of reduced fees.*

(1) A small entity, as defined in paragraph (a) of this section, who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section will be accorded small entity status by the Office in the particular application or patent in which entitlement to small entity status was asserted. Establishment of small entity status allows the payment of certain reduced patent fees pursuant to 35 U.S.C. 41(h)(1).

(2) Submission of an original utility application in compliance with the Office electronic filing system by an applicant who has properly asserted entitlement to small entity status pursuant to paragraph (c) of this section in that application allows the payment of a reduced filing fee pursuant to 35 U.S.C. 41(h)(3).

(c) *Assertion of small entity status.* Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) *Assertion by writing.* Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are

required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) *Parties who can sign and file the written assertion.* The written assertion can be signed by:

(i) One of the parties identified in §1.33(b) (e.g., an attorney or agent registered with the Office), §3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as ~~the~~ inventor (even though a ~~statement under §1.63(b) executed oath or declaration~~ has not been submitted), notwithstanding §1.33(b)(~~3~~4), who can also file the written assertion pursuant to the exception under §1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under §1.33(b) of this part.

(3) *Assertion by payment of the small entity basic filing or basic national fee.* The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§1.16(a), 1.16(b), 1.16(c), 1.16(d), 1.16(e), or the small entity basic national fee set forth in §1.492(a), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in §1.16(f), or §1.16(g).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent.

(4) *Assertion required in related, continuing, and reissue applications.* Status as a small entity must be specifically established by an assertion in each related, continuing and reissue application in which status is appropriate and desired. Status as a small entity in one application or patent does not affect the status of any other application or patent, regardless of the relationship of the applications or patents. The refiling of an application under §1.53 as a continuation, divisional, or continuation-in-part application (including a continued prosecution application under §1.53(d)), or the filing of a reissue application, requires a new assertion as to continued entitlement to small entity status for the continuing or reissue application.

(d) *When small entity fees can be paid.* Any fee, other than the small entity basic filing fees and the small entity national fees of paragraph (c)(3) of this section, can be paid in the small entity amount only if it is submitted with, or subsequent to, the submission of a written assertion of entitlement to small entity status, except when refunds are permitted by §1.28(a).

(e) *Only one assertion required.*

(1) An assertion of small entity status need only be filed once in an application or patent. Small entity status, once established, remains in effect until changed pursuant to paragraph (g)(1) of this section. Where an assignment of rights or an obligation to assign rights to other parties who are small entities occurs subsequent to an assertion of small entity status, a second assertion is not required.

(2) Once small entity status is withdrawn pursuant to paragraph (g)(2) of this section, a new written assertion is required to again obtain small entity status.

Comment [n8]: The amendment producers conformance with the referenced sections. In brief, the term "oath or declaration" is removed in favor of the use of the term "statement."

(f) *Assertion requires a determination of entitlement to pay small entity fees.* Prior to submitting an assertion of entitlement to small entity status in an application, including a related, continuing, or reissue application, a determination of such entitlement should be made pursuant to the requirements of paragraph (a) of this section. It should be determined that all parties holding rights in the invention qualify for small entity status. The Office will generally not question any assertion of small entity status that is made in accordance with the requirements of this section, but note paragraph (h) of this section.

(g)

(1) *New determination of entitlement to small entity status is needed when issue and maintenance fees are due.* Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. (2) *Notification of loss of entitlement to small entity status is required when issue and maintenance fees are due.* Notification of a loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity as defined in paragraph (a) of this section is no longer appropriate. The notification that small entity status is no longer appropriate must be signed by a party identified in §1.33(b). Payment of a fee in other than the small entity amount is not sufficient notification that small entity status is no longer appropriate.

(h) *Fraud attempted or practiced on the Office.*

(1) Any attempt to fraudulently establish status as a small entity, or pay fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

(2) Improperly, and with intent to deceive, establishing status as a small entity, or paying fees as a small entity, shall be considered as a fraud practiced or attempted on the Office.

Subpart B—National Processing Provisions

Prosecution of Application and Appointment of Attorney or Agent

Sec. 1.31 Applicant ~~may be represented~~ **by one or more patent practitioners.**

If the applicant for patent includes a person that is not the inventor, such person must give a power of attorney so as to be represented by one or more patent practitioners. If the applicant for patent includes one or more joint inventors, any one joint inventor may be represented by any one or more of the other joint inventors who applied for the patent. If the applicant for patent includes the inventor or a joint inventor, such individual may file and prosecute his or her own case, or he or she may give a power of attorney so as to be represented by one or more patent practitioners or, for a joint invention, can be represented by one or more other joint inventors. The United States Patent and Trademark Office cannot aid in the selection of a patent practitioner.

Comment [n9]: The term “applicant” no longer references the inventor, but typically the assignee, thus necessitating the change in title.

Sec. 1.32 Power of attorney.

(a) Definitions.

(1) *Patent practitioner* means a registered patent attorney or registered patent agent under §11.6.

(2) *Power of attorney* means a written document by which a principal authorizes one or more patent practitioners or, if a joint inventor is an applicant for patent, one or more other joint inventors who applied for the patent to act ~~its or~~ his or her behalf.

Comment [n10]: The new provision requires all assignee-applicants to be represented by a patent practitioner, but makes no change in the situation that applies to the inventor or a joint inventor.

Comment [n11]: A conforming amendment. The amended rules need to account for the situation where the applicant for patent is the assignee of one of several joint inventors, a second joint inventor appearing pro se, and a third joint inventor giving power of attorney to the second joint inventor.

(3) *Principal* means ~~the either an~~ applicant for patent (§1.41(b)) ~~or an assignee of entire interest of the applicant for patent or~~ in a reexamination proceeding, the ~~assignee of the entirety of ownership of a patent~~patentee. The principal executes a power of attorney designating one or more patent practitioners (or joint inventors, as the case may be) to act on ~~his or her~~its behalf.

Comment [n12]: The new rules on assignee filing make it desirable to identify the applicant for patent as the principle. Because the applicant will typically be a juristic entity, references to the applicant should not reference gender.

(4) *Revocation* means the cancellation by the principal of the authority previously given to a patent practitioner or joint inventor to act on his or her behalf.

(5) *Customer Number* means a number that may be used to:

(i) Designate the correspondence address of a patent application or patent such that the correspondence address for the patent application, patent or other patent proceeding would be the address associated with the Customer Number;

(ii) Designate the fee address (§1.363) of a patent such that the fee address for the patent would be the address associated with the Customer Number; and

(iii) Submit a list of patent practitioners such that those patent practitioners associated with the Customer Number would have power of attorney.

(b) A power of attorney must:

(1) Be in writing;

(2) Name one or more representatives in compliance with (c) of this section;

(3) Give the representative power to act on behalf of the principal; and

(4) Be signed by the applicant for patent (~~§1.41(b)) or the assignee of the entire interest of the applicant.~~

Comment [n13]: A conforming amendment based on the preceding comment.

(c) A power of attorney may only name as representative:

(1) One or more other joint inventors if the power is given by a joint inventor who is an applicant for patent (§1.45);

Comment [n14]: This provision must be limited to joint inventors who are applicants for patent and does not apply if the applicant includes the joint inventor's assignee.

(2) Those registered patent practitioners associated with a Customer Number;

(3) Ten or fewer patent practitioners, stating the name and registration number of each patent practitioner. Except as provided in paragraph (c)(1) or (c)(2) of this section, the Office will not recognize more than ten patent practitioners as being of record in an application or patent. If a power of attorney names more than ten patent practitioners, such power of attorney must be accompanied by a separate paper indicating which ten patent practitioners named in the power of attorney are to be recognized by the Office as being of record in the application or patent to which the power of attorney is directed.

Sec. 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) *Correspondence address and daytime telephone number.* When filing an application, the identity of the person or persons that comprise that applicant for patent and each such person's mailing address, as well as one such person's mailing address being designated as the correspondence address, must be set forth in either an application data sheet (§1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named ~~inventor~~applicant (~~if provided, see §§1.76(b)(1) and 1.63(c)(2)~~) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address. For correspondence submitted via the Office's electronic filing system, however, an electronic acknowledgment receipt will be sent to the submitter. The Office will generally not engage in double

correspondence with an applicant and a patent practitioner, or with more than one patent practitioner except as deemed necessary by the Director. If more than one correspondence address is specified in a single document, the Office will select one of the specified addresses for use as the correspondence address and, if given, will select the address associated with a Customer Number over a typed correspondence address. For the party to whom correspondence is to be addressed, a daytime telephone number should be supplied in a clearly identifiable manner and may be changed by any party who may change the correspondence address. The correspondence address may be changed as follows:

~~(1) Prior to filing of §1.63 oath or declaration by any of the inventors. If a §1.63 oath or declaration has not been filed by any of the inventors, the correspondence address may be changed by the party who filed the application applicant for patent or by. If the application was filed by a patent practitioner, any other patent practitioner named in the transmittal papers may also change the correspondence address. Thus, the inventor(s), any patent practitioner named in the transmittal papers accompanying the original application, or a party that will be the assignee who filed the application, may change the correspondence address in that application under this paragraph.~~

~~(2) Where a §1.63 oath or declaration has been filed by any of the inventors. If a §1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).~~

(b) *Amendments and other papers.* Amendments and other papers, except for written assertions pursuant to §1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A patent practitioner of record appointed in compliance with §1.32(b);

(2) A patent practitioner not of record who acts in a representative capacity under the provisions of §1.34; or

(3) ~~An assignee as provided for under §3.71(b) of this chapter; or~~

~~(4) All of the applicants (§1.41(b)) for patent, unless there is a patent practitioner who has the power to sign the paper an assignee of the entire interest and such assignee has taken action in the application in accordance with §3.71 of this chapter.~~

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the correspondence address. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of §1.34. Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See §1.363 for "fee address" used solely for maintenance fee purposes.

(e) A change of address filed in a patent application or patent does not change the address for a patent practitioner in the roster of patent attorneys and agents. See §11.11 of this title.

Sec. 1.36 Revocation of power of attorney; withdrawal of patent attorney or agent.

(a) A power of attorney, pursuant to §1.32(b), may be revoked at any stage in the proceedings of a case by ~~an~~the applicant for patent (~~§1.41(b)) or an assignee of the entire interest of the applicant, or the owner of the entire interest~~

Comment [n15]: This rule must be conformed to assignee-applicant filing. Thus, the USPTO needs a specific rule requiring that the patent applicant identify itself and provide its correspondence address.

Comment [n16]: This rule can be simplified by simply limiting changes to the correspondence address to the applicant for patent (typically, the assignee) or the practitioner identified.

Comment [n17]: Mooted by the ability of assignees to be applicants.

Comment [n18]: This requires practitioners to sign, unless there is none.

~~of a patent.~~ A power of attorney to the patent practitioners associated with a Customer Number will be treated as a request to revoke any powers of attorney previously given. Fewer than all of the persons who constitute the applicants for patent~~(or fewer than all of the assignees of the entire interest of the applicant or, in a reexamination proceeding, fewer than all the owners of the entire interest of a patent)~~ may revoke the power of attorney only upon a showing of sufficient cause, and payment of the petition fee set forth in § 1.17(f). A patent practitioner will be notified of the revocation of the power of attorney. Where power of attorney is given to the patent practitioners associated with a Customer Number (§ 1.32(c)(2)), the practitioners so appointed will also be notified of the revocation of the power of attorney when the power of attorney to all of the practitioners associated with the Customer Number is revoked. The notice of revocation will be mailed to the correspondence address for the application (§ 1.33) in effect before the revocation. An assignment will not of itself operate as a revocation of a power previously given, but the assignee of the entire interest of the applicant may revoke previous powers of attorney and give another power of attorney of the assignee's own selection as provided in § 1.32(b).

Comment [n19]: Assignee filing permits the simplification of this rule.

(b) A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant for patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant for patent has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Board of Patent Appeals and Interferences.

Comment [n20]: This continues the consistent treatment of the patent applicant as the patent owner. Thus, it encourages assignee filing in preference to the assignee permitting the inventor to make the application for patent for the assigned invention.

Who May Apply for a Patent

Sec. 1.41 Applicant for patent and relation to the inventor.

Comment [n21]: Assignee filing makes it critical to deal with the relationship between the applicant and the inventor.

(a) The applicant for patent is the person, or the persons collectively, who identify themselves in the application as having filed the application for patent. The inventor must apply for a patent, as the applicant for patent, unless the inventor is dead (§ 1.42) or one or more other persons have a proprietary interest sufficient to apply for the patent in lieu of, or in addition to, the inventor or one or more joint inventors. A patent is applied for in the name or names of the actual inventor or inventors. A person authorized under § 1.42 to make a substitute statement on behalf a deceased individual may additionally file the application for patent on such individual's behalf. An assignee, or a person who has a sufficient proprietary interest otherwise, may file the application for patent on its own behalf and identify itself, with or without others as the case may be, as the applicant for patent.

Comment [n22]: This sentence requires applicant self-identification.

Comment [n23]: This sentence requires inventor filing as the applicant unless non-inventor filing is appropriate (including assignee filing, as assignees always have sufficient proprietary interest to seek the patent).

Comment [n24]: This sentence covers filing in the case of a deceased inventor.

(1) The applicant for patent must identify the inventor, including each joint inventor in the case of a joint invention, in the application for patent. The identification of the inventor or the joint inventors should be made in the application as filed. For each individual named as the inventor or a joint inventor, a statement from such individual inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by under § 1.63(b), or a substitute statement under § 1.64 on behalf of such individual, must be provided in connection with the application, except as provided otherwise in this subpart, and should be provided in the application as filed, but in any event must be provided prior to the mailing of a notice of allowance (§ 1.311) for in §§ 1.53(d)(4) and 1.63(d). The applicant for patent may make the original identification of the inventor by amendment to its application for patent or may file an amendment to the application to correct the inventorship previously identified. No such amendment may be filed unless a statement under § 1.63(b) or § 1.64 is provided to the Office, at the time such amendment is made, by or on behalf of any individual named as the inventor or a joint inventor for which no such statement has theretofore been provided to the Office. If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless applicant files a paper, including, An amendment under this paragraph shall be accompanied by the processing fee set forth in § 1.17(i), supplying or

Comment [n25]: This sentence specifically authorizes assignee filing and filing by others with sufficient proprietary interest to do so.

Comment [n26]: This sentence (and the next) places a categorical obligation on the patent applicant to identify the inventor in the application as filed.

Comment [n27]: This sentence clarifies the relationship between naming (or identifying) the inventor in the application as filed and providing the required statement from the inventor or each joint inventor. The latter, although filing with the application is encouraged, need only be supplied before allowance.

Comment [n28]: This sentence implements the statutory provision that permits naming or correction of the inventor after filing (35 U.S.C. § 115).

~~changing the name or names of the inventor or inventors.~~ No statement under §1.63(b) or substitute statement under §1.64 shall be required by or on behalf of any individual once the individual is no longer identified as the inventor or a joint inventor on account of a correction of inventorship made under this paragraph. An amendment correcting inventorship must additionally provide a correction to the identification of the applicant for patent, if the change in the inventorship of the application requires such a change in the ownership of the application. An amendment correcting inventorship of an application may be filed at any time during the pendency of the application. An amendment providing the original identification of the inventorship of an application for patent must be filed within the period of time prescribed under §1.53(f).

(2) The inventorship of a provisional application is ~~the individual, or in the case of a joint invention the individuals, at inventorship~~ set forth in the cover sheet as prescribed by §1.51(c)(1). If a cover sheet as prescribed by §1.51(c)(1) is not filed during the pendency of a provisional application, the inventorship is ~~the~~ at individual inventorship or individuals collectively set forth in the application papers filed pursuant to §1.53(c), unless applicant files a paper including the processing fee set forth in §1.17(q), supplying or changing the name ~~or names~~ of the inventor ~~or inventors~~.

(3) In a nonprovisional application filed ~~without an oath or declaration as prescribed by §1.63~~ or a provisional application filed without a cover sheet as prescribed by §1.51(c)(1), the identification of the inventor, including each joint inventor, i.e., the name, residence, and citizenship of each person believed to be an actual inventor such individual, should be provided when the application papers pursuant to §1.53(b) or §1.53(c) are filed.

(4) The inventorship of an international application entering the national stage under 35 U.S.C. 371 is ~~the~~ at individual inventorship (or, in the case of a joint invention, the individuals) so named set forth in the international application, which includes any change effected under PCT Rule 92bis. See §1.497(d) and (f) for ~~filing an oath or declaration~~ naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§1.48(f)(1)) does not apply to an international application entering the national stage under 35 U.S.C. 371).

(b) ~~Unless the contrary is indicated,~~ The word “applicant” when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§1.42, 1.43, or 1.47 who is applying for a patent in place of the inventor only if the inventor himself or herself is the person making the application for patent.

(c) Any person authorized by the applicant may physically or electronically deliver an application for patent to the Office ~~on behalf of the inventor or inventors, but an oath or declaration for the application (§1.63) can only be made in accordance with §1.64.~~

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

Sec. 1.42 When the inventor is dead.

In case of the death of the inventor or a joint inventor, the legal representative (executor, administrator, etc.) of the deceased ~~inventor individual~~ may make ~~the necessary oath or declaration~~ the substitute statement required under §1.64, and may apply for and obtain the patent. ~~Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.~~

Sec. 1.43 When the inventor is insane or legally incapacitated.

Comment [n29]: This sentence imposes a set of specific obligations on applicants who fail to identify the inventorship or correct the inventorship after filing, including the requirement for a fee and the immediate filing of the required statements of the inventor.

Comment [n30]: This sentence clarifies that no statement is required once an individual is no longer being named as an inventor.

Comment [n31]: This sentence provides the USPTO authority to require the original identification of the inventorship within the same specified time period that formerly applied to the late submission of the oath or declaration.

Comment [n32]: This provision is conformed to the new statutory nomenclature.

Comment [n33]: Same as above.

Comment [n34]: Same as above.

Comment [n35]: This provision clarifies that inventors normally will not be applicants.

Comment [n36]: This provision is amended to conform to assignee filing and the removal of the requirement for the “oath or declaration” to be filed with the application for patent.

Comment [n37]: This provision is conformed to new terminology. It also specifically authorizes a legal representative to be the applicant for patent.

In case ~~the inventor or a joint~~ inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make ~~the necessary oath or declaration, and apply for and obtain the patent~~ the substitute statement required under §1.64.

Sec. 1.44 [Reserved]

Sec. 1.45 Joint inventors.

(a) Joint inventors must ~~each be named in the application for patent, in the case of a joint invention, and each such individual apply for a patent jointly and each~~ must make ~~the statement~~ the required ~~under oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in §1.63(b), or a statement on such individual's behalf must be made under §1.64, except as otherwise provided under this subpart~~ 47.

(b) ~~Individuals may be named as joint~~ inventors ~~may apply for a patent jointly~~ even though

(1) They did not physically work together or at the same time,

(2) Each ~~joint~~ inventor did not make the same type or amount of contribution, or

(3) Each ~~joint~~ inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple ~~individual~~ inventors are named ~~as the inventor~~ in a nonprovisional application, each named ~~individual~~ inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple ~~individual~~ inventors are named in a provisional application, each named ~~individual~~ inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

Sec. 1.46 Assigned inventions and patents.

~~In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in §3.81.~~ [Reserved.]

Sec. 1.47 Filing when ~~the inventor, a joint inventor or a joint inventor~~ owner refuses to ~~join~~ sign or cannot be reached.

(a) If a joint ~~inventor~~ owner of an application for patent refuses to join in ~~making such an~~ application ~~for patent~~ or cannot be found or reached after diligent effort, the application may be made by the other ~~joint owner or owners~~ inventor on behalf of ~~themselves~~ or herself and the ~~non-joining nonsigning inventor~~ owner. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(g), and the last known address of the nonsigning inventor. The ~~non-joining nonsigning joint inventor~~ owner retains the right to ~~may~~ subsequently join in the application ~~by filing an oath or declaration complying with §1.63.~~

(b) Whenever ~~the inventor or fewer than~~ all of the ~~joint~~ inventors refuse to ~~make~~ execute an application for patent ~~the statement otherwise required under §1.63,~~ or cannot be found or reached after diligent effort, a person to whom ~~the~~ inventor or such joint inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent ~~and may~~ file a substitute statement under §1.64 in lieu of the statement otherwise required under §1.63(b) by the individual

Comment [n38]: This section is fully conformed to the new terminology.

Comment [n39]: This section is repealed and reserved because assignee filing is expressly authorized elsewhere.

Comment [n40]: This provision is transformed from a joint inventor to a joint owner provision to conform to the option for owners to file in lieu of inventors.

who refuses to make such statement or who cannot be found or reached. The Office may require that the applicant for patent provide on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts as they relate to the applicant's authority to file for the patent, including that a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. For any individual for which a statement under §1.63(b) cannot be filed because the individual refuses to make such statement or cannot be found or reached, the applicant for patent must provide the fee set forth in §1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

Comment [n41]: This provision deals with the filing of a substitute statement where the inventor or a joint inventor refuses to file the inventor's statement.

Comment [n42]: This provision gives the USPTO the option – but no longer would require – proof of facts on authority to file.

Comment [n43]: The "last known address" requirement is continued for the inventor or joint inventor who refuses to file or cannot be found.

(c) For an application for patent for which subsection (b) applies, the Office will send notice of the filing of the application to each individual all inventors who have not made the statement required under §1.63(b) joined in the application at the address or addresses for such individual(es) provided by the applicant for patent in the petition under this section, and shall publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in any continuing or divisional application, if notice regarding the filing of the prior application was given to such individual the nonsigning inventor(s).

Comment [n44]: The USPTO will continue to provide notices at the last known address provided.

Sec. 1.48 **Supplying or correcting** of inventorship in a patent application, other than a reissue application, pursuant to 35 U.S.C. 116.

Comment [n45]: The term "supplying" is included because an applicant for patent may fail to name the inventorship in the application as filed and, thus, must file an amendment to the application to do so.

(a) *Nonprovisional application after oath/declaration filed.* If the inventive entity is set forth in error in an executed §1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the applicant for patent has the responsibility for correctly identifying the inventor of its application for patent and for correcting by amendment any error in the identification of the inventor. Inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. An amendment to an application of the supplying or correcting inventorship requires:

Comment [n46]: This sentence places a categorical requirement on the applicant for patent to supply and to correct inventorship of the application.

(1) An identification of the inventorship of the application, if not previously identified in the application, or a request to correct the prior identification of the inventorship that sets forth the desired inventorship change;

(2) A statement under §1.63(b) or §1.64 from each person individual being named as the inventor or a joint inventor who has not theretofore made such a statement in connection with the application for patent being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §§1.42, 1.43 or §1.47. Any correction in the identification of the applicant for patent that might be required on account of the correction being made to the inventorship; and

(4) The processing fee set forth in §1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see §3.73(b) of this chapter).

Comment [n47]: Where the inventorship is not originally supplied or requires correction, then the amendment required to do so will require a fee and the required statements from the inventor (or a substitute statement).

(b) *Nonprovisional application—fewer inventors due to amendment or cancellation of claims.* If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

(1) A request, signed by a party set forth in §1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and

(2) The processing fee set forth in §1.17(i).

~~(e) Nonprovisional application— inventors added for claims to previously unclaimed subject matter. If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. Amendment of the inventorship requires:~~

~~(1) A request to correct the inventorship that sets forth the desired inventorship change;~~

~~(2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;~~

~~(3) An oath or declaration by the actual inventors as required by §1.63 or as permitted by §§1.42, 1.43, or §1.47;~~

~~(4) The processing fee set forth in §1.17(i); and~~

~~(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see §3.73(b) of this chapter);~~

~~(d) Provisional application— adding omitted inventors. If the name or names of thean inventor or inventors were omitted or incorrect in a provisional application through error without any deceptive intention on the part of the omitted inventor or inventors, the provisional application may be amended by the applicant for patent to add or correct the name or names of the identification of the omitted inventor or inventors. Amendment of the inventorship under this subsection requires:~~

~~(1) A request, signed by a party set forth in §1.33(b), to supply or correct the inventorship that identifies the inventor or inventors being added and states that the inventorship error occurred without deceptive intention on the part of the omittedcorrect inventorship or inventors; and~~

~~(2) The processing fee set forth in §1.17(q).~~

~~(e) Provisional application— deleting the name or names of the inventor or inventors. If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention on the part of such person or persons, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Amendment of the inventorship requires:~~

~~(1) A request to correct the inventorship that sets forth the desired inventorship change;~~

~~(2) A statement by the person or persons whose name or names are being deleted that the inventorship error occurred without deceptive intention on the part of such person or persons;~~

~~(3) The processing fee set forth in §1.17(q); and~~

~~(4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see §3.73(b) of this chapter);~~

~~(f)~~

~~(1) Nonprovisional application— filing executed oath/declaration corrects~~

Comment [n48]: Correcting inventorship, when required of the applicant, should be handled by the preceding paragraph. This should be solely a technicality.

Comment [n49]: The supplying or correcting of inventorship of a provisional application should simply require that patent applicant to make the request and pay the fee.

Comment [n50]: There is no need for the deleted provision; all corrections of inventorship should be done under the preceding paragraph.

~~inventorship. If the correct inventor or inventors are not named on filing a nonprovisional application under §1.53(b) without an executed oath or declaration under §1.63 by any of the inventors, the first submission of an executed oath or declaration under §1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.(2) Provisional application—filing cover sheet corrects inventorship. If the correct inventor or inventors are not named on filing a provisional application without a cover sheet under §1.51(c)(1), the later submission of a cover sheet under §1.51(c)(1) during the pendency of the application will act to correct the earlier identification of inventorship. (g)~~

~~(c) Additional information may be required.~~ The Office may require such other information as may be deemed appropriate under the particular circumstances surrounding the identification or correction of inventorship.

Comment [n51]: Conforming amendment.

~~(d)~~ Reissue applications not covered. The provisions of this section do not apply to reissue applications. See §§1.171 and 1.175 for correction of inventorship in a patent via a reissue application.

~~(e)~~ Correction of inventorship in patent. See §1.324 for correction of inventorship in a patent.

~~(f)~~ Correction of inventorship in a contested case ~~before the Board of Patent Appeals and Interferences.~~ In a contested case under part 41, subpart D, of this title, a request for correction of an application must be in the form of a motion under §41.121(a)(2) of this title and must comply with the requirements of this section.

The Application

Sec. 1.51 General requisites of an application.

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office.

(b) A complete application filed under §1.53(b) or §1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§1.71 to 1.77;

(2) The name of the inventor, including any required statement of the inventor under An oath or declaration, see §§1.63 or substitute statement under §1.64 and 1.68;

Comment [n52]: §115 of title 35 requires specifically that the inventor be named and then makes a second requirement that the inventor's statement be filed.

(3) Drawings, when necessary, see §§1.81 to 1.85; and

(4) The prescribed filing fee, search fee, examination fee, and application size fee, see §1.16.

(c) A complete provisional application filed under §1.53(c) comprises:

(1) A cover sheet identifying:

(i) The application as a provisional application,

(ii) The name ~~or names~~ of the inventor ~~or inventors~~, (see §1.41(a)(2)),

Comment [n53]: Under the new definition the inventor is the inventive entity.

(iii) The residence of each named ~~inventor~~ individual inventor under item (ii),

(iv) The title of the invention,

(v) The name and registration number of the attorney or agent (if applicable),

(vi) The docket number used by the person filing the application to identify the application (if applicable),

(vii) The name and the correspondence address of the applicant for patent, and _____

(viii) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(2) A specification as prescribed by the first paragraph of 35 U.S.C. 112, see §1.71;

(3) Drawings, when necessary, see §§1.81 to 1.85; and

(4) The prescribed filing fee and application size fee, see §1.16.

~~(d) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §1.97 and §1.98. No information disclosure statement may be filed in a provisional application.~~

Sec. 1.52 Language, paper, writing, margins, compact disc specifications.

(a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

(i) Flexible, strong, smooth, non-shiny, durable, and white;

(ii) Either 21.0 cm by 29.7 cm (DIN size A4) or 21.6 cm by 27.9 cm (8 1/2 by 11 inches), with each sheet including a top margin of at least 2.0 cm (3/4 inch), a left side margin of at least 2.5 cm (1 inch), a right side margin of at least 2.0 cm (3/4 inch), and a bottom margin of at least 2.0 cm (3/4 inch);

(iii) Written on only one side in portrait orientation;

(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent; and

(v) Presented in a form having sufficient clarity and contrast between the paper and the writing thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by use of digital imaging and optical character recognition.

(2) All papers that are submitted on paper or by facsimile transmission and are to become a part of the permanent records of the United States Patent and Trademark Office should have no holes in the sheets as submitted.

(3) The provisions of this paragraph and paragraph (b) of this section do not apply to the pre-printed information on paper forms provided by the Office, or to the copy of the patent submitted on paper in double column format as the specification in a reissue application or request for reexamination.

(4) See §1.58 for chemical and mathematical formulae and tables, and §1.84 for drawings.

(5) Papers that are submitted electronically to the Office must be formatted and transmitted in compliance with the Office's electronic filing system requirements.

~~(b) The application (specification, including the claims, and drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding.~~ _____

Comment [n54]: The USPTO needs to separately require the identification of the applicant for patent and the correspondence address of the applicant.

Comment [n55]: Conforming amendment. The superseding requirement is to identify the inventor.

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

(ii) Text written in a nonscript type font (*e.g.*, Arial, Times Roman, or Courier) lettering style having capital letters which are at least 0.21 cm (0.08 inch) high; and

(iii) Only a single column of text.

(3) The claim or claims must commence on a separate physical sheet or electronic page (§ 1.75(h)).

(4) The abstract must commence on a separate physical sheet or electronic page or be submitted as the first page of the patent in a reissue application or reexamination proceeding (§ 1.72(b)).

(5) Other than in a reissue application or reexamination proceeding, the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(6) Other than in a reissue application or reexamination proceeding, the paragraphs of the specification, other than in the claims or abstract, may be numbered at the time the application is filed, and should be individually and consecutively numbered using Arabic numerals, so as to unambiguously identify each paragraph. The number should consist of at least four numerals enclosed in square brackets, including leading zeros (*e.g.*, [0001]). The numbers and enclosing brackets should appear to the right of the left margin as the first item in each paragraph, before the first word of the paragraph, and should be highlighted in bold. A gap, equivalent to approximately four spaces, should follow the number. Nontext elements (*e.g.*, tables, mathematical or chemical formulae, chemical structures, and sequence data) are considered part of the numbered paragraph around or above the elements, and should not be independently numbered. If a nontext element extends to the left margin, it should not be numbered as a separate and independent paragraph. A list is also treated as part of the paragraph around or above the list, and should not be independently numbered. Paragraph or section headers (titles), whether abutting the left margin or centered on the page, are not considered paragraphs and should not be numbered.

(c)

(1) Any interlineation, erasure, cancellation or other alteration of the application papers filed ~~should~~**must** be made before the signing of any ~~accompanying oath or declaration pursuant to statement under § 1.63(b)~~ referring to ~~these~~ application papers and ~~should be dated and initialed or signed by the applicant on the same sheet of paper.~~

Application papers containing alterations made after the signing of ~~an oath or declaration~~ **statement under § 1.63(b)** referring to ~~an those~~ application papers ~~may~~**must be supported by** ~~may require~~ **a supplemental oath or declaration** ~~substitute statement~~ under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

Comment [n56]: These provisions simplify the requirements on the applicant for patent. They encourage, but do not mandate, that no changes to the application can be made after the inventor has executed a required statement. It does recognize that an applicant for patent may require a substitute statement from the inventor be filed.

(2) After the ~~signing of the oath or declaration referring to~~ filing of the application papers ~~with the Office~~, amendments may only be made in the manner provided by §1.121.

~~(3) Notwithstanding the provisions of this paragraph, if an oath or declaration is a copy of the oath or declaration from a prior application, the application for which such copy is submitted may contain alterations that do not introduce matter that would have been new matter in the prior application.~~

(d) A nonprovisional or provisional application may be filed in a language other than English.

(1) *Nonprovisional application.* If a nonprovisional application is filed in a language other than English, an English language translation of the non-English language application, a statement that the translation is accurate, and the processing fee set forth in §1.17(i) are required. If these items are not filed with the application, applicant will be notified and given a period of time within which they must be filed in order to avoid abandonment.

(2) *Provisional application.* If a provisional application is filed in a language other than English and the benefit of such provisional application is claimed in a nonprovisional application, an English language translation of the non-English language provisional application will be required in the provisional application. See §1.78(b).

(e) *Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.*

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

(i) A computer program listing (see §1.96);

(ii) A “Sequence Listing” (submitted under §1.821(c)); or

(iii) A table (see §1.58) that has more than 50 pages of text.

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a “read-only” medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a “write once” medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)

(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). (ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (*e.g.*, IBM-PC, Macintosh), the operating system compatibility (*e.g.*, MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc. Compact discs submitted to the Office will not be returned to the applicant.

(4) Any compact disc must be submitted in duplicate unless it contains only the “Sequence Listing” in computer readable form required by §1.821(e). The compact disc and duplicate copy must be labeled “Copy 1” and “Copy 2,” respectively. The transmittal letter which accompanies the compact disc must include a statement that the two compact discs are identical. In the event that the two compact discs are not identical, the Office will use the compact disc labeled “Copy 1” for further processing. Any amendment to the information on a compact disc must be by way of a replacement compact disc in compliance with this paragraph containing the substitute information, and must be

Comment [n57]: This deletion provides a further simplification for applicants' no inventor statements are required in any form of continuing application.

accompanied by a statement that the replacement compact disc contains no new matter. The compact disc and copy must be labeled "COPY 1 REPLACEMENT MM/DD/YYYY" (with the month, day and year of creation indicated), and "COPY 2 REPLACEMENT MM/DD/YYYY," respectively.

(5) The specification must contain an incorporation-by-reference of the material on the compact disc in a separate paragraph (§1.77(b)(5)), identifying each compact disc by the names of the files contained on each of the compact discs, their date of creation and their sizes in bytes. The Office may require applicant to amend the specification to include in the paper portion any part of the specification previously submitted on compact disc.

(6) A compact disc must also be labeled with the following information:

(i) The name of ~~the~~ inventor (if known);

(ii) Title of the invention;

(iii) The docket number, or application number if known, used by the person filing the application to identify the application; and

(iv) A creation date of the compact disc.

(v) If multiple compact discs are submitted, the label shall indicate their order (*e.g.* "1 of X").

(vi) An indication that the disk is "Copy 1" or "Copy 2" of the submission. See paragraph (b)(4) of this section.

(7) If a file is unreadable on both copies of the disc, the unreadable file will be treated as not having been submitted. A file is unreadable if, for example, it is of a format that does not comply with the requirements of paragraph (e)(3) of this section, it is corrupted by a computer virus, or it is written onto a defective compact disc.

(f)

(1) Any sequence listing in an electronic medium in compliance with §§1.52(e) and 1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§1.52(e) and 1.96, will be excluded when determining the application size fee required by §1.16(s) or §1.492(j). For purposes of determining the application size fee required by §1.16(s) or §1.492(j), for an application the specification and drawings of which, excluding any sequence listing in compliance with §1.821(c) or (e), and any computer program listing filed in an electronic medium in compliance with §§1.52(e) and 1.96, are submitted in whole or in part on an electronic medium other than the Office electronic filing system, each three kilobytes of content submitted on an electronic medium shall be counted as a sheet of paper. (2) Except as otherwise provided in this paragraph, the paper size equivalent of the specification and drawings of an application submitted via the Office electronic filing system will be considered to be seventy-five percent of the number of sheets of paper present in the specification and drawings of the application when entered into the Office file wrapper after being rendered by the Office electronic filing system for purposes of determining the application size fee required by §1.16(s). Any sequence listing in compliance with §1.821(c) or (e), and any computer program listing in compliance with §1.96, submitted via the Office electronic filing system will be excluded when determining the application size fee required by §1.16(s) if the listing is submitted in ASCII text as part of an associated file.

Sec. 1.53 Application number, filing date, and completion of application.

(a) *Application number.* Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

Comment [n58]: Conforming amendment to the new definition of the term "inventor."

(b) *Application filing requirements—Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75, and any drawing required by §1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under this section if the conditions specified in 35 U.S.C. 120, 121, or 365(c) and §1.78 are met.

(1) A continuation or divisional application ~~that names as inventors the same or fewer than all of the inventors named in the prior application~~ may be filed under paragraph (b) or (d) of this section. ~~A continuation or divisional application naming an inventor not named in the prior application must be filed under paragraph (b) of this section.~~ See §1.78(a)(2) for the definition of a divisional application and §1.78(a)(3) for the definition of a continuation application.

(2) A continuation-in-part application must be filed under paragraph (b) of this section. See §1.78(a)(4) for the definition of a continuation-in-part application.

(c) *Application filing requirements—Provisional application.* The filing date of a provisional application is the date on which a specification as prescribed by the first paragraph of 35 U.S.C. 112, and any drawing required by §1.81(a) are filed in the Patent and Trademark Office. No amendment, other than to make the provisional application comply with the patent statute and all applicable regulations, may be made to the provisional application after the filing date of the provisional application.

(1) A provisional application must also include the cover sheet required by §1.51(c)(1), which may be an application data sheet (§1.76), or a cover letter identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under paragraph (b) of this section.

(2) An application for patent filed under paragraph (b) of this section may be converted to a provisional application and be accorded the original filing date of the application filed under paragraph (b) of this section. The grant of such a request for conversion will not entitle applicant to a refund of the fees that were properly paid in the application filed under paragraph (b) of this section. Such a request for conversion must be accompanied by the processing fee set forth in §1.17(q) and be filed prior to the earliest of:

(i) Abandonment of the application filed under paragraph (b) of this section;

(ii) Payment of the issue fee on the application filed under paragraph (b) of this section; [or](#)

(iii) Expiration of twelve months after the filing date of the application filed under paragraph (b) of this section; ~~or~~

~~(iv) The filing of a request for a statutory invention registration under §1.293 in the application filed under paragraph (b) of this section.~~

(3) A provisional application filed under paragraph (c) of this section may be converted to a nonprovisional application filed under paragraph (b) of this section and accorded the original filing date of the provisional application. The conversion of a provisional application to a nonprovisional application will not result in either the refund of any fee properly paid in the provisional application or the application of any such fee to the filing fee, or any other fee, for the nonprovisional application. Conversion of a provisional application to a nonprovisional application under this paragraph will result in the term of any patent to issue from the application being measured from at least the filing date of the provisional application for which conversion is requested. Thus, applicants should consider avoiding this adverse patent term impact by filing a nonprovisional application claiming the benefit of the provisional application under 35 U.S.C. 119(e) (rather than converting the provisional application into a

Comment [n59]: The restriction on the filing of continuing applications is no longer required since they no longer require new inventor statements be provided for any reason.

Comment [n60]: The SAR provisions are being repealed.

nonprovisional application pursuant to this paragraph). A request to convert a provisional application to a nonprovisional application must be accompanied by the fee set forth in §1.17(i) and an amendment including at least one claim as prescribed by the second paragraph of 35 U.S.C. 112, unless the provisional application under paragraph (c) of this section otherwise contains at least one claim as prescribed by the second paragraph of 35 U.S.C. 112. The nonprovisional application resulting from conversion of a provisional application must also include the filing fee, search fee, and examination fee for a nonprovisional application, ~~an oath or declaration by the applicant pursuant to §1.63(b) and 1.64, 1.162, or 1.175, and the surcharge required by §1.16(f) if either the basic filing fee for a nonprovisional application or the oath or declaration~~ identification of the inventor was not present on the filing date accorded the resulting nonprovisional application (*i.e.*, the filing date of the original provisional application). A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of: |

Comment [n61]: A conforming amendment.

(i) Abandonment of the provisional application filed under paragraph (c) of this section; or

(ii) Expiration of twelve months after the filing date of the provisional application filed under paragraph (c) of this section.

(4) A provisional application is not entitled to the right of priority under 35 U.S.C. §119 or 365(a) or §1.55, or to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c) or §1.78 of any other application. No claim for priority under 35 U.S.C. 119(e) or §1.78 may be made in a design application based on a provisional application. No request under §1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(d) *Application filing requirements—Continued prosecution (nonprovisional) application.*

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The application is for a **design patent**;

(ii) The prior nonprovisional application is a design application that is complete as defined by §1.51(b); and

(iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under §1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

(i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application; |

Comment [n62]: A conforming amendment.

(iii) Names as the inventors the same individual or individual inventors named as the inventor in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, ~~and drawings and oath or declaration~~ from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and |

Comment [n63]: A conforming amendment.

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in §1.16(b), the search fee as set forth in §1.16(l), and the examination fee as set forth in §1.16(p).

(4) An application filed under this paragraph may be filed by fewer than all the ~~inventor~~ individuals named as the inventor in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the ~~person~~ individual or ~~individuals~~ persons who are not ~~the inventor~~ or a joint inventor of ~~the~~ claimed invention ~~being claimed~~ in the new application. No ~~person~~ individual may be named as ~~the~~ inventor or a joint inventor in an application filed under this paragraph who was not ~~so~~ named ~~as an inventor~~ in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under §1.48 |

Comment [n64]: A conforming amendment.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with §1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of §1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of ~~his or~~ hers ability:

(i) Title of invention;

(ii) Name of applicant(s); and

(iii) Correspondence address.

(9) See §1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

(e) *Failure to meet filing date requirements.*

(1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a period of time within which to correct the filing error. If, however, a request for an application under paragraph (d) of this section does not meet the requirements of that paragraph because the application in which the request was filed is not a design application, and if the application in which the request was filed was itself filed on or after June 8, 1995, the request for an application under paragraph (d) of this section will be treated as a request for continued examination under §1.114.

(2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in §1.17(f). In the absence of a timely (§1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

(3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in §1.21(n), will be refunded.

(f) *Completion of application subsequent to filing—Nonprovisional (including continued prosecution or reissue) application.*

(1) If an application which has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include the basic filing fee, the search fee, or the examination fee, or if an application which has been accorded a filing date pursuant to paragraph (b) of this section does not ~~include an oath or declaration by the applicant pursuant to §§1.63, 1.162 or 1.175~~ identify the inventor, and the applicant for patent has provided a correspondence address (§1.33(a)), the applicant will be notified and given a period of time within which to pay the basic filing fee, search fee, and examination fee, ~~file an oath or declaration in an application under paragraph (b) of this section~~ identify the inventor, and pay the surcharge if required by §1.16(f) to avoid abandonment |

Comment [n65]: A conforming amendment.

(2) If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the basic filing fee, the search fee, the examination fee, or ~~an oath or declaration by the applicant pursuant to §§1.63, 1.162 or 1.175~~ identify the inventor, and applicant has not provided a correspondence address (§1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, search fee, and examination fee, ~~file an oath or declaration~~ identify the inventor, and pay the surcharge if required by §1.16(f) to avoid abandonment. |

Comment [n66]: A conforming amendment.

(3) If the excess claims fees required by §§1.16(h) and (i) and multiple dependent claim fee required by §1.16(j) are not paid on filing or on later presentation of the claims for which the excess claims or multiple dependent claim fees are due, the fees required by §§1.16(h), (i), and (j) must be paid or the claims canceled by amendment prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency. If the application size fee required by §1.16(s) (if any) is not paid on filing or on later presentation of the amendment necessitating a fee or additional fee under §1.16(s), the fee required by §1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) This paragraph applies to continuation or divisional applications under paragraphs (b) or (d) of this section and to continuation-in-part applications under paragraph (b) of this section. ~~See §1.63(d) concerning the submission of a copy of the oath or declaration from the prior application for a continuation or divisional application under paragraph (b) of this section.~~ |

Comment [n67]: New statements are no longer required in any continuing application where a statement from an individual has been previously provided.

(5) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(6) If an application that has been accorded a filing date pursuant to paragraph (b) or (d) of this section does not include or appear to include a statement that is required under §1.63(b) or §1.64, an applicant for patent may be notified of same by the Office and given a period of time within which to respond to the notice. The notice will require the applicant to confirm that all statements required under §1.63(b) and §1.64 have been provided to the Office or that all such statements have been or will be executed and provided to the Office prior to the date of the notice of allowance under §1.311. If a timely and complete response is provided by the applicant under this paragraph, the application will not be further examined for compliance with the requirements of §1.63(b) or §1.64. If a timely and complete response is not provided to the Office, the Office may order the applicant to make a satisfactory showing that it has the right to make application for patent under §1.41 and 35 U.S.C. 101. If the Office provides a notice of allowance to an applicant for patent in which a statement required under §1.63(b) or §1.64 has not been filed, the applicant for patent shall be required to petition for withdrawal of the application from allowance under §1.313 and such petition must be accompanied by any statement required under §1.63(b) and §1.64 and the fee required under §1.117(h), together with an explanation of the facts and circumstances that resulted in the failure to provide the statements required in a timely manner.

(g) *Completion of application subsequent to filing—Provisional application.*

(1) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by §1.51(c)(1) or the basic filing fee (§1.16(d)), and applicant has provided a correspondence address (§1.33(a)), applicant will be notified and given a period of time within which to pay the basic filing fee, file a cover sheet (§1.51(c)(1)), and pay the surcharge required by §1.16(g) to avoid abandonment.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (c) of this section does not include the cover sheet required by §1.51(c)(1) or the basic filing fee (§1.16(d)), and applicant has not provided a correspondence address (§1.33(a)), applicant has two months from the filing date of the application within which to pay the basic filing fee, file a cover sheet (§1.51(c)(1)), and pay the surcharge required by §1.16(g) to avoid abandonment.

(3) If the application size fee required by §1.16(s) (if any) is not paid on filing, the fee required by §1.16(s) must be paid prior to the expiration of the time period set for reply by the Office in any notice of fee deficiency in order to avoid abandonment.

(4) If applicant does not pay the basic filing fee during the pendency of the application, the Office may dispose of the application.

(h) *Subsequent treatment of application—Nonprovisional (including continued prosecution) application.* An application for a patent filed under paragraphs (b) or (d) of this section will not be placed on the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(i) *Subsequent treatment of application—Provisional application.* A provisional application for a patent filed under paragraph (c) of this section will not be placed on the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(j) *Filing date of international application.* The filing date of an international application designating the United States of America is treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

Comment [n68]: This provision launches a new procedure for applicants who fail to include a statement from an inventor or a joint inventor with the application as filed. It provides the USPTO may notify the applicant that the statement is missing and set a time for response to the notice.

Comment [n69]: The notice requires the applicant, in effect, to confirm that it is authorized to file for the patent – that it has or will obtain all required statements and file them with the USPTO before the Notice of Allowance issues.

Comment [n70]: If the applicant response with the required representations, then the USPTO will not further examine for compliance with the requirement for a timely filing of the statements with the USPTO.

Comment [n71]: If there is no response, the USPTO may enter a notice to show cause of the right to file for the patent.

Comment [n72]: If the applicant fails to provide any required statement before the Notice of Allowance, the applicant must petition and pay the fee to withdraw the application from allowance, file the required statements and then explain the failure to make a timely filing of the required statements.

Sec. 1.59 Expungement of information or copy of papers in application file.

(a)

(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or §41.7(a) of this title. (2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment ~~specifically incorporated into an executed oath or declaration under §§1.63 and 1.175~~) will not be expunged from the application file.

Comment [n73]: A conforming amendment.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in §1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in §1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

Sec. 1.60-1.62 [Reserved]

Oath or Declaration Naming the Inventor and Required Inventor Statement

Comment [n74]: This provision now specifically references the two-pronged requirements, identify the inventor and provide the required statement from the inventor.

Sec. 1.63 Oath or declaration Naming the inventor and required inventor statement.

(a) ~~The identification of the inventor required. An oath or declaration filed under §1.51(b)(2) as a part of a nonprovisional application must, as to each individual so named:~~

(1) ~~Be executed, *i.e.*, signed, in accordance with either §1.66 or §1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, *i.e.*, understand the document that the person is signing;~~

(2) ~~Identify each such individual inventor by the individual's full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;~~

(3) ~~Identify the country of citizenship of the each individual; and~~

(4) ~~Identify the individual's inventor mailing address and residence if the individual lives at a location which is different from where the individual customarily receives mail.~~

Comment [n75]: The statutory requirement to name the inventor is implemented by requiring the applicant to make the type of full identification of the inventor that was formerly made in the oath or declaration.

(b) ~~Except as otherwise provided under this section, for each individual identified under subsection (a), the applicant for patent shall provide to the Office a statement from such individual that the individual believes himself or herself to be, and~~

(c) ~~State that the person making the oath or declaration believes the named an original inventor or joint inventors to be the original and first inventor or inventors of the subject matter which is of a claimed invention and for which a patent is sought and such individual authorized the filing of the application for patent by the applicant for patent.~~

Comment [n76]: The inventor statement is a simple, two-part statement that the filing of the application was authorized and that the individual regards himself or herself as the inventor or a joint inventor.

~~The statement required in the preceding sentence shall be deemed filed with the Office if filed in the application for patent or if incorporated into an assignment of the application for patent that was recorded in the Office. (b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:~~

Comment [n77]: If the statements are filed in an assignment recorded in the USPTO, the statements are deemed filed with the USPTO.

(1) ~~Identify the application to which it is directed;~~

subsection (b) is not required with respect to an individual if a substitute statement with respect to such individual was filed under §1.64

~~(4) Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.~~

~~(5) A newly executed oath or declaration must be filed in a continuation or divisional application naming an inventor not named in the prior application.~~

~~(e) A newly executed oath or declaration must be filed in any continuation-in-part application, which application may name all, more, or fewer than all of the inventors named in the prior application.~~

Sec. 1.64 Person making oath or declarationSubstitute statement permitted.

(a) The oath or declaration (§1.63), including any supplemental oath or declaration (§1.67), must be made by all of the actual inventors except as provided for. ~~For an individual named as an inventor or a joint inventor for whom -in §§1.42, 1.43, or 1.47 applies, a substitute statement in lieu of the statement otherwise required of such individual under §1.63(b) may be filed by the applicant for patent or a person authorized under §§1.42 or 1.43. The substitute statement under this section or §1.67.~~

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§1.42, 1.43, 1.47, or §1.67), the oath or

~~declaration shall state the relationship of the applicant person to the individual inventor, and, upon information and belief, the facts which the individual would otherwise be inventor is required to state under §1.63(b). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.~~

Sec. 1.66 Officers authorized to administer oathsStatement made under oath.

(a) ~~The~~A statement made under §1.63(b) or §1.64 may be made by declaration or may be made under oath or affirmation. If made under oath or affirmation, the statement may be made before any person within the United States authorized by law to administer oaths. An oath made in a foreign country may be made before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, or by an apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States. The oath shall be attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the State or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

~~(b) When the oath is taken before an officer in a country foreign to the United States, any accompanying application papers, except the drawings, must be attached together with the oath and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before~~

Comment [n79]: When a statement from the inventor cannot be secured, substitute statements are permitted.

Comment [n80]: The requirement statement may be made under oath or declaration.

whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination, but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Sec. 1.67 Supplemental oath or declarationAdditional statements.

(a) The Office may not require the filing of any additional or supplemental statement with respect to an individual unless the Office determines that such a requirement was made in order, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of §1.63 or §1.162 to correct any deficiencies or inaccuracies present in anthe earlier filed oath or declarationstatement made by or with respect to such individual.

(b) Deficiencies or inaccuracies relating to all the inventors or applicants (§§1.42, 1.43, or §1.47)statement under §1.63(b) or §1.64 made by or with respect to an individual may be corrected with the filing of a correctedstatement in complying with the requirements of §1.63(b) or §1.64pplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§1.42, 1.43 or §1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of §1.63(c) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with §1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by §1.33(a)(2) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of §1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with §1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(e) [Reserved]

Sec. 1.68 Form of dDeclaration in lieu of oath.

(a) A statement made under §1.63(b) or §1.64 by written declaration must include the following text or its equivalent: "I acknowledge that any willful false statement made herein is punishable under 18 U.S.C. §1001 by fine or imprisonment of not more than 5 years or both." A statement under §1.63(b) shall be deemed sufficient if it additionally includes the following text or its equivalent with respect to the application for patent to which the statement relates: "The application was made or was authorized to be made by me and I believe myself to be the original inventor or an original joint inventor of a claimed invention in the application." If the statement is made with respect to an application for patent made prior to the filing of the application with the Office, then the statement can be made either in the present tense or in the past tense, notwithstanding that the application has yet to be received by the Office at the time the statement is made.

Comment [n81]: The USPTO can no longer require supplemental oaths or declarations.

Comment [n82]: This provision provides "safe harbor" language that the USPTO will deem sufficient to meet the requirements for the inventor's statement.

(b) Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

Sec. 1.76 Application data sheet.

(a) *Application data sheet.* An application data sheet is a sheet or sheets, that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. An application data sheet must be titled "Application Data Sheet" and must contain all of the section headings listed in paragraph (b) of this section, with any appropriate data for each section heading. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes:

(1) *Applicant information.* This information includes full name (either individual or juristic entity), mailing address and place of residence of each person making application for patent. In the case of an individual, the information includes the name (family name, and at least one given name without abbreviation together with any other given name or initial), residence, mailing address, and citizenship of each applicant (§1.41(b))the individual. The name of each applicant must include the family name, and at least one given name without abbreviation together with any other given name or initial. If the applicant is not an inventor, this information also includes the applicant's authority (§§1.42, 1.43, and 1.47) to apply for the patent on behalf of the inventor. In the case of a juristic entity, the place of its juristic existence.

(2) *Applicant's correspondence information.* This information includes the correspondence address, which may be indicated by reference to a customer number, to which correspondence is to be directed (*see* §1.33(a)).

(3) *Application information.* This information includes the title of the invention, a suggested classification, by class and subclass, the Technology Center to which the subject matter of the invention is assigned, the total number of drawing sheets, a suggested drawing figure for publication (in a nonprovisional application), any docket number assigned to the application, the type of application (*e.g.*, utility, plant, design, reissue, provisional), whether the application discloses any significant part of the subject matter of an application under a secrecy order pursuant to §5.2 of this chapter (*see* §5.2(c)), and, for plant applications, the Latin name of the genus and species of the plant claimed, as well as the variety denomination. The suggested classification and Technology Center information should be supplied for provisional applications whether or not claims are present. If claims are not present in a provisional application, the suggested classification and Technology Center should be based upon the disclosure.

(4) *Representative information.* This information includes the registration number of each practitioner having a power of attorney in the application (preferably by reference to a customer number). Providing this information in the application data sheet does not constitute a power of attorney in the application (*see* §1.32).

(5) *Domestic priority information.* This information includes the application number, the filing date, and relationship of each application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). This information includes the application number and the filing date of each application for which a benefit is claimed under 35 U.S.C. 119(e). Providing this information in the application data sheet also constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and §1.78(b)(3) or §1.78(d)(3), and need not otherwise be made part of the specification.

Comment [n83]: This provision is conformed for assignee filing to assure the Office has a full identification of the assignee.

(6) *Foreign priority information.* This information includes the application number, country, and filing date of each foreign application for which priority is claimed, as well as any foreign application having a filing date before that of the application for which priority is claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and §1.55(a).

(7) *Inventor information.* This information the name (family name, and at least one given name without abbreviation together with any other given name or initial), residence, mailing address, and citizenship of each individual named as the inventor or a joint inventor. *Assignee information.* This information includes the name (either person or juristic entity) and address of the assignee of the entire right, title, and interest in an application. Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of this chapter to have an assignment recorded by the Office.

Comment [n84]: The paragraph on the assignee is moot with assignee filing and has been replaced by a provision requiring full inventor identification.

(c) *Supplemental application data sheets.* Supplemental application data sheets:

(1) May be subsequently supplied prior to payment of the issue fee either to correct or update information in a previously submitted application data sheet, ~~or an oath or declaration under §1.63 or §1.67~~, except that inventorship changes are governed by §1.48, correspondence changes are governed by §1.33(a), and citizenship changes are governed by §1.63 or §1.67; and

Comment [n85]: A conforming amendment.

(2) Must be titled "Supplemental Application Data Sheet," include all of the section headings listed in paragraph (b) of this section, include all appropriate data for each section heading, and must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.

(d) *Inconsistencies between application data sheet and other documents.* For inconsistencies between information that is supplied by both an application data sheet under this section and other documents.

(1) The latest submitted information will govern notwithstanding whether supplied by an application data sheet, an amendment to the specification, ~~or~~ a designation of a correspondence address, ~~or by a §1.63 or §1.67 oath or declaration~~, except as provided by paragraph (d)(3) of this section;

Comment [n86]: A conforming amendment.

(2) The information in the application data sheet will govern when the inconsistent information is supplied at the same time by an amendment to the specification, ~~or~~ a designation of correspondence address, ~~or a §1.63 or §1.67 oath or declaration, except as provided by paragraph (d)(3) of this section;~~

Comment [n87]: A conforming amendment.

(3) ~~The oath or declaration under §1.63 or §1.67 governs inconsistencies with the application data sheet in the naming of inventors (§1.41(a)(1)) and setting forth their citizenship (35 U.S.C. 115);~~

Comment [n88]: A conforming amendment.

(4) The Office will capture bibliographic information from the application data sheet ~~(notwithstanding whether an oath or declaration governs the information)~~. Thus, the Office shall generally, for example, not look to an oath or declaration under §1.63 to see if the bibliographic information contained therein is consistent with the bibliographic information captured from an application data sheet ~~(whether the oath or declaration is submitted prior to or subsequent to the application data sheet)~~. Captured bibliographic information derived from an application data sheet containing errors may be corrected if applicant submits a request therefor and a supplemental application data sheet.

Comment [n89]: A conforming amendment.

Sec. 1.77 Arrangement of application elements.

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility application transmittal form.
- (2) Fee transmittal form.

(3) Application data sheet (see §1.76).

(4) Specification.

(5) Drawings.

(6) [Statements required under §1.63\(b\) or §1.65](#)~~Executed oath or declaration.~~

Comment [n90]: A conforming amendment.

(b) The specification should include the following sections in order:

(1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the [applicant/inventor](#) (unless included in the application data sheet).

Comment [n91]: A conforming amendment.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) The names of the parties to a joint research agreement.

(5) Reference to a “Sequence Listing,” a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see §1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the several views of the drawing.

(9) Detailed description of the invention.

(10) A claim or claims.

(11) Abstract of the disclosure.

(12) “Sequence Listing,” if on paper (see §§1.821 through 1.825).

(c) The text of the specification sections defined in paragraphs (b)(1) through (b)(12) of this section, if applicable, should be preceded by a section heading in uppercase and without underlining or bold type.

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

(a) *Definitions*—

(1) *Continuing application.* A continuing application is a nonprovisional application or an international application designating the United States of America that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of a prior-filed nonprovisional application or international application designating the United States of America. An application that does not claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a prior-filed application is not a continuing application even if the application claims the benefit under 35 U.S.C. 119(e) of a provisional application, claims priority under 35 U.S.C. 119(a)-(d) or 365(b) to a foreign application, or claims priority under 35 U.S.C. 365(a) or (b) to an international application designating at least one country other than the United States of America.

(2) *Divisional application.* A divisional application is a continuing application as defined in paragraph (a)(1) of this section that discloses and claims only an invention or inventions that were disclosed and claimed in a prior-filed

application, but were subject to a requirement to comply with the requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121 in the prior-filed application, and were not elected for examination and were not examined in any prior-filed application.

(3) *Continuation application.* A continuation application is a continuing application as defined in paragraph (a)(1) of this section that discloses and claims only an invention or inventions that were disclosed in the prior-filed application.

(4) *Continuation-in-part application.* A continuation-in-part application is a continuing application as defined in paragraph (a)(1) of this section that discloses subject matter that was not disclosed in the prior-filed application.

(b) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and paragraph (b) of this section.

(1) The nonprovisional application or international application designating the United States of America must be filed not later than twelve months after the date on which the provisional application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) and §1.7(a).

(2) Each prior-filed provisional application must name as ~~the~~ inventor at least one ~~inventor~~ individual named in the later-filed application as the inventor. 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 have been paid for such provisional application within the time period set forth in §1.53(g).

Comment [n92]: A conforming amendment.

(3) Any nonprovisional application or international application designating the United States of America that claims 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). 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.

(4) The reference required by paragraph (b)(3) of this section 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. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

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

(ii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) 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 the translation and the statement in the prior-filed provisional application. 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.

(c) *Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* If the reference required by 35 U.S.C. 119(e) and paragraph (b)(3) of this section is presented in a nonprovisional application after the time period provided by paragraph (b)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if submitted during the pendency of the later-filed application and 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:

- (1) The reference required by 35 U.S.C. 119(e) and paragraph (b)(3) of this section to the prior-filed provisional application, unless previously submitted;
- (2) The surcharge set forth in §1.17(t); and
- (3) A statement that the entire delay between the date the claim was due under paragraph (b)(4) 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.

(d) *Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.* A nonprovisional application (including an international application that has entered the national stage after compliance with 35 U.S.C. 371) may claim the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America under the conditions set forth in 35 U.S.C. 120 and paragraph (d) of this section.

(1) A nonprovisional application that claims the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must satisfy the conditions set forth in at least one of paragraphs (d)(1)(i) through (d)(1)(vi) of this section. The Office will refuse to enter, or will delete if present, any specific reference to a prior-filed application that is not permitted by at least one of paragraphs (d)(1)(i) through (d)(1)(vi) of this section. The Office's entry of, or failure to delete, a specific reference to a prior-filed application that is not permitted by at least one of paragraphs (d)(1)(i) through (d)(1)(vi) of this section does not constitute a waiver of the provisions of paragraph (d)(1) of this section.

(i)

(A) The nonprovisional application is either a continuation application as defined in paragraph (a)(3) of this section or a continuation-in-part application as defined in paragraph (a)(4) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of no more than two prior-filed applications; and (B) Any application whose benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in such nonprovisional application has its benefit claimed in no more than one other nonprovisional application, not including any nonprovisional application that satisfies the conditions set forth in paragraph (d)(1)(ii), (d)(1)(iii) or (d)(1)(vi) of this section.

(ii)

(A) The nonprovisional application is a divisional application as defined in paragraph (a)(2) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of a prior-filed application that was subject to a requirement to comply with the requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121; and (B) The divisional application contains only claims directed to an invention or inventions that were identified in such requirement to comply with the requirement of unity of invention or requirement for restriction but were not elected for examination and were not examined in the prior-filed application or in any other nonprovisional application, except for a nonprovisional application that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of such divisional application and satisfies the conditions set forth in paragraph (d)(1)(iii) or (d)(1)(vi) of this section.

(iii)

(A) The nonprovisional application is a continuation application as defined in paragraph (a)(3) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of a divisional application that satisfies the conditions set forth in paragraph (d)(1)(ii) of this section; (B) The nonprovisional application discloses and claims only an invention or inventions that were disclosed and claimed in such divisional application;

(C) The nonprovisional application claims the benefit under 35 U.S.C. 120, 121, or 365(c) of only the divisional application, any application to which such divisional application claims benefit under 35 U.S.C. 120, 121, or 365(c) in compliance with the conditions set forth in paragraph (d)(1)(ii) of this section, and no more than one intervening prior-filed nonprovisional application; and

(D) The divisional application whose benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in such nonprovisional application has its benefit claimed in no more than one other nonprovisional application, not including any other divisional application that satisfies the conditions set forth in paragraph (d)(1)(ii) or any nonprovisional application that claims the benefit under 35 U.S.C. 120 or 365(c) of such other divisional application and satisfies the conditions set forth in paragraph (d)(1)(iii) or (d)(1)(vi) of this section.

(iv)

(A) The nonprovisional application claims benefit under 35 U.S.C. 120 or 365(c) of a prior-filed international application designating the United States of America, and a Demand has not been filed and the basic national fee (§1.492(a)) has not been paid in the prior-filed international application and the prior-filed international application does not claim the benefit of any other nonprovisional application or international application designating the United States of America; (B) The nonprovisional application is either a continuation application as defined in paragraph (a)(3) of this section or a continuation-in-part application as defined in paragraph (a)(4) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of no more than three prior-filed applications; and

(C) Any application whose benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in such nonprovisional application has its benefit claimed in no more than two other nonprovisional applications, not including any nonprovisional application that satisfies the conditions set forth in paragraph (d)(1)(ii), (d)(1)(iii) or (d)(1)(vi) of this section.

(v)

(A) The nonprovisional application claims benefit under 35 U.S.C. 120 or 365(c) of a prior-filed nonprovisional application filed under 35 U.S.C. 111(a), and such nonprovisional application became abandoned due to the failure to timely reply to an Office notice issued under §1.53(f) and does not claim the benefit of any other nonprovisional application or international application designating the United States of America; (B) The nonprovisional application is either a continuation application as defined in paragraph (a)(3) of this section or a continuation-in-part application as defined in paragraph (a)(4) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of no more than three prior-filed applications; and

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(C) Any application whose benefit is claimed under 35 U.S.C. 120, 121, or 365(c) in such nonprovisional application has its benefit claimed in no more than two other nonprovisional applications, not including any nonprovisional application that satisfies the conditions set forth in paragraph (d)(1)(ii), (d)(1)(iii) or (d)(1)(vi) of this section.

(vi) The nonprovisional application is a continuing application as defined in paragraph (a)(1) of this section that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of a prior-filed application, is filed to obtain consideration of an amendment, argument, or evidence that could not have been submitted during the prosecution of the prior-filed application, and does not satisfy the conditions set forth in any of paragraphs (d)(1)(i) through (d)(1)(v) of this section. A petition must be filed in such nonprovisional application that is accompanied by the fee set forth in §1.17(f) and a showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application. If the continuing application is an application filed under 35 U.S.C. 111(a), this petition must be submitted within four months from the actual filing date of the continuing application. If the continuing application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this petition must be submitted within four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the international application.

(2) Each prior-filed application must name as the inventor at least one inventor/individual named in the later-filed application as the inventor. In addition, each prior-filed application must either be:

Comment [n93]: A conforming amendment.

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

(ii) A nonprovisional application under 35 U.S.C. 111(a) that is entitled to a filing date as set forth in §1.53(b) or §1.53(d) for which the basic filing fee set forth in §1.16 has been paid within the pendency of the application.

(3) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application, or international application designating the United States of America, that claims the benefit of one or more prior-filed 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. The reference must also identify the relationship of the applications (i.e., whether the later-filed application is a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application or international application). If an application is identified as a continuation-in-part application, the applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application. 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.

(4) The reference required by 35 U.S.C. 120 and paragraph (d)(3) of this section 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. Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(3) of this section is considered a waiver of

any benefit under 35 U.S.C. 120, 121, or 365(c) to the prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (i) An application for a design patent;
- (ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or
- (iii) An international application filed under 35 U.S.C. 363 before November 29, 2000.

(5) 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.

(6) Cross-references to other related applications may be made when appropriate. Cross-references to applications for which a benefit is not claimed under title 35, United States Code, must be located in a paragraph that is separate from the paragraph containing the references to applications for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c) that is required by 35 U.S.C. 119(e) or 120 and this section.

(e) *Delayed claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application or international application.* If the reference required by 35 U.S.C. 120 and paragraph (d)(3) of this section is presented after the time period provided by paragraph (d)(4) 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:

- (1) The reference required by 35 U.S.C. 120 and paragraph (d)(3) of this section to the prior-filed application, unless previously submitted;
- (2) The surcharge set forth in §1.17(t); and
- (3) A statement that the entire delay between the date the claim was due under paragraph (d)(4) 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.

(f) *Applications and patents naming as the inventor at least one individual inventor in common.*

(1)

(i) The applicant in a nonprovisional application that has not been allowed (§1.311) must identify by application number (i.e., series code and serial number) and patent number (if applicable) each other pending or patented nonprovisional application, in a separate paper, for which the following conditions are met: (A) The nonprovisional application has a filing date that is the same as or within two months of the filing date of the other pending or patented nonprovisional application, taking into account any filing date for which a benefit is sought under title 35, United States Code;

(B) The nonprovisional application names as the inventor at least one individual inventor in common with the other pending or patented nonprovisional application; and

Comment [n94]: A conforming amendment.

(C) The nonprovisional application is owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented nonprovisional application.

(ii) The identification of such one or more other pending or patented nonprovisional applications if required by paragraph (f)(1)(i) of this section must be submitted within the later of:

(A) Four months from the actual filing date in a nonprovisional application filed under 35 U.S.C. 111(a);

(B) Four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371; or

(C) Two months from the mailing date of the initial filing receipt in such other nonprovisional application for which identification is required by paragraph (f)(1)(i) of this section.

(2)

(i) A rebuttable presumption shall exist that a nonprovisional application contains at least one claim that is not patentably distinct from at least one of the claims in another pending or patented nonprovisional application if the following conditions are met:

(A) The nonprovisional application has a filing date that is the same as the filing date of the other pending or patented nonprovisional application, taking into account any filing date for which a benefit is sought under title 35, United States Code;

(B) The nonprovisional application names as the inventor at least one individual inventor in common with the other pending or patented nonprovisional application;

Comment [n95]: A conforming amendment.

(C) The nonprovisional application is owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented nonprovisional application; and

(D) The nonprovisional application and the other pending or patented nonprovisional application contain substantial overlapping disclosure. Substantial overlapping disclosure exists if the other pending or patented nonprovisional application has written description support under the first paragraph of 35 U.S.C. 112 for at least one claim in the nonprovisional application.

(ii) If the conditions specified in paragraph (f)(2)(i) of this section exist, the applicant in the nonprovisional application must, unless the nonprovisional application has been allowed (§1.311), take one of the following actions within the time period specified in paragraph (f)(2)(iii) of this section:

(A) Rebut this presumption by explaining how the application contains only claims that are patentably distinct from the claims in each of such other pending nonprovisional applications or patents; or

(B) Submit a terminal disclaimer in accordance with §1.321(c). In addition, where one or more other pending nonprovisional applications have been identified, the applicant must explain why there are two or more pending nonprovisional applications naming at least one inventor in common and owned by the same person, or subject to an obligation of assignment to the same person, which contain patentably indistinct claims.

(iii) If the conditions specified in paragraph (f)(2)(i) of this section exist, the applicant in the nonprovisional application must, unless the nonprovisional application has been allowed (§1.311), take one of the actions specified in paragraph (f)(2)(ii) of this section within the later of:

(A) Four months from the actual filing date of a nonprovisional application filed under 35 U.S.C. 111(a);

(B) Four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371;

(C) The date on which a claim that is not patentably distinct from at least one of the claims in the one or more other pending or patented nonprovisional applications is presented; or

(D) Two months from the mailing date of the initial filing receipt in the one or more other pending or patented nonprovisional applications.

(3) In the absence of good and sufficient reason for there being two or more pending nonprovisional applications owned by the same person, or subject to an obligation of assignment to the same person, which contain patentably indistinct claims, the Office may require elimination of the patentably indistinct claims from all but one of the applications.

(g) *Applications or patents under reexamination naming as the inventor different ~~inventor~~ individuals and containing patentably indistinct claims.* If an application or a patent under reexamination and at least one other application naming as the inventor different ~~inventor~~ individuals are owned by the same party and contain patentably indistinct 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~~ as of the effective filing date of a claimed invention, the Office may require the applicant for patent ~~signee~~ 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~~ as of such effective filing date.

(h) *Parties to a joint research agreement.* If an application discloses or is amended to disclose the names of parties to a joint research agreement under 35

U.S.C. 103(c)(2)(C), the parties to the joint research agreement are considered to be the same person for purposes of this section. If the application is amended to disclose the names of parties to a joint research agreement, the identification of such one or more other nonprovisional applications as required by paragraph (f)(1) of this section must be submitted with such amendment unless such identification is or has been submitted within the four-month period specified in paragraph (f)(1) of this section.

(i) *Time periods not extendable:* The time periods set forth in this section are not extendable.

§ 1.495 Entering the national stage in the United States of America.

(a) The applicant in an international application must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. The thirty-month time period set forth in paragraphs (b), (c), (d), (e) and (h) of this section may not be extended. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of thirty months from the priority date:

(1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and

(2) The basic national fee (see § 1.492(a)).

(c)(1) If applicant complies with paragraph (b) of this section before expiration of thirty months from the priority date, the Office will notify the applicant if he or she has omitted any of:

Comment [n96]: A conforming amendment; requires recognition of the new provisions on prior art exceptions.

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(i) A translation of the international application, as filed, into the English language, if it was originally filed in another language and if any English language translation of the publication of the international application previously submitted under 35 U.S.C. 154(d) (§ 1.417) is not also a translation of the international application as filed (35 U.S.C. 371(c)(2));

(ii) The inventor statement as required under 1.63 if it has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1;

...
§ 1.497 Inventor's statement (Oath or declaration under 35 U.S.C. 371(c)(4)).

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and an inventor's statement under 1.63 has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, the applicant must file a statement in accordance with § 1.63.

(b) Such an inventor's statement will be accepted as complying with 35 U.S.C. 371(c)(4) and § 1.495(c) for purposes of entering the national stage under 35 U.S.C. 371 if it:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the application to which it is directed;

(3) Identifies each inventor;

(4) States that the person executing the oath or declaration believes the named inventor or inventors to be the original inventor or an original joint inventor of a claimed invention in the application; 5) States that the application was made or was authorized to be made by the inventor; and (6) Where the oath or declaration is not made by the inventor, complies with the applicable requirements of §§ 1.42 and 1.47.

~~(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to § 1.495, and a declaration in compliance with this section has not been previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1, he or she must file an oath or declaration that:~~

~~(1) Is executed in accordance with either §§ 1.66 or 1.68;~~

~~(2) Identifies the specification to which it is directed;~~

~~(3) Identifies each inventor and the country of citizenship of each inventor; and~~

~~(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the~~

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