Notice of Proposed Rule Making

Proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims


Los Angeles Intellectual Property Law Association
“Washington and the West” Conference
January 25, 2006

Robert J. Spar, Director
Office of Patent Legal Administration
(571) 272-7700  Bob.Spar@USPTO.gov

January 25, 2006
Objectives of Proposed Changes

- Use the limited examination resources for examining more applications disclosing “new” inventions as opposed to spending resources on “reworking” continued examination filings.

- Improve the quality of issued patents and promote public certainty by providing more timely and clear notice of patented technologies by reducing the number of patents that have overlapping disclosures and claims.

- Make the examination process more efficient and effective by requiring more focus on important patentability issues during the first examination of an invention.
Brief Highlights of Proposed Changes

- **PUBLIC COMMENTS**
  - Public Comments on this proposed rulemaking must be received on or before **May 3, 2006** via e-mail, facsimile, mail or internet.

- **MULTIPLE FILINGS* PRACTICE**
  - Only one continued examination filing* will be permitted, unless a petition is granted.
  - First action final practice will be eliminated if proposed changes adopted.

* Includes continuation applications, continuation-in-part applications, and requests for continued examination (RCEs)
Brief Highlights of Proposed Changes

DIVISIONAL APPLICATIONS

- Are only permitted if the Office imposes a restriction, or lack of unity, requirement in the parent application.
- Can only claim the benefit of a single parent application, which had the restriction, or lack of unity, requirement, unless a petition is granted.
- A single continuation or RCE of each divisional application will be permitted (without petition).
Brief Highlights of Proposed Changes

- RELATED APPLICATIONS AND CLAIMS
  - An applicant must identify all other applications that are related (close effective filing dates, common inventor, and common assignee) to his or her application.
  - If the disclosure of a related application substantially overlaps applicant’s disclosure, the Office will rebuttably presume double patenting between the inventions for certain applications.
  - The Office may require that patentably indistinct claims be eliminated from all but one application.
Brief Highlights of Proposed Changes

- OTHER CHANGES
  - Continuation-in-Part (CIP) Applications: If a CIP application is filed, the applicant must identify which claims are supported in the parent application.
  - National Stage Entry: In case of ambiguity, documents and fees will be treated as an entry to the national stage of an international application under 35 USC 371 rather than as an application under 35 USC 111.
Proposed Changes to Rules

List of Rules Proposed to be Changed

- 37 CFR 1.78 – Claiming benefit of earlier filing date and cross-references to other applications
- 37 CFR 1.114 – Request for continued examination
- 37 CFR 1.495 – Entering the national stage in the United States of America
Proposed Changes to Practice of Continued Examination Practice

Proposed Requirements for Continuing Applications
Section 1.78 is proposed to be reorganized as follows:

- § 1.78(a) – definitions established;
- § 1.78(b) - claims under 35 USC 119(e) for the benefit of a prior-filed provisional application;
- § 1.78(c) - delayed claims under 35 USC 119(e);
- § 1.78(d) - claims under 35 USC 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application;
- § 1.78(e) - delayed claims under 35 USC 120, 121, or 365(c);
- § 1.78(f) - applications naming at least one inventor in common;
- § 1.78(g) - applications or patents under reexamination naming different inventors and containing patentably indistinct claims; and
- § 1.78(h) - the treatment of parties to a joint research agreement under the CREATE Act.
Proposed Changes to 37 CFR 1.78(a)

Definitions would be set forth in § 1.78(a)

- **Continuing Application**
  - A nonprovisional application or an international application (IA) designating the U.S. that claims the benefit under 35 USC 120, 121, 365(c) of a prior-filed nonprovisional application or IA designating the U.S. § 1.78(a)(1)

- **Continuation Application**
  - A continuing application that discloses and claims only an invention or inventions that were disclosed in the prior-filed application. § 1.78(a)(2)
Proposed Changes to 37 CFR 1.78(a)

Definitions would be forth in § 1.78(a)

- **Divisional Application**
  - A continuing application that discloses and claims only an invention or inventions that were disclosed and claimed in the prior-filed application, but were subject to a requirement of unity of invention under PCT Rule 13, or a requirement for restriction under 35 USC 121, and were not elected for examination in the prior-filed application. § 1.78(a)(3)

- **Continuation-in-Part (CIP) Application**
  - A continuing application that discloses subject matter that was not disclosed in the prior-filed application. § 1.78(a)(4)
A continuing application (application that claims the benefit of a prior-filed nonprovisional or international application) must meet at least one of the 4 permitted conditions set forth in proposed §§ 1.78(d)(1)(i)-(iv).
Proposed Changes to 37 CFR 1.78(d)(1)
Benefit Claims under 35 USC 120, 121, or 365(c)

**Permitted Condition 1** (proposed § 1.78(d)(1)(i)):

- A continuation and CIP application may claim the benefit of only a single prior-filed nonprovisional application, if:
  - No RCE was filed in the prior-filed nonprovisional application, and
  - The benefit of such prior filed application is not claimed in any other nonprovisional application other than a divisional.
Proposed Changes to 37 CFR 1.78(d)(1)
Benefit Claims under 35 USC 120, 121, or 365(c)

Example 1 - Permitted Condition 1
One RCE, Continuation, or CIP Permitted

Applicant may file:
an RCE, § 1.114(f), or
a continuation, or a CIP
application, claiming a benefit
under 35 USC 120, 121 or
365(c), § 1.78(d)(1)(i)
Proposed Changes to 37 CFR 1.78(d)(1)  
Benefit Claims under 35 USC 120, 121, or 365(c)

Permitted Condition 2 (proposed § 1.78(d)(1)(ii)):

- A divisional application may claim the benefit of only a single prior-filed nonprovisional application, provided:
  - The prior-filed application was subject to a requirement of unity of invention under PCT Rule 13, or a requirement for restriction under 35 USC 121, and
  - The divisional application contains only claims directed to an invention or inventions that were identified in such requirement but were not elected for examination in the prior-filed application.
- Thus, only “involuntary” divisional applications are permitted.
Proposed Changes to 37 CFR 1.78(d)(1)

Benefit Claims under 35 USC 120, 121, or 365(c)

Example 2A - Permitted Condition 2

Only Involuntary Divisional Applications Are Permitted

1. Provisional Application
2. Nonprovisional Application claiming the benefit of the provisional application, 35 USC 119(e)
3. Restriction made in Application #2
4. Applicant may file a Divisional Application to non-elected invention, if there is compliance with § 1.78(d)(1)(ii)
Proposed Changes to 37 CFR 1.78(d)(1)
Benefit Claims under 35 USC 120, 121, or 365(c)

Example 2B - Permitted Condition 2
Divisional Applications Can Only Claim Benefit of One Prior Nonprovisional Application

Nonprovisional Application with claims to inventions A, B, and C

Restriction made in Application #1

Applicant elected invention A and canceled claims directed to B, and C

Applicant may file Divisional Applications claiming only the benefit of application #1 and the claims must be directed non-elected inventions in compliance with § 1.78(d)(1)(ii).
Permitted Condition 3 (proposed § 1.78(d)(1)(iii)):

- A continuation or CIP application may claim the benefit of:
  - Only a single divisional application in compliance with § 1.78(d)(1)(ii), and
  - The single prior-filed application whose benefit is claimed in such divisional application, provided further that no RCE was filed in such prior-filed divisional application.
Proposed Changes to 37 CFR 1.78(d)(1)

Benefit Claims under 35 USC 120, 121, or 365(c)

Example 3 - Permitted Condition 3

One Continuing Filing after a Divisional Permitted

1. Provisional Application
2. Nonprovisional Application claiming the benefit of the provisional application, 35 USC 119(e)
3. Restriction made in Application #2
4. Divisional Application under § 1.78(d)(1)(ii) to non-elected invention

Applicant may file: a single RCE, or continuation or CIP application of the divisional application, § 1.78(d)(1)(iii)
Proposed Changes to 37 CFR 1.78(d)(1)

Benefit Claims under 35 USC 120, 121, or 365(c)

Permitted Condition 4 (proposed § 1.78(d)(1)(iv)):

- A continuing application may be filed to obtain consideration of an amendment, argument, or evidence, if applicant files a petition accompanied by:
  - The fee under § 1.17(f); and
  - A showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted during the prosecution of the prior-filed application.

- The petition must be filed within 4 months from the actual filing date of the later filed continuing application, or the date on which the national stage commenced (if a § 371 filing).
Proposed Changes to 37 CFR 1.78(d)(1)

Benefit Claims under 35 USC 120, 121, or 365(c)

Example 4 - Permitted Condition 4

Second Continuing Filing Requires Petition & Showing

1. Provisional Application
2. Nonprovisional Application claiming the benefit of the provisional application
3. A first continuing application or an RCE
4. Applicant may file a second or subsequent RCE or continuing application w/ a petition and showing in compliance with § 1.114(f) or § 1.78(d)(1)(iv)
**Proposed Changes to 37 CFR 1.78(d)(1)**

**Benefit Claims under 35 USC 120, 121, or 365(c)**

**Example 5 - Permitted Condition 4**

*Second CIP Requires Petition & Showing*

- **#1** Nonprovisional Application
- **#2** CIP Application claiming the benefit of Application #1
- **#3** A second CIP application may claim the benefit of Application #2, but not Application #1 unless applicant files it with a petition and showing in compliance with § 1.78(d)(1)(iv)
Proposed Changes to 37 CFR 1.78(d)(1)

Benefit Claims under 35 USC 120, 121, or 365(c)

Example 6 - Permitted Condition 4

Second Continuing Filing Requires Petition & Showing

#1

PCT Application designated U.S.

#2

Continuation Application claiming the benefit of PCT Application #1

#3

Applicant may not file an RCE or a second Con or CIP application, unless applicant files it w/ a petition and showing in compliance with § 1.114(f) or § 1.78(d)(1)(iv).
Proposed Changes to 37 CFR 1.78(d)(3)
Benefit Claims under 35 USC 120, 121, or 365(c)

What if none of the 4 conditions of proposed § 1.78(d)(1) could be met?

- The Office will refuse to enter, or will delete if present, any specific reference to a prior-filed application that is not permitted by proposed § 1.78(d)(1).
- The entry or failure to delete a specific reference to a prior-filed application that is not permitted by proposed § 1.78(d)(1) does not constitute a waiver of the provisions of proposed § 1.78(d)(1).

See proposed § 1.78(d)(3).
Proposed Changes to 37 CFR 1.78(d)(3)  
**Benefit Claims under 35 USC 120, 121, or 365(c)**

- **Additional requirements for CIP applications:** 
  Applicant must identify which claim(s) in the CIP application are disclosed in the manner provided by 35 USC 112, ¶1, in the prior-filed application within the 4/16 month time period set in § 1.78(d)(4).
  - If not identified as required, the claims will be treated as entitled only to the filing date of the CIP application.
- Thus, applicant will have the burden of indicating when support in the prior application exists. See proposed § 1.78(d)(3).
Proposed Changes to 37 CFR 1.78(d)(6)

Related Application Filings

Cross-references to related applications for which a benefit is not claimed must be set forth in a separate paragraph.

- Such cross references must be located in a paragraph which is separate from the first sentence(s) which include the reference(s) required by 35 USC 119(e) or 120 and § 1.78 to applications for which a benefit is claimed under 35 USC 119(e), 120, 121 or 365(c).

See proposed § 1.78(d)(6).
Proposed Changes to 37 CFR 1.78(e)  
Benefit Claims under 35 USC 120, 121, or 365(c)

Provisions relating to delayed claims:
- Petitions to accept an unintentionally delayed claim for the benefit of a nonprovisional application will continue to be permitted,
- But such petitions will not be granted in an application in which an RCE has been filed.  
See proposed § 1.78(e) and § 1.114(f).
Proposed Changes to 37 CFR 1.78

Benefit Claims under 35 USC 120, 121, or 365(c)

- **Effective Date** of proposed changes to § 1.78 (if adopted):
- The proposed changes would be applicable to any application filed on or after the effective date of the final rule.
- Any application filed on or after the effective date of the final rule seeking to claim benefit of more than a single prior-filed nonprovisional application or international application under 35 USC 120, 121, 365(c) and § 1.78 would need to either:
  - Meet the requirements in proposed § 1.78(d)(1)(iii) (e.g., a CIP of a divisional application compliant with proposed § 1.78(d)(1)(ii)); or
  - Include a petition coupled with a satisfactory showing under proposed § 1.78(d)(1)(iv).
Proposed Changes to 37 CFR 1.78

Example 7 - Meaning of Effective Date Provision
Permitted Conditions 1-3 cannot be met

Nonprovisional Application

Con or CIP Application claiming the benefit of Application #1

Con or CIP Application claiming the benefit of Applications #1 and #2

Effective Date

Con or CIP Application may claim the benefit of Application #3, but not Applications #1 & #2 unless applicant files a petition and showing in compliance with § 1.78(d)(1)(iv) (Permitted Condition 4)
Example 8 - *Meaning of Effective Date Provision*

Permitted Conditions 1-3 cannot be met

- **#1**: Nonprovisional Application
- **#2**: Voluntary Divisional Application claiming the benefit of Application #1
- **#3**: Con or CIP Application may claim the benefit of Application #2, but not Application #1 unless applicant files with a petition and showing in compliance with § 1.78(d)(1)(iv) (Permitted Condition 4)
Proposed Changes to Continued Examination Practice

Requirements for Requests for Continued Examination (RCE) under Proposed 37 CFR 1.114
Proposed Requirements for RCE Practice  
37 CFR 1.114(f)

Proposal: Multiple RCEs permitted, but impose additional requirements on:

(1) A second or subsequent RCE in a non-continuing application, or in a divisional application in compliance with proposed § 1.78(d)(1)(ii); and

(2) Any RCE in a continuation or CIP application.

Additional requirements include a petition accompanied by:

- The fee set forth in §1.17(f) and
- A showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application.

Currently: Multiple RCE filings are permitted without such requirements.
Proposed Changes to RCE practice
37 CFR 1.114(f)

What happens if an RCE is improperly filed without the required petition and showing under proposed § 1.114(f)?

- The RCE will be treated as an improper RCE and any time period for reply set forth in the last Office action will continue to run.
  - In an application not under appeal, the improper RCE will be treated as a reply under § 1.116.
  - If the RCE is filed after allowance, but before the payment of the issue fee, the improper RCE will not toll the time period for paying the issue fee. If the time period expires, the application is abandoned.
  - If the RCE is filed after appeal, the improper RCE will be treated as a request to withdraw the appeal.
Proposed Changes to RCE Practice
37 CFR 1.114(f)

- **Effective Date:** The proposed changes to § 1.114 (if adopted) would be applicable to any application in which an RCE is filed on or after the effective date of the final rule.
  - Applicant must include a petition and the showing in compliance with proposed § 1.114(f) for any RCE filed on or after the effective date of the final rule:
    - In an application in which an RCE has previously been filed; or
    - In a continuing application other than a divisional application in compliance with proposed § 1.78(d)(1)(ii).
Proposed Changes to RCE Practice
37 CFR 1.114(f)

Example 9: Second RCE filing situation

#1
Nonprovisional Application

#2
An RCE or Continuation or CIP Application claiming the benefit of Application #1

Effective Date

#3
Applicant may not file a second RCE in Application #1, or an RCE in Application #2, unless the RCE includes a petition and a showing in compliance with §1.114(f)
Proposed Changes to 37 CFR 1.78(f)

Identification of Certain Related Applications And Rebuttable Presumption of Double Patenting
Proposed Changes to 37 CFR 1.78(f)(1)

Identification Requirement in proposed § 1.78(f)(1):

Identification of other pending or patented nonprovisional application(s) would be required if a nonprovisional application and the other pending application(s) or patent(s) have:

- the same effective filing date, or the effective filing dates are within 2 months,
- a common inventor, and
- a common assignee (or subject to an obligation of assignment to the same person).

The identification of the nonprovisional application must also be made in the other application(s) or patent(s).
Proposed Changes to 37 CFR 1.78(f)(1)

How must such applications or patents be identified:

- The other pending or patented applications must be identified by application number and patent number (if applicable) located in:
  - the specification in the paragraph containing cross-reference to applications for which a benefit is not claimed (see proposed § 1.78(d)(6)); or
  - a separate paper.
Proposed Changes to 37 CFR 1.78(f)(1)

When must such applications be identified:

- The identification required by proposed § 1.78(f)(1) must be submitted within 4 months from:
  - The actual filing date of a nonprovisional application filed under 35 USC 111(a), or
  - The date on which the national stage commenced under 35 USC 371(b) or (f) in an international application.
Proposed changes to § 1.78(f)(2)  

Rebuttal Presumption of Double Patenting

A rebuttable presumption shall be established that certain applications (in typical double patenting situations) contain patentably indistinct claims with other applications or patents.

Which applications will receive such a rebuttable presumption of double patenting? Applications that have:

1) Same effective filing date;
2) A common inventor;
3) Same assignee (or subject to an assignment to the same person); and
4) Substantially overlapping disclosures.
Proposed changes to § 1.78(f)(2)

Rebuttal Presumption of Double Patenting

If applicant receives an Office action with a rebuttable presumption of double patenting, applicant must:

- **Cancel** claims so only patentably distinct claims remain; or
- **Rebut** the presumption by satisfactorily explaining how the pending applications contain only patentably distinct claims; or
- Submit terminal disclaimers, and satisfactorily explain why two or more pending applications with “conflicting” or patentably indistinct claims should be maintained (assuming only obviousness double patenting applies).
Proposed Changes to 37 CFR 1.78(f)(3)

Double Patenting

The Office may require elimination of the patentably indistinct claims from all but one of the applications*:

- In the absence of good and sufficient reason for there being multiple pending nonprovisional applications* which contain patentably indistinct claims, and

- Even if terminal disclaimers are submitted to overcome the presumption of patentably indistinct claims.

*Naming at least one inventor in common and owned by the same person, or subject to an obligation of assignment to the same person.
Proposed Changes to 37 CFR 1.78(h)

Effect of Joint Research Agreements

§ 1.78(h) provides that if an application discloses or is amended to disclose the names of parties to a joint research agreement (JRA) (as defined by 35 USC 103(c)(2)(C)), the parties to the JRA are considered to be the same person (or commonly owned) for purposes of § 1.78.

- For example, the requirements of proposed § 1.78(f) would apply to applications which have invoked the prior art exclusion under 35 USC 103(c) based on a JRA.
- Parties to a JRA are treated as common owners for purposes of 35 USC 103(c) by virtue of the CREATE Act (Public Law 108-453, enacted Dec. 10, 2004).
Changes to 37 CFR 1.495

Submission to Enter the National Stage in the United States of America
Proposed Changes to 37 CFR 1.495(g)

Entering the National Stage

- If the documents and fees contain conflicting indications as between an application under 35 USC 111 and a submission to enter the national stage under 35 USC 371, the documents and fees will be treated as a submission to enter the national stage under 35 USC 371.

- It is Office experience that, in the majority of cases, documents and fees that contain such conflicting indications were intended as a submission under 35 USC 371.
Public Comments

Public Comments on this proposed rulemaking must be received on or before **May 3, 2006.**

Comments can be sent to or via:

- AB93Comments@USPTO.gov
- Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
  - Please include a DOS formatted 3.5 inch disk accompanied by a paper copy of the comments
- Facsimile to (571) 273-7735
- Federal eRulemaking Portal at www.regulations.gov

Because comments will be made available for public inspection, information that is not desired to be made public should not be included.
More Information

- Additional information is posted on the USPTO’s Internet Web at: http://www.uspto.gov
- For more information, please contact the Office of Patent Legal Administration at (571) 272-7701 or e-mail to PatentPractice@USPTO.gov, or contact one of the following:
  - Joni Chang 571-272-7720
  - Jeanne Clark 571-272-7714
  - Anton Fetting 571-272-7717
  - Eugenia Jones 571-272-7727
  - Fred Silverberg 571-272-7719
Appendix – Proposed Rules
37 CFR 1.78(a)

§ 1.78(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) 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.

(3) 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 the prior-filed application, but were subject to a requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121 and not elected for examination 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.
§ 1.78(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 this paragraph.

(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 an inventor at least one inventor named in the later-filed application, must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must be paid within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). 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.
§ 1.78(b) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.

(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. These time periods are not extendable. Except as provided in paragraph (c) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of such 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

Appendix – Proposed Rules

37 CFR 1.78(b) – continued

§ 1.78(b) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.

(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, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing in the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an amendment or Supplemental Application Data Sheet withdrawing the benefit claim, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.
§ 1.78(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.
Appendix – Proposed Rules
37 CFR 1.78(d)(1)

§ 1.78(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 this paragraph.

(1) A nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must satisfy at least one of the following conditions:

(i) The nonprovisional application is either a continuation application as defined in paragraph (a)(2) 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 only a single prior-filed application, the benefit of such prior-filed application not being claimed in any other nonprovisional application other than a divisional application in compliance with paragraph (d)(1)(ii) of this section, and no request for continued examination under § 1.114 has been filed in the prior-filed application.
§ 1.78(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

(ii) The nonprovisional application is a divisional 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 only a single prior-filed application, the prior-filed application was subject to a requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121, and the divisional application contains only claims directed to an invention or inventions that were identified in such requirement of unity of invention or requirement for restriction but were not elected for examination in the prior-filed application.

(iii) The nonprovisional application is either a continuation application as defined in paragraph (a)(2) 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 only a single divisional application in compliance with paragraph (d)(1)(ii) of this section and the single prior-filed application whose benefit is claimed in such divisional application, and no request for continued examination under § 1.114 has been filed in such prior-filed divisional application.
Appendix – Proposed Rules
37 CFR 1.78(d)(1) - continued

§ 1.78(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

(iv) 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, which continuing 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. The nonprovisional application must have filed therein a petition accompanied by the fee set forth in § 1.17(f) and a showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted during the prosecution of the prior-filed application. If the later-filed 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 later-filed continuing application, and if the later-filed 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 later-filed international application.
Appendix – Proposed Rules

37 CFR 1.78(d)(2)

§ 1.78(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

(2) Each prior-filed application must name as an inventor at least one inventor named in the later-filed application and must be either an international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America, or 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) and have paid therein the basic filing fee set forth in § 1.16 within the pendency of the application.
§ 1.78(d) **Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.**

(3) Except for a continued prosecution application application filed under § 1.53(d), any nonprovisional application, or international application designating the United States of America, claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and identifying 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 which claim or claims in the continuation-in-part application are 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. The Office will refuse to enter, or will delete if present, any specific reference to a prior-filed application that is not permitted by paragraph (d)(1) of this section. The entry of or failure to delete a specific reference to a prior-filed application that is not permitted by paragraph (d)(1) of this section does not constitute a waiver of the provisions of paragraph (d)(1) of this section.
Appendix – Proposed Rules

37 CFR 1.78(d)(4)

§ 1.78(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

(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. These time periods are not extendable. Except as provided in paragraph (e) of this section, the 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 such 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
Appendix – Proposed Rules
37 CFR 1.78(d)(5) & (6)

§ 1.78(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application.

(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 (see § 1.14). Cross-references to applications for which a benefit is not claimed under title 35, United States Code, must be located in a separate paragraph from the references required by 35 U.S.C. 119(e) or 120 and this section to applications for which a benefit is claimed under 35 U.S.C. 119(e), 120, 121, or 365(c).
§ 1.78(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 will not be granted in an application in which a request for continued examination under § 1.114 has been filed. 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.
§ 1.78(f) Applications and patents naming at least one inventor in common.

(1) If a nonprovisional application has a filing date that is the same as or within two months of the filing date of one or more other pending or patented nonprovisional applications, taking into account any filing date for which a benefit is sought under title 35, United States Code, names at least one inventor in common with the one or more other nonprovisional applications, and is owned by the same person, or subject to an obligation of assignment to the same person, as the one or more other nonprovisional applications, the applicant must identify each such other application by application number (i.e., series code and serial number) and patent number (if applicable). The identification of such one or more other nonprovisional applications if required by this paragraph must be submitted within four months from the actual filing date of a nonprovisional application filed under 35 U.S.C. 111(a), or within four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371.
Appendix – Proposed Rules

37 CFR 1.78(f)(2)

§ 1.78(f) Applications and patents naming at least one inventor in common.

(2) If a nonprovisional application has the same filing date as the filing date of one or more other pending or patented nonprovisional applications, taking into account any filing date for which a benefit is sought under title 35, United States Code, names at least one inventor in common with the one or more other pending or patented nonprovisional applications, is owned by the same person, or subject to an obligation of assignment to the same person, and contains substantial overlapping disclosure as the one or more other pending or patented nonprovisional applications, a rebuttable presumption shall exist that the nonprovisional application contains at least one claim that is not patentably distinct from at least one of the claims in the one or more other pending or patented nonprovisional applications. In this situation, the applicant in the nonprovisional application must either:

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

(ii) 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 to the satisfaction of the Director 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.
Appendix – Proposed Rules

37 CFR 1.78(f)(3)

§ 1.78(f) Applications and patents naming at least one inventor in common.

(3) In the absence of good and sufficient reason for there being 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, the Office may require elimination of the patentably indistinct claims from all but one of the applications.
Appendix – Proposed Rules

37 CFR 1.78(g)

§ 1.78(g) Applications or patents under reexamination naming different inventors and containing patentably indistinct claims.

If an application or a patent under reexamination and at least one other application naming different inventors 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, the Office may require the assignee to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor.
§ 1.78(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 (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 under 35 U.S.C. 103(c)(2)(C), the identification of such one or more other nonprovisional applications as required by paragraph (f)(1) of this section must be submitted with the amendment under 35 U.S.C. 103(c)(2)(C) unless such identification is or has been submitted within the four-month period specified in paragraph (f)(1) of this section.
§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may, subject to the conditions of this section, file a request for continued examination of the application by filing a submission and the fee set forth in §1.17(e) prior to the earliest of:

* * * * *

(f) An applicant may not file more than a single request for continued examination under this section in any application, and may not file any request for continued examination under this section in any continuing application (§1.78(a)(1)) other than a divisional application in compliance with §1.78(d)(1)(ii), unless the request for continued examination also includes a petition accompanied by the fee set forth in §1.17(f) and a showing to the satisfaction of the Director that the amendment, argument, or evidence could not have been submitted prior to the close of prosecution in the application. Any other proffer of a request for continued examination in an application not on appeal will be treated as a submission under §1.116. Any other proffer of a request for continued examination in an application on appeal will be treated only as a request to withdraw the appeal.
§ 1.495 Entering the national stage in the United States of America.

(g) The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371. If the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.