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4. TYPES, CROSS-NOTING AND STATUS OF APPLICATIONS

4-1 Types of Application

Patent applications fall into three broad types, viz., applications for "mechanical," design, and plant patents. The term "mechanical," as here employed, embraces all applications and patents which are directed to a "new and useful art, machine, manufacture, or composition of matter, or to any new and useful improvement thereof." The specialized procedure which pertains to the examination of applications for design and plant patents will be treated in detail in sections 17 and 18 respectively.

4-1-1. Joint

A joint application is one which sets forth two or more persons as the common inventors of the claimed subject matter.

4-1-2. Sole

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

4-1-3. Convertability from a Joint to A Sole Application

A sole application may be substituted for a joint application, or the joint application amended to a sole application on the filing of the proper disclaimer by the surrendering joint applicant and oath by sole inventor. See *In re Roberts*, 1920 C.D. 158; 273 O.G. 410. Where such change is made the file should be sent to the Application Branch for revision of the record.

The conversion of a sole into a joint application is not permitted. *Ex parte Benes*, 1925 C.D. 75, 339 O.G. 499.

When a joint application in interference is changed to a sole application, the Examiner of Interferences calls the attention of the Primary Examiner to this fact. The Primary Examiner requests jurisdiction of the interference, enters the necessary amendments made to the application, redeclares the interference to accord therewith and returns the files to the examiner of interferences. (For letter forms, see sec. 13). However, before redeclaring the interference, the examiner should make certain that the proposed conversion from joint to sole meets the conditions set forth in *In re Ferrin*, 1944 C. D. 330, 565 O. G. 151.

When on motion a sole application is to be substituted for a joint application the primary examiner redeclares the interference, substituting the sole for the joint application. (For letter forms, see Sec. 13).

4-1-4. Original or Parent

These terms are interchangeably applied to the first application of an inventor disclosing a given invention. Such invention may or may not be claimed in this application.

CONTINUING APPLICATIONS

4-1-5. Reissue

A reissue application is an application for a patent to take the place of an unexpired patent that is defective in some one or more particulars.

A detailed treatment of reissues will be found in Section 16.

4-1-6. Divisional

A later application carved out of a pending application by the same applicant and showing and claiming nothing not disclosed in the earlier or parent application is known as a divisional application. Sometimes, as in the case of a process application divided from an apparatus application, the divisional application may have the same specification and drawing as the parent case. Where both applications are for apparatus inventions, there is usually no necessity or excuse for reproducing in the divisional case the entire specification and drawing of the parent application.

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

A divisional application is also referred to as a "division" of the parent case.

4-1-7. Continuation

A continuation is a second application for the same invention claimed in a prior application by the same applicant filed before the original becomes abandoned. Where an application has been prosecuted

to a final rejection an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner. If the new claims, however, are in the opinion of the Examiner met in the art of record in the original application, the Examiner may make his rejection final on the first action on the continuation. (Sec. 10-8-48). If rejection is based on res adjudicata, however, it may not be made final, since this is a new issue.

A continuation, as is also true of a continuation-in-part and a divisional application, may be filed after appeal to the Board or to the Court, provided the parent application has not become abandoned, (Sec. 10-11-19). A continuation or continuation-in-part may be filed after the application has gone to issue (In re Febrey, 1943 C. D. 510; 554 O.G. 377) and this holds for the three months' period where the final fee is paid on the last day of the six months and a three months' extension is asked.

A sole application may be a continuation of a joint application which was erroneously jointly filed. (Union Switch, v. Kodol, 1932 C.D. 530, 416 O.G. 3).

See conditions stated under "Divisional," supra.

4-1-8

Continuation-in Part

This is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application, and adding matter not disclosed in the said earlier case. (In re Klein, 1950 C.D. 2 393 O.G. 519).

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated hereinafter in the case of a sole divisional application stemming from a joint application, (4-1-12) and the further condition that the applicant present an exact line of division between matters of joint invention and sole invention. (In re Perrin, 1944 C.D. 330, 565 O.G. 151.)

4-1-9.

Substitute

The use of the term "Substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case, finds official recognition in the decision, Ex parte Komenak, 1940 - C.D. 512 O.G. 739.

A substitute is not entitled to the benefit of the filing date of the original application for a constructive reduction to practice. (In re Spitteler et al., 1908 C.D. 374; 134 O.G., 1301.

At most, such filing date can be availed of only as the date of conception, leaving the question of diligence to be determined as bridging any gap between the date of a reference and the filing date of the substitute application.

Any public use or patent or printed publication prior to the filing date of the substitute even though junior to the earlier application, if it discloses the subject matter of the claims, is a proper citation in the substitute application.

4-1-10.

Re-file

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

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

4-1-11.

TABLE ILLUSTRATING CONTINUITY BETWEEN APPLICATIONS

| | Co-pending | Not Co-pending |
|--|-------------------------|-------------------|
| <u>LESS</u> disclosure in second case | Division | |
| <u>SAME</u> disclosure in second case | Continuation | Substitute |
| <u>MORE</u> disclosure in second case | Continuation in-part | |

All applications which come under the designations listed in the center column of the table are linked by co-pendency with the original or parent application; they also contain, in whole or in part, disclosure in common with the original application. Such applications are entitled to the effective filing date of the original application for the common subject matter disclosed.

A substitute application, as seen from the table, is not linked by co-pendency with the original application, and is not entitled to the effective filing date of the latter. As a matter of public policy, however, all substitute applications are required to include a reference to the original application, one reason being to make the original application accessible to the public for a fuller understanding of the basis for the allowance of claims in the substitute application.

It will be noted that two blank spaces occur in the table. Applications of the kind which would correspond to these blank spaces are not distinguished by any special name. No special treatment is involved in examining such applications.

4-1-11.1. Assignment Carries Title

Assignment of an original application carries title to any divisional, continuation, or substitute application stemming from the original application.

4-1-12. When Entitled to Filing Date

Inasmuch as a division, a continuation or a continuation-in-part is construed as an amendment of the parent application and therefore given the benefit of the filing date of said parent application, such division, continuation, or continuation-in-part may be filed at any time during the pendency of the appeal (that is, prior to or not later than withdrawal of the appeal) and be entitled to the benefit of the filing date of the parent application, provided six months have not elapsed from the date of the final rejection. Sec. 10-11-19.

Since a joint application may, when the facts warrant it, be transformed into a sole application, a sole application may be a division of a joint application may be a division if the joint application contained and claimed an invention which was solely that of one of the joint applicants.

However, the following conditions must obtain:

(a) The invention must have been claimed in the joint application.

(b) It must appear that the joint application was filed "by mistake and without fraudulent intention."

(c) On discovery of the mistake the party filing the sole application "must act with reasonable diligence" and must assume the burden of establishing his good faith."

(d) There must be filed in the sole application a disclaimer by each of the other parties of the joint application.

A later joint application, however, may not be termed a division of a prior application filed by one of the joint inventors. This follows from the doctrine of ex parte Bones, 1925 C.D. 75; 399 O.G. 499.

4-1-13. International Convention

Sec. 4887. R.S. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign

country, unless the application for said foreign patent was filed more than twelve months prior to the filing of the application in this country in which a patent shall be granted in this country.

An application for patent for an invention or discovery...filed in this country by any person who has previously regularly filed an application for a patent for the same invention or discovery, in a foreign country, which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention or discovery...was first filed in such foreign country, provided the application in this country is filed within twelve months...from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery...which had been patented or described in a printed publication in this country, or which had been in public use or on sale in this country for more than one year prior to such filing.

In the case of designs, the period is six months instead of twelve.

The first paragraph of R.S. 4887 establishes four conditions which, if all are present, establish a bar against the granting of a patent in this country. These four conditions are as follows:

- (1) The foreign application must be filed more than one year before the filing in the United States. (Modified by Public Law 690, Sec. 4-1-15.)
- (2) It must be filed by the inventor or someone "entitled" to him.
- (3) The foreign patent must be actually granted (e.g., by sealing of the papers in Great Britain.)
- (4) The same invention must be involved.

The second paragraph of the statute accords what is known as a "right of priority" to applicant under certain conditions, which conditions are defined by an international treaty or agreement known as the International Convention for the Protection of Industrial Property. There are now forty countries, including the United States, adhering to this convention.

The primary object of the convention is stated to be the equal treatment of nationals of all participating countries. In pursuance of this policy, a filing of an application in any country which adheres to the Convention is treated as having the legal, or constructive, effect of a filing in all countries, provided it is followed up, within twelve months, by an actual filing there.

The inventor's priority rights under the Convention are based, not upon his citizenship, but upon the status of the country, in which the earliest foreign filing was made, as a party to the International Convention.

4-1-14. Proving of Foreign Filing
 "Normal" Priority

Rule 9.1 Oath of Applicant

If any application for patent has been filed in any foreign country by the applicant in this country, or by his legal representatives or assigns, prior to his application in this country, he shall state the country or countries in which such application has been filed, giving the date of such application, and shall also state that no application has been filed in any other country or countries than those mentioned, and if no application for patent has been filed in any foreign country, he shall so state. This oath must be subscribed to by the affiant.

No proof of the earlier filing is required, unless a reference is brought to light which has an effective date earlier than applicant's United States filing date but later than the date of his foreign filing under the convention. Where the applicant acknowledges in his oath a first filed foreign application less than twelve months prior to his U.S. filing date, but antedating the reference, such foreign application will serve to void the reference if a certified copy of the foreign application is filed, together with a sworn translation if the copy be not in English.

4-1-14.1. Examiner's Determination of
 Right of Priority

The most important aspect of the examiner's

action pertaining to a right of priority because of a foreign filing is the determination of the identity of invention between the U.S. application. If it is for the same invention, the foreign application may be considered in the same manner that a duplicate U.S. application, filed on the same date, would be considered, and applicant is entitled to any claims based on such application that he would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the description under R.S. 4888, as well as to determine if there is a basis for the claims sought. In some cases the matter of sufficiency of disclosure in the sense of having a sufficient basis for certain types of claims, as in chemical cases, may arise.

In applications filed from Great Britain there may be submitted a certified copy of the British "provisional specification", which may also in some cases be accompanied by a copy of the "complete specification". The nature and function of the British provisional specification is described in an article in the Journal of the Patent Office Society, for November 1936, pages 770-774. According to British law the provisional specification does not need to contain a complete disclosure of the invention in the sense of R.S. 4888, but need only describe the general nature of the invention and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important.

If it is found that the British provisional specification is insufficient, for lack of disclosure or other reason, reliance may then be had on the complete specification if one has been presented, the latter being treated as a different application.

It may occasionally happen that the U.S. application will be found entitled to the filing date of the foreign application with respect to some claims and not with respect to others. In such a case the examiner's letter will state that the applicant is considered entitled to the foreign date with respect to certain named claims and is not entitled with respect to other claims, with the reasons for the latter statement being given.

Occasionally, an applicant may rely on two

different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to the other in respect to other claims. In such a case, the Examiner's letter will specify the claims relating to each of the applications.

4-1-15. Public Law 690

Public Law 690 was enacted for the purpose of restoring, to a certain extent, the loss of priority rights which occurred as a result of war conditions. This act extends, if certain conditions are met, the twelve months period (six months in the case of designs) provided in the second paragraph of Sec. 4007 R.S. In addition to all other legal requirements, the citizenship of the inventor becomes material; that is, he must either be a citizen of the United States or a citizen of a country which grants reciprocal privileges to citizens of the United States. The decision as to the inclusion of a given country is determined by the Commissioner of Patents after consultation with the State Department, and notices are published from time to time in the Official Gazette listing countries which have been added. The list, to date, is as follows:

4-1-15.1. Time Limits For
Obtaining Benefit of Law

The extreme limit of the benefit of Public Law 690 (as extended by Public Law 220) applies to cases filed abroad after Sept. 8, 1938, and in this country on or before Feb. 29, 1948. Sec. 4-1-15.2 for shorter periods in some cases. Request for priority, under the Act may be filed at any time during the pendency of the U.S. application.

Although Feb. 29, 1948 fell on a Sunday, the Patent Office has ruled that applications filed on the next following day, i.e., March 1, 1948, are not entitled to the priority benefits of the Act.

4-1-15.2.

Countries Granting
Reciprocity

| <u>COUNTRY</u> | <u>Time limit for filing applications in United States</u> |
|-----------------------|--|
| Austria | February 29, 1948 |
| Belgium | February 29, 1948 |
| Brazil | December 31, 1946 |
| Bulgaria | February 29, 1948 |
| Canada | November 15, 1947 |
| Czechoslovakia | February 29, 1948 |
| Denmark | February 29, 1948 |
| Finland | February 29, 1948 |
| France | February 29, 1948 (1) |
| Great Britain | February 29, 1948 |
| Holland | December 31, 1947 (2) |
| Hungary | February 29, 1948 |
| Italy | February 29, 1948 |
| Ireland | February 29, 1948 |
| Luxembourg | February 29, 1948 |
| New Zealand | February 29, 1948 |
| Norway | December 31, 1947 |
| Palestine | February 29, 1948 |
| Poland | February 29, 1948 |
| Roumania | February 29, 1948 |
| Spain | February 29, 1948 |
| Sweden | February 29, 1948 |
| Switzerland | February 29, 1948 |
| Union of South Africa | February 29, 1948 |

(1) The supplementary agreement extending date to February 29, 1948 (605 O.G. 20) came into force February 27, 1948.

(2) The date is February 29, 1948 in the case of section 3 of Public Law 690.

4-1-15.4 Allegation as to Citizenship
in Reciprocating Country

An allegation as to citizenship in a country granting reciprocal privileges is sufficient. Proof is not required unless there is some inconsistency.

4-1-15.5. Proof of The Contents
Of Foreign Application

In addition to citizenship, other conditions are imposed. As contrasted with the procedure in the normal right of priority, proof of the contents of the foreign application must be advanced by the applicant.

4-1-15.6. Effect on Term of Patent

Section 10 of Public Law 690 provides for the shortening of the term of the United States patent so that it will expire twenty years from the filing date of the earliest application in any country. In any of these cases where the priority date may be different for different claims, the term of the patent as a whole will be determined by the earliest foreign application, since section 10 reads: "twenty years from the filing date of the first application" and the Patent Office will not specify different terms for different claims in the same patent.

4-1-15.7. When no Papers
Have Been Filed

The Act specifically requires the applicant to request the applicant to request the extended period of priority and to supply certain papers. Until and unless the required material is furnished, examiners will act on applications in the usual way, that is, they will cite and use whatever references and grounds of rejection may be applicable, considering the actual filing date of the application in the United States as the only date to which it is entitled. However, if it appears that the applicant is attempting or intends to obtain the extended period of priority but is unaware of the conditions, his attention may be called to such conditions.

In some cases there may be a statement that the applicant relies on a foreign filing date. The Examiner should mention in his action that no reliance can be placed on the foreign filing date until and unless the requirements of Section 1 are met.

4-1-15.8. Filing of Papers Does Not
Excuse A Reply to An Action

While the papers may be filed during the pendency of the application, applicants are not relieved from the necessity of replying to Office actions within the statutory time limit and of making as complete

a response as is ordinarily required.

4-1-15.9.

Requirements
of the Statute

The statute requires of those who wish the extended period of priority under Section 1 the following:

- (a) A request in writing;
- (b) A copy of the original foreign application, certified to by the country in which filed;
- (c) A sworn translation thereof if not in the English language;
- (d) An affidavit by the inventor in certain cases.

4-1-15.9.

The Request in Writing

The written request for the extended period of priority need not be a formal paper signed by the inventor. It may be contained in the letter of the attorney transmitting the papers or in some other letter and no specific form is necessary. It must appear definitely and without implication that the applicant is seeking the benefit of Section 1 of the Act, and preferably should specify the foreign application and date, the benefit of whose filing date is requested.

4-1-15.9(b). Certified Copy of Foreign
Application

The foreign application must be a copy of the foreign application as filed and the certificate by the foreign patent office must make this evident, as has been customary. In some instances a printed copy of the patent as issued may be used. This is not sufficient unless the certificate indicates that it is a true copy of the application. In French cases, the printed patent is practically always a duplicate of the application as filed since substantial amendments are not permitted. Most countries, however, permit amendment of the application and hence a copy of the patent is not proof of the application as filed.

Section 1 also permits other evidence relating to the original application if the original foreign application has been destroyed. The only "other evidence" which has been considered is a certified copy. For example, a copy of a German application certified by the German Patent Office in the proper manner may

have been filed in the Swiss or Dutch Patent Office. A copy of these papers, certified to by the Patent Office of Switzerland or Holland as being a true copy of the papers there filed, has been accepted in appropriate cases. Cases in which "other evidence" is offered should be referred to the Supervisory Examiners for consideration.

4-1-15.9(c). Sworn Translation

A sworn translation of the foreign application is not in the English language is also required. This means a translation which is sworn to and not a translation made by a so-called "sworn translator", which phrase is used in some countries. Oaths taken in foreign countries for use in this country need to be authenticated by a diplomatic officer of the United States if not taken before such officer.

4-1-15.9(d). Affidavit of Inventor

The statute further requires:

"If the foreign application was not made by the inventor himself, an affidavit by the applicant (in the U.S.) or patentee (in the U.S.) stating that such application was filed for his (the inventor's) benefit or on his behalf and that such procedure is in accordance with the procedure in the foreign country." (Parenthetical matter added.)

The purpose of this requirement is to take care of the situation in which the foreign application was not filed by the inventor but by an agent or representative as is permitted in some countries. In such cases the inventor, who is the applicant here, must make the required affidavit.

Cases also arise in which the foreign application was made by the assignee of the inventor. The affidavit, by the inventor, is likewise required in such cases; the phrase "for his benefit or on his behalf" then meaning that the application was filed by the assignee in place of the inventor as permitted by the law of the country.

If the United States patent has issued to the assignee, the language of the statute would permit this affidavit to be taken by such assignee.

In some instances the foreign application may have been filed jointly by the inventor and the assignee as joint applicants as is permitted in

some countries. An affidavit will not be required in these cases; the word "himself" is not taken to mean "alone". If the relationship of the foreign applicants is not evident, an explanation may be required.

4-1-15.10.

Examiner Must Determine
Right To Rely On Foreign
Patent

Even when determination of the right to rely on the foreign application may not be necessary for the purpose of overcoming a reference, such determination is required in each instance where Applicant includes papers pertaining to Public Law 690, because by Section 10 of the Act the term of the patent is to be appropriately adjusted, Section 4-1-15.6. If the determination is not needed to overcome a reference, it need not be done until the case is ready for issue or all the claims are allowed.

4-1-15.11(a).

Action by the Examiner

When papers are received in an application pending before the examiner (including those applications awaiting action by the applicant) such papers are to be entered in the file and are to be considered by the examiner at the time of the next regular action. No acknowledgement need be made at the time of receipt and if, for any reason, acknowledgement is found to be necessary it should not count as an action in the case. When the case comes up for regular action the examiner should examine the papers for formal compliance with the requirements.

In the case of applications filed by citizens of countries with respect to which reciprocity has not yet been announced, the applicant should be informed that the matter of the right of priority is held in abeyance.

Until the case is ready for issue or all the claims allowed (ex parte Quayle 1935 C.D. 11 453 O.G. 213), the Examiner need not determine whether the foreign application is for the "same invention" as applied for in the United States unless any statutory bar or pertinent reference is found which would be eliminated by the priority date. If any such

statutory bar or reference is found, a complete action on the right of priority as to all the claims should be given.

If the application is placed in condition for allowance having once been given the benefit of the priority date and all claims still relate to the "same invention," it may be passed to issue by the examiner without again referring it to the Supervisory Examiners for approval.

4 - 1-15.11(b). Examiner's Letter

The next regular Office letter, following filing of the papers, should include a statement with reference to the papers under Public Law 690 and said statement should appear at the beginning of the letter. Where the papers do not meet the formal requirements the particular deficiencies should be noted. In those cases where the formal requirements are satisfied but no ruling is made on the question of "same invention," the following form is suggested:

FORM Receipt is acknowledged of papers on _____, 194__, under Section 1 of Public Law 690. These papers have been placed of record in the file as complying with the formal requirements of the Act. Determination of whether the claims herein are for the same invention as that disclosed in the foreign application is not made at this time.

4-1-15.11 (c). Date Refused

In those cases where a ruling on the matter of priority is made and the date is refused, the reasons should be stated. Where the applicant is found to be entitled to the foreign filing date, a statement should be incorporated in the letter that the applicant is entitled to the filing date of a particular foreign application for all or certain specified claims. A form for such statement could be as follows:

Applicant having complied with the provisions of Section 1, Public Law 690, ap-

FORM

proved August 8, 1946, this application is considered entitled to a priority date corresponding to the filing date of the application, filed in _____ on _____, as to claims _____.

The letter when written should be submitted to the Supervisory Examiners for review. If the letter is approved and the applicant is entitled to the benefits of the Act, an identifying label will be attached to the face of the file by the secretary to the Supervisory Examiners who will also maintain a card index of all cases with a note of the action taken.

In those cases where a ruling on the right of priority is not made until the case is ready for issue or all the claims allowed, the examiner should at that time state whether or not the applicant is entitled to the priority date. If the date is refused, the reasons for so holding should be stated. If granted, a statement such as that embraced in the suggested form set forth in the immediately preceding paragraph should be employed.

4-1-15.11(d). Allowed Applications

If an application is in issue when the papers are received, the examiner should, if the final fee has not been paid, borrow the file from the Issue Division and treat it in the same manner as a pending case, writing a letter and referring it to the Supervisory Examiners for approval as above. If the final fee has been paid the examiner should, if there is time, examine the papers promptly and write a letter in the same manner. Deferment of the issue of the patent may be requested if it is still possible. If the papers are received too late to take any of the above actions, they should be referred to the Supervisory Examiners.

4-1-15.12. Applications on Appeal

If papers are filed after an appeal is taken, appropriate action may be taken by the examiner if the examiner's statement has

not been written, and any rejection withdrawn or the appeal forwarded as may be appropriate. If the examiner's statement has been mailed the application will be **re-manded** by the Board for consideration of the papers.

4-1-15.13. Applications In Interference

If the papers are received while an application is involved in interference, they are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken **after the termination** of the interference.

If the papers are to be relied on for proof of priority in any interference, the party must act in the interference in accordance with interference rules and is subject to whatever rules relating to motions, notices, production of testimony, etc., may be applicable.

4-1-14. Application Oath

When the extended priority date is granted, certain informalities or variations in the customary application oath may be permitted. The date of execution of the oath may become immaterial and variations as to the allegation of one year public use, etc., corresponding to the last paragraph of Section 1 of Public Law 690 may be encountered. An oath such as follows, as well as the customary oath, would ordinarily be acceptable:

_____, the above petitioner, being duly sworn, deposes and says that he is a citizen of _____ and a resident of _____, that he verily believes himself to be the original, first and sole inventor of the improvement in _____ described _____ and claimed in the annexed specification; that he does not know and does not believe that said invention was ever known or used before his invention or discovery thereof, or patented or described

FORM

in any printed publication in any country before his invention or discovery thereof, or prior to the filing of the application in (specify country) upon which the right of priority of the present application is based, or in public use or on sale in the United States prior to the filing of said application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns and that no application for patent on said invention has been filed by him or his representatives or assigns in any country foreign to the United States, except as follows: (List all foreign applications and patents)

4-1-15.15.

Submission of Cases
to Supervisory Examiner

Applications wherein action is taken on a request for the benefits of section 1 of Public Law 698 should not be submitted to the Supervisory Examiner for review of the priority papers unless and until said benefits are given.

If the application is placed in condition for allowance, having once been given the benefit of the priority date and all the claims still relate to the "same invention", it may be passed to issue by the Examiner without again referring it to the Supervisory Examiners for approval.

4-1-16.

Fee-exempt, Government Owned

These terms, as well as "Act of 1883 application", apply to applications for which no fee is required, according to the provisions of the Act of March 3, 1883, as amended. Sec. 8-8 and 8-8-1.

4-2.

Cross - Noting

4-2-1.

In Specification

When an application is filed which in the opinion of the Examiner is a division of, a continuation of, a continuation-in-part of, or a substitute for a previously filed application, but which contains no reference in the specification to such prior application, the Examiner will require applicant to insert the proper reference to the prior application in the specification. If, when the case is otherwise in condition for allowance, this requirement has not been complied with, nor shown to have been improperly made, the proper reference to the prior application will be made by an Examiner's amendment, and the application passed to issue forthwith.

4-2-2.

Notation as to Parent Application on Jacket and in File of a Divisional, Continuation, Continuation-in-part, or Substitute Application

The identifying data of a parent or prior application must be given in the specification and on the left margin of the jacket under "Division of Application No.", in the case of a DIVISION, a CONTINUATION, or a SUBSTITUTE application, and in the specification only, in the case of a continuation-in-part. In the case of a continuation-in-part, the letters C.P. will be stamped on the outside of the file jacket at the bottom thereof.

4-2-3.

On File Wrapper When Foreign Application is Acknowledged

Where applicant acknowledges a prior foreign application, the country where filed and the date of filing are noted at the bottom of the face of the file wrapper. Where there are two or more such earlier foreign applications, only the earliest filed on those is noted, except that all foreign applications filed more than twelve months prior to the U.S. application must be noted on the file wrapper.

4-2-4.

Foreign Patent Granted
After Date of Specification

An applicant will not be required in any case to file a statement setting forth the date of any foreign patent granted him, or to others with his knowledge or consent between the date of execution of his specification and the date of the payment of the final fee.

4-2-5.

In Oath

As will be noted by reference to 4-1-14, Rule 9.1 requires that the oath include a list of the foreign countries in which applications have been filed by the applicant in this country, or by his legal representatives. If no applications for patent have been filed in any foreign country, the oath should so state.

4-2-6.

In Case of Reissues

Rule 22.9 requires that a notice be placed in the file of an original patent for which an application for reissue has been filed. For the form employed for this notice see Clerk's Manual, Sec. 50.

4-2-7.

Notice of Filing of Application
Claiming Matter Disclosed
But not Claimed in Patent

When, after obtaining a patent, the patentee files an application claiming subject matter disclosed but not claimed in his patent, he is required to place a notice in the file of the patent, as soon as the application has received a Serial Number, to the effect that such an application has been filed and to identify the application in the notice by its Serial Number and filing date. He is also required to identify in his application the patent in which the subject matter now claimed is disclosed. (Order 5200)

4-2-8.

Derogatory Remarks Prohibited

Applicant may refer to the general state of the art and the advance thereover made by his invention, but he is not permitted to make derogatory remarks concerning the inventions of others or to designate them by name unless to state that he desires to improve on

the disclosure in a prior patent or application of common ownership or that he makes no claim to the disclosure in a certain application, also of the same ownership.

4-2-9. Data of Applications Referred to
Must be Brought up to Date

Where a copending application is referred to in the specification, the examiner should ascertain whether said copending application has matured into a patent and if so, insert by examiner's amendment the number and date of the patent.

4-3. Status of Applications

4-3-1. New

A "new" application is one that has not yet received an action by the examiner.

4-3-2. Amended

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

4-3-4. Allowed or Issue

An allowed or issue application is one which, having been examined, is passed for issue as a patent on payment of the final fee. Its status as an "allowed" case continues from the date of allowance unless it is withdrawn from issue or the final fee is paid and it issues as a patent.

The files of allowed cases are kept in the Issue and Gazette Branch, arranged in the order of dates of allowance.

4-3-5. Abandoned

An abandoned application is, inter alia, one which is removed from the Office docket of pending cases through formal abandonment by the applicant (acquiesced in by

the assignee if there is one) or through failure of applicant to take appropriate action at some stage in the history of the case, as by failing to respond to an Office action within the statutory period for response, failure to issue within the twelve months' period of forfeiture, or by failure to file a brief in an appeal within the time required. (Rule 32.3) A case may also become abandoned through withdrawal of appeal to the Board of Appeals more than six months after the final rejection provided there are no allowed claims, and no properly responsive amendment has been seasonably filed.

Likewise it may become abandoned through dismissal of appeal to C.C.P.A. or of suit in equity, where there was not filed prior to such dismissal or within six months from the Board's decision an amendment putting the case in condition for issue or fully responsive to the Board's decision.

The Examiner has no authority to act upon an application in which no response was taken during the statutory or shortened period. However he may reverse his judgment as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned.

4-3-5.1.

Incomplete

An application lacking some of the essential parts is termed an incomplete application. (Sec. 7-1-9 and 7-1-12.)

4-3-6.

Forfeited

A forfeited application is one which had the status of an allowed case for six months and on which the final fee was not paid. (Rule 34.6). Its legal status during the year dating from its forfeiture makes possible its being issued as a patent on petition to the Commissioner, the petition being supported by a verified statement and accompanied by the final fee and the petition fee (\$10).

The six months' period within which the final fee might have been paid having expired, the file is returned by the Issue and Gazette Branch to the examining division. The clerk of the examining division takes out the drawing, stamps it "Forfeited," stamps the file likewise, makes the proper entry in the register, and forwards the file and drawing to the proper section of the Record and Attorneys' Room which is under the supervision of the Librarian. The application is recorded as forfeited and filed away in the abandoned files section. If not patented within eighteen months from the date of allowance, the forfeited case is then considered abandoned as of the date it became forfeited (Rule 34.6); and such abandoned application cannot be revived upon petition. In this respect an abandoned application that has passed through the twelve months' period of forfeiture differs in status from an application that has become abandoned under the provisions of Rule 19.1 and that can be revived under the provisions of Rule 19.3. See also Sec. 3, Public Law 690.

4-3-7. Examiners to Answer "Status Letters"

Simple letters of inquiry regarding the status of applications will be transmitted from the Register, Correspondence and from the Mail Branch to the examining divisions for direct action.

Such letters will be stamped "Status Letters."

In cases of allowed applications, a memorandum should be pinned to the inquiry with a statement of date of notice of allowance, and transmitted to the Issue Branch for its appropriate action. This Branch will notify the inquirer of the date of the notice of allowance and the status of the application with respect to payment of the final fee and forfeiture. If the correspondent is not entitled to the information, in view of Rule 3.4 of the Rules of Practice, he should be so informed.