

TYPES OF APPLICATIONS

(MPEP 200, 600, 1400, 1800 SUMMARY)

[Young Patent Practitioner Series] Types of Applications (MPEP 200, 600, 1400, 1800 Summary)

This post gives an overview of the patent prosecution process by explaining the types of patent applications. The USPTO’s Manual of Patent Examining Procedure (MPEP) Chapters 200, 600, 1400, and 1800 are summarized. (Ninth Edition, Revision 08.2017, Last Revised January 2018).

Generally, the first procedural question a U.S. inventor or applicant encounters is what kind of a patent application is to be filed. Based on the subject matter of the invention, 1) **a utility patent application** for protecting a new and useful process, machine, article of manufacture, or composition of matter; 2) **a design patent application** for protecting an ornamental appearance of an article; or 3) **a plant patent application** for protecting a distinct and new variety of asexually produced plant can be filed.

For a utility invention (most common), the inventor or applicant should decide whether to pursue patent protection only in the United States or in multiple countries including the United States. For domestic (the U.S.) patent protection, [a provisional application](#) or [a non-provisional application](#) can be filed. The provisional application can be converted to a non-provisional application, or a non-provisional application has to be filed to claim the benefit of the provisional application within 12 months after the provisional application filing date. For international purposes, [an international application](#) (a Patent Cooperation Treaty application) can be filed. The international application can claim priority to one or more prior foreign applications or U.S. domestic applications within 12 months after the prior application filing date. The international application can be a U.S. national application when the international application enters the national state or a bypass application of the international application is filed. While the non-provisional application or national stage application is pending, [a continuing application \(divisional, continuation, or continuation-in-part\)](#) can be filed as well. After the patent is issued, [a reissue application](#) can be filed to correct an error in the patent. Each type of applications is explained in detail in this post.

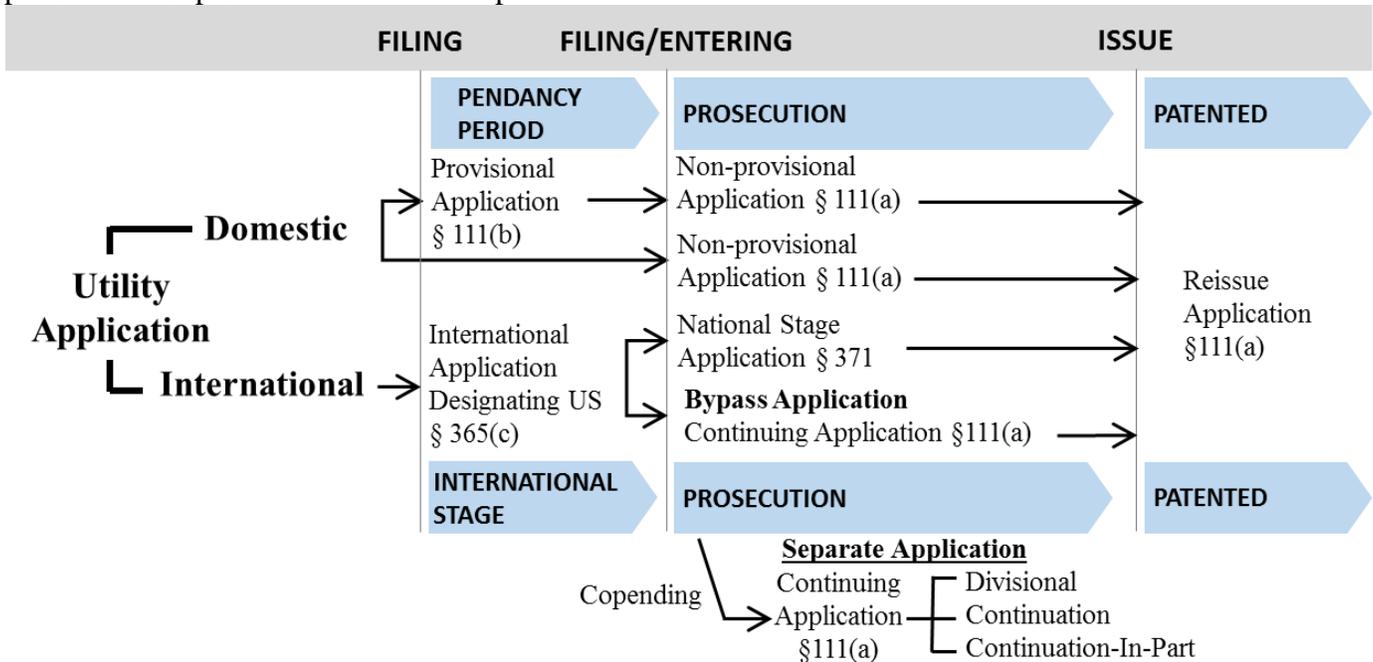


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- **Terms**

- **U.S. patent application publication:** Pre-grant publication by the USPTO under 35 U.S.C. § 122(b)
- **International application:** An application filed under the Patent Cooperation Treaty (PCT)
- **§ 365(c) application:** An international application designating the U.S. that allows for benefit claims to a prior national application, a prior international application designating the U.S. or a prior international design applications.
- **§ 371 application:** An international application that has entered the national stage in the U.S. (35 U.S.C. § 371(c)(1), (2), & (4))
- **WIPO publication:** An publication of an international application under PCT Article 21(2)
- **§ 111(a) application:** The filing requirements for nonprovisional application including continuing application (divisional, continuation, and continuation-in-part) and reissue application.
- **§ 111(b) application:** The filing requirements for provisional application
- **§ 119(e):** The code that allows for benefit claims to provisional application
- **§ 119(a)-(d):** The code that allows for priority claims to foreign applications
- **§ 120:** The code that allows for benefit claims to prior nonprovisional applications

- **Types of Applications**

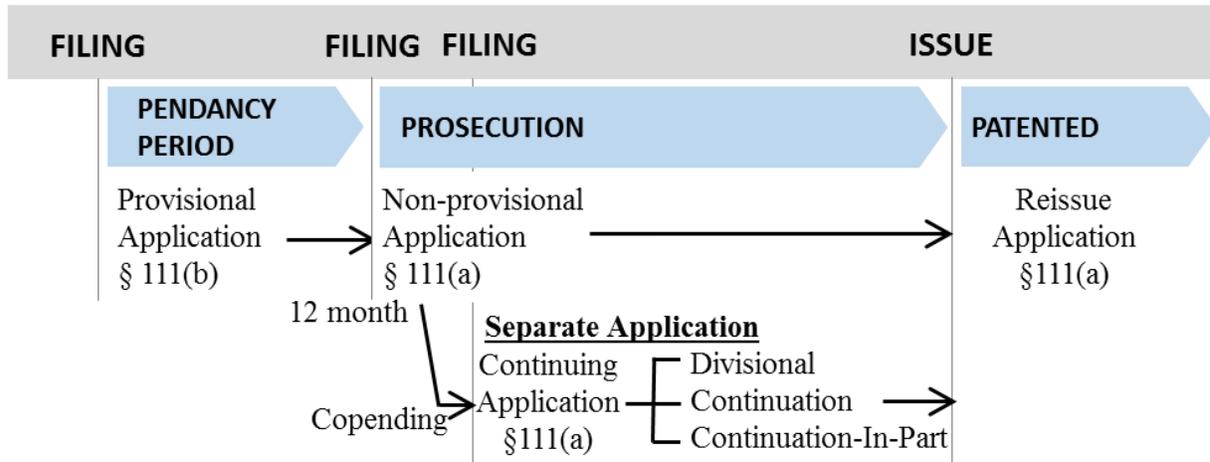
- **Summary:**

App Type Subject Matter	Domestic		International
	Provisional application (§111(b))	Regular domestic national application (§111(a))	National stage
Utility (§101)	Provisional application	Nonprovisional utility patent application, Continuing application (Divisional, Continuation, and Continuation-in-part), Reissue application	National stage application (§371)
Design (§171)		Design patent application, Continued prosecution application (CPA), Continuing application (Divisional, Continuation, and Continuation-in-part), Reissue application	International design application (§385)
Plant (§161)	Provisional application	Plant patent application, Continuing application (Divisional, Continuation, and Continuation-in-part), Reissue application	

- **Utility patent by §101:** A new and useful process, machine, manufacture, or composition of matter
 - ◆ **Domestic national application (§111):** Provisional application (§111(b)), original nonprovisional utility application (§111(a)), continuing application (§111(a)) (divisional, continuation, and continuation-in-part), reissue application (§111(a)).
 - ◆ **International application designating the U.S. (§363)** filed under the Patent Cooperation Treaty (PCT).
- **Design patent by §171:** An ornamental appearance for an article
 - ◆ **National application (§111):** Design patent application, continued prosecution application (CPA) (§111a), continuing application (§111(a)) (divisional, continuation, and continuation-in-part) , reissue application (§111(a))
 - ◆ **International design application designating the U.S. (§385)** filed under the Hague Agreement
- **Plant patent by §161:** A distinct and new variety of asexually produced plant

- ◆ **National application (§111):** Provisional application (§111(b)), plant application (§111(a)), continuing application (§111(a)) (divisional, continuation, and continuation-in-part), reissue application (§111(a))
- **Domestic utility patent application (§101)**
 - **Summary:**

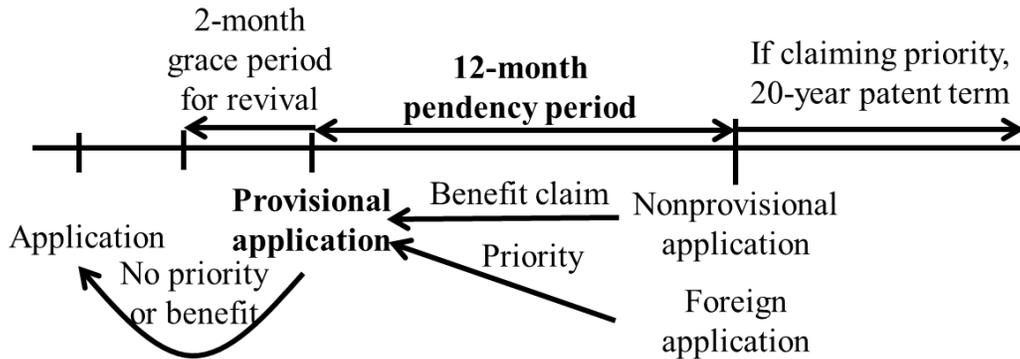
DOMESTIC UTILITY PATENT APPLICATION



- ◆ The utility patent is the most common type of patent applications (a new and useful process, machine, manufacture, or composition of matter). There are two types of utility patent applications: provisional application under §111(b) and nonprovisional application under §111(a).
- ◆ A **provisional application** provides a quick and inexpensive way to establish a U.S. filing date for an invention. To preserve the filing date, a provisional application requires few formalities. A provisional application is not examined for patentability and remains pending for twelve months. A corresponding nonprovisional application must be filed within the pendency period. A provisional application is recommended because
 - ◇ 1) the one-year pendency period does not include the 20-year patent term, which in fact results in the extended patent term, and
 - ◇ 2) the one-year pendency period can give the inventor time to test the market or improve the invention when the nonprovisional application is filed although the improvement may have a different priority date from that of the provisional application.
- ◆ A **nonprovisional application** demands more formalities than the provisional application for the application to be ready for examination. While the original nonprovisional application is pending, a **continuing application including a divisional, continuation, and continuation-in-part application** can be filed in a separate application. The divisional and continuation applications have the same effective filing date as the prior filed nonprovisional application and cannot include new matter. However, the continuation-in-part application is permitted to include new matter. The new matter in claims has a different effective filing date from the rest of the application which has the same effective filing date as the prior filed nonprovisional application.
- ◆ After the nonprovisional application is patented, a **reissue application** can be filed to correct an error in the patent. The error includes where: 1) the claims are too narrow or too broad; 2) the disclosure contains inaccuracies; 3) applicant failed to or incorrectly claimed foreign priority; and 4) applicant failed to make reference to or incorrectly made reference to prior copending applications.

o **201.04 Provisional application**

◆ **Summary:**



- ◆ **12-month pendency period:** A provisional application provides a 12-month pendency period without examination. The applicant for the provisional application must file a corresponding nonprovisional application during the 12-month pendency period of the provisional application in order to benefit from the earlier provisional application filing date. A provisional application is automatically abandoned 12 months after its filing date.
- ◆ **2-month grace period:** From 12/18/2013, a nonprovisional application filed more than 12 months but within 14 months after the filing date of the provisional application may claim the benefit of the provisional application restored by filing a grantable petition to restore the benefit.
- ◆ **Complete provisional application:** comprises
 - ◇ a cover sheet identifying:
 - * the application as a provisional application,
 - * the name or names of the inventor or inventors,
 - * the residence of each named inventor,
 - * the title of the invention,
 - * the name and registration number of the attorney or agent (if applicable),
 - * the docket number used by the person filing the application to identify the application (if applicable),
 - * the correspondence address, and
 - * 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);
 - ◇ a specification as prescribed by 35 U.S.C. 112(a);
 - ◇ drawings necessary for an understanding of the invention; and
 - ◇ prescribed fees.
 - ◇ **Note:** No claim is required, and no oath or declaration is required. No information disclosure statement is required to be filed. A provisional application is not examined for patentability.
- ◆ **Priority:** A provisional application may not claim priority to any foreign application or is not entitled to the benefit of any earlier filed national application. A provisional application is effective for 12 months from its filing date to be converted to a nonprovisional application or to claim benefit of the provisional application in a nonprovisional application. The pendency period or domestic priority period (12 months) does not count in the measurement of the 20-year patent term. This in fact results in the extended patent term.
- ◆ **Filing date:** Filed on or after 12/18/2013 – the filing date is the date on which a specification with or without claims is filed in the USPTO. Before 12/18/2013 – the filing date on which a

specification and any drawing with or without claims is filed in the USPTO. If the applicant wishes to rely on the filing date of the provisional application in a foreign filed application, the foreign filing must be made within 12 months after the provisional application filing date.

◆ **Conversion**

- ◇ **To a provisional application:** A nonprovisional application may be converted to a provisional application with a request and fee. The request and the fee must be submitted prior to the earliest of the abandonment of the nonprovisional application, the payment of the issue fee, or the expiration of 12 months after the filing date of the nonprovisional application.
- ◇ **To a nonprovisional application:** A request with fees to convert a provisional application to a nonprovisional application must be filed prior to the earliest of the abandonment of the provisional application or the expiration of twelve months after the filing date of the provisional application. **Note:** This conversion adversely affects the patent term because the term is measured from at least the filing date of the provisional application.

o **601 Nonprovisional utility patent application**

- ◆ **Summary:** A nonprovisional application is examined by a patent examiner and may be issued as a patent if all the requirements for patentability are met. From 12/18/2013, a nonprovisional application is no longer required to include at least one claim or any drawings in order to receive a filing date for the application. However, it is recommendable to file a nonprovisional application with claims and drawings prescribed by § 112.
- ◆ **Patent term:** A 20-year term from the date the application was filed.
- ◆ **Filing options:** The Office's electronic filing system called EFS-Web, delivery by U.S. mail, or hand delivery to the Office in Alexandria, Virginia.
- ◆ **Filing requirements:** On or after 12/18/2013, the filing date for an application filed under § 111 is the date on which a specification, with or without claims, is received in the USPTO. Despite these minimal formal requirements, it is recommendable to file a patent application with claims and drawings prescribed by § 112. Before 12/18/2013, a filing date is assigned if a specification containing a description and claim and any necessary drawing are filed in the USPTO.
- ◆ **Complete application to be filed:** includes
 - ◇ a utility patent application transmittal form showing a list of items to be filed,
 - ◇ appropriate fees,
 - ◇ an application data sheet (ADS),
 - ◇ a specification with at least one claim,
 - ◇ drawings to understand the claimed invention (when necessary),
 - ◇ an executed oath or declaration,
 - ◇ a nucleotide and amino acid sequence listing (when necessary), and
 - ◇ a large tables or computer listings (when necessary).
- ◆ **Applicant Data Sheet (ADS):** A sheet or set of sheets containing bibliographic data such as inventor information, correspondence information, application information, representative information, domestic benefit information, foreign priority information, and applicant information.
 - ◇ **Claiming benefit of one or more earlier applications filed in the U.S.:** A specific reference to the corresponding earlier-filed application must be in the applicant data sheet (ADS) for applications filed on or after 9/16/2012. A specific reference to the earlier-filed application must be in the ADS or in the first sentence of the specification for applications filed prior to 9/16/2012.

- ◇ **Claiming priority to one or more earlier foreign applications:** On or after 9/16/2012, the claim for priority should be in ADS. Prior to 9/16/2012, the claim for priority is required to be identified on an ADS or in the oath or declaration.
- ◇ **Inconsistencies between ADS and other documents:** For an application filed on or after 9/16/2012, the most recent ADS governs inconsistencies with respect to foreign priority or benefit of a provisional application. If submitted at the same time, the ADS governs inconsistencies with respect to a designation of correspondence address or the inventor's oath or declaration. However, for applications filed on or after 9/16/2012, the inventor's oath or declaration governs inconsistencies with the ADS.
- ◆ **Preferable order of arrangement of specification**
 - ◇ Title of the invention: up to 500 characters,
 - ◇ Cross-reference to related applications: claiming the benefit of one or more prior-filed copending nonprovisional applications, or to a provisional patent application,
 - ◇ Statement regarding federally sponsored research or development,
 - ◇ The names of the parties to a joint research agreement,
 - ◇ Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation-by-reference of the material on the compact disc,
 - ◇ Statement regarding prior disclosures by an inventor or joint inventor,
 - ◇ Background of the invention (Field of the invention, Description of related art),
 - ◇ Brief summary of the invention,
 - ◇ Brief description of the several views of the drawing,
 - ◇ Detailed description of the invention,
 - ◇ Claim(s) (commencing on a separate sheet): additional fees if more than 20 claims in total or 3 independent claims,
 - ◇ Abstract of the Disclosure, and
 - ◇ Sequence Listing, if on paper
- ◆ **Drawings:** An application other than a design application filed on or after 12/18/2013 no longer requires to contain a drawing necessary for the understanding of the subject matter to be entitled to a filing date. However, drawings are required to get a patent if drawings are necessary to understand the subject matter to be patented. The drawings must show every feature of the invention as specified in the claims. Thus, necessary drawings should be filed at the same time the application is filed because a new drawing after the filing date might not be introduced into an application due to the prohibition against new matter.
- ◆ **Oath/Declaration:** For an application filed on or after 9/16/2012, the inventor's oath or declaration can be filed until the application is in condition for allowance, and for an application filed on or after 12/18/2013, the inventor's oath or declaration can be filed until the issue fee is paid if each inventor's legal name and mailing address are identified in an application data sheet (ADS).

o **201.06-08 Continuing application (Divisional, Continuation, Continuation-in-part)**

◆ **Summary**

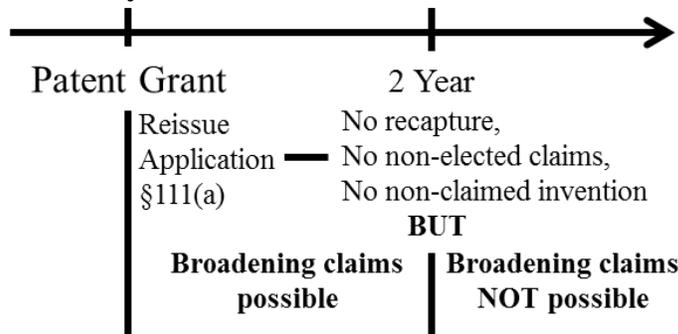
	Divisional	Continuation	Continuation-in-part (CIP)
Effective filing date (EFD)	EFD of a prior-filed nonprovisional application	EFD of a prior-filed nonprovisional application	Two EFDs: 1) new matter: CIP filing date 2) others: EFD of a prior-filed nonprovisional application
Specification	Specification of the parent application with new claims without new matter	Specification of the parent application with new claims without new matter	New matter allowed with a different filing date
Oath/Declaration	New oath/declaration or copy from a prior application	New oath/declaration or copy from a prior application	New oath/declaration or copy from a prior application

- ◆ **Definition (divisional application):** A later application for an independent or distinct invention disclosing and claiming only subject matter disclosed in the earlier or parent copending application. The earlier or parent application is a nonprovisional application, an international application designating the U.S., or international design applications designating the U.S. A divisional application is often filed as a result of a restriction requirement made by the examiner.
- ◆ **Definition (Continuation):** An application for the invention(s) disclosed in a prior-filed copending nonprovisional application, international application designating the U.S., or international design application designating the U.S. The inventorship in the continuation application must include at least one inventor named in the prior-filed application, and the continuation application must also claim the benefit of the prior-filed application
- ◆ **Definition (Continuation-in-part (CIP)):** A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the said earlier nonprovisional application.
- ◆ **Effective filing date:** The effective filing date for a divisional application or a continuation application is the effective filing date of the prior-filed copending nonprovisional applications, international applications designating the U.S., or international design applications designating the U.S. However, a continuation-in-part application may have two different effective filing dates: for new matter, the CIP filing date and for some substantial portion or all of the earlier nonprovisional application, the effective filing date of the prior-filed copending nonprovisional applications.
- ◆ **Filing requirement:** The same requirements as those of the nonprovisional utility patent application above. If an application is a continuation, divisional, or continuation-in-part application, the relationship must be indicated in an application data sheet (ADS) if the application is filed on or after 9/16/2012 or in the first sentence of the specification or in an ADS if filed prior to 9/16/2012.
- ◆ **Inventorship in a continuing application**
 - ◇ **On or after 9/16/2012:** The filing of a continuing application by all or by fewer than all of the inventors named in a prior application without a newly executed oath or declaration is permitted if an oath, declaration or substitute statement was filed in the earlier-filed application and a copy of them is submitted in the continuing application.
 - * **Requirements:** The inventor's oath or declaration must state that 1) the inventor is an original inventor of the claimed invention, 2) the inventor authorized the filing of the patent application for the claimed invention, and 3) the oath or declaration must contain an acknowledgement that any willful false statement made in such declaration is punishable.

- * **Exception:** A new inventor’s oath or declaration needs to be filed in a continuing application filed on or after 9/16/2012, where the prior application was filed before 9/16/2012 and each inventor is not identified in application data sheet (ADS) because an application filed prior to 9/16/2012 needs not identify each inventor in ADS.
- ◇ **Prior to 9/16/2012:** The applicant has the option of filing 1) a newly executed oath or declaration signed by the inventors for the continuation or divisional application; or 2) a copy of the oath or declaration filed in the prior application (accompanied by a statement from an authorized party requesting the deletion of the names of the person or persons who are not inventors in the continuation or divisional application).
- ◇ **Copies of affidavits:** Affidavits or declarations filed during the prosecution of the prior nonprovisional application do not automatically become a part of a continuation or divisional application file. The applicant should make such remarks of record in a continuing application and include a copy of the original affidavit or declaration file in the prior nonprovisional application.
- ◆ **Specification and drawings:** A continuation or divisional application may be filed by providing
 - ◇ A new specification and drawings and a copy of the signed oath or declaration as filed in the prior application without new matter in the new specification; or
 - ◇ A new specification and drawings and a newly executed oath or declaration provided the new specification and drawing without new matter.
 - ◇ **Claims:** Applicant should file a new set of claims as the original claims of the continuing application instead of filing a copy of the claims from the prior application and a preliminary amendment to those claims.
- ◆ **New matter:** If there is new matter in a continuation or divisional application, the applicant is required to delete the benefit claim or change the relationship to continuation-in-part.
- ◆ **Incorporation by reference:** An applicant may incorporate by reference the prior application by including, in the continuing application-as-filed, an explicit statement that such specifically enumerated prior application or applications are “hereby incorporated by reference.” This statement must appear in the specification. An incorporation by reference statement added after an application’s filing date is not effective due to a new matter issue. Since 9/21/2004, a claim for the benefit of a prior-filed application is considered an incorporation by reference as to inadvertently omitted material. Thus an applicant is encouraged to provide an explicit incorporation by reference statement to the prior-filed foreign priority application if the applicant does not want to limit the incorporation by reference to inadvertently omitted material.
- ◆ **Extensions of time:** If an extension of time is necessary to establish continuity between the prior application and the continuing application, the petition for an extension of time must be filed as a separate paper directed to the prior nonprovisional application.

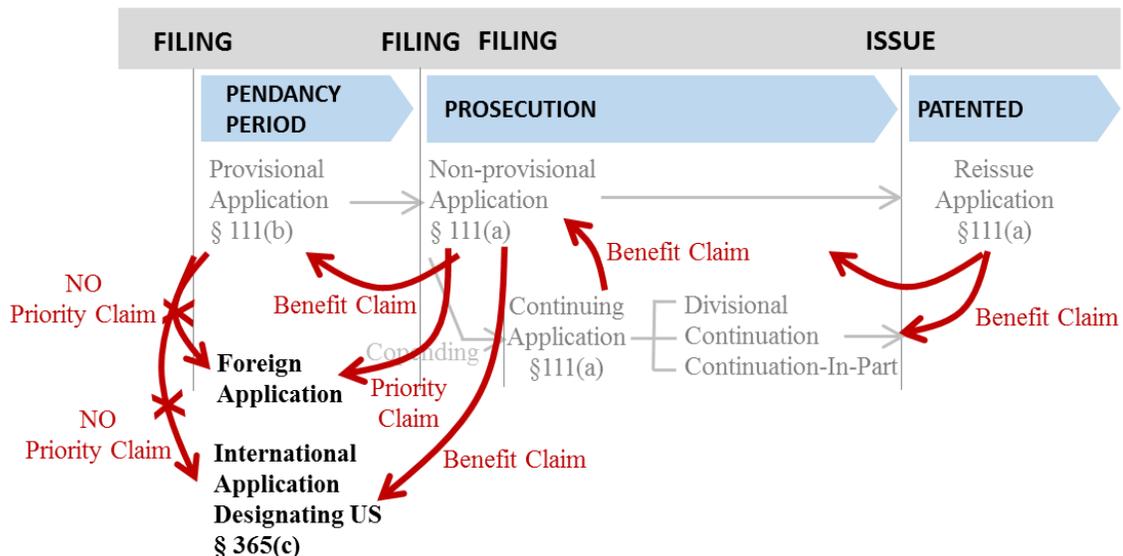
o **1400 Reissue application**

◆ **Summary:**



- ◆ **Definition:** An application to correct an error in a patent, and the error causes the patent to be deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent.
 - ◇ **Error includes where:**
 - * the claims are too narrow or too broad;
 - * the disclosure contains inaccuracies;
 - * applicant failed to or incorrectly claimed foreign priority; and
 - * applicant failed to make reference to or incorrectly made reference to prior copending applications.
 - ◆ **Patent term:** The reissued patent has the unexpired term of the original patent.
 - ◆ **Contents:** An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter is allowed.
 - ◆ **Content of Claims**
 - ◇ **Same general invention:** Reissue claims must be for the same general invention as the original claims. Thus, a non-elected and non-claimed invention where a restriction requirement was made in an application cannot be recovered by filing a reissue application.
 - ◇ **No recapture of canceled subject matter:** A reissue will not be granted to recapture claimed subject matter which was surrendered in an application to obtain the original patent.
 - * **Three-step test:** 1) whether the reissue claims are broader in scope than the original patent claims, 2) if so, whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution, 3) if so, whether the claims are not materially narrowed in related aspects or are narrowed in unrelated aspects. If 1), 2), and 3) are yes, there is recapture.
 - ◇ **Broadening reissue claims within two year period:** Where any intent to broaden is unequivocally indicated in the reissue application within the two years from the patent grant, a broadened claim can be presented before or even after the two year period.
- o **210 Claiming priority and benefit in domestic utility patent application**
- ◆ **Summary:** A later-filed application may claim the benefit of, or priority to, a prior application filed in the United States (§§ 119(e), 120, 121, 365(c), 386(c)) or in a foreign country (§119(a)-(d), (f), 365(a), (b), 386(a), (b)).

DOMESTIC UTILITY PATENT APPLICATION



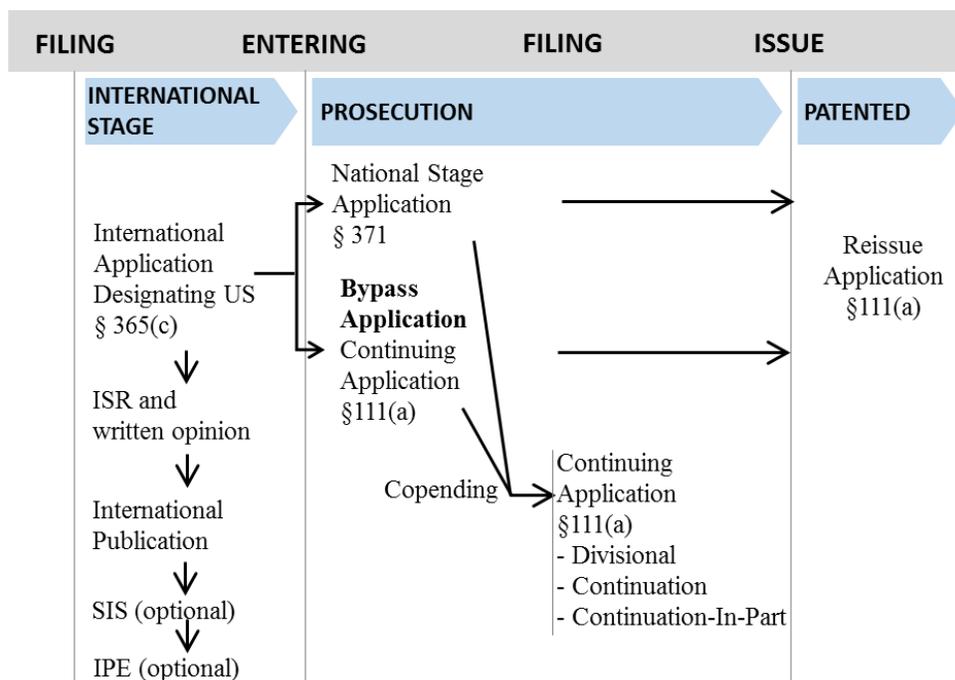
- ◆ **211 Claiming the benefit of prior application filed in the U.S.**
 - ◇ An application filed in the U.S. may be entitled to the benefit of a filing date of a prior application filed under §119(e), 120, 121, 365(c), or 386(c).
 - ◇ **Claiming the benefit of a provisional application filed under § 119(e)**
 - * **Requirements:** 1) A nonprovisional application with 12 months after a provisional application filing date (2 months grace period to restore the benefit of the provisional application), 2) the same inventor or at least one joint inventor in common with the nonprovisional application, 3) filing fees, and 4) if the provisional application is filed in a non-English language, an English language translation and a statement that the translation is accurate are required to be filed.
 - ◇ **Claiming the benefit of a nonprovisional application filed under § 120 (benefit of earlier filing date in the U.S.), 121 (divisional)**
 - * **Copendency:** To claim the benefit of a prior-filed nonprovisional application, the later-filed application must be filed before 1) the patenting of the prior application, 2) the abandonment of the prior application or 3) the termination of proceedings in the prior application. The later-filed application includes a continuing application (divisional, continuation, and continuation-in-part application) when the prior application is not a provisional application
 - * **Benefit claims to multiple prior application:** Sometimes, a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application. If so, the applicant must identify all of the prior applications and indicate the relationship between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications.
 - ◇ **Time period for making a claim for benefit**
 - * **If the application is a utility or plant application filed under § 111(a),** the benefit claim of the prior application under § 119(e), 120, 121, 365(c), or 386(c) must be made during the pendency of the application and 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.
 - * **Not extendable** except a petition to accept an unintentionally delayed benefit claim is granted.
- ◆ **213 Right of priority of foreign application**
 - ◇ An application filed in the U.S. may be entitled to the filing date of a prior application filed in a foreign country under § 119(a)-(d) and (f).
 - ◇ **Recognized countries:** The foreign country with respect to which the right of priority under § 119(a)-(d) has been recognized is a party to Patent Cooperation Treaty (PCT), the Paris Convention for the Protection of Industrial Property, or the World Trade Organization (WTO).
 - ◇ **Requirements**
 - * **Identification of foreign application**
 - i) **Applications filed under § 111(a) on or after 9/16/2012:** The claim for priority must be in the ADS.
 - ii) **Applications filed prior to 9/16/2012:** The claim to priority must appear in the oath or declaration or in the ADS.
 - * **Same inventor or at least one common joint inventor:** The foreign application and U.S. application must have same inventor or at least one common joint inventor.

- ◇ **Time for filing subsequent applications:** The nonprovisional application must be 1) filed not later than 12 months (6 months for design applications) after the foreign application filing date. If not, the applicant may file a petition for an unintentionally delayed benefit claim within 2 month from the expiration of the period.
- ◇ **Time for filing priority claim:**
 - * **Application under § 111(a) (not applicable for design application):** The claim for priority must be filed within the later of 4 months from the actual filing date of the application or 16 months from the filing date of the prior foreign application. A petition to restore the right of priority due to unintentional delay may be filed. The claim for priority must be presented during the pendency of the application.
- ◇ **Time for filing certified copy of foreign application**
 - * **Definition of certified copy:** A copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the applications as filed with a certificate of the foreign patent office.
 - * **Application under § 111(a):** A certified copy of the foreign application must be filed within the later of 4 months from the actual filing date of the application, or 16 months from the filing date of the prior foreign application except design applications.
 - * **Delay:** Petition including a showing of good and sufficient cause for the delay may be filed.
 - i) **Requirements for petition:** 1) the claim for priority to the prior foreign application, 2) a certified copy of the foreign application, 3) the petition fee, and 4) a statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional.
 - * **Foreign IP office participating in a priority document exchange agreement:** If the USPTO receives a copy of the priority document through the priority document exchange program during the pendency of the application and before the patent is granted, a certified copy is considered to be submitted.
 - * **Perfecting claim for priority after issuance of a patent:** The failure to perfect a claim to foreign priority prior to issuance of the patent may be cured via a certificate of correction or by filing a reissue application.
 - * **Translation:** An English language translation of a non-English language foreign application is not required except:
 - i) when the application is involved in an interference or derivation proceeding,
 - ii) when necessary to overcome the date of a reference relied upon by the examiner, or
 - iii) when specifically required by the examiner.

• **1800 International utility patent application**

o **Summary:**

INTERNATIONAL UTILITY PATENT APPLICATION



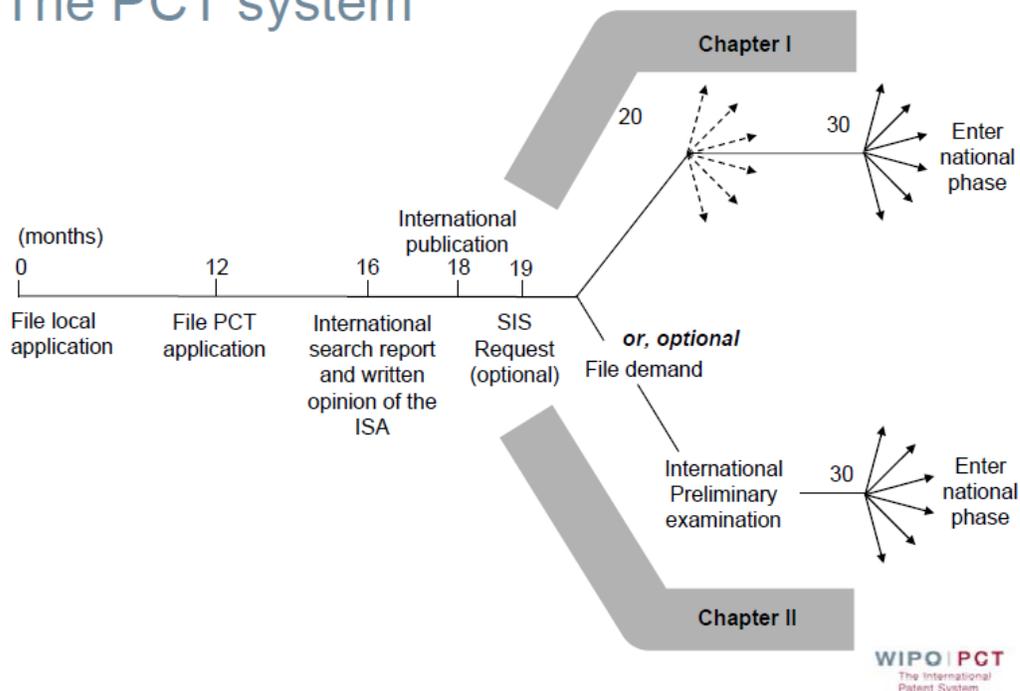
- ◆ An applicant may file a standardized international application or Patent Cooperation Treaty (PCT) application in the U.S. Receiving Office (USPTO). The international application is acknowledged as a regular national or regional filing in the PCT contracting states the applicant designated. Many applicants file a U.S. domestic application or a foreign application first, and file an international application claiming priority to the prior application within 12 months after the prior application filing date.
- ◆ After filing an international application, an international search report (ISR) and written opinion are established at 16 months from the priority date which is the foreign application filing date or the international application filing date if no priority is claimed. The international application is published after 18 months from the priority date. At any time prior to the expiration of 19 months from the priority date, the applicant can request one or more supplementary international searches (SIS). The applicant has the right to file a demand for international preliminary examination (IPE) under Chapter II of the Treaty. If no demand has been filed, the national stage entry is made under Chapter I of the Treaty. Generally, 30 months after the priority date, the international application enters a national phase in each of the designated countries.
- ◆ An international application designating the U.S. can be a U.S. national application when the international application enters the national phase or can be a bypass application of the international application. Prosecution of an national stage application is similar to that of a regular domestic national application except restriction practice in that the national stage application requires unity of invention under the PCT while the domestic national application require restriction on two or more independent and distinct claimed inventions in one application.
- ◆ As in a domestic application, a continuing application including a divisional, continuation, and continuation-in-part application of a U.S. national application can be filed in a separate application. After the nonprovisional application is patented, a reissue application can be filed to correct an error in the patent as well.

o **1802 Basic Terms**

- ◆ **Patent Cooperation Treaty:** The Patent Cooperation Treaty (PCT) enables an applicant to file an international application in a standardized format in English in the U.S. Receiving Office (the USPTO) or their home language in their home patent office and have that application acknowledged as a regular national or regional filing in as many Contracting States to the PCT as the applicant designates as countries or regions in which patent protection is desired.
- ◆ **Receiving office (RO):** The receiving office functions as the filing and formalities review organization for international applications. The U.S. RO is the United States Patent and Trademark Office (USPTO).
- ◆ **International searching authority (ISA):** The basic functions of the ISA are to conduct a prior art search of inventions claimed in international applications and to issue a written opinion which will normally be considered to be the first written opinion of the International Preliminary Examining Authority where international preliminary examination is demanded. An international search report (ISR) and written opinion will normally be issued by the ISA within 3 months from the receipt of the search copy (usually about 16 months after the priority date).
- ◆ **International Bureau (IB):** The basic functions of the IB are to maintain the master file of all international applications and to act as the publisher and central coordinating body under the Treaty. The World Intellectual Property Organization (WIPO) performs the duties of the IB.
- ◆ **Designated Office (DO) and Elected Office (EO):** The designated Office is the national Office (e.g., the USPTO) acting for the state or region designated under Chapter I. Similarly, the elected Office is the national Office acting for the state or region elected under Chapter II.
- ◆ **International Preliminary Examining Authority (IPEA):** The IPEA normally starts the examining process when it is in possession of 1) the Demand, 2) the amount due, 3) a translation if required, 4) either the ISR or a notice of the declaration by the ISA that no ISR will be established, and 5) the written opinion. The IPEA establishes the international preliminary examination report (IPER) which presents the examiner’s final position as to whether each claim is novel involves inventive step and is industrially applicable by 28 months from the priority date.

o **1842 Basic flow under the PCT**

The PCT system



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- ◆ **Measuring time limits under the PCT:** Time limits are measured from the priority date of the application. If an international application does not contain any priority claim, the international application filing date is considered to be the priority date.
- ◆ **International filing date:** An international application is generally filed within 12 months after the filing of the first application directed to the same subject matter, so that priority may be claimed.
- ◆ **Establishment of the International Search Report (ISR) and written opinion of the International Searching Authority (ISA):** The time limit for establishing the ISR and written opinion is 3 months from the receipt of the search copy by the ISA or 9 month from the priority date, whichever time limit expires later.
- ◆ **International publication:** The international publication of the international application by the IB shall be effected promptly after the expiration of 18 months from the priority date of the application.
- ◆ **Supplementary international search (SIS):** At any time prior to the expiration of 19 months from the priority date, the applicant can request one or more supplementary international searches each to be carried out by an ISA other than the ISA which carries out the main international search.
- ◆ **Deadline for filing the demand:** International preliminary examination is optional. A demand for international preliminary examination must be filed prior to the expiration of whichever of the following periods expires later 1) 3 months from the date of transmittal to the applicant of the ISR and written opinion or 2) 22 months from the priority date.
- ◆ **Deadline for filing copy, translation, and fee in national stage offices:**
 - ◇ **National stage entry following PCT chapter I:** Under PCT Article 22(1), the national stage requirements are due not later than at the expiration of 30 months from the priority date if no demand has been filed.
 - ◇ **National stage entry following PCT chapter II:** If the election of a Contracting State has been effected by filing a demand prior to the expiration of the 19 month from the priority date, the provisions of Article 39 apply rather than the provisions of Article 22. The deadline for filing the national stage requirements under Article 39(a) is 30 months from the priority date, but any national law may fix time limits which expire later than the time limit provided in PCT Article 39(a).
- **International application (PCT application)**
 - ◆ **1806 Applicants and inventors**
 - ◇ **Applicant as resident or national:** Any resident or national of a Contracting State may file an international application. PCT Art. 9 and Rule 18. Where there are two or more applicants, at least one of them must be a national or a resident of a Contracting State.
 - ◇ **Inventor but not applicant:** Where the inventor is not the applicant, indications concerning the inventor must nevertheless be made in the Request where the national law of at least one of the designated States requires that the name of the inventor be furnished at the time of filing a national application.
 - ◆ **1807 Agent or common representative and general power of attorney**
 - ◇ **Power of attorney and waiving the requirement:** Where an appointment of an agent or common representative is effected by a separate power of attorney, that power of attorney must be submitted to either the RO or IB. But for international applications having an international filing date on or after 1/1/2004, the RO, IB, ISA, and IPEA may waive the requirement for a separate power of attorney or copy of the general power of attorney in all cases except with respect to notice of withdrawals.

◆ **1810 Filing date requirements**

- ◇ **PCT Article 11(1):** The RO shall accord as the international filing date the date of receipt of the international application if that the RO has found that
 - * the applicant's right to file an international application with the RO (residence or nationality)
 - * the international application is in the prescribed language,
 - * the international application contains 1) an indication that it is intended as an international application, 2) the designation of at least one Contracting State, 3) the name of the applicant, 4) description and 5) claims
- ◇ **§ 363:** An international application designating the U.S. shall have the effect from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the PTO.

◆ **1812 Elements of the international application**

- ◇ **Elements & order:** Any international application must contain the following elements in the following order: request, description, claim or claims, abstract and one or more drawings (if necessary), and the sequence listing part of the description (where applicable).

◆ **1821 The Request**

- ◇ **Petition for the international application:** the Request contains a petition for the international application to be processed according to the PCT and must contain certain indications (title of the invention, applicant and agent (if any), and designation of at least one Contracting State).
 - * **Designation of states:** The filing of an international application request constitutes: 1) the designation of all Contracting States that are bound by the Treaty on the international filing date; 2) an indication that the international application is, in respect of each designated state for the grant of every kind of protection which is available by way of the designation of that State, and 3) an indication that the international application is in respect of each designated State for the grant of a regional patent and a national patent.

◆ **1828 Priority claim and document**

- ◇ **Indication on Request:** An applicant who claims the priority of one or more earlier national, regional or international applications for the same invention must indicate on the Request, at the time of filing, the country in or for which it was filed, the date of filing, and the application number.
- ◇ **Correction:** The applicant may correct or add a priority claim by a notice submitted to the RO or the IB within 16 months from the priority date, or where the priority date is changed, within 16 months from the priority date so changed, whichever period expires first, provided that a notice correcting or adding a priority claim may in any event be submitted until the expiration of 4 months from the international filing date.
- ◇ **Certified copy:** The applicant may file the certified copy of the earlier filed national application together with the international application in the RO or alternatively the certified copy may be submitted by the applicant to the IB or the RO not later than 16 months from the priority date or if the applicant has requested early processing in any designated Office, not later than the time such processing or examination is requested.
- ◇ **1828.01 Restoration of the right of priority:** Within two months from the expiration of the priority period, the right of priority in the international application may be restored upon request if the delay in filing the international application within the priority period was unintentional.

◆ **1805 Where to file an International Application**

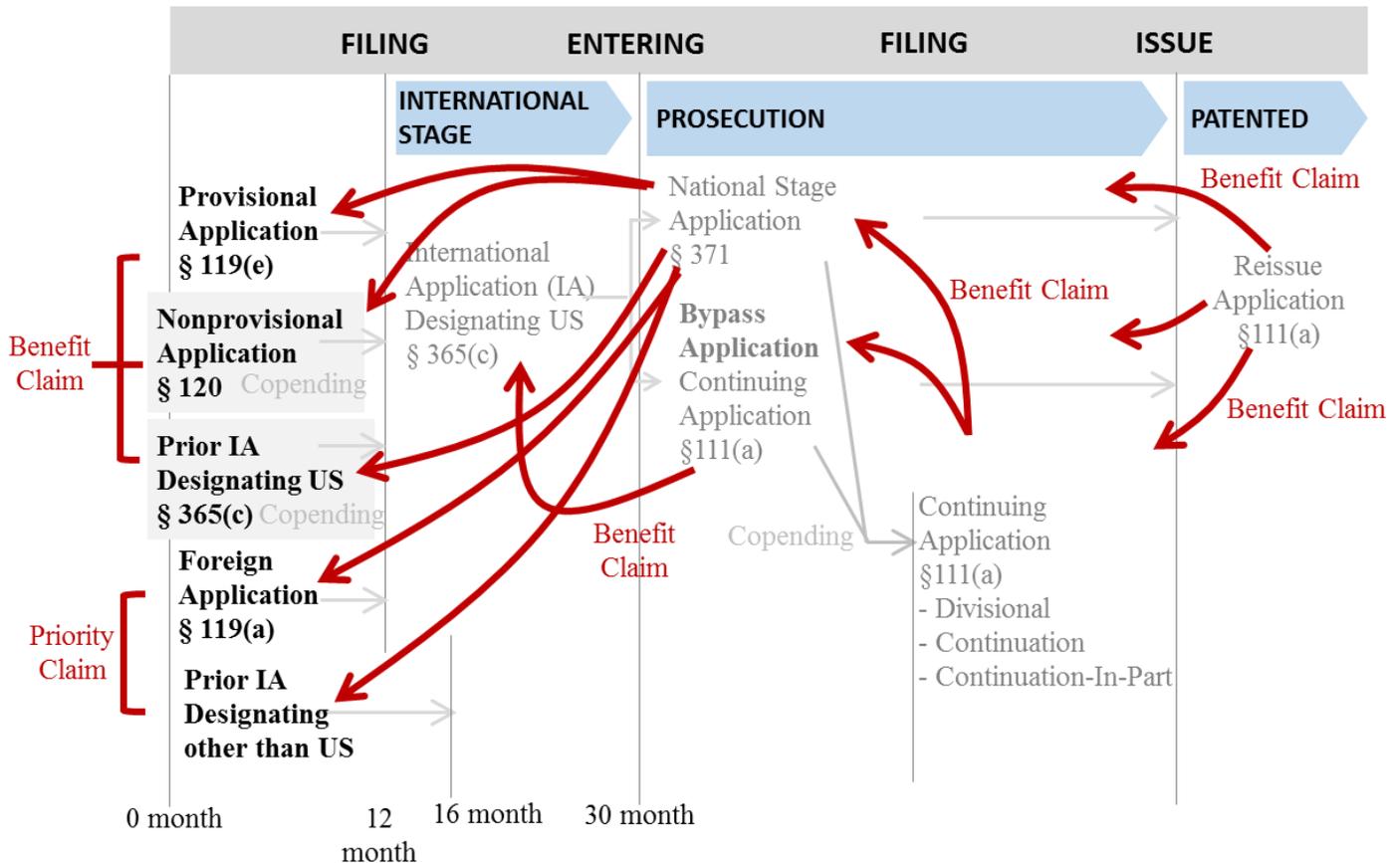
- ◇ **The USPTO:** The USPTO shall act as a Receiving Office for international applications filed by nationals or residents of the United States.
- ◇ **Transmittal to IB:** When the international application is filed with USRO and the filed language of the international application is not accepted by the USRO, or if the applicant does not have the requisite residence or nationality, the application may be forwarded to the IB for processing in its capacity as a RO with the USRO filing date.
- ◇ **IB:** Any applicant who is a resident or national of a PCT Contracting State may also directly file their application directly with the IB as RO. Especially, considering this when after the expiration of 12 months priority period but within two months of the expiration of the priority period if applicant desires to request restoration of the right of priority.
- **1843 The International Search**
 - ◆ **International Search Report:** Upon completion of the international search, an ISR is established. The report provides information on the relevant prior art to the applicant, the public, the designated offices, and the International Preliminary Examining Authority. The ISR is subject to international publication 18 months from the international filing date.
 - ◆ **Written opinion:** indicates whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable. The written opinion also indicates any defects in the form or content of the international application under PCT articles or regulations.
 - ◇ **Time to reply:** If applicant wishes to file a demand and amendments and/or arguments, the time period for response is 3 months from the mailing of the ISR and the written opinion or before the expiration of 22 months from the priority date, whichever expires later.
 - ◆ **1853 Amendment under PCT Article 19**
 - ◇ **One opportunity to amend:** The applicant shall after having received the ISR, be entitled to one opportunity to amend the claims of the international application by filing amendments with the IB within the time limit.
 - ◇ **Time limit:** shall be 2 months from the date of transmittal of ISR to the IB and to the applicant by the ISA or 16 months from the priority date, whichever time limit expires later.
- **1850 Unity of Invention before the ISA**
 - ◆ **Requirement (PCT Rule 13):** The international application shall relate to one invention only or to a group of invention so linked as to form a single general inventive concept.
 - ◆ **Fulfillment:** The requirement of unity of invention is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.
- **1852 Taking into account results of earlier searches**
 - ◆ **Request to consider earlier searches:** The applicant may request that the results of an earlier international, international-type or national search carried out by the same or another ISA or by a national Office be used in establishing an international search report on such international application. But the examiner is not bound by the results of the earlier search.
- **1856 Supplementary International Searches (SIS)**
 - ◆ **Additional search:** The SIS is an optional service that allows additional searches to be performed by a Supplementary International Searching Authority (SISA) during the international phase, in addition to the search performed by the main ISA.
 - ◆ **Time limit:** The applicant must file a request for a SIS prior to the expiration of 19 months from the priority date. (no extension)

- **1857 International Publication**
 - ◆ **Publication after 18 months:** An international application is generally published after the expiration of 18 months from the priority date of the application.
- **1859 Withdrawal of international application, designations, or priority claims**
 - ◆ **Withdrawal:** The applicant may withdraw the international application, the designation of any state, or a priority claim by a notice to the IB or to the RO and received before the expiration of 30 months from the priority date. The notice must be signed by all the applicants.
- **1860 International Preliminary Examination Procedure**
 - ◆ **Examination procedure:** The international preliminary examination is to be carried out after the demand is checked. The written opinion of the ISA is treated as the first written opinion of IPEA. A further written opinion is usually not mandatory. A further written opinion should be prepared by the examiner if applicant files a response which includes a persuasive argument that the written opinion issued by the ISA was improper because of a negative opinion with respect to a lack of novelty, inventive step or industrial applicability; and which results in the examiner considering any of the claims to lack novelty, inventive step or industrial applicability based on new art not necessitated by any amendment.
 - ◆ **Demand:** Once applicant has filed an international application under Chapter I of the PCT, applicant has the right to file a demand for preliminary examination under Chapter II of the Treaty. The use of the term “Demand” distinguishes Chapter II from the “Request” under Chapter I.
 - ◇ **Chapter I:** Chapter I affords applicant the benefit of an international search, which includes an ISR and a written opinion established by the ISA.
 - ◇ **Chapter II:** The filing of a demand affords applicant examination of the application and allows applicant to file amendments to the description claims, drawings to correct any defects, respond to any observations, or address negative findings with respect to any of the claims because of a lack of novelty, inventive step or industrial applicability mentioned in the written opinion established by the ISA.
- **1893 National Stage (U.S. National Application filed under § 371)**
 - ◆ **National stage application under § 371:** An international application designating the U.S. becomes a national application by entering the national phase under § 371.
 - ◆ **Time limit:** Not later than the expiration of 30 months from the priority date. The national stage may commence earlier than 30 months from the priority date with applicant’s express request for early processing. In the absence of an express request for early processing, the U.S. national stage will commence upon expiration of 30 months from the priority date of the international application.
 - ◆ **Article 19 amendment filed with the IB:** The amendment under Art. 19 after issuance of the search report is forwarded to the U.S. DO by the IB for inclusion in the U.S. national stage application.
 - ◆ **Article 34 Amendment filed with the IPEA:** Amendments to the international application that were properly made under PCT Art. 34 during the international preliminary examination phase (Chapter II) will be annexed by the IPEA to the IPER and communicated to the elected Offices. If these annexes are in English, they will normally be entered into the U.S. national stage application by the Office. Applicant may expressly instruct the US DO not to enter the Art. 34 amendment in the U.S. national stage application.
 - ◆ **Applicant:** Prior to 9/16/2016, the inventors are required to be the applicants. On or after 9/16/2012, the applicant may be enough to be identified.

- ◆ **Translation:** If the international application was filed in another language and was not published in English, applicants entering the national stage in the U.S. are required to file an English translation of the international application. Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation.

o **Claiming priority and benefit in international utility patent application**

INTERNATIONAL UTILITY PATENT APPLICATION



- ◆ **Priority date:** A U.S. national stage application may be entitled to 1) a right of priority under § 119(a) and 365(b) based on a prior foreign application or international application designating at least one country other than the U.S. and 2) the benefit of an earlier filed U.S. national application or international application designating the U.S. pursuant to § 119(e) or 120 and 365(c).
 - ◇ **Right of priority under § 119(a) and 365(b):** Pursuant to § 365(b), a U.S. national stage application shall be entitled to a right of priority based on a prior foreign application or international application designating at least one country other than the U.S. in accordance with the conditions and requirements of § 119(a) and PCT regulation. International applications filed on or after 4/1/2007 may claim priority to a foreign application filed more than 12 months before the filing date of the international application.
 - * **Certified copy:** Applicant must submit the certified copy, request the RO to prepare and transmit the certified copy or request the IB to obtain the priority document from a digital, within 16 months from the priority date. For international applications in which the U.S. national stage commenced under § 371 on or after 12/18/2013, applicant must submit the certified copy within the later of 4 months from the date of entry into the U.S. national stage or 16 months from the filing date of the priori-filed foreign application.

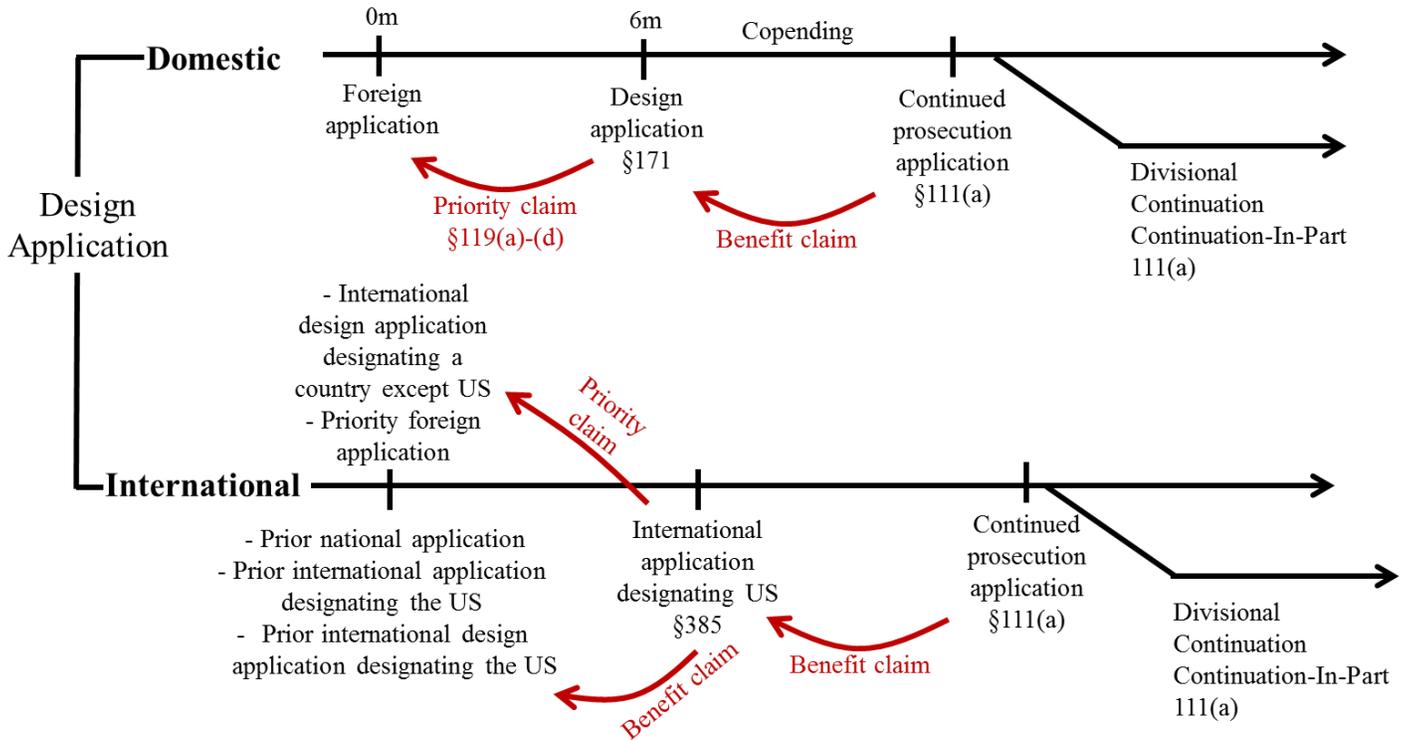
- * **Time for filing priority claim:**
 - i) **Application under § 371 (international application entering the national stage):**
The claim for priority must be made during the international stage (normally, 30 months from the priority date). The petition is also available. The claim for priority must be presented during the pendency of the application.
- ◇ **Benefit claim under § 119(e) or 120 and 365(c):** A national stage application may include a benefit claim under § 119(e), or 120 and 365(c) to a prior U.S. national application or under §120 and 365(c) to a prior international application designating the U.S.
 - * **National stage application under § 119(e):** must contain a reference to the provisional application identifying it as a provisional application. If the national stage application has an international filing date prior to 9/16/2012, the reference must be in either an application data sheet (ADS) or in the first sentence of the specification. If filed on or after 9/16/2012, the reference must be in an ADS.
 - i) **Inclusion of ADS:** will be satisfied in a U.S. national stage application by presentation of such benefit claim in the PCT request form contained in the international application or the presence of such benefit claim on the front page of the published international application.
 - * **Time period for making a claim for benefit:**
 - i) **If the application is a nonprovisional application entering the national stage from an international application under § 371,** the benefit claim must be made within the later of 1) four months from the date on which the national stage commenced under § 371(b) or (f), 2) four months from the date of the initial submission under § 371 to enter the national stage, or 3) sixteen months from the filing date of the prior application.
 - ii) **Not extendable** except a petition to accept an unintentionally delayed benefit claim is granted.
- ◆ **National stage application under § 120 (prior filed copending nonprovisional application) and 365(c) (prior filed copending international application designating the U.S.):** must contain a reference to the prior nonprovisional or international application (either in an ADS or in the first sentence of the specification). If national stage application has an international filing date on or after 9/16/2012, the reference must be in an ADS.
- ◆ **Claiming the benefit of an international application designating the U.S. filed under § 365(c):** Two options are available: 1) submitting a national stage application under § 371, 2) filing a continuation divisional, or continuation-in-part under § 111(a) of an international (PCT) application designating the U.S. (bypass application). The bypass application must be filed during the pendency of the international application.
- ◇ **Differences between a national application filed under §111(a) and §371**

	National Application filed under §111(a)	National Application filed under §371
Filing date	The date when a specification is received in the USPTO	International filing date of PCT application
§119(a)-(d) Priority requirement	The claim for priority must be filed within the later of 4 months from the actual filing date of the application or 16 months from the filing date of the prior foreign application with the certified copy.	The claim for priority must be made and the certified copy of the priority application must be furnished during the international stage within the PCT time limit. The IB sends a copy of the certified priority document to each DO that has requested to receive such documents.

Unity of invention	U.S. restriction practice	Unity of invention practice
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• **Design patent application (§ 171)**

o **Summary:**



- o **Definition:** A design application to protect the visual ornamental characteristics embodied in or applied to an article of manufacture. Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.
 - o **Patent term:** A 15 year term from the date of grant for applications filed on or after 5/13/2015. A 14 year term for application filed before 5/13/2015.
 - o **Continued Prosecution Application (CPA)**
 - ◆ **Only to design application:** Effective 7/14/2013, CPA practice has been eliminated as to utility and plant applications (applicable only to design applications). However, utility and plant applications may consider a request for continued examination (RCE) after the prosecution is closed.
 - ◆ **Requirements:** 1) the application is for a design patent, 2) the prior nonprovisional application is a design application, but not an international design application except for the inventor's oath or declaration if the application is filed on or after 9/16/2012, and the prior nonprovisional application contains an application data sheet, and 3) the CPA is filed before the earliest of payment of the issue fee, abandonment or termination of proceedings on the prior application.
- **Plant patent application (§ 161)**
- ◆ **Definition:** An application to protect a newly found asexually reproduced plant.
 - ◆ **Patent term:** A 20 years term from the date the application was filed.