Treaty Request Form must be accompanied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

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

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

(1) Except as provided in paragraph (b) of this section, the nonprovisional application or international application designating the United States of America must be filed not later than twelve months after the date on which the provisional application was filed, or be entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of an application that was filed not later than twelve months after the date on which the provisional application was filed. This twelve-month period is subject to 35 U.S.C. 21(b) (and § 1.7(a)) and PCT Rule 80.5.

(2) Each prior-filed provisional application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(d) must have been paid for such provisional application within the time period set forth in § 1.53(g).

(3) Any nonprovisional application or international application designating the United States of America that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the
provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76(b)(5)).

(4) The reference required by paragraph (a)(3) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a national stage application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed provisional application. Except as provided in paragraph (c) of this section, failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) of the prior-filed provisional application.

(5) If the prior-filed provisional application was filed in a language other than English and both an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application, the applicant will be notified and given a period of time within which to file, in the prior-filed provisional application, the translation and the statement. If the notice is mailed in a pending nonprovisional application, a timely reply to such a notice must include the filing of the nonprovisional application of either a confirmation that the translation and statement were filed in the provisional application, or an application data sheet eliminating the reference under paragraph (a)(3) of this section to the prior-filed provisional application, or the nonprovisional application will be abandoned. The translation and statement may be filed in the provisional application, even if the provisional application has become abandoned.

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in §1.491 in an international application, sixteen months from the filing date of the prior-filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in §1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

(b) Delayed filing of the nonprovisional application or international application designating the United States of America.

If the nonprovisional application or international application designating the United States of America has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1) of this section but within two months from the expiration of the period set forth in paragraph (a)(1) of this section, the benefit of the provisional application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the nonprovisional application or international application designating the United States of America within the period set forth in paragraph (a)(1) of this section was unintentional.

(1) A petition to restore the benefit of the provisional application under this paragraph filed in the nonprovisional
application or international application designating the United States of America must include:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The petition fee as set forth in §1.17(m); and

(iii) A statement that the delay in filing the nonprovisional application or international application designating the United States of America within the twelve-month period set forth in paragraph (a)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(2) The restoration of the right of priority under PCT Rule 26bis.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

(c) Delayed claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application. If the reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section is presented in an application after the time period provided by paragraph (a)(4) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(1) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted;

(2) The petition fee as set forth in §1.17(m); and

(3) A statement that the entire delay between the date the benefit claim was due under paragraph (a)(4) of this section and the date the benefit claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(d) Claims under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional or international application. An applicant in a nonprovisional application (including an international application entering the national stage under 35 U.S.C. 371) or an international application designating the United States of America may claim the benefit of one or more prior-filed co pending nonprovisional applications or international applications designating the United States of America under the conditions set forth in 35 U.S.C. 120, 121, or 365(c) and this section.

(1) Each prior-filed application must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor. In addition, each prior-filed application must either be:

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

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

(2) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application, or international application designating the United States of America, that claims the benefit of one or more prior-filed nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date. If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76(b)(5)). The reference also must identify the relationship of the applications, namely, whether the later-filed application is a continuation, divisional, or continuation-in-
part of the prior-filed nonprovisional
application or international applica-
tion.

(3) The reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the later-filed application. If the later-filed application is a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application, four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior-filed application. Except as provided in paragraph (e) of this section, failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (d)(2) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to the prior-filed application. The time periods in this paragraph do not apply in a design application.

(4) The request for a continued prosecution application under §1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(5) Cross-references to other related applications may be made when appropriate (see §1.14), but cross-references to applications for which a benefit is not claimed under title 35, United States Code, must not be included in an application data sheet (§1.76(b)(5)).

(6) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a non-

37 CFR Ch. I (7–1–14 Edition)
of a prior-filed application must be accom-
panied by:
(1) The reference required by 35
U.S.C. 120 and paragraph (d)(2) of this
section to the prior-filed application,
unless previously submitted;
(2) The petition fee as set forth in
§1.17(m); and
(3) A statement that the entire delay
between the date the benefit claim was
due under paragraph (d)(3) of this sec-
tion and the date the benefit claim was
filed was unintentional. The Director
may require additional information
where there is a question whether the
delay was unintentional.
(f) Applications containing patentably
indistinct claims. Where two or more ap-
plications filed by the same applicant
contain patentably indistinct claims,
elimination of such claims from all but
one application may be required in the
absence of good and sufficient reason
for their retention during pendency in
more than one application.
(g) Applications or patents under reex-
amination naming different inventors and
containing patentably indistinct claims. If
an application or a patent under reex-
amination and at least one other appli-
cation naming different inventors are
owned by the same person and contain
patentably indistinct claims, and there
is no statement of record indicating
that the claimed inventions were com-
monly owned or subject to an obliga-
tion of assignment to the same person
on the effective filing date (as defined
in §1.109), or on the date of the inven-
tion, as applicable, of the later claimed
invention, the Office may require the
applicant to state whether the claimed
inventions were commonly owned or sub-
ject to an obligation of assignment to
the same person on such date. Even
if the claimed inventions were com-
monly owned, or subject to an obliga-
tion of assignment to the same person
on the effective filing date (as defined
in §1.109), or on the date of the inven-
tion, as applicable, of the later claimed
invention, the patentably indistinct
claims may be rejected under the doc-
trine of double patenting in view of
such commonly owned or assigned ap-
plications or patents under reexamina-
tion.
(h) Time periods not extendable. The
time periods set forth in this section
are not extendable.

§1.79 Reservation clauses not per-
mitted.
A reservation for a future application
of subject matter disclosed but not
claimed in a pending application will
not be permitted in the pending appli-
cation, but an application disclosing
unclaimed subject matter may contain
a reference to a later filed application
of the same applicant or owned by a
common assignee disclosing and claim-
ing that subject matter.

THE DRAWINGS

AUTHORITY: Secs. 1.81 to 1.88 also issued

§1.81 Drawings required in patent ap-
plication.
(a) The applicant for a patent is re-
quired to furnish a drawing of the in-
vention where necessary for the under-
standing of the subject matter sought
to be patented. Since corrections are
the responsibility of the applicant, the
original drawing(s) should be retained
by the applicant for any necessary fu-
ture correction.
(b) Drawings may include illustra-
tions which facilitate an understanding
of the invention (for example, flow
sheets in cases of processes, and dia-
grammatic views).
(c) Whenever the nature of the sub-
ject matter sought to be patented ad-
mits of illustration by a drawing with-
out its being necessary for the under-
standing of the subject matter and the
applicant has not furnished such a
drawing, the examiner will require its
submission within a time period of not
less than two months from the date of
the sending of a notice thereof.
(d) Drawings submitted after the fil-
ing date of the application may not be
used to overcome any insufficiency of
the specification due to lack of an ena-
bling disclosure or otherwise inade-
quate disclosure therein, or to supple-
ment the original disclosure thereof for