

(f) *Patent Law Treaty Model International Forms*. The requirement in §1.55 or §1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied by the presentation of such priority or benefit claim in the Patent Law Treaty Model International Request Form, and the requirement in §1.57(a) for a reference to the previously filed application in an application data sheet will be satisfied by the presentation of such reference to the previously filed application in the Patent Law Treaty Model International Request Form. The requirement in §1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied by the presentation of the name of the applicant in the Patent Law Treaty Model International Request Form, Patent Law Treaty Model International Request for Recordation of Change in Name or Address Form, or Patent Law Treaty Model International Request for Recordation of Change in Applicant or Owner Form, as applicable.

(g) *Patent Cooperation Treaty Request Form*. The requirement in §1.78 for the presentation of a benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet will be satisfied in a national stage application under 35 U.S.C. 371 by the presentation of such benefit claim in the Patent Cooperation Treaty Request Form contained in the international application or the presence of such benefit claim on the front page of the publication of the international application under PCT Article 21(2). The requirement in §1.55 or §1.78 for the presentation of a priority or benefit claim under 35 U.S.C. 119, 120, 121, or 365 in an application data sheet and the requirement in §1.46 for the presentation of the name of the applicant under 35 U.S.C. 118 in an application data sheet will be satisfied in an application under 35 U.S.C. 111 by the presentation of such priority or benefit claim and presentation of the name of the applicant in a Patent Cooperation Treaty Request Form. If a Patent Cooperation Treaty Request Form is submitted in an application under 35 U.S.C. 111, the Patent Cooperation Treaty Request Form must be accom-

panied by a clear indication that treatment of the application as an application under 35 U.S.C. 111 is desired.

[65 FR 54668, Sept. 8, 2000, as amended at 65 FR 57054, Sept. 20, 2000; 69 FR 56540, Sept. 21, 2004; 70 FR 54266, Sept. 14, 2005; 72 FR 46837, Aug. 21, 2007; 74 FR 52689, Oct. 14, 2009; 77 FR 48820, Aug. 14, 2012; 78 FR 11055, Feb. 14, 2013; 78 FR 62402, Oct. 21, 2013; 80 FR 17959, Apr. 2, 2015]

§1.77 Arrangement of application elements.

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

(1) Utility application transmittal form.

(2) Fee transmittal form.

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

(4) Specification.

(5) Drawings.

(6) The inventor's oath or declaration.

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

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

(2) Cross-reference to related applications.

(3) Statement regarding federally sponsored research or development.

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

(5) An incorporation by reference statement regarding the material in:

(i) One or more ASCII plain text files, submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see §1.52(e)(8)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes, for the following document types:

(A) A "Computer Program Listing Appendix" (see §1.96(c));

(B) A "Sequence Listing" (see §1.821(c)); or

(C) "Large Tables" (see §1.58(c)).

(ii) An XML file for a "Sequence Listing XML" (see §1.831(a)), submitted via the USPTO patent electronic filing system or on one or more read-only optical discs (see §1.52(e)(8)), identifying the names of each file, the date of creation of each file, and the size of each file in bytes.

§ 1.78

37 CFR Ch. I (7–1–24 Edition)

(6) Statement regarding prior disclosures by the inventor or a joint inventor.

(7) Background of the invention.

(8) Brief summary of the invention.

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

(10) Detailed description of the invention.

(11) A claim or claims.

(12) Abstract of the disclosure.

(13) “Sequence Listing,” required by § 1.821(c), that is submitted as a Portable Document Format (PDF) file (as set forth in § 1.821(c)(2)) via the USPTO patent electronic filing system or on physical sheets of paper (as set forth in § 1.821(c)(3)).

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

[65 FR 54668, Sept. 8, 2000, as amended at 70 FR 1823, Jan. 11, 2005; 77 FR 48820, Aug. 14, 2012; 78 FR 11055, Feb. 14, 2013; 86 FR 57047, Oct. 14, 2021; 86 FR 73985, Dec. 29, 2021; 87 FR 30817, May 20, 2022]

§ 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 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) The nonprovisional application or international application designating the United States must be:

(i) Filed not later than twelve months after the date on which the provisional application was filed, subject to paragraph (b) of this section (a subsequent application); or

(ii) Entitled to claim the benefit under 35 U.S.C. 120, 121, or 365(c) of a subsequent application that was filed within the period set forth in paragraph (a)(1)(i) of this section.

(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 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 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) (§ 1.491(a)), 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. The time periods in this paragraph do not apply if the later-filed application is:

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