

# Chapter 600: Parts, Form, and Content of Application

## 601 Content of Provisional and Nonprovisional Applications

I. GUIDELINES FOR DRAFTING A NONPROVISIONAL PATENT APPLICATION UNDER 35 U.S.C. 111(a)

II. GUIDELINES FOR DRAFTING A PROVISIONAL APPLICATION UNDER 35 U.S.C. 111(b)

III. THE APPLICATION

### 601.01 Complete Application

#### 601.01(a) Nonprovisional Applications Filed Under 35 U.S.C. 111(a)

I. APPLICATION FILING REQUIREMENTS

II. COMPLETION OF NONPROVISIONAL APPLICATION UNDER 35 U.S.C. 111 SUBSEQUENT TO FILING

A. Completion of Nonprovisional Application Filed On or After September 16, 2012

B. Completion of Nonprovisional Application Filed Before September 16, 2012.

#### 601.01(b) Provisional Applications Filed Under 35 U.S.C. 111(b)

#### 601.01(c) Conversion to or from a Provisional Application

I. CONVERSION FROM A NONPROVISIONAL APPLICATION TO A PROVISIONAL APPLICATION

II. CONVERSION FROM A PROVISIONAL APPLICATION TO A NONPROVISIONAL APPLICATION

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I. APPLICATION ENTITLED TO FILING DATE

II. APPLICATION NOT ENTITLED TO FILING DATE

III. APPLICATION LOCATED IN A TECHNOLOGY CENTER

A. Application Entitled to a Filing Date

B. Application NOT Entitled to a Filing Date

601.01(e) Nonprovisional Application Filed Without at Least One Claim

601.01(f) Applications Filed Without Drawings

601.01(g) Applications Filed Without All Figures of Drawings

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601.04 National Stage Requirements of the United States as a Designated Office

601.05 Bibliographic Information - Application Data Sheet (ADS)

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II. CORRECTING AND UPDATING AN ADS

III. TREATMENT OF INCONSISTENT INFORMATION

IV. ADDITIONAL INFORMATION

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III. TREATMENT OF INCONSISTENT INFORMATION

IV. ADDITIONAL INFORMATION

602 Oaths and Declarations

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B. VENUE

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- I. Naming Inventorship in application filed on or after September 16, 2012.
- II. Naming Inventorship in an Application filed Before September 16, 2012
- III. Correction of Inventorship

602.01(a) Inventor's Oath or Declaration in Application Filed On or After September 16, 2012

- I. IDENTITY OF INVENTOR(S), APPLICATION, AND REQUIRED STATEMENTS
  - A. INVENTOR NAME AND MAILING ADDRESS
  - B. IDENTIFICATION OF APPLICATION
  - C. REQUIRED STATEMENTS
- II. ASSIGNMENT-STATEMENT AS OATH OR DECLARATION
- III. EXECUTION OF INVENTOR'S OATH OR DECLARATION

602.01(b) Inventor's Oath or Declaration in Application Filed Before September 16, 2012

602.01(c) Correction of Inventorship, Name of Inventor, and Order of Names in an Application

- I. NAMING INVENTORSHIP
  - A. Applications Filed on or After September 16, 2012
  - B. Applications Filed Before September 16, 2012
- II. REQUESTS FOR CORRECTION OF INVENTORSHIP UNDER 37 CFR 1.48
- III. CORRECTION OF INVENTORSHIP BY FILING CONTINUING APPLICATION

602.01(c)(1) Correction of Inventorship in an Application – Request Filed On or After September 16, 2012

- I. 37 CFR 1.48(a) - Nonprovisional Application
- II. 37 CFR 1.48(b) – Inventor's Oath or Declaration for Added Inventor
- III. 37 CFR 1.48(c) – Request filed after Office Action on the Merits
- IV. 37 CFR 1.48(d) – Provisional Application

602.01(c)(2) Correcting or Updating Inventor Name 37 CFR 1.48(f) – Request Filed On or After September 16, 2012

602.01(c)(3) Correction of Inventorship in an Application – Request Under 37 CFR 1.48 Filed Prior to September 16, 2012

I. GENERAL INFORMATION

II. APPLICATIONS FILED UNDER 37 CFR 1.53(f) - NO OATH/DECLARATION

III. 37 CFR 1.48(a)

A. Statement of Lack of Deceptive Intention

B. Oath or Declaration

C. Fee

D. Written Consent of Assignee

E. Continuing Applications

IV. Pre-AIA 37 CFR 1.48(b)

V. Pre-AIA 37 CFR 1.48(c)

VI. Pre-AIA 37 CFR 1.48(d)

VII. Pre-AIA 37 CFR 1.48(e)

VIII. Pre-AIA 37 CFR 1.48(f)

602.02 New Oath or Substitute for Original

602.03 Office Finds the Inventor's Oath or Declaration Defective

602.04 Foreign Executed Oath

I. HAGUE CONVENTION APOSTILLE

II. CERTIFICATE OF DIPLOMATIC OR CONSULAR OFFICER

602.05 Oath or Declaration in Continuing Applications

602.05(a) Oath or Declaration in Continuing Applications Filed On or After September 16, 2012

602.05(b) Oath or Declaration in Continuing Applications Filed Before September 16, 2012

602.06 Non-English Oath or Declaration

602.07 Oath or Declaration Filed in United States as a Designated Office

## 602.08 Inventor and Application Information

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- I. INVENTOR'S CITIZENSHIP
- II. INVENTOR'S RESIDENCE
- III. INVENTOR'S MAILING OR POST OFFICE ADDRESS

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- I. SIGNATURE REQUIREMENT - EXECUTION OF INVENTOR'S OATHS OR DECLARATIONS
- II. SIGNATURE REQUIREMENT - EXECUTION OF OATH OR DECLARATION ON BEHALF OF INVENTOR
  - A. For applications filed on or after September 16, 2012
  - B. For applications filed before September 16, 2012
- III. INVENTOR'S NAME
  - A. Correction of Name
  - B. Change of Name
  - C. Order of Joint Inventor Names

### 602.08(c) Identification of Application

## 602.09 Joint Inventors

## 603 Supplemental Oath or Declaration

- I. APPLICATIONS FILED ON OR AFTER SEPTEMBER 16, 2012
- II. APPLICATIONS FILED BEFORE SEPTEMBER 16, 2012

### 603.01 Supplemental Oath or Declaration Filed After Allowance

## 604 Substitute Statements

## 605 Applicant

### 605.01 Applicant for Application filed on or after September 16, 2012

- I. DEFINITION OF APPLICANT
- II. CHANGE OF APPLICANT

605.02 Applicant for Application Filed Before September 16, 2012

606 Title of Invention

606.01 Examiner May Require Change in Title

607 Filing Fee

- I. BASIC FILING, SEARCH, AND EXAMINATION FEES
- II. APPLICATION SIZE FEE
- III. EXCESS CLAIMS FEES
- IV. NON-ELECTRONIC FILING FEE
- V. APPLICANT DOES NOT SPECIFY FEES TO WHICH PAYMENT IS TO BE APPLIED

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- I. MANNER OF MAKING A REFUND
- II. TIME PERIOD FOR REQUESTING A REFUND
- III. FEES PAID BY DEPOSIT ACCOUNT
- IV. LATER ESTABLISHMENT OF SMALL ENTITY STATUS
- V. REFUND OF SEARCH FEE AND EXCESS CLAIMS FEE

608 Disclosure

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- I. PAPER REQUIREMENTS
- II. ALTERATION OF APPLICATION PAPERS
- III. CERTIFIED COPIES OF AN APPLICATION-AS-FILED
- IV. USE OF METRIC SYSTEM OF MEASUREMENTS IN PATENT APPLICATIONS
- V. FILING OF NON-ENGLISH LANGUAGE APPLICATIONS
- VI. ILLUSTRATIONS IN THE SPECIFICATION
- VII. Hyperlinks and Other Forms of Browser-Executable Code in the Specification

608.01(a) Arrangement of Application

608.01(b) Abstract of the Disclosure

## I. GUIDELINES FOR THE PREPARATION OF PATENT ABSTRACTS

- A. Background
- B. Content
- C. Language and Format
- D. Responsibility
- E. Sample Abstracts

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608.01(d) Brief Summary of Invention

608.01(e) Reservation Clauses Not Permitted

608.01(f) Brief Description of Drawings

608.01(g) Detailed Description of Invention

608.01(h) Mode of Operation of Invention

608.01(i) Claims

608.01(j) Numbering of Claims

608.01(k) Statutory Requirement of Claims

608.01(l) Claims Present on the Application Filing Date

608.01(m) Form of Claims

608.01(n) Dependent Claims

## I. MULTIPLE DEPENDENT CLAIMS

- A. Acceptable Multiple Dependent Claim Wording
- B. Unacceptable Multiple Dependent Claim Wording
  - 1. Claim Does Not Refer Back in the Alternative Only
  - 2. Claim Does Not Refer to a Preceding Claim
  - 3. Reference to Two Sets of Claims to Different Features
  - 4. Reference Back to Another Multiple Dependent Claim
- C. Restriction Practice

D. Handling of Multiple Dependent Claims by the Office of Patent Application Processing

E. Handling of Multiple Dependent Claims by the Technology Center Technical Support Staff

F. Handling of Multiple Dependent Claims by the Examiner

G. Fees for Multiple Dependent Claims

1. Use of Form PTO/SB/07

2. Calculation of Fees

(a) Proper Multiple Dependent Claim

(b) Improper Multiple Dependent Claim

(c) Fee calculation example

i) Comments On Fee Calculation Example

ii) Calculation of Fee in Fee Example

II. TREATMENT OF IMPROPER DEPENDENT CLAIMS

III. INFRINGEMENT TEST

IV. CLAIM FORM AND ARRANGEMENT

V. REJECTION AND OBJECTION

608.01(o) Basis for Claim Terminology in Description

608.01(p) Completeness of Specification

I. INCORPORATION BY REFERENCE

A. Review of Applications Which Are To Issue as Patents.

1. Complete Disclosure Filed

2. Improper Incorporation

B. Review of Applications Which Are Relied on To Establish an Earlier Effective Filing Date.

II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

608.01(q) Substitute or Rewritten Specification

608.01(r) Derogatory Remarks About Prior Art in Specification



608.01(s) Restoration of Canceled Matter

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I. PERMISSIBLE USE IN PATENT APPLICATIONS

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I. FILING DATE IN THE ABSENCE OF DRAWING

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V. DRAWING STANDARDS

VI. DEFINITIONS

VII. BLACK AND WHITE PHOTOGRAPHS

VIII. COLOR DRAWINGS OR COLOR PHOTOGRAPHS

IX. DRAWING SYMBOLS

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608.02(b) Acceptability of Drawings

I. ACCEPTABILITY OF DRAWINGS

II. NOTIFYING APPLICANT

III. HANDLING OF REPLACEMENT DRAWINGS

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608.02(e) Examiner Determines Completeness and Consistency of Drawings

608.02(f) Modifications in Drawings

608.02(g) Illustration of Prior Art

608.02(h) Replacement Drawings

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608.02(v) Drawing Changes Which Require Annotated Sheets

608.02(w) Drawing Changes Which May Be Made Without Applicant's Annotated Sheets

608.02(x) Drawing Corrections or Changes Accepted Unless Notified Otherwise

608.02(y) Return of Drawing

608.02(z) Allowable Applications Needing Drawing Corrections or Corrected Drawings

I. UTILITY PATENT APPLICATIONS RECEIVING REPLACEMENT DRAWINGS  
AFTER THE NOTICE OF ALLOWABILITY

II. 37 CFR 1.312 AMENDMENTS

608.03 Models, Exhibits, Specimens

608.03(a) Handling of Models, Exhibits, and Specimens

608.04 New Matter

608.04(a) Matter Not Present in Specification, Claims, or Drawings on the Application Filing Date

608.04(b) New Matter by Preliminary Amendment

608.04(c) Review of Examiner's Holding of New Matter

608.05 Sequence Listing, Table, or Computer Program Listing Appendix Submitted in Electronic Form

I. TEXT FILES SUBMITTED VIA EFS-WEB

A. Information Specific to Sequence Listings

B. Application Size Fee

C. Size Limit for Text Files

II. Submissions On Compact Disc

608.05(a) Deposit of Computer Program Listings

I. BACKGROUND

II. DISCUSSION OF THE BACKGROUND AND MAJOR ISSUES INVOLVED

III. OTHER INFORMATION

608.05(b) Compact Disc Submissions of Large Tables

608.05(c) Submissions of Biological Sequence Listings as ASCII Files

609 Information Disclosure Statement

609.01 Examiner Checklist for Information Disclosure Statements

609.02 Information Disclosure Statements in Continued Examinations or Continuing Applications

A. IDS That Has Been Considered (1) in the Parent Application, or (2) Prior to the Filing of a Request for Continued Examination (RCE)

1. Continued Prosecution Applications (CPAs) Filed Under 37 CFR 1.53(d)
2. Continuation Applications, Divisional Applications, or Continuation-in-Part Applications Filed Under 37 CFR 1.53(b)
3. Requests for Continued Examination (RCE) Under 37 CFR 1.114

B. IDS That Has Not Been Considered (1) in the Parent Application, or (2) Prior to the Filing of a Request for Continued Examination

1. Continued Prosecution Applications Filed Under 37 CFR 1.53(d)
2. Continuation Applications, Divisional Applications, or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)
3. Requests for Continued Examination Under 37 CFR 1.114

609.03 Information Disclosure Statements in National Stage Applications

609.04(a) Content Requirements for an Information Disclosure Statement

I. LIST OF ALL PATENTS, PUBLICATIONS, U.S. APPLICATIONS, OR OTHER INFORMATION

II. LEGIBLE COPIES

III. CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION

#### 609.04(b) Timing Requirements for an Information Disclosure Statement

##### I. INFORMATION DISCLOSURE STATEMENT FILED BEFORE FIRST ACTION ON THE MERITS OR WITHIN THREE (3) MONTHS OF ACTUAL FILING DATE (37 CFR 1.97(b))

A. National or International Applications

B. RCE and CPA

##### II. INFORMATION DISCLOSURE FILED AFTER I. ABOVE BUT BEFORE MAILING OF FINAL ACTION, NOTICE OF ALLOWANCE, OR AN EX PARTE QUAYLE ACTION (37 CFR 1.97(c))

A. Information is Used in a New Ground of Rejection

1. Final Rejection is Not Appropriate

2. Final Rejection Is Appropriate

##### III. INFORMATION DISCLOSURE STATEMENT FILED AFTER II. ABOVE BUT PRIOR TO PAYMENT OF ISSUE FEE (37 CFR 1.97(d))

##### IV. INFORMATION DISCLOSURE STATEMENT FILED AFTER PAYMENT OF ISSUE FEE

##### V. STATEMENT UNDER 37 CFR 1.97(e)

##### VI. EXTENSIONS OF TIME (37 CFR 1.97(f))

#### 609.05 Examiner Handling of Information Disclosure Statements

##### 609.05(a)-Noncomplying Information Disclosure Statements

##### 609.05(b) Complying Information Disclosure Statements

##### 609.05(c) Documents Submitted as Part of Applicant's Reply to Office Action

#### 609.06 Information Printed on Patent

#### 609.07 IDSs Electronically Submitted (e-IDS) Using EFS

#### 609.08 Electronic Processing of Information Disclosure Statement