

Patent Laws and Regulations

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[Added 47 FR 41274, Sept. 17, 1982, effective date Oct. 1, 1982; paras. (b) and (l), 49 FR 553, Jan. 4, 1984, effective date Apr. 1, 1984; paras. (a)(5) and (6) added, 50 FR 5171, Feb. 6, 1985, effective date Apr. 8, 1985; 50 FR 31825, Aug. 6, 1985, effective date Oct. 5, 1985; paras. (a), (b)(1), (d)-(j), (l)-(m), 54 FR 6893, Feb. 15, 1989, 54 FR 8053, Feb. 24, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (n) added 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (o)-(q) added 54 FR 50942, Dec. 11, 1989, effective Feb. 12, 1990; paras. (a)-(c), (e)-(h), (j)-(l) & (n) amended, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (p) and (q) deleted, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1), (a)(5), (a)(6), (b)(2), (b)(3), (e) and (i), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) added, 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (p) deleted, 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (l) amended, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (a)(1) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995]

37 CFR 1.22 Fees payable in advance.

(a) Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under § 1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

(b) All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent, or other proceeding in such a manner that it is clear for which purpose the fees are paid.

*Patent Laws and Regulations**[48 FR 2708, Jan. 20, 1983, effective Feb. 27, 1983]***37 CFR 1.23 Method of payment.**

All payments of money required for Patent and Trademark Office fees, including fees for the processing of international applications (§ 1.445), should be made in U.S. specie, Treasury notes, national bank notes, post office money orders, or by certified check. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Patent and Trademark Office will be at the risk of the sender; letters containing money should be registered.

*[43 FR 20462, May 11, 1978]***37 CFR 1.24 Coupons.**

Coupons in denominations of three dollars, for the purchase of patents, designs, defensive publications, statutory invention registrations, and trademark registrations are sold by the Patent and Trademark Office for the convenience of the general public; these coupons may not be used for any other purpose. The three-dollar coupons are sold individually and in books of 50 for \$150.00. These coupons are good until used; they may be transferred but cannot be redeemed.

*[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2708, Jan. 20, 1983, effective date Feb. 27, 1983; 50 FR 31825, Aug. 6, 1985, effective Oct. 5, 1985; 51 FR 28057, Aug. 4, 1986; 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991]***37 CFR 1.25 Deposit accounts.**

(a) For the convenience of attorneys, and the general public in paying any fees due, in ordering services offered by the Office, copies of records, etc. deposit accounts may be established in the Patent and Trademark Office upon payment of the fee for establishing a deposit account § 1.21(b)(1)). A minimum deposit of \$1,000 is required for paying any fee due or in ordering any services offered by the Office. However, a minimum deposit of \$300 may be paid to establish a restricted subscription deposit account used exclusively for subscription order of patent copies as issued. At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit value. An amount sufficient to cover all fees, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted. A service charge (§ 1.21(b)(2)) will be assessed for each month that the balance at the end of the month is below \$1,000. For restricted subscription deposit accounts, a service charge (§ 1.21(b)(3)) will be assessed for each month that the balance at the end of the month is below \$300.

(b) Filing, issue, appeal, international-type search report, international application processing, petition, and post-issuance fees may be charged against these accounts if sufficient funds are on deposit to cover such fees. A general authorization to charge all fees, or only certain fees, set forth in §§ 1.16 to 1.18 to a deposit account containing sufficient funds may be filed in an individual application, either for the entire pendency of the application or with respect to a particular paper filed. An authorization to charge to a deposit account the fee for a request for reexamination pursuant to § 1.510 and any other fees required in a reexamination proceeding in a patent may also be filed with the request for reexamination. An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

*[49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985]***37 CFR 1.26 Refunds.**

(a) Money paid by actual mistake or in excess will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five

Patent Laws and Regulations

dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amount; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account.

(b) [Reserved]

(c) If the Commissioner decides not to institute a reexamination proceeding, a refund of \$1,690 will be made to the requester of the proceeding. Reexamination requesters should indicate whether any refund should be made by check or by credit to a deposit account.

[47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 50 FR 31826 Aug. 6, 1985, effective Oct. 5, 1985; para. (c), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (c), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a) and (c), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992]

37 CFR 1.27 Statement of status as small entity.

(a) Any person seeking to establish status as a small entity (§ 1.9(f) of this part) for purposes of paying fees in an application or a patent must file a verified statement in the application or patent prior to or with the first fee paid as a small entity. Such a verified statement need only be filed once in an application or patent and remains in effect until changed.

(b) Any verified statement filed pursuant to paragraph (a) of this section on behalf of an independent inventor must be signed by the independent inventor except as provided in §§ 1.42, 1.43, or 1.47 of this part and must aver that the inventor qualifies as an independent inventor in accordance with § 1.9(c) of this part. Where there are joint inventors in an application, each inventor must file a verified statement establishing status as an independent inventor in order to qualify as a small entity. Where any rights have been assigned, granted, conveyed, or licensed, or there is an obligation to assign, grant, convey, or license, any rights to a small business concern, a nonprofit organization, or any other individual, a verified statement must be filed by the individual, the owner of the small business concern, or an official of the small business concern or nonprofit organization empowered to act on behalf of the small business concern or nonprofit organization averring to their status. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(c) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a small business concern must

- (1) be signed by the owner or an official of the small business concern empowered to act on behalf of the concern;
- (2) aver that the concern qualifies as a small business concern as defined in § 1.9(d); and
- (3) aver that exclusive rights to the invention have been conveyed to and remain with the small business concern or, if the rights are not exclusive, that all other rights belong to small entities as defined in § 1.9.

Where the rights of the small business concern as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a license as set forth in § 1.9 of this part.

(d) Any verified statement filed pursuant to paragraph (a) of this section on behalf of a nonprofit organization must

- (1) be signed by an official of the nonprofit organization empowered to act on behalf of the organization;
- (2) aver that the organization qualifies as a nonprofit organization as defined in § 1.9(e) of this part specifying under which one of § 1.9(e)(1), (2), (3), or (4) of this part the organization qualifies; and
- (3) aver that exclusive rights to the invention have been conveyed to and remain with

Patent Laws and Regulations

the organization or if the rights are not exclusive that all other rights belong to small entities as defined in § 1.9 of this part.

Where the rights of the nonprofit organization as a small entity are not exclusive, a verified statement must also be filed by the other small entities having rights averring to their status as such. For purposes of a verified statement under this paragraph, a license to a Federal agency resulting from a funding agreement with that agency pursuant to 35 U.S.C. 202(c)(4) does not constitute a conveyance of rights as set forth in this paragraph.

[47 FR 40139, Sept. 10, 1982, added effective Oct. 1, 1982; para. (c) added, 47 FR 43276, Sept. 30, 1982; paras. (b), (c), and (d), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984]

37 CFR 1.28 Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application or includes a copy of the verified statement in the prior application and status as a small entity is still proper and desired. Once status as a small entity has been established in an application or patent, the status remains in that application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status.

(b) Once status as a small entity has been established in an application or patent, fees as a small entity may thereafter be paid in that application or patent without regard to a change in status until the issue fee is due or any maintenance fee is due. Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application or patent prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate pursuant to § 1.9 of this part. The notification of change in status may be signed by the applicant, any person authorized to sign on behalf of the assignee, or an attorney or agent of record or acting in a representative capacity pursuant to § 1.34(a) of this part.

(c) If status as a small entity is established in good faith, and fees as a small entity are paid in good faith, in any application or patent, and it is later discovered that such status as a small entity was established in error or that through error the Office was not notified of a change in status as required by paragraph (b) of this section, the error will be excused

- (1) if any deficiency between the amount paid and the amount due is paid within three months after the date the error occurred or
- (2) if any deficiency between the amount paid and the amount due is paid more than three months after the date the error occurred and the payment is accompanied by a statement explaining how the error in good faith occurred and how and when the error was discovered. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full.

(d)(1) Any attempt to fraudulently

Patent Laws and Regulations

- (i) establish status as a small entity or
- (ii) pay fees as a small entity shall be considered as a fraud practiced or attempted on the Office.
- (2) Improperly and with intent to deceive
 - (i) establishing status as a small entity or
 - (ii) paying fees as a small entity shall be considered as a fraud practiced or attempted on the Office.

[47 FR 40140, Sept. 10, 1982, added effective Oct. 1, 1982; para. (a), 49 FR 553, Jan. 4, 1984, effective Apr. 1, 1984; para. (d)(2), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c) revised, 58 FR 54504, Oct. 22, 1993, effective Jan 3, 1994; para. (a) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

SUBPART B –NATIONAL PROCESSING PROVISIONS**PROSECUTION OF APPLICATION AND APPOINTMENT OF ATTORNEY OR AGENT****37 CFR 1.31 Applicants may be represented by a registered attorney or agent.**

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases. See § 10.6 and § 10.9 of this subchapter. The Patent and Trademark Office cannot aid in the selection of a registered attorney or agent.

[50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 1.32 [Reserved]

[Deleted 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

37 CFR 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

(a) The residence and post office address of the applicant must appear in the oath or declaration if not stated elsewhere in the application. The applicant may also specify an attorney or agent of record may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the case will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see § 1.34(b)), or, if no attorney or agent is of record, to the applicant, or to any assignee of record of the entire interest if the applicant or such assignee so requests, or to an assignee of an undivided part if the applicant so requests, at the post office address of which the Office has been notified in the case. Amendments and other papers filed in the application must be signed:

- (1) by the applicant, or
- (2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
- (3) if there is an assignee of record of the entire interest, by such assignee, or
- (4) by an attorney or agent of record, or
- (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a).

Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent be made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

- (b) An applicant who has not made of record a registered attorney or agent may be required to

Patent Laws and Regulations

state whether he received assistance in the preparation or prosecution of his application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. This includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (see § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to § 10.5 and § 10.11 or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a). Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent is of record and a correspondence address has not been specified, correspondence will be held with the last attorney or agent made of record.

(d) A "correspondence address" or change thereto may be filed with the Patent and Trademark Office during the enforceable life of the patent. The "correspondence address" will be used in any correspondence relating to maintenance fees unless a separate "fee address" has been specified. See § 1.363 for "fee address" used solely for maintenance fee purposes.

[36 FR 12617, July 2, 1971; 46 FR 29181, May 29, 1981; para. (d) added, 49 FR 34724, Aug. 31, 1984, effective Nov. 1, 1984; para. (c), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 1.34 Recognition for representation.

(a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent and Trademark Office in a patent case, his or her personal appearance or signature shall constitute a representation to the Patent and Trademark Office that under the provisions of this subchapter and the law, he or she is authorized to represent the particular party in whose behalf he or she acts. In filing such a paper, the registered attorney or agent should specify his or her registration number with his or her signature. Further proof of authority to act in a representative capacity may be required.

(b) When an attorney or agent shall have filed his or her power of attorney, or authorization, duly executed by the person or persons entitled to prosecute an application or a patent involved in a reexamination proceeding, he or she is a principal attorney of record in the case. A principal attorney or agent, so appointed, may appoint an associate attorney or agent who shall also then be of record.

[46 FR 29181, May 29, 1981; para. (a), 50 FR 5171, Feb. 6, 1985, effective Mar. 6, 1985]

37 CFR 1.36 Revocation of power of attorney or authorization; withdrawal of attorney or agent.

A power of attorney or authorization of agent may be revoked at any stage in the proceedings of a case, and an attorney or agent may withdraw, upon application to and approval by the Commissioner. An attorney or agent, except an associate attorney or agent whose address is the same as that of the principal attorney or agent, will be notified of the revocation of the power of attorney or authorization, and the applicant or patent owner will be notified of the withdrawal of the attorney or agent. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by an attorney or agent of the assignee's own selection. See § 1.613(d) for withdrawal of an attorney or agent of record in an interference.

[49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985]

WHO MAY APPLY FOR A PATENT**37 CFR 1.41 Applicant for patent.**

(a) A patent must be applied for in the name of the actual inventor or inventors. Full names must be stated, including the family name, and at least one given name without abbreviation together with any other given name or initial.

(b) Unless the contrary is indicated the word “applicant” when used in these sections refers to the inventor or joint inventors who are applying for a patent, or to the person mentioned in §§ 1.42, 1.43 or 1.47 who is applying for a patent in place of the inventor.

(c) Any person authorized by the applicant may file an application for patent on behalf of the inventor or inventors, but an oath or declaration for the application (§ 1.63) can only be made in accordance with § 1.64.

(d) A showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.

[48 FR 2708, Jan. 20, 1983; 48 FR 4285, Jan. 31, 1983]

37 CFR 1.42 When the inventor is dead.

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

37 CFR 1.43 When the inventor is insane or legally incapacitated.

In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

37 CFR 1.44 Proof of authority.

In the cases mentioned in §§ 1.42 and 1.43, proof of the power or authority of the legal representative must be recorded in the Patent and Trademark Office or filed in the application before the grant of a patent.

37 CFR 1.45 Joint inventors.

(a) Joint inventors must apply for a patent jointly and each must make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in § 1.47.

(b) Inventors may apply for a patent jointly even though

- (1) They did not physically work together or at the same time,
- (2) Each inventor did not make the same amount of contribution, or
- (3) Each inventor did not make a contribution to the subject matter of every claim of the application.

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

[paras. (b) and (c), 47 FR 41274, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb.

Patent Laws and Regulations

27, 1983; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

37 CFR 1.46 Assigned inventions and patents.

In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made or authorized to be made, and an oath or declaration signed, by the inventor or one of the persons mentioned in §§ 1.42, 1.43, or 1.47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in § 3.81.

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; 57 FR 29642, July 6, 1992, effective Sept. 4, 1992]

37 CFR 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the omitted inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he or she had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and by the required fee (§ 1.17(h)) and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent and Trademark Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The inventor may subsequently join in the application on filing an oath or declaration of the character required by § 1.63. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

[47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983]

37 CFR 1.48 Correction of inventorship.

(a) If the correct inventor or inventors are not named in a nonprovisional application through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by:

- (1) a petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred;
- (2) an oath or declaration by each actual inventor or inventors as required by § 1.63;
- (3) the fee set forth in § 1.17(h); and
- (4) the written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the nonprovisional application when filed and the

Patent Laws and Regulations

prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

- (1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and
- (2) The fee set forth in § 1.17(h).

(c) If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

(d) If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the actual inventor or inventors, the provisional application may be amended to add the name or names of the actual inventor or inventors. Such amendment must be accompanied by:

- (1) a petition including a statement that the error occurred without deceptive intention on the part of the actual inventor or inventors, which statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office; and
- (2) the fee set forth in § 1.17(q).

(e) If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Such amendment must be accompanied by:

- (1) a petition including a statement of facts verified by the person or persons whose name or names are being deleted establishing that the error occurred without deceptive intention;
- (2) the fee set forth in § 1.17(q); and
- (3) the written consent of any assignee.

[48 FR 270-9, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; 50 FR 9379, Mar. 7, 1985, effective May 8, 1985; para. (a), 57 FR 56446, Nov. 30, 1992, effective Jan. 4, 1993; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

THE APPLICATION

37 CFR 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

- (1) A complete application filed under § 1.53(b)(1) comprises:
 - (i) A specification, including a claim or claims, see §§ 1.71 to 1.77;
 - (ii) An oath or declaration, see §§ 1.63 and 1.68;
 - (iii) Drawings, when necessary, see §§ 1.81 to 1.85; and
 - (iv) The prescribed filing fee, see § 1.16.
- (2) A complete provisional application filed under § 1.53(b)(2) comprises:
 - (i) A cover sheet identifying:
 - (A) The application as a provisional application,
 - (B) The name or names of the inventor or inventors, (see § 1.41),

Patent Laws and Regulations

- (C) The residence of each named inventor,
 - (D) The title of the invention,
 - (E) The name and registration number of the attorney or agent (if applicable),
 - (F) The docket number used by the person filing the application to identify the application (if applicable),
 - (G) The correspondence address, and
 - (H) 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);
- (ii) A specification as prescribed by 35 U.S.C. 112, first paragraph, see § 1.71;
 - (iii) Drawings, when necessary, see §§ 1.81 to 1.85; and
 - (iv) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §§ 1.97 and 1.98. No information disclosure statement may be filed in a provisional application.

(c) Applicants may desire and are permitted to file with, or in, the application or authorization to charge, at any time during the pendency of the application, any fees required under any of §§ 1.16 to 1.18 to a deposit account established and maintained in accordance with § 1.25.

[42 FR 5593, Jan. 28, 1977; paras. (a) and (c), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; paras. (a) and (b), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; paras. (a) & (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

37 CFR 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language. All papers which are to become apart of the permanent records of the Patent and Trademark Office must be legibly written, typed, or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing, typing, or printing thereon to permit the direct production of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

(b) The application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in §§ 1.42, 1.43, 1.47, etc.) and also papers subsequently filed, must be plainly written on but one side of the paper. The size of all sheets of paper should be 8 to 8 1/2 by 10 1/2 to 13 inches (20.3 to 21.6 cm. by 26.6 to 33.0 cm.) A margin of at least approximately 1 inch (2.5 cm.) must be reserved on the left-hand of each page. The top of each page of the application, including claims must have a margin of at least approximately 3/4 inch (2 cm.). The lines must not be crowded too closely together; typewritten lines should be 1 1/2 or double spaced. The pages of the application including claims and abstract should be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text.

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67(c). After the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by ww1.121 and 1.123 through 1.125.

Patent Laws and Regulations

(d) An application may be filed in a language other than English. A verified English translation of the non-English language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time as may be set by the Office.

[43 FR 20462, May 11, 1978; paras. (a) and (d), 47 FR 41275, Sept. 17, 1982, effective Oct. 1, 1982; para. (c), 48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; para. (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

37 CFR 1.53 Application number, filing date, and completion of application.

(a) Any application for a patent received in the Patent and Trademark Office will be assigned an application number for identification purposes.

(b)(1) The filing date of an application for patent filed under this section, except for a provisional application, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in (§ 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed under this section, § 1.60 or § 1.62. A continuation-in-part application may be filed under this section or § 1.62.

(2) The filing date of a provisional application is the date on which: a specification as prescribed by 35 U.S.C. 112, first paragraph; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No amendment, other than to make the provisional application comply with all applicable regulations, may be made to the provisional application after the filing date of the provisional application. If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.

(i) A provisional application must also include a cover sheet identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under § 1.53(b)(1).

(ii) An application for patent filed under § 1.53(b)(1) may be treated as a provisional application and be accorded the original filing date provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of 12 months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under § 1.53(b)(1).

(iii) A provisional application shall not be entitled to the right of priority under § 1.55 or 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date under § 1.78 or 35 U.S.C. 120, 121 or 365(c) of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821-1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

(c) If any application is filed without the specification, drawing or name, or names, of the

Patent Laws and Regulations

actual inventor or inventors required by paragraph (b)(1) or (b)(2) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n). Any request for review of a refusal to accord an application a filing date must be by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2).

(d)(1) If an application which has been accorded a filing date pursuant to paragraph (b)(1) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

- (2) If a provisional application which has been accorded a filing date pursuant to paragraph (b)(2) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which the required basic filing fee has not been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application.

(e)(1) An application for a patent filed under paragraph (b)(1) of this section will not be placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

- (2) A provisional application for a patent filed under paragraph (b)(2) of this section will not be placed upon the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(f) The filing date of an international application designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

[48 FR 2709, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (d), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (c), 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; paras. (c) and (d), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; paras. (b) and (c), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; paras. (a)-(e) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

*Patent Laws and Regulations***37 CFR 1.54 Parts of application to be filed together; filing receipt.**

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See § 1.53 with regard to completion of an application.

(b) Applicant will be informed of the application serial number and filing date by a filing receipt.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983]

37 CFR 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a)-(d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in § 1.17(i). If the certified copy filed is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

[para. (b), 48 FR 41275, Sept. 17, 1982, effective Oct. 1 1982; 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; para. (b), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; para. (a), 49 FR 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (a), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 54 FR 47518, Nov. 15, 1989, effective Jan. 16, 1990; para. (a) revised, 58 FR 54504, Oct. 22, 1993, effective Jan 3, 1994; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

37 CFR 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed

Patent Laws and Regulations

by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

[42 FR 5593, Jan. 28, 1977; paras. (d) & (e) - (i), 47 FR 21751, May 19, 1982, effective July 1, 1982; para. (c), 48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; paras. (b) and (j), 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; paras. (d) and (h), 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992]

37 CFR 1.57 [Reserved]

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983]

37 CFR 1.58 Chemical and mathematical formulas and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) All tables and chemical and mathematical formulas in the specification, including claims, and amendments thereto, must be on paper which is flexible, strong, white, smooth, non-shiny, and durable in order to permit use as camera copy when printing any patent which may issue. A good grade of bond paper is acceptable; watermarks should not be prominent. India ink or its equivalent, or solid black typewriter, should be used to secure perfectly black solid lines.

Patent Laws and Regulations

(c) To facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 5 inches (12.7 cm.) so that it may appear as a single column in the printed patent. If it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10 3/4 inches (27.3 cm.) and to place it sideways on the sheet. Typewritten characters used in such formulas and tables must be from a block (nonscript) type font or lettering style having capital letters which are at least 0.08 inch (2.1 mm.) high (e.g., elite type). Hand lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.). A space at least 1/4 inch (6.4 mm.) high should be provided between complex formulas and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with high degree of legibility.

[43 FR 20463, May 11, 1978]

37 CFR 1.59 Papers of application with filing date not to be returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or, if the application was filed under § 1.53(b)(1), the processing and retention fee § 1.21(l)) has been paid. See § 1.618 for return of unauthorized and improper papers in interferences.

[48 FR 2710, Jan. 20, 1983, effective Feb. 27, 1983; 49 FR 554, Jan. 4, 1984, effective Apr. 1, 1984; 49 FR 48416, Dec. 12, 1984; 50 FR 23123, May 31, 1985, effective Feb. 11, 1985; revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995]

37 CFR 1.60 Continuation or divisional application for invention disclosed in a prior nonprovisional application.

(a) [RESERVED]

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application (filed under the conditions specified in 35 U.S.C.120 or 121 and § 1.78(a)) if:

- (1) the prior application was a nonprovisional application and a complete application as set forth in § 1.51(a)(1);
- (2) applicant indicates that the application is being filed pursuant to this section and files a true copy of the prior complete application as filed including the specification (with claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application;
- (3) the inventors named in the continuation or divisional application are the same or less than all the inventors named in the prior application; and
- (4) the application is filed before the patenting, or abandonment of, or termination of proceedings on the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior complete application. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date. If the continuation or divisional application is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. Except as provided in paragraph (d) of this section, if a true copy of the prior application as filed is not filed with the application or if the statement that the application papers are a true copy is omitted, the application will not be given a filing date earlier than the date upon which the copy and statement are filed, unless a petition with the fee set forth in § 1.17(i) is filed which satisfactorily explains the delay in filing these items.