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deceased inventor may file an international application which designates the United States of America.

37 CFR 1.423 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 file an international application which designates the United States of America.

37 CFR 1.424 Joint inventors.

Joint inventors must jointly file an international application which designates the United States of America; the signature of either of them alone, or less than the entire number, will be insufficient for an invention invented by them jointly, except as provided in § 1.425.

37 CFR 1.425 Filing by other than inventor.

(a) If a joint inventor refuses to join in an international application which designates the United States of America or cannot be found or reached after diligent effort, the international application which designates the United States of America may be filed by the other inventor on behalf of himself or herself and the omitted inventor. Such an international application which designates the United States of America must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent and Trademark Office shall forward notice of the filing of the international application to the omitted inventor at said address.

(b) Whenever an inventor refuses to execute an international application which designates the United States of America, 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 file the international application on behalf of and as agent for the inventor. Such an international application which designates the United States of America must be accompanied by 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 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.

THE INTERNATIONAL APPLICATION**37 CFR 1.431 International application requirements.**

(a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). (PCT Art. 3(2) and Section 207 of the Administrative Instructions.)

(b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:

- (1) At least one applicant is a United States resident or national and the papers filed at the time of receipt of the international application so indicate (35 U.S.C. 361(a), PCT Art. 11(1)(i)).
- (2) The international application is in the English language (35 U.S.C. 361(c), PCT Art. 11(1)(ii)).
- (3) The international application contains at least the following elements (PCT Art. 11(1)(iii)):
 - (i) An indication that it is intended as an international application (PCT Rule 4.2);
 - (ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ 1.432);
 - (iii) The name of the applicant, as prescribed (note §§ 1.421-1.424);

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- (iv) A part which on the face of it appears to be a description; and
- (v) A part which on the face of it appears to be a claim.

(c) Payment of the basic portion of the international fee (PCT Rule 15.2) and the transmittal and search fees (§ 1.445) may be made in full at the time the international application papers required by paragraph (b) of this section are deposited or within one month thereafter. If the basic, transmittal and search fees are not paid within one month from the date of receipt of the international application, applicant will be notified and given one month within which to pay the deficient fees plus a late payment fee equal to the greater of:

- (1) 50% of the amount of the deficient fees up to a maximum amount equal to the basic fee, or
- (2) an amount equal to the transmittal fee (PCT Rule 16bis).

The one-month time limit set in the notice to pay deficient fees may not be extended.

(d) If the payment needed to cover the transmittal fee, the basic fee, the search fee, one designation fee and the late payment fee pursuant to paragraph (c) of this section is not timely made, the Receiving Office will declare the international application withdrawn under PCT Article 14(3)(a).

[43 FR 20486, May 11, 1978; paras. (b), (c), (d) and (e), 50 FR 9383, Mar. 7, 1985, effective May 8, 1985; para. (d) amended 52 FR 20047, May 28, 1987; paras. (b)(1), (b)(3)(ii), (c) and (d) amended, para. (e) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.432 Designation of States and payment of designation fees.

(a) The designation of States including an indication that applicant wishes to obtain a regional patent, where applicable, shall appear in the Request upon filing and must be indicated as set forth in PCT Rule 4.9 and section 115 of the Administrative Instructions. Applicant must specify at least one national or regional designation on filing of the international application for a filing date to be granted.

(b) If the fees necessary to cover all the national and regional designations specified in the Request are not paid by the applicant within one year from the priority date or within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, applicant will be notified and given one month within which to pay the deficient designation fees plus a late payment fee equal to the greater of 50% of the amount of the deficient fees up to a maximum amount equal to the basic fee, or an amount equal to the transmittal fee (PCT Rule 16bis). The one-month time limit set in the notification of deficient designation fees may not be extended. Failure to timely pay at least one designation fee will result in the withdrawal of the international application. The one designation fee may be paid:

- (1) within one year from the priority date,
- (2) within one month from the date of receipt of the international application if that month expires after the expiration of one year from the priority date, or
- (3) with the late payment fee defined in this paragraph within the time set in the notification of the deficient designation fees. If after a notification of deficient designation fees the applicant makes timely payment, but the amount paid is not sufficient to cover the late payment fee and all designation fees, the Receiving Office will, after allocating payment for the basic, search, transmittal and late payment fees, allocate the amount paid in accordance with PCT Rule 16bis.1(c) and withdraw the unpaid designations. The notification of deficient designation fees pursuant to this paragraph may be made simultaneously with any notification pursuant to § 1.431(c).

(c) On filing the international application, in addition to specifying at least one national or regional designation under PCT Rule 4.9(a), applicant may also indicate under PCT Rule 4.9(b) that all other designations permitted under the Treaty are made. The latter indication under PCT Rule 4.9(b) must be made in a statement on the Request that any designation made under this paragraph is subject to confirmation (PCT Rule 4.9(c)) not later than the expiration of 15 months from the

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priority date by:

- (1) Filing a written notice with the United States Receiving Office specifying the national and/or regional designations being confirmed;
- (2) Paying the designation fee for each designation being confirmed; and
- (3) Paying the confirmation fee specified in § 1.445(a)(4).

Unconfirmed designations will be considered withdrawn. If the amount submitted is not sufficient to cover the designation fee and the confirmation fee for each designation being confirmed, the Receiving Office will allocate the amount paid in accordance with any priority of designations specified by applicant. If applicant does not specify any priority of designations, the allocation of the amount paid will be made in accordance with PCT Rule 16 bis.1(c).

[43 FR 20486, May 11, 1978; para. (b) amended 52 FR 20047, May 28, 1987; paras. (a), (b) amended and para. (c) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.433 Physical requirements of international application.

- (a) The international application and each of the documents that may be referred to in the check list of the Request (PCT Rule 3.3(a)(ii)) shall be filed in one copy only.
- (b) All sheets of the international application must be on A4 size paper (21.0 x 29.7 cm.).
- (c) Other physical requirements for international applications are set forth in PCT Rule 11 and sections 201-207 of the Administrative Instructions.

37 CFR 1.434 The request.

- (a) The request shall be made on a standardized form (PCT Rules 3 and 4). Copies of printed Request forms are available from the Patent and Trademark Office. Letters requesting printed forms should be marked "Box PCT."
- (b) The Check List portion of the Request form should indicate each document accompanying the international application on filing.
- (c) All information, for example, addresses, names of States and dates, shall be indicated in the Request as required by PCT Rule 4 and Administrative Instructions 110 and 201.
- (d) International applications which designate the United States of America shall include:
 - (1) The name, address and signature of the inventor, except as provided by §§ 1.421(d), 1.422, 1.423 and 1.425;
 - (2) A reference to any copending national application or international application designating the United States of America, if the benefit of the filing date for the prior copending application is to be claimed.

[Para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.435 The description.

- (a) Requirements as to the content and form of the description are set forth in PCT Rules 5, 9, 10, and 11 and Administrative Instruction 204 and shall be adhered to.
- (b) In international applications designating the United States the description must contain upon filing an indication of the best mode contemplated by the inventor for carrying out the claimed invention.

37 CFR 1.436 The claims.

The requirements as to the content and format of claims are set forth in PCT Art. 6 and PCT Rules 6, 9, 10, and 11 and shall be adhered to. The number of the claims shall be reasonable, considering the nature of the invention claimed.

37 CFR 1.437 The drawings.

- (a) Subject to paragraph (b) of this section, when drawings are necessary for the

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understanding of the invention, or are mentioned in the description, they must be part of an international application as originally filed in the United States Receiving Office in order to maintain the international filing date during the national stage (PCT Art. 7).

(b) Drawings missing from the application upon filing will be accepted if such drawings are received within 30 days of the date of first receipt of the incomplete papers. If the missing drawings are received within the 30-day period, the international filing date shall be the date on which such drawings are received. If such drawings are not timely received, all references to drawings in the international application shall be considered nonexistent (PCT Art. 14(2), Administrative Instruction 310).

(c) The physical requirements for drawings are set forth in PCT Rule 11 and shall be adhered to.

37 CFR 1.438 The abstract.

(a) Requirements as to the content and form of the abstract are set forth in PCT Rule 8, and shall be adhered to.

(b) Lack of an abstract upon filing of an international application will not affect the granting of a filing date. However, failure to furnish an abstract within one month from the date of the notification by the Receiving Office will result in the international application being declared withdrawn.

FEES

37 CFR 1.445 International application filing, processing, and search fees.

(a) The following fees and charges for international applications are established by the Commissioner under the authority of 35 U.S.C. 376:

- (1) A transmittal fee (see 35 U.S.C. 361(d) and PCT Rule 14) \$220.00
- (2) A search fee (see 35 U.S.C. 361(d) and PCT Rule 16) where:
 - (i) No corresponding prior United States national application with basic filing fee has been filed \$660.00
 - (ii) A corresponding prior United States national application with basic filing fee has been filed \$430.00
- (3) A supplemental search fee when required, per additional invention \$190.00
- (4) A confirmation fee (PCT Rule 96) equal to 50% of the sum of designation fees for the national and regional designations being confirmed (§ 1.432(c)).
- (5) A fee equivalent to the transmittal fee in paragraph (a)(1) of this section for transmittal of an international application to the International Bureau for processing in its capacity as a Receiving Office (PCT Rule 19.4).

(b) The basic fee and designation fee portion of the international fee shall be as prescribed in PCT Rule 15.

[43 FR 20466, May 11, 1978; para. (a), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para. (a)(4) - (6), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (a) amended 52 FR 20047, May 28, 1987; paras. (a)(2) and (3), 54 FR 6893, Feb. 15, 1989, 54 FR 9432, March 7, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; para. (a), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para. (a)(4) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1)-(3), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; para. (a)(5) added, 60 FR 21438, May 2, 1995, effective June 1, 1995; para. (a) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995]

37 CFR 1.446 Refund of international application filing and processing fees.

(a) Money paid for international application fees, where paid by actual mistake or in excess, such as a payment not required by law or Treaty and its Regulations, will be refunded.

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(b) [Reserved]

(c) Refund of the supplemental search fees will be made if such refund is determined to be warranted by the Commissioner or the Commissioner's designee acting under PCT Rule 40. 2(c).

(d) The international and search fees will be refunded if no international filing date is accorded or if the application is withdrawn before transmittal of the record copy to the International Bureau (PCT Rules 15.6 and 16.2). The search fee will be refunded if the

application is withdrawn before transmittal of the search copy to the International Searching Authority. The transmittal fee will not be refunded.

(e) The handling fee (§ 1.482(b)) will be refunded (PCT Rule 57.6) only if:

(1) The Demand is withdrawn before the Demand has been sent by the International Preliminary Examining Authority to the International Bureau, or

(2) The Demand is considered not to have been submitted (PCT Rule 54.4(a)).

[43 FR 20466, May 11, 1978; para. (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; para.(b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985; 50 FR 31826, Aug. 6, 1985, effective Oct. 5, 1985; para. (d) amended and para. (e) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

PRIORITY**37 CFR 1.451 The priority claim and priority document in an international application.**

(a) The claim for priority must be made on the Request (PCT Rule 4.10) in a manner complying with sections 110 and 115 of the Administrative Instructions.

(b) Whenever the priority of an earlier United States national application is claimed in an international application, the applicant may request in a letter of transmittal accompanying the international application upon filing with the United States Receiving Office, or in a separate letter filed in the Receiving Office not later than 16 months after the priority date, that the Patent and Trademark Office prepare a certified copy of the national application for transmittal to the International Bureau (PCT Art. 8 and PCT Rule 17). The fee for preparing a certified copy is stated in § 1.19(b)(1).

(c) If a certified copy of the priority document is not submitted together with the international application on filing, or if the priority application was filed in the United States and a request and appropriate payment for preparation of such a certified copy do not accompany the international application on filing or are not filed within 16 months of the priority date, the certified copy of the priority document must be furnished by the applicant to the International Bureau or to the United States Receiving Office within the time limit specified in PCT Rule 17.1(a).

[43 FR 20466, May 11, 1978; 47 FR 40140, Sept. 10, 1982, effective Oct. 1, 1982; para. (b), 47 FR 41282, Sept. 17, 1982, effective Oct. 1, 1982; paras. (b) & (c), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985, para. (b), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

REPRESENTATION**37 CFR 1.455 Representation in international applications.**

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and § 10.10). If applicants have not appointed an attorney or agent or one of the applicants to represent them, and there is more than one applicant, the applicant first named in the request and who is entitled to file in the U.S. Receiving Office shall be considered to be the common representative of all the applicants. An attorney or agent having the right to practice before a national office with which an international application is filed and for which the United States is an International Searching Authority or International Preliminary Examining Authority may be appointed to represent the applicants in the international application before that authority. An attorney or agent may appoint an associate attorney or agent

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who shall also then be of record (PCT Rule 90.1(d)). The appointment of an attorney or agent, or of a common representative, revokes any earlier appointment unless otherwise indicated (PCT Rule 90.6(b) and (c)).

(b) Appointment of an agent, attorney, or common representative (PCT Rule 4.8) must be effected either in the Request form, signed by all applicants, or in a separate power of attorney submitted either to the United States Receiving Office or to the International Bureau.

(c) Powers of attorney and revocations thereof should be submitted to the United States Receiving Office until the issuance of the international search report.

(d) The addressee for correspondence will be as indicated in section 108 of the Administrative Instructions.

[43 FR 20466, May 11, 1978; 50 FR 5171, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

TRANSMITTAL OF RECORD COPY**37 CFR 1.461 Procedures for transmittal of record copy to the International Bureau.**

(a) Transmittal of the record copy of the international application to the International Bureau shall be made by the United States Receiving Office.

(b) [Reserved]

(c) No copy of an international application may be transmitted to the International Bureau, a foreign Designated Office, or other foreign authority by the United States Receiving Office or the applicant, unless the applicable requirements of Part 5 of this chapter have been satisfied.

[43 FR 20466, May 11, 1978; paras. (a) and (b), 50 FR 9384, Mar. 7, 1985, effective May 8, 1985]

TIMING**37 CFR 1.465 Timing of application processing based on the priority date.**

(a) For the purpose of computing time limits under the Treaty, the priority date shall be defined as in PCT Art. 2(xi).

(b) When a claimed priority date is cancelled under PCT Rule 4.10(d), or considered not to have been made under PCT Rule 4.10(b), the priority date for the purposes of computing time limits will be the date of the earliest valid remaining priority claim of the international application, or if none, the international filing date.

(c) When corrections under PCT Art. 11(2), Art. 14(2) or PCT Rule 20.2(a) (i) or (iii) are timely submitted, and the date of receipt of such corrections falls later than one year from the claimed priority date or dates, the Receiving Office shall proceed under PCT Rule 4.10(d).

37 CFR 1.468 Delays in meeting time limits.

Delays in meeting time limits during international processing of international applications may only be excused as provided in PCT Rule 82. For delays in meeting time limits in a national application, see § 1.137.

AMENDMENTS**37 CFR 1.471 Corrections and amendments during international processing.**

(a) All corrections submitted to the United States Receiving Office must be in the form of replacement sheets and be accompanied by a letter that draws attention to the differences between the replaced sheets and the replacement sheets, except that the deletion of lines of text, the correction of simple typographical errors, and one addition or change of not more than five words per sheet may be stated in a letter and the United States Receiving Office will make the deletion or transfer the correction to the international application, provided that such corrections do not

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adversely affect the clarity and direct reproducibility of the application (PCT Rule 26.4).

(b) Amendments of claims submitted to the International Bureau shall be as prescribed by PCT Rule 46.

37 CFR 1.472 Changes in person, name, or address of applicants and inventors.

All requests for a change in person, name or address of applicants and inventor should be sent to the United States Receiving Office until the time of issuance of the international search report. Thereafter requests for such changes should be submitted to the International Bureau.

[43 FR 20466, May 11, 1978; redesignated at 52 FR 20047, May 28, 1987]

UNITY OF INVENTION

37 CFR 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention") Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

[Added 52 FR 20047, May 28, 1987, effective July 1, 1987; paras. (a) - (e) amended and para. (f) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.476 Determination of unity of invention before the International Searching Authority.

(a) Before establishing the international search report, the International Searching Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

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(b) If the International Searching Authority considers that the international application does not comply with the requirement of unity of invention, it shall inform the applicant accordingly and invite the payment of additional fees (note § 1.445 and PCT Art. 17(3)(a) and PCT Rule 40). The applicant will be given a time period in accordance with PCT Rule 40.3 to pay the additional fees due.

(c) In the case of noncompliance with unity of invention and where no additional fees are paid, the international search will be performed on the invention first mentioned (main invention) in the claims.

(d) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Searching Authority may raise the objection of lack of unity of invention.

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.477 Protest to lack of unity of invention before the International Searching Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Searching Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are considered excessive, or both (PCT Rule 40.2(c)).

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the international search report when forwarded to the Designated Offices may notify the International Searching Authority to that effect any time prior to the issuance of the international search report. Thereafter, such notification should be directed to the International Bureau (PCT Rule 40.2(c)).

[43 FR 20466, May 11, 1978; redesignated and amended at 52 FR 20047, May 28, 1987]

INTERNATIONAL PRELIMINARY EXAMINATION

37 CFR 1.480 Demand for international preliminary examination.

(a) On the filing of a Demand and payment of the fees for international preliminary examination (§ 1.482), the international application shall be the subject of an international preliminary examination. The preliminary examination fee (§ 1.482(a)(1)) and the handling fee (§ 1.482(b)) shall be due at the time of filing of the Demand.

(b) The Demand shall be made on a standardized form. Copies of the printed Demand forms are available from the Patent and Trademark Office. Letters requesting printed Demand forms should be marked "Box PCT."

(c) If the Demand is made prior to the expiration of the 19th month from the priority date and the United States of America is elected, the provisions of § 1.495 shall apply rather than § 1.494.

(d) Withdrawal of a proper Demand prior to the start of the international preliminary examination will entitle applicant to a refund of the preliminary examination fee minus the amount of the transmittal fee set forth in § 1.445(a)(1).

[52 FR 20048, May 28, 1987; para. (d), 53 FR 47810, Nov. 28, 1988, effective Jan. 1, 1989; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.482 International preliminary examination fees.

(a) The following fees and charges for international preliminary examination are established

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by the Commissioner under the authority of 35 U.S.C. 376:

- (1) A preliminary examination fee is due on filing the Demand:
 - (i) Where an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority, a preliminary examination fee of \$470.00
 - (ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office, a preliminary examination fee of \$710.00
- (2) An additional preliminary examination fee when required, per additional invention:
 - (i) Where the international Searching Authority for the international application was the United States Patent and Trademark Office \$140.00
 - (ii) Where the International Searching Authority for the international application was an authority other than the United States Patent and Trademark Office \$250.00

- (b) The handling fee is due on filing the Demand. (35 U.S.C. 6, 376)

[52 FR 20048, May 28, 1987; para. (a), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a), 56 FR 65142, Dec. 13, 1991, effective Dec. 27, 1991; paras. (a)(1) and (a)(2)(ii), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; paras. (a)(2)(i) and (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a)(1) and (a)(2)(ii), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a)(1)(i), (a)(1)(ii), & (a)(2)(ii) amended, 60 FR 41018, Aug. 11, 1995, effective Oct. 1, 1995]

37 CFR 1.484 Conduct of international preliminary examination.

(a) An international preliminary examination will be conducted to formulate a non-binding opinion as to whether the claimed invention has novelty, involves inventive step (is non-obvious) and is industrially applicable.

(b) International preliminary examination will begin promptly upon receipt of a Demand which requests examination based on the application as filed or as amended by an amendment which has been received by the United States International Preliminary Examining Authority. Where a Demand requests examination based on a PCT Article 19 amendment which has not been received, examination may begin at 20 months without receipt of a PCT Article 19 amendment. Where a Demand requests examination based on a PCT Article 34 amendment which has not been received, applicant will be notified and given a time period within which to submit the amendment. Examination will begin after the earliest of:

- (1) Receipt of the amendment;
- (2) Receipt of applicant's statement that no amendment will be made; or
- (3) Expiration of the time period set in the notification.

No international preliminary examination report will be established prior to issuance of an international search report.

(c) No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.

(d) The International Preliminary Examining Authority will establish a written opinion if any defect exists or if the claimed invention lacks novelty, inventive step or industrial applicability and will set a non-extendable time limit in the written opinion for the applicant to respond.

(e) If no written opinion under paragraph (d) of this section is necessary, or after any written opinion and the response thereto or the expiration of the time limit for response to such written opinion, an international preliminary examination report will be established by the International Preliminary Examining Authority. One copy will be submitted to the International Bureau and one

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copy will be submitted to the applicant.

(f) An applicant will be permitted a personal or telephone interview with the examiner, which must be conducted during the non-extendable time limit for response by the applicant to a written opinion. Additional interviews may be conducted where the examiner determines that such additional interviews may be helpful to advancing the international preliminary examination procedure. A summary of any such personal or telephone interview must be filed by the applicant as a part of the response to the written opinion or, if applicant files no response, be made of record in the file by the examiner.

[52 FR 20049, May 28, 1987; para. (b) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.485 Amendments by applicant during international preliminary examination.

(a) The applicant may make amendments at the time of filing of the Demand and within the time limit set by the International Preliminary Examining Authority for response to any notification under § 1.484(b) or to any written opinion. Any such amendments must:

- (1) Be made by submitting a replacement sheet for every sheet of the application which differs from the sheet it replaces unless an entire sheet is cancelled, and
- (2) Include a description of how the replacement sheet differs from the replaced sheet.

(b) If an amendment cancels an entire sheet of the international application, that amendment shall be communicated in a letter.

[Added 52 FR 20049, May 28, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.487 [Reserved]

[Added 52 FR 20049, May 28, 1987, effective July 1, 1987; 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.488 Determination of unity of invention before the International Preliminary Examining Authority.

(a) Before establishing any written opinion or the international preliminary examination report, the International Preliminary Examining Authority will determine whether the international application complies with the requirement of unity of invention as set forth in § 1.475.

(b) If the International Preliminary Examining Authority considers that the international application does not comply with the requirement of unity of invention, it may:

- (1) Issue a written opinion and/or an international preliminary examination report, in respect of the entire international application and indicate that unity of invention is lacking and specify the reasons therefor without extending an invitation to restrict or pay additional fees. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority.
- (2) Invite the applicant to restrict the claims or pay additional fees, pointing out the categories of the invention found, within a set time limit which will not be extended. No international preliminary examination will be conducted on inventions not previously searched by an International Searching Authority, or
- (3) If applicant fails to restrict the claims or pay additional fees within the time limit set for response, the International Preliminary Examining Authority will issue a written opinion and/or establish an international preliminary examination report on the main invention and shall indicate the relevant facts in the said report. In case of any doubt as to which invention is the main invention, the invention first mentioned in the claims and previously searched by an International Searching Authority shall be considered the main invention.

(c) Lack of unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration, as where a document discovered

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during the search shows the invention claimed in a generic or linking claim lacks novelty or is clearly obvious, leaving two or more claims joined thereby without a common inventive concept. In such a case the International Preliminary Examining Authority may raise the objection of lack of unity of invention.

[52 FR 20049, May 28, 1987; para. (a) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.489 Protest to lack of unity of invention before the International Preliminary Examining Authority.

(a) If the applicant disagrees with the holding of lack of unity of invention by the International Preliminary Examining Authority, additional fees may be paid under protest, accompanied by a request for refund and a statement setting forth reasons for disagreement or why the required additional fees are excessive, or both.

(b) Protest under paragraph (a) of this section will be examined by the Commissioner or the Commissioner's designee. In the event that the applicant's protest is determined to be justified, the additional fees or a portion thereof will be refunded.

(c) An applicant who desires that a copy of the protest and the decision thereon accompany the inter-national preliminary examination report when forwarded to the Elected Offices, may notify the International Preliminary Examining Authority to that effect any time prior to the issuance of the international preliminary examination report. Thereafter, such notification should be directed to the International Bureau.

[Added 52 FR 20050, May 28, 1987, effective July 1, 1987]

NATIONAL STAGE

37 CFR 1.491 Entry into the national stage.

An international application enters the national stage when the applicant has filed the documents and fees required by 35 U.S.C. 371(c) within the periods set in §§ 1.494 or 1.495.

[Added 52 FR 20050, May 28, 1987]

37 CFR 1.492 National stage fees.

The following fees and charges are established for international applications entering the national stage under 35 U.S.C. 371:

(a) The basic national fee:

- (1) Where an international preliminary examination fee as set forth in § 1.482 has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f)) \$340.00

By other than a small entity \$680.00

- (2) Where no international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office, but an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

By a small entity (§ 1.9(f)) \$375.00

By other than a small entity \$750.00

- (3) Where no international preliminary examination fee as set forth in § 1.482 has been paid and no international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f)) \$505.00

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By other than a small entity \$1.010.00

- (4) Where the international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see § 1.496(b)):

By a small entity (§ 1.9(f)) \$47.00

By other than a small entity \$94.00

- (5) Where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office:

By a small entity (§ 1.9(f)) \$440.00

By other than a small entity \$880.00

- (b) In addition to the basic national fee, for filing or later presentation of each independent claim in excess of three:

By a small entity (§ 1.9(f)) \$39.00

By other than a small entity \$78.00

- (c) In addition to the basic national fee, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.9(f)) \$11.00

By other than a small entity \$22.00

- (d) In addition to the basic national fee, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.9(f)) \$125.00

By other than a small entity \$250.00

(If the additional fees required by paragraph (b), (c), and (d) are not paid on presentation of the claims for which the additional fees are due, they must be paid or the claims cancelled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

- (e) Surcharge for filing the oath or declaration later than 20 months from the priority date pursuant to § 1.494(c) or later than 30 months from the priority date pursuant to § 1.495(c):

By a small entity (§ 1.9(f)) \$65.00

By other than a small entity \$130.00

- (f) For filing an English translation of an international application later than 20 months after the priority date (§ 1.494(c)) or filing an English translation of the international application or of any annexes to the international preliminary examination report later than 30 months after the priority date (§ 1.495(c) and (e)) \$130.00

(35 U.S.C. 6, 376)

[52 FR 20050, May 28, 1987, effective July 1, 1987; paras. (a)(1) - (3), (b), (d)- (f), 54 FR 6893, Feb. 15, 1989, effective Apr. 17, 1989; para. (a)(5) added, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; revised, 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)(1)-(a)(3), (a)(5) and (b)-(d), 57 FR 38190, Aug. 21, 1992, effective Oct. 1, 1992; para.(e) amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; paras. (a), (b) and (d), 59 FR 43736, Aug. 25, 1994, effective Oct. 1, 1994; paras. (a), (b), & (d) amended, 60 FR 41018, Aug 11, 1995, effective, Oct. 1, 1995]

*Patent Laws and Regulations***37 CFR 1.494 Entering the national stage in the United States of America as a Designated Office.**

(a) Where the United States of America has not been elected by the expiration of 19 months from the priority date (see § 1.495), the applicant must fulfill the requirements of PCT Article 22 and 35 U.S.C. 371 within the time periods set forth in paragraph (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date:

- (1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and
- (2) The basic national fee (see § 1.492(a)). The 20-month time limit may not be extended.

(c) If applicant complies with paragraph (b) of this section before expiration of 20 months from the priority date but omits:

- (1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or
- (2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 20 months after the priority date. A copy of the notification mailed to applicant should accompany any response thereto submitted to the Office.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 20 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 20 months from the priority date will be considered to be cancelled. The 20-month time limit may not be extended.

(e) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(f) The documents and fees submitted under paragraph (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

(g) An international application becomes abandoned as to the United States 20 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 20 months from the priority date where the United States has been designated but not elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 20 months from the priority date but any required translation of the international application as filed and/or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

[Added 52 FR 20050, May 28, 1987; paras. (a) - (d) and (g) amended and para. (h) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.495 Entering the national stage in the**United States of America as an Elected Office**

(a) Where the United States of America has been elected by the expiration of 19 months from the priority date, the applicant must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraph (b) and (c) of this section in order to prevent the abandonment of the international application as to the United States of America. International applications for which those requirements are timely fulfilled will enter the national stage and obtain an examination as to the patentability of the invention in the United States of America.

(b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date:

- (1) A copy of the international application, unless it has been previously communicated by the International Bureau or unless it was originally filed in the United States Patent and Trademark Office; and
- (2) The basic national fee (see § 1.492(a)). The 30-month time limit may not be extended.

(c) If applicant complies with paragraph (b) of this section before expiration of 30 months from the priority date but omits:

- (1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) and/or
- (2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497), applicant will be so notified and given a period of time within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 30 months after the priority date. A copy of the notification mailed to applicant should accompany any response thereto submitted to the Office.

(d) A copy of any amendments to the claims made under PCT Article 19, and a translation of those amendments into English, if they were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Amendments under PCT Article 19 which are not received by the expiration of 30 months from the priority date will be considered to be cancelled. The 30-month time limit may not be extended.

(e) A translation into English of any annexes to the international preliminary examination report, if the annexes were made in another language, must be furnished not later than the expiration of 30 months from the priority date. Translations of the annexes which are not received by the expiration of 30 months from the priority date may be submitted within any period set pursuant to paragraph (c) of this section accompanied by the processing fee set forth in § 1.492(f). Annexes for which translations are not timely received will be considered cancelled. The 30-month time limit may not be extended.

(f) Verification of the translation of the international application or any other document pertaining to an international application may be required where it is considered necessary, if the international application or other document was filed in a language other than English.

(g) The documents submitted under paragraph (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

(h) An international application becomes abandoned as to the United States 30 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 30 months from the priority date where the United States has been elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 30 months from the priority date but any required translation of the international

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application as filed and/or the oath or declaration are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987; paras. (a)-(e) & (h) amended and para. (i) deleted, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

37 CFR 1.496 Examination of international applications in the national stage.

(a) International applications which have complied with the requirements of 35 U.S.C. 371(c) will be taken up for action based on the date on which such requirements were met. However, unless an express request for early processing has been filed under 35 U.S.C. 371(f), no action may be taken prior to one month after entry into the national stage.

(b) A national stage application filed under 35 U.S.C. 371 may have paid therein the basic national fee as set forth in § 1.492(a)(4) if it contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an international preliminary examination report prepared by the United States Patent and Trademark Office as satisfying the criteria of PCT Article 33(1)-(4) as to novelty, inventive step and industrial applicability. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. Such national stage applications in which the basic national fee as set forth in § 1.492(a)(4) has been paid will be taken up out of order.

[Added 52 FR 20051, May 28, 1987, effective July 1, 1987]

37 CFR 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application, if the inventor, desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, he or she must file an oath or declaration in accordance with § 1.63.

(b) If the international application was made as provided in §§ 1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by § 1.63 to state.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987]

37 CFR 1.499 Unity of invention during the national stage.

If the examiner find that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

[Added 52 FR 20052, May 28, 1987, effective July 1, 1987; amended, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993]

SUBPART D-REEXAMINATION OF PATENTS**CITATION OF PRIOR ART****37 CFR 1.501 Citation of prior art in patent files.**

(a) At any time during the period of enforceability of a patent, any person may cite to the Patent and Trademark Office in writing prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of a particular patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Citations by the patent owner under § 1.555 and by a reexamination requester under either §§ 1.510 or 1.535 will be entered in the patent file during a reexamination proceeding. The entry in the patent file of citations submitted after the date of an order to reexamine pursuant to § 1.525 by persons other than the patent owner, or a reexamination requester under either §§ 1.510