

Revised Procedure for Preliminary Amendments Presented on Filing of a Patent Application

The publication of a patent application under 35 U.S.C. 122(b) is based, in part, upon the specification and drawings deposited on the filing date of the application filed under 35 U.S.C. 111(a). See 37 CFR 1.215(a). A preliminary amendment that is present on the filing date of a patent application filed under 35 U.S.C. 111(a) is part of the original disclosure of the application. See 37 CFR 1.115(a)(1). Thus, if on filing an application includes a preliminary amendment to the specification, then the publication of the application must be based on the specification and drawings as amended by the preliminary amendment. See 37 CFR 1.215(a). Accordingly, the United States Patent and Trademark Office (Office) has indicated that if a preliminary amendment is filed in a format that cannot be included in the publication, the Office of Initial Patent Examination (OIPE) will issue a notice to the applicant requiring the applicant to submit the amendment in a format useable for publication purposes. See Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, Final Rule, 69 Fed. Reg. 56482, 56517-18, and 56524 (September 21, 2004), 1287 Off. Gaz. Pat. Office 67, 95-96, and 100-101 (October 12, 2004)(Strategic Plan Final Rule); 37 CFR 1.115(a)(1) and 1.215. The only format for an amendment to the specification (other than the claims) that is usable for publication is a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125. As a result, the Office has revised its procedures to mail a notice (e.g., "Notice to File Corrected Application Papers") requiring a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125, if an applicant included a preliminary amendment to the specification (other than the claims) on filing.

Since 1997, the Office has encouraged applicants to file patent applications under 35 U.S.C. 111(a), especially continuation and divisional applications, without preliminary amendments by including any desired changes as part of the specification and drawings of the new application. A copy of the declaration from the prior application can still be filed in a continuation or divisional application even if the specification filed in the continuation or divisional application is different from the prior application so long as the continuation or divisional application contains no new matter. See Changes to Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53132, 53148 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 77 (October 21, 1997); 37 CFR 1.63(d)(1). Moreover, when the Office began to publish patent applications, the Office urged applicants to file clean copies of the specifications, including any desired or required amendments, so that the published application will include the amended text. See Pre-Grant Publication Helpful Hint: File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office 54 (October 9, 2001); Helpful Hints Regarding Publication of Patent Applications, 1249 Off. Gaz. Pat. Office 83 (August 21, 2001). Filing clean copies of application papers, without preliminary amendments, will reduce the amount of processing done by the Office, thus reducing Office costs, and will help to ensure that patent application publications and patents are printed correctly. The specific reference to the prior application required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a) can be submitted in an application data sheet (ADS) under 37 CFR 1.76 rather than in a preliminary amendment to the first sentence(s)

of the specification. See 37 CFR 1.78(a)(2)(iii) and (5)(iii). If the specific reference is submitted in a preliminary amendment, however, a substitute specification will not be required if the preliminary amendment only adds or amends a benefit claim to a prior-filed application under 35 U.S.C. 120, 121, 365(c), or 119(e). If an applicant receives a notice from OIPE (e.g., "Notice to File Corrected Application Papers") requiring a substitute specification because a preliminary amendment was filed that only adds or amends a benefit claim, applicant may reply to the notice explaining that a substitute specification should not have been required because the amendment was only to add or amend a benefit claim. In order to avoid abandonment, applicant should file a reply with the required substitute specification or an explanation that the substitute specification is not necessary because the preliminary amendment only adds or amends a benefit claim. If the preliminary amendment contains other amendments to the specification (other than the claims), a substitute specification would be required, and a reply to a notice requiring a substitute specification without the substitute specification will be treated as an incomplete reply with no new time period for reply being provided.

Because a preliminary amendment to the claims or abstract in compliance with 37 CFR 1.121(c) or 1.121(b)(2) would include a complete claim listing or replacement abstract, the Office can publish the amended claims or a replacement abstract as submitted in the preliminary amendment without a substitute specification being filed. Applicants should note, however, that there is no need to file a preliminary amendment to the claims on filing. By making the new claim set part of the originally filed specification, applicant may avoid having to pay an application size fee, as both the specification (including the claims) and any preliminary amendment are used in counting the number of pages for purposes of 37 CFR 1.16(s). See "H.R. 4818 Questions and Answers" concerning the Patent Fee Related Provisions of the Consolidated Appropriations Act, 2005 posted on the Office's Internet web site at:

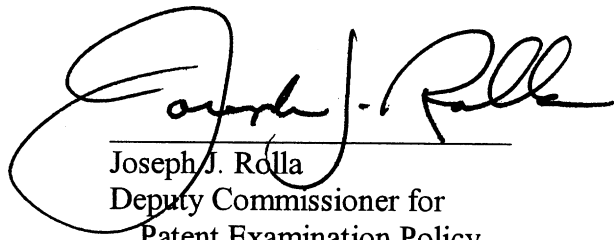
<http://www.uspto.gov/web/patents/hr4818/qna.htm#B>. The claim set submitted should be the set of claims intended to be examined, and when the claims submitted on filing are part of the specification (on sequentially numbered pages of the specification (see 37 CFR 1.52(b)(5))), no status identifiers and no markings showing the changes need to be used. A preliminary amendment filed upon the entry of the national stage of an international application under 35 U.S.C. 371 is not part of the original disclosure (because the filing date of the national stage application is the international filing date and not the national stage entry date) so the patent application publication need not include such an amendment.

Requiring a substitute specification (with all preliminary amendments made therein) is also important to ensure that applicants do not circumvent the limitations upon redacted publications set forth in 35 U.S.C. 122(b)(2)(B)(v). As preliminary amendments to the specification, excluding the claims, cannot be easily published, the Office must require a substitute specification whenever an application is filed with a preliminary amendment to the specification, excluding the claims, in order to ensure that the application, including any new matter added by way of a preliminary amendment included on the filing date of the application, is published.

Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Office of Patent Legal Administration by telephone at (571) 272-7701.

10/11/05

DATE



Joseph J. Rolla
Deputy Commissioner for
Patent Examination Policy