

(Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed.

The status identifier “previously presented” must be used in those circumstances where: (1) A claim has been previously presented as “new” in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as “currently amended” in a prior amendment document. “Previously presented” should not be used for a claim which was previously presented in a prior amendment document, most particularly an after final amendment, and entry of the claim was denied or applicant is uncertain at the present time whether or not the claim has been approved for entry. The status of “not entered” should be used for such claims. It is foreseen that the latter described scenario could occur in those situations where a first after final amendment has been filed and applicant desires to file a second after final amendment prior to receiving a notice of allowance or an advisory action notifying the applicant whether or not claims presented or amended in the first after final amendment have been entered. Thus, the status of “not entered” should be used for claims which have not been approved for entry, or if it is not known if they have been approved for entry.

Patent Cooperation Treaty (PCT) amendment procedures (*i.e.*, PCT Articles 19 and 34(2)(b)) are applicable during the international stage of an international application, and thus status identifiers are not to be used during the international stage. During the national stage (pursuant to 35 U.S.C. 371), amendment rules under § 1.121 apply to preliminary and subsequent amendments. When submitting these amendments in national stage, a claim listing is required with status identifiers indicated in a parenthetical expression following the claim number. The status identifier may indicate that claims were “original,” “previously presented,” or “canceled” based on changes made during the international stage. More specifically, in an amendment under § 1.121 in national stage, the status identifier “original” must be used for claims that had been presented on or by the international filing date and not modified or canceled. The status identifier “previously presented” must be used in any amendment submitted during national stage for all claims added or modified under PCT Articles

19 or 34 in the international stage that were subsequently entered in the national stage. Similarly, the status identifier “canceled” must be used in any amendment submitted during national stage for any claims canceled under an Article 19 or 34 amendment in the international stage that was subsequently entered in the national stage. If the amendment under § 1.121 in the national stage is making a change in a claim, the status identifier “currently amended” must be used for that claim.

The Office will continue the current practice of entering all previously filed unentered after final amendments and amendments filed with a request for continued examination (RCE) under § 1.114, unless applicant instructs otherwise. Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. *See* MPEP § 706.07(h) (page 700–85). The claim listing in the most recent amendment will be used as the current claim listing. When applicant submits an amendment after final or an amendment with an RCE, the markings in the text of the claims should be made relative to the claims of the last entered amendment (or the original claims if no amendments have been entered). When filing an RCE, applicants are encouraged to present a comprehensive amendment that includes all of the desired changes previously presented in the unentered after final amendments along with specific instructions not to enter the after final amendments.

When claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented, whether entered or not. *See* § 1.126. Therefore, the claim listing in any after final amendment, or amendment filed with an RCE, should include the claim number(s) for any unentered new claims submitted in a previously filed after final amendment, the status identifier should be indicated as (not entered) and the text of such claims must not be presented. Consecutive unentered claims may be aggregated into one line (*e.g.*, claims 20–25 (not entered)) in the claim listing. If applicant wishes to represent the previously submitted but unentered new claims, the claim listing must include the new claims with claim numbers beginning with the number next following the highest numbered claim previously presented. The new claims must include the status identifier “new” and the text of the new claims.

The Office will also continue the current practice of entering unentered after final amendments that the examiner has indicated would be entered upon the filing of an appeal.

Absent specific instructions for entry, these amendments will be entered in the order in which they were filed. The claim listing in the most recent amendment will be used as the current claim listing.

Combining the status identifiers (withdrawn) and (currently amended) into a single status identification, *e.g.*, (withdrawn—currently amended), may be used in those situations where a claim has been previously withdrawn as non-elected but applicant wishes to amend the claim in an effort to rejoin the withdrawn (non-elected) claim with the elected invention. In all other situations only a single status identifier may be used.

As a result of the changes to § 1.121, each amendment document will be self-contained, as it sets forth a complete listing of all claims, including the text of all pending claims, for examination and provides the status of all of the claims in one location in the file.

Paragraph (c)(1) provides for the presentation of the claims in ascending numerical order. This prevents the grouping of claims by status (all “new” claims together, all “currently amended” claims together, etc.), and ensures a complete listing of all claims in numerical order, regardless of status. Consecutive “canceled” or “not entered” claims, however, may be aggregated (*e.g.*, “Claims 1–5 (canceled)”). Further, paragraph (c)(1) requires that any sheet of an amendment paper including part of the text of a claim shall not include material directed to any other part of the amendment or any remarks concerning the claims. In other words, the complete listing of all of the claims must commence on a separate sheet of the amendment document. This requirement facilitates indexing of the application papers.

Paragraph (c)(2) requires that markings be provided in claims to show the addition or deletion of subject matter. Added subject matter must be shown by underlining. If any claim is being marked-up to show added subject matter and at least part of the added subject matter is to be underlined itself following entry, then the subject matter intended to include underlining that is being added may be shown by double underlining that part of the added text. Deleted subject matter must be shown by striking through the deleted text with two exceptions: (1) For deletion of five characters or fewer, double brackets may be used (*e.g.*, [[error]]); and (2) if strike-through cannot be easily perceived (*e.g.*, deletion of the number “4” or certain punctuation marks), double brackets must be used (*e.g.*,