

In *In re Tangsrud*, 184 USPQ 746 (Comm'r Pat. 1973), the Office held that a certified copy of a foreign priority document may be filed in a continuation application under § 1.60, rather than in its abandoned parent application, to meet the requirements in 35 U.S.C. 119 for the continuation application to claim the benefit of the foreign priority application (through its abandoned parent application). The language of *Tangsrud*, however, is broad enough to imply that neither the claim for priority nor the certified copy of the foreign priority document must be filed in the first-filed application for a subsequent application to claim the benefit of the foreign priority application through the first-filed application. This proposed change to § 1.55(a) would not affect the holding in *Tangsrud* that the certified copy of the foreign priority document may be filed in a continuing application, rather than in an abandoned first-filed application, provided that a claim for priority in compliance with § 1.55 to a prior foreign application is presented in the first-filed application.

Section 1.55(a)(4) is proposed to be amended to require that the statement that the translation is accurate be signed by the individual who made the translation. The Office has received a number of inquiries as to who may sign the statement, and has decided that it is appropriate to include the requirement that the signature required is that of the translator into the rules of practice. See also the proposed amendments to §§ 1.52(b)(1)(ii), 1.52(d)(1), 1.69(b) and 1.78(a)(5)(iv). The requirement that the person who made the translation sign the statement that the translation is accurate is consistent with current § 3.26.

Section 1.55(c) is proposed to be amended to change "365(a)" to "365(a)-(b)" such that the procedures for acceptance of delayed priority claims under § 1.55(c) also apply to delayed priority claims under 35 U.S.C. 365(b) in international applications.

Section 1.57: Section 1.57 is proposed to be added to provide for incorporation by reference. Section 1.57(a) as proposed provides that, if all or a portion of the specification or drawings is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the date of receipt of the application, and the omitted portion of the specification or drawings is completely contained in the prior-filed

application, the claim would be considered an incorporation by reference of the prior-filed application. Sections 1.57(b) through (f) as proposed treat incorporation by reference into an application of essential and nonessential material by: (1) Providing a definition of essential and nonessential material; (2) defining specific language that must be used to trigger an incorporation by reference; (3) codifying current practice as set forth in MPEP § 608.01(p) (Incorporation by Reference), updated to reflect the publication of applications; and (4) codifying treatment of improper incorporation by reference.

Currently, the mere reference to another application is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure under 35 U.S.C. 112, ¶ 1. See MPEP §§ 201.06(c) and 608.01(p), and *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). The proposed rule would allow all or a portion of the specification or drawings that is inadvertently omitted from an application containing a priority claim for a prior-filed foreign application, or a benefit claim for a prior-filed provisional, nonprovisional, or international application, to be added to the application by way of an amendment if the omitted portion of the specification or drawings is completely contained in the prior-filed application even though there is no explicit incorporation by reference of the prior-filed application. The phrase "completely contained" in § 1.57(a) requires that the material to be added to the application under § 1.57(a) must be expressly (as opposed to implicitly) disclosed in the prior application. Cf. PLT Rule 2(4)(iv). The claim for priority or benefit would have to be present on the date of receipt of the application in order for it to be considered an incorporation by reference of the prior-filed application. The nonprovisional application claiming benefit could be a continuation, divisional, or continuation-in-part of the prior application for which benefit is claimed. The purpose of the proposed rule is to provide a safeguard for applicants when a page(s) of the specification, or a portion thereof, or a sheet(s) of the drawings, or a portion thereof, is inadvertently omitted from an application.

If all or a portion of the specification or drawings is inadvertently omitted from an application and applicant wants to rely on the incorporation by reference provided by the proposed rule, the application would need to be amended

to include the omitted portion of the specification or drawings within the time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114. In order for the omitted material to be included in the application, the application must be amended to include it. The incorporation by reference provided by the proposed rule requires an applicant to timely amend the application to include the omitted material in order for this material to be considered part of the disclosure. The proposed rule gives the examiner the authority to require the applicant to supply a copy of the prior-filed application, to supply an English-language translation of any prior-filed application that is in a language other than English, and to identify where the omitted portion of the specification or drawings can be found in the prior-filed application.

Any amendment to an international application pursuant to the proposed rule would be effective only as to the United States. See proposed § 1.57(a)(2). In addition, no request to add the missing part of the description or the missing drawing in an international application designating the United States will be acted upon by the Office prior to the expiration of the applicable time limit under PCT Article 22(1) or (2), or Article 39(a).

If an application is not entitled to a filing date under § 1.53(b) or under PCT Article 11, the amendment must be by way of a petition accompanied by the fee set forth in § 1.17(f). See proposed § 1.57(a)(3).

The proposed rule is similar to the current practice under MPEP § 201.06(c) where there is an explicit incorporation by reference of the prior U.S. application contained in the specification or in the application transmittal letter of a continuation or divisional application filed under § 1.53(b). See MPEP § 201.06(c) (Incorporation by Reference). The proposed rule is also consistent with the PLT Article 5(6)(b) and Rule 2(3) and (4).

Of course, whether the proposed rule is adopted or not, applicants may continue to explicitly incorporate by reference a prior application or applications by including, in the body of the specification as filed, a statement that the prior application or applications is "hereby incorporated by reference." Such an explicit incorporation by reference would not be limited to inadvertent omissions as in the proposed rule. Accordingly, applicants are encouraged to explicitly incorporate by reference a prior application or applications by including