

contents of the originally filed specification, including claims, and drawings, and the preliminary amendment is not specifically referred to in the oath or declaration under § 1.63, a new oath or declaration in compliance with § 1.63 and referencing such preliminary amendment(s) will be required. Further, the Office proposes to amend current section 1.115(b)(1), as proposed new paragraph (c)(1)(i), to allow the Office to disapprove entry of any amendment, whether submitted prior to, on or after the filing date of an application, which seeks cancellation of all claims without presenting any new or substitute claims, except that the Office would treat a preliminary amendment canceling all of the claims and presenting no new or substitute claims procedurally as preserving a claim (the first independent claim) for filing and fee calculation purposes only.

*Preliminary Amendment Submitted on or Prior to the Filing Date as Part of the Original Disclosure:* It has long been the practice that a preliminary amendment filed on or prior to the filing date of an application may be considered a part of the original disclosure if it is referred to in a first filed oath or declaration in compliance with § 1.63. The first filed oath or declaration may have been filed prior to, on or after the application filing date. If the preliminary amendment is not referred to in the oath or declaration, any request to treat the preliminary amendment as a part of the original disclosure is by way of petition under § 1.182 requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an executed oath or declaration under § 1.53(f). Any such petition must be accompanied by the \$130.00 petition fee, a newly executed oath or declaration (which identifies the application and refers to the preliminary amendment), and the requisite surcharge under § 1.16(e).

All application papers, including preliminary amendments, located in the application file on the application filing date are currently scanned by the Office of Initial Patent Examination (OIPE) into an electronic image format. Therefore, the treatment of a preliminary amendment as being part of the original disclosure by the newly proposed practice of automatically treating all preliminary amendments filed on or prior to the filing date of an application as being part of the original disclosure would add no additional scanning work to OIPE. The proposed practice, however, would provide a consistent way of treating preliminary amendments and eliminate the need for

filing a petition. As a result, valuable processing time would be saved. No change in practice is contemplated regarding inclusion of preliminary amendments in a published application, as only preliminary amendments submitted by EFS (electronic system for submitting patent applications) will be included in a published application. See § 1.215(c).

A preliminary amendment seeking cancellation of all claims, but not presenting any new or substitute claims, would be part of the original disclosure, but would be entered only in part in conformance with the practice set forth below.

All preliminary amendments filed on or prior to the filing date of an application are proposed to be treated as part of the original disclosure. These preliminary amendments would be entered into the application. Thereafter, the application, including the preliminary amendments, would be forwarded to an examiner for examination in due course. During examination, the examiner would make a determination as to whether the preliminary amendments contain matter not in the originally filed specification, including claims and any drawings. If the examiner determines that the preliminary amendments filed on or prior to the filing date of an application contains only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings, no reference to the preliminary amendments in the oath or declaration would be necessary and, thus, would not be required. If, however, it is determined by the examiner that the amendments filed on or prior to the filing date of an application do contain matter not in the originally filed specification, including claims and any drawings, and the preliminary amendments are not referred to in a first filed oath or declaration (or a later submitted one), then a new oath or declaration in compliance with § 1.63 and referencing such preliminary amendment(s) would be necessary and, thus, would be required by the examiner. The oath or declaration filed in such an application must identify the preliminary amendment adding matter not in the originally filed specification, including claims and any drawings as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with § 1.63(b)(2) (the surcharge under § 1.16(e) would not be required).

Preliminary amendments filed after the filing date of an application are not considered as part of the original disclosure and are not subject to a

determination of whether the preliminary amendments must be referred to in an oath or declaration (if they contain subject matter not disclosed in the contents of the originally filed specification, including claims and any drawings) but will be reviewed by the examiner for new matter. Preliminary amendments filed prior to or on the filing date of the application by definition cannot contain new matter whether or not they are referred to in a first filed oath or declaration because they would be considered part of the application as originally filed.

The appropriate provisions of the MPEP will be modified accordingly, if the proposed amendment to § 1.115 is adopted.

It is recognized that the requirement for a new oath or declaration when the originally filed application papers include preliminary amendments which have been determined by an examiner to contain matter not in the originally filed specification, including claims and any drawings and are not referred to in the originally filed oath or declaration (or a later submitted one) may present a hardship in acquiring the requisite signatures of all the inventors. The treatment, however, of such a preliminary amendment as being part of the original disclosure and the elimination of the current petition practice are believed to outweigh such hardship.

A good practice to follow, when at all possible, is to refer to all preliminary amendments filed on or prior to the filing date of an application, in an oath or declaration filed under § 1.63 whenever the oath or declaration is first filed. Following this practice will avoid the necessity for filing a new oath or declaration referencing the preliminary amendments.

It should be noted that no oath or declaration filed under § 1.63 would be determined to be defective under this section if it makes reference to a preliminary amendment filed on or prior to the filing date of an application, which is determined by the Office to contain only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings.

#### *Preliminary Amendment Filed Prior to the Filing Date of an Application*

*Example A:* An example of a preliminary amendment filed prior to the filing date of an application is a preliminary amendment filed with the original application papers, wherein the original application papers did not include a specification in compliance