

with 35 U.S.C. 112. Accordingly, the application papers, as filed, were not entitled to a filing date under 35 U.S.C. 111(a)(2)(A). Thereafter, a specification in compliance with 35 U.S.C. 112 was filed in the application, and the application was entitled to a filing date as of the date of submission of the specification in compliance with 35 U.S.C. 112.

Preliminary Amendment Not Desired To Be Part of the Original Disclosure

Example B1: If a preliminary amendment is not desired to be a part of the original disclosure, then such preliminary amendment must be filed in the application on a date later than the application filing date. Such a situation could occur if a practitioner drafts a preliminary amendment, which he believes contains only subject matter disclosed in the contents of the originally filed specification, including claims and any drawings, after a declaration was signed by all the inventors executing the application papers without the preliminary amendment being before them and it would be very difficult to obtain a new oath or declaration in compliance with § 1.63 executed by all the inventors referring to the preliminary amendment.

Example B2: Where it is determined by an examiner that a preliminary amendment filed on or prior to the filing date of an application (including an executed declaration) contains additional subject matter not disclosed in the contents of the originally filed specification, including claims and any drawings, a practitioner may determine that the preliminary amendment does not need to be a part of the original disclosure (e.g., to support the particular invention being claimed) and therefore it would be easier to cancel the preliminary amendment rather than obtain a new oath or declaration in compliance with § 1.63 executed by all the inventors referring to the preliminary amendment.

Preliminary Amendment Adding a Benefit Claim to a Prior Application

Example C1: An application was filed under § 1.53(b) as a continuation application of a prior filed (parent) application including a specification (including claims) and drawings updated with all desired amendments (without adding any new matter (§ 1.63(d)(1)(iii))) from a prior filed (parent) application, a copy of a signed declaration used in the prior application (§ 1.63(d)(1)(iv)), and a preliminary amendment adding a benefit claim. The preliminary amendment adds only a specific reference to the prior filed (e.g.,

parent) application to the first line of the specification. As the preliminary amendment was submitted on filing, it is part of the original disclosure.

Question: Does the oath or declaration need to refer to this preliminary amendment? *Answer:* No. As the application submitted on filing is an updated version of the specification of the prior application (without adding new matter) including the benefit claim, the oath or declaration does not need to include a reference to the preliminary amendment. Thus, the preliminary amendment is not adding additional subject matter not disclosed in the contents of the originally filed specification of the continuation application, including claims and drawings.

Example C2: In addition to the facts set forth in Example C(1), the specification submitted on filing inadvertently omitted a copy of page 5 of the specification, however, the transmittal letter (PTO/SB/05) submitted on filing stated the following:

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

Thereafter, the omitted page 5 from the prior application, that was intended to be submitted with the new application on filing but was not, is then submitted. *Question:* Is a new oath or declaration required? *Answer:* No. While the continuation application did not include all the subject matter of the prior application which was intended to be submitted on filing, the application did include a limited incorporation by reference. See MPEP § 201.06(c). As the material of page 5 of the prior application was inadvertently omitted on filing, the incorporation by reference would permit the entry of the subject matter of page 5 of the prior application into the continuation application. See also proposed § 1.57(a).

Preliminary Amendment Adding New Matter to a Continuation Application

Example D: An application was filed under § 1.53(b) as a continuation application of a prior filed (parent) application including an updated specification (including claims) and drawings from a prior filed (parent) application, a copy of the signed declaration from the prior application,

and a preliminary amendment. The preliminary amendment included a benefit claim and also a new matter amendment of the specification, which new matter was not disclosed in the contents of the originally filed specification, including claims and drawings. As the preliminary amendment was submitted on filing, it is part of the original disclosure.

Question: Does the oath or declaration need to refer to this preliminary amendment? *Answer:* Yes. As the application includes new matter, the application cannot be a continuation application. The application is a continuation-in-part application. An examiner would require that the application be redesignated as a continuation-in-part application, and require a new oath or declaration in compliance with § 1.63 and referencing the preliminary amendment(s).

The Office is particularly interested in comments from our customers regarding whether the benefits of the proposed change in Office policy (elimination of the current petition practice and treatment of preliminary amendments filed on or prior to the filing date of an application as part of the original disclosure) outweighs the attendant hardship (reexecution of the oath or declaration).

This change to § 1.115 would not be retroactive to any applications filed before the effective date of the rule change. The proposed change would be prospective only since to apply the change retroactively would result in changing the expectations regarding treatment of preliminary amendments filed on or prior to the filing date of an application by the Office.

Preliminary Amendment Cancelling All Claims: Current paragraph (b) of § 1.115 is proposed to be redesignated as paragraph (c) based on the above new proposed paragraph (b) and would be reformatted to accommodate the addition of new paragraph (c)(1)(i) as is being proposed to treat a preliminary amendment seeking to cancel all claims.

Before June of 1998, it was the practice of the Office to treat an application filed with an amendment (preliminary amendment) canceling all of the claims and presenting no new or substitute claims by denying entry of the amendment. See MPEP §§ 711.01 and 714.19. In *Baxter Int'l Inc. v. McGaw Inc.*, 149 F.3d 1321, 47 USPQ2d 1225 (Fed. Cir. 1998), the Federal Circuit held that a divisional application that included instructions to cancel all of the claims in the specification, without presenting any new claims, and did not contain at least one claim as required by 35 U.S.C. 112,