

Understanding Priority Claims for U.S. Patent Applications: Part 1

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This article is first in a two-part series focusing on various issues related to priority claims in U.S. patent applications. Part 1 is a general overview of how to make a proper priority claim, without addressing how to correct an improper priority claim, which will be examined in Part 2.

In general, for examination purposes at the U.S. Patent and Trademark Office (USPTO), a priority claim determines the priority date of a patent application. But why is that important? Because the priority date effectively determines what references can and cannot be asserted as prior art against a patent application during its examination. That is, the priority date draws a line in the sand for prior art, and this line cannot be crossed.

A priority claim is made to an earlier-filed patent application. For example, an Applicant can claim priority in a later-filed patent application to earlier-filed U.S. provisional applications, U.S. nonprovisional applications, PCT applications, and/or foreign (i.e., non-U.S. Paris Convention signatory) applications. In order for a priority claim to be effective, certain conditions must be met. These specific conditions are set forth in 35 U.S.C. §119(e) and 37 C.F.R. § 1.78(a) for a priority claim to earlier-filed provisional applications, 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d) for a priority claim to earlier-filed nonprovisional applications or PCT applications, and 35 U.S.C. §119(a)–(d) and 37 C.F.R. § 1.55 for a priority claim to earlier-filed foreign applications.

Generally, a priority claim is properly made when:

1. the later- and earlier-filed patent applications include a common inventor or joint inventor;
2. the later-filed patent application makes a specific reference to the earlier-filed patent application(s);
3. the claim is made within 16 months from the filing date of the earliest-filed application or 4 months from the filing of the later-filed patent application; and
4. the later-filed patent application is filed before or on the same day as the grant or abandonment of the earlier-filed patent application.

Additional Comments on Specific Reference to an Earlier-filed Patent Application(s)

Per 37 C.F.R. §1.78(d)(2), the later-filed patent application must specifically reference (1) the serial number of the earlier-filed patent application(s) and (2) the relationship between the later- and earlier-filed patent applications (e.g., a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application, international application, or international design application). Further, if the later-filed patent application is a U.S. nonprovisional, the specific reference must be made in an Application Data Sheet (ADS) for the later-filed patent application.

While not required, it is good U.S. patent practice for an applicant to include a “Cross-Reference To Related Application(s)” section within a patent application that includes a specific reference to the earlier-filed patent application(s). Examples of “Cross-Reference To Related Application(s)” sections are listed below. Further, while not required, it may be beneficial for the applicant to include an incorporation by reference statement as shown in the below examples.

EXAMPLE 1: Priority Claim to a Provisional Application

CROSS-REFERENCE TO RELATED APPLICATION

This application claims the benefit of U.S. Provisional Patent Application No. ###/###/###, filed July 1, 2018, which is incorporated by reference herein in its entirety.

EXAMPLE 2: Priority Claim to a Nonprovisional Application

CROSS-REFERENCE TO RELATED APPLICATION

This application is a continuation of U.S. Patent Application No. ####,###, filed July 1, 2018, which is incorporated by reference herein in its entirety.

EXAMPLE 3: Priority Claim to a Chain of Nonprovisional and Provisional Applications

CROSS-REFERENCE TO RELATED APPLICATIONS

This application is a continuation of U.S. Patent Application No. ####,###, filed July 1, 2018, which is a continuation of U.S. Patent Application ####,###, filed July 1, 2017, which claims the benefit of U.S. Provisional Patent Application No. ####,###, filed July 1, 2016, each of which is incorporated by reference herein in its entirety.

EXAMPLE 4: Priority Claim to a PCT Application

CROSS-REFERENCE TO RELATED APPLICATION

This application is a national stage application, filed under 35 U.S.C. § 371, of International Patent Application No. PCT/US####/#####, filed on July 1, 2018, which is incorporated by reference herein in its entirety.

Conclusion

While the above discussion provides a general overview of priority claims and how to make them, applicants are encouraged to consider when and whether to file various papers under every application's particular circumstances and to verify disclosure requirements according to the current rules and regulations of the USPTO.

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