TEXT

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PTO FINAL RULE ON 20-YEAR TERM AND PROVISIONAL APPLICATIONS

60 FR 20195

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1 and 3

[Docket No. 950404087–5087–01]

RIN 0651–AA76

Changes To Implement 20-Year Patent Term and Provisional Applications

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Patent and Trademark Office (PTO) is amending the rules of practice in patent cases to establish procedures for: filing and processing provisional application papers; calculating the length of any patent term extension to which an applicant is entitled where the issuance of a patent on an application filed on or after June 8, 1995 (the implementation date of the 20-year patent term provisions of the Uruguay Round Agreements Act), other

than for designs, was delayed due to interference proceedings, the imposition of a secrecy order and/or appellate review; and implementing certain transitional provisions contained in the Uruguay Round Agreements Act.

EFFECTIVE DATE: June 8, 1995.

FOR FURTHER INFORMATION CONTACT: Magdalen Y. Greenlief or John F. Gonzales, Senior Legal Advisors, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, by telephone at (703) 305–9285, by fax at (703) 308–6916 or by mail marked to their attention and addressed to the Commissioner of Patents and Trademarks, Box DAC, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: The Uruguay Round Agreements Act (Public Law 103–465) was enacted on December 8, 1994. Public Law 103–465 amends 35 U.S.C. 154 to provide that the term of patent protection begins on the date of grant and ends 20 years from the filing date of the application. The amendment applies to all utility and plant patents issued on applications having an actual United States application filing date on or after June 8, 1995. Specifically, 35 U.S.C. 154(a)(2), as contained in Public Law 103–465, provides that the patent term will begin on the date on which the patent issues and will end twenty years from the date on which the application was filed in the United States. If the application contains a specific reference to an earlier application under 35 U.S.C. 120, 121 or 365(c), the patent term will end twenty years from the date on which the earliest application referred to was filed. As amended by Public Law 103–465, 35 U.S.C. 154 does not take into account for determination of the patent term any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).

Under 35 U.S.C. 154(b)(1), as contained in Public Law 103–465, if the issuance of an original patent is delayed due to interference proceedings under 35 U.S.C. 135(a) or because the application is placed under a secrecy order under 35 U.S.C. 181, the term of the patent shall be extended for the period of delay, but in no case more than five (5) years.

Under 35 U.S.C. 154(b)(2), as contained in Public Law 103–465, if the issuance of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than five (5) years. However, a patent shall not be eligible for extension under 35 U.S.C. 154(b)(2) if the patent is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

Under 35 U.S.C. 154(b)(3)(B) and 154(b)(3)(C), as contained in Public Law 103–465, the period of extension under 35 U.S.C. 154(b)(2) shall be reduced by any time attributable to appellate review before the expiration of three (3) years from the filing date of the application and for any period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

Under 35 U.S.C. 154(b)(4), as contained in Public Law 103–465, the total duration of all extensions of a patent under 35 U.S.C. 154(b) shall not exceed five (5) years.

The provisions for patent term extension under 35 U.S.C. 154(b) are separate from and in addition to the patent term extension provisions of 35 U.S.C. 156. The patent term extension provisions of 35 U.S.C. 154(b) are designed to compensate the patent owner for delays in issuing a patent, whereas the patent term extension provisions of 35 U.S.C. 156 are designed to restore term lost to premarket regulatory review after the grant of a patent. In order to prevent a term extension under 35 U.S.C. 154(b) from precluding a term extension under 35 U.S.C. 156, Public Law 103–465 amends 35 U.S.C. 156(a)(2) to specify that the term has never been extended under 35 U.S.C. 156(e)(1).

The 20-year patent term provision is contained in 35 U.S.C. 154, as amended by Public Law 103–465. Section 154 of title 35, United States Code, applies to utility and plant patents, but not to design patents. The term of a design patent is defined in 35 U.S.C. 173 as fourteen (14) years from the date of grant. Therefore, the patent term and patent term extension provisions set forth in 35 U.S.C. 154, as amended by Public Law 103–465, do not apply to patents for designs.

In addition, Public Law 103–465 establishes a domestic priority system. In accordance with the provisions of the Paris Convention for the Protection of Industrial Property, the term of a patent cannot include the Paris Convention priority period. Public Law 103–465 provides a mechanism to enable applicants to quickly and inexpensively file provisional applications. Applicants will be entitled to claim the benefit of priority in a given application based upon a previously filed provisional application in the United States. The domestic priority period will not count in the measurement of the term.

Section 111 of title 35, United States Code, was amended by Public Law 103–465 to provide for the filing of a provisional application on or after June 8, 1995. Section 41(a)(1) of title 35, United States Code, was amended by Public Law 103–465 to provide a

$150.00 filing fee for each provisional application, subject to a fifty (50) percent reduction for a small entity. The requirements for obtaining a filing date for a provisional application are the same as those which previously existed for an application filed under 35 U.S.C. 111, except that no claim or claims as set forth in 35 U.S.C. 112, second paragraph, is required. Moreover, no oath/declaration as set forth in 35 U.S.C. 115 is required. The provisional application is also not subject to the provisions of 35 U.S.C. 131, 135 and 157, i.e., a provisional application will not be examined for patentability, placed in interference or made the subject of a statutory invention registration. Further, the provisional application will automatically be abandoned no later than twelve (12) months after its filing date and will not be subject to revival to restore it to pending status beyond a date which is after twelve (12) months from its filing date. A provisional application will not be entitled to claim priority benefits based on any other application under 35 U.S.C. 119, 120, 121 or 365.

Also, Public Law 103–465 amended 35 U.S.C. 119 to allow an applicant to claim the benefit of the filing date of one or more copending provisional applications in a later filed application for patent under 35 U.S.C. 111(a) or 363. The later filed application for patent under 35 U.S.C. 111(a) or 363 must be filed by an inventor or inventors named in the copending provisional application not later than 12 months after the date on which the provisional application was filed and must contain or be amended to contain a specific reference to the provisional application. The provisional application must disclose an invention which is claimed in the application for patent under 35 U.S.C. 111(a) or 363 in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the provisional application must be pending on the filing date of the application for patent under 35 U.S.C. 111(a) or 363 and the filing fee set forth in subparagaph (A) or (C) of 35 U.S.C. 41(a)(1) must be paid.

Since 35 U.S.C. 154(a)(3), as contained in Public Law 103–465, excludes from the determination of the patent term any application on which priority is claimed under 35 U.S.C. 119,

365(a) or 365(b), the filing date of a provisional application is not considered in determining the term of any patent.

Section 119(e)(1) of title 35, United States Code, provides that if all of the conditions of 35 U.S.C. 119 (e)(1) and (e)(2) are met, an application for patent filed under 35 U.S.C. 111(a) or 363 shall have the same effect as though filed on the date of the provisional application. Thus, the effective United States filing date of an application for patent filed under 35 U.S.C. 111(a), and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application. Any patent granted on such an application, is prior art under 35 U.S.C. 102(e) as of the filing date of the provisional application.

Likewise, the effective United States filing date of a patent issued on an international application filed under 35 U.S.C. 363, and entitled to benefits under 35 U.S.C. 119(e), is the filing date of the provisional application, except for the purpose of applying that patent as prior art under 35 U.S.C. 102(e). For that purpose only, 35 U.S.C. 102(e) defines the filing date of the international application as the date the requirements of 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) were fulfilled.

Public Law 103–465 further includes transitional provisions for limited reexamination in certain applications pending for two (2) years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). The transitional provisions also permit examination of more than one independent and distinct invention in certain applications pending for three (3) years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). These transitional provisions are not applicable to any application which is filed after June 8, 1995, regardless of whether the application is a continuing application.

The amendments to title 35 relating to 20-year patent term, patent term extension, provisional applications and the transitional provisions are effective on the date which is six (6) months after the date of enactment, i.e., on June 8, 1995.

A Notice of Proposed Rulemaking was published in the **Federal Register** at 59 FR 63951 (December 12, 1994) and in the Patent and Trademark Office Gazette at 1170 Off. Gaz. Pat. Office 377–390 (January 3, 1995).

Forty-nine written comments were received in response to the Notice of Proposed Rulemaking. A public hearing was held at 9:30 a.m. on February 16, 1995. Fourteen individuals offered oral comments at the hearing. The forty-nine written comments and a transcript of the hearing are available for public inspection in the Special Program Law Office, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, Room 520, Crystal Park I, 2011 Crystal Drive, Arlington, Virginia, and are available on the Internet through anonymous file transfer protocol (ftp), address: ftp.uspto.gov.

The following includes a discussion of the rules being added or amended, the reasons for those additions and amendments and an analysis of the comments received in response to the Notice of Proposed Rulemaking.

Changes in text: The final rules contain numerous changes to the text of the rules as proposed for comment. Those changes are discussed below. Familiarity with the Notice of Proposed Rulemaking is assumed.

Section 1.9(a)(1) is being changed for clarity to define a national application as a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. Also, a new paragraph (a)(3) is being added to define the term "nonprovisional application" as a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

The proposed deletion of § 1.60 is being withdrawn. Therefore, § 1.17(i) is being changed to retain the reference to § 1.60.

Section 1.17(q) is being changed to delete the fifty (50) percent reduction for small entities in the $50.00 fee established for filing a petition under § 1.48 in a provisional application and a petition to accord a provisional application a filing date or to convert an application filed under § 1.53(b)(1) to a provisional application.

Sections 1.17(r) and (s) are being changed to include a fifty (50) percent reduction for small entities in the fees established for entry of a submission after final rejection under § 1.129(a) and for each additional invention requested to be examined under § 1.129(b). In the final rule, the fee required by §§ 1.17(r) and 1.17(s) from a small entity is $365.00. The fee required from other than a small entity is $730.00.

The elimination of the small entity reduction in § 1.17(q) and the addition of the small entity reduction in §§ 1.17 (r) and (s) are the result of additional review, which resulted in the conclusion that the fees established for the transitional procedures in §§ 1.129 (a) and (b) may be reduced by fifty (50) percent for small entities. However, the petition fees required by § 1.17(q) are not subject to the fifty (50) percent reduction for small entities.

The proposed deletion of the retention fee practice set forth in former § 1.53(d), now redesignated § 1.53(d)(1), is being withdrawn. Therefore, § 1.21(l) is being retained and amended to refer to § 1.53(d)(1). Also, the proposed change in the text to § 1.17(n) is being withdrawn, since § 1.60 is being retained.

Section 1.28(a) is being changed to clarify the procedure for establishing status as a small entity in a nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application. In such cases, applicants may file a new verified statement or they may rely on a verified statement filed in the prior application, if status as a small entity is still proper and desired. If applicants intend to rely on a verified statement filed in the prior application, applicants must include in the nonprovisional application either a reference to the verified statement filed in the prior application or a copy of the verified statement filed in the prior application. A verified statement in compliance with existing § 1.27 is required to be filed in each provisional application in which it is desired to pay reduced fees.

Section 1.45(c), first sentence, is being changed for clarity to refer to a "nonprovisional" application.

Section 1.48 is being changed to include a new paragraph (e) setting forth the procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in § 1.17(q); and the written consent of any assignee. The first sentences of §§ 1.48 (a)–(c) are also being changed for clarity to refer to a "nonprovisional" application.

Section 1.51(a)(2)(i) is being changed to require that the provisional application cover sheet include the residence of each named inventor and, if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the name of the U.S. Government agency and Government contract number. The residence of each named inventor is information which is

necessary to identify those provisional applications which must be reviewed by the PTO for foreign filing licenses. If the invention disclosed in the provisional application was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the security review for that application should already have been done by that agency of the U.S. Government. Therefore, identification of those particular provisional applications on the cover sheet will reduce the number of applications which the PTO must forward to other agencies of the U.S. Government for security review.

Section 1.53(b)(1) is being changed to retain the reference to § 1.60.

Section 1.53(b)(2)(ii) is being changed to require that any petition and petition fee to convert a § 1.53(b)(1) application to a provisional application be filed in the § 1.53(b)(1) application prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. Where the § 1.53(b)(1) application was abandoned before the expiration of twelve (12) months after the filing date of the application, a petition to convert the application to a provisional application may be filed in the § 1.53(b)(1) application if the petition to convert is filed prior to the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application and is accompanied by an appropriate petition to revive an abandoned application under § 1.137.

Section 1.53(b)(2)(iii) is being changed to indicate that the requirements of §§ 1.821–1.825 regarding application disclosures containing nucleotide and/or amino acid sequences are not mandatory for provisional applications.

Section 1.53(d)(1) is being changed to retain the retention fee practice. The proposal to delete the retention fee practice set forth in § 1.53(d) is being withdrawn.

The first sentences of §§ 1.55 (a) and (b) are being changed for clarity to refer to a "nonprovisional" application.

Also, §§ 1.55 (a) and (b) are being changed to clarify that the nonprovisional application may claim the benefit of one or more prior foreign applications or one or more applications for inventor's certificate.

Section 1.59 is being changed to retain the reference to the retention fee set forth in § 1.21(l) and to clarify that the retention fee practice applies only to applications filed under § 1.53(b)(1).

The proposal to delete § 1.60 is being withdrawn. Therefore, § 1.60 is being retained and amended to clarify in the title of the section and in paragraph (b)(1) that the procedure set forth in the section is only available for filing a continuation or divisional application if the prior application was a nonprovisional application and complete as set forth in § 1.51(a)(1). Also, paragraph (b)(4) is being amended to delete the requirement that the statement which must accompany the copy of the prior application include the language that "no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein." The requirement is unnecessary because any amendment filed to complete the prior application would be considered a part of the original disclosure of the prior application and, by definition, could not contain new matter. Also, paragraph (b)(4) is being amended to refer to § 1.17(i).

Section 1.62(a) is being changed to refer to a prior complete "nonprovisional" application and to clarify that a continuing application may be filed under § 1.62 after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application. Section 1.62(a) is also being changed to clarify the existing practice that the request for a § 1.62 application must include identification of the inventors named in the prior application.

Section 1.63(a) is being changed for clarity to refer to an oath or declaration filed as a part of a "nonprovisional" application.

Section 1.67(b) is being changed for clarity to refer to a "nonprovisional" application.

Section 1.78 (a)(1) and (a)(2) are being changed to refer to a "nonprovisional" application and to clarify that the nonprovisional application may claim the benefit of one or more prior copending nonprovisional applications or international applications designating the United States of America. Section 1.78(a)(1)(ii) is being changed to retain the reference to § 1.60. Section 1.78(a)(1)(iii) is being retained and amended to refer to §§ 1.53(b)(1) and 1.53(d)(1).

Sections 1.78 (a)(3) and (a)(4) are being changed to refer to a "nonprovisional" application and to clarify that the nonprovisional application may claim the benefit of one or more prior copending provisional applications.

Section 1.78(a)(3) is also being changed to remind applicants and practitioners that when the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional

application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. Section 111(b)(5) of title 35, United States Code, states that a provisional application is abandoned twelve months after its filing date. Sections 119 (e)(1) and (e)(2) of title 35, United States Code, require that a nonprovisional application claiming benefit of a prior provisional application be filed not later than twelve months after the date on which the provisional application was filed and that the provisional application be pending on the filing date of the nonprovisional application. Under § § 1.6 and 1.10, no filing dates are accorded to applications on a Saturday, Sunday, or Federal holiday within the District of Columbia. Thus, if a provisional application is abandoned by operation of 35 U.S.C. 111(b)(5) on a Saturday, Sunday, or Federal holiday within the District of Columbia, a nonprovisional application claiming benefit of the provisional application under 35 U.S.C. 119(e) must be filed no later than the preceding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.78(a)(4) is also being changed to delete the requirement that the reference in the nonprovisional application to the provisional application indicate the relationship of the applications. As a result of the change, § 1.78(a)(4) provides that a nonprovisional application claiming benefit of one or more provisional applications must contain a reference to each provisional application, identifying it as a provisional application and including the provisional application number (consisting of series code and serial number). However, the section does not require the nonprovisional application to identify the nonprovisional application as a continuation, divisional or continuation-in-part application of the provisional application.

Section 1.83(a) is being changed to delete the proposed redesignation of paragraph (a) and to delete proposed paragraph (a)(2). Also, §§ 1.83 (a) and (c) are being changed for clarity to refer to a "nonprovisional" application. Further, § 1.83(c) is being changed to remove the reference to paragraph (a)(1).

Section 1.101 is being changed for clarity to refer to a "nonprovisional" application.

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Sections 1.129 (a) and (b) are being changed to identify the effective date of 35 U.S.C. 154(a)(2) as June 8, 1995.

Further, § 1.129(a) is being changed to provide that the first and second submissions and fees set forth in § 1.17(r) must be filed prior to the filing of an Appeal Brief, rather than prior to the filing of the Notice of Appeal, and prior to abandonment of the application. The requirement that the fee set forth in § 1.17(r) be filed within one month of the notice refusing entry is being deleted. Section 1.129(a) is also being changed to provide that the finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). The language indicating that the submission would be entered and considered after timely payment of the fee set forth in § 1.17(r) "to the extent that it would have been entered and considered if made prior to final rejection" is being deleted. In view of the magnitude of the fee set forth in § 1.17(r), the next PTO action following timely payment of the fee set forth in § 1.17(r) will be equivalent to a first action in a continuing application. Under existing PTO practice, it would not be proper to make final a first Office action in a continuing application where the continuing application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The identical procedure will apply to examination of a submission considered as a result of the procedure under § 1.129(a). Thus, under § 1.129(a), if the first submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Likewise, if the second submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. In view of 35 U.S.C. 132, no amendment considered as a result of the payment of the fee set forth in § 1.17(r) may introduce new matter into the disclosure of the application.

Section 1.129(b)(1) is being changed to identify the date which is two months prior to the effective date of 35 U.S.C. 154(a)(2) as April 8, 1995. Section 1.129(b)(1) is also being changed to clarify in subsection (ii) that the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant.

Section 1.129(b)(2) is being changed to delete the identification of the period provided for applicants to respond to a notification under § 1.129(b) as one month. The time period for response will be identified in any written notification under § 1.129(b) and will usually be one month, but in no case will it be less than thirty days. The period may be extended under § 1.136(a). The language is also being changed to provide that applicant may respond to the notification by (i) electing the invention or inventions to be searched and examined, if no election has been made prior to the notice, and paying the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects, (ii) confirming an election made prior to the notice and paying the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or (iii) filing a petition under § 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. The section is also being changed to provide that if the petition under § 1.129(b)(2) is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

Section 1.129(c) is being changed to clarify that the provisions of §§ 1.129 (a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995 would be subject to a 20-year patent term.

Section 1.137 is being amended by revising paragraph (c) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application. The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C.

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120, 121, or 365. No change to § 1.137 was proposed in the Notice of Proposed Rulemaking. However, in all applications filed on or after June 8, 1995, except design applications, any delay in filing a petition under § 1.137(a) will automatically result in the loss of patent term. The loss of patent term will be the incentive for applicants to promptly file any petition to revive. Therefore, no need is seen for requiring a terminal disclaimer in such applications. It would amount to a penalty if a terminal disclaimer was required.

Section 1.136 is being amended by revising paragraph (d) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1995" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121, or 365. No change to § 1.316 was proposed in the Notice of Proposed Rulemaking. However, in all applications filed on or after June 8, 1995, except design applications, any delay in filing a petition under § 1.316(b) will automatically result in the loss of patent term. The loss of patent term will be the incentive for applicants to promptly file any petition under § 1.316(b). Therefore, no need is seen for requiring a terminal disclaimer in such applications. It would amount to a penalty if a terminal disclaimer was required.

Section 1.317 is being amended by removing and reserving paragraph (d) to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent. No change to § 1.317 was proposed in the Notice of Proposed Rulemaking. However, the delay in filing a petition under § 1.317(b) does not result in any gain of patent term. Therefore, no reason is seen for requiring a terminal disclaimer in such cases.

Section 1.701(a) is being changed to identify the implementation date as June 8, 1995, and to clarify that a proceeding under 35 U.S.C. 135(a) is an interference proceeding.

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Section 1.701(b) is being changed to provide that the term of a patent entitled to an extension under § 1.701 shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of § 1.701 and the extension will run from the expiration date of the patent. The reference to a terminal disclaimer is being deleted to be consistent with § 1.701(a)(3) and to avoid any confusion.

Section 1.701(c)(1)(i) is being changed for clarity by deleting the phrase "if any" after the first occurrence of "interference" and by inserting the same phrase after the phrase "the number of days."

Section 1.701(c)(1)(ii) is being changed to clarify that the period referred to ends on the "date of the termination of the suspension" rather than on the date of the next PTO communication reopening prosecution.

Section 1.701(d)(1) is being amended to clarify that the "time" referred to is time "during the period of appellate review".

Section 1.701(d)(2) is being amended to clarify that the Commissioner, under the broad discretion granted by 35 U.S.C. 154(b)(3)(C), has decided to limit consideration of applicant's due diligence only to acts occurring during the period of appellate review. The supplementary information published in the Notice of Proposed Rulemaking contained examples of what might be considered a lack of due diligence for purposes of § 1.701(d)(2) as proposed. Specifically, the supplementary information identified requests for extensions of time to respond to Office communications, submission of a response which is not fully responsive to an Office communication, and filing of informal applications as examples. In view of the comments received and the language adopted in the final rules, those examples are withdrawn. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspensions at applicant's request under § 1.103(a) during the period of appellate review and abandonments during the period of appellate review.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1 and 3, are being amended as indicated below:

Section 1.1 is being amended to add a paragraph (i) to provide a special "Box Provisional Patent Application" address to assist the Mail Room in separating and processing provisional applications and mail relating thereto.

Section 1.9 is being amended to redesignate paragraph (a) as paragraph (a)(1) and to define a national application as a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371. A new paragraph (a)(2) is being added to define the term "provisional application" as a U.S. national application filed under 35 U.S.C. 111(b). Also, a new paragraph (a)(3) is being added to define the term "nonprovisional application" as a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

Sections 1.12 and 1.14 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i).

Sections 1.16(a)–(e) and (g) are being amended to clarify that those sections do not apply to provisional applications. A complete provisional application does not require claims. However, provisional applications may be filed with one or more claims as part of the application. Nevertheless, no additional claim fee or multiple dependent claim fee will be required in a provisional application. Section 1.16(f) is being amended to insert the words "basic fee". Section 1.16(e) refers to "the basic filing fee". Current Office practice allows a design application to be filed without the design filing fee or the oath/declaration as set forth in § 1.53(d)(1). The change to § 1.16(f) is merely for clarification. In addition, § 1.16(a) is being amended to replace the word "cases" with the word "applications", since the word "applications" is used elsewhere in the rule.

Section 1.16 is also being amended to add a new paragraph (k) which lists the basic filing fee for a provisional application as $75.00 for a small entity (see §§ 1.9(c)–(f)) or $150.00 for other than a small entity as contained in Public Law 103–465. Since the filing fee for a provisional application is established by Public Law 103–465 as a 35 U.S.C. 41(a) fee, the filing fee for a provisional application will be subject to the fifty (50) percent reduction provided for in 35 U.S.C. 41(h).

Further, § 1.16 is being amended to add a new paragraph (l) which establishes the surcharge required by new § 1.53(d)(2) for filing the basic filing fee or the cover sheet required by new § 1.51(a)(2) for a provisional application at a time later than the provisional application filing date as $25.00 for a small entity or $50.00 for other than a small entity.

Section 1.17(h) is being amended to clarify that the $130.00 petition fee for filing a petition for correction of inventorship under § 1.48 applies to all

patent applications, except provisional applications. Paragraph (i)(1) is being redesignated as paragraph (i) and paragraph (i)(2) is being removed. The fee for a petition under § 1.102 to make an application special has been placed in paragraph (i). The words "of this part", in § 1.17, paragraphs (h) and (i), are being deleted, since the paragraphs currently refer to sections in parts other than Part 1. Section 1.17(i) is also being amended to clarify that the fee set forth in paragraph (i) for filing a petition to accord a filing date under § 1.53 applies to all patent applications, except provisional applications.

A new § 1.17(q) is being added to establish a petition fee of $50.00 for filing a petition for correction of inventorship under § 1.48 in a provisional application and for filing a petition to accord a provisional application a filing date or to convert an application filed under § 1.53(b)(1) to a provisional application. The petition fee set forth in § 1.17(q) is not reduced for a small entity.

New §§ 1.17 (r) and (s) are being added to establish the fees for entry of a submission after final rejection under § 1.129(a) and for each additional invention requested to be examined under § 1.129(b), respectively. These fees have been set at $365.00 for a small entity and $730.00 for other than a small entity.

Section 1.21(l) is being amended to refer to § 1.53(d)(1).

Section 1.28(a) is being amended to clarify the procedure for establishing status as a small entity in a nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application. In such cases, applicants may file a new verified statement or rely on a verified statement filed in the prior application, if status as a small entity is still proper and desired. If applicants intend to rely on a verified statement filed in the prior application, applicants must include in the nonprovisional application either a reference to the verified statement filed in the prior application or a copy of the verified statement filed in the prior application. Status as a small entity may be established in a provisional application by complying with existing § 1.27.

Section 1.45(c) is being amended to clarify that the first sentence applies to a "nonprovisional" application. Section 1.45 (c) is also being amended to add a second sentence relating to joint inventors named in a provisional application. The second sentence states that each inventor named in a provisional application must have made a contribution to the subject matter disclosed in the provisional application. All that § 1.45(c), second sentence, requires is that if a person is named as an inventor in a provisional application, that person must have made a contribution to the subject matter disclosed in the provisional application.

Sections 1.48 (a)–(c) are being amended to specify that the procedures for correcting an error in inventorship set forth in those sections apply to nonprovisional applications. New paragraph (d) is being added to establish a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent. Paragraph (d) does not require the verified statement of facts by the original inventor or inventors, the oath or declaration by each actual inventor in compliance with § 1.63 or the consent of any assignee as required in paragraph (a). Instead, the procedure requires the filing of a petition identifying the name or names of the inventors to be added and including a statement that the name or names of the inventors were omitted through error without deceptive intention on the part of the actual inventor(s). The statement would be required to be verified if made by a person not registered to practice before the PTO. The statement could be signed by a registered practitioner of record in the application or acting in a representative capacity under § 1.34(a). The $50.00 petition fee set forth in § 1.17(q) would also be required. New paragraph (e) is also being added setting forth the procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in § 1.17(q); and the written consent of any assignee.

Section 1.51 is being amended to redesignate § 1.51(a) as § 1.51(a)(1) and to include a new paragraph (a)(2) identifying the required parts of a complete provisional application. As set forth in § 1.51(a)(2), a complete provisional application includes a cover sheet, a specification as prescribed in 35 U.S.C. 112, first paragraph, any necessary drawings and the provisional application filing fee. A suggested cover sheet format for a provisional application is included as an Appendix A to this Notice of Final Rulemaking and is available from the PTO free of charge to the public. However, the rule does *not* require the applicant to use the PTO suggested cover sheet. Any paper containing the information required in § 1.51(a)(2)(i) will be acceptable. The cover sheet is required to identify the paper as a provisional application and to provide the information which is necessary for the PTO to prepare the provisional application filing receipt. Also, the residence of each named inventor and, if the invention disclosed in the provisional application was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government, the name of the U.S. Government agency and Government contract number must be identified on the cover sheet.

Section 1.51(b) is being amended to indicate that an information disclosure statement is not required and may not be filed in a provisional application. Any information disclosure statements filed in a provisional application will either be returned or disposed of at the convenience of the Office. An information disclosure statement filed in a § 1.53(b)(1) application which has been converted to a provisional application will be retained in the application after the conversion, if the information disclosure statement was filed before the petition required by § 1.53(b)(2)(ii) was filed.

The title of § 1.53 and paragraph (a) are being amended to refer to application number, rather than application serial number. The term "application number" is found in current § 1.53(a).

Section 1.53(b) is being redesignated as § 1.53(b)(1) and is being amended to refer to § 1.17(i) rather than § 1.17(i)(1) to conform to the change therein.

A new § 1.53(b)(2) is being added to set forth the requirements for obtaining a filing date for a provisional application. Section 1.53(b)(2) states that a filing date will be accorded to a provisional application as of the date the specification as prescribed by 35 U.S.C. 112, first paragraph, any necessary drawings, and the name of each inventor of the subject matter disclosed are filed in the PTO. The filing date requirements for a provisional application set forth in new paragraph (b)(2) parallel the existing requirements set forth in former paragraph (b), now redesignated paragraph (b)(1), except that no claim is required. In order to minimize the cost of processing provisional applications and to reduce the handling of provisional applications, amendments,

other than those required to make the provisional application comply with applicable regulations, are not permitted after the filing date of the provisional application.

Section 1.53(b)(2)(i) is being added requiring all provisional applications to be filed with a cover sheet identifying the application as a provisional application. The section also indicates that the PTO will treat an application as having been filed under § 1.53(b)(1), unless the application is identified as a provisional application on filing. A provisional application, which is identified as such on filing, but which does not include all of the information required by § 1.51(a)(2)(i) would still be treated as a provisional application. However, the omitted information and a surcharge would be required to be submitted at a later date under new § 1.53(d)(2).

Section 1.53(b)(2)(ii) is being added to establish a procedure for converting an application filed under § 1.53(b)(1) to a provisional application. The section requires that a petition requesting the conversion and a petition fee be filed in the § 1.53(b)(1) application prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of twelve (12) months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition would not entitle applicant to a refund of the fees properly paid in the application filed under § 1.53(b)(1).

Section 1.53(b)(2)(iii) is being added to call attention to the provisions of Public Law 103–465 which prohibit any provisional application from claiming a right of priority under 35 U.S.C. 120, 121 or 365(c) of any other application. The section also calls attention to the provisions of Public Law 103–465 which provide that no claim for benefit of an earlier filing date may be made in a design application based on a provisional application and that no request for a statutory invention registration may be filed in a provisional application. Section 1.53(b)(2)(iii) further specifies that the requirements of §§ 1.821–1.825 are not mandatory for provisional applications. However, applicants are reminded that an invention being claimed in an application filed under 35 U.S.C. 111(a) or 365 which claims benefit under 35 U.S.C. 119(e) of a provisional application must be disclosed in the provisional application in the manner provided by the first paragraph of 35 U.S.C. 112. Voluntary compliance with the requirements of §§ 1.821–1.825 in

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the provisional application is recommended, in order to ensure that support for the invention claimed in the 35 U.S.C. 111(a) application can be readily ascertained in the provisional application.

Section 1.53(c) is being amended to require that any request for review of a refusal to accord an application a filing date be made by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2). This reflects the current practice set forth in the Manual of Patent Examining Procedure (MPEP), section 506.02 (Sixth Edition, Jan. 1995) with regard to any request for review of a refusal to accord a filing date for an application. The PTO will continue its current practice of refunding the petition fee, if the refusal to accord the requested filing date is found to have been a PTO error.

Section 1.53(d) is being redesignated as § 1.53(d)(1).

Section 1.53(d)(2) is being added to provide that a provisional application may be filed without the basic filing fee and without the complete cover sheet required by § 1.51(a)(2). In such a case, the applicant will be notified and given a period of time in which to file the missing fee, and/or cover sheet and to pay the surcharge set forth in § 1.16(l).

Section 1.53(e) is being redesignated as § 1.53(e)(1) and amended to refer to § 1.53(b)(1). Also, a new § 1.53(e)(2) is being added to indicate that a provisional application will not be given a substantive examination and will be abandoned no later than twelve (12) months after its filing date.

Sections 1.55(a) and (b) are being amended to clarify that the sections apply to nonprovisional applications and to clarify that a nonprovisional application may claim the benefit of one or more prior foreign applications or one or more applications for inventor's certificate. Also, § 1.55(a) is being amended to replace the reference to 35 U.S.C. 119 with a reference to 35 U.S.C. 119(a)–(d). In addition, the reference to § 1.17(i)(1) in § 1.55(a) is being replaced by a reference to § 1.17(i) to be consistent with the change to § 1.17. Section 1.55(b) is also being amended to refer to 35 U.S.C. 119(d) to conform to the paragraph designations contained in Public Law 103–465.

Section 1.59 is being amended to clarify that the retention fee practice set forth in § 1.53(d)(1) applies only to applications filed under § 1.53(b)(1).

Section 1.60 is being amended to clarify in the title of the section and in paragraph (b)(1) that the procedure set forth in the section is only available for filing a continuation or divisional application if the prior application was a nonprovisional application and complete as set forth in § 1.51(a)(1). Paragraph (b)(4) is being amended to delete the requirement that the statement which must accompany the copy of the prior application include the language that "no amendments referred to in the oath or declaration filed to complete the prior application introduced new matter therein." The requirement is unnecessary because any amendment filed to complete the prior application would be considered a part of the original disclosure of the prior application and, by definition, could not contain new matter. Also, paragraph (b)(4) is being amended to refer to § 1.17(i).

Section 1.62(a) is being amended to clarify that the procedure set forth in the section is only available for filing a continuation, continuation-in-part, or divisional application of a prior nonprovisional application which is complete as defined in § 1.51(a)(1). Section 1.62(a) is also being amended to clarify that a continuing application may be filed under § 1.62 after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application and that the request for a § 1.62 application must include identification of the inventors named in the prior application. The phrase "Serial number, filing date" in § 1.62(a) is being changed to "application number."

Section 1.62(e) is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17. Also, the term "application serial number" in § 1.62(e) is being changed to "application number."

Section 1.63(a) is being amended to replace the reference to § 1.51(a)(2) with a reference to § 1.51(a)(1)(ii) in order to conform with the changes in § 1.51 and to refer to an oath or declaration filed as a part of a nonprovisional application.

Section 1.67(b) is being amended to replace the reference to § 1.53(d) with a reference to § 1.53(d)(1) in order to conform with the changes in § 1.53. Furthermore, the references to §§ 1.53(b) and 1.118 are being deleted to make clear that the new matter exclusion applies to all applications including those filed under §§ 1.60 and 1.62. Also, the section is being amended to refer to a nonprovisional application.

Sections 1.78 (a)(1) and (a)(2) are being amended to clarify that the sections apply to nonprovisional applications claiming the benefit of one or more copending nonprovisional

applications or international applications designating the United States of America. Section 1.78(a)(1)(iii) is being amended to refer to §§ 1.53(b)(1) and 1.53(d)(1). Section 1.78(a)(2) is also being amended to eliminate the use of serial number and filing date as an identifier for a prior application. The section will require that the prior application be identified by application number (consisting of the series code and serial number) or international application number and international filing date.

Sections 1.78 (a)(3) and (a)(4) are being added to set forth the conditions under which a nonprovisional application may claim the benefit of one or more prior copending provisional applications. The later filed nonprovisional application must be an application other than for a design patent and must be copending with each provisional application. There must be a common inventor named in the prior provisional application and the later filed nonprovisional application. Each prior provisional application must be complete as set forth in §1.51(a)(2), or entitled to a filing date as set forth in § 1.53(b)(2) and include the basic filing fee. Section 1.78(a)(3) also includes the warning that when the last day of pendency of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, any nonprovisional application claiming benefit of the provisional application must be filed prior to the Saturday, Sunday, or Federal holiday within the District of Columbia. A provisional application may be abandoned by operation of 35 U.S.C. 111(b)(5) on a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case, a nonprovisional application claiming benefit of the provisional application under 35 U.S.C. 119(e) must be filed no later than the preceding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

Section 1.78(a)(4) is also being added to provide that a nonprovisional application claiming benefit of one or more provisional applications must contain a reference to each provisional application, identifying it as a provisional application and including the provisional application number (consisting of series code and serial number). The section does not require the nonprovisional application to identify the nonprovisional application as a continuation, divisional or continuation-in-part application of the provisional application.

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Sections 1.83 (a) and (c) are being amended to clarify that the sections apply to nonprovisional applications.

Section 1.97(d) is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.101(a) is being amended to indicate that the section applies to nonprovisional applications.

Section 1.102(d) is being amended to replace the reference to § 1.17(i)(2) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.103(a) is amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.129 is being added to set forth the procedure for implementing certain transitional provisions contained in Public Law 103–465. Section 1.129(a) provides for limited reexamination of applications pending for 2 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). An applicant will be entitled to have a first submission entered and considered on the merits after final rejection if the submission and the fee set forth in § 1.17(r) are filed prior to the filing of an Appeal Brief and prior to abandonment of the application. Section 1.129(a) also provides that the finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). After submission and payment of the fee set forth in § 1.17(r), the next PTO action on the merits may be made final only under the conditions currently followed by the PTO for making a first action in a continuing application final. If a subsequent final rejection is made in the application, applicant would be entitled to have a second submission entered and considered on the merits under the same conditions set forth for consideration of the first submission. Section 1.129(a) defines the term "submission" as including, but not limited to, an information disclosure statement, an amendment to the written description, claims or drawings, and a new substantive argument or new evidence in support of patentability. For example, the submission may include an amendment, a new substantive argument and an information disclosure statement. In view of the fee set forth in § 1.17(r), any information disclosure statement previously refused consideration in the application because of applicant's failure to comply with § 1.97 (c) or (d) or which is filed as part of either the first or second submission will be treated as though it had been filed within one of the time periods set forth in § 1.97(b) and will be considered without the petition and petition fee required in § 1.97(d), if it complies with the requirements of § 1.98. In view of 35 U.S.C. 132, no amendment considered as a result of the payment of the fee set forth in § 1.17(r) may introduce new matter into the disclosure of the application.

Section 1.129(b)(1) is being added to provide for examination of more than one independent and distinct invention in certain applications pending for 3 years or longer as of June 8, 1995, taking into account any reference to any earlier application under 35 U.S.C. 120, 121 or 365(c). Under § 1.129(b)(1), a requirement for restriction or for the filing of divisional applications would only be made or maintained in the application after June 8, 1995, if: (1) The requirement was made in the application or in an earlier application relied on under 35 U.S.C. 120, 121 or 365(c) prior to April 8, 1995; (2) the examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or (3) the required fee for examination of each additional invention was not paid. Under § 1.129(b)(2), if the application contains claims to more than one independent and distinct invention, and no requirement for restriction or for the filing of divisional applications can be made or maintained, applicant will be notified and given a time period to (i) elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects, (ii) in situations where an election was made in response to a requirement for restriction that cannot be maintained, confirm the election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected, or (iii) file a petition under § 1.129(b)(2) traversing the requirement without regard to whether the requirement has been made final. No petition fee is required. Section 1.129(b)(2) also provides that if the petition is filed in a timely manner, the original time period for electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be

searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects. Under § 1.129(b)(3), each additional invention for which the required fee set forth in § 1.17(s) has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

Section 1.129(c) is being added to clarify that the provisions of §§ 1.129 (a) and (b) are not applicable to any application filed after June 8, 1995. However, any application filed on June 8, 1995, would be subject to a 20-year patent term.

Section 1.137 is being amended by revising paragraph (c) to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.137(a) not filed within six (6) months of the date of the abandonment of the application. The language "filed before June 8, 1995" and "filed on or after June 8, 1995" as used in the amended rule, refer to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.139 is being added to set forth the procedure for reviving a provisional application where the delay was unavoidable or unintentional. Section 1.139(a) addresses the revival of a provisional application where the delay was unavoidable and § 1.139(b) addresses the revival of a provisional application where the delay was unintentional. Applicant may petition to have an abandoned provisional application revived as a pending provisional application for a period of no longer than twelve months from the filing date of the provisional application where the delay was unavoidable or unintentional. It would be permissible to file a petition for revival later than twelve months from the filing date of the provisional application but only to revive the application for the twelve-month period following the filing of the provisional application. Thus, even if the petition were granted to reestablish the pendency up to the end of the twelve-month period, the provisional application would not be considered pending after twelve months from its filing date. The requirements for reviving an abandoned provisional application set forth in § 1.139 parallel the existing requirements set forth in § 1.137.

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Sections 1.177, 1.312(b), 1.313(a), and 1.314 are being amended to replace the references to § 1.17(i)(1) with references to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.316(d) is being amended to eliminate, in all applications filed on or after June 8, 1995, except design applications, the requirement that a terminal disclaimer accompany any petition under § 1.316(b) not filed within six (6) months of the date of the abandonment of the application. Acceptance of a late payment of an issue fee in a design application is specifically provided for in § 1.155. Therefore, § 1.316 does not apply to design applications. The language "filed before June 8, 1955" as used in the amended rule, refers to the actual United States filing date, without reference to any claim for benefit under 35 U.S.C. 120, 121 or 365.

Section 1.317(d) is being removed and reserved to eliminate the requirement that a terminal disclaimer accompany any petition under § 1.317(b) not filed within six (6) months of the date of lapse of the patent.

Section 1.666 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Section 1.701 is being added to set forth the procedure the PTO will follow in calculating the length of any extension of patent term to which an applicant is entitled under 35 U.S.C. 154(b) where the issuance of a patent on an application, other than for designs, filed on or after June 8, 1995, was delayed due to certain causes of prosecution delay. Applicants need not file a request for the extension of patent term under § 1.701. The extension of patent term is automatic by operation of law. It is currently anticipated that applicant will be advised as to the length of any patent term extension at the time of receiving the Notice of Allowance and Issue Fee Due. Review of the length of a patent term extension calculated by the PTO under § 1.701 prior to the issuance of the patent would be by way of petition under § 1.181. If an error is noted after the patent issues, patentee and any third party may seek correction of the period of patent term granted by filing a request for Certificate of Correction pursuant to § 1.322. The PTO intends to identify the length of any patent term extension calculated under § 1.701 on the printed patent.

Section 1.701(a) is being added to identify those patents which are entitled to an extension of patent term under 35 U.S.C. 154(b).

Section 1.701(b) is being added to provide that the term of a patent entitled to extension under § 1.701(a) shall be extended for the sum of the periods of delay calculated under §§ 1.701 (c)(1), (c)(2), (c)(3) and (d), to the extent that those periods are not overlapping, up to a maximum of five years. The section also provides that the extension will run from the expiration date of the patent.

Section 1.701(c)(1) is being added to set forth the method for calculating the period of delay where the delay was a result of an interference proceeding under 35 U.S.C. 135(a). The period of delay with respect to each interference in which the application was involved is calculated under § 1.701(c)(1)(i) to include the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application. An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO. If a civil action is filed under 35 U.S.C. 146, and the decision of the district court is not appealed, the interference terminates on the date the time for filing an appeal from the court's decision expires. See section 2361 of the MPEP. The period of delay with respect to an application suspended by the PTO due to interference proceedings under 35 U.S.C. 135(a) not involving the application is calculated under § 1.701(c)(1)(ii) to include the number of days in the period beginning on the date prosecution in the application is suspended due to interference proceedings not involving the application and ending on the date of the termination of the suspension. The period of delay under § 1.701(a)(1) is the sum of the periods calculated under §§ 1.701 (c)(1)(i) and (c)(1)(ii), to the extent that the periods are not overlapping.

Section 1.701(c)(2) is being added to set forth the method for calculating the period of delay where the delay was a result of the application being placed under a secrecy order.

Section 1.701(c)(3) is being added to set forth the method for calculating the period of delay where the delay was a result of appellate review. The period of delay is calculated under § 1.701(c)(3) to include the number of days in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed

under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

Section 1.701(d) is being added to set forth the method for calculating any reduction in the period calculated under § 1.701(c)(3). As required by 35 U.S.C. 154(b)(3)(B), § 1.701(d)(1) provides that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination. The "filing date" for the purpose of § 1.701(d)(1) would be the earliest effective U.S. filing date, but not including the filing date of a provisional application or the international filing date of a PCT application. For PCT applications entering the national stage, the PTO will consider the "filing date" for the purpose of § 1.701(d)(1) to be the date on which applicant has complied with the requirements of § 1.494(b), or § 1.495(b), if applicable.

As contained in Public Law 103–465, 35 U.S.C. 154(b)(3)(C) states that the period of extension referred to in 35 U.S.C. 154(b)(2) "shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner." Section 1.701(d)(2) is being added to provide that the period of delay calculated under § 1.701(c)(3) shall be reduced by any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. Section 1.701(d)(2) also provide that in determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review. Acts which the Commissioner considers to constitute *prima facie* evidence of lack of due diligence under § 1.701(d)(2) are suspension at applicant's request under § 1.103(a) during the period of appellate review and abandonment during the period of appellate review.

Section 3.21 is being amended to provide that an assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number,

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e.g., 07/123,456) and to eliminate the use of serial number and filing date as an identifier for national patent applications in assignment documents. This change is intended to eliminate any confusion as to whether an application identified by its serial number and filing date in an assignment document is an application filed under § 1.53(b)(1), 1.60 or 1.62 or a design application or a provisional application since there is a different series code assigned to each of these types of applications.

Section 3.21 is also being amended to provide that if an assignment of a patent application filed under § 1.53(b)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended.

Further, § 3.21 is being amended to provide that if an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

Section 3.81 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent with the change to § 1.17.

Responses to and Analysis of Comments: Forty-nine written comments were received in response to the Notice of Proposed Rulemaking. These comments, along with those made at the public hearing, have been analyzed. Some suggestions made in the comments have been adopted and others have not been adopted. Responses to the comments follow.

General Comments

1. Comment: One comment questioned the use of the word "proposed" in the notice of proposed rulemaking in describing the statutory amendments contained in Public Law 103–465.

Response: The statutory changes contained in Public Law 103–465 were described as "proposed" changes in the Notice of Proposed Rulemaking because the President had not signed the legislation at the time the notice was prepared for publication. In fact, the legislation was signed by the President on December 8, 1994, which is the date of enactment.

2. Comment: Several comments urged the PTO to favorably consider the 17/20 patent term specified in H.R. 359 since this proposed legislation would overcome the existing impact of extended PTO prosecution and eliminate patent term extensions for prosecution delays. Furthermore, the proposed legislation is consistent with the Uruguay Round Agreements Act, Public Law 103–465.

Response: The administration and the PTO strongly believe that the 20-year patent term as enacted in Public Law 103–465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The PTO will take steps to ensure that processing and examination of applications are handled expeditiously.

3. Comment: One comment stated that the proposed rules are premature in view of the Rohrabacher bill, H.R. 359.

Response: The proposed rules are not premature. Public Law 103–465 was signed into law on December 8, 1994, with an effective date of June 8, 1995, for the implementation of the 20-year patent term and provisional applications. The Commissioner must promulgate regulations to implement the changes required by Public Law 103–465.

4. Comment: One comment stated that there is nothing in the TRIPs agreement that requires the term to be measured from filing, nor that provisional applications be provided for, nor that new fees of $730 as set forth in §§ 1.17 (r) and (s) be established. It is suggested that 35 U.S.C. 154 be amended to provide that "every patent (other than a design patent) shall be granted a term of twenty years from the patent issue date, subject to the payment of maintenance fees." It was also suggested that the section regarding maintenance fees be amended to add a new fee payable at 16.5 years of $5000 (for large entity)/ $2500 (for small entity) for maintenance of patent between 17 and 20 years.

Response: The suggestion has not been adopted. The administration and the PTO strongly believe that the 20-year patent term as enacted in Public Law 103–465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The establishment of a provisional application is not required by GATT. The provisional application has been adopted as a mechanism to provide easy and inexpensive entry into the patent system. The filing of provisional applications is optional. Provisional applications will place domestic applicants on an equal footing with foreign applicants as far as the measurement of term is concerned because the domestic priority period,

like the foreign priority period, is not counted in determining the endpoint of the patent term. As to the §§ 1.17 (r) and (s) fees, the statute authorizes the Commissioner to establish appropriate fees for further limited reexamination of applications and for examination of more than one independent and distinct inventions in an application.

5. Comment: One comment suggested that the 20-year patent term of claims drawn to new matter in continuation-in-part (CIP) applications be measured from the filing date of the CIP application, irrespective of any reference to a parent application under 35 U.S.C. 120.

Response: The suggestion has not been adopted. The term of a patent is not based on a claim-by-claim approach. Under 35 U.S.C. 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

6. Comment: One comment objected to the 20-year term provisions of Public Law 103–465 because it was believed that payment of maintenance fees would be required earlier under 20-year term than under 17-year term.

Response: The payment of maintenance fees are not due earlier under 20-year term than under 17-year term. Maintenance fees continue to be due at 3.5, 7.5 and 11.5 years from the issue date of the patent.

7. Comment: Several comments suggested that the expiration date be printed on the face of the patent.

Response: The suggestion has not been adopted. The expiration date will not be printed on the face of the patent. The PTO will publish any patent term extension that is granted as a result of administrative delay pursuant to § 1.701 on the face of the patent. The term of a patent will be readily discernible from the face of the patent. Furthermore, it is noted that the term of a patent is dependent on the timely payment of maintenance fees which is not printed on the face of the patent.

8. Comment: One comment suggested that in order to aid the bar in advising clients as to whether a provisional application has had its priority claimed in a patent, the PTO should somehow link the provisional application number

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with the complete application number and/or the patent number.

Response: It is contemplated by the PTO that all provisional applications will be given application numbers, starting with a series code "60" followed by a six digit number, e.g., "60/123,456." If a subsequent 35 U.S.C. 111(a) application claims the benefit of the filing date of the provisional application pursuant to 35 U.S.C. 119(e) and the 35 U.S.C. 111(a) application results in a patent, the provisional application would be listed by its application number and filing date on the face of the patent under the heading "Related U.S. Application Data." The public will be able to identify an application under the above-noted heading as a provisional application by checking to see if it has a series code of "60."

9. Comment: Several comments suggested that the PTO consider modifying the rules to permit the filing of all applications by assignees. This would promote harmonization with other patent laws throughout the world and would eliminate one of the difficulties which will occur for the PTO in considering claims for priority based on the filing of a provisional application.

Response: Assignee filing was recommended in the 1992 Advisory Commission Report on Patent Law Reform. The PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken under advisement in that project.

10. Comment: Several comments stated that a complete provisional application should not be forwarded to a central repository for storage.

Response: In view of the relatively small filing fee for a provisional application and the fact that the provisional application will not be examined, PTO handling must be kept to a minimum and these provisional applications, once complete, will be sent to the Files Repository for storage rather than being kept in the examination area of the PTO.

11. Comment: One comment suggested that the provisional application be maintained with the 35 U.S.C. 111(a) application because the examiner may need it to determine whether the 35 U.S.C. 111(a) application is entitled to the benefit of the prior provisional application and in the event of 18-month publication, there will be a demand for accessibility by the public to the provisional and 35 U.S.C. 111(a) applications upon publication.

Response: The suggestion has not been adopted. Benefit of the same provisional application may be claimed in a number of 35 U.S.C. 111(a) applications. If the PTO is to maintain the provisional application file with one of several 35 U.S.C. 111(a) applications claiming benefit of the provisional application and the 35 U.S.C. 111(a) application containing the provisional application file were to go abandoned while one of the other 35 U.S.C. 111(a) application issues, the public would be entitled to inspect the provisional application file but not the abandoned 35 U.S.C. 111(a) application file containing the provisional application file. This would create access problems.

12. Comment: One comment suggested that provisional applications be available in full to the public if the benefit of priority is being claimed.

Response: Section 1.14 relating to access applies to all applications including provisional applications. If the benefit of a provisional application is claimed in a later filed 35 U.S.C. 111(a) application which resulted in a patent, then access to the provisional application will be available to the public pursuant to § 1.14. The mere fact that a provisional application is claimed in a later filed 35 U.S.C. 111(a) application does not give the public access to the provisional application unless the 35 U.S.C. 111(a) application issues as a patent.

13. Comment: Several comments requested that the PTO clarify whether a 35 U.S.C. 111(a) application will be accorded an effective date as a reference under 35 U.S.C. 102(e) as of the filing date of the provisional application for which benefit under 35 U.S.C. 119(e) is claimed. If so, the comment questioned whether pending applications will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.

Response: If a patent is granted on a 35 U.S.C. 111(a) application claiming the benefit of the filing date of a provisional application, the filing date of the provisional application will be the 35 U.S.C. 102(e) prior art date. A pending application will be rejected under 35 U.S.C. 102(e) on the basis that an invention was described in a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application by another filed in the U.S. before the invention thereof by the applicant for patent.

14. Comment: One comment suggested that the PTO issue a final rule stating that if a 35 U.S.C. 111(a) application claims the benefit of the

filing date of a provisional application, the "inventive entity" for the purposes of 35 U.S.C. 102(e) will be the inventors listed on the issued patent, and the list of inventors in the provisional application shall have no effect on the identity of an "inventive entity" for the purposes of 35 U.S.C. 102(e).

Response: The suggestion has not been adopted. The "inventive entity" for the purpose of 35 U.S.C. 102(e) is determined by the patent and not by the inventors named in the provisional application. As long as the requirements of 35 U.S.C. 119(e) are satisfied, a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application has a 35 U.S.C. 102(e) prior art effect as of the filing date of the provisional application based on the inventive entity of the patent. It is clear from 35 U.S.C. 102(e) that the inventive entity is determined by the patent and a rule to this effect is not necessary.

15. Comment: One comment requested the PTO to express its position as to whether the filing of a provisional application with the subsequent filing of a 35 U.S.C. 111(a) application claiming benefit of the provisional application under 35 U.S.C. 119(e) creates a prior art date against other patent applicants under 35 U.S.C. 102(g).

Response: As to 35 U.S.C. 102(g), the filing of a provisional application with the subsequent filing of a 35 U.S.C. 111(a) application claiming benefit of the provisional application under 35 U.S.C. 119(e) creates a prior art date under 35 U.S.C. 102(g) as of the filing date of the provisional application.

16. Comment: One comment suggested that in view of the 20-year patent term measured from filing, § 1.103(a) should be deleted. The PTO should not have the right to suspend action on any application, thereby reducing applicant's term of protection.

Response: Section 1.103(a) refers to suspension of action as a result of a request by applicant. If applicant wishes to suspend prosecution and thereby reduce his/her term of protection, applicant should be permitted to do so.

17. Comment: One comment suggested that in order to avoid delays resulting from consideration of petitions to withdraw premature notices of abandonment, examiners should be required to contact an attorney of record prior to abandoning the application to find out if a response to an Office communication has been filed.

Response: The suggestion has not been adopted. However, in order to avoid loss of patent term, applicants are encouraged to check on the status in

cases where applicants have not received a return postcard from the PTO within two (2) weeks of the filing of any response to a PTO action.

18. Comment: One comment asked whether there is a "cut-off" date after which patentees may lose the opportunity to choose 17- vs. 20-year patent term.

Response: The "cut-off" date is June 8, 1995. A patent that is in force on June 8, 1995, or a patent that issues after June 8, 1995, on an application filed before June 8, 1995, is automatically entitled to the longer of the 20-year patent term measured from the earliest U.S. effective filing date or 17 years from grant. This is automatic by operation of law. Patentees need not make any election to be entitled to the longer term. A patent that issues on an application filed on or after June 8, 1995 is entitled to a 20-year patent term measured from the earliest U.S. effective filing date.

19. Comment: One comment stated that there is no clear guidance as to a patentee's "bonus rights" that may arise because of the difference in a 17-year term vs. a 20-year term. Will parties that were previously in a licensing arrangement have to renegotiate terms for the bonus patent term?

Response: Section 154(c) of title 35, United States Code, states that the remedies of sections 283 (injunction), 284 (damages) and 285 (attorney fees) shall not apply to acts which were commenced or for which substantial investment was made before June 8, 1995, and became infringing by reason of the 17/20 year term and that these acts may be continued only upon the payment of an equitable remuneration to the patentee that is determined in an action brought under chapters 28 and 29 of Title 35. There is no guidance provided in the statute as to the meaning of "substantial investment" and "equitable remuneration." Licensing arrangements are between the parties to the agreement and are determined by the terms of the agreement and state law and are outside the jurisdiction of the PTO.

20. Comment: One comment questioned whether an international application designating the U.S. filed before June 8, 1995, with entry into the U.S. national stage on or after June 8, 1995, preserves the 17-year patent term measured from grant.

Response: An international application designating the U.S. that is filed before June 8, 1995, with entry into the U.S. national stage under 35 U.S.C. 371 on or after June 8, 1995, preserves the option for a 17-year patent term measured from date of grant.

21. Comment: One comment suggested that 35 U.S.C. 371(c) be amended because a declaration should not be required to obtain a filing date and a prior art date under 35 U.S.C. 102(e).

Response: The suggestion has not been adopted. This issue was not addressed in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to re-engineer the entire patent process.

22. Comment: One comment suggested that §§ 1.604, 1.605 and 1.607 be amended to state that provisional applications are not subject to interference.

Response: The suggestion has not been adopted because it is unnecessary. By statute, 35 U.S.C. 111(b)(8), provisional applications are not subject to 35 U.S.C. 135, i.e., a provisional application will not be placed in interference.

23. Comment: One comment suggested that §§ 1.821–1.825 be amended so that (1) only unbranched sequences of ten or more amino acids and twenty or more nucleotides which are claimed have to be included in Sequence Listings, (2) previously published sequences can be omitted, and (3) the sequences of primers and oligonucleotide probes should not be included in a Sequence Listing if encompassed by another disclosed sequence.

Response: The suggestion has not been adopted. There was no change proposed to §§ 1.821–1.825 in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

24. Comment: One comment suggested that §§ 5.11 to 5.15 be amended to provide for the grant of a foreign license for a provisional application.

Response: The suggestion has not been adopted. The present language of §§ 5.11 to 5.15 already provides for the grant of a foreign license for a provisional application.

25. Comment: One comment suggested that in order to assist defense agencies in reviewing application for secrecy orders, PTO should (1) automatically impose a secrecy order on any application filed under 35 U.S.C. 111(a) if a secrecy order was previously imposed on corresponding provisional application, and (2) require applications filed under 35 U.S.C. 111(a) based on a previous provisional application to

indicate changes made to the provisional application in the 35 U.S.C. 111(a) application by means of underlining and bracketing.

Response: The suggestions have not been adopted. The PTO cannot automatically impose a secrecy order on any 35 U.S.C. 111(a) applications even if a secrecy order was previously imposed on a provisional application, for which benefit under 35 U.S.C. 119(e) is claimed, unless the agency which imposed the secrecy order on the provisional application specifically requests the PTO to do so since the 35 U.S.C. 111(a) application could disclose subject matter which is different from that which is disclosed in the provisional application.

As to item (2), the PTO will not require applicants to identify the differences in subject matter disclosed in the 35 U.S.C. 111(a) application and the provisional application.

26. Comment: One comment suggested that in order to relieve defense agencies from possible liability for secrecy orders imposed for more than 5 years, the PTO should seek legislation setting patent term at 20 years from the earliest filing date or 17 years from the issue date, whichever is longer, for any patent application placed under secrecy order.

Response: The suggestion has not been adopted. The PTO strongly believes that the 20-year patent term as enacted in Public Law 103–465 is the appropriate way to implement the 20-year patent term required by the GATT Uruguay Round Agreements Act. The 35-year limit for patent term extension set forth in § 1.701(b) is required by statute, 35 U.S.C. 154(b).

Comments Directed to Specific Rules

27. Comment: One comment suggested that in order to eliminate the need for the expression "other than a provisional application" in other parts of the regulations, § 1.9 should be amended to identify a 35 U.S.C. 111(a) application by some term that can be used in the rules to distinguish that type of application from a provisional application.

Response: The suggestion has been adopted. The rules are being amended to include a definition of the term "nonprovisional application" in § 1.9(a) to describe an application filed under 35 U.S.C. 111(a) or 371. Further, the term "nonprovisional application" is being used in the final rules where the rule applies only to applications filed under 35 U.S.C. 111(a) or 371 and not to provisional applications.

28. Comment: One comment suggested that the rules be simplified if

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a "national application" could be defined in § 1.9 to exclude a provisional application.

Response: The suggestion has not been adopted. Section 1.9(a), prior to this rulemaking, defined a national application to include any application filed under 35 U.S.C. 111. A provisional application is an application filed under 35 U.S.C. 111. It is appropriate to define a provisional application as a special type of national application.

29. Comment: One comment requested an explanation of the showing required in a petition under §§ 1.12 and 1.14 for access to pending applications and to assignment records for pending applications.

Response: There was no substantive change proposed to either § 1.12 or 1.14 in the Notice of Proposed Rulemaking. Thus, the showing required in a petition under § 1.12 or 1.14 remains the same after this final rulemaking as before. A discussion of such a petition can be found in section 103 of the MPEP.

30. Comment: Several comments objected to the definition in § 1.45(c) of joint inventors in provisional applications as being those having made a contribution to "the subject matter disclosed" in the provisional application. Various language, such as, "the subject matter which constitutes the invention," "subject matter disclosed and regarded to be the invention," "disclosed invention," "the inventive subject matter disclosed" was suggested. Another comment requested guidance as to the determination of inventorship in a provisional application.

Response: The suggestion has not been adopted. The term "invention" is typically used to refer to subject matter which applicant is claiming in his/her application. Since claims are not required in a provisional application, it would not be appropriate to reference joint inventors as those who have made a contribution to the "invention" disclosed in the provisional application. If the "invention" has not been determined in the provisional application because no claims have been presented, then the name(s) of those person(s) who have made a contribution to the subject matter disclosed in the provisional application should be submitted. Section 1.45(c) states that "if multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application." All that § 1.45(c) requires is that if someone is named as an inventor, that person must have made a contribution to the subject matter disclosed in the provisional application. When applicant has determined what the invention is by the filing of the 35 U.S.C. 111(a) application, that is the time when the correct inventors must be named. The 35 U.S.C. 111(a) application must have an inventor in common with the provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the provisional application under 35 U.S.C. 119(e).

31. Comment: Several comments suggested that it might be desirable to correct inventorship in a provisional application where an individual was erroneously named as an inventor and that the procedure for doing so should be set forth in § 1.48.

Response: Under 35 U.S.C. 119(e), as contained in Public Law 103–465, a later filed application under 35 U.S.C. 111(a) may claim priority benefits based on a copending provisional application so long as the applications have at least one inventor in common. An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application to serve as a basis for a priority claim under 35 U.S.C. 119(e). However, in response to the comments, § 1.48 is being amended to include a new paragraph (e) which sets forth the requirements for deleting the names of the inventors incorrectly named as joint inventors in a provisional application, namely, a petition including a verified statement by the inventor(s) whose name(s) are being deleted stating that the error arose without deceptive intent, the fee set forth in § 1.17(q) and the written consent of all assignees.

32. Comment: One comment suggested that in order to make the procedures for provisional applications as simple as possible, there is no need to provide any rules to add inventor(s) or change inventorship in a provisional application since the whole concept of inventorship is meaningless without a claim. Error in inventorship can be corrected by the filing of and 35 U.S.C. 111(a) application within 12 months after the filing of a provisional application.

Response: The suggestion has not been adopted. One of the requirements of 35 U.S.C. 119(e) is that a 35 U.S.C. 111(a) application must have at least one inventor in common with a provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing

date of the provisional application. In situations where there is no inventor in common between the 35 U.S.C. 111(a) application and the provisional application due to error in naming the inventors in the provisional application, procedures must be established to permit applicant to correct the inventorship in the provisional application.

33. Comment: One comment suggested that an individual who is the inventor of subject matter disclosed in a provisional application, but who is not named as an inventor in the provisional application because that subject matter was not intended to be claimed in a later filed 35 U.S.C. 111(a) application, could be added as an inventor pursuant to § 1.48(d) in the provisional application if the subject matter was claimed in 35 U.S.C. 111(a) application.

Response: The individual could be added as an inventor pursuant to § 1.48(d) in the provisional application so long as the individual was originally omitted without deceptive intent.

34. Comment: One comment questioned whether it would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d) that the error occurred without deceptive intention on the part of the inventors.

Response: It would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d), if the registered practitioner has a reasonable basis to believe the truth of the statement being signed.

35. Comment: One comment suggested that there should be no diligence requirement to correct inventorship in a provisional application.

Response: Diligence is not a requirement to correct inventorship in a provisional application in either § 1.48(d) or 1.48(e).

36. Comment: One comment suggested that § 1.48(a) be amended by deleting the requirements for "a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred" and for the written consent of any assignee.

Response: The suggestion has not been adopted. There was no substantive change proposed to § 1.48(a) in the Notice of Proposed Rulemaking. Since the correction of inventorship affects ownership rights, the existing rules are designed to provide assurances that all parties including the original named inventors and all assignees agree to the change of inventorship. If the

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requirements for verified statements of facts from the original named inventors and written consent of the assignees are to be deleted, the PTO would no longer have the assurances that all parties agree to the change.

37. Comment: One comment expressed concern that a provisional application filed without a claim will leave subsequent readers with little or no clue as to what the inventors in the provisional application considered to be their invention at the time the provisional application was filed and doubted that a provisional application filed without a claim defining the invention could ever provide a sufficient disclosure to support a claim for a foreign or U.S. priority date.

Response: Claims are not required by the statute to provide a specification in compliance with the requirements of 35 U.S.C. 112, first paragraph. However, if an applicant desires, one or more claims may be included in a provisional application. Any claim field with a provisional application will, of course, be considered part of the original provisional application disclosure.

38. Comment: One comment suggested that the PTO issue a specification format or guideline for a provisional application to enable an inventor to comply with 35 U.S.C. 112, first paragraph.

Response: The format of a provisional application is the same as for other applications and is set forth in existing § 1.77 which is applicable to provisional applications except no claims are required for provisional applications.

39. Comment: Several comments suggested that the PTO revise its rules to clarify that strict adherence to the enablement, description and best mode requirements of 35 U.S.C. 112, first paragraph, is not required in provisional applications.

Response: The suggestion has not been adopted. The substantive requirements of a specification necessary to comply with 35 U.S.C. 112, first paragraph, are established by court cases interpreting that section of the statute, not by rule. The case law applies to provisional applications as well as to applications filed under 35 U.S.C. 111(a).

40. Comment: Several comments suggested that the rules or comments published with the Final Rule indicate whether there is any requirement to update the best mode disclosed in the provisional application when filing the 35 U.S.C. 111(a) application.

Response: No rule was proposed to address the issue when going from a provisional application to a 35 U.S.C. 111(a) application because no current rule exists when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application. The question of whether the best mode has to be updated is the same when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application or from a provisional application to a 35 U.S.C. 111(a) application. Accordingly, the rationale of *Transco Products, Inc. v. Performance Contracting Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994), would appear to be applicable. Clearly, if the substantive content of the application does not change when filing the 35 U.S.C. 111(a) application, there is no requirement to update the best mode. However, if subject matter is added to the 35 U.S.C. 111(a) application, there may be a requirement to update the best mode.

41. Comment: One comment suggested that § 1.51(c) be amended to permit a provisional application to be filed with an authorization to charge fees to a deposit account.

Response: Section 1.51(c) permits an application to be filed with an authorization to charge fees to a deposit account. Section 1.51(c) applies to provisional applications. Therefore, no change to § 1.51(c) is necessary.

42. Comment: One comment suggested that the PTO confirm that there will be no procedural examination of a provisional application other than to determine whether the provisional application complies with § 1.51(a)(2).

Response: The PTO intends to require compliance with the formal requirements of §§ 1.52(a)–(c) only to the extent necessary to permit the PTO to properly microfilm and store the application papers.

43. Comment: Several comments suggested that an English translation of a foreign language provisional application should not be required unless necessary in prosecution of the 35 U.S.C. 111(a) application to establish benefit. If an English translation is required, there is no useful purpose to require the translation at any time earlier than the filing of 35 U.S.C. 111(a) application claiming the benefit of the provisional application.

Response: Provisional applications may be filed in a language other than English as set forth in existing § 1.52(d). However, an English language translation is necessary for security screening purposes. Therefore, the PTO will require the English language translation and payment of the fee required in § 1.52(d) in the provisional application. Failure to timely submit the translation in response to a PTO requirement will result in the abandonment of the provisional

application. If a 35 U.S.C. 111(a) application is filed without providing the English language translation in the provisional application, the English language translation will be required to be supplied in every 35 U.S.C. 111(a) application claiming priority of the non-English language provisional application.

44. Comment: One comment suggested that a new model oath or declaration form for use in claiming 35 U.S.C. 119(e) priority and a "cover sheet" for use in filing provisional applications be published as an addendum to the final rules.

Response: The suggestion has been adopted. See Appendix A for the sample cover sheet for filing a provisional application and Appendix B for the sample declaration for use in claiming 35 U.S.C. 119(e) priority.

45. Comment: One comment suggested that the statement in § 1.53(b)(2) that the provisional application will not be given a filing date if all the names of the actual inventor or inventor(s) are not supplied be deleted and § 1.41 be amended to make an exception for provisional applications. The comment suggested that 35 U.S.C. 111(b) is satisfied as long as the name of one person who made an inventive contribution to the subject matter of the application is given.

Response: The suggestion has not been adopted. Section 111(b) of title 35, United States Code, states that "a provisional application shall be made or authorized to be made by the inventor." This language parallels 35 U.S.C. 111(a). The naming of inventors for obtaining a filing date for a provisional application is the same as for other applications. A provisional application filed with the inventors identified as "Jones et al." will not be accorded a filing date earlier than the date upon which the name of each inventor is supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. Administrative oversight is an acceptable reason. It should be noted that for a 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing date of a provisional application, the 35 U.S.C. 111(a), application must have at least one inventor in common with the provisional application.

46. Comment: One comment suggested that a drawing should not be required to obtain a filing date for a provisional application. Whatever is filed should be given a serial number and filing date in order to establish status as a provisional application, regardless of what is in the specification or drawing. If the provisional

application omitted drawings, has pages missing, or is otherwise incomplete, then applicant may not be able to rely on the filing date of the provisional application in a subsequently filed 35 U.S.C. 111(a) application. It should not be the job of the Application Branch to review compliance with § 1.81(a).

Response: Section 111(b) of title 35, United States Code, states that a provisional application must include a specification as prescribed by 35 U.S.C. 112, first paragraph and a drawing as prescribed by 35 U.S.C. 113. Drawings are required pursuant to 35 U.S.C. 113 if they are necessary to understand the subject matter sought to be patented. If a provisional application as filed omitted drawings and/or has pages missing, the provisional application is prima facie incomplete and no filing date will be granted. Application Branch currently reviews all applications to make sure that no filing date will be granted to an application that is prima facie incomplete. Application Branch will perform the same type of review with provisional applications. If a filing date is not granted to a provisional application because it is prima facie incomplete, applicant may petition the PTO under § 1.182 to grant a filing date to the provisional application as of the date of deposit of the application papers if it can be shown that the omitted items are not necessary for the understanding of the subject matter.

47. Comment: One comment objected to the requirement in § 1.53(b)(2)(i) for a cover sheet identifying the application as a provisional application because it is unnecessarily rigid and contrary to Congress' desire to keep the filing of provisional application as simple as possible.

Response: The requirement that a provisional application be specifically identified on filing as a provisional application is not seen to be burdensome on the applicant and is necessary for the PTO to properly process the papers as a provisional application. All an applicant is required to do in order to comply with the requirement of § 1.53(b)(2)(i) is to include a transmittal sheet identifying the papers being filed as a PROVISIONAL application.

48. Comment: Several comments suggested that in § 1.53(b)(2)(ii), as proposed, the phrase "the expiration of 12 months after the filing date of the provisional application" should read "the expiration of 12 months after the filing date of the § 1.53(b)(1) – application".

Response: The suggestion has been adopted.

49. Comment: One comment objected to the requirement in § 1.53(b)(2)(ii) for a petition to convert an application filed under § 1.53(b)(1) to a provisional application and suggested that any confusion concerning applicant's intention could be handled informally without a petition or petition fee.

Response: The requirement for a petition and fee is intended to ensure that the cost of any PTO reprocessing is borne specifically by the applicant requesting the action.

50. Comment: Several comments suggested that the filing fee required in an application filed under 35 U.S.C. 111(a) claiming benefit of the filing date of an earlier 35 U.S.C. 111(a) application which has been converted to a provisional application under proposed § 1.53(b)(2)(ii) be reduced, since the $730/$365 filing fee was paid in the earlier application.

Response: The suggestion has not been adopted. The filing fee required in an application filed under 35 U.S.C. 111(a) is set by statute. The statute does not provide for the suggested reduction in the filing fee.

51. Comment: One comment suggested that the proposed § 1.53(b)(2)(iii) should apply retroactively to permit applications filed between June 9, 1994, and June 8, 1995, to be converted to provisional applications.

Response: The suggestion has not been adopted. The statute does not permit a provisional application to have a filing date prior to June 8, 1995.

52. Comment: One comment suggested that § 1.53(b)(2)(ii) be revised to state that the petition requesting conversion must also be filed before (1) the application becomes involved in interference, or (2) notice by the PTO of intent to publish the application as a statutory invention registration. This suggestion conforms with 35 U.S.C. 11(b)(8).

Response: The suggestion has not been fully adopted. It is not necessary to include interference in § 1.53(b)(2)(ii) because if a 35 U.S.C. 111(a) application becomes involved in an interference proceeding and applicant files a petition requesting conversion of that 35 U.S.C. 111(a) application to a provisional application, the 35 U.S.C. 111(a) will be removed from the interference proceeding upon granting the petition to convert. When a subsequent 35 U.S.C. 111(a) application is filed based on the provisional application, the subsequent 35 U.S.C. 111(a) application could be placed in the interference proceeding if necessary. As to the reference to statutory invention registration, § 1.53(b)(2)(ii) is being amended to

require the petition and the fee be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293.

53. Comment: One comment suggested that the procedures for converting a 35 U.S.C. 111(a) application to a provisional application be explained in greater detail in § 1.53(b)(2)(ii) or in the discussion. If a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, and a second 35 U.S.C. 111(a) application is concurrently filed, how should this be done and how should the first sentence in the second 35 U.S.C. 111(a) application be worded. Furthermore, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, will it be necessary to file a second 35 U.S.C. 111(a) application on the same day, or else lose the priority claim.

Response: The suggestion has not been adopted. The language in § 1.53(b)(2)(ii) is clear relating to the requirements for converting a 35 U.S.C. 111(a) application to a provisional application. If applicant wishes to convert a 35 U.S.C. 111(a) application to a provisional application, applicant must file a petition requesting the conversion along with the petition fee set forth in § 1.17(q). The petition and the fee must be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293. In the example noted in the comment, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, a second 35 U.S.C. 111(a) application must be filed on that same day, otherwise, applicant will lose the priority pursuant to 35 U.S.C. 119(e). An example of how the first sentence of the second 35 U.S.C. 111(a) application would read is, "This application claims the benefit of U.S. Provisional Application No. 60/———, filed ———, which was converted from Application No.———."

54. Comment: One comment suggested that the PTO consider a rule mandating that any prior U.S. application that would have been eligible for conversion to a provisional application that is abandoned in favor of a continuing application within one

year of the earlier priority date asserted be deemed constructively converted to a provisional application.

Response: The suggestion has not been adopted. Conversion of a 35 U.S.C. 111(a) application to a provisional will be permitted only by way of a petition and under the conditions set forth in § 1.53(b)(2)(ii). One reason for this is that the PTO plans to provide sufficient information on the printed patent to determine the end date of the 20-year patent term by identifying provisional applications using a unique series code, i.e., "60". Thus, a 35 U.S.C. 111(a) application converted to a provisional application will need to be reprocessed by the PTO with a new application number. The petition fee is intended to reimburse the PTO for the extra processing necessitated by the conversion.

55. Comment: One comment stated that § 1.53(b)(2)(ii) permits the conversion of a 35 U.S.C. 111(a) application to a provisional application. However, it is silent as to whether such a conversion would kill any benefit the 35 U.S.C. 111(a) application had of domestic and/or foreign priority.

Response: Section 111(b)(7) of title 35, United States Code, specifically states that a provisional application shall not be entitled to the right of priority of any other application under 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date in the United States under 35 U.S.C. 120, 121, or 365(c). If a 35 U.S.C. 111(a) application is converted to a provisional application, the granting of the conversion will automatically eliminate any claim of priority which could have been made in the 35 U.S.C. 111(a) application.

56. Comment: Several comments suggested that it was inconsistent with the purpose of the provisional application to require any compliance with the Sequence Disclosure Rules §§ 1.821–1.823 and 1.825, since the provisional applications are not examined and there is no comparison of the sequences with the prior art.

Response: The Office agrees with the comments that a provisional application need not comply with the requirements of §§ 1.821 through 1.825. Section 1.53(b)(2)(iii) is being amended to indicate that the requirements of §§ 1.821 through 1.825 regarding sequence listings are not mandatory for a provisional application. However, applicants are cautioned that in order for a 35 U.S.C. 111(a) application to obtain the benefit of the filing date of an earlier filed provisional application, the claimed subject matter of the 35 U.S.C. 111(a) application must have been disclosed in the provisional application in a manner provided by 35 U.S.C. 112, first paragraph. Applicants are encouraged to follow the sequence rules to ensure that support for the invention claimed in the 35 U.S.C. 111(a) application can be readily ascertained in the provisional application.

57. Comment: One comment suggested that the language in § 1.53(e)(2) that a provisional application will become abandoned no later than twelve months after its filing date was misleading and that the words "no later than" should be deleted because it was believed that a provisional application could not be abandoned prior to twelve months after its filing date.

Response: The statute does not state that a provisional application can never be abandoned prior to twelve months after its filing date. In fact, a provisional application may be abandoned as a result of applicant's failure to timely respond to a PTO requirement. For example, if a provisional application which has been accorded a filing date does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l). Failure to timely respond will result in the abandonment of the application. This may occur prior to twelve months after its filing date. Furthermore, a provisional application may also be expressly abandoned prior to twelve months from its filing date.

58. Comment: One comment objected to the deletion of the "retention fee" practice in § 1.53(d) since it permits an applicant in a first application claiming benefits under 35 U.S.C. 119 (a)–(d) or 120 to correct inventorship by filing a second application without having to pay the full filing fee in the first application.

Response: Since the comment indicated that there is a benefit to retain the retention fee practice, the proposal to eliminate the practice is withdrawn.

59. Comment: One comment stated that the language of §§ 1.53 (d)(1) and (d)(2) indicates an intent by the PTO to mail the "Notice Of Missing Parts" to applicant's post office address and argues that the "Notice" should be mailed to the registered practitioner who filed the application on behalf of the applicant.

Response: The language in §§ 1.53 (d)(1) and (d)(2) states that the applicant will be notified of the missing part, if a correspondence address is provided. This means that the "Notice" to applicant will be mailed to the

correspondence address provided in the application papers. Under current PTO practice, if no specific correspondence address is identified in the application, the address of the registered practitioner who filed the application on behalf of the applicant is used as the correspondence address. If no specific correspondence address or registered practitioner is identified in the application, the post office address of the first named inventor is used as the correspondence address. No change in current PTO practice in this regard is required as a result of § 1.53(d)(2) nor is any change planned.

60. Comment: Several comments objected to the proposed deletion of § 1.60. One comment suggested that the deletion of § 1.60 was a major rule change and should have been proposed separate from the proposed rules dealing with the changes in practice required by Public Law 103–465.

Response: In view of the comments received, the proposal to delete § 1.60 is withdrawn. However, the proposal will be considered as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

61. Comment: One comment suggested that in view of the deletion of § 1.60, language should be incorporated in § 1.53(a)(1) to state that a copy of the prior application along with a copy of the declaration may be filed to obtain a filing date. Furthermore, full details and guidelines of the procedure should accompany the rule.

Response: The suggestion has not been adopted. The proposal to delete § 1.60 is withdrawn in view of several comments received objecting to the deletion.

62. Comment: One comment suggested that the removal of the stale oath practice be codified.

Response: The suggestion has not been adopted. Neither the statute nor the rules require a recent date of execution to appear on the oath or declaration. The PTO practice of objecting to an oath or declaration where the time elapsed between the date of execution and the filing date of the application is more than three months is found in section 602.05 of the MPEP. Therefore, the removal of the stale oath practice will be accomplished by amending the MPEP.

63. Comment: One comment questioned whether a copy of an application faxed to an attorney could be filed in the PTO as the application papers.

Response: Yes. While a patent application may not be faxed directly to the PTO, an application faxed to an

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attorney may be forwarded to the PTO by mail or courier as the application papers provided the papers meet the formal requirements of § 1.52. Effective November 22, 1993, § 1.4 was amended to include a new paragraph (d) to specify that most correspondence filed in the PTO, which requires a person's signature, may be an original, a copy of an original or a copy of a copy. Only correspondence identified in §§ 1.4(e) and (f) require the original to be filed in the PTO. Thus, an oath or declaration required by § 1.63, 1.153, 1.162 or 1.175 may be an original, a copy of an original or a copy of a copy. See 1156 Off. Gaz. Pat. Office 61 (November 16, 1993).

64. Comment: One comment suggested that applicant be permitted to use § 1.62 procedure to file the 35 U.S.C. 111(a) application which claims the benefit of a provisional application, at least in those situations where the 35 U.S.C. 111(a) application has been converted to a provisional application which is followed by the filing of a second 35 U.S.C. 111(a) application.

Response: The suggestion has not been adopted. Section 1.62 will not be amended to permit the filing of a 35 U.S.C. 111(a) application based on a provisional application because the PTO sees this situation as a trap for applicants. The filing procedures would be made more complicated if an exception is provided to address situations where a 35 U.S.C. 111(a) application is converted to a provisional application and a second 35 U.S.C. 111(a) application is later filed. However, the suggestion will be taken under advisement when greater familiarity with provisional applications is developed.

65. Comment: One comment suggested that § 1.62 procedure be replaced with a simple petition procedure to reopen prosecution.

Response: The suggestion is not being adopted. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process.

66. Comment: One comment suggested that the language in § 1.62(a) that requires an identification of the "applicant's name of the prior complete application" is confusing and should be clarified.

Response: The suggestion has been adopted. Section 1.62 is being amended to require the identification of the "applicants named in the prior complete application."

67. Comment: One comment suggested that § 1.62 be amended to state that the refiling procedures set forth in § 1.62 may be used after the issue fee is paid when a petition under § 1.313(b)(5) is granted. This practice is permitted pursuant to the notice published in 1138 Off. Gaz. Pat. Office 40 (May 19, 1992).

Response: The suggestion has been adopted.

68. Comment: One comment suggested that § 1.62 be amended to clarify whether applicant needs to re-list, in the § 1.62 application, all the references cited by the examiner and applicant in the parent application in order to get those references printed on the eventual patent.

Response: The suggestion has not been adopted. Section 609 of the MPEP (Sixth Edition, Jan. 1995) has been amended to clarify that in a § 1.62 application, references submitted and cited in the parent application need not be resubmitted. These references will be printed on the patent. However, in any continuing application filed under § 1.53(b)(1) or 1.60, a list of the references must be resubmitted if applicant wishes to have the references printed in the eventual patent.

69. Comment: One comment suggested that § 1.67 should go into more detail on when supplemental oaths are required in § 1.53 filings of continuation and divisional applications.

Response: The suggestion has been adopted because it is seen to be unnecessary and no substantive change was proposed to § 1.67 in the Notice of Proposed Rulemaking.

70. Comment: One comment suggested that "not but" in § 1.67(b) should read "but not".

Response: The suggestion has been adopted.

71. Comment: Several comments suggested that a rule be provided to state that an application for patent is permitted to claim the benefit of the filing date of more than one prior provisional application so long as the applicant complies with all statutory provisions.

Response: The suggestion has been adopted. Section 1.78(a)(3) is being amended to indicate that applicants are permitted to separately claim the benefit of the filing date of more than one prior provisional application in a later filed 35 U.S.C. 111(a) application provided all statutory requirements of 35 U.S.C. 119(e) are complied with. It is noted that current practice permits an application to claim the benefits of the filing date of more than one prior foreign application under 35 U.S.C. 119(a)–(d) and of more than one prior copending U.S. application under 35 U.S.C. 120, without an explicit statement to that effect in the rules.

Since the final rules are being amended to specifically permit applications filed under 35 U.S.C. 111(a) to claim the benefits of the filing date of more than one prior copending provisional application, corresponding changes are also being made to §§ 1.55 and 1.78(a)(1) relating to claims for the benefits available under 35 U.S.C. 119(a)–(d) and 120 to be consistent with § 1.78(a)(3).

72. Comment: Several comments requested that the PTO specify language to use in the first sentence of an application when priority is based on more than one provisional application.

Response: Section 1.78(a)(4) requires that "any application claiming the benefit of a prior filed copending provisional application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior provisional application, identifying it as a provisional application, and including the provisional application number." Where a 35 U.S.C. 111(a) application claims the benefit of more than one provisional application, a suitable reference would read, "This application claims the benefit of U.S. Provisional Application No. 60/——, filed —— and U.S. Provisional Application No. 60/——, filed ——." In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. application No. 08/——, filed ——, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/——, filed ——."

73. Comment: One comment suggested that the rules address the effect on patent term where an applicant in a continuing application deletes the reference to the prior filed application before the patent issues.

Response: an applicant has full control over claims to the benefit of an earlier filing date under 35 U.S.C. 120, 121 or 365(c). The 20-year patent term will be based upon the filing date of the earliest U.S. application that the applicant makes reference to under 35 U.S.C. 120, 121 and 365(c). Whether an applicant is entitled to the benefit of the filing date of an earlier application is something that an applicant should examine before the patent is issued. The PTO is not, unless it comes up as an issue in the examination process, going to determine whether any of the claims are entitled to the earlier filing date. Applicant however, should determine whether the claims are entitled to or require the benefit of the earlier filing

date. If not, the applicant should consider canceling the reference to the earlier filed application to avoid having the 20-year patent term measured from that earlier filing date. An amendment adding or deleting a reference to an earlier filed application presented prior to a final action will be entered, however, the claims may be subject to possible intervening prior art.

74. Comment: One comment stated that in view of the fact that a provisional application is not entitled to claim the benefit of a prior filed copending national or international application as stated in § 1.53(b)(2)(iii), the phrase "other than a provisional application" in § 1.78(a)(2) is unnecessary.

Response: Section 1.78(a)(2) is being amended to state that "any nonprovisional application claiming the benefit of a prior copending nonprovisional or international application must contain * * *." Section 1.78(a)(2) addresses a 35 U.S.C. 111(a) application which claims the benefit of a prior copending 35 U.S.C. 111(a) application or international application.

75. Comment: Several comments objected to the content requirements for drawings filed in a provisional application as originally set forth in proposed § 1.83(a)(2). One comment suggested that no rule was necessary to set forth the required content of drawings in a provisional application.

Response: In view of the comments received, the proposed amendment to § 1.83 is withdrawn. Under 35 U.S.C. 113, first sentence, applicant must furnish drawings in a provisional application "where necessary for the understanding of the subject matter sought to be patented." This requirement is also stated in existing § 1.81(a). Therefore, no further elaboration on the content of the drawings in a provisional application is believed necessary in the rules.

76. Comment: One comment suggested that the rules specify that formal drawings are not required in a provisional application.

Response: The suggestion has not been adopted. However, the PTO intends to examine provisional applications for requirements of form only to the extent that is necessary to permit normal storage and microfilming of the application papers. Formal drawings are usually not required for those purposes.

77. Comment: Several comments suggested that § 1.97(d) be amended to require the PTO to consider any information disclosure statement submitted after a final rejection or notice of allowance if an appropriate fee is paid.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking. The existing rules are designed to encourage prompt submission of information to the PTO. To permit applicant to merely pay a fee to have any information disclosure statement submitted after a final rejection or Notice of Allowance would be contrary to the effort to encourage prompt submissions.

78. Comment: One comment suggested that § 1.97 be changed so that an office action which uses a newly cited reference as a ground for rejection under 35 U.S.C. 102 or 103 cannot be made final.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking.

79. Comment: One comment suggested that the words "which are not examined" in § 1.101 as proposed are unnecessary and could create a negative implication that some provisional applications are examined.

Response: The suggestion has not been adopted. By statute, provisional applications are not subject to 35 U.S.C. 131, i.e., the Commissioner is not permitted to examine a provisional application for patentability.

80. Comment: Several comments stated that it is unfair to require small entities to pay the full $730.00 fee set forth in proposed § 1.129. It is suggested that the fee be changed to $365.00 or less.

Response: Pursuant to Public Law 103–465, the Commissioner has the authority to establish appropriate fees for the further limited reexamination of applications and for the examination of more than one independent and distinct invention in an application. As a result of additional review, it was concluded that these fees may be reduced by 50% for small entities. Sections 1.17 (r) and (s) are being amended to indicate that the fees are reduced by 50% for small entities, that is, $365.00 for small entities.

81. Comment: Several comments suggested that the transitional procedure set forth in § 1.129(a) as proposed is equivalent to filing one application, i.e., it provides for an extra examination and reexamination after the original final rejection, and, therefore, the requirement for two $730.00 fees, which is equivalent to two filing fees, is unwarranted. Another comment suggested that if the proposed $730.00 fee is adopted, the examiner should be instructed to treat the after-final

amendment as any other initial filing, i.e., a new application, not as an amendment submitted after a non-final office action.

Response. Under existing PTO practice, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The identical procedure will apply to examination of a submission consideration as a result of the procedure under § 1.129(a). Thus, under § 1.129(a), if the first submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Likewise, if the second submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Thus, the fee required by § 1.129(a) has been set at the amount required for filing an application because the procedure provided by the rule is equivalent to the filing of two applications. No new matter can be entered by payment of the fee set forth in § 1.17(r).

82. Comment: Several comments suggested that the fees required for filing a provisional application and those fees required by §§ 1.129(a) and (b) for the transitional procedures should not be greater than the average cost of processing such matters by the PTO. Two comments stated that the fee required by § 1.129(a) is excessive relative to PTO costs.

Response: The fee required for filing a provisional application is set by Public Law 103–465 and the PTO has no discretion with respect to the amount of that particular fee. As to the fee required by § 1.129(a), the procedures relating to the first submission provided by § 1.129(a) is equivalent to the filing of a file wrapper continuation application under § 1.62, and therefore, the fee required with the first submission is appropriately set at the same amount as a filing fee, which is $730.00. The $730.00 fee is subject to a 50% reduction for small entities. The second submission is equivalent to the filing of

a second file wrapper continuation application and the fee for the second submission is appropriately set at the same amount as a filing fee. As to the fee required by § 1.129(b), the procedures set forth in § 1.129(b) permit applicants to retain multiple inventions in a single application rather than having to file multiple divisional applications. The fee for each independent and distinct invention in excess of one is appropriately set at the same amount as the filing fee for a divisional application, which is $730.00. The $730.00 fee is subject to a 50% reduction for small entities.

83. Comment: One comment suggested that the time period for the payment of the $730.00 fee for the transitional after-final practice by extended if applicant files a petition seeking reversal of the examiner's refusal to enter the amendment after final without fee, until one month after an unfavorable decision on the petition.

Response: If an earlier filed petition seeking reversal of the examiner's refusal to enter the amendment after final is granted by the Director finding that the final rejection was premature, but the petition had not been decided by the time the § 1.129(a) fee was due, applicant must submit the § 1.129(a) fee so as to toll the time period for response to the final rejection. Otherwise, the application would be abandoned. Upon granting of such a petition by the Director, the § 1.129(a) fee paid will be refundable to applicant on request. Applications that fall under § 1.129(a) are under final rejection and there is a time period running against the applicant. Applicant must toll that time period by paying the transitional after-final fee set forth in § 1.129(a) and any necessary extension of time fees and Notice of Appeal fee. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) may be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

84. Comment: One comment suggested that if it is decided that the transitional after-final practice is made permanent, the PTO should seek legislative authorization to provide reduced fees for small entities.

Response: If it is decided that the transitional after-final practice be made permanent, the PTO will propose legislation to accomplish this change.

85. Comment: Several comments suggested that §§ 1.129 (a) and (b) should apply to all applications regardless of whether they were filed before or after June 8, 1995.

Several comments suggested that the practices set forth in §§ 1.129 (a) and (b) should be made permanent.

Several comments suggested that an applicant should be permitted to have a submission entered and considered after any final rejection upon payment of a fee as set forth in § 1.17(r), not just the first and second final rejections.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

86. Comment: One comment suggested that the PTO make an effort to treat applications in which a submission under § 1.129(a) has been filed on an expedited basis.

Response: Once the submission is filed and the fee set forth in § 1.17(r) is paid the finality of the last PTO action is withdrawn. The filing of the submission and the fee under § 1.129(a) is equivalent to the filing of a continuing application and will be treated in the same fashion and under the same turnaround time frame as a continuing application.

87. Comment: One comment suggested that PTO practice be changed so that a first Office action in a continuing application cannot be made final.

One comment suggested that PTO practice regarding second action final be relaxed.

Response: The suggestions have not been adopted at this time. However, the PTO is undertaking a project to reengineer the entire patent process. These suggestions will be taken under advisement in that project.

88. Comment: One comment stated that in proposed § 1.129, there is no express provision for the finality of the previous rejection to be withdrawn if applicant complies with the proposed rule. It is suggested that the proposed rule state that the finality of the previous action would be withdrawn if applicant complied with the rule when making a first or second submission after a final action.

Response: The suggestion has been adopted.

89. Comment: One comment requested that the PTO clarify whether § 1.129(a) required the first final rejection to be specifically withdrawn and a different final (i.e., one containing a new ground of rejection) rejection made before applicant is entitled to make a second submission.

Response: The final rule provides that the finality of the previous final office action is automatically withdrawn upon the timely filing of the first § 1.129(a)

submission and the fee set forth in § 1.17(r). If the first PTO action following the payment of the § 1.17(r) fee is a non-final office action, a further response from applicant will be entered and considered as a matter of right without payment of the fee set forth in § 1.17(r). If the next office action or any subsequent action is made final, the finality of that office action will be automatically withdrawn upon the timely filing of a second § 1.129(a) submission and the fee set forth in § 1.17(r).

90. Comment: One comment suggested that the PTO not permit the first PTO action following the payment of the § 1.17(r) fee to be made final under any circumstances.

Response: The suggestion has not been adopted. The first PTO action following the payment of the § 1.17(r) fee may be made final under the same conditions that a first office action may be made final in a continuing application (see section 706.07(b) of the MPEP). However, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The procedure set forth in section 706.07(b) of the MPEP will apply to examination of a submission considered as a result of the procedure under § 1.129(a).

91. Comment: Several comments suggested that the filing of the first submission under § 1.129(a) within the statutory period for response set in final rejection should toll the running of the six-month statutory period.

Response: The filing of a submission, e.g., an information disclosure statement or an amendment, after a final rejection without payment of the fee set forth in § 1.17(r) will not toll the period for response set in the final rejection. However, § 1.129(a) is being amended to provide in the rule that the finality of the previous Office action is automatically withdrawn upon the filing of the submission and the payment of the fee set forth in § 1.17(r). Thus, the filing of a submission and the payment of the fee set forth in § 1.17(r) and any extension of time fees and Notice of Appeal fee, if they are necessary to avoid abandonment of the application, will automatically toll the period for response set in the final rejection. It must be kept in mind that the provisions of § 1.129 apply only to an application, other than for reissue or

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a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c).

92. Comment: One comment asked (1) whether it would be necessary to file a Notice of Appeal and appeal fee with or after the first submission and fee if the examiner acts on the first submission and before the end of the six months from the date of the final rejection issues (a) a notice of allowance, (b) a non-final action, or (c) a second final rejection; (2) would the Notice of Appeal and fee be due only at the end of the six months from the date of the final rejection regardless of whether the examiner has acted on the submission by then; and (3) if the Notice of Appeal and fee have once been paid following a first final rejection, would a second notice and fee need to be paid if a second final rejection were issued and applicant desired to file a second submission under § 1.129(a).

Another comment suggested that the appeal fee set forth in § 1.17(e) should not be required where the Notice of Appeal is filed with a § 1.129(a) submission and the fee set forth in § 1.17(r).

Response: As to questions (1) and (2) and the second comment, if the first submission and the proper fee set forth in § 1.17(r) are timely filed in response to the final rejection, the finality of the previous rejection will be automatically withdrawn and applicant need not file the Notice of Appeal or the appeal fee. For example, if the first submission and the proper fee set forth in § 1.17(r) were filed on the last day of the six-month period for response to the final rejection, applicant must also file a petition for three months extension of time with the appropriate fee in order to avoid abandonment of the application. In such case, applicant need not file the Notice of Appeal or the appeal fee if the proper fee set forth in § 1.17(r) was timely paid. However, under the same fact situation, if applicant failed to submit the proper fee set forth in § 1.17(r), the finality of the previous rejection would not be withdrawn and the time period for response would still be running against applicant. In such case, a Notice of Appeal and appeal fee must also accompany the papers filed at the six-month period in order to avoid abandonment of the application. The proper fee set forth in § 1.17(r) must be filed prior to the filing of the Appeal Brief and prior to the abandonment of the application.

As to question (3), if the Notice of Appeal and fee have once been paid following a first final rejection and applicant timely files a first submission and the proper fee set forth in § 1.17(r), the finality of the previous final rejection will be withdrawn and the appeal fee paid could be applied against any subsequent appeal. If the examiner issues a non-final rejection in response to applicant's first submission, a further response from applicant will be entered and considered as a matter of right. If any subsequent Office action is made final, applicant may file a second submission along with the proper fee pursuant to § 1.129(a). If the second submission and the proper fee set forth in § 1.17(r) are timely filed in response to the subsequent final rejection, the finality of the previous final rejection will be withdrawn. Any submission filed after a final rejection made in the application subsequent to the fee under § 1.129(a) having been paid twice will be treated as set forth in § 1.116. Applicant may, upon payment of the appeal fee, appeal a final rejection within the time allowed for response pursuant to § 1.191.

93. Comment: One comment questioned whether the "first submission" under § 1.129(a) has to be the first response filed after a final rejection or could it include subsequent responses to the same final rejection.

Response: The "first submission" under § 1.129(a) would include all responses filed prior to and with the payment of the fee required by § 1.129(a) provided the submission and fee are filed prior to the filing of the Appeal Brief and prior to abandonment of the application.

94. Comment: One comment suggested that § 1.129(a) be changed to permit the procedure to be available up until the filing of an Appeal Brief since it is not uncommon to file an amendment after a Notice of Appeal is filed but before the filing of an Appeal Brief.

Response: The suggestion has been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the application.

95. Comment: One comment suggested that the transitional after-final practice be available at any time after final, including after the resolution of an appeal unfavorable to applicant in whole or in part.

Response: The suggestion has not been adopted. Section 1.129(a) is being amended to indicate that the submission and the fee set forth in § 1.17(r) must be submitted before the filing of the Appeal Brief and prior to abandonment of the

application. The suggestion to extend the period to after the resolution of an appeal unfavorable to applicant in whole or in part has not been adopted because the suggestion would further unduly extend prosecution of the application.

96. Comment: One comment stated that if an examiner must withdraw the finality of the rejection as a result of the transitional provision, the examiner should be credited with two counts in order to be compensated for the additional work.

Response: The examiner credit system is not part of this rulemaking package. However, as part of the Public Law 103–465 implementation plan, some accommodation will be made for the extra work performed.

97. Comment: One comment stated that regarding the transitional after-final practice, the fee should not be required if the only reason is to have the PTO consider recently obtained art.

Response: Under current practice, if applicant submits prior art after final rejection but before the payment of issue fee, the art will be considered if applicant makes the required certification and submits a petition with the required petition fee of $130.00 (see section 609 of the MPEP). If applicant can make the certification, applicant would not have to rely on the transitional after-final procedure to have the prior art considered. In the event that applicant cannot make the certification, then the procedure under § 1.129(a) is available if applicant wishes the PTO to consider the prior art without refiling the application.

98. Comment: One comment suggested that the PTO modify existing restriction practice to make it more difficult for examiners to require restriction, for example, by requiring every restriction requirement to show two-way distinctness and separate status in the art established by means other than reference to the PTO's classification system.

Response: The suggestion has not been adopted. However, the PTO is undertaking a project to reengineer the entire patent process. This suggestion will be taken under advisement in that project.

99. Comment: One comment suggested that the pendency periods required by §§ 1.129(a) and (b) should be 18 months rather than 2-year and 3-year, respectively.

Response: The pendency periods set forth in the rule which establish eligibility for the transitional procedures are set forth in Public Law 103–465.

100. Comment: One comment suggested that § 1.129(a) be amended to

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permit prosecution to be reopened after a Notice of Allowance or final rejection upon the filing of a form requesting that prosecution be reopened and payment of the necessary fee.

Response: The procedures set forth in § 1.129(a) are not applicable to amendments filed after a Notice of Allowance. Amendments filed after the mailing of a Notice of Allowance are governed by § 1.312. The procedures set forth in § 1.129(a) are applicable to amendments filed after a final rejection. If applicant submits an amendment after final and the examiner notifies the applicant in writing that the amendment is not entered, § 1.129(a) permits applicant to submit a letter prior to abandonment of the application and prior to the filing of the Appeal Brief, requesting entry of the prior filed amendment along with the payment of the appropriate fee set forth in § 1.17(r). The letter requesting entry of the prior filed amendment would be equivalent to "a form" as suggested in the comment.

101. Comment: One comment suggested that the PTO liberalize its current practice under § 1.116 to make it easier for amendments or evidence to be entered and considered after a final rejection.

Response: The suggestion has not been adopted since no change was proposed to § 1.116 in the Notice of Proposed Rulemaking. However, the suggestion will be taken under advisement as part of a comprehensive effort being conducted by the PTO to reengineer the entire patent process. It should be noted that any change to liberalize the current practice under § 1.116 would necessitate increasing fees.

102. Comment: Several comments suggested that the transitional restriction provision be modified to state that no restriction requirement shall be made or maintained in any application pending for three years on the effective date of the legislation. The comment stated that if restriction requirements made prior to April 8, 1995, are permitted to be maintained then applicants will be forced to file divisional applications resulting in the automatic loss of term after June 8, 1995. A heavy penalty will be placed on the chemical, pharmaceutical and biotechnology industries, who have less than 4 months to search through the ancestors of all pending applications and to identify all restriction requirements and to file divisional applications before June 8, 1995. The comment further suggested that the current restriction practice be changed in view of the implementation of the 20-year term.

Response: The suggestion has not been adopted. The two-month date set forth in § 1.129(b)(1)(i) is from the Statement of Administrative Action, which is part of Public Law 103–465. Under section 102 of Public Law 103–465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application." The Commissioner does not have any authority to establish rules which are inconsistent with the Act. It is noted that in cases where a restriction requirement was made prior to April 8, 1995, applicant will have sufficient time to file divisional applications prior to June 8, 1995, so as to retain the benefit of the 17-year patent term for those divisional applications.

The PTO is currently reviewing the restriction practice in view of the implementation of the 20-year patent term. It is noted that a change in restriction practice without changes to other fees would have a negative impact on funding needed to operate the PTO.

103. Comment: Several comments suggested that proposed exceptions (1) and (2) in § 1.129(b) ignore the mandatory language of section 532(2)(B) of Public Law 103–465 and should be deleted.

Response: The suggestion has not been adopted. The exceptions referred to are contained in the Statement of Administrative Action, which is part of Public Law 103–465. Under section 102 of Public Law 103–465, "the statement of administrative action approved by the Congress shall be regarded as an authoritative expression by the United States concerning the interpretation and application of the Uruguay Round Agreements and this Act in any judicial proceeding in which a question arises concerning such interpretation or application."

104. Comment: One comment asked whether "restriction" under § 1.129(b) apply to election of species under § 1.146.

Response: "Restriction" under § 1.129(b) applies to both requirements under § 1.142 and elections under § 1.146.

105. Comment: Several comments requested that clarification be made as to what constitutes "actions by the applicant" in § 1.129(b)(1) and specifically, whether a request for extension of time under § 1.136(a) constitutes such "actions" by the applicant.

Response: Examples of what constitute "actions by the applicant" in § 1.129(b)(1) are: (1) applicant abandons the application and continues to refile the application such that no Office action can be issued in the application, and (2) applicant requests suspension of prosecution under § 1.103(a) such that no Office action can be issued in the application. Extension of time under § 1.136(a) would not constitute such "actions by the applicant" under § 1.129(b)(1).

106. Comment: One comment suggested that the one-month period set forth in § 1.129(b) is insufficient to give an applicant time to file a petition under § 1.144 from a restriction requirement. Several comments suggested that § 1.129(b) be amended to permit applicant to challenge the restriction requirement by way of a petition before being required to pay the fees set forth in § 1.17(s).

Response: Section 1.129(b)(2) is being amended in the final rule package to indicate that applicant will be given "a time period" to (1) make an election, if no election has been previously made, and pay the fee set forth in § 1.17(s), (2) confirm an earlier election and pay the fee set forth in § 1.17(s), or (3) file a petition under § 1.129(b)(2) traversing the restriction requirement. If applicant chooses not to pay the fee set forth in § 1.17(s), applicant may file a petition under § 1.129(b)(2) requesting immediate review by the Group Director of the restriction requirement. No petition fee is required. A petition under § 1.129(b)(2) rather than under § 1.144 would be more appropriate under the circumstances since a petition under § 1.144 requires the examiner to make the restriction final before the petition can be considered.

107. Comment: One comment suggested that if applicant elects not to pay the fee set forth in § 1.17(s), applicant should be allowed to elect the invention to be examined.

Response: The suggestion has been adopted. Section 1.129(b) is being amended to indicate that if applicant chooses not to pay the fees for the additional inventions, applicant must elect the invention to be examined and the claims directed to the non-elected inventions for which no fee has been paid will be withdrawn from consideration.

108. Comment: One comment suggested that the PTO amend the rules to permit all, or at least several, inventions to be examined in a single application upon payment of an appropriate fee.

Response: The suggestion has not been adopted at this time. However, the

PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken in advisement in this project.

109. Comment: One comment suggested that PTO follow the wording of 35 U.S.C. 121 and only require restriction where an application claims two or more independent and distinct inventions rather than two or more independent or distinct inventions.

Response: In making restriction requirements, the PTO has always followed the wording of 35 U.S.C. 121 to require restriction if two or more independent and distinct inventions are claimed in an application rather than independent or distinct as suggested by the comment. The term "independent" includes species and related inventions such as combination/subcombination and process and product. Restriction is proper if these independent inventions are patentably distinct (see section 802.01 of the MPEP).

110. Comment: One comment suggested that the standard for determining whether an application contains independent and distinct inventions should only be the "unity of invention" standard used for PCT applications.

Response: The suggestion has not been adopted. The current restriction practice for 35 U.S.C. 111(a) applications is governed by 35 U.S.C. 121 and §§ 1.141, 1.142 and 1.146. The PCT "unity of invention" standard only applies to PCT applications and applications filed under 35 U.S.C. 371. The PTO is currently reviewing the restriction practice in view of the implementation of the 20-year patent term. It is noted that a change in restriction practice without changes to other fees would have a negative impact on funding needed to operate the PTO.

111. Comment: One comment suggested that the PTO apply the PCT unity of invention standard as interpreted by the EPO and that § 1.475(b) be amended to permit a broad range of claims in a single application.

Response: The PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken under advisement in this project.

112. Comment: One comment suggested that the PTO examiner should not be permitted to issue a restriction requirement or an election of species requirement if the ISA and the IPEA have found that an application complies with the unity of invention requirement.

Another comment suggested that the PTO consider allowing applicants to retain all claims in a single application when the claims are related, e.g., method and apparatus claims.

Another comment suggested that all species be searched before the first Office action regardless of whether one species is found to be unpatentable.

Another comment suggested that election of species requirements be prohibited.

Response: The suggestions have not been adopted. These issues were not addressed in the Notice of Proposed Rulemaking. However, the PTO is currently undertaking a project to reengineer the entire patent process. The suggestions will be taken under advisement in that project.

113. Comment: One comment suggested that decisions on whether to issue a restriction requirement be made within two-three months of the application filing date, and, if the requirement is traversed, the examiner should determine within four-five months of the filing date whether to maintain the requirement. Decisions on petitions to withdraw a restriction requirement should be decided within one month.

Response: The suggestion has not been adopted. Current practice dictates that restriction requirements be made at the earliest appropriate time in the pendency of a given application, e.g., in the first Office action. It would be difficult to issue a restriction requirement within two-three months of the application filing date as suggested since a large number of applications are filed with missing parts and applicants are given a time period to submit the missing parts. Furthermore, applications must be processed by the Application Branch and must be screened by Licensing and Review for national security. Petitions to withdraw a restriction requirement should be acted on by the Group Director expeditiously.

114. Comment: One comment argued that the phrases, "so as to be pending for a period of no longer than 12 months" and "under no circumstances will the provisional application be pending after 12 months", in § 1.139 were repetitious and suggested that one or both of the phrases be deleted.

Response: The suggestion has not been adopted. The statements are included for emphasis.

115. Comment: One comment suggested that § 1.139 clearly state that if the revival petition is filed later than 12 months after filing of the provisional application, then the revival is for the sole purpose of providing copendency for a 35 U.S.C. 111(a) application filed during that 12-month period.

Response: The suggestion has not been adopted. The proposed language is not necessary.

116. Comment: One comment stated that 35 U.S.C. 154(b) as contained in Public Law 103-465 does not give the Commissioner any authority to decide the period of extension. Therefore, proposed § 1.701 is without statutory basis.

Response: 35 U.S.C. 6(a) gives the Commissioner authority to establish regulations not inconsistent with law. Section 1.701 is consistent with 35 U.S.C. 154(b) and furthermore, the Commissioner has the authority under 35 U.S.C. 154(b)(3)(C) to establish regulations to address the standards for determining due diligence.

117. Comment: One comment questioned whether patent term extension under 35 U.S.C. 154(b) is available for patents issuing: (1) Before June 8, 1995, with a 17-year patent term or a 17/20 year patent term; (2) on or after June 8, 1995, on applications filed before June 8, 1995, with a 17-year patent term or a 17/20 year patent term.

Response: None of the patents set forth in the examples are eligible for patent term extension. Under the terms of the statute, patent term extension is only available for patents issued on applications filed on or after June 8, 1995.

118. Comment: Several comments questioned whether a patent issued on a continuing application is entitled to a patent term extension under 35 U.S.C. 154(b) due to interference, secrecy order, or appellate review delays occurring in the examination of the parent application.

Response: If the delay in the parent application contributed to a delay in the issuance of a patent in the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

119. Comment: One comment suggested that the patent term be extended for a period of time equal to the time necessary to revive an application improperly abandoned due to PTO error. Another comment suggested that patent time extension be available for other PTO delays.

Response: The suggestions have not been adopted. Section 154(b) of title 35, United States Code, only permits patent term extension for delays due to interferences, secrecy orders, and/or successful appeals.

120. Comment: One comment suggested that the period of an extension granted under § 1.701 be printed on the face of the patent.

Response: The PTO will publish on the face of the patent any patent term

extension that is granted pursuant to § 1.701.

121. Comment: One comment suggested that the word "interference" be inserted before the word "proceedings" in § 1.701(a)(1).

Response: The suggestion has been adopted.

122. Comment: One comment stated that the last sentence of § 1.701(b) is confusing because it suggests that patent term extension will be available in cases of terminal disclaimer and that the extension begins on the terminal disclaimer date rather than the original expiration date. This statement is contrary to 35 U.S.C. 154(b)(2) which does not permit any patent term extension for appellate delay if the patent is subject to a terminal disclaimer.

Response: In order to reduce confusion, the last sentence of § 1.701(b) is being amended to state that the extension will run from the expiration date of the patent. The reference to "terminal disclaimer" is being deleted.

123. Comment: Two comments stated that if an application involved in an interference proceeding contains uninvolved claims, those uninvolved claims should not be entitled to extension of patent term under proposed § 1.701 because applicant could cancel those uninvolved claims from the application and refile those claims in a continuation application. It is suggested that if an applicant leaves conclusively uninvolved claims (where no § 1.633(c)(4) motion is filed) in the application in interference, applicant does not get the benefit of the extension for any claim.

Response: The suggestion has not been adopted. The statute, 35 U.S.C. 154(b), grants patent term extension to a patent if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a). The statute does not exclude applications containing uninvolved claims. The Commissioner does not have the authority to establish regulations which are inconsistent with the law. Therefore, an application involved in an interference which contains uninvolved claims will be entitled to patent term extension if the issuance of the patent was delayed due to interference proceeding under 35 U.S.C. 135(a).

124. Comment: One comment asked whether applicant is entitled to patent term extension regardless of whether an interference involving applicant's application is ultimately declared.

One comment asked if the PTO ends the suspension without declaring an interference, and continued prosecution results in filing of a continuation or divisional application, are such subsequent cases entitled to the extension.

Response: An application will not be suspended unless it is decided that an interference can be declared involving that application. If prosecution of applicant's application is suspended due to an interference not involving applicant's application and an interference involving applicant's application is later declared, applicant will be entitled to patent term extension under § 1.701(c)(1)(ii) for the suspension period and under § 1.701(c)(1)(ii) for the interference period. However, if prosecution of applicant's application is suspended due to an interference not involving applicant's application and if the PTO ends the suspension of the application without declaring an interference involving applicant's application, that application will be entitled to patent term extension under § 1.701(c)(1)(ii). If prosecution results in filing of a continuing application and if the delay in the parent application contributed to a delay in the issuance of a patent on the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

125. Comment: One comment stated that delays in the issuance of a patent can exceed the five-year limit provided for in proposed § 1.701(b). Where the delay was not the fault of the applicant, why should there be this maximum?

Another comment stated that in a biotechnology application, if suspension of the application results in a declared interference, the period of delay calculated under § 1.701(c)(1)(i) will likely consume most of the five-year maximum extension. This renders the value of any time period measured under § 1.701(c)(1)(ii) negligible, thus diminishing the rights of applicant due to the unregulated suspension powers of the PTO.

Response: The five-year limit for patent term extension set forth in § 1.701(b) is required by statute, 35 U.S.C. 154(b).

126. Comment: One comment suggested that § 1.701(c)(1)(i) be amended to state that an application added after an interference is declared is entitled to an extension measured only from the date of redeclaration.

Response: The suggestion has not been adopted. The language in § 1.701(c)(1)(i) is clear that for an application that is added to an interference, that application is entitled to an extension measured from the date of redeclaration of the interference.

127. Comment: One comment stated that § 1.701(c)(1)(ii) does not address the

case where a suspended application is added to the interference without the suspension being lifted.

Response: Section 1.701(c)(1)(ii) is being amended to reference the endpoint for the suspension period to the date of termination of the suspension. Where prosecution of an application is suspended due to interference proceedings not involving the application, the suspension is made pursuant to § 1.103(b). When that application is added to an interference, the suspension pursuant to § 1.103(b) will be automatically lifted. The application is entitled to patent term extension for the period of suspension pursuant to § 1.701(c)(1)(ii) and for the period of interference pursuant to § 1.701(c)(1)(i). Under § 1.701(c)(1)(ii), the period of suspension begins on the date the application is suspended and ends on the date the suspension under § 1.103(b) is terminated, which in this case would be the same date as the date of redeclaration of the interference.

128. Comment: One comment suggested that the phrase ", if any," in § 1.701(c)(1)(i) and (ii) is unnecessary.

Response: The suggestion has not been adopted. However, § 1.701(c)(1)(i) is being amended for clarity by deleting the phrase "if any" after the first occurrence of "interference" and by inserting the same phrase after the phrase "the number of days."

129. Comment: Several comments suggested that the phrase "was declared or redeclared" in § 1.701(c)(1)(i) be changed to—was first declared—.

Response: The suggestion has not been adopted. The language of the rule reads "with respect to each interference in which the application was involved, the number of days in the period beginning on the date the interference was declared or redeclared to involve the application in the interference.* * *" An interference may be declared as A vs. B and later redeclared as A vs. B vs. C. Under the rule, the period of extension would be counted, with respect to applications A and B, from the date the interference was declared to involve the applications A and B. With respect to application C, the period of extension would be counted from the date the interference was redeclared to involve the application C. No ambiguity is seen in the language as originally proposed.

130. Comment: One comment suggested that the use of the phrase "appellate review" in reference to an action under 35 U.S.C. 145 or 146 is incorrect, since an action under 35 U.S.C. 145 or 146 is not considered as an "appellate review" and suggests that § 1.701(a)(3) be amended so that the introductory phrase reads "Appellate review by the Board of Patent Appeals and Interferences or review by a Federal court under 35 U.S.C. 141 or 145,* * *."

Response: The suggestion has not been adopted. The use of the phrase "appellate review" in reference to an action under 35 U.S.C. 145 or 146 is technically incorrect. However, Public Law 103–465 provides for extension of patent term for "delay due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court". The introductory phrase referred to in the comment uses the exact language found in the statute.

131. Comment: One comment suggested that § 1.701(a) be amended to specify whether extensions for appellate delays are available for reissue applications.

Response: The suggestion has not been adopted. Under 35 U.S.C. 251, the term of a reissue patent is "for the unexpired part of the term of the original patent." Therefore, patent term extension for appellate delays is not available for reissue applications.

132. Comment: One comment suggested that § 1.701(d) be deleted.

Response: The suggestion has not been adopted. Section 1.701(d) sets forth the language found in the statute, 35 U.S.C. 154(b)(3) and further provides a standard for determining due diligence.

133. Comment: Several comments suggested that the lack of due diligence set forth in § 1.701(d)(2) be limited to the acts which occurred during the appellate period (after the filing of a Notice of Appeal) and not during prosecution.

Response: The suggestion has been adopted. Section 1.701(d) is being amended accordingly.

134. Comment: One comment suggested that the rules be made clear that a suspension under § 1.103 does not constitute a lack of due diligence under § 1.701(d)(2).

Response: The suggestion has not been adopted. A request for suspension pursuant to § 1.103(a) during the appellate review period will be considered to be *prima facie* evidence of lack of due diligence.

135. Comment: Several comments stated that the rules permit extensions of time and the filing of informal applications. These acts should not constitute lack of due diligence since the proposed rule defined the standard for determining due diligence is whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person. One comment suggested that the Office adopt a gross negligence standard.

Response: The examples of acts that may constitute lack of due diligence set forth in the Notice of Proposed Rulemaking (extensions of time, filing of nonresponsive submissions, and filing of informal applications) are being withdrawn. The suggestion regarding the adoptions of a gross negligence standard has not been adopted. As set forth in § 1.701(d)(2), the standard for determining due diligence is whether applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during the appellate review period.

136. Comment: One comment stated that the PTO list in the rule all circumstances in which an applicant will be considered not to have acted with due diligence.

Another comment suggested that objective criteria for "diligence" be set forth in § 1.701(d)(2).

Response: The suggestion has not been adopted. Whether an action by the applicant constitutes lack of due diligence will be determined by the facts and circumstances of each case. Since lack of due diligence is determined on a case-by-case basis, it would not be possible to list all circumstances in the rule. Examples of acts which will constitute prima facie evidence of lack of due diligence are: (1) abandonment of the application during appellate review; and (2) suspension of action under § 1.103(a) during appellate review.

137. Comment: One comment suggested that guidance be provided in the comments to the Notice of Final Rules identifying in what circumstances is a patent issued "pursuant to an appellate decision reversing an adverse determination of patentability."

Several comments questioned whether the reversal of all rejections on one of several appealed claims would entitle applicant to an extension under § 1.701(a)(3). Two comments suggested that the rule be redrafted to allow appropriate extension of term where the Board or a court reverses at least "in part."

Response: Extension of patent term under § 1.701(a)(3) is applicable if all the rejections of any one claim are ultimately reversed. The rule is clear and no clarification is needed.

138. Comment: One comment stated that § 1.701 does not address the situation where applicant appeals with both allowed and rejected claims. In such case, patent term extension should be available for any claims that were allowed prior to appellate review, if the

allowed claims were in the same application, whether or not the decision of the examiner on the rejected claims is ultimately reversed. Applicant should not have to refile the allowed claims and rejected claims in separate cases in order to take advantage of the patent term extension.

Response: If applicant chooses to keep the allowed claims with the rejected claims in the application on appeal, patent term extension pursuant to 35 U.S.C. 154(b)(2) is only available if a patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If the appellate review is not successful, applicant will not be entitled to patent term extension.

139. Comment: One comment questioned whether the phrase "if the patent is not subject to a terminal disclaimer" in § 1.701(a)(3) is intended to be limited to those applications in which a terminal disclaimer has actually been filed or encompass those applications in which a double patenting rejection has been made and a terminal disclaimer suggested by an examiner.

Response: The calculation of any applicable extension under § 1.701 will be made prior to the mailing of the Notice of Allowance and Issue Fee Due. At that time, any double patenting rejection would have been resolved and a terminal disclaimer would have been filed if one was required.

140. Comment: One comment stated that § 1.701(d)(1) is inconsistent with 35 U.S.C. 154(b)(2) and (b)(3), because the period of extension for appellate review would be calculated under § 1.701(d)(1) by first subtracting the period of appellate review occurring within three years of the filing date before the five-year limit is imposed. It is suggested that § 1.701 be modified to be consistent with 35 U.S.C. 154(b)(2) which requires the five-year limit to be imposed before the subtraction for appellate review occurring within three years of the filing date.

Response: The suggestion has not been adopted. Section 1.701 is not inconsistent with 35 U.S.C. 154(b)(2) and (b)(3). The period of extension referred to in 35 U.S.C. 154(b)(2) is defined in 35 U.S.C. 154(b)(3). Therefore, one must determine the period of extension in 35 U.S.C. 154(b)(3)(A), then reduce that period by the time determined in 35 U.S.C. 154(b)(3)(B) and (b)(3)(C). Then, according to 35 U.S.C. 154(b)(2), the

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resulting time period may not be more than five years.

141. Comment: One comment suggested that the Commissioner identify a senior person who is charged with approving all reductions in extension of patent term rather than leaving the decision to the examiner or the SPE.

One comment questioned who will make the calculation of the period of patent term extension under § 1.701 and whether that calculation can be challenged and by whom.

Response: It is contemplated that the period of patent term extension calculated and any reduction in the extension of patent term will not be made by an examiner. It is noted that the period of patent term extension will be identified in the Notice of Allowance and Issue Fee Due and if applicant disagrees with the period, applicant may request further review by way of a petition under § 1.181. If an error is noted after the patent issues, patentee or any third party may seek correction of the period of patent term extension granted by filing a request for a Certificate of Correction pursuant to § 1.322.

142. Comment: One comment questioned whether a challenge to the period of patent term extension calculated by the PTO under § 1.701 would be required to be made within a fixed period.

Response: No. However, the longer applicant delays filing a petition under § 1.181 challenging the period of extension calculated by the PTO, the less likely any error will be corrected before the patent is issued with the error printed on the patent. If the patent issues with an incorrect period of extension, applicant should file a request for a Certificate of Correction pursuant to § 1.322 instead of a petition under § 1.181.

143. Comment: One comment suggested that § 1.701(d)(2) be amended to require PTO to notify applicant in writing of any intent to reduce the term extension for lack of due diligence, stating the specific basis, and provide applicant with a reasonable opportunity to respond.

Response: The suggestion has not been adopted. The period of patent term extension will be identified in the Notice of Allowance and Issue Fee Due and if applicant disagrees with the period, applicant may request further review by way of a petition under § 1.181.

144. Comment: One comment suggested that a cover sheet for use in recording assignments be included in the final rules package as an addendum.

Response: The suggestion has not been adopted. A sample cover sheet for use in recording assignments was published as Appendix B in the **Federal Register** on July 6, 1992, at 57 FR 29634 and in the Official Gazette on July 28, 1992, at 1140 Off. Gaz. Pat. Office 63 and may be obtained from Assignment Branch.

Other Considerations

This final rule change is in conformity with the requirements of the Regulatory Flexibility Act, 5 U.S.C. 601 et seq., Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 et seq. This final rule has been determined not to be significant for the purposes of E.O. 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these final rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impact of these changes is to provide a procedure for domestic applicants to quickly and inexpensively file a provisional application. The filing date of the provisional application will not be used to measure the term of a patent granted on an application which claims the earlier filing date of the provisional application.

The Patent and Trademark Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in E.O. 12612.

These final rules contain collections of information subject to the requirements of the Paperwork Reduction Act (Act). The provisional application has been approved by the Office of Management and Budget under control numbers 0651–0031 and 0651–0032. The cover sheet is approved under OMB control number 0651–0037. The cover sheet is necessary to expedite the processing of a provisional application and improve quality. Public reporting burden for the collection of information on the cover sheet is estimated to average 12 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing the burden to the Office of Assistance Quality and

Enhancement Division, Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, D.C. 20503 (ATTN: Paperwork Reduction Act Projects 0651–0031, 0651–0032, and 0651–0037).

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small businesses.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

For the reasons set forth in the preamble, 37 CFR Parts 1 and 3 are amended as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR Part 1 continues to read as follows:

Authority: 35 U.S.C. 6 unless otherwise noted.

2. Section 1.1 is amended by adding new paragraph (i) to read as follows:

§ 1.1 All communications to be addressed to Commissioner of Patents and Trademarks.

* * * * *

(i) The filing of all provisional applications and any communications relating thereto should be additionally marked "Box Provisional Patent Application."

* * * * *

3. Section 1.9 is amended by revising paragraph (a) to read as follows:

§ 1.9 Definitions.

(a)(1) A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

* * * * *

4. Section 1.12 is amended by revising paragraph (c) to read as follows:

§ 1.12 Assignment records open to public inspection.

* * * * *

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in secrecy under § 1.14, or any information with respect thereto, must

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

* * * * *

5. Section 1.14 is amended by revising paragraph (e) to read as follows:

§ 1.14 Patent applications preserved in secrecy.

* * * * *

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in secrecy pursuant to paragraphs (a) and (b) of this section, or any papers relating thereto, must

(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i), or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

* * * * *

6. Section 1.16 is amended by revising paragraphs (a) through (g) and by adding new paragraphs (k) and (l) to read as follows:

§ 1.16 National application filing fees.

(a) Basic fee for filing each application for an original patent, except provisional, design or plant applications:

By a small entity (§ 1.9(f)).....$365.00
By other than a small entity 730.00

(b) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each independent claim in excess of 3:

By a small entity (§ 1.9(f)).....38.00
By other than a small entity 76.00

(c) In addition to the basic filing fee in an original application, except provisional applications, for filing or later presentation of each claim (whether independent or dependent) in excess of 20 (Note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes.):

By a small entity (§ 1.9(f)).....11.00
By other than a small entity 22.00

(d) In addition to the basic filing fee in an original application, except provisional applications, if the application contains, or is amended to contain, a multiple dependent claim(s), per application:

By a small entity (§ 1.9(f)).....120.00
By other than a small entity 240.00

(If the additional fees required by paragraphs (b), (c), and (d) of this section are not paid on filing or on later presentation of the claims for which the additional fees are due, they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the Office in any notice of fee deficiency.)

(e) Surcharge for filing the basic filing fee or oath or declaration on a date later than the filing date of the application, except provisional applications:

By a small entity (§ 1.9(f)).....65.00
By other than a small entity 130.00

(f) Basic fee for filing each design application:

By a small entity (§ 1.9(f)).....150.00
By other than a small entity 300.00

(g) Basic fee for filing each plant application, except provisional applications:

By a small entity (§ 1.9(f)).....245.00
By other than a small entity.....490.00

* * * * *

(k) Basic fee for filing each provisional application:

By a small entity (§ 1.9(f)).....75.00
By other than a small entity 150.00

(l) Surcharge for filing the basic filing fee or cover sheet (§ 1.51(a)(2)(i)) on a date later than the filing date of the provisional application:

By a small entity (§ 1.9(f)).....25.00
By other than a small entity.....50.00

* * * * *

7. Section 1.17 is amended by revising paragraphs (h) and (i), and by adding new paragraphs (q), (r) and (s) to read as follows:

§ 1.17 Patent application processing fees.

* * * * *

(h) For filing a petition to the Commissioner under a section listed below which refers to this paragraph 130.00

§ 1.47—for filing by other than all the inventors or a person not the inventor

§ 1.48—for correction of inventorship, except in provisional applications
§ 1.84—for accepting color drawings or photographs
§ 1.182—for decision on questions not specifically provided for
§ 1.183—to suspend the rules
§ 1.295—for review of refusal to publish a statutory invention registration
§ 1.377—for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent
§ 1.378(e)—for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in expired patent
§ 1.644(e)—for petition in an interference
§ 1.644(f)—for request for reconsideration of a decision on petition in an interference
§ 1.666(c)—for late filing of interference settlement agreement
§§ 5.12, 5.13 and 5.14—for expedited handling of a foreign filing license
§ 5.15—for changing the scope of a license
§ 5.25—for retroactive license

(i) For filing a petition to the Commissioner under a section listed below which refers to this paragraph 130.00

§ 1.12—for access to an assignment record
§ 1.14—for access to an application
§ 1.53—to accord a filing date, except in provisional applications
§ 1.55—for entry of late priority papers
§ 1.60—to accord a filing date
§ 1.62—to accord a filing date
§ 1.97(d)—to consider an information disclosure statement
§ 1.102—to make application special
§ 1.103—to suspend action in application
§ 1.177—for divisional reissues to issue separately
§ 1.312—for amendment after payment of issue fee
§ 1.313—to withdraw an application from issue
§ 1.314—to defer issuance of a patent
§ 1.666(b)—for access to interference settlement agreement
§ 3.81—for patent to issue to assignee, assignment submitted after payment of the issue fee

(q) For filing a petition to the Commissioner under a section listed below which refers to this paragraph 50.00

§ 1.48—for correction of inventorship in a provisional application
§ 1.53—to accord a provisional application a filing date or to convert an application filed under 20222 § 1.53(b)(1) to a provisional application

(r) For entry of a submission after final rejection under § 1.129(a):

By a small entity (§ 1.9(f)).....365.00
By other than a small entity 730.00

(s) For each additional invention requested to be examined under § 1.129(b):

By a small entity (§ 1.9(f)).....365.00
By other than a small entity 730.00

8. Section 1.21 is amended by revising paragraph (l) to read as follows:

§ 1.21 Miscellaneous fees and charges.

* * * * *

(l) For processing and retaining any application abandoned pursuant to § 1.53(d)(1) unless the required basic filing fee has been paid.....$130.00

* * * * *

9. Section 1.28 is amended by revising paragraph (a) to read as follows:

§ 1.28 Effect on fees of failure to establish status, or change status, as a small entity.

(a) The failure to establish status as a small entity (§§ 1.9(f) and 1.27 of this part) in any application or patent prior to paying, or at the time of paying, any fee precludes payment of the fee in the amount established for small entities. A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within two months of the date of payment of, the fee. Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application may rely on a verified statement filed in the prior application if the nonprovisional application includes a reference to the verified statement in the prior application or includes a copy of the verified statement in the prior application and status as a small entity is still proper and desired. Once status as a small entity has been established in an application or patent, the status remains in the application or patent without the filing of a further verified statement pursuant to § 1.27 of this part unless the Office is notified of a change in status.

* * * * *

10. Section 1.45 paragraph (c) is revised to read as follows:

§ 1.45 Joint inventors.

* * * * *

(c) If multiple inventors are named in a nonprovisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter of at least one claim of the application and the application will be considered to be a joint application under 35 U.S.C. 116. If multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application and the provisional application will be considered to be a joint application under 35 U.S.C. 116.

11. Section 1.48 is revised to read as follows:

§ 1.48 Correction of inventorship.

(a) If the correct inventor or inventors are not named in a nonprovisional application through error without any deceptive intention on the part of the actual inventor or inventors, the application may be amended to name only the actual inventor or inventors. Such amendment must be diligently made and must be accompanied by:

(1) A petition including a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred;

(2) An oath or declaration by each actual inventor or inventors as required by § 1.63;

(3) The fee set forth in § 1.17(h); and

(4) The written consent of any assignee. When the application is involved in an interference, the petition shall comply with the requirements of this section and shall be accompanied by a motion under § 1.634.

(b) If the correct inventors are named in the nonprovisional application when filed and the prosecution of the application results in the amendment or cancellation of claims so that less than all of the originally named inventors are the actual inventors of the invention being claimed in the application, an amendment shall be filed deleting the names of the person or persons who are

not inventors of the invention being claimed. The amendment must be diligently made and shall be accompanied by:

(1) A petition including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and

(2) The fee set forth in § 1.17(h).

(c) If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended pursuant to paragraph (a) of this section to add claims to the subject matter and name the correct inventors for the application.

(d) If the name or names of an inventor or inventors were omitted in a provisional application through error without any deceptive intention on the part of the actual inventor or inventors, the provisional application may be amended to add the name or names of the actual inventor or inventors. Such amendment must be accompanied by:

(1) A petition including a statement that the error occurred without deceptive intention on the part of the actual inventor or inventors, which statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office; and

(2) The fee set forth in § 1.17(q).

(e) If a person or persons were named as an inventor or inventors in a provisional application through error without any deceptive intention, an amendment may be filed in the provisional application deleting the name or names of the person or persons who were erroneously named. Such amendment must be accompanied by:

(1) A petition including a statement of facts verified by the person or persons whose name or names are being deleted establishing that the error occurred without deceptive intention;

(2) The fee set forth in § 1.17(q); and

(3) The written consent of any assignee.

12. Section 1.51 is amended by revising paragraphs (a) and (b) to read as follows:

§ 1.51 General requisites of an application.

(a) Applications for patents must be made to the Commissioner of Patents and Trademarks.

(1) A complete application filed under § 1.53(b)(1) comprises:

(i) A specification, including a claim or claims, see §§ 1.71 to 1.77;

(ii) An oath or declaration, see §§ 1.63 and 1.68;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

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(iv) The prescribed filing fee, see § 1.16.

(2) A complete provisional application filed under § 1.53(b)(2) comprises:

(i) A cover sheet identifying:

(A) The application as a provisional application,

(B) The name or names of the inventor or inventors, (see § 1.41),

(C) The residence of each named inventor,

(D) The title of the invention,

(E) The name and registration number of the attorney or agent (if applicable),

(F) The docket number used by the person filing the application to identify the application (if applicable),

(G) The correspondence address, and

(H) The name of the U.S. Government agency and Government contract number (if the invention was made by an agency of the U.S. Government or under a contract with an agency of the U.S. Government);

(ii) A specification as prescribed by 35 U.S.C. 112, first paragraph, see § 1.71;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

(iv) The prescribed filing fee, see § 1.16.

(b) Applicants are encouraged to file an information disclosure statement in nonprovisional applications. See §§ 1.97 and 1.98. No information disclosure statement may be filed in a provisional application.

* * * * *

13. Section 1.53 heading and paragraphs (a) through (e) are revised to read as follows:

§ 1.53 Application number, filing date, and completion of application.

(a) Any application for a patent received in the Patent and Trademark Office will be assigned an application number for identification purposes.

(b)(1) The filing date of an application for patent filed under this section, except for a provisional application, is the date on which: a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed under this section, § 1.60 or § 1.62. A continuation-in-part application may be filed under this section or § 1.62.

(2) The filing date of a provisional application is the date on which: a specification as prescribed by 35 U.S.C. 112, first paragraph; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No amendment, other than to make the provisional application comply with all applicable regulations, may be made to the provisional application after the filing date of the provisional application. If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the provisional application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(q) is filed which sets forth the reasons the delay in supplying the names should be excused.

(i) A provisional application must also include a cover sheet identifying the application as a provisional application. Otherwise, the application will be treated as an application filed under § 1.53(b)(1).

(ii) An application for patent filed under § 1.53(b)(1) may be treated as a provisional application and be accorded the original filing date provided that a petition requesting the conversion, with the fee set forth in § 1.17(q), is filed prior to the earlier of the abandonment of the § 1.53(b)(1) application, the payment of the issue fee, the expiration of 12 months after the filing date of the § 1.53(b)(1) application, or the filing of a request for a statutory invention registration under § 1.293. The grant of any such petition will not entitle applicant to a refund of the fees which were properly paid in the application filed under § 1.53(b)(1).

(iii) A provisional application shall not be entitled to the right of priority under § 1.55 or 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date under § 1.78 or 35 U.S.C. 120, 121 or 365(c) of any other application. No claim for priority under § 1.78(a)(3) may be made in a design application based on a provisional application. No request under § 1.293 for a statutory invention registration may be filed in a provisional application. The requirements of §§ 1.821 through 1.825 regarding application disclosures containing nucleotide and/or amino acid sequences

are not mandatory for provisional applications.

(c) If any application is filed without the specification, drawing or name, or names, of the actual inventor or inventors required by paragraph (b)(1) or (b)(2) of this section, applicant will be so notified and given a time period within which to submit the omitted specification, drawing, name, or names, of the actual inventor, or inventors, in order to obtain a filing date as of the date of filing of such submission. A copy of the "Notice of Incomplete Application" form notifying the applicant should accompany any response thereto submitted to the Office. If the omission is not corrected within the time period set, the application will be returned or otherwise disposed of; the fee, if submitted, will be refunded less the handling fee set forth in § 1.21(n). Any request for review of a refusal to accord an application a filing date must be by way of a petition accompanied by the fee set forth in § 1.17(i), if the application was filed under § 1.53(b)(1), or by the fee set forth in § 1.17(q), if the application was filed under § 1.53(b)(2).

(d)(1) If an application which has been accorded a filing date pursuant to paragraph (b)(1) of this section does not include the appropriate filing fee or an oath or declaration by the applicant, applicant will be so notified, if a correspondence address has been provided and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one

year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application.

(2) If a provisional application which has been accorded a filing date pursuant to paragraph (b)(2) of this section does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which the required basic filing fee has not been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, cover sheet and to pay the surcharge as set forth in § 1.16(l) in order to prevent abandonment of the application.

(e)(1) An application for a patent filed under paragraph (b)(1) of this section will not be placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities may be waived subject to subsequent correction whenever required.

(2) A provisional application for a patent filed under paragraph (b)(2) of this section will not be placed upon the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

* * * * *

14. Section 1.55 is revised to read as follows:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a)–(d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in § 1.17(i). If the certified copy filed is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

15. Section 1.59 is revised to read as follows:

§ 1.59 Papers of application with filing date not to be returned.

Papers in an application which has received a filing date pursuant to § 1.53 will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost of any application in which either the required basic filing fee (§ 1.16) or, if the application was filed under § 1.53(b)(1), the processing and retention fee (§ 1.21(l)) has been paid.

See § 1.618 for return of unauthorized and improper papers in interferences.

16. Section 1.60 is amended by revising the heading and paragraph (b) to read as follows:

§ 1.60 Continuation or divisional application for invention disclosed in a prior nonprovisional application.

* * * * *

(b) An applicant may omit signing of the oath or declaration in a continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) if:

(1) The prior application was a nonprovisional application and a complete application as set forth in § 1.51(a)(1);

(2) Applicant indicates that the application is being filed pursuant to this section and files a true copy of the prior complete application as filed including the specification (with claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application;

(3) The inventors named in the continuation or divisional application are the same or less than all the inventors named in the prior application; and

(4) The application is filed before the patenting, or abandonment of, or termination of proceedings on the prior application. The copy of the prior application must be accompanied by a statement that the application papers filed are a true copy of the prior complete application. Such statement must be by the applicant or applicant's attorney or agent and must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting the filing date. If the continuation or divisional application is filed by less than all the inventors named in the prior application, a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation or divisional application. Except as provided in paragraph (d) of this section, if a true copy of the prior application as filed is not filed with the application or if the statement that the application papers are a true copy is omitted, the application will not be given a filing date earlier than the date upon which the copy and statement are

filed, unless a petition with the fee set forth in § 1.17(i) is filed which satisfactorily explains the delay in filing these items.

* * * * *

17. Section 1.62 is amended by revising paragraphs (a) and (e) to read as follows:

§ 1.62 File wrapper continuing procedure.

(a) A continuation, continuation-in-part, or divisional application, which uses the specification, drawings and oath or declaration from a prior nonprovisional application which is complete as defined by § 1.51(a)(1), and which is to be abandoned, may be filed under this section before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application, or after payment of the issue fee if a petition under § 1.313(b)(5) is granted in the prior application. The filing date of an application filed under this section is the date on which a request is filed for an application under this section including identification of the application number and the names of the inventors named in the prior complete application. If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement must accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application.

* * * * *

(e) An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application number. Changes to the prior application must be made in the form of an amendment to the prior application as it exists at the time of filing the application under this section. No copy of the prior application or new specification is required. The filing of such a copy or specification will be considered improper, and a filing date as of the date of deposit of the request for an application under this section will not be granted to the application unless a petition with the fee set forth in § 1.17(i) is filed with instructions to cancel the copy or specification.

* * * * *

18. Section 1.63 is amended by revising paragraph (a) to read as follows:

§ 1.63 Oath or declaration.

(a) An oath or declaration filed under § 1.51(a)(1)(ii) as a part of a nonprovisional application must:

(1) Be executed in accordance with either § 1.66 or § 1.68;

(2) Identify the specification to which it is directed;

(3) Identify each inventor and the residence and country of citizenship of each inventor; and

(4) State whether the inventor is a sole or joint inventor of the invention claimed.

* * * * *

19. Section 1.67 is amended by revising paragraph (b) to read as follows:

§ 1.67 Supplemental oath or declaration.

* * * * *

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(d)(1) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper cases, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

* * * * *

20. Section 1.78 is amended by revising paragraphs (a)(1) and (a)(2) and by adding new paragraphs (a)(3) and (a)(4) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

(i) Complete as set forth in § 1.51(a)(1); or

(ii) Entitled to a filing date as set forth in § 1.53(b)(1), § 1.60 or § 1.62 and include the basic filing fee set forth in § 1.16; or

(iii) Entitled to a filing date as set forth in § 1.53(b)(1) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(d)(1).

(2) Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate. (See § 1.14(b)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday. In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be:

(i) Complete as set forth in § 1.51(a)(2); or

(ii) Entitled to a filing date as set forth in § 1.53(b)(2) and include the basic filing fee set forth in § 1.16(k).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the

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provisional application number (consisting of series code and serial number).

* * * * *

21. Section 1.83 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.83 Content of drawing.

(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).

* * * * *

(c) Where the drawings in a nonprovisional application do not comply with the requirements of paragraphs (a) and (b) of this section, the examiner shall require such additional illustration within a time period of not less than two months from the date of the sending of a notice thereof. Such corrections are subject to the requirements of § 1.81(d).

22. Section 1.97 is amended by revising paragraph (d) to read as follows:

§ 1.97 Filing of information disclosure statement.

* * * * *

(d) An information disclosure statement shall be considered by the Office if filed after the mailing date of either a final action under § 1.113 or a notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

(1) A certification as specified in paragraph (e) of this section;

(2) A petition requesting consideration of the information disclosure statement; and

(3) The petition fee set forth in § 1.17(i).

* * * * *

23. Section 1.101 is amended by revising paragraph (a) to read as follows:

§ 1.101 Order of examination.

(a) Nonprovisional applications filed in the Patent and Trademark Office and accepted as complete applications are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Nonprovisional applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which examination has been advanced pursuant to § 1.102. See § 1.496 for order of examination of international applications in the national stage.

* * * * *

24. Section 1.102 is amended by revising paragraph (d) to read as follows:

§ 1.102 Advancement of examination.

* * * * *

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the petition fee set forth in § 1.17(i).

25. Section 1.103 is amended by revising paragraph (a) to read as follows:

§ 1.103 Suspension of action.

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(i). Action will not be suspended when a response by the applicant to an Office action is required.

* * * * *

26. A new, undesignated center heading and new section 1.129 are added to Subpart B—National Processing Provisions to read as follows:

Transitional Provisions

§ 1.129 Transitional procedures for limited examination after final rejection and restriction practice.

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in

§ 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

(b)(1) In an application, other than for reissue or a design patent, that has been pending for at least three years as of June 8, 1995; taking into account any reference made in the application to any earlier filed application under 35 U.S.C. 120, 121, and 365(c), no requirement for restriction or for the filing of divisional applications shall be made or maintained in the application after June 8, 1995, except where:

(i) The requirement was first made in the application or any earlier filed application under 35 U.S.C. 120, 121 and 365(c) prior to April 8, 1995;

(ii) The examiner has not made a requirement for restriction in the present or parent application prior to April 8, 1995, due to actions by the applicant; or

(iii) The required fee for examination of each additional invention was not paid.

(2) If the application contains more than one independent and distinct invention and a requirement for restriction or for the filing of divisional applications cannot be made or maintained pursuant to this paragraph, applicant will be so notified and given a time period to:

(i) Elect the invention or inventions to be searched and examined, if no election has been made prior to the notice, and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects;

(ii) Confirm an election made prior to the notice and pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in addition to the one invention which applicant previously elected; or

(iii) File a petition under this section traversing the requirement. If the required petition is filed in a timely manner, the original time period for

electing and paying the fee set forth in § 1.17(s) will be deferred and any decision on the petition affirming or modifying the requirement will set a new time period to elect the invention or inventions to be searched and examined and to pay the fee set forth in § 1.17(s) for each independent and distinct invention claimed in the application in excess of one which applicant elects.

(3) The additional inventions for which the required fee has not been paid will be withdrawn from consideration under § 1.142(b). An applicant who desires examination of an invention so withdrawn from consideration can file a divisional application under 35 U.S.C. 121.

(c) The provisions of this section shall not be applicable to any application filed after June 8, 1995.

27. Section 1.137 is amended by revising paragraph (c) to read as follows:

§ 1.137 Revival of abandoned application.

* * * * *

(c) In all applications filed before June 8, 1995, and in all design applications filed on or after June 8, 1995, any petition pursuant to paragraph (a) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

* * * * *

28. Section 1.139 is added to read as follows:

§ 1.139 Revival of provisional application.

(a) A provisional application which has been accorded a filing date and abandoned for failure to timely respond to an Office requirement may be revived so as to be pending for a period of no longer than twelve months from its filing date if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. Under no circumstances will the provisional application be pending after twelve months from its filing date. A petition to revive an abandoned provisional application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be accompanied by:

(1) The required response unless it has been previously filed;

(2) The petition fee as set forth in § 1.17(l); and

(3) A showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(b) A provisional application which has been accorded a filing date and abandoned for failure to timely respond to an Office requirement may be revived so as to be pending for a period of no longer than twelve months from its filing date if the delay was unintentional. Under no circumstances will the provisional application be pending after twelve months from its filing date. A petition to revive an abandoned provisional application must be:

(1) Accompanied by the required response unless it has been previously filed;

(2) Accompanied by the petition fee as set forth in § 1.17(m);

(3) Accompanied by a statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Filed either:

(i) Within one year of the date on which the provisional application became abandoned; or

(ii) Within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the provisional application became abandoned.

(c) Any request for reconsideration or review of a decision refusing to revive a provisional application upon petition filed pursuant to paragraphs (a) or (b) of this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision.

(d) The time periods set forth in this section cannot be extended, except that the three-month period set forth in paragraph (b)(4)(ii) of this section and the time period set forth in paragraph (c) of this section may be extended under the provisions of § 1.136.

29. Section 1.177 is revised to read as follows:

§ 1.177 Reissue in divisions.

The Commissioner may, in his or her discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each

division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of §§ 1.83 and 1.84. On filing divisional reissue applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner upon petition and payment of the fee set forth in § 1.17(i), all the divisions of a reissue will issue simultaneously; if there is any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner orders otherwise.

30. Section 1.312 is amended by revising paragraph (b) to read as follows:

§ 1.312 Amendments after allowance.

* * * * *

(b) Any amendment pursuant to paragraph (a) of this section filed after the date the issue fee is paid must be accompanied by a petition including the fee set forth in § 1.17(i) and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

31. Section 1.313 is amended by revising paragraph (a) to read as follows:

§ 1.313 Withdrawal from issue.

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. Any such petition by the applicant must include a showing of good and sufficient reasons why withdrawal of the application is necessary and, if the reason for the withdrawal is not the fault of the Office, must be accompanied by the fee set forth in § 1.17(i). If the application is withdrawn from issue, a new notice of allowance will be sent if the application is again allowed. Any amendment accompanying a petition to withdraw an application from issue must comply with the requirements of § 1.312.

* * * * *

32. Section 1.314 is revised to read as follows:

§ 1.314 Issuance of patent.

If payment of the issue fee is timely made, the patent will issue in regular course unless the application is withdrawn from issue (§ 1.313), or issuance of the patent is deferred. Any petition by the applicant requesting a deferral of the issuance of a patent must be accompanied by the fee set forth in § 1.17(i) and must include a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

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33. Section 1.316 is amended by revising paragraph (d) to read as follows:

§ 1.316 Application abandoned for failure to pay issue fee.

* * * * *

(d) In all applications filed before June 8, 1995, any petition pursuant to paragraph (b) of this section not filed within six months of the date of abandonment of the application, must be accompanied by a terminal disclaimer with fee under § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. The terminal disclaimer must also apply to any patent granted on any continuing application entitled under 35 U.S.C. 120 to the benefit of the filing date of the application for which revival is sought.

* * * * *

34. Section 1.317 is amended by removing and reserving paragraph (d).

§ 1.317 [Amended]

35. Section 1.666 is amended by revising paragraph (b) to read as follows:

§ 1.666 Filing of interference settlement agreements.

* * * * *

(b) If any party filing the agreement or understanding under paragraph (a) of this section so requests, the copy will be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person upon petition accompanied by the fee set forth in § 1.17(i) and on a showing of good cause.

* * * * *

36. Section 1.701 is added to Subpart F to read as follows:

§ 1.701 Extension of patent term due to prosecution delay.

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent

Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

PART 3—ASSIGNMENT, RECORDING, AND RIGHTS OF ASSIGNEE

37. The authority citation for 37 CFR Part 3 continues to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6.

38. Section 3.21 is revised to read as follows:

§ 3.21 Identification of patents and patent applications.

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the serial number, e.g., 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international number (e.g., PCT/US90/01234). If an assignment of a patent application filed under § 1.53(b)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

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39. Section 3.81 is amended by revising paragraph (b) to read as follows:

§ 3.81 Issue of patent to assignee.

* * * * * * *

(b) If the assignment is submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent, the assignee may petition that the patent issue to the assignee. Any such petition must be accompanied by the fee set forth in § 1.17(i) of this chapter.

Dated: April 14, 1995.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

Note—The following appendix will not appear in the Code of Federal Regulations.

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Appendix

Appendix A

PTO/SB/16 (6-95)
Approved for use through 04/11/98. OMB 0651-0037
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PROVISIONAL APPLICATION COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION under 37 CFR 1.53 (b)(2).

Docket Number		Type a plus sign (+) inside this box ->	

INVENTOR(s)/APPLICANT(s)

LAST NAME	FIRST NAME	MIDDLE INITIAL	RESIDENCE (CITY AND EITHER STATE OR FOREIGN COUNTRY)

TITLE OF THE INVENTION (280 characters max)

CORRESPONDENCE ADDRESS

STATE		ZIP CODE		COUNTRY	

ENCLOSED APPLICATION PARTS *(check all that apply)*

- ☐ Specification — *Number of Pages*
- ☐ Drawing(s) — *Number of Sheets*
- ☐ Small Entity Statement
- ☐ Other (specify)

METHOD OF PAYMENT *(check one)*

- ☐ A check or money order is enclosed to cover the Provisional filing fees
- ☐ The Commissioner is hereby authorized to charge filing fees and credit Deposit Account Number:

PROVISIONAL FILING FEE AMOUNT ($)

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

- ☐ No.
- ☐ Yes, the name of the U.S. Government agency and the Government contract number are: _____

Respectfully submitted,

SIGNATURE _____ Date / -/

TYPED or PRINTED NAME _____ REGISTRATION NO. *(if appropriate)*

☐ Additional inventors are being named on separately numbered sheets attached hereto

PROVISIONAL APPLICATION FILING ONLY

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0037), Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231

Appendix B

20231

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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

DECLARATION FOR PATENT APPLICATION

Docket Number (Optional)

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled _____, the specification of which

is attached hereto unless the following box is checked:

☐ was filed on _____ as United States Application Number or PCT International Application Number _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)			Priority Claimed
(Number)	(Country)	(Day/Month/Year Filed)	☐ Yes ☐ No
(Number)	(Country)	(Day/Month/Year Filed)	☐ Yes ☐ No

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

(Application Number)	(Filing Date)
(Application Number)	(Filing Date)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

(Application Number)	(Filing Date)	(Status -- patented, pending, abandoned)
(Application Number)	(Filing Date)	(Status -- patented, pending, abandoned)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Address all telephone calls to _____ at telephone number _____

Address all correspondence to _____

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor (given name, family name) _____

Inventor's signature _____ Date _____

Residence _____ Citizenship _____

Post Office Address _____

Full name of second joint inventor, if any (given name, family name) _____

Second Inventor's signature _____ Date _____

Residence _____ Citizenship _____

Post Office Address _____

☐ Additional inventors are being named on separately numbered sheets attached hereto.

Burden Hour Statement: This form is estimated to take 4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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