

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(1) 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