

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 The proposal to delete the retention fee practice set forth in § 1.53(d) is being withdrawn.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