

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 In view of the comments received and the language adopted in the final rules, those examples are withdrawn.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