

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