

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