

a "national application" could be defined in § 1.9 to exclude a provisional application.

*Response:* The suggestion has not been adopted. Section 1.9(a), prior to this rulemaking, defined a national application to include any application filed under 35 U.S.C. 111. A provisional application is an application filed under 35 U.S.C. 111. It is appropriate to define a provisional application as a special type of national application.

29. *Comment:* One comment requested an explanation of the showing required in a petition under §§ 1.12 and 1.14 for access to pending applications and to assignment records for pending applications.

*Response:* There was no substantive change proposed to either § 1.12 or 1.14 in the Notice of Proposed Rulemaking. Thus, the showing required in a petition under § 1.12 or 1.14 remains the same after this final rulemaking as before. A discussion of such a petition can be found in section 103 of the MPEP.

30. *Comment:* Several comments objected to the definition in § 1.45(c) of joint inventors in provisional applications as being those having made a contribution to "the subject matter disclosed" in the provisional application. Various language, such as, "the subject matter which constitutes the invention," "subject matter disclosed and regarded to be the invention," "disclosed invention," "the inventive subject matter disclosed" was suggested. Another comment requested guidance as to the determination of inventorship in a provisional application.

*Response:* The suggestion has not been adopted. The term "invention" is typically used to refer to subject matter which applicant is claiming in his/her application. Since claims are not required in a provisional application, it would not be appropriate to reference joint inventors as those who have made a contribution to the "invention" disclosed in the provisional application. If the "invention" has not been determined in the provisional application because no claims have been presented, then the name(s) of those person(s) who have made a contribution to the subject matter disclosed in the provisional application should be submitted. Section 1.45(c) states that "if multiple inventors are named in a provisional application, each named inventor must have made a contribution, individually or jointly, to the subject matter disclosed in the provisional application." All that § 1.45(c) requires is that if someone is named as an inventor, that person must have made a contribution to the subject

matter disclosed in the provisional application. When applicant has determined what the invention is by the filing of the 35 U.S.C. 111(a) application, that is the time when the correct inventors must be named. The 35 U.S.C. 111(a) application must have an inventor in common with the provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the provisional application under 35 U.S.C. 119(e).

31. *Comment:* Several comments suggested that it might be desirable to correct inventorship in a provisional application where an individual was erroneously named as an inventor and that the procedure for doing so should be set forth in § 1.48.

*Response:* Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed application under 35 U.S.C. 111(a) may claim priority benefits based on a copending provisional application so long as the applications have at least one inventor in common. An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application to serve as a basis for a priority claim under 35 U.S.C. 119(e). However, in response to the comments, § 1.48 is being amended to include a new paragraph (e) which sets forth the requirements for deleting the names of the inventors incorrectly named as joint inventors in a provisional application, namely, a petition including a verified statement by the inventor(s) whose name(s) are being deleted stating that the error arose without deceptive intent, the fee set forth in § 1.17(q) and the written consent of all assignees.

32. *Comment:* One comment suggested that in order to make the procedures for provisional applications as simple as possible, there is no need to provide any rules to add inventor(s) or change inventorship in a provisional application since the whole concept of inventorship is meaningless without a claim. Error in inventorship can be corrected by the filing of and 35 U.S.C. 111(a) application within 12 months after the filing of a provisional application.

*Response:* The suggestion has not been adopted. One of the requirements of 35 U.S.C. 119(e) is that a 35 U.S.C. 111(a) application must have at least one inventor in common with a provisional application in order for the 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing

date of the provisional application. In situations where there is no inventor in common between the 35 U.S.C. 111(a) application and the provisional application due to error in naming the inventors in the provisional application, procedures must be established to permit applicant to correct the inventorship in the provisional application.

33. *Comment:* One comment suggested that an individual who is the inventor of subject matter disclosed in a provisional application, but who is not named as an inventor in the provisional application because that subject matter was not intended to be claimed in a later filed 35 U.S.C. 111(a) application, could be added as an inventor pursuant to § 1.48(d) in the provisional application if the subject matter was claimed in 35 U.S.C. 111(a) application.

*Response:* The individual could be added as an inventor pursuant to § 1.48(d) in the provisional application so long as the individual was originally omitted without deceptive intent.

34. *Comment:* One comment questioned whether it would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d) that the error occurred without deceptive intention on the part of the inventors.

*Response:* It would be proper for a registered practitioner who did not file the provisional application to sign the statement required by § 1.48(d), if the registered practitioner has a reasonable basis to believe the truth of the statement being signed.

35. *Comment:* One comment suggested that there should be no diligence requirement to correct inventorship in a provisional application.

*Response:* Diligence is not a requirement to correct inventorship in a provisional application in either § 1.48(d) or 1.48(e).

36. *Comment:* One comment suggested that § 1.48(a) be amended by deleting the requirements for "a statement of facts verified by the original named inventor or inventors establishing when the error without deceptive intention was discovered and how it occurred" and for the written consent of any assignee.

*Response:* The suggestion has not been adopted. There was no substantive change proposed to § 1.48(a) in the Notice of Proposed Rulemaking. Since the correction of inventorship affects ownership rights, the existing rules are designed to provide assurances that all parties including the original named inventors and all assignees agree to the change of inventorship. If the