

application omitted drawings, has pages missing, or is otherwise incomplete, then applicant may not be able to rely on the filing date of the provisional application in a subsequently filed 35 U.S.C. 111(a) application. It should not be the job of the Application Branch to review compliance with § 1.81(a).

*Response:* Section 111(b) of title 35, United States Code, states that a provisional application must include a specification as prescribed by 35 U.S.C. 112, first paragraph and a drawing as prescribed by 35 U.S.C. 113. Drawings are required pursuant to 35 U.S.C. 113 if they are necessary to understand the subject matter sought to be patented. If a provisional application as filed omitted drawings and/or has pages missing, the provisional application is prima facie incomplete and no filing date will be granted. Application Branch currently reviews all applications to make sure that no filing date will be granted to an application that is prima facie incomplete. Application Branch will perform the same type of review with provisional applications. If a filing date is not granted to a provisional application because it is prima facie incomplete, applicant may petition the PTO under § 1.182 to grant a filing date to the provisional application as of the date of deposit of the application papers if it can be shown that the omitted items are not necessary for the understanding of the subject matter.

*47. Comment:* One comment objected to the requirement in § 1.53(b)(2)(i) for a cover sheet identifying the application as a provisional application because it is unnecessarily rigid and contrary to Congress' desire to keep the filing of provisional application as simple as possible.

*Response:* The requirement that a provisional application be specifically identified on filing as a provisional application is not seen to be burdensome on the applicant and is necessary for the PTO to properly process the papers as a provisional application. All an applicant is required to do in order to comply with the requirement of § 1.53(b)(2)(i) is to include a transmittal sheet identifying the papers being filed as a PROVISIONAL application.

*48. Comment:* Several comments suggested that in § 1.53(b)(2)(ii), as proposed, the phrase "the expiration of 12 months after the filing date of the provisional application" should read "the expiration of 12 months after the filing date of the § 1.53(b)(1) application".

*Response:* The suggestion has been adopted.

*49. Comment:* One comment objected to the requirement in § 1.53(b)(2)(ii) for a petition to convert an application filed under § 1.53(b)(1) to a provisional application and suggested that any confusion concerning applicant's intention could be handled informally without a petition or petition fee.

*Response:* The requirement for a petition and fee is intended to ensure that the cost of any PTO reprocessing is borne specifically by the applicant requesting the action.

*50. Comment:* Several comments suggested that the filing fee required in an application filed under 35 U.S.C. 111(a) claiming benefit of the filing date of an earlier 35 U.S.C. 111(a) application which has been converted to a provisional application under proposed § 1.53(b)(2)(ii) be reduced, since the \$730/\$365 filing fee was paid in the earlier application.

*Response:* The suggestion has not been adopted. The filing fee required in an application filed under 35 U.S.C. 111(a) is set by statute. The statute does not provide for the suggested reduction in the filing fee.

*51. Comment:* One comment suggested that the proposed § 1.53(b)(2)(iii) should apply retroactively to permit applications filed between June 9, 1994, and June 8, 1995, to be converted to provisional applications.

*Response:* The suggestion has not been adopted. The statute does not permit a provisional application to have a filing date prior to June 8, 1995.

*52. Comment:* One comment suggested that § 1.53(b)(2)(ii) be revised to state that the petition requesting conversion must also be filed before (1) the application becomes involved in interference, or (2) notice by the PTO of intent to publish the application as a statutory invention registration. This suggestion conforms with 35 U.S.C. 11(b)(8).

*Response:* The suggestion has not been fully adopted. It is not necessary to include interference in § 1.53(b)(2)(ii) because if a 35 U.S.C. 111(a) application becomes involved in an interference proceeding and applicant files a petition requesting conversion of that 35 U.S.C. 111(a) application to a provisional application, the 35 U.S.C. 111(a) will be removed from the interference proceeding upon granting the petition to convert. When a subsequent 35 U.S.C. 111(a) application is filed based on the provisional application, the subsequent 35 U.S.C. 111(a) application could be placed in the interference proceeding if necessary. As to the reference to statutory invention registration, § 1.53(b)(2)(ii) is being amended to

require the petition and the fee be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293.

*53. Comment:* One comment suggested that the procedures for converting a 35 U.S.C. 111(a) application to a provisional application be explained in greater detail in § 1.53(b)(2)(ii) or in the discussion. If a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, and a second 35 U.S.C. 111(a) application is concurrently filed, how should this be done and how should the first sentence in the second 35 U.S.C. 111(a) application be worded. Furthermore, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, will it be necessary to file a second 35 U.S.C. 111(a) application on the same day, or else lose the priority claim.

*Response:* The suggestion has not been adopted. The language in § 1.53(b)(2)(ii) is clear relating to the requirements for converting a 35 U.S.C. 111(a) application to a provisional application. If applicant wishes to convert a 35 U.S.C. 111(a) application to a provisional application, applicant must file a petition requesting the conversion along with the petition fee set forth in § 1.17(q). The petition and the fee must be filed prior to the earlier of the abandonment of the 35 U.S.C. 111(a) application, the payment of the issue fee, the expiration of 12 months after the filing date of the 35 U.S.C. 111(a) application, or the filing of a request for a statutory invention registration under § 1.293. In the example noted in the comment, if a 35 U.S.C. 111(a) application is converted to a provisional application on the last day of the 12-month period, a second 35 U.S.C. 111(a) application must be filed on that same day, otherwise, applicant will lose the priority pursuant to 35 U.S.C. 119(e). An example of how the first sentence of the second 35 U.S.C. 111(a) application would read is, "This application claims the benefit of U.S. Provisional Application No. 60/—, filed —, which was converted from Application No. —."

*54. Comment:* One comment suggested that the PTO consider a rule mandating that any prior U.S. application that would have been eligible for conversion to a provisional application that is abandoned in favor of a continuing application within one