

date. If not, the applicant should consider canceling the reference to the earlier filed application to avoid having the 20-year patent term measured from that earlier filing date. An amendment adding or deleting a reference to an earlier filed application presented prior to a final action will be entered, however, the claims may be subject to possible intervening prior art.

74. Comment: One comment stated that in view of the fact that a provisional application is not entitled to claim the benefit of a prior filed copending national or international application as stated in § 1.53(b)(2)(iii), the phrase "other than a provisional application" in § 1.78(a)(2) is unnecessary.

Response: Section 1.78(a)(2) is being amended to state that "any nonprovisional application claiming the benefit of a prior copending nonprovisional or international application must contain * * *." Section 1.78(a)(2) addresses a 35 U.S.C. 111(a) application which claims the benefit of a prior copending 35 U.S.C. 111(a) application or international application.

75. Comment: Several comments objected to the content requirements for drawings filed in a provisional application as originally set forth in proposed § 1.83(a)(2). One comment suggested that no rule was necessary to set forth the required content of drawings in a provisional application.

Response: In view of the comments received, the proposed amendment to § 1.83 is withdrawn. Under 35 U.S.C. 113, first sentence, applicant must furnish drawings in a provisional application "where necessary for the understanding of the subject matter sought to be patented." This requirement is also stated in existing § 1.81(a). Therefore, no further elaboration on the content of the drawings in a provisional application is believed necessary in the rules.

76. Comment: One comment suggested that the rules specify that formal drawings are not required in a provisional application.

Response: The suggestion has not been adopted. However, the PTO intends to examine provisional applications for requirements of form only to the extent that is necessary to permit normal storage and microfilming of the application papers. Formal drawings are usually not required for those purposes.

77. Comment: Several comments suggested that § 1.97(d) be amended to require the PTO to consider any information disclosure statement submitted after a final rejection or

notice of allowance if an appropriate fee is paid.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking. The existing rules are designed to encourage prompt submission of information to the PTO. To permit applicant to merely pay a fee to have any information disclosure statement submitted after a final rejection or Notice of Allowance would be contrary to the effort to encourage prompt submissions.

78. Comment: One comment suggested that § 1.97 be changed so that an office action which uses a newly cited reference as a ground for rejection under 35 U.S.C. 102 or 103 cannot be made final.

Response: The suggestion has not been adopted because no substantive change to this rule was proposed in the Notice of Proposed Rulemaking.

79. Comment: One comment suggested that the words "which are not examined" in § 1.101 as proposed are unnecessary and could create a negative implication that some provisional applications are examined.

Response: The suggestion has not been adopted. By statute, provisional applications are not subject to 35 U.S.C. 131, i.e., the Commissioner is not permitted to examine a provisional application for patentability.

80. Comment: Several comments stated that it is unfair to require small entities to pay the full \$730.00 fee set forth in proposed § 1.129. It is suggested that the fee be changed to \$365.00 or less.

Response: Pursuant to Public Law 103-465, the Commissioner has the authority to establish appropriate fees for the further limited reexamination of applications and for the examination of more than one independent and distinct invention in an application. As a result of additional review, it was concluded that these fees may be reduced by 50% for small entities. Sections 1.17 (r) and (s) are being amended to indicate that the fees are reduced by 50% for small entities, that is, \$365.00 for small entities.

81. Comment: Several comments suggested that the transitional procedure set forth in § 1.129(a) as proposed is equivalent to filing one application, i.e., it provides for an extra examination and reexamination after the original final rejection, and, therefore, the requirement for two \$730.00 fees, which is equivalent to two filing fees, is unwarranted. Another comment suggested that if the proposed \$730.00 fee is adopted, the examiner should be instructed to treat the after-final

amendment as any other initial filing, i.e., a new application, not as an amendment submitted after a non-final office action.

Response: Under existing PTO practice, it would not be proper to make final a first Office action in a continuing or substitute application where the continuing or substitute application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. The identical procedure will apply to examination of a submission consideration as a result of the procedure under § 1.129(a). Thus, under § 1.129(a), if the first submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Likewise, if the second submission after final rejection was initially denied entry in the application because (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised, then the next action in the application will not be made final. Thus, the fee required by § 1.129(a) has been set at the amount required for filing an application because the procedure provided by the rule is equivalent to the filing of two applications. No new matter can be entered by payment of the fee set forth in § 1.17(r).

82. Comment: Several comments suggested that the fees required for filing a provisional application and those fees required by §§ 1.129(a) and (b) for the transitional procedures should not be greater than the average cost of processing such matters by the PTO. Two comments stated that the fee required by § 1.129(a) is excessive relative to PTO costs.

Response: The fee required for filing a provisional application is set by Public Law 103-465 and the PTO has no discretion with respect to the amount of that particular fee. As to the fee required by § 1.129(a), the procedures relating to the first submission provided by § 1.129(a) is equivalent to the filing of a file wrapper continuation application under § 1.62, and therefore, the fee required with the first submission is appropriately set at the same amount as a filing fee, which is \$730.00. The \$730.00 fee is subject to a 50% reduction for small entities. The second submission is equivalent to the filing of