than for designs, was delayed due to interference proceedings, the imposition of a secrecy order and/or appellate review; and implementing certain transitional provisions contained in the Uruguay Round Agreements Act. EFFECTIVE DATE: June 8, 1995.

FOR FURTHER INFORMATION CONTACT: Magdalen Y. Greenlief or John F. Gonzales, Senior Legal Advisors, Office of the Deputy Assistant Commissioner for Patent Policy and Projects, by telephone at (703) 305-9285, by fax at (703) 308-6916 or by mail marked to their attention and addressed to the Commissioner of Patents and Trademarks, Box DAC, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: The Uruguay Round Agreements Act (Public Law 103-465) was enacted on December 8. 1994. Public Law 103-465 amends 35 U.S.C. 154 to provide that the term of patent protection begins on the date of grant and ends 20 years from the filing date of the application. The amendment applies to all utility and plant patents issued on applications having an actual United States application filing date on or after June 8, 1995. Specifically, 35 U.S.C. 154(a)(2), as contained in Public Law 103-465, provides that the patent term will begin on the date on which the patent issues and will end twenty years from the date on which the application was filed in the United States. If the application contains a specific reference to an earlier application under 35 U.S.C. 120, 121 or 365(c), the patent term will end twenty years from the date on which the earliest application referred to was filed. As amended by Public Law 103-465, 35 U.S.C. 154 does not take into account for determination of the patent term any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b). Under 35 U.S.C. 154(b)(1), as

contained in Public Law 103-465, if the issuance of an original patent is delayed due to interference proceedings under 35 U.S.C. 135(a) or because the application is placed under a secrecy order under 35 U.S.C. 181, the term of the patent shall be extended for the period of delay, but in no case more than five (5) years.

Under 35 U.S.C. 154(b)(2), as contained in Public Law 103-465, if the issuance of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than five (5) years.

However, a patent shall not be eligible for extension under 35 U.S.C. 154(b)(2) if the patent is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

Under 35 U.S.C. 154(b)(3)(B) and 154(b)(3)(C), as contained in Public Law 103–465, the period of extension under 35 U.S.C. 154(b)(2) shall be reduced by any time attributable to appellate review before the expiration of three (3) years from the filing date of the application and for any period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

Under 35 U.S.C. 154(b)(4), as contained in Public Law 103-465, the total duration of all extensions of a patent under 35 U.S.C. 154(b) shall not exceed five (5) years.

The provisions for patent term extension under 35 U.S.C. 154(b) are separate from and in addition to the patent term extension provisions of 35 U.S.C. 156. The patent term extension provisions of 35 U.S.C. 154(b) are designed to compensate the patent owner for delays in issuing a patent, whereas the patent term extension provisions of 35 U.S.C. 156 are designed to restore term lost to premarket regulatory review after the grant of a patent. In order to prevent a term extension under 35 U.S.C. 154(b) from precluding a term extension under 35 U.S.C. 156, Public Law 103–465 amends 35 U.S.C. 156(a)(2) to specify that the term has never been extended under 35 U.S.C. 156(e)(1).

The 20-year patent term provision is contained in 35 U.S.C. 154, as amended by Public Law 103-465. Section 154 of title 35, United States Code, applies to utility and plant patents, but not to design patents. The term of a design patent is defined in 35 U.S.C. 173 as fourteen (14) years from the date of grant. Therefore, the patent term and patent term extension provisions set forth in 35 U.S.C. 154, as amended by Public Law 103-465, do not apply to patents for designs.

In addition, Public Law 103-465 establishes a domestic priority system. In accordance with the provisions of the Paris Convention for the Protection of Industrial Property, the term of a patent cannot include the Paris Convention priority period. Public Law 103-465 provides a mechanism to enable applicants to quickly and inexpensively file provisional applications. Applicants will be entitled to claim the benefit of priority in a given application based upon a previously filed provisional application in the United States. The

domestic priority period will not count in the measurement of the term

Section 111 of title 35, United States Code, was amended by Public Law 103-465 to provide for the filing of a provisional application on or after June 8, 1995. Section 41(a)(1) of title 35, United States Code, was amended by Public Law 103-465 to provide a \$150.00 filing fee for each provisional application, subject to a fifty (50) percent reduction for a small entity. The requirements for obtaining a filing date for a provisional application are the same as those which previously existed for an application filed under 35 U.S.C. 111, except that no claim or claims as set forth in 35 U.S.C. 112, second paragraph, is required. Moreover, no oath/declaration as set forth in 35 U.S.C. 115 is required. The provisional application is also not subject to the provisions of 35 U.S.C. 131, 135 and 157, i.e., a provisional application will not be examined for patentability, placed in interference or made the subject of a statutory invention registration. Further, the provisional application will automatically be abandoned no later than twelve (12) months after its filing date and will not be subject to revival to restore it to pending status beyond a date which is after twelve (12) months from its filing date. A provisional application will not be entitled to claim priority benefits based on any other application under 35 U.S.C. 119, 120, 121 or 365.

Also, Public Law 103-465 amended 35 U.S.C. 119 to allow an applicant to claim the benefit of the filing date of one or more copending provisional applications in a later filed application for patent under 35 U.S.C. 111(a) or 363. The later filed application for patent under 35 U.S.C. 111(a) or 363 must be filed by an inventor or inventors named in the copending provisional application not later than 12 months after the date on which the provisional application was filed and must contain or be amended to contain a specific reference to the provisional application. The provisional application must disclose an invention which is claimed in the application for patent under 35 U.S.C. 111(a) or 363 in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the provisional application must be pending on the filing date of the application for patent under 35 U.S.C. 111(a) or 363 and the filing fee set forth in subparagaph (A) or (C) of 35 U.S.C. 41(a)(1) must be paid. Since 35 U.S.C. 154(a)(3), as

contained in Public Law 103–465, excludes from the determination of the patent term any application on which priority is claimed under 35 U.S.C. 119,