e.g., 07/123,456) and to eliminate the use of serial number and filing date as an identifier for national patent applications in assignment documents. This change is intended to eliminate any confusion as to whether an application identified by its serial number and filing date in an assignment document is an application filed under § 1.53(b)(1), 1.60 or 1.62 or a design application or a provisional application since there is a different series code assigned to each of these types of applications.

Section 3.21 is also being amended to provide that if an assignment of a patent application filed under § 1.53(b)(1) or § 1.62 is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended.

Further, § 3.21 is being amended to provide that if an assignment of a provisional application is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

Section 3.81 is being amended to replace the reference to § 1.17(i)(1) with a reference to § 1.17(i) to be consistent

with the change to § 1.17.

Responses to and Analysis of Comments: Forty-nine written comments were received in response to the Notice of Proposed Rulemaking. These comments, along with those made at the public hearing, have been analyzed. Some suggestions made in the comments have been adopted and others have not been adopted. Responses to the comments follow.

General Comments

1. Comment: One comment questioned the use of the word "proposed" in the notice of proposed rulemaking in describing the statutory amendments contained in Public Law 103–465.

Response: The statutory changes contained in Public Law 103–465 were described as "proposed" changes in the Notice of Proposed Rulemaking because the President had not signed the legislation at the time the notice was prepared for publication. In fact, the legislation was signed by the President on December 8, 1994, which is the date of enactment.

2. Comment: Several comments urged the PTO to favorably consider the 17/20

patent term specified in H.R. 359 since this proposed legislation would overcome the existing impact of extended PTO prosecution and eliminate patent term extensions for prosecution delays. Furthermore, the proposed legislation is consistent with the Uruguay Round Agreements Act, Public Law 103–465.

Response: The administration and the PTO strongly believe 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 PTO will take steps to ensure that processing and examination of applications are handled expeditiously.

3. Comment: One comment stated that the proposed rules are premature in view of the Rohrabacher bill, H.R. 359.

Response: The proposed rules are not premature. Public Law 103–465 was signed into law on December 8, 1994, with an effective date of June 8, 1995, for the implementation of the 20-year patent term and provisional applications. The Commissioner must promulgate regulations to implement the changes required by Public Law 103–465.

4. Comment: One comment stated that there is nothing in the TRIPs agreement that requires the term to be measured from filing, nor that provisional applications be provided for, nor that new fees of \$730 as set forth in §§ 1.17 (r) and (s) be established. It is suggested that 35 U.S.C. 154 be amended to provide that "every patent (other than a design patent) shall be granted a term of twenty years from the patent issue date, subject to the payment of maintenance fees." It was also suggested that the section regarding maintenance fees be amended to add a new fee payable at 16.5 years of \$5000 (for large entity)/ \$2500 (for small entity) for maintenance of patent between 17 and 20 years.

Response: The suggestion has not been adopted. The administration and the PTO strongly believe that the 20year 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 establishment of a provisional application is not required by GATT. The provisional application has been adopted as a mechanism to provide easy and inexpensive entry into the patent system. The filing of provisional applications is optional. Provisional applications will place domestic applicants on an equal footing with foreign applicants as far as the measurement of term is concerned because the domestic priority period,

like the foreign priority period, is not counted in determining the endpoint of the patent term. As to the §§ 1.17 (r) and (s) fees, the statute authorizes the Commissioner to establish appropriate fees for further limited reexamination of applications and for examination of more than one independent and distinct inventions in an application.

5. Comment: One comment suggested that the 20-year patent term of claims drawn to new matter in continuation-in-part (CIP) applications be measured from the filing date of the CIP application, irrespective of any reference to a parent application under 35 U.S.C. 120.

Response: The suggestion has not been adopted. The term of a patent is not based on a claim-by-claim approach. Under 35 U.S.C. 154(a)(2), if an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(a), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(a). For a CIP application, applicant should review whether any claim in the patent that will issue is supported in an earlier application. If not, applicant should consider canceling the reference to the earlier filed application.

6. Comment: One comment objected to the 20-year term provisions of Public Law 103–465 because it was believed that payment of maintenance fees would be required earlier under 20-year term than under 17-year term.

Response: The payment of maintenance fees are not due earlier under 20-year term than under 17-year term. Maintenance fees continue to be due at 3.5, 7.5 and 11.5 years from the issue date of the patent.

7. Comment: Several comments suggested that the expiration date be printed on the face of the patent.

Response: The suggestion has not been adopted. The expiration date will not be printed on the face of the patent. The PTO will publish any patent term extension that is granted as a result of administrative delay pursuant to § 1.701 on the face of the patent. The term of a patent will be readily discernible from the face of the patent. Furthermore, it is noted that the term of a patent is dependent on the timely payment of maintenance fees which is not printed on the face of the patent.

8. Comment: One comment suggested that in order to aid the bar in advising clients as to whether a provisional application has had its priority claimed in a patent, the PTO should somehow link the provisional application number