requirements for verified statements of facts from the original named inventors and written consent of the assignees are to be deleted, the PTO would no longer have the assurances that all parties agree to the change.

37. Comment: One comment expressed concern that a provisional application filed without a claim will leave subsequent readers with little or no clue as to what the inventors in the provisional application considered to be their invention at the time the provisional application was filed and doubted that a provisional application filed without a claim defining the invention could ever provide a sufficient disclosure to support a claim for a foreign or U.S. priority date.

Response: Claims are not required by the statute to provide a specification in compliance with the requirements of 35 U.S.C. 112, first paragraph. However, if an applicant desires, one or more claims may be included in a provisional application. Any claim field with a provisional application will, of course, be considered part of the original provisional application disclosure.

38. Comment: One comment suggested that the PTO issue a specification format or guideline for a provisional application to enable an inventor to comply with 35 U.S.C. 112,

first paragraph. *Response:* The format of a provisional application is the same as for other

application is the same as for other applications and is set forth in existing § 1.77 which is applicable to provisional applications except no claims are required for provisional applications.

39. Comment: Several comments suggested that the PTO revise its rules to clarify that strict adherence to the enablement, description and best mode requirements of 35 U.S.C. 112, first paragraph, is not required in provisional

applications.

Response: The suggestion has not been adopted. The substantive requirements of a specification necessary to comply with 35 U.S.C. 112, first paragraph, are established by court cases interpreting that section of the statute, not by rule. The case law applies to provisional applications as well as to applications filed under 35 U.S.C. 111(a).

40. Comment: Several comments suggested that the rules or comments published with the Final Rule indicate whether there is any requirement to update the best mode disclosed in the provisional application when filing the 35 U.S.C. 111(a) application.

Response: No rule was proposed to address the issue when going from a provisional application to a 35 U.S.C. 111(a) application because no current

rule exists when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application. The question of whether the best mode has to be updated is the same when going from one 35 U.S.C. 111(a) application to another 35 U.S.C. 111(a) application or from a provisional application to a 35 U.S.C. 111(a) application. Accordingly, the rationale of Transco Products, Inc. v. Performance Contracting Inc., 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994), would appear to be applicable. Clearly, if the substantive content of the application does not change when filing the 35 U.S.C. 111(a) application, there is no requirement to update the best mode. However, if subject matter is added to the 35 U.S.C. 111(a) application, there may be a requirement to update the best mode.

41. Comment: One comment suggested that § 1.51(c) be amended to permit a provisional application to be filed with an authorization to charge fees to a deposit account.

Response: Section 1.51(c) permits an application to be filed with an authorization to charge fees to a deposit account. Section 1.51(c) applies to provisional applications. Therefore, no change to § 1.51(c) is necessary.

42. Comment: One comment suggested that the PTO confirm that there will be no procedural examination of a provisional application other than to determine whether the provisional application complies with § 1.51(a)(2).

Response: The PTO intends to require compliance with the formal requirements of §§ 1.52(a)–(c) only to the extent necessary to permit the PTO to properly microfilm and store the application papers.

43. Comment: Several comments suggested that an English translation of a foreign language provisional application should not be required unless necessary in prosecution of the 35 U.S.C. 111(a) application to establish benefit. If an English translation is required, there is no useful purpose to require the translation at any time earlier than the filing of 35 U.S.C. 111(a) application claiming the benefit of the provisional application.

Response: Provisional applications may be filed in a language other than English as set forth in existing § 1.52(d). However, an English language translation is necessary for security screening purposes. Therefore, the PTO will require the English language translation and payment of the fee required in § 1.52(d) in the provisional application. Failure to timely submit the translation in response to a PTO requirement will result in the abandonment of the provisional

application. If a 35 U.S.C. 111(a) application is filed without providing the English language translation in the provisional application, the English language translation will be required to be supplied in every 35 U.S.C. 111(a) application claiming priority of the non-English language provisional application.

34. Comment: One comment suggested that a new model oath or declaration form for use in claiming 35 U.S.C. 119(e) priority and a "cover sheet" for use in filing provisional applications be published as an addendum to the final rules.

Response: The suggestion has been adopted. See Appendix A for the sample cover sheet for filing a provisional application and Appendix B for the sample declaration for use in claiming 35 U.S.C. 119(e) priority.

45. Comment: One comment suggested that the statement in § 1.53(b)(2) that the provisional application will not be given a filing date if all the names of the actual inventor or inventor(s) are not supplied be deleted and § 1.41 be amended to make an exception for provisional applications. The comment suggested that 35 U.S.C. 111(b) is satisfied as long as the name of one person who made an inventive contribution to the subject matter of the application is given.

Response: The suggestion has not been adopted. Section 111(b) of title 35, United States Code, states that "a provisional application shall be made or authorized to be made by the inventor." This language parallels 35 U.S.C. 111(a). The naming of inventors for obtaining a filing date for a provisional application is the same as for other applications. A provisional application filed with the inventors identified as "Jones et al." will not be accorded a filing date earlier than the date upon which the name of each inventor is supplied unless a petition with the fee set forth in § 1.17(i) is filed which sets forth the reasons the delay in supplying the names should be excused. Administrative oversight is an acceptable reason. It should be noted that for a 35 U.S.C. 111(a) application to be entitled to claim the benefit of the filing date of a provisional application, the 35 U.S.C. 111(a), application must have at least one inventor in common with the provisional application.

46. Comment: One comment suggested that a drawing should not be required to obtain a filing date for a provisional application. Whatever is filed should be given a serial number and filing date in order to establish status as a provisional application, regardless of what is in the specification or drawing. If the provisional