year of the earlier priority date asserted be deemed constructively converted to a

provisional application.

Response: The suggestion has not been adopted. Conversion of a 35 U.S.C. 111(a) application to a provisional will be permitted only by way of a petition and under the conditions set forth in § 1.53(b)(2)(ii). One reason for this is that the PTO plans to provide sufficient information on the printed patent to determine the end date of the 20-year patent term by identifying provisional applications using a unique series code, i.e., "60". Thus, a 35 U.S.C. 111(a) application converted to a provisional application will need to be reprocessed by the PTO with a new application number. The petition fee is intended to reimburse the PTO for the extra processing necessitated by the conversion.

55. Comment: One comment stated that § 1.53(b)(2)(ii) permits the conversion of a 35 U.S.C. 111(a) application to a provisional application. However, it is silent as to whether such a conversion would kill any benefit the 35 U.S.C. 111(a) application had of domestic and/or foreign priority

Response: Section 111(b)(7) of title 35, United States Code, specifically states that a provisional application shall not be entitled to the right of priority of any other application under 35 U.S.C. 119 or 365(a) or to the benefit of an earlier filing date in the United States under 35 U.S.C. 120, 121, or 365(c). If a 35 U.S.C. 111(a) application is converted to a provisional application, the granting of the conversion will automatically eliminate any claim of priority which could have been made in the 35 U.S.C. 111(a) application.

56. Comment: Several comments suggested that it was inconsistent with the purpose of the provisional application to require any compliance with the Sequence Disclosure Rules §§ 1.821–1.823 and 1.825, since the provisional applications are not examined and there is no comparison of

the sequences with the prior art.

Response: The Office agrees with the comments that a provisional application need not comply with the requirements of §§ 1.821 through 1.825. Section 1.53(b)(2)(iii) is being amended to indicate that the requirements of §§ 1.821 through 1.825 regarding sequence listings are not mandatory for a provisional application. However, applicants are cautioned that in order for a 35 U.S.C. 111(a) application to obtain the benefit of the filing date of an earlier filed provisional application, the claimed subject matter of the 35 U.S.C. 111(a) application must have been disclosed in the provisional application

in a manner provided by 35 U.S.C. 112, first paragraph. Applicants are encouraged to follow the sequence rules to ensure that support for the invention claimed in the 35 U.S.C. 111(a) application can be readily ascertained in the provisional application.

*57. Comment:* One comment suggested that the language in § 1.53(e)(2) that a provisional application will become abandoned no later than twelve months after its filing date was misleading and that the words "no later than" should be deleted because it was believed that a provisional application could not be abandoned prior to twelve months after

its filing date.

Response: The statute does not state that a provisional application can never be abandoned prior to twelve months after its filing date. In fact, a provisional application may be abandoned as a result of applicant's failure to timely respond to a PTO requirement. For example, if a provisional application which has been accorded a filing date does not include the appropriate filing fee or the cover sheet required by § 1.51(a)(2), applicant will be so notified if a correspondence address has been provided and given a period of time within which to file the fee, cover sheet and to pay the surcharge as set forth in § 1.16(l). Failure to timely respond will result in the abandonment of the application. This may occur prior to twelve months after its filing date. Furthermore, a provisional application may also be expressly abandoned prior to twelve months from its filing date.

58. Comment: One comment objected to the deletion of the "retention fee" practice in § 1.53(d) since it permits an applicant in a first application claiming benefits under 35 U.S.C. 119 (a)–(d) or 120 to correct inventorship by filing a second application without having to pay the full filing fee in the first application.

Response: Since the comment indicated that there is a benefit to retain the retention fee practice, the proposal to eliminate the practice is withdrawn.

*59. Comment:* One comment stated that the language of §§ 1.53 (d)(1) and (d)(2) indicates an intent by the PTO to mail the "Notice Of Missing Parts" to applicant's post office address and argues that the "Notice" should be mailed to the registered practitioner who filed the application on behalf of the applicant.

Response: The language in §§ 1.53 (d)(1) and (d)(2) states that the applicant will be notified of the missing part, if a correspondence address is provided. This means that the "Notice" to applicant will be mailed to the

correspondence address provided in the application papers. Under current PTO practice, if no specific correspondence address is identified in the application, the address of the registered practitioner who filed the application on behalf of the applicant is used as the correspondence address. If no specific correspondence address or registered practitioner is identified in the application, the post office address of the first named inventor is used as the correspondence address. No change in current PTO practice in this regard is required as a result of § 1.53(d)(2) nor is any change planned.

60. Comment: Several comments objected to the proposed deletion of § 1.60. One comment suggested that the deletion of § 1.60 was a major rule change and should have been proposed separate from the proposed rules dealing with the changes in practice required by Public Law 103-465.

Response: In view of the comments received, the proposal to delete § 1.60 is withdrawn. However, the proposal will be considered as part of a comprehensive effort being conducted by the PTO to reengineer the entire

patent process.

61. Comment: One comment suggested that in view of the deletion of § 1.60, language should be incorporated in § 1.53(a)(1) to state that a copy of the prior application along with a copy of the declaration may be filed to obtain a filing date. Furthermore, full details and guidelines of the procedure should accompany the rule.

*Response:* The suggestion has not been adopted. The proposal to delete § 1.60 is withdrawn in view of several comments received objecting to the deletion.

62. Comment: One comment suggested that the removal of the stale

oath practice be codified.

Response: The suggestion has not been adopted. Neither the statute nor the rules require a recent date of execution to appear on the oath or declaration. The PTO practice of objecting to an oath or declaration where the time elapsed between the date of execution and the filing date of the application is more than three months is found in section 602.05 of the MPEP. Therefore, the removal of the stale oath practice will be accomplished by amending the MPEP.

63. Comment: One comment questioned whether a copy of an application faxed to an attorney could be filed in the PTO as the application

Response: Yes. While a patent application may not be faxed directly to the PTO, an application faxed to an