

# EXHIBIT W

**[ii] PTO Processing; Conversion.**

Section 111(b)(8) provided that Sections 131, 135, and 157 did not apply to provisional applications, which meant that provisional applications were (1) not subject to examination (Section 131), (2) could not be the basis for an interference (Section 135), and (3) could not be issued as a statutory invention registration (Section 157).

The PTO's rules barred provisional applicants from filing information disclosure statements, which would serve no purpose in the absence of a PTO search and examination. They barred amendments except those necessary "to make the provisional application comply with all applicable regulations."

Prior to a 1999 amendment, Section 111(b)(5) provided that a provisional application "shall be regarded as abandoned 12 months after the filing date of such application and cannot be subject to revival thereafter."

Section 111(b)(6) allowed an applicant to convert a complete Section 111(a) application into a provisional application. An advantage of a provisional application is that its filing does not start the 20-year-from-filing patent term.

In 1999, Congress amended Section 111(b)(5) to allow conversion in both directions, that is, from provisional to non-provisional as well as from non-provisional to provisional: "[n]otwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period."

In amending Rule 53(c) to conform to this statutory change, the PTO required payment of a fee and the addition of at least one claim if the provisional application did not contain a claim. The PTO also warned that a conversion from provisional to non-provisional status may be inadvisable because it can result in loss of up to a year of potential patent term.

The legislation allowing conversion to a nonprovisional application may have been desirable to cure a potential problem with the status of provisional applications as the basis for priority in other countries. It would seem to resolve conclusively any doubt about whether a U.S. provisional application constitutes a "regular national filing" of a patent application within the meaning of Article 4 of the Paris Convention. It removes an argument that might have been made to a court in another country that a U.S. provisional application is not a true patent application because it cannot be examined or be issued as a patent. Hence, the change establishes the status of a provisional application as a regular filing for transnational law purposes even if, in fact, few applicants exercise the right of conversion from provisional to nonprovisional.

4 Chisum on Patents § 11.02[1][g][ii] (2021)