

Appendix 5 – What SPRE/SPE should do when applicant requests a copy of a provisional application stating that no copy of a provisional application was supplied with a prior Office action?

A. Dismiss the request in any of the following 5 situations:

1. The request was submitted more than 3 months after the mail date of the Office action;
2. The Office action was mailed before the date of this memo, or after termination of this transitional practice;
3. The provisional application number was listed on the PTO-892 with the annotation: **“Copy not readily available;”**
4. The reference claiming the benefit of the prior provisional application was not applied in a rejection (it was only cited of interest); or
5. The reference has a good § 102(e) date other than the filing date of the prior provisional application (e.g., the reference has an actual filing date, or a § 120 or § 365(c) benefit date antedating the earliest effective filing date of the application being examined).

In the dismissal, notify applicant that a copy of the provisional application may be ordered from the Office of Public Records (OPR) under 37 CFR § 1.14(a)(1)(iv), and that a request for a copy of a provisional application under 37 CFR § 1.14(a)(1)(iv) requires payment of the fee set forth at 37 CFR § 1.19(b)(1) - currently \$20.00

B. Grant the request in any of the following situations and where dismissal is not appropriate as set forth above:

1. The provisional application number was listed on the PTO-892 but without the annotation **“Copy not readily available,”**
2. The provisional application number was not listed on the PTO-892 but it should have been because the benefit of the filing date of the provisional application under 35 U.S.C. § 102(e) was necessary to antedate the effective filing date, or perfected priority date, of the application being examined.

In the grant of the request, the SPE/examiner should prepare, as appropriate, a new cover letter (PTOL-326), a PTOL-90, including form paragraphs 7.81 and 7.81.01, and, if necessary a new PTO-892 (where, for example, the prior PTO-892 lists other documents) so a copy will now be provided, and the period for reply restarted, or reset, per MPEP 710.06¹.

Note: While a request should be granted in the situations listed above, if the provisional application is not contained in the PACR and IFW databases, the request will have to be dismissed. In this situation, the Office letter will state that a copy is not readily available and instruct applicant to request the copy from OPR under the procedure set forth at 37 CFR § 1.14(a)(1)(iv).

¹ If applicant’s request was made within one month of the mailing date of the Office action, the 3 month SSP will be restarted. If the request was filed more than one month after the mailing date of the Office action but less than three months, the SSP will be reset for two months, or one month, as set forth in MPEP 710.06.