

February 24, 2015

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Via email: michelle.lee@uspto.gov

**Re: Recommendation Regarding Consideration by the PCT Receiving
Office of the USPTO of Requests for Restoration of Priority Based
Upon the “Due Care” Standard**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) would like to take this opportunity to provide the United States Patent and Trademark Office (USPTO) with a recommendation concerning the consideration by the PCT Receiving Office of the USPTO of requests for restoration of priority based upon the “due care” standard.

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA’s members represent a wide and diverse spectrum of individuals, companies, and institutions, and are involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

Background

The Patent Law Treaty offers its signatories the opportunity to consider requests for restoration of priority under the Paris Convention for applicants that have missed the 12-month priority period but that have discovered the error within 14 months of the priority date. The Treaty contemplates that such a request might be based upon a mere statement that the error was “unintentional” or might be based upon a more demanding showing that the error occurred despite the exercise of “due care.”

When the United States joined this Treaty, the USPTO determined that for requests filed by PCT applicants, the Receiving Office of the USPTO would only consider requests made pursuant to the “unintentional” standard and would not consider requests made pursuant to the “due care” standard.

This has the perhaps unintended consequence of disadvantaging a U.S. applicant that had hoped to also pursue patent protection in any of the patent offices that condition the restoration of priority upon a grant of a “due care” request. Such patent offices include those of Armenia, Bahrain, Croatia, Denmark, Estonia, Egypt, Finland, Guatemala, Hungary, Iceland, Israel, Lithuania, Macedonia, New Zealand, Peru, Poland, Portugal, Serbia, Slovakia, Spain, Sweden, and Switzerland, as well as the European Patent Office.

Recommendation

To more fully realize the potential benefits of the Patent Law Treaty, the AIPLA Board of Directors recently adopted the following resolution:

RESOLVED, that AIPLA favors the USPTO in its role as PCT Receiving Office considering requests for restoration of priority based upon the “due care” standard, in addition to considering requests for restoration of priority based upon the “unintentional” standard.

We appreciate that the consideration of “due care” requests can in some cases require the USPTO to weigh and sift through a variety of types of evidence that may be offered in support. As such, we recognize that the USPTO may wish to establish a fee sufficient to cover the cost to the Office of the consideration of such requests.

Benefits

AIPLA believes that the consideration of such “due care” requests will be very helpful for the (hopefully relatively small) number of applicants that find themselves to have missed the 12-month period for filing a PCT application claiming priority from an earlier patent application, and wish to pursue patent protection in any of a number of foreign patent offices.

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AIPLA supports the USPTO’s continuing efforts to better serve patent applicants and to improve the PCT system. AIPLA would welcome the opportunity to answer any questions that this recommendation may raise.

Sincerely,



Sharon A. Israel
President
American Intellectual Property Law Association