

# PATENT LAW TREATY



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# Patent Law Treaty

- Patent Law Treaty (PLT) was concluded on June 1, 2000, and entered into force on April 28, 2005.
- U.S. Senate ratified the PLT on December 7, 2007, but the PLT required implementing legislation.



# Patent Law Treaties Implementation Act

- Patent Law Treaties Implementation Act of 2012 (PLTIA) was enacted on December 18, 2012.
- Title II of the PLTIA amends 35 U.S.C. to implement the PLT.
- Title II of the PLTIA is effective on December 18, 2013.



# Areas of Major Changes

- Application filing date and reference filing provisions
- Restoration of the right of priority to foreign applications and domestic benefit of provisional applications
- Restoration of patent rights
- Time periods for action by applicants



# Application Filing Date and Reference Filing Provisions



# Filing Provisions

- PLT and PLTIA:
  - Change application filing date requirements (except for design applications) (aka “application filing date”)
  - Provide for filing an application “by reference” to a previously filed application (aka “reference filing”)



# Application Filing Date

- Filing date of a provisional or nonprovisional application (other than for a design patent) is:
  - Date on which a specification, with or without claims, is received in the Office.



# Application Filing Date

- Filing date of an application for a design patent continues to be the date on which the Office receives:
  - Specification as prescribed by 35 U.S.C. 112 (which requires at least one claim), and
  - Any required drawings.





# Application Filing Date

- If an application is filed without any claim:
  - Applicant will be notified and given a time period within which to submit at least one claim and the late filing surcharge.
- Similar to current “missing parts” practice for applications filed without fees.



# Application Filing Date

- Any claim submitted after the filing date of the application must have 35 U.S.C. 112(a) support in the application as filed.
- Application will not be examined until it includes at least one claim.



# Application Filing Date

- If an application is filed without any drawings:
  - Applicant will be notified if the examiner determines that a drawing is necessary (35 U.S.C. 113); otherwise, drawings are not required.
- Any drawing submitted after the filing date of the application must have 35 U.S.C. 112(a) support in the application as filed.



# Reference Filing

- Application may be filed “by reference” to a previously filed application.
- Reference must be in English in an application data sheet (ADS) or the PLT Model Request Form.



# Reference Filing

- Reference must specify the previously filed application by:
  - Application number,
  - Filing date, and
  - Intellectual property authority or country in which the previously filed application was filed.



# Reference Filing

- Applicants filing by reference should take care to ensure that the correct previously filed application is specified on the ADS or the PLT Model Request Form.
- If the wrong application is specified on ADS or the PLT Model Request Form, the specification and drawings of the wrong application will be the specification and drawings of the application filed by reference.



# Reference Filing

- Applicant will be notified and given a time period to file:
  - Copy of the specification and drawings from the previously filed application,
  - English language translation and processing fee if the previously filed application is not in the English language, and
  - Late filing surcharge.



# Reference Filing

- If the application is abandoned for failure to file a proper reply to the notice, the application will be treated as having never been filed unless:
  - Application is revived, and
  - Copy of the specification and any drawings of the previously filed application are filed.





# Reference Filing

- A certified copy of the previously filed application also must be filed unless:
  - Previously filed application is a U.S. or PCT application, or
  - Certified copy of the previously filed application is available via PDX.



# Reference Filing

- Certified copy of the previously filed application (if required) must be filed within the later of:
  - Four months from the filing date of the application, or
  - Sixteen months from the filing date of the previously filed application.



# Application Filing Provisions

- Application filing provisions of the PLT are a safeguard against the loss of a filing date due to a technicality, e.g.,
  - Application missing the claims or the drawings, or
  - Copy of a previously filed application not being available for filing.
- Application filing provisions of the PLT should not be viewed as best practices.



# Restoration of Foreign Priority or Domestic Benefit



# Restoration of Priority or Benefit

- PLT and PLTIA provide for restoration of:
  - Right of foreign priority in applications filed more than twelve months (six months in designs) after the filing date of the foreign application.
  - Domestic benefit of a provisional application in applications filed more than twelve months after the filing date of the provisional application.



# Restoration of Priority or Benefit

- PLT and PLTIA require that the delay in filing the “subsequent” application within the priority or benefit period have been unintentional.
  - Not an “extension” of the priority or benefit period.
- PLTIA requires that the “subsequent” application have been filed within two months of the expiration of the twelve-month (six-month in designs) priority or benefit period.



# Petition to Restore the Right of Priority or Benefit

- Petition to restore the right of priority or benefit must include:
  - Priority or benefit claim,
  - “Unintentional” petition fee (\$1700 for large entity and \$850 for small entity), and
  - Statement that the delay in filing the subsequent application was unintentional.



# Restoration of Patent Rights





# Restoration of Patent Rights

- PLTIA eliminates the “unavoidable” delay standard as a basis for:
  - Reviving an abandoned application,
  - Accepting a delayed patent owner response in reexamination, or
  - Accepting a delayed maintenance fee payment.



# Restoration of Patent Rights

- PLTIA adds new 35 U.S.C. 27, which expressly provides that the Director may establish procedures to:
  - Revive an unintentionally abandoned patent application,
  - Accept an unintentionally delayed payment of the issue fee, and
  - Accept an unintentionally delayed response by the patent owner in a reexamination proceeding.



# Restoration of Patent Rights

- Under the PLTIA, there is a single unintentional delay standard and petition fee for:
  - Reviving an abandoned application,
  - Accepting a delayed patent owner response in reexamination, and
  - Accepting a delayed maintenance fee payment.



# Restoration of Patent Rights

- PLTIA eliminates the twenty-four month time period requirement for petitions to accept an unintentionally delayed maintenance fee payment.



# Restoration of Patent Rights

- PLTIA “unintentional” fee applies to petitions for:
  - Revival of an abandoned application,
  - Delayed payment of the fee for issuing each patent,
  - Delayed response by patent owner in any reexamination proceeding,
  - Delayed maintenance fee payment,
  - Delayed submission of a priority or benefit claim, and
  - Delayed filing of an application claiming priority to a foreign or provisional application.



# Restoration of Patent Rights

- PLTIA “unintentional” fee is \$1,700 for a large entity and \$850 for a small entity.
- Micro entity discount does not currently apply to the PLTIA “unintentional” petition fee.
- Micro entity discount applies to fees set under section 10(a) of the America Invents Act (AIA).
- “Unintentional” petition fee will have a micro entity amount when patent fees are set under section 10(a) of the AIA again.



# Restoration of Patent Rights

- PLTIA provides that the Office may refund any part of the “unintentional” petition fee in exceptional circumstances as determined by the Director.
- Provision permits the Office to refund (or waive) the “unintentional” petition fee where there is a widespread disaster, such as a hurricane, earthquake, or flood.



# Time Periods for Action by Applicants





# Time Periods for Action by Applicant

- PLT provides a time period of at least two months for replies to most Office actions and other notices.
- Primarily impacts:
  - Requirement for restriction or an election of species,
  - Notices of non-responsive or noncompliant reply or amendment, and
  - Requirements to comply with the sequence regulations (37 CFR 1.821 et seq.).



# Time Periods for Action by Applicant

- Pilot programs are not encompassed by this requirement of the PLT:
  - Pre-appeal brief conference program, and
  - Pre-first Office action on the merits interview program.



# Miscellaneous



# Patent Term Adjustment

- Rules for patent term adjustment (PTA) provide for a reduction of any patent term adjustment if an application is not “in condition for examination” within eight months of:
  - Filing date of an application under 35 U.S.C. 111(a), or
  - Date of commencement of national stage in an international application.



# Patent Term Adjustment

- Application in condition for examination includes:
  - Specification, including at least one claim and an abstract, in publication quality papers,
  - Publication quality drawings,
  - Compliant sequence listing (if applicable),
  - Inventor's oath or declaration or ADS containing inventor information, and
  - Basic filing, search, examination, and any applicable application size fee.



# Patent Term Adjustment

- Application filed by reference to a previously filed application must include a certified copy of the previously filed application if applicable to be in condition for examination.
- Application filed in a language other than English (including an application filed by reference) must include an English translation to be in condition for examination.



# PLT Model Forms

- PLT Model Request Form may be used in place of the ADS for:
  - filing an application by reference,
  - priority/benefit claims, and
  - naming a non-inventor applicant.



# PLT Model Forms

- AIA change to oath-declaration practice now allows applicants to postpone submission of the inventor's oath or declaration until allowance.
- ADS must be used to name the inventor(s) if applicant wants to postpone submission of the inventor's oath or declaration.





# Representation

- Natural person applicant may act pro se.
- Juristic entity applicant must be represented by a patent practitioner except for:
  - Filing an application or submitting a copy of an application when filing by reference,
  - Requesting a filing receipt, and
  - Paying fees.



# Lapsed Patent Practice

- Issue and publication fee due is fixed at the time of allowance.
- Issue and publication fee due is the amount specified in the notice of allowance,
  - Even if there is a subsequent change in either the issue fee or publication fee.



# Extensions in Reexamination

- 37 CFR 1.550(c) is amended to allow for a no-cause, two-month extension of time in patent owner requested or Director ordered ex parte reexamination proceeding.
  - No change to extension of time practice in third party requested ex parte reexaminations.
  - No change to extension of time practice in patent owner requested or Director ordered ex parte reexaminations for extensions of more than two months.



# Antedating-Disqualifying References

- 37 CFR 1.131 amended to simply refer to “the applicant or patent owner.”
  - Change due to the changes to “the applicant” in the oath-declaration provisions of the AIA.
  - Party qualified under former 37 CFR 1.42, 1.43, or 1.47 is the non-inventor applicant in an application filed before September 16, 2012.
  - Party qualified under 37 CFR 1.42 or 1.46 is the applicant in an application filed on or after September 16, 2012.



# Inventor's Oath or Declaration

- AIA Technical Corrections Act permits the USPTO to issue a notice of allowance before the application includes the inventor's oath or declaration
  - AIA 35 U.S.C. 115(f) precluded the USPTO from issuing a notice of allowance until each required inventor's oath or declaration has been filed.



# Inventor's Oath or Declaration

- If applicant is notified in a notice of allowability that each oath or declaration has not been filed,
  - Applicant must file each oath or declaration by the date on which the issue fee is paid to avoid abandonment.



# Applicability Date



# Applicability Date

- PLTIA provisions (other than application filing date and reference filing provisions) apply to:
  - Patents issued before, on, or after December 18, 2013, and
  - Applications for patent pending on or filed after December 18, 2013.
- Application filing date and reference filing provisions of PLTIA apply only to applications filed under 35 U.S.C. 111 on or after December 18, 2013.





# Applicability Date

- Patent term adjustment changes apply only to applications filed under 35 U.S.C. 111 on or after December 18, 2013, and international applications in which the national stage commenced on or after December 18, 2013.
- Oath-declaration changes apply only to applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012.

# THANK YOU



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