

October 29, 2013

## Changes to Implement the Patent Law Treaty



On October 21, 2013 the U.S. Patent and Trademark Office (USPTO) published a Notice of Final Rulemaking to revise its rules of practice to reflect the Patent Law Treaty and title II of the Patent Law Treaties Implementation Act of 2012. See 78 Fed. Reg. 62368. This rulemaking especially impacts four practice areas: (i) filing date requirements; (ii) priority and benefit claims; (iii) revival of abandoned application/delayed maintenance fee payments; and (iv) patent term adjustment. The effective date of this final rule is December 18, 2013.

### Changes to filing date requirements

The final rule makes two changes to the requirements for obtaining a filing date for utility nonprovisional applications: (i) a claim will no longer be required on the filing date; and (ii) a specification and drawing will no longer be required on the filing date if the filing refers to a previously filed application. These changes apply only to patent applications filed under 35 U.S.C. § 111 on or after December 18, 2013.

With respect to claims, the USPTO amended 37 C.F.R. § 1.53(b) to recite that the filing date of a nonprovisional application (other than an application for a design patent) is the date the USPTO receives the specification, with or without claims. The USPTO cautions that filing a claim with a nonprovisional application is preferable because it will help ensure that the application satisfies the disclosure requirements of 35 U.S.C. § 112(a).

The USPTO amended the "incorporation by reference" rule, 37 C.F.R. § 1.57(a), to provide that a nonprovisional application filed without a copy of the specification and drawings will receive a filing date if the application refers to a previously filed application in the application data sheet and indicates that the specification and any drawings of the application are replaced by reference to the earlier application. The reference to the earlier application must specify the application number, filing date, and the intellectual property authority or country in which the earlier application was filed.

The USPTO will treat applications filed without claims or "by reference" to a previously filed application in a manner analogous to pre-existing provisions for treating an application that is missing application parts not required for a filing date. Particularly, if the applicant provides a correspondence address, then the USPTO will notify the applicant and give a time period within which to file the missing parts to avoid abandonment. If the applicant did not provide a correspondence address, then the applicant has three months from the filing date of the application to file the missing parts. It is important to note that when "by reference" applications are abandoned for failure to submit the specification and drawings, the application will be treated as if it was never filed. If this happens, the applicant cannot rely on such a "by reference" application in a benefit claim unless the application is revived.

### Restoration of priority and benefit claims

The final rule provides for restoration of the right of priority to a foreign application (37 C.F.R. § 1.55(c)) and the right to benefit of a provisional application (37 C.F.R. § 1.78(b)). If an applicant unintentionally misses the twelve-month deadline to file an application claiming priority to a foreign application (a six-month period for design applications) or the benefit of a provisional

application, then the applicant will have a two month period to file a petition to restore the priority/benefit claim. Specifically, the applicant must file (i) the application with an application data sheet identifying the application to which priority/benefit is claimed, (ii) a petition fee, and (iii) a statement that the delay in timely filing the application was unintentional. The USPTO cautions that using these provisions as an extension of time is considered an abuse of the revival procedures. These provisions apply to any patent application filed before, on, or after December 18, 2013.

## Revival of abandoned applications and acceptance of delayed maintenance fee payments

Previously, applicants/patent owners could file a petition to revive abandoned applications or terminated reexamination proceedings based on unavoidable delay or unintentional delay under 37 C.F.R. § 1.137. Similarly, patent owners could file a petition to accept a delayed maintenance fee payment based on unavoidable delay or unintentional delay under 37 C.F.R. § 1.378. The USPTO amended these two rules to eliminate the ability to petition based on an unavoidable delay. As such, under the final rule, applicants/patent owners can only petition to (i) revive abandoned applications or terminated reexamination proceedings or (ii) accept a delayed maintenance fee payment based on unintentional delay. These provisions apply to any patent applications filed before, on, or after December 18, 2013, to any patent resulting from an application filed before, on, or after December 18, 2013, and to any reexamination proceeding filed before, on, or after December 18, 2013.

## Changes to patent term adjustment

The final rule revises the patent term adjustment provisions to provide for a reduction of any patent term adjustment if an application is not in condition for examination within eight months of its filing date or of the date of commencement of the national stage of an international application. The purpose for this change is to avoid a situation in which an applicant obtains patent term adjustment because the applicant takes advantage of additional opportunities to delay the examination process, such as the ability to file an application without claims or without a specification by referring to a previously filed application. Specifically, 37 C.F.R. § 1.704(c)(12) recites that the period of adjustment will be reduced by the number of days beginning on the day after the date that is eight months from the filing date (or commencement of the national stage for international applications) and ending on the date that the application is in condition for examination. This provision applies to any patent applications filed on or after December 18, 2013 and international patent applications in which the national stage commenced on or after December 18, 2013.

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