

**From:** Carol Bidwell

**Sent:** Wednesday, May 29, 2013 6:03 PM

**To:** AC85.comments

**Subject:** Comments on proposed rules for Patent Law Treaty implementation

Attached please find my comments for your consideration.

Carol Bidwell

This comment pertains to an omission of a proposed change to 37 CFR 1.412(c)(6) that should have been included in the Notice of Proposed Rulemaking on the Changes to Implement the Patent Law Treaty.

English is the only prescribed language accepted by the USPTO as Receiving Office for filing an international application as set forth in 35 U.S.C. 361(c). International applications filed by US applicants are sometimes based on foreign language priority applications. If an applicant does not have sufficient time to prepare an English translation before the expiration of the Paris Convention priority period, he or she may nevertheless file a non-English international application with the USPTO. In that situation the Office will record the date of submission, accept the international application on behalf of the Receiving Office of the International Bureau (RO/IB) and forward it to RO/IB in accordance with PCT Rule 19.4(a)(ii) upon payment of a fee equal to the transmittal fee. If the requirements of PCT Article 11(1) are met on the date of filing in the USPTO, that date will be accorded by RO/IB as the international filing date. While the international application retains its original filing date, the applicant must submit any responses to invitations issued by the receiving Office and pay various fees (e.g., international filing fee, search fee and transmittal fee) to the RO/IB in Geneva, Switzerland instead of the USPTO. If the language of submission is not a language of publication or a language that the International Searching Authority accepts, the applicant will be required to file a translation of the international application in accordance with PCT Rule 12.

The legislation implementing the Patent Law Treaty includes a change to 35 U.S.C. 361(c) that broadens the scope of the statute by providing that an international application filed with the USPTO “shall be in the English language, or **an English translation shall be filed within such later time as may be fixed by the Director**” [emphasis added]. This change to the statute will allow the USPTO to be a competent receiving Office for international applications that are not filed in English, provided that an English translation is filed at a later time. This change will eliminate the need for the Office to transmit the non-English international application to the RO/IB and to refund fees that were paid to the Office in error as well as the need for the applicant to communicate with RO/IB in Geneva when responding to invitations issued by the RO/IB and to pay fees to the RO/IB. The Notice of Proposed Rulemaking does not include proposed changes to the rules that set forth the later time set by the Director for filing a later English translation for an international application that was filed in the USPTO in a language other than English. One would hope that the failure to propose a change to 37 CFR 1.412(c)(6)(ii) was through an oversight rather than not necessary because the Office is interpreting the phrase “within such later time as may be fixed by the Director” to mean “never”.

It should be noted that if an applicant files a US nonprovisional application under 35 U.S.C. 111(a) in a language other than English, under the provisions of 37 CFR 1.52(d), that applicant will be notified that an English translation is required and given a period of time to file an English translation together with a statement that the translation is accurate and payment of a processing fee set forth in 37 CFR 1.17(i). Now the legislation implementing the Patent Law Treaty allows for the later filing of an English translation of an international application, applicants who file international applications that are not in English with the USPTO should have the same ability to later file an English translation as those that file nonprovisional applications that are not in English.