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DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. 000302057-0057-01]

Request for Comments on Patent Law Treaty

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of request for public comments.

SUMMARY: A Diplomatic Conference for the adoption of the draft Patent Law Treaty will be held at the World Intellectual Property Organization in Geneva, Switzerland, from May 11 through June 2, 2000. The Patent and Trademark Office is seeking comments to obtain views of the public on this effort to simplify the formal requirements associated with patent applications and patents and the consequent changes to United States law and practice. Comments may be offered on any aspect of this effort.

DATES: All comments are due by April 21, 2000.

ADDRESSES: Persons wishing to offer written comments should address those comments to the Commissioner of Patents and Trademarks, Box 4, Patent and Trademark Office, Washington, DC 20231, marked to the attention of Lois E. Boland. Comments may also be submitted by facsimile transmission to (703) 305-8885 or by electronic mail through the Internet to lois.boland@uspto.gov. All comments will be maintained for public inspection in Room 902 of Crystal Park II, at 2121 Crystal Drive, Arlington, Virginia.

FOR FURTHER INFORMATION CONTACT: Lois E. Boland by telephone at (703) 305-9300, by fax at (703) 305-8885 or by mail marked to her attention and addressed to Commissioner of Patents and Trademarks, Box 4, Washington, DC 20231.

SUPPLEMENTARY INFORMATION:

1. Background

Since 1995, the United States has been involved in an effort, carried out under the auspices of the World Intellectual Property Organization, to reduce the formal requirements associated with patent applications and patents in the different countries of the world. This effort has involved five sessions of the Committee of Experts on the Patent Law Treaty and three sessions of its successor, the Standing Committee on the Law of Patents. The objective of the meetings has been to develop a Basic Proposal, consisting of articles and regulations, which will

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minimize the formal requirements associated with patent applications and patents. Upon adoption, these articles and rules will simplify the formal obligations and reduce associated costs for patent applicants and owners of patents in obtaining and preserving their rights in inventions in many countries of the world. The Diplomatic Conference to conclude this effort will take place in Geneva, Switzerland, from May 11 through June 2, 2000.

The texts of the Basic Proposal, notes on the Basic Proposal and other documents relating to the Diplomatic Conference are available via WIPO's web site for the Standing Committee on the Law of Patents at <http://www.wipo.int/scp>.

The United States Patent and Trademark Office (USPTO), leading the negotiations for the United States, is interested in assessing support for the effort and in obtaining comprehensive comments on the particulars of the Basic Proposal. Prior to the previous meetings of the Standing Committee and its predecessor, the Committee of Experts, the USPTO informally solicited and received comments on the then-current drafts of the articles, rules and notes. Additionally, on October 22, 1997, before the fifth session of the Committee of Experts, the USPTO formally solicited comments on the effort via a Federal Register notice. 62 FR 54836. In light of the upcoming conclusion of this effort, the USPTO desires to ensure that the text of the Basic

Proposal for the Treaty is disseminated as widely as possible and that the opportunity to provide comments is correspondingly comprehensive.

Written comments may be offered on any aspect of the Basic Proposal, notes or expected implementation in the United States or elsewhere. Comments are also solicited on the expected benefits to patent applicants and patentees throughout the world of the conclusion and implementation of this Treaty. Comments are also welcome on the following specific issues:

- The substantive and "form or contents" distinctions made in Articles 2 and 6, respectively, that serve to define the freedom of Contracting Parties to impose requirements relating to patent applications and patents;
- The filing date provision in Article 5 and the effect of the "no later than" clause, included in brackets in the Basic Proposal, on the ability of Contracting Parties to be more liberal both for basic filing date issues in Article 5(1) and for missing part-type issues in Article 5(6);
- The reference filing provision in Article 5(7);
- The evidentiary limitation imposed upon Contracting Parties in Article 6(6);
- The exemptions from the ability of a Contracting Party to mandate representation before the Office of that Contracting Party in Article 7(2) and Rule 7(1), with particular reference to the bracketed provisions;
- The application of Article 12 and related Regulations to pending applications and to patents in force on the date the Treaty binds a Contracting Party even where the failure to comply with a time limit occurred prior to that date, as set forth in the bracketed language in Article 21(1)(a); and
- The exceptions available to Contracting Parties for Article 11--Relief in Respect of Time Limits and Article 12--Reinstatement of Rights found in Rule 12(5) and Rule 13(3), respectively.

2. Brief Summary of the Draft Treaty

The Basic Proposal consists of a draft of the Patent Law Treaty (PT/DC/3) and a draft of the Regulations under the Patent Law Treaty (PT/DC/4). Bracketed text, other than for paragraph headings, is not part of the Basic Proposal; it is included in the Basic Proposal for convenience and as an indication of issues for which resolution is expected at the Diplomatic Conference. Explanatory notes on the provisions of the draft Treaty and Regulations are contained in

document PT/DC/5. While the notes are not part of the Basic Proposal, they will be published by WIPO with the text of the Treaty upon adoption of the Treaty. The text of the Basic Proposal includes 26 articles and 21 rules. A brief summary of selected articles and significant associated rules follows. To the extent that a given article is not summarized, it is considered to be self-explanatory. Insofar as this effort is focused upon and limited to formal matters associated with patent applications and patents, the USPTO expects that, upon implementation, changes to our patent law would be minimal. However, to the extent the need for any such change has been identified for a given draft article or rule, it is noted below. This discussion is intended, only, to highlight various articles and rules; it is not intended as a comprehensive treatment of the draft texts. The draft texts should be consulted for a complete understanding of the effort that is under way.

Article 1--Abbreviated Expressions--This article provides definitions for terms used throughout the text of the draft articles and rules.

Article 2--General Principles--Paragraphs (1) and (2) of this article are included for the avoidance of doubt. With regard to paragraph (1), it should be noted that the flexibility of a Contracting Party is limited in the context of Article 5, the filing date provision. Paragraph (2) is important to emphasize that the Treaty and regulations cannot be construed to limit the freedom of Contracting Parties concerning substantive law relating to patents. This latter issue also arises in the context of Article 6 where the "form or contents" requirements of the Patent Cooperation Treaty are, except as otherwise provided in the Treaty and regulations, incorporated as the maximum formal or non-substantive, requirements to which a Contracting Party may require compliance.

Article 3--Applications and Patents to Which the Treaty Applies--This article defines the scope of the Treaty by virtue of the types of applications and patents that are encompassed by its terms. As mentioned above, the issue of the application of the Treaty to existing applications and patents, covered in Article 21, should also be noted, especially concerning the bracketed provision in Article 21(1)(b).

Article 4--National Security--This article preserves the right of Contracting Parties to apply measures deemed necessary for the preservation of national security. A similar provision appears in PCT Article 27(8).

Article 5--Filing Date--This article is viewed by the United States as one of the more important features of the Basic Proposal. It mandates that a Contracting Party must provide a filing date for an

application as of the date on which its Office has received the following elements:

- (i) An indication that submitted elements are intended to be an application;
- (ii) Indications allowing the identity of the applicant to be established or allowing the applicant to be contacted; and
- (iii) A description.

This filing date requirement is fairly minimal and would greatly simplify the conditions imposed upon the grant of filing dates to patent applications throughout the world. Note that this article would mandate the acceptance, for filing date purposes, of patent applications in any language, subject to the furnishing of later translations. The USPTO has supported this article, with the knowledge that our claim requirement, for filing date purposes, in section 111(a) of title 35, United States

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Code, would have to be deleted. Note that such a requirement is not included for provisional applications filed under section 111(b) of title 35, United States Code. The United States has also supported the retention of the bracketed phrase "no later than" throughout this article as it will provide Offices needed flexibility on filing date and missing part issues.

Article 6--Application--This article is another of the more important features of this effort. It mandates that no Contracting Party may impose any requirement relating to the form or contents of an application which is different from or additional to any requirement applicable under the Patent Cooperation Treaty (PCT) in respect of international applications or those requirements relating to form or contents, compliance with which may be required once national processing has begun. In essence, this article states that, except as otherwise provided, if an applicant submits an application to a national office that complies with the requirements of the PCT, that national office can impose no different or additional form or contents requirements on that national application. Of course, as Article 2(1) makes clear, Contracting Parties would be free to impose requirements that are more favorable, from an applicant's perspective, than this Treaty or the PCT. Of note, the incorporation of the "form or contents" requirements from the PCT into this article would mandate the application of the PCT unity of invention standard for all national applications. The USPTO has taken exception to this view insofar as unity of invention is considered to be a substantive matter that is

outside the scope of this effort. Nevertheless, Article 22(1) would permit the United States to take a reservation on this issue.

Article 7--Representation--This article addresses requirements regarding representation, mandatory representation and appointment of representatives. Importantly, Article 7(2) provides that Contracting Parties may not mandate representation for filing date purposes, for the payment of maintenance fees or notifications relating thereto. Certain bracketed provisions are also included that would have the effect, if adopted, of expanding the exceptions to mandatory representation, including: any procedure referred to in the filing date provision (Article 5), the payment of fees, the filing of translations and any other procedure as prescribed in the regulations. The United States has consistently supported maximizing the exceptions in this article and Rule 7(1).

Article 8--Communications; Addresses--This article provides the basis upon which Contracting Parties may impose requirements relating to the form, format and means of filing of communications. Note that paragraph (1)(d) mandates that Contracting Parties must, even if they eventually and exclusively adopt electronic filing, accept the filing of communications on paper for the purpose of complying with a time limit. This article also addresses signature issues in paragraph (4). Note Rules 8 through 11 for details regarding these issues.

Article 9--Notifications--This article allocates burdens relating to the sufficiency of notification and the provision of contact information among Contracting Parties and prospective recipients of notifications.

Article 10--Validity of Patent; Revocation--This article, in paragraph (1), mandates that once a patent has been granted, it may not be revoked or invalidated on the ground of non-compliance with certain formal requirements enunciated in Article 6. In paragraph (2), the obligation to provide at least one opportunity to make observations on intended revocation or invalidation is mandated.

Article 11--Relief in Respect of Time Limits--This article, with Rule 12, requires that the Offices of all Contracting Parties must provide either extensions of time limits (similar to practices in the USPTO under 37 CFR 1.136) or continued processing (similar to practices provided for in the context of the European Patent Convention) for time limits fixed by the Office. This article and the associated rule do not necessarily apply to time limits that are not fixed by the Office, in particular, time limits set by national law. The possible exceptions to the requirements of this article that are set forth in Rule 12(5) should be noted.

Article 12--Re-instatement of Rights After a Finding of Due Care or

Unintentionality by the Office--This article, with Rule 13, requires that all Contracting Parties must provide for the re-instatement of rights where an applicant or owner has failed to comply with a time limit and that failure has the direct consequence of causing a loss of rights with respect to an application or patent. In the United States, the practice that is embraced by this article is found in our revival procedures under 37 CFR 1.137. The possible exceptions to the requirements of this article that are set forth in Rule 13(3) should be noted.

Article 13--Correction or Addition of Priority Claim; Restoration of Priority Right--Paragraph (1) provides for the correction or addition of a priority claim to an earlier application where a subsequent application is timely filed. Paragraph (2) provides for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period. The United States currently permits correction and late claiming of priority and supports the concept of accepting the delayed filing of a subsequent application. The acceptance of delayed filing of a subsequent application would require an amendment to section 119 of title 35, United States Code.

Article 14--Regulations--This article provides a basis for all matters which the Treaty expressly provides as being "prescribed in the Regulations," for details useful in the implementation of the Treaty and for administrative requirements, matters or procedures. The article also provides a basis for the rules relating to recordation of change in name or address, recordation of change in applicant or owner, recordation of a licensing agreement or security interest and correction of a mistake. There are no longer article provisions for these matters as the level of detail contained in the former articles was considered more appropriate for the rules. This article also provides a basis for certain administrative matters relating to the amendment of the rules, requirement of unanimity and resolution of conflicts between the Treaty and the regulations.

Articles 15 through 26, and associated Rules--These articles are considered the Administrative and Final provisions of the Treaty and are, for the most part, self-explanatory. Many of the provisions are modeled after those employed in other recently adopted treaties such as the Geneva Act of the Hague Agreement, the Trademark Law Treaty, the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty. Article 21 should be noted, including the bracketed provision in paragraph (1)(b), as it relates to the application of the Treaty to existing applications and patents. Rule 21 should be noted as it relates to the requirement of unanimity for amending certain rules

under Article 14(3).

Dated: February 25, 2000.

Q. Todd Dickinson,

Assistant Secretary of Commerce and Commissioner of Patents and
Trademarks.

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