

Patent Law Treaty (PLT)



Patent Law Treaties Implementation Act of 2012 (PLTIA)

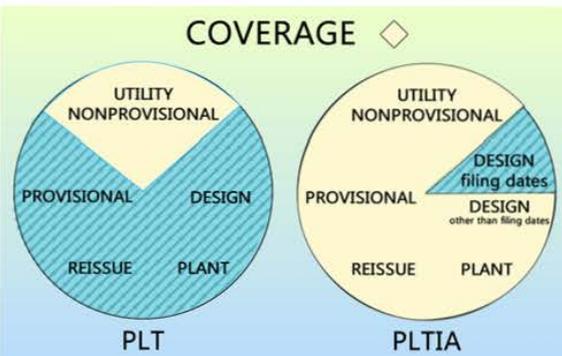
- ◆ Minimal application filing date requirements
- ◆ Reference filing
- ◆ Restoration of patent rights
- ◆ Restoration of priority rights
- ◆ Minimum 2 month reply periods for most situations



The Patent Law Treaty (PLT) harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications. The PLT does not concern substantive conditions of patentability.

Title II of the Patent Law Treaties Implementation Act of 2012 (PLTIA) amends the U.S. patent laws for consistency with the requirements of the PLT. The notable changes to the U.S. patent laws resulting from the PLT and PLTIA pertain to:

- (1) the filing date requirements for a patent application;
- (2) the restoration of the right of priority to a foreign application in an application filed after the expiration of the priority period; and
- (3) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments.



- ◆ Filing Date (non-Design) = Date USPTO receives a specification with or without claims
- ◆ No claims or drawings required to establish Filing Date
- ◆ If no claims at filing, Office notice and late filing surcharge to avoid abandonment
- ◆ Claims or drawings filed after Filing Date must be supported under 35 USC 112(a) in application as filed
- ◆ Any drawings necessary to understand invention will be required during examination

BEST PRACTICE TIP:

The drafting of claims and preparation of drawings at the time an application (provisional or nonprovisional) is prepared for any claimed invention for which patent protection is desired and inclusion of such claims and drawings with the application will help ensure that the application will contain an adequate disclosure under 35 U.S.C. 112 and drawings under 35 U.S.C. 113.

The filing date of a design application is the date on which the USPTO receives the specification as prescribed by 35 U.S.C. 112, which includes at least one claim as prescribed by 35 U.S.C. 112(b), and any required drawings.

8 months

Patent term adjustment is reduced if an application is not in condition for examination within eight months from either the date on which the application was filed or the date of commencement of the national stage in a PCT application.

The PLT provides for a reply time period of at least two months in many situations. The USPTO will provide a period for reply of at least two months for replies to Office actions for applications not involved in voluntary pilot programs or in proceedings before the PTAB.

The PLTIA eliminates "lapsed patent" practice. The issue fee due will be the issue fee specified in the notice of allowance, regardless of the issue fee amount in effect on the date the issue fee is paid.

REFERENCE FILING



A nonprovisional application may be filed by a reference in the ADS (or PLT Model International Request Form) to a previously filed application (foreign, international, provisional, or nonprovisional).



Unless the previously filed application is a US or PCT application, applicants filing by reference must also file a certified copy of any previously filed application 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.

- (1) specify the previously filed application by
 - application number
 - filing date
 - intellectual property authority or country in which the previously filed application was filed

- (2) indicate that the specification and any drawings of the application being filed are replaced by the reference to the previously filed application.

The application number, filing date, and country or IPA of filing indicated in a reference filing must be correct or the application will not include the intended disclosure.

USPTO will notify applicant to timely file:

- a copy of the specification and drawings from the previously filed application
- an English translation of the previously filed application and translation fee if not in English
- late filing surcharge

If the application is abandoned for failure to meet these requirements, the application is treated as having never been filed, unless it is revived and a copy of the specification and any drawings of the previously filed application are filed.

BEST PRACTICE TIP:

Reference filing is not considered a best practice and should be used only when a copy of the specification and drawings of the previously filed application are not available.

RESTORATION OF PRIORITY RIGHTS

Applications filed after expiration of the 12 month (6 month for designs) period for filing an application claiming the benefit of a prior foreign application can have the right of priority restored if the delay in filing the subsequent application was unintentional.

Applications filed after expiration of the 12 month period for filing an application claiming the benefit of a prior provisional application can have the right of priority restored if the delay in filing the subsequent application was unintentional.

The subsequent application must be filed within 2 months of the expiration of the 12 month/6 month period.

A petition including the foreign priority claim or specific reference to the provisional application, petition fee and a statement that the delay was unintentional is required.

RESTORATION OF PATENT RIGHTS

Eliminates "unavoidable" delay standard as a basis for reviving an abandoned application, accepting a delayed patent owner response in reexamination, or accepting an unintentionally delayed maintenance fee payment.

A single standard (unintentional delay) and petition fee for reviving an abandoned application, accepting a delayed patent owner response in reexamination, and accepting a delayed maintenance fee payment.

Eliminates 24 month time period requirement for petitions to accept an unintentionally delayed maintenance fee payment.