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Via Electronic Mail
AC85.comments@uspto.gov

The Honorable Teresa Stanek Rea
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and Acting Director of the United States Patent and Trademark Office
Mail Stop Congressional Relations
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ATTN: Robert W. Bahr

Re: Comments regarding: *Changes to Implement the Patent Law Treaty*,
78 Fed. Reg. 21788 (Apr. 11, 2013)

Dear Acting Under Secretary Rea:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to provide comments in response to the request the United States Patent and Trademark Office (the "Office" or the "USPTO") published in the Federal Register 78 Fed. Reg. 21788 (Apr. 11, 2013) (the "Federal Register Notice"), entitled "Changes to Implement the Patent Law Treaty."

These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section generally supports the USPTO's efforts to implement the Patent Law Treaty ("PLT") through the three major changes described in the Federal Register Notice. Namely, these changes to the PLT and title II of the Patent Law Treaty Implementing Act of 2012 ("PLTIA") concern:

(1) The filing date requirements for a patent application; (2) the restoration of patent rights via the revival of abandoned applications and acceptance of delayed maintenance fee payments; and (3) the restoration of the right of priority to a foreign application or the benefit of a provisional application via the permitting of a claim to priority to a foreign application or the benefit of a provisional application in a subsequent application filed within two months of the expiration of the twelve-month period (six-month period for design applications) for filing such a subsequent application.

78 Fed. Reg. 21788 (Apr. 11, 2013). Each of these proposed changes are addressed below.

We note that the requirements for obtaining a filing date for a patent application will change in two ways. First, 35 U.S.C. § 111(a) will be amended to allow a nonprovisional utility patent application “with or without claims” to be assigned a filing date. Second, 35 U.S.C. § 111(c) will be amended to allow a reference to a previously filed application to replace the description and any drawings of the subsequent application when the reference is made at the time of filing the subsequent application.

The Section supports the amendment to § 111(a) that will allow the assignment of a filing date to a non-provisional utility patent application which does not contain any claims at the time of filing; provided that all filing requirements are satisfied within a prescribed time limit. Like the fee, oath, or declaration, at least one claim must be submitted, if not at the time of filing, then within a prescribed timeframe. Because 35 U.S.C. § 112 requires the invention to be described in the specification, claims can be formulated from language in the specification at any time before grant of the application. Even under current law, an application can be filed with a single claim, and additional claims can be added at any time before grant of the application. This proposed change to § 111(a) simply allows more flexibility for the applicant by allowing him to obtain a filing date for an application without even one claim, and subsequently define the scope of the claimed invention by submitting claims. It is reasonable to align the requirements for obtaining a filing date for nonprovisional utility applications with those for provisional applications.

New § 111(c) provides for the filing of a nonprovisional application “by reference” to a previously filed application in lieu of filing the specification and drawings, treating such application similarly to an application with missing parts that are not required for obtaining a filing date. The Section favors that, in the case of a derivative filing either in the same country or a different country which corresponds to a previously filed application, a filing date will be awarded on request, together with a submission of an identifying reference to the previously filed application; provided that all filing requirements are satisfied within a prescribed time limit.

It is noted by the Office that the proposals for obtaining a filing date without any claims or by reference to a previously filed application may cause delay in the examination of an application. Thus, the Office proposes revising the patent term adjustment rules such that patent term adjustment is reduced if an application is not in condition for examination within eight months of its filing date (or date of commencement of national stage in an international application).

Understandably, the Office needs to understand the scope of the claimed invention in order to begin examination and respond to the applicant within fourteen months of filing. Thus, a practical need exists for submitting one or more claims within a reasonable timeframe to allow this examination. Furthermore, public policy supports a requirement to complete the submission: such delay leads to less certainty for the public regarding the invention. Given these needs, incentivizing submission of claims and missing parts within a reasonable timeframe is appropriate and necessary, and eight months is a reasonable timeframe to allow for compliance. Further delay should be discouraged. The Section supports the proposal to revise the period of patent term adjustment set forth in 37 C.F.R. § 1.703 to be reduced for this delay. The time for reduction should begin the day following eight months from the date on which either (1) the application was filed under 35 U.S.C. § 111(a) or (2) the application commences the national stage, and should end on the date the application is in condition for examination, as described in the proposed rules.

The second group of major changes for implementation of the PLT relates to “unintentional” delay on the part of the applicant. The Office proposes revising the rules of practice to provide for the revival of abandoned applications and acceptance of delayed maintenance fee payments solely on the basis of “unintentional” delay. Further, the PLTIA eliminates the provisions of the patent statutes relating to revival of abandoned applications or acceptance of delayed maintenance fee payments on the basis of a showing of “unavoidable” delay.

The Section favors the reinstatement of rights with respect to an application or patent following failure to comply with a time limit for an action in a procedure before the Office and that failure had the direct consequence of causing a loss of rights with respect to an application or patent, wherein such reinstatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or was unintentional. Additionally, we suggest that any exceptions to this right of reinstatement be limited as much as possible. Further, we support the removal of the revival of abandoned applications or acceptance of delayed maintenance fee payments on the basis of a showing of “unavoidable” delay, which is merely a form of unintentional delay.

The Honorable Teresa Stanek Rea
U.S. Patent and Trademark Office
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The third set of major changes pertains to priority and benefit claims—restoring the right of priority to a prior-filed foreign application and restoring the right to benefit of a prior-filed provisional application. Per the proposed changes, if a subsequent application is filed after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in 35 U.S.C. § 119(a), but within two months from the expiration of that period, the right of priority in the subsequent application may be restored by filing a petition and paying the applicable fee so long as the delay in filing the subsequent application was unintentional. Regarding a prior-filed provisional application, if the subsequent application is filed after the expiration of the twelve-month period set forth in 35 U.S.C. 119(e), but within two months from the expiration of that period, the benefit of the provisional application may be restored by filing a petition and paying the applicable fee so long as the delay was unintentional.

The Section supports the proposed changes for restoring the right of priority for a period not to exceed two months when the failure to file a claim of priority during the priority period was due to unintentional delay. We favor an applicant having the ability to correct or add a priority claim, on or after the filing date, to an application which could have claimed the priority of such earlier application but did not do so within a prescribed time limit. Particularly, we favor restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within a period of not more than two months thereafter, and where the failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken, or was unintentional.

The Section applauds the USPTO's efforts to implement the Patent Law Treaty which harmonizes certain procedures for the filing of patent applications. We appreciate the opportunity to review and comment on the proposed changes which provide greater flexibility to applicants.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,



Joseph M. Potenza
Section Chair
American Bar Association
Section of Intellectual Property Law