

**DANEKER, McINTIRE, SCHUMM,
PRINCE, MANNING & WIDMANN, P.C.**

**Attorneys at Law
One N. Charles St., Suite 2450
Baltimore, Maryland 21201
Telephone (410) 649-4747
Facsimile (410) 649-4758**

*Brooke Schumm III
Direct Dial (410) 649-4761*

June 6, 2013

Via e-mail-AC85.comments@uspto.gov
Robert W. Bahr, Senior Patent Counsel
Office of Patent Examination Policy
Mail Stop Comments-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Comment focused on Restoration of Priority and Standards of PLT:

Dear Mr. Bahr:

Summary:

The Patent Law Treaty (“PLT”) has two standards for restoration of priority. As pointed out at 78 Fed. Reg. 21972 (April 11, 2013), “PLT Article 12 provides for reinstatement of rights on the basis of unintentional delay (or alternatively if the failure occurred in spite of due care). The United States, in the Patent Law Treaty Implementation Act (“PLTIA” or the “Act”), elected to use the standard of unintentional delay.

The U.S. Patent and Trademark Office has had a general objective of attempting to harmonize international practice. The Leahy-Smith American Invents Act (“AIA”), which notably moved the United States to a first-to-file jurisdiction, is an example of implementing this objective.

Unfortunately, many major patent offices, most notably the European Patent Office (“EPO”), require, in order to obtain restoration of priority, that there be a showing of a failure to timely file in spite of due care. Thus, U.S. provisional application applicants who failed to file a PCT application or a national stage section 111 application within 12 months of their provisional application date, in order to preserve benefit of their priority date under U.S. law, for U.S. purposes, would merely have to make a statement, under penalty of perjury, that the failure to timely file was unintentional. However, such a statement would not be adequate for EPO purposes and might in fact prejudice the proof needed to show “a failure to timely file in spite of due care.” Thus, an applicant who met the U.S. standard would either have to surmount a second hurdle in the EPO to meet its due care standard, or based on evidence and statements given, have effectively foreclosed any restoration of priority for EPO purposes.

**DANEKER, McINTIRE, SCHUMM,
PRINCE, MANNING & WIDMANN, P.C.**

Robert W. Bahr, Senior Patent Counsel

June 6, 2013

Page 2

Because the unavoidably abandoned standard of current U.S. law is not in the PLT, the objective of this comment and the proposed draft rule below is to give U.S. applicants an opportunity to use the “exceptional circumstances” provision of the statute coming into force, 35 U.S.C. §41(a)(7), as the equivalent of the “failure to timely file in spite of due care” standard.

Posit the following simple example: An individual inventor/ applicant files an application in the United States on February 1, 2014, after the implementation of the PLT. Absent restoration of the right of priority, if that inventor fails to file a PCT application or a U.S. national state application by February 1, 2015, no claim may be made for benefit of the February 1, 2014 date. On January 27, 2015, the inventor dies. No application has been filed. A personal representative/executor is appointed several weeks later and it comes to that fiduciary’s attention that there had been an invention and a provisional application on file. Most surely, under the law of most countries, and certainly, U.S. law, such delay in filing by the fiduciary in the place of the deceased applicant for restoration (so long as it occurred by April 1, 2014) would be considered as meeting the “unavoidable delay” standard, the “failure to timely file in spite of due care” standard, and of course, the “unintentional” standard. A power outage in a city or force majeure event such as Hurricane Sandy would also seem to be eligible for the “exceptional circumstances”

Conclusion:

The commentator believes that applicants should be given the option of filing a petition on the basis of “exceptional circumstances” which the USPTO would interpret as including and meeting the PLT standard of “failure to timely file in spite of due care.” Otherwise, applicants would be forced to file in the International Bureau to handle the standard correctly (if they were astute enough to understand the complexity of the course they may embark upon by merely claiming that the failure to timely file was “unintentional”). This comment should apply to all requests for restoration of priority, but the most important is the 12 month provisional application benefit rule. A draft rule is presented:

Proposed Rule §1.55(c) with subparagraphs to be re-numbered accordingly:

The present text of §1.55(b) being re-used is shown in italics and the new language to address the above comment is underlined (cross-outs indicate where the sense of the text is switched from “unintentional” to “exceptional circumstances”):

(c) Time for filing subsequent application and restoration of priority based on exceptional circumstances.

(1) If the subsequent application has a filing date which is after the expiration of the twelve-month period (six-month period in the case of a design application) set forth in paragraph (b)(1) of this section but within two months from the expiration of the period set forth in paragraph

**DANEKER, McINTIRE, SCHUMM,
PRINCE, MANNING & WIDMANN, P.C.**

Robert W. Bahr, Senior Patent Counsel

June 6, 2013

Page 3

(b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application or upon petition if the delay in the subsequent application within the period set forth in paragraph (b)(1) of this section was ~~unintentional~~ as the result of exceptional circumstances within the meaning of 35 U.S.C. 41(a)(7), which shall be interpreted by the Director to include, for purposes of this subparagraph, failure to timely file in spite of due care as referenced in PCT Rule 26 bis.3, as well as being unintentional . A petition to restore the right of priority under this paragraph filed in the subsequent application must include:

(i) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(ii) The petition fee as set forth in § 1.17(m); and

(iii) A statement that the delay in filing the subsequent application within the twelve-month period (six-month period in the case of a design application) as set forth in paragraph (b)(1) of this section was ~~unintentional~~ as a result of exceptional circumstances, including failure to timely file in spite of due care and, accordingly, unintentional. The Director may require additional information where there is a question whether the delay was ~~unintentional~~ a result of exceptional circumstances or unintentional.

(2) Upon a finding of exceptional circumstances, pursuant to 35 U.S.C. 41(a)(7), the petition fee shall be refunded.

The views expressed in this Comment are my own and not those of my firm, any client of the firm, or of any organization of which I am a member, particularly the American Intellectual Property Law Association (AIPLA) which is submitting its own comment. I am very familiar with the importance of the issue discussed in this letter because I am Vice-Chair of the PCT Issues Committee of the AIPLA and have been the observer for the AIPLA to the PCT Working Group in Geneva, Switzerland and participated actively in the meeting; again, that said, my views in this comment are strictly my own.

In addition, on behalf of the AIPLA, I had earlier prepared the comment to PCT Circular 1372 dealing with the "unintentional" and "failure in spite of due care" standards to be applied under the PLT by the International Bureau at WIPO. On request to the AIPLA, the comment to WIPO should be available to the USPTO. I refer the USPTO's attention to PCT Circular 1372 which is currently being drafted by the World Intellectual Property Organization.

**DANEKER, McINTIRE, SCHUMM,
PRINCE, MANNING & WIDMANN, P.C.**

Robert W. Bahr, Senior Patent Counsel

June 6, 2013

Page 4

Thank you for your attention.

Sincerely,

/s//Brooke Schumm III

/BSIII/

Brooke Schumm III