

***EFFECTS OF
GATT AND NAFTA
ON
PTO PRACTICE***



EFFECTS OF GATT AND NAFTA ON PTO PRACTICE

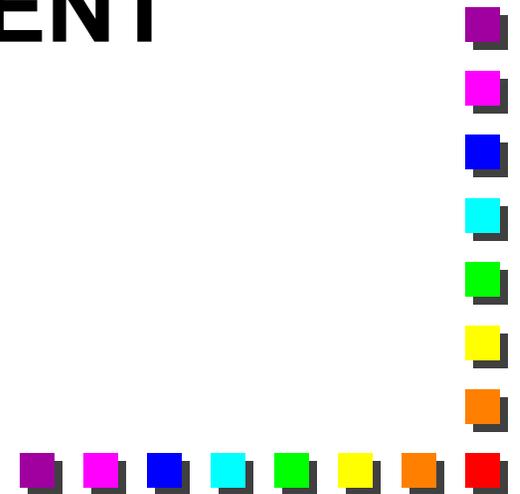
20-YEAR PATENT TERM

- **EXISTING AND FUTURE PATENTS**
- **TRANSITION PROCEDURES**
- **TERM EXTENSIONS**

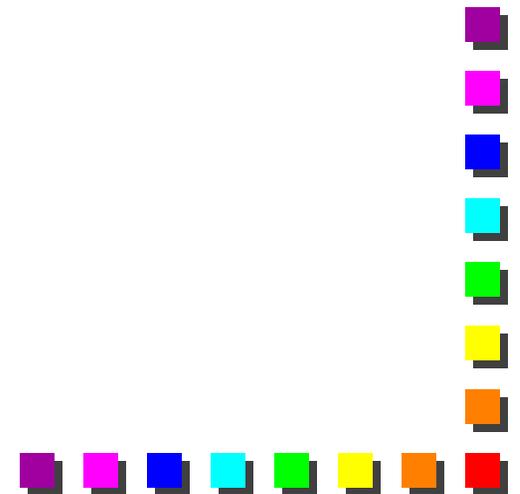


EFFECTS OF GATT AND NAFTA ON PTO PRACTICE

**INTRODUCTION OF A
PROVISIONAL APPLICATION
DATE OF INVENTION FOR
OBTAINING A PATENT**

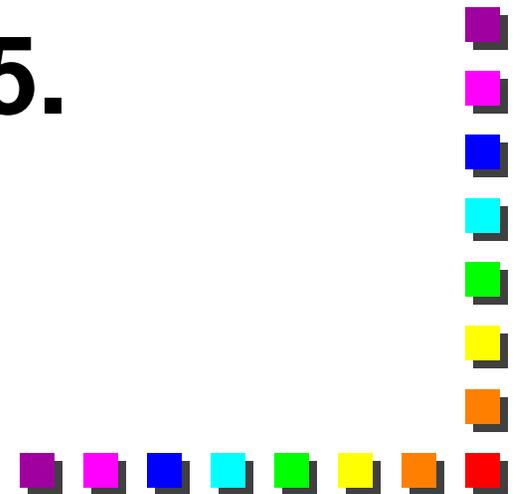


20 YEAR PATENT TERM



NOTICE:

**PROPOSED RULES AT
59 FR 63951
DECEMBER 12, 1994, AND
1170 OG 377
JANUARY 3, 1995.**



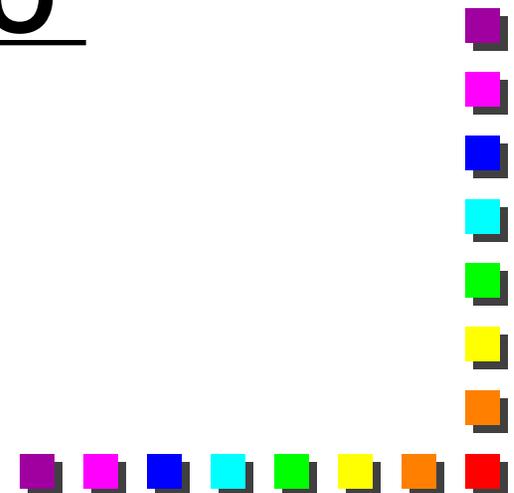
20 YEAR PATENT TERM

UTILITY PATENTS- YES

PLANT PATENTS- YES

DESIGN PATENTS- NO

REMAIN 14 YEAR TERM



BENEFITS OF THE 20 YEAR TERM:

**MOST PATENTS WILL HAVE A
LONGER PATENT TERM THAN
THE CURRENT 17 YEAR PATENT
TERM**

**NOTE: THE CURRENT AVERAGE
PENDENCY OF AN APPLICATION
FROM DATE OF FILING TO FINAL
DISPOSITION IS 19.0 MONTHS**



**MAKING NOTE OF THIS AVERAGE
PENDENCY OF 19.0 MONTHS, AN INVENTOR
WOULD RECEIVE A PATENT TERM OF 18
YEARS AND 5 MONTHS VERSUS THE
PRESENT SYSTEM OF 17 YEARS**

**THE TECHNOLOGY AVERAGES ARE AS
FOLLOWS**

ELECTRICAL APPLICATIONS: THE PENDENCY
AVERAGE IS 22.2 MONTHS

MECHANICAL APPLICATIONS: THE PENDENCY
AVERAGE IS 17.7 MONTHS

CHEMICAL APPLICATIONS: THE PENDENCY
AVERAGE IS 19.7 MONTHS

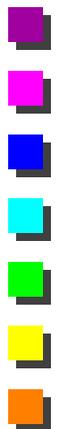
BENEFITS OF THE 20 YEAR TERM:

PROMOTES PROMPT PROSECUTION

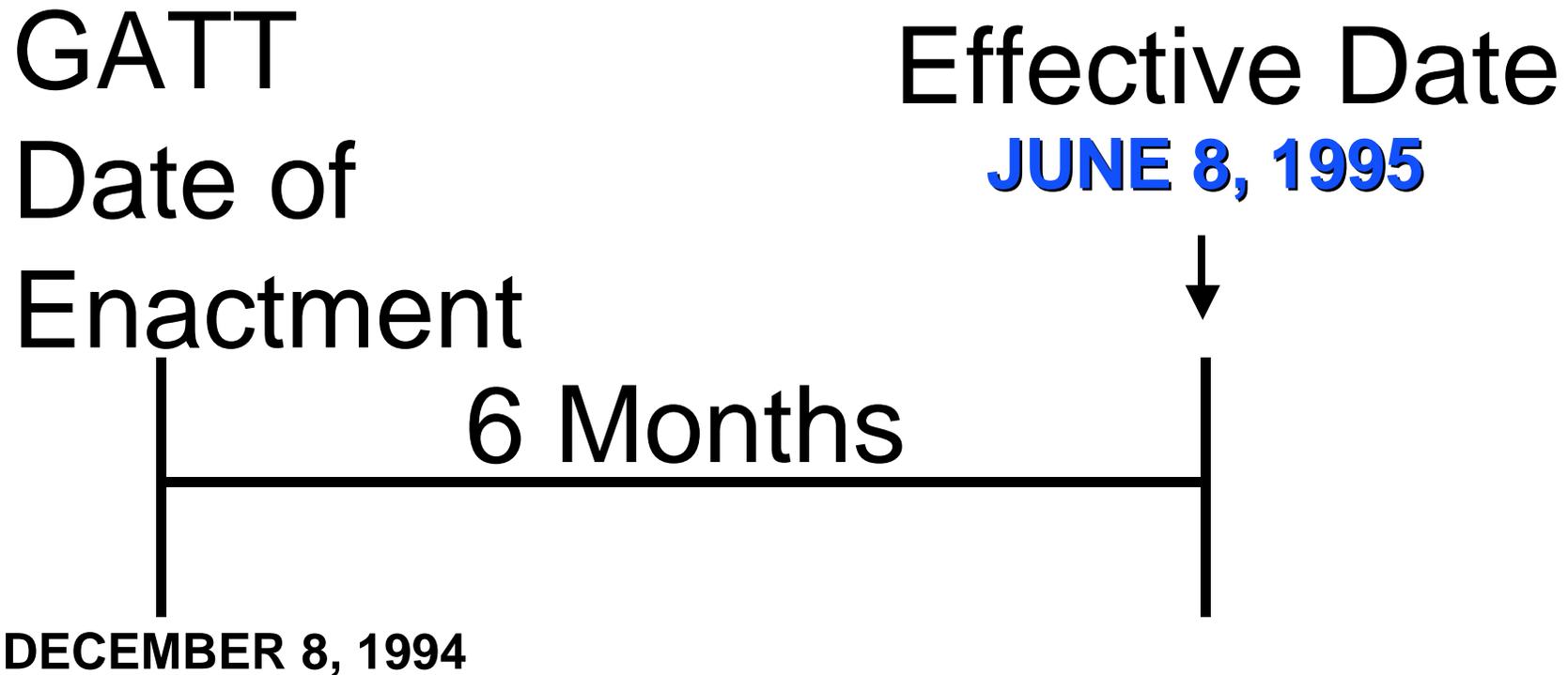
**DISCOURAGES “SUBMARINE” PATENTS THAT
EXIST DUE TO INTENTIONALLY EXTENDED
PROSECUTION**

**MAINTAINS PRESSURE ON PATENT
COMMUNITY TO KEEP PENDENCY DOWN**

**ENCOURAGES INVENTORS TO PROMPTLY
OBTAIN A PATENT TO MAXIMIZE THEIR
EXCLUSIVE RIGHTS**



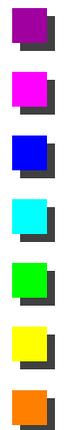
20-YEAR PATENT TERM APPLICATIONS AFFECTED



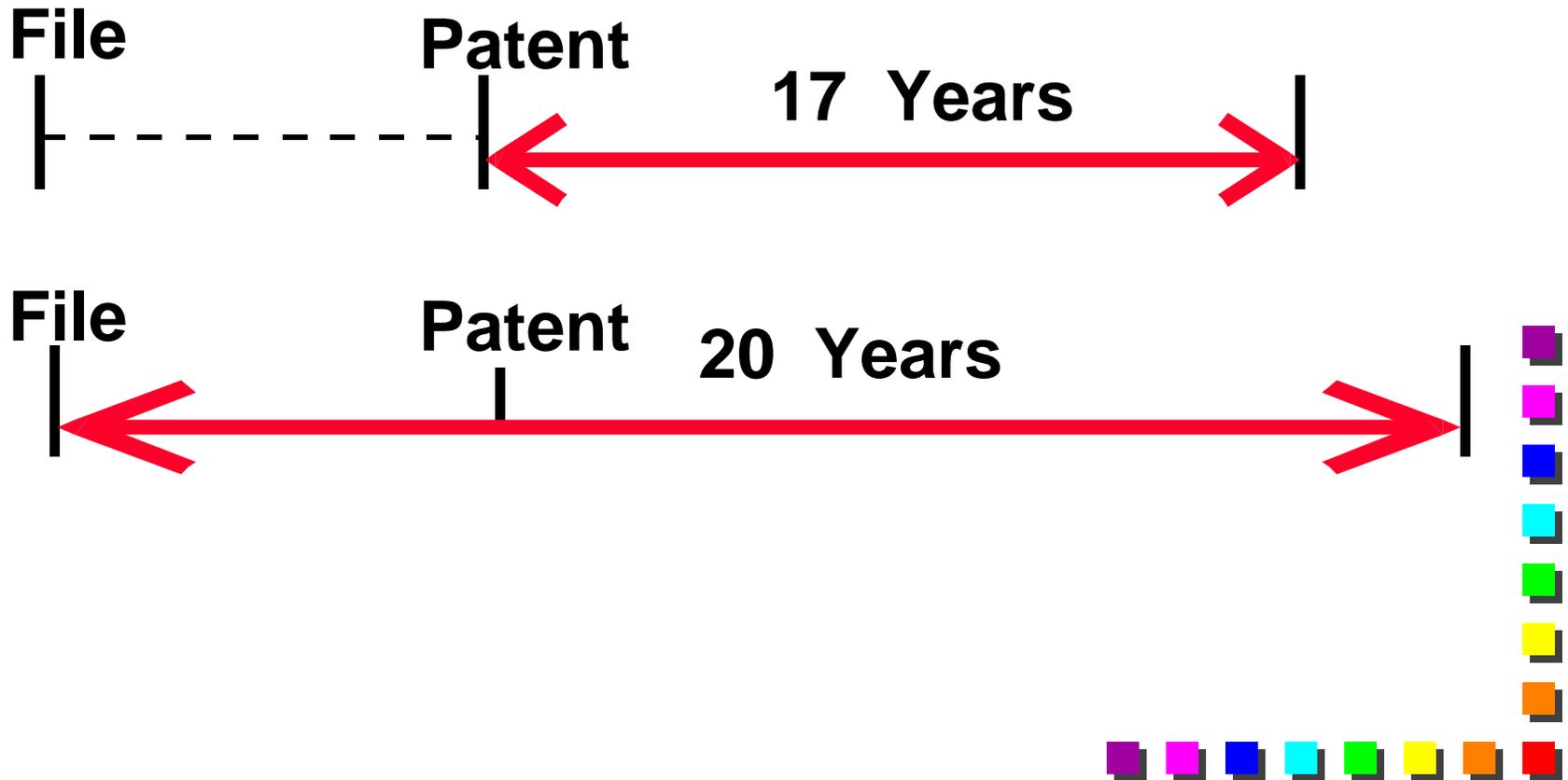
**ALL APPLICATIONS FILED ON
OR AFTER JUNE 8, 1995**

20 YEAR PATENT TERM

STARTS FROM THE
ISSUE DATE , AND,
ENDS 20 YEARS FROM
THE DATE OF FILING



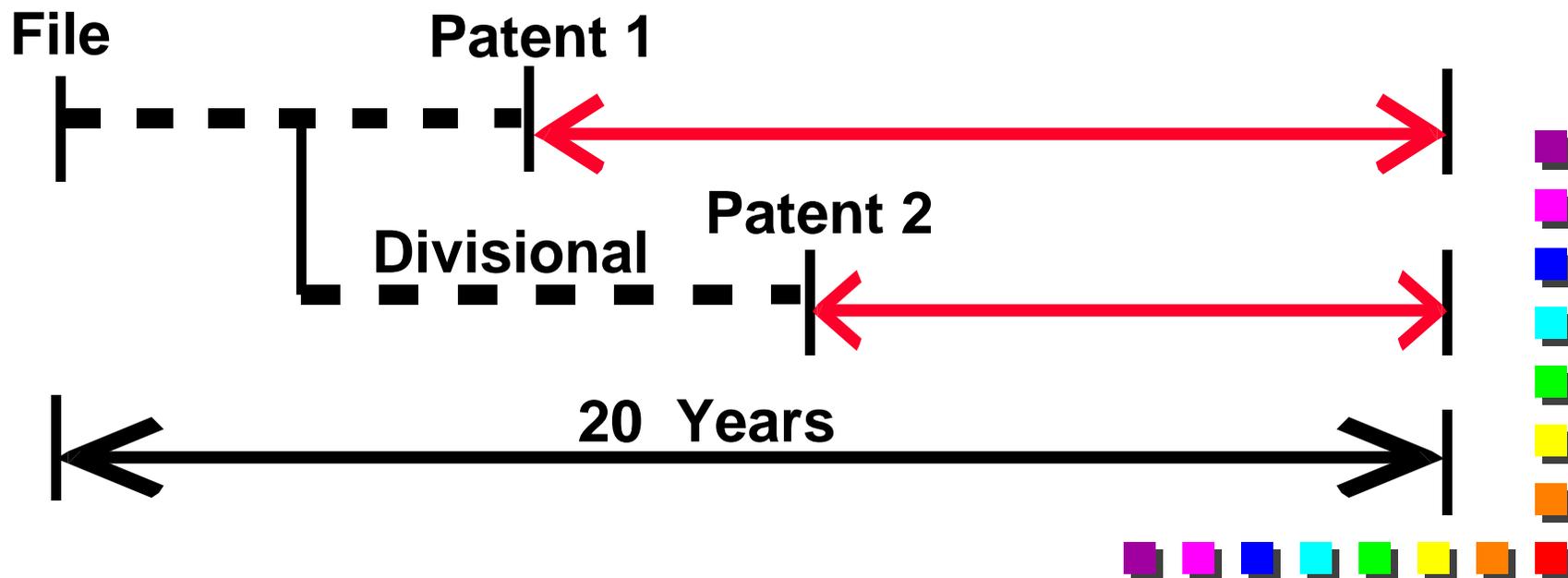
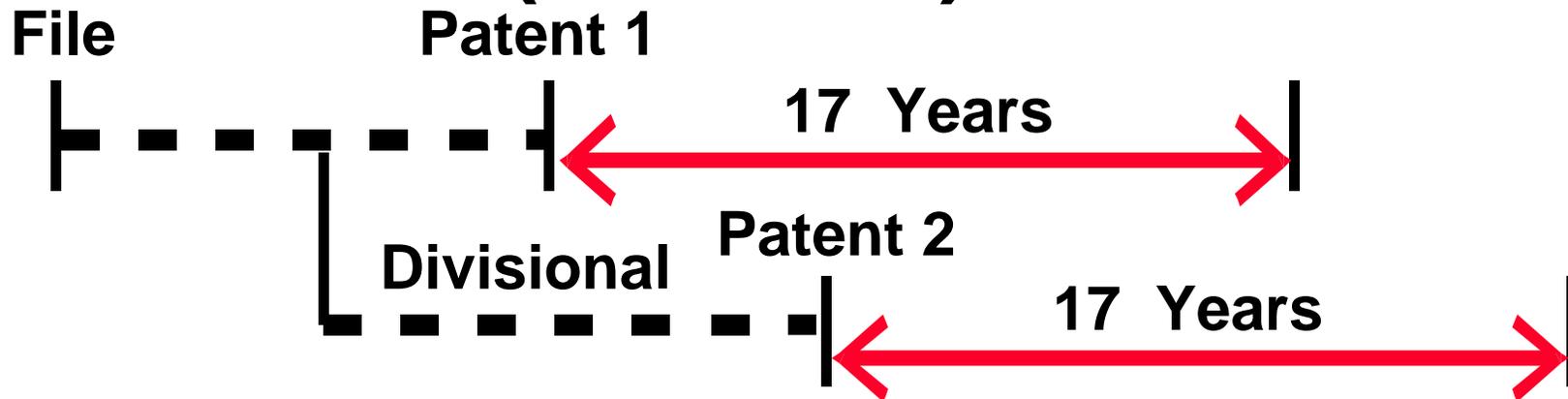
CONTRAST (17 VS 20)



FILING DATE (20 YEAR PATENT TERM)

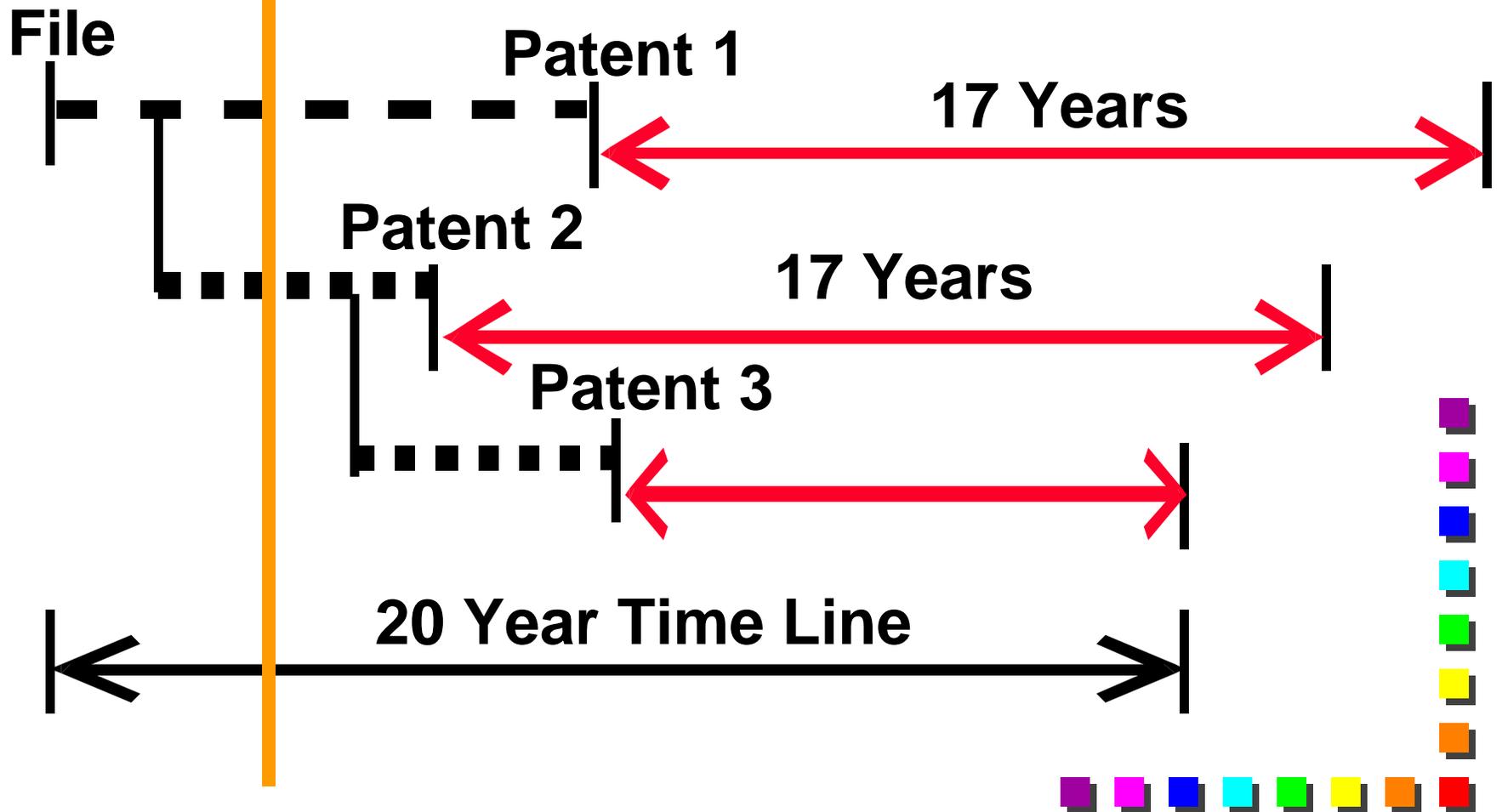


Contrast (17 vs 20) Divisional



20 YEAR PATENT TERM IMPLEMENTATION

Effective Date
JUNE 8, 1995



TRANSITION PROCEDURES

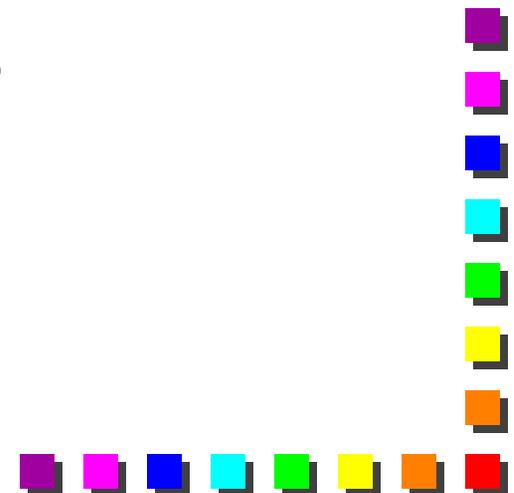
AFTER-FINAL PRACTICE

RESTRICTION PRACTICE



TRANSITION AFTER-FINAL PRACTICE
(proposed rule 129)

**AFFECTS ONLY THOSE
APPLICATIONS FILED AS OF
JUNE 8, 1995 AND HAVING
U.S. EFFECTIVE DATE ON OR
PRIOR TO JUNE 8, 1993**



TRANSITION AFTER-FINAL PRACTICE (proposed rule 129)

APPLICANT ENTITLED TO TWICE HAVE A
SUBMISSION AFTER FINAL, THAT WAS NOT
INITIALLY ENTERED BY THE EXAMINER,
ENTERED AND CONSIDERED

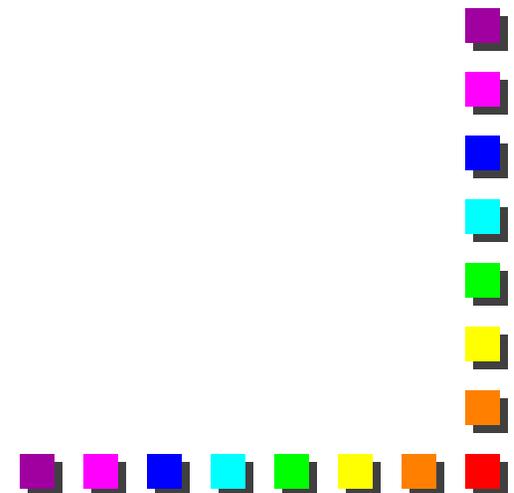
PAYMENT OF FEE AFTER NOTICE OF
NON-ENTRY

IF SUBMISSION IS FILED PRIOR TO OR
WITH NOTICE OF APPEAL



TRANSITION AFTER-FINAL PRACTICE (proposed rule 129)

A SUBMISSION MAY INCLUDE
INFORMATION DISCLOSURE
STATEMENT
AMENDMENTS
NEW EVIDENCE
NEW ARGUMENTS



TRANSITION AFTER-FINAL PRACTICE (proposed rule 129)

**EXAMINER MUST WITHDRAW
FINALITY AND CONSIDER NEW
SUBMISSION IN THE SAME WAY
AS WITH ANY RESPONSE TO A
NON-FINAL OFFICE ACTION**



TRANSITION AFTER-FINAL PRACTICE (proposed rule 129)

**ANY SUBMISSION AFTER-FINAL,
AFTER AN APPLICANT HAS
TWICE PAID THE TRANSITION
AFTER-FINAL FEE, IS TREATED
IN THE SAME MANNER AS A
SUBMISSION AFTER-FINAL
UNDER CURRENT PRACTICE**



TRANSITION RESTRICTION PRACTICE (proposed rule 129)

**AFFECTS ONLY THOSE
APPLICATIONS FILED AS OF
JUNE 8, 1995 AND HAVING
U.S. EFFECTIVE DATE ON OR
PRIOR TO JUNE 8, 1992**



TRANSITION RESTRICTION PRACTICE (proposed rule 129)

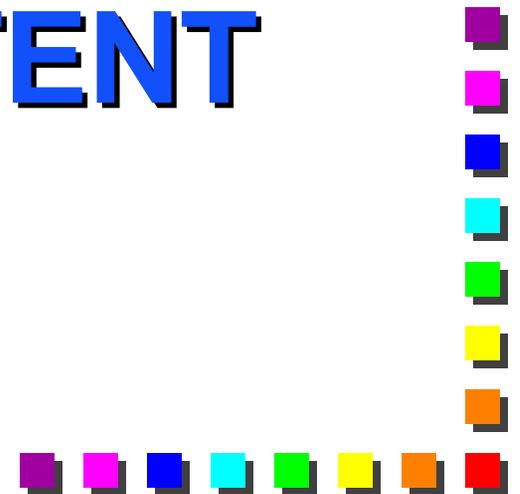
NO RESTRICTION CAN BE MADE OR MAINTAINED EXCEPT WHERE:

- (1) REQUIREMENT WAS MADE MORE THAN TWO MONTHS PRIOR TO JUNE 8, 1995 (THAT IS PRIOR TO APRIL 8, 1995);**
- (2) NO OFFICE ACTION IN APPLICATION DUE TO APPLICANT'S ACTION, OR,**
- (3) ADDITIONAL INVENTION FEE WAS NOT PAID**



PATENT TERM EXTENSION

UP TO 5 YEARS TOTAL
FOR CERTAIN DELAYS
IN ISSUING PATENT



PATENT TERM EXTENSION

CERTAIN DELAYS IN ISSUING PATENT

SECRECY ORDER UNDER § 181

INTERFERENCE PROCEEDING

UNDER § 135

SUCCESSFUL APPELLATE

REVIEW AT BPAI / FEDERAL

COURT *



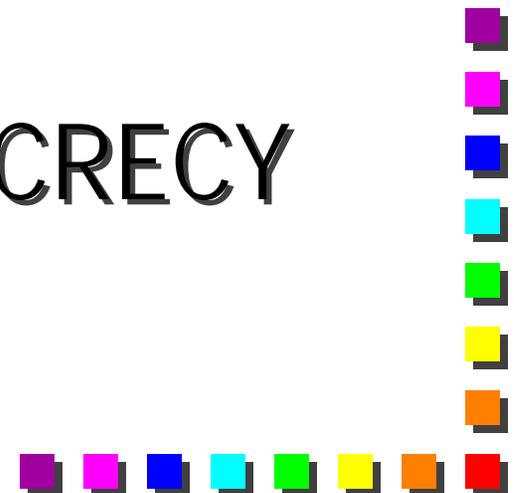
PATENT TERM EXTENSION

(proposed rule 701)

CERTAIN DELAYS IN ISSUING PATENT

SECURITY ORDER UNDER § 181

EXTENSION EQUAL TO DAYS IN
PERIOD APPLICATION
MAINTAINED UNDER SECURITY
ORDER



PATENT TERM EXTENSION

(proposed rule 701)

CERTAIN DELAYS IN ISSUING PATENT

INTERFERENCE PROCEEDING UNDER §135

EXTENSION FOR APPLICATION

INVOLVED IN INTERFERENCE EQUAL

TO DAYS IN PERIOD BEGINNING

ON DATE INTERFERENCE

DECLARED AND ENDING ON

DATE INTERFERENCE TERMINATED



PATENT TERM EXTENSION

(proposed rule 701)

CERTAIN DELAYS IN ISSUING PATENT

SUCCESSFUL APPELLATE REVIEW AT BPAI / FEDERAL COURT*

EXTENSION EQUAL TO SUM OF DAYS IN
PERIOD **BEGINNING** ON DATE APPEAL TO
BPAI FILED & **ENDING** ON DATE OF FINAL
DECISION BY BPAI / FEDERAL COURT IN
FAVOR OF APPLICANT



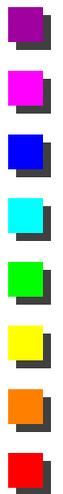
* PATENT TERM EXTENSION

SUCCESSFUL APPELLATE REVIEW CONDITIONS

**PATENT NOT SUBJECT TO A
TERMINAL DISCLAIMER**

**EXTENSION PERIOD REDUCED
BY:**

- **TIME WITHIN 3 YEARS OF
FILING DATE**
- **TIME APPLICANT DID NOT
ACT WITH DUE DILIGENCE**

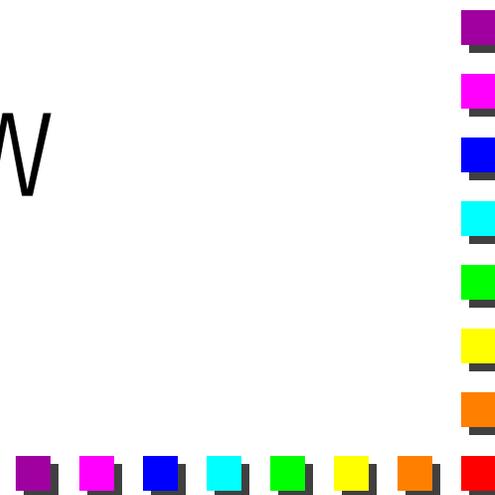


PATENT TERM EXTENSION

(1) DELAYS IN ISSUING PATENT
(UP TO 5 YEARS)

PLUS

(2) (§ 156) PREMARKET
REGULATORY REVIEW
(UP TO 5 YEARS)



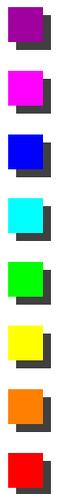
17/20-YEAR PATENT TERM

CERTAIN PATENTS WILL BE ENTITLED TO A PATENT TERM WHICH IS THE LONGER OF: 17 YEARS FROM PATENT GRANT, OR 20 YEARS FROM APPLICATION FILING

PATENTS IN FORCE ON JUNE 8, 1995

PATENTS ISSUED AFTER JUNE 8, 1995 ON APPLICATIONS FILED PRIOR TO JUNE 8, 1995

REMEDIES LIMITED IN ANY EXTENDED TERM



maintenance fees

\$ The timetable for paying maintenance fees will not change. The schedule for payment of maintenance fees is 3.5, 7.5 and 11.5 years from the patent issue date.



INTRODUCTION OF A PROVISIONAL APPLICATION



PROVISIONAL APPLICATION

REQUIREMENTS (proposed rule 51(a)(2))

↔ **SPECIFICATION (§112, 1ST ¶)**

↔ **DRAWINGS IF NECESSARY FOR THE UNDERSTANDING UNDER §113**

↔ **NAMING OF INVENTORS**

↔ **FILING FEE**

↔ **COVER SHEET TO IDENTIFY AS PROVISIONAL**



COVER SHEET FOR A PROVISIONAL APPLICATION MUST IDENTIFY

APPLICATION AS PROVISIONAL

NAMES OF INVENTORS

TITLE OF INVENTION

**NAME & REGISTRATION NUMBER OF
ATTORNEY / AGENT (IF APPLICABLE)**

DOCKET NUMBER (IF APPLICABLE)

CORRESPONDENCE ADDRESS



MINIMUM REQUIREMENTS FOR OBTAINING PROVISIONAL APPLICATION FILING DATE (proposed rule 53(b)(2))

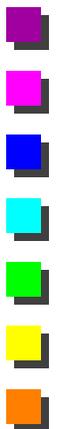
**SPECIFICATION (§112, 1ST ¶)
DRAWINGS
NAMING OF INVENTORS
MUST BE IDENTIFIED AS A
PROVISIONAL APPLICATION**



PROVISIONAL APPLICATIONS

**ACCESS / CERTIFIED COPIES
ONLY GIVEN TO PARTIES WITH
WRITTEN AUTHORITY FROM:**

- 1 . A NAMED INVENTOR;**
- 2 . ASSIGNEE OF RECORD; OR**
- 3 . ATTORNEY / AGENT OF
RECORD.**



**PROVISIONAL APPLICATION WHICH
HAS BEEN ACCORDED A FILING
DATE BUT DOES NOT INCLUDE:**

FILING FEE; OR

COMPLETE COVER SHEET

**APPLICANT WILL BE GIVEN TIME
TO FILE MISSING PARTS WITH
PAYMENT OF \$50/\$25
SURCHARGE.**



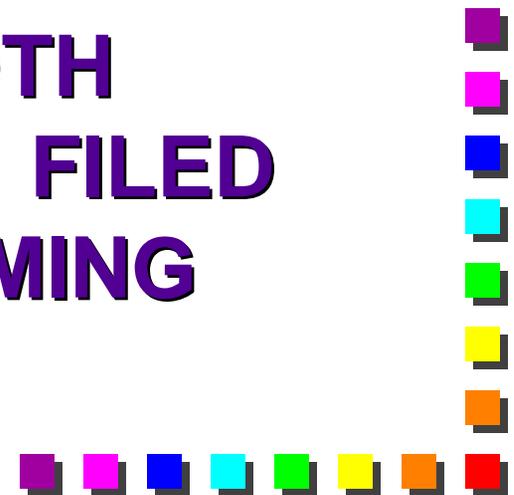
INVENTORSHIP OF PROVISIONAL APPLICATION

**ANY PERSON THAT MADE CONTRIBUTION
TO INVENTION(S) DESCRIBED IN
PROVISIONAL SHOULD BE NAMED**

**BETTER TO HAVE MORE INVENTORS
NAMED IN PROVISIONAL BECAUSE:**

**MUST HAVE AT LEAST ONE
COMMON INVENTOR IN BOTH
PROVISIONAL AND LATER FILED
§ 111(a) APPLICATION CLAIMING
BENEFIT OF PROVISIONAL**

(PROPOSED RULE 78 (a)(3))



INVENTORSHIP OF PROVISIONAL APPLICATION

**IF NO COMMON INVENTOR,
PETITION WITH FEE OF \$50/\$25
MUST BE FILED TO ADD
INVENTOR IN PROVISIONAL IF
OMISSION WAS DUE TO ERROR W/
O DECEPTIVE INTENT**



CONVERSION TO PROVISIONAL

**APPLICATION NOT IDENTIFIED
AS A PROVISIONAL WILL BE
TREATED AS FILED UNDER
§111(a) (proposed rule 53(a)(2)(i))**

**APPLICATION INTENTIONALLY
FILED UNDER §111(a)**



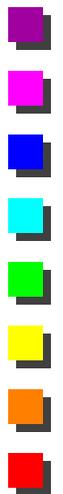
CONVERSION TO PROVISIONAL

APPLICANT MAY FILE PETITION WITH FEE OF \$50/\$25 REQUESTING CONVERSION OF §111(a) APPLICATION TO A PROVISIONAL
(proposed rule 53 (a)(2)(ii))

PETITION MUST BE FILED BEFORE:

- (1) PAYMENT OF ISSUE FEE; OR**
- (2) EXPIRATION OF 12 MONTHS FROM FILING DATE OF APPLICATION, WHICHEVER IS EARLIER**

FEES PROPERLY PAID IN §111(a) APPLICATION WILL NOT BE REFUNDED

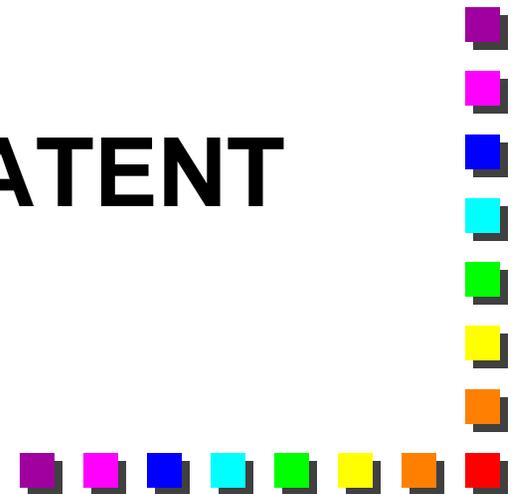


A PROVISIONAL APPLICATION DOES NOT

REQUIRE A CLAIM

**REQUIRE AN OATH OR
DECLARATION**

MATURE INTO A PATENT

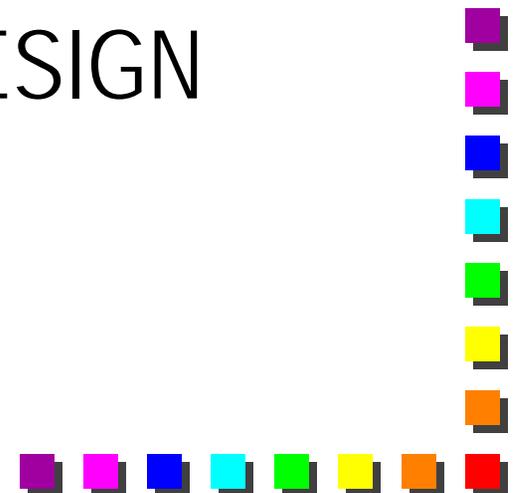


PROVISIONAL APPLICATION

IS NOT EXAMINED

CANNOT CLAIM PRIORITY OF AN
EARLIER APPLICATION (FOREIGN OR
DOMESTIC)

CANNOT BE USED WITH DESIGN
APPLICATIONS



PROVISIONAL APPLICATION

IS A REGULAR NATIONAL FILING THAT
STARTS THE PARIS CONVENTION
PRIORITY YEAR

AUTOMATICALLY GOES ABANDONED BY
LAW AFTER 1 YEAR FROM FILING



PROVISIONAL APPLICATION

MAY GO ABANDONED PRIOR TO THE ONE YEAR PERIOD DUE TO LACK OF FEE PAYMENT OR LACK OF RESPONSE TO OFFICE REQUIREMENT

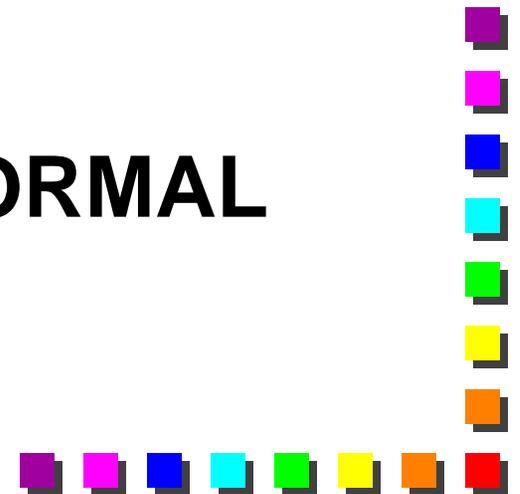
MAY BE REVIVED AFTER ONE YEAR FROM FILING DATE, BUT PENDENCY CANNOT EXTEND BEYOND ONE YEAR FROM FILING DATE



THE BENEFITS OF A PROVISIONAL APPLICATION ARE:

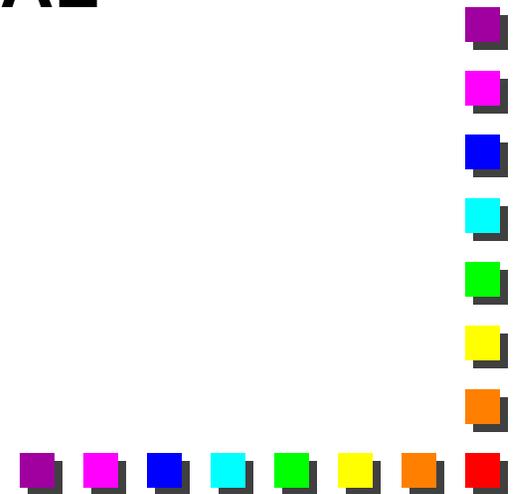
**LOW COST
(\$75.00 FOR INDEPENDENT
INVENTORS, NONPROFIT
ORGANIZATIONS AND SMALL
BUSINESSES)**

**MINIMAL LEGAL AND FORMAL
REQUIREMENTS**



THE BENEFITS OF A PROVISIONAL APPLICATION ARE:

**PROVIDES ONE YEAR PERIOD TO:
FURTHER DEVELOP INVENTION
DETERMINE MARKETABILITY
ACQUIRE FUNDING / CAPITAL
SEEK LICENSING
SEEK MANUFACTURING**



THE BENEFITS OF A PROVISIONAL APPLICATION ARE:

**VALUE BASED ON AMOUNT OF
DISCLOSURE**

**ESTABLISH AN EARLY FILING
DATE**

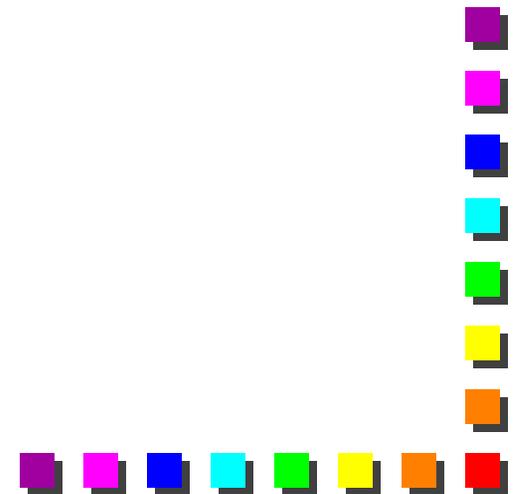
**APPLICATIONS KEPT IN
CONFIDENCE BY OFFICE**



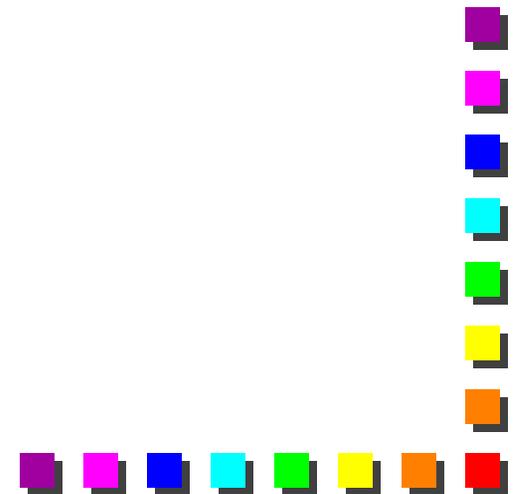
THE BENEFITS OF A PROVISIONAL APPLICATION ARE:

**PARITY WITH FOREIGN
APPLICANTS**

**FILING DOES NOT START 20
YEAR TERM**



DATE OF INVENTION FOR OBTAINING A PATENT



NAFTA / GATT

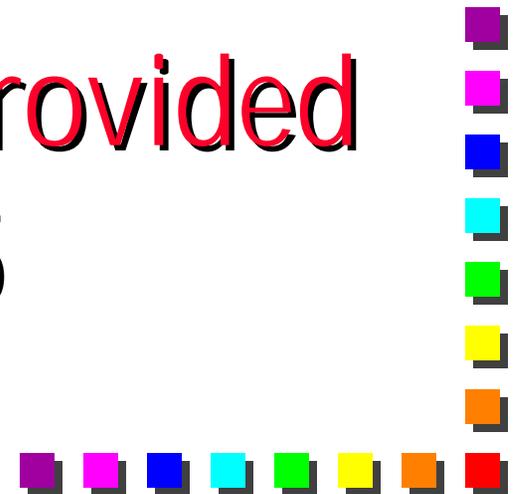
**... PATENTS SHALL BE
AVAILABLE ... WITHOUT
DISCRIMINATION AS TO
THE PLACE OF INVENTION**



**§ 104 ...AN APPLICANT
FOR A PATENT ... MAY
NOT ESTABLISH A DATE
OF INVENTION IN A
FOREIGN COUNTRY
EXCEPT AS PROVIDED IN
SECTION 119 AND 365**



§ 104 ...an applicant for a patent
... may not establish a date of
invention in a foreign country
OTHER THAN A NAFTA
COUNTRY OR A WTO MEMBER
COUNTRY except as provided
in section 119 and 365



37 CFR 1.131

**... FACTS SHOWING A
COMPLETION OF THE
INVENTION IN THIS
COUNTRY BEFORE
THE FILING DATE ...**

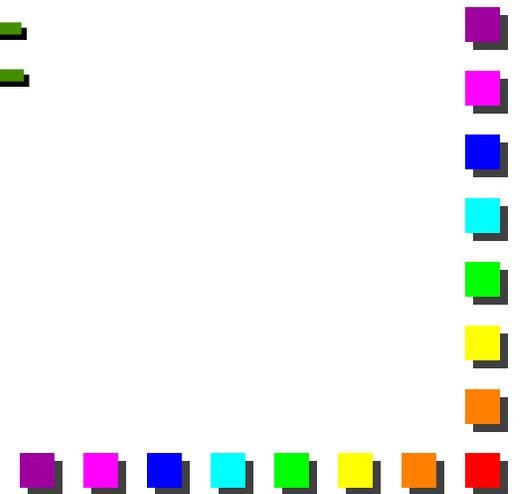


37 CFR 1.131

... facts showing a
completion of the
invention in this
country **OR IN A
NAFTA OR WTO
MEMBER COUNTRY**
before the filing date...



DATE OF
INVENTION
CHANGES ARE
PROSPECTIVE



§104 EFFECTIVE DATE

NAFTA: 08 December 1993

GATT: 01 JANUARY 1996

(THIS DATE IS ONE
YEAR AFTER ENTRY
INTO FORCE OF WTO
AGREEMENT)



GATT LEGISLATION DOES NOT MODIFY THE PROVISIONS OF

§ 102(a) [. . . invention was known or
used by others in this country]

§ 102(b) [. . . in public use or on sale
in this country]

§ 102(g) [. . . the invention was made
in this country]



NOTICE:

**PROPOSED RULES
RELATING TO CHANGES TO
37 CFR 1.131 &
INTERFERENCE PRACTICE
WERE PUBLISHED ON
OCTOBER 25, 1994, AT 1167
OG 96 & 98, RESPECTIVELY**



WHAT PRACTITIONERS SHOULD THINK ABOUT

 **PRIOR TO JUNE 8, 1995**

**OUTSTANDING RESTRICTION
REQUIREMENTS**

**LAST OPPORTUNITY TO FILE
APPLICATION THAT MAY RESULT IN
17 YEAR PATENT TERM**

**APPLICATIONS ELIGIBLE FOR
TRANSITION PROCEDURES**

 **PROVISIONAL APPLICATIONS**

 **PROPOSED IMPLEMENTING REGULATIONS**

 **EXPEDITING PROSECUTION**



**QUESTION #1 (IMPLEMENTING LEGISLATION FOR
GATT WAS ENACTED DECEMBER 8, 1994)**

A MEXICAN INVENTOR HAS MADE AN INVENTION IN MEXICO CITY ON JUNE 1, 1993, FILED A PATENT APPL. IN MEXICO ON DEC. 1, 1993, FILED A PATENT APPL. IN THE U.S. ON DEC. 1, 1994, AND IS PLACED IN INTERFERENCE WITH AN APPL. FILED DEC. 16, 1994, BY A U.S. CITIZEN. THE U.S. CITIZEN ESTABLISHES A DATE OF INVENTION IN THE U.S. ON NOV. 1, 1993. CAN THE MEXICAN INVENTOR RELY ON THE JUNE 1, 1993, DATE OF INVENTION? (A) YES (B) NO

ANSWER: (B) NO (NAFTA EFFECTIVE DATE IS DECEMBER 8, 1993)

QUESTION #2 (IMPLEMENTING LEGISLATION FOR GATT WAS ENACTED DECEMBER 8, 1994)

A U.S. INVENTOR FILED THE FOLLOWING SEQUENCE OF APPLS., EACH SUBSEQUENT APPL. CLAIMING THE BENEFIT OF THE FILING DATE OF EACH OF THE EARLIER APPLS.:

PROVISIONAL APPLICATION (§ 111b) - 6/20/95

PCT INTL. APPLICATION (§ 363) - 6/20/96

NATIONAL STAGE APPLICATION (§ 371) - 6/20/97

NATIONAL CIP APPLICATION (§ 111a) - 6/20/99 WHAT

DATE WILL ANY PATENT ISSUED ON THE CIP

APPLICATION EXPIRE? (A) 6/20/2015 (B) 6/20/

2016 (C) 12/20/2017 (D) 6/20/2019

ANSWER: (B) 6/20/2016 (6/20/96 PLUS 20 YEARS)

QUESTION #3 (IMPLEMENTING LEGISLATION FOR GATT WAS ENACTED DECEMBER 8, 1994)

A U.S. INVENTOR FILES AN APPL. ON A NEW DRUG COMPOUND ON 6/20/95. A NOTICE OF APPEAL IS FILED INVOLVING THIS APPL. ON 6/20/97, AND IS DECIDED FAVORABLE TO THIS INVENTOR ON 6/20/2000. SUBSEQUENTLY, AN INTERFERENCE IS DECLARED ON 6/20/2002, AND IS TERMINATED BY A FINAL DECISION FAVORABLE TO THIS INVENTOR ON 6/20/2004. THE PATENT IS ISSUED ON 6/20/2005. THE PATENT IS SUBSEQUENTLY DETERMINED TO BE ENTITLED TO PATENT TERM EXTENSION OF FIVE YEARS UNDER §156 BECAUSE OF REGULATORY REVIEW BY THE F.D.A. WHAT IS THE DATE OF EXPIRATION OF THIS PATENT? (A) 6/20/2015 (B) 6/20/2020 (C) 6/20/2023 (D) 6/20/2024

ANSWER: (D) 6/20/2024 [**2 YEARS (APPEAL)** PLUS **2 YEARS (INTERFERENCE)** PLUS **5 YEARS (FDA)** IS A TOTAL OF 29 YEARS; THE YEAR 1995 + 29 IS THE YEAR 2024]

QUESTION #4 (IMPLEMENTING LEGISLATION FOR GATT WAS ENACTED DECEMBER 8, 1994)

AN APPLICANT HAS FILED A SERIES OF CONTINUATION APPLICATIONS DATING BACK TO 6/20/88. THE LATEST APPLICATION WAS FILED ON 6/20/94, AND IS THE SUBJECT OF A FINAL ACTION ON 4/30/95. WHAT OPTIONS ARE AVAILABLE TO APPLICANT TO CONTINUE PROSECUTION AND THE PATENT TERM CONSEQUENCES OF EACH OPTION? WHAT IS THE PATENT TERM OF ANY PATENT ISSUING ON A CONTINUING APPLICATION FILED ON OR AFTER 6/15/95 THAT CLAIMS THE BENEFIT OF THE 6/20/88 FILING DATE?

*For further information on Uruguay
Round Agreements Act, please phone
our help line @*

1-(800) PTO-2224.

Thank you very much.



18 MONTH PUBLICATION

Advance Notice:

59 FR 63966

December 12, 1994 ,and,

1170 OG 390

January 3, 1995

