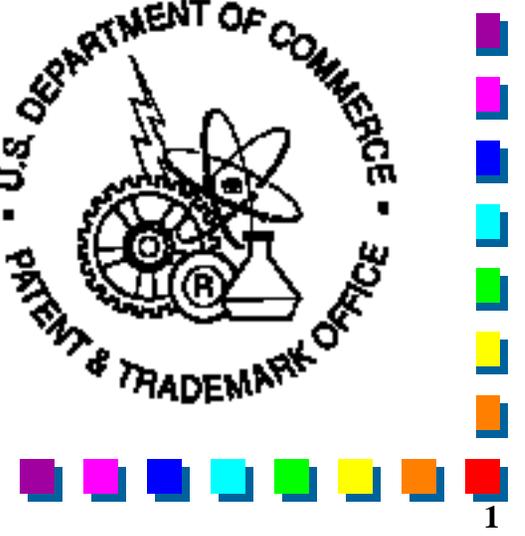


United States Patent Practice in a Post Uruguay Round World

Patent and Trademark Office
United States Department of Commerce

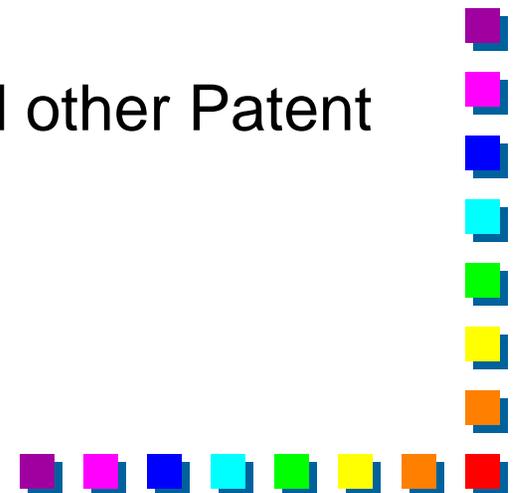


The Uruguay Round Agreement

Most Comprehensive Intellectual Property Agreement Ever Negotiated

Key Patent Provisions include:

- Product Patent Protection in Essentially All Fields of Technology
- Consistent Rights and Remedies
- Limits on Compulsory Licensing and other Patent Diminishing Foreign Practices
- 20 Year Patent Term



Summary of Major Domestic Changes

**Twenty Year from Filing Date
Patent Term**

Provisional Patent Applications

**Proving Invention Dates With
Foreign-Generated Evidence**

**Infringement by Importation and
Offers for Sale**



NOTICE:

Proposed rules at
59 FR 63951 (December 12,
1994) and **1170 OG 377**
(January 3, 1995).

Final Rules Published
April 25 (FR) and May 2 (OG)



Twenty Year Patent Term

Affects Utility and Plant Patents, *Not Design Patents*

Rights Begin on Issue Date and End 20 Years After the Earliest Effective Filing Date *Claimed by the Applicant*

20 Year Term Applies to Any Application filed **ON OR AFTER**
JUNE 8, 1995

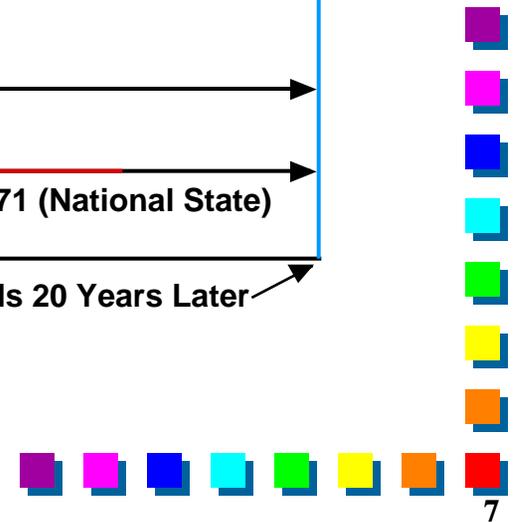
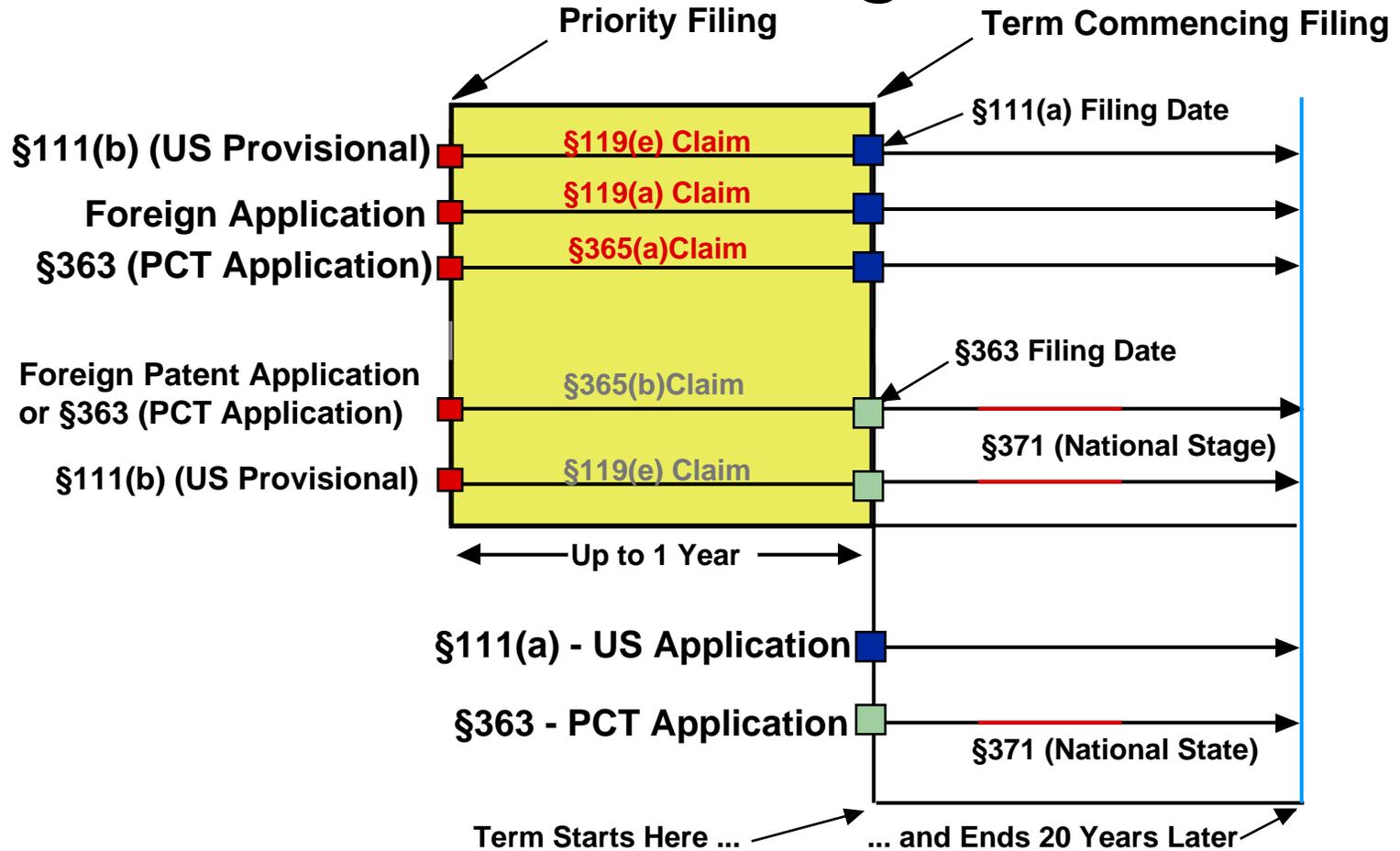


Twenty Year Patent Term

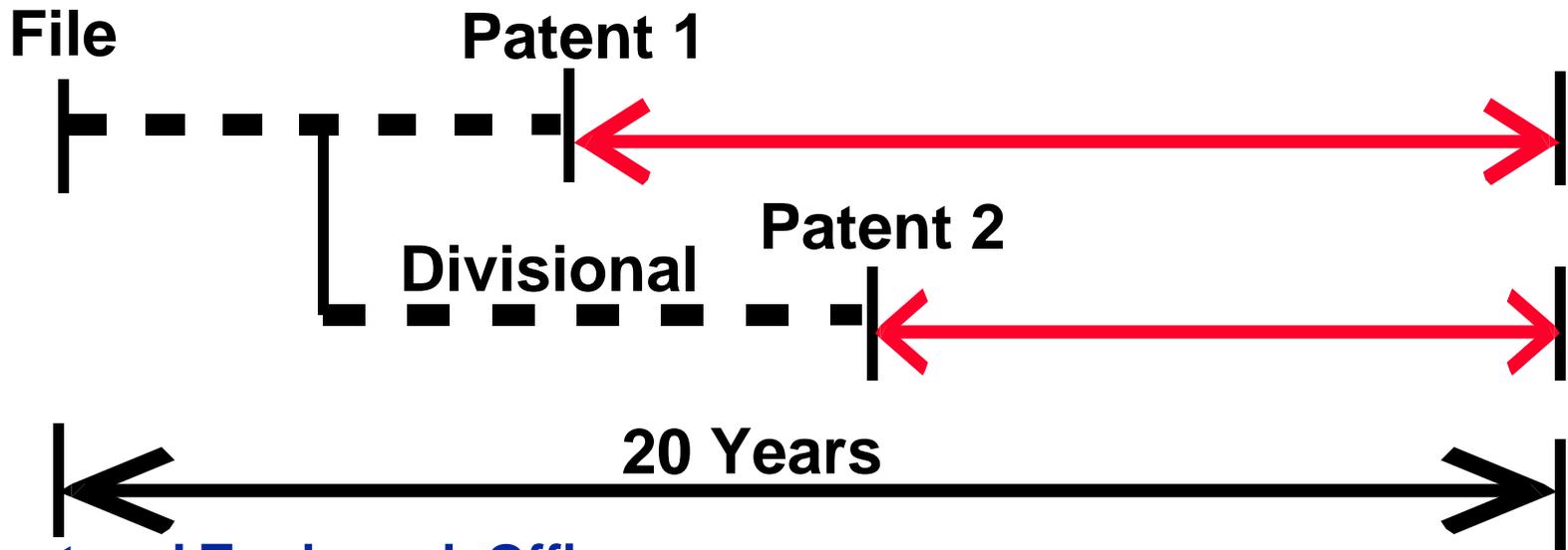
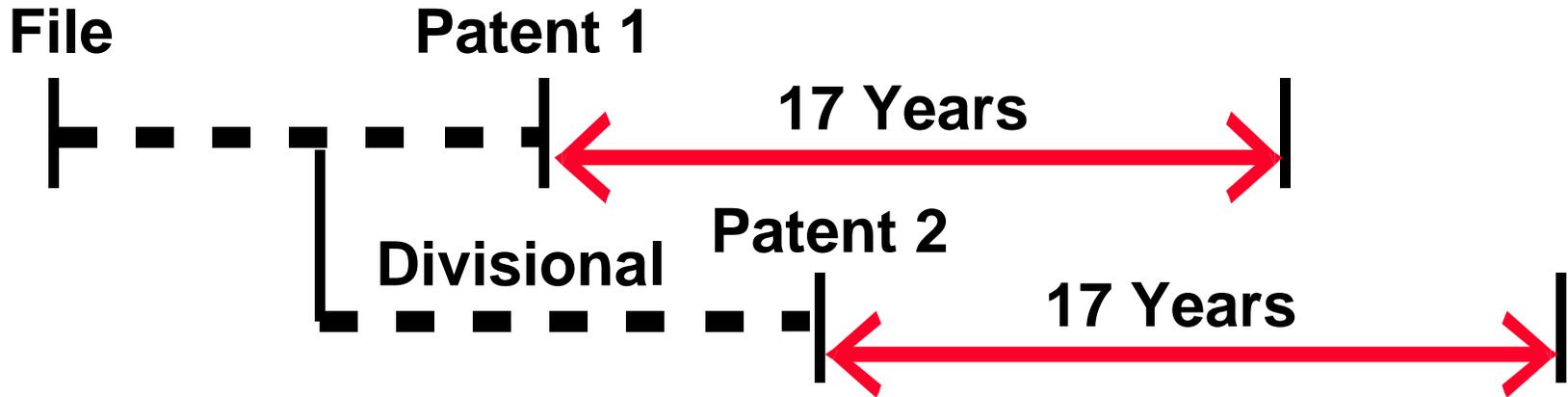
Rights **Start** on the **Issue Date**
and **End 20 Years** From the
Earliest Effective **Filing Date**



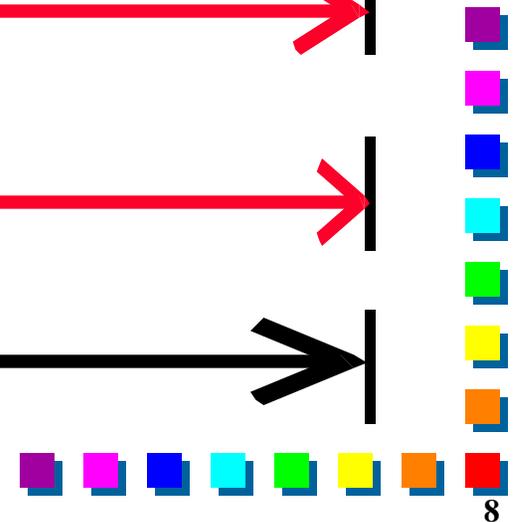
20 Year Term Filing Scenarios



Contrast (17 vs 20) Divisional



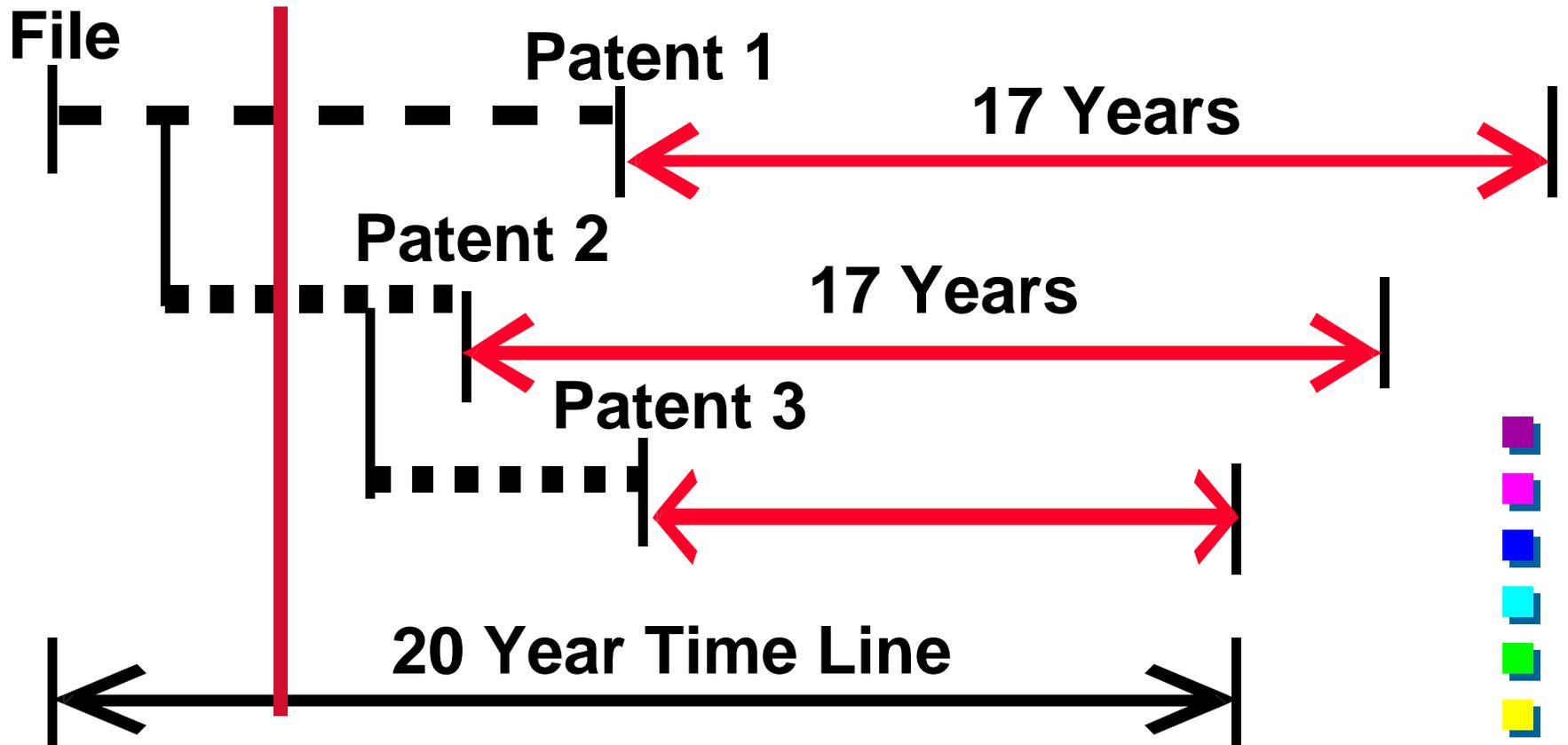
Patent and Trademark Office
United States Department of Commerce



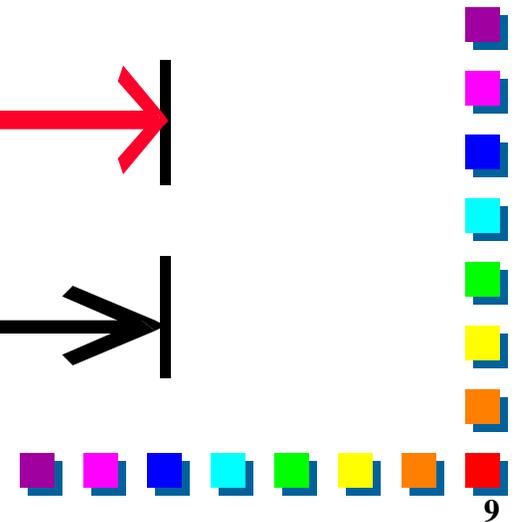
20 Year Term Effective Date

Effective Date

JUNE 8, 1995



Patent and Trademark Office
United States Department of Commerce



Patent Term Extensions (Rule 701)

Patent Term Will Be Extended for
Pre-Grant Delays due to Appeals,
Interference or Secrecy Orders

– **Some Limits on Appeal Extensions**

Maximum Extension is **5 Years**

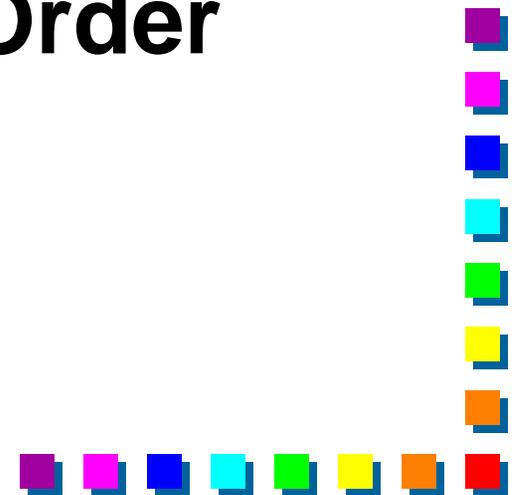
Independent of Regulatory Delay
Extensions under 35 USC § 156



Patent Term Extensions (Rule 701)

Secrecy Orders Under § 181

–Extension Equal to Days in
Period **Beginning** on Date
Secrecy Order Imposed and
Ending Date Secrecy Order
Rescinded

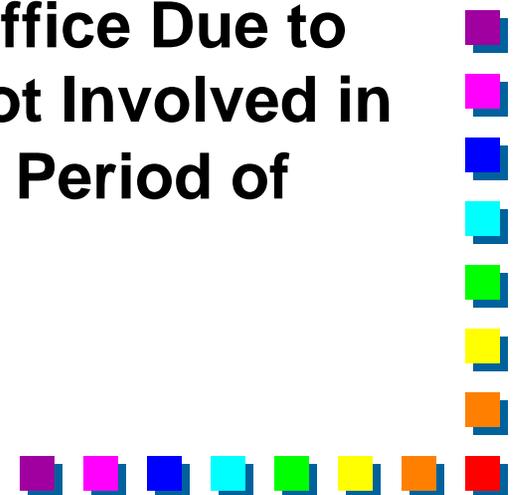


Patent Term Extensions (Rule 701)

Interference Proceedings Under §135

Extension Equal to Days in Period **Beginning** on Date Interference Declared and **Ending** on Date Interference Terminated

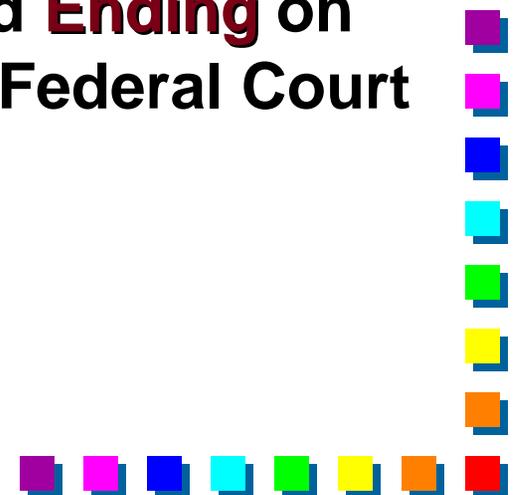
Applications Suspended by the Office Due to Interference Determination But Not Involved in Interference May Be Extended for Period of Suspension



Patent Term Extensions (Rule 701)

Successful Appellate Review at Board or Federal Court (e.g., All Rejections on At Least One Claim Reversed)

Extension Equal to Days in Period **Beginning** on Date Appeal to Board Filed and **Ending** on Date of Final Decision by Board / Federal Court in Favor of Applicant



Patent Term Extensions (Rule 701)

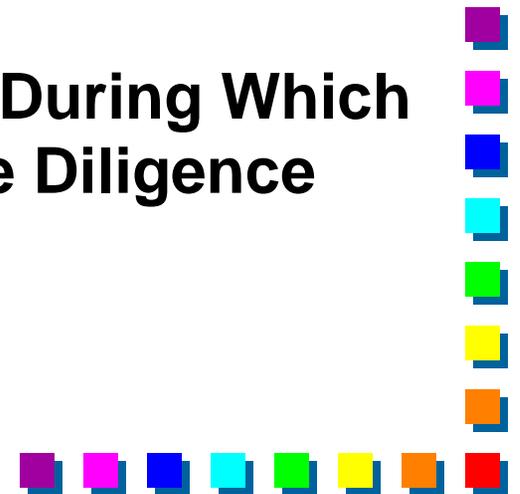
Limits on Extensions for Appeals:

Patent Not Subject to a Terminal Disclaimer

Extension Period Reduced by:

Portion of Appeal that Occurs Before Third Year of Pendency

Time During Appellate Review During Which Applicant Did Not Act With Due Diligence



Patent Term Extensions (Rule 701)

Acts That Will Constitute *Prima Facie* Lack of Due Diligence During Appeal Period Include:

- Abandonment of Application During Appellate Review Period
- Suspension at Applicant's Request Under §1.103(a) During Appellate Review Period



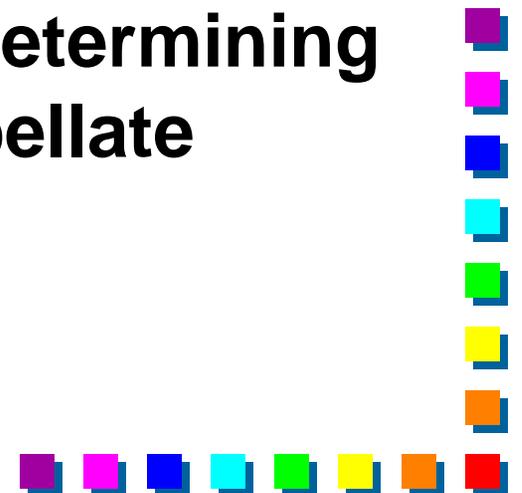
Proposed vs. Final §1.701

Proposed § 1.701(d)(2)

- Time Period Considered in Determining Lack of Due Diligence is Entire Pendency of Application

Final § 1.701(d)(2)

- Time Period Considered In Determining Lack of Due Diligence is Appellate Review Period



Proposed vs. Final §1.701

Proposed § 1.701(d)(2)

- Prima Facie Acts of Lack of Due Diligence are:

Extensions of Time

Filing of Informal Application

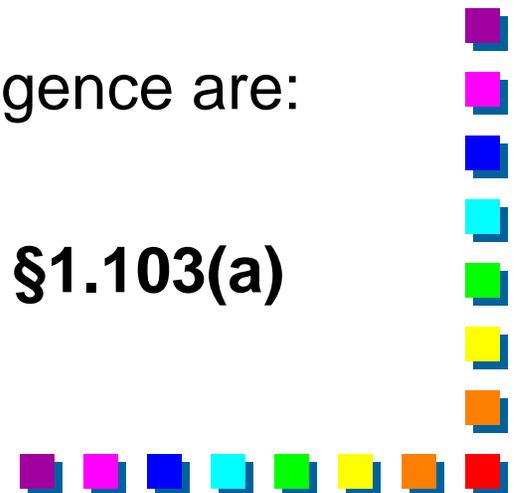
Filing of Submissions Not Fully Responsive

Final § 1.701(d)(2)

- Prima Facie Acts of Lack of Due Diligence are:

Abandonment of Application

Request for Suspension under §1.103(a)



Provisional Applications

**Simplified Filings (no oath/
declaration, no claims required)**

Inexpensive -- \$75 for Small Entities

Is a Regular US National Filing

**– Provides Internationally Recognized
Priority Date**



Provisional Application Requirements

(Rules 51(a)(2) and 53(b)(2))

Disclosure to Comply with §112 1st ¶**

Any Drawings Necessary to Understand Invention**

Naming of At Least One Inventor**

Cover Sheet to Identify as Provisional Filing**

Filing Fee (\$150/\$75)

**** Elements Needed for Obtaining a Filing Date**



Perfecting a Provisional Application Filing

(Rules 51(a)(2) and 53(b)(2))

**Application Which Has Been Given Filing Date
But Which Lacks the Filing Fee or a Complete
Cover Sheet Can be Perfected**

**Applicant Will be Given Time to File Missing
Parts with Payment of \$50/\$25 Surcharge**

**Provisionals May Be Revived Up to 1 Year After
They Go Abandoned But **Cannot Pending More
Than 12 Months****

Elements of the Cover Sheet

Identifies Application as Provisional

Name and Residence of Each Inventor

Title of Invention

Name/Registration # of Attorney/Agent (if applicable)

Docket Number (if applicable)

Correspondence Address

Name of US Gov't Agency and Gov't Contract Number Having Interest in Application



Proposed vs. Final §1.51(a)(2)(ii)

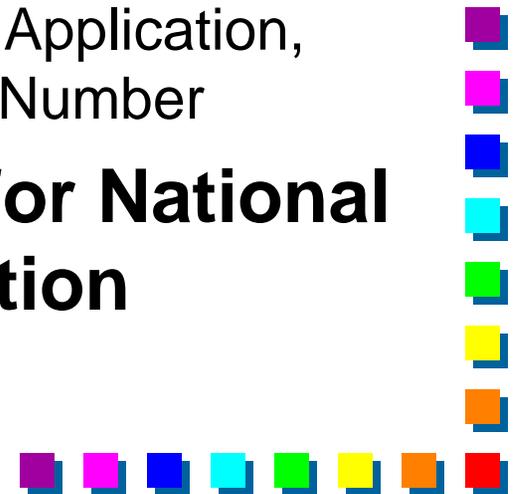
Proposed §1.51(a)(2)(ii)

- No Requirement for Residence of Inventors
- No Requirement to Note Gov't Interest in Application

Final §1.51(a)(2)(ii)

- Identification of Residence of Each Named Inventor
- Identification of Government Interest in Application, with Indication of Agency and Contract Number

Reason: Necessary Elements for National Security Processing of Application

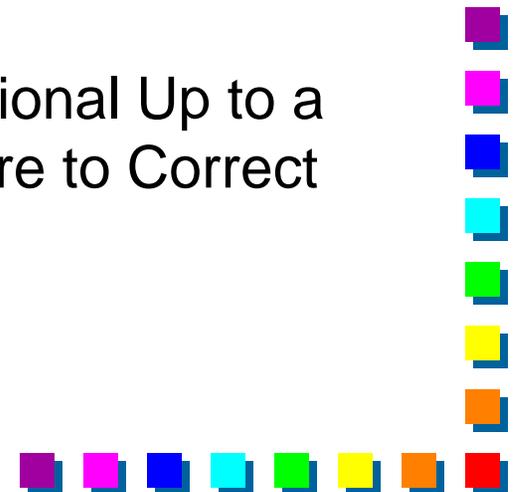


Provisional Filing Status

§111(a) Application Must be Filed Within 12 Months from Provisional Filing Date to Claim Benefit of Date

Provisionals Will Go Abandoned

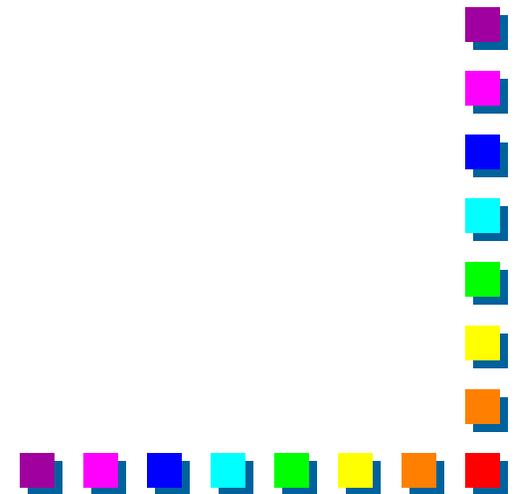
- 12 Months After Filing Date By Operation of Law or
- Upon Failure to Correct Formality Defect (fee not paid or defective cover sheet)
- You May Correct and “Revive” a Provisional Up to a Year After It Goes Abandoned for Failure to Correct Defect



Provisional Application Filing Issues

**May Be Filed in Language Other
Than English**

**Verified English Translation and Fee
under §1.17(k) Must Be Filed With
Application or Within Time Set by
Office**



Inventorship in Provisional Applications

§111(a)/363 Filing Needs to Have **One Inventor in Common** to Claim Benefit of Provisional Filing Date, per §119(e)

Each Named Inventor Must Have Made Contribution to Invention Described in Provisional Application (37 CFR §1.45(c))

Better to be **Overinclusive Rather than Underinclusive** in Naming of Inventors

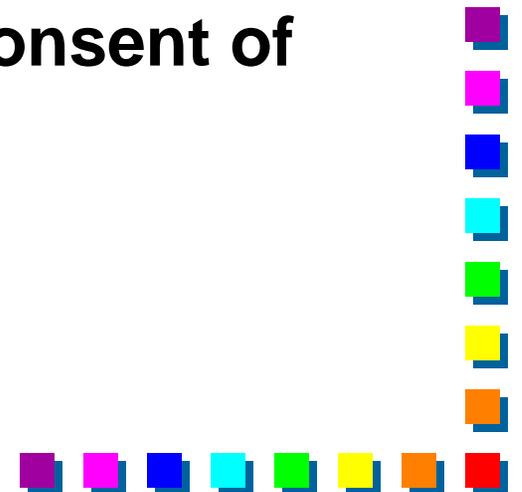


Inventorship in Provisional Applications

Inventors May Be Added or Deleted by Filing Petition With Statement that Omission Occurred Without Deceptive Intent

If No Common Inventor Between 111(a) and Provisional, Petition with Fee of \$50 Must Be Filed to Add At Least One Common Inventor

Statement of Facts and Written Consent of Assignee Required



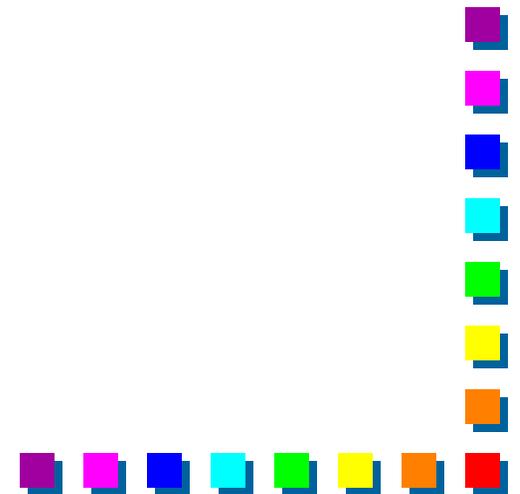
Proposed vs. Final §1.48

Proposed §1.48

- Petition Fee of \$50 Subject to 50% Small Entity Reduction

Final §1.48

- Petition Fee of \$50 **NOT** Subject to 50% Small Entity Reduction



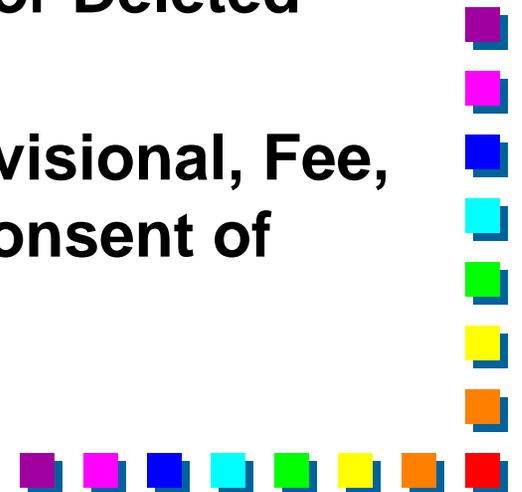
Proposed vs. Final §1.48

Proposed §1.48

- Inventor May Be Added If Omission Due to Error Without Deceptive Intent and Petition Fee Paid (§1.48(d))

New §1.48(e)

- Inventor May Be Added (§1.48(d) or Deleted (1.48(e))
- To Delete Inventor Named on Provisional, Fee, Statement of Facts and Written Consent of Assignee Required



Features of the Provisional Application

Kept in Confidence by Office (Same as §111(a) Patent Applications)

- **Access and Certified Copies Only Given to Parties With Written Authority from a Named Inventor or Assignee/Attorney/Agent of Record**
- **Request From Other Party Will Result in Certified Copy Being Sent to Correspondence Address on Application**

Not Examined and Go Abandoned by Operation of Law After 12 Months

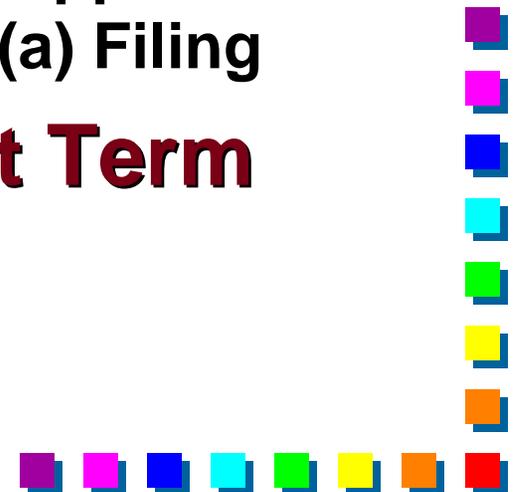


Features of the Provisional Application

Filing Starts the Paris Convention Priority Year

- You **Cannot** Claim Priority to an Earlier Domestic or Foreign Filing in a Provisional Application
- You **Can** File Multiple Provisional Applications and Consolidate them in the §111(a) Filing

Filing Does Not Start Patent Term



Conversion of §111(a) Applications to Provisionals

You May Convert a §111(a) to a §111(b) through a Petition [Rule 53(a)(2)(ii)] if Filed **Before the Earlier of the:**

- Payment of Issue Fee or
- Expiration of 12 Months From the 111(a) Filing Date
- Abandonment of Application
- Prior to Conversion of Application to Statutory Invention Registration

Petition Fee of \$50 Must Be Paid



Conversion of §111(a) Applications to Provisionals

Why Would You Do This?

- Push Back Start of Term Up to 1 Year
- Obtain Some Prosecution During “Provisional” Year
- Correct Error in Filing -- Under Rule 53(a)(2)(i), an Application Filed Without Indication Treated As §111(a) Filing

Fees Properly Paid Under §111(a) Will Not be Refunded



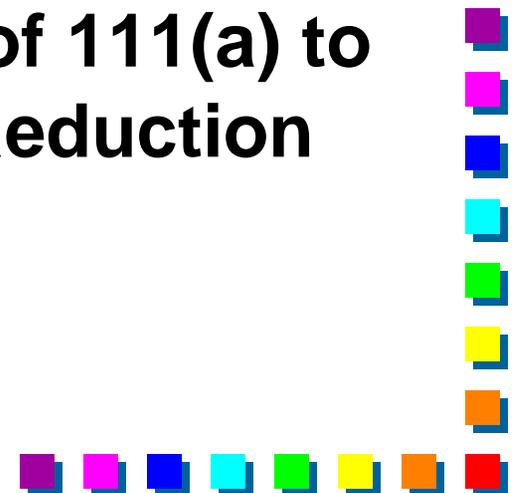
Proposed vs. Final §1.53(a)(2)(ii)

Proposed §1.53(a)(2)(ii)

- Petition Fee for Conversion of 111(a) to 111(b) Subject to 50% Reduction for Small Entities

Final §1.53(a)(2)(ii)

- Petition Fee for Conversion of 111(a) to 111(b) **NOT** Subject to 50% Reduction for Small Entities



Proposed vs. Final §1.53(a)(2)(ii)

Proposed §1.53(a)(2)(ii)

- Conversion to Provisional Must Occur Before Payment of Issue Fee or Expiration of 12 Months From Filing Date

Final §1.53(a)(2)(ii)

- Conversion to Provisional Must Also Occur Before Abandonment of Application and Before Conversion to SIR



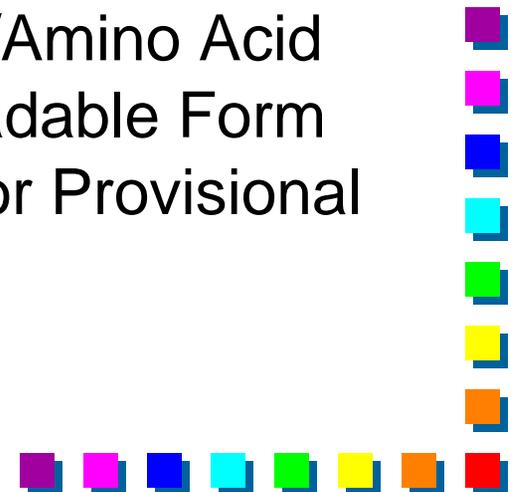
Proposed vs. Final §1.53(a)(2)(iii)

Proposed §1.53(a)(2)(iii)

- Requirements for Nucleotide/Amino Acid Sequence Listings in Computer Readable Form [§1.821(e)] “Not Applicable” to Provisional Applications

Final §1.53(a)(2)(iii)

- Requirements related to Nucleotide/Amino Acid Sequence Listings in Computer Readable Form [§1.821 to 1.825] “Not Mandatory” for Provisional Applications



Provisional Application Reminders

Cannot Claim Benefit of Earlier Filing or Priority

Cannot Be Used With Design Applications

Are Not Examined and **Cannot** Mature into a Patent

Cannot Become Involved in Interferences

Cannot Be Converted into SIR Application

Cannot be Filed Before June 8, 1995

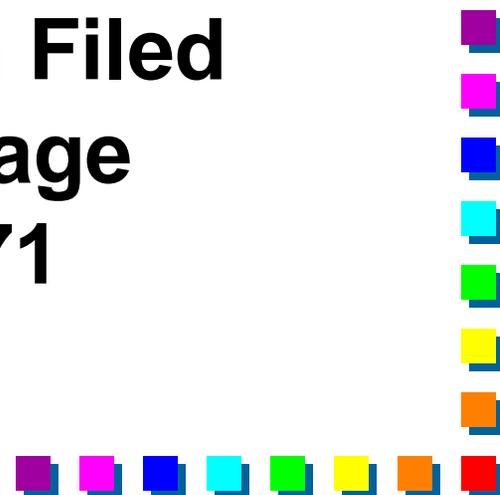
Value Dependent on Breadth of Disclosure



Additional Rule and Practice Changes

§1.1(i) Establishes “Box Provisional Patent Application”

§1.9(a) Defines “Provisional Application” as Application Filed under 111(b) and “Nonprovisional Application” as Application Filed Under 111(a) or National Stage Application Filed Under §371



Additional Rule and Practice Changes

§ 1.28(a) Provides That a Nonprovisional Application Claiming Benefit Under §119(e), 120, 121 or 365(c) May Rely on Verified Statement Filed in the Prior Application, if Small Entity Status is Still Proper and Desired, by:

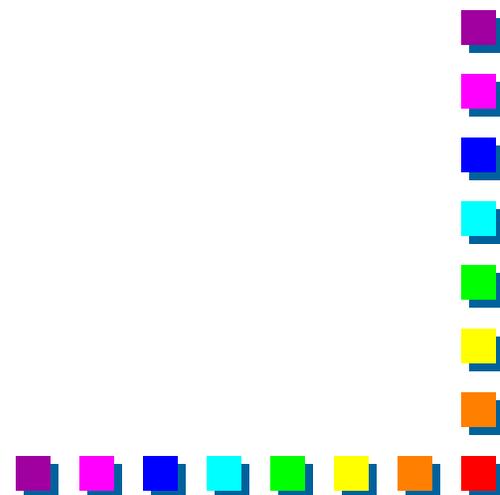
- Referencing the Statement Filed in Earlier Application, or
- Including Copy of Statement Filed in Earlier Application



Additional Rule and Practice Changes

§1.53(d)(1) - Proposal to Delete
Processing and Retention Fee
Practice Withdrawn

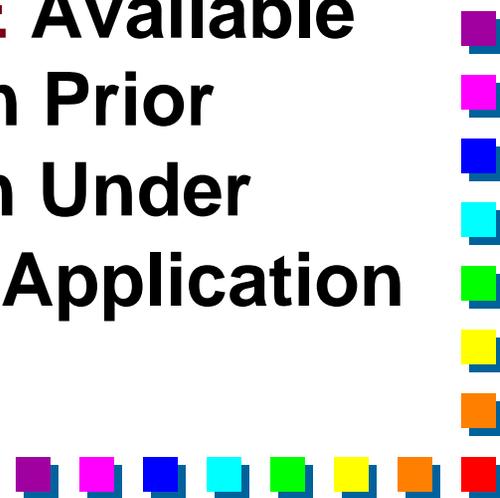
§1.60 - Proposal to Delete Rule 60 is
Withdrawn



Additional Rule and Practice Changes

Rule §1.62 Changes

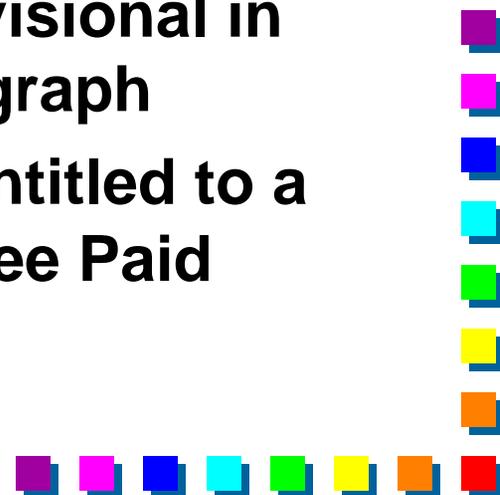
- Procedures Under §1.62 NOT Available for Filing a 111(a) Application Claiming Benefit of a Provisional Application Through 119(e)
- Procedures Under §1.62 **ARE** Available After Payment of Issue Fee in Prior Application Provided Petition Under §1.313(b)(5) Granted in Prior Application



Additional Rule and Practice Changes

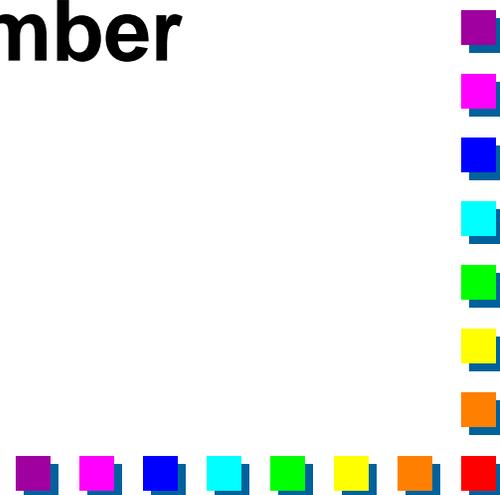
§1.78(a)(3) -- Clarifies that for Nonprovisional Application to Claim Benefit of One or More Prior Provisional Applications It Must

- Be Copending with Provisional(s)
- Have at Least One Inventor in Common With Provisional
- Claim Invention Disclosed in Provisional in Compliance with §112, First Paragraph
- Be Complete (§1.51(a)(2)) or Be Entitled to a Filing Date and Have Had Filing Fee Paid



Additional Rule and Practice Changes

§1.78(a)(4) - Any Nonprovisional Application Claiming Benefit to Provisional Must Indicate in First Line After Title Claims to Provisional Application(s) with Indication of Provisional Application Number



Additional Rule and Practice Changes

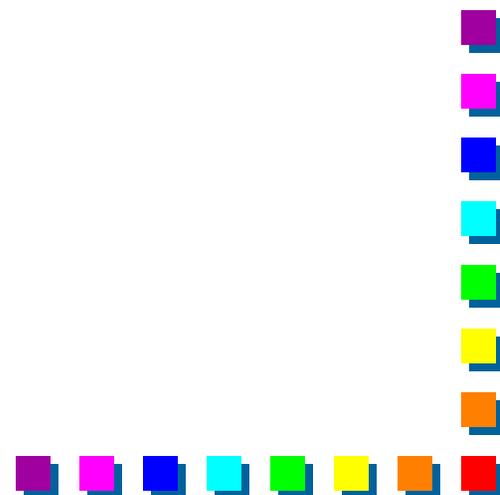
§1.139(a) Sets Forth Procedures for Reviving a Provisional Application Which Was Abandoned Due to Unavoidable Delay

§1.139(b) Sets Forth Procedures for Reviving a Provisional Application Which Was Abandoned Due to Unintentional Delay



Additional Rule and Practice Changes

§3.21 Provides that Assignment of Provisional Application Executed Before Its Filing Date Must Identify the Provisional Application by Name of Each Inventor and Title of Invention



Transition After Final Practice (Rule 129)

Permits Filing and Consideration of a Submission After Final Rejection Has Been Imposed Where Such Submission Would Not Ordinarily Be Entered or Considered

Use to Have Office Consider...

- Information Disclosure Statement**
- New Arguments or New Evidence**
- Amendments**



Transition After Final Practice (Rule 129)

Affects Only Those Cases Pending on June 8, 1995, with an Effective Filing Date Before June 8, 1993.

Can Be Used **Twice, provided:**

Payment of Fee After Notice of Non-Entry of Submission

Submission Is Filed **Prior to or With Notice of Appeal**



Transition After Final Practice (Rule 129)

Examiner **Must Withdraw Finality** and Consider New Submission in the Same Way As With Any Response to a Non-Final Office Action

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**



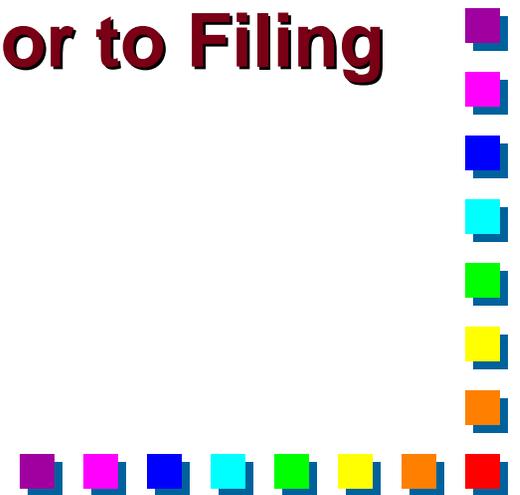
Proposed vs. Final §1.129(a)

Proposed § 1.129(a)

- Submission Filed Prior to Notice of Appeal and Fee Paid Within 1 Month from Notice Refusing Entry of Submission

Final Rule §1.129(a)

- **Submission and Fee filed Prior to Filing of Appeal Brief**



Proposed vs. Final §1.129(a)

Proposed §1.129(a)

- Status of Finality of Previous Rejection Not Specified

Final Rule §1.129(a)

- Specifies that Finality of Previous Rejection Automatically Withdrawn Upon Timely Filing of Submission and Fee



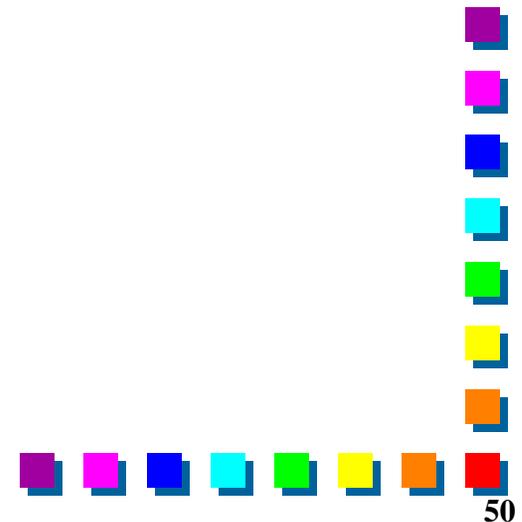
Proposed vs. Final §1.129(a)

Proposed § 1.129(a)

- § 1.17(r) Fee Not Subject to 50% Reduction for Small Entities

Final Rule §1.129(a)

- § 1.17(r) Fee is Subject to 50% Reduction for Small Entities



Proposed vs. Final §1.129(a)

Proposed § 1.129(a)

- Submission will be entered “to the extent that it would have been entered and considered if made prior to final rejection.”

Final Rule §1.129(a)

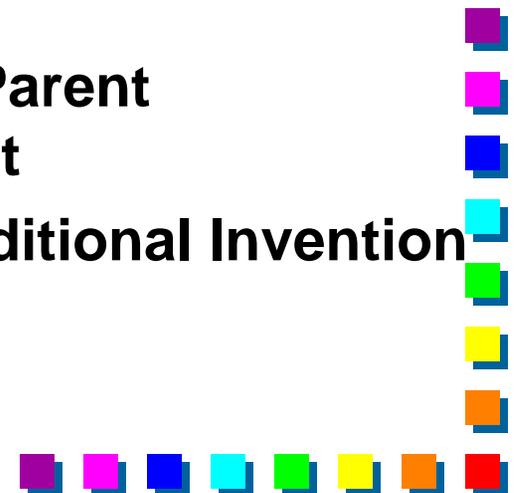
- Submission Will Be Treated In Same Manner As If Submission Was Denied Entry In Application Subsequently Refiled As File Wrapper Continuation

Transition Restriction Practice (37 C.F.R. § 129)

Permits Examination of **More Than One** Patentably Distinct Invention in a **Single Application**

No Restriction Will Be Made in Cases **Pending on June 8, 1995, with an Effective Filing Date Before June 8, 1992, Except Where**

- Restriction Requirement Was **Made Earlier than April 8, 1995.**
- No Office Action Issued in Present or Parent Application Due to Actions of Applicant
- Additional **Fee** Is Not Paid for Each Additional Invention



Transition Restriction Practice

(37 C.F.R. § 129)

In Applications Eligible for Transition Restriction Procedure, Applicants will be Notified and Given Time to:

- **Elect and Pay Fee For Each Invention In Excess of One**
- **File Petition Under § 1.129(b)(2) Traversing Restriction Requirement**

NOTE: Fee Not Required Unless and Until Adverse Determination Made on Petition

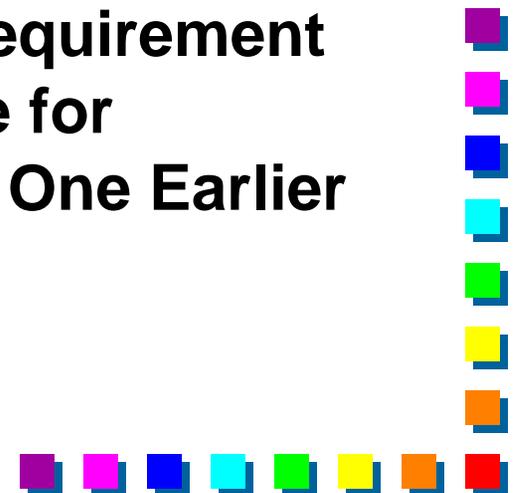


Transition Restriction Practice

(37 C.F.R. § 129)

In Applications Eligible for Transition Restriction Procedure, Applicants Will Be Able to:

- Elect and Pay Fee For Each Additional Invention Where No Election Has Been Made Prior to Notice, and**
- Confirm Election in Restriction Requirement Made Prior to Notice, and Pay Fee for Additional Inventions Other Than One Earlier Elected.**



Proposed vs. Final §1.129(b)

Proposed § 1.129(b)

- No Restriction Can Be Made or Maintained Except Where “the examiner has not issued an Office action in the Application due to actions by the applicant.”

Final § 1.129(b)

- No Restriction Can Be Made or Maintained Except Where “the examiner has not made a requirement for restriction in the present or parent application prior to 4/8/95 due to actions by the applicant.”



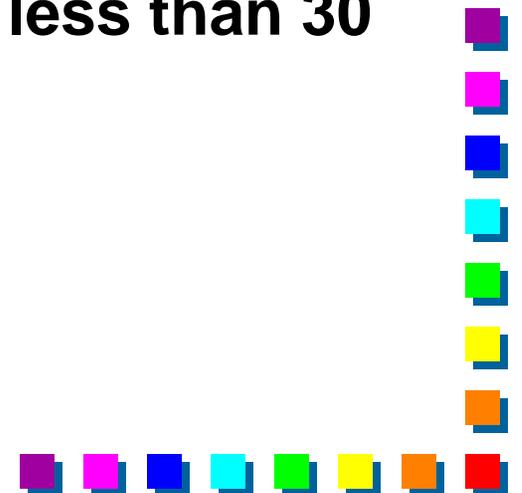
Proposed vs. Final §1.129(b)

Proposed § 1.129(b)

- Applicant given 1 month from notice to pay fee for additional invention(s) in excess of one.

Final § 1.129(b)

- “One Month” time period deleted. Time period for response will be set in the notice, which will usually be one month, but no less than 30 days.



Proposed vs. Final §1.129(b)

Proposed § 1.129(b)

- First Claimed Invention Will be Searched and Examined if Fee For Additional Invention Not Timely Paid.

Final § 1.129(b)

- Applicant May Respond by (1) Electing and Paying Additional Invention Fee; (2) Confirming Previous Election and Paying Additional Invention Fee; or (3) Filing Petition Traversing Requirement.



Proposed vs. Final §1.129(c)

Proposed § 1.129(c)

- Transitional Procedures Not Applicable to Applications Filed on or After 6/8/95.

Final § 1.129(c)

- Transitional Procedures Not Applicable to Applications Filed After 6/8/95. Applications Filed on 6/8/95 May Be Eligible for Transitional Procedures, But Will Be Subject to 20 Year From Filing Date Patent Term.



Transition Patent Term

Patents **in Force on June 8, 1995**, or that Result from an **Application Filed Before June 8, 1995**, Will Have a Patent Term that Last the **Longer of 17 Years From Grant or 20 Years from Filing Date**

Remedies for the Extended Period May be Limited to Equitable Remuneration



Additional Term-Related Considerations

Maintenance Fee Schedules
Unaltered and Continue to Run from
Grant Date

Applications that Will Yield Grant-
Based Patent Term **Must be Filed
BEFORE JUNE 8, 1995.**

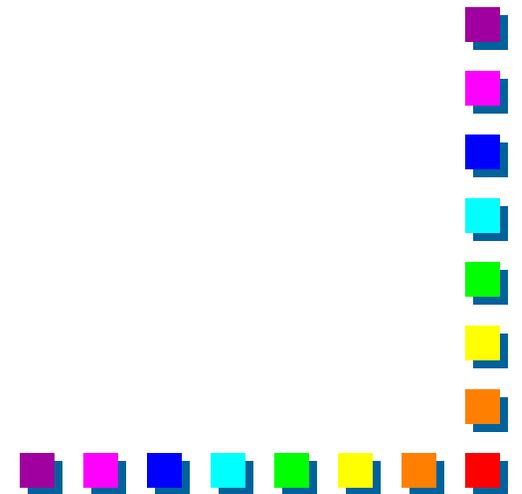
Provisional Applications **Cannot Be
Filed Before June 8, 1995.**



Proving Date of Invention to Obtain a Patent

**§104 Changed to Preclude
Discrimination as to Place of
Invention**

**Affects Interference and
37 CFR 1.131 Practice**



35 U.S.C. § 104

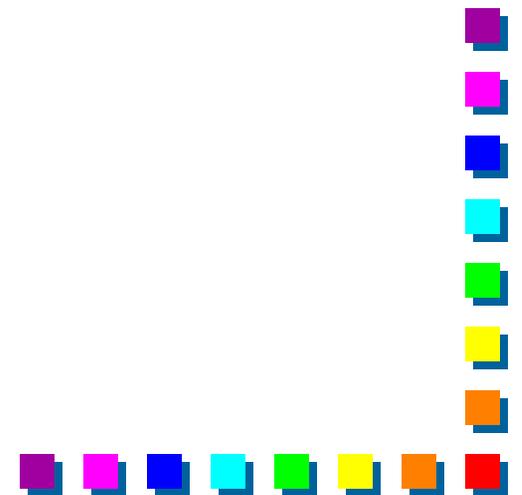
...an applicant for a patent ... may not establish a date of invention in a foreign country **OTHER THAN A NAFTA COUNTRY OR A WTO MEMBER COUNTRY except as provided in section 119 and 365**

Limits on Use of Information Where Foreign Access to Evidence Limited



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...



Invention Date Changes are Prospective

Cannot Prove Invention Date In NAFTA or WTO Country Before

– NAFTA: 08 December 1993

– WTO: 01 January 1996

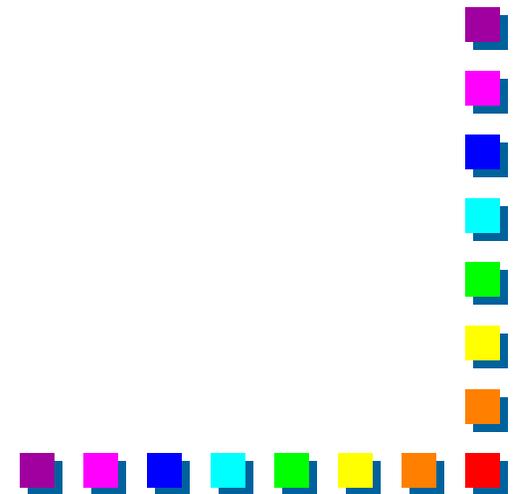
Does not Affect Prior Art-Related Inventive Activity Provisions [e.g., 102(a), 102(e), 102(g)]



Notice

Final Rules Relating to Changes to Interference Practice Were Published March 17, 1995 at 60 FR 14488

Final Rule Relating to Changes to 37 CFR §1.131 is Expected to be Published in Early May



Merits of the New System

Most Patents Will Provide a **Longer Period of Exclusive Rights** than under Previous System

- Over 75% of Applications are Original Filings
- Average Pendency on Per Application Basis is 19.0 Months

Note: Average Pendency is From Date of Filing to Final Disposition



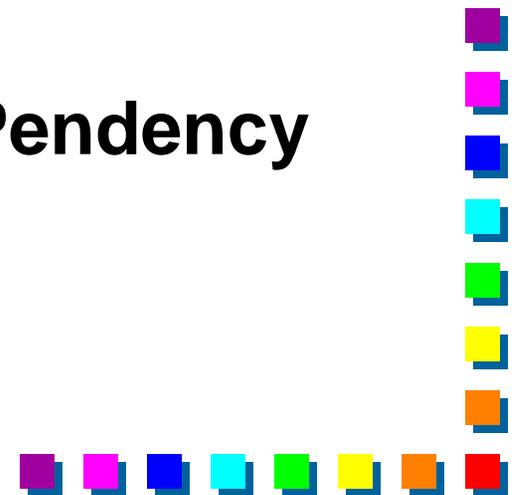
Merits of the New System (cont'd)

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



Merits of the New System (cont'd)

With the Provisional Application, 4 Years Must Pass Before Term of Rights in New System Less than That of Old System

Most Patents Expire Due to Failure to Pay Maintenance Fees Before the 12th Year [Third Maintenance Fee Not Paid in over 75% of Patents]

Ample Flexibility in New System to Maximize Patent Term



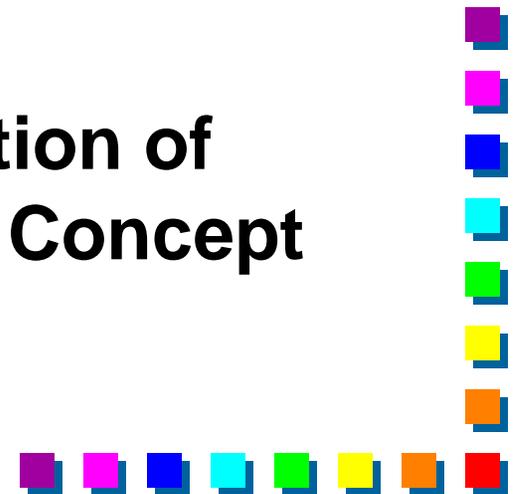
Merits of the New System (cont'd)

20 Year Term is **Sound Public Policy:**

Built In Incentive for Rapid Conclusion of Prosecution -- Either to Issue or Appeal

Only Effective Way to Eliminate Abuses that Have Harmed American Interests

Assures Certainty in Expiration of Rights to a Single Inventive Concept



Merits of the New System (cont'd)

Patent Term Extensions Compensate For Delays Beyond Control of Applicant

Applications **Pending Today** that Mature into Patents Will Have **At Least 17 Years of Rights**

Provisional Applications **Will Help Many Inventors**

- Safety Valve for “Unexpected” Inventor Bar Dates
- Permits Inexpensive Updating of Disclosures
- Permits Deferral of Patent Term

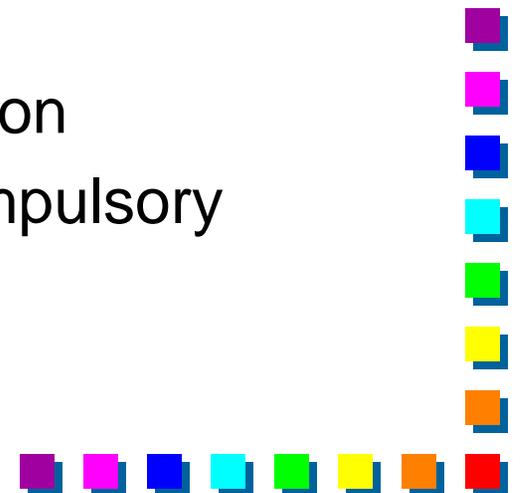


Some Additional Benefits...

“Partial” Harmonization Will Help US Inventors Gain Effective Patent Rights in Other Countries

Two Japan-US Agreements Are Examples:

- Will Permit English Language Copy to Serve as Record Copy for Corrections of Errors in Translation
- Will Eliminate Pre-Grant Oppositions
- Will Provide 3 Year Examination Option
- Will Eliminate Dependent Patent Compulsory Licensing Authority



Things to Think About Now

Evaluate Status of Long-Pending Applications

Which Applications Do You Need to File Before the June 8 Cut-off Date?

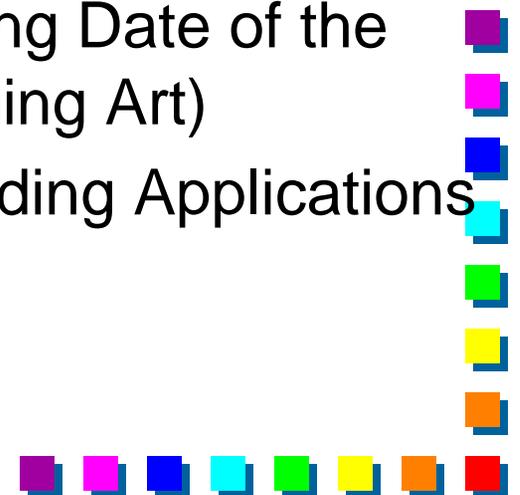
Factors Influencing Your Decision Should Be:

Value of the Underlying Invention

Significance of Possibly Reduced Term

Whether You Need to Rely on the Filing Date of the Earlier Application (e.g., CIP, Intervening Art)

Where You Are in Prosecution of Pending Applications



Helpful Hints

Provisional Applications Cannot be Pending More than 12 Months, But Claims under 119(e) Must Be Made Between Copending Applications, So You Must File 111(a) Application Before Provisional Expires

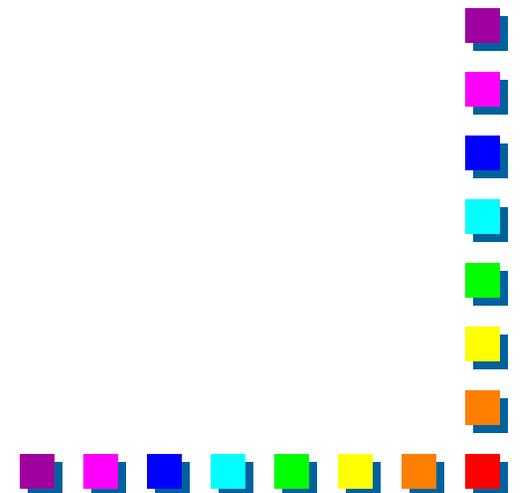
Watch Out for Expiration Dates that Occur on Saturday, Sunday or Holidays!



Helpful Hints

Strategy for Maximizing Patent Term

- File 111(a) Application
- Request “Special” Status
- Convert to Provisional and File Second 111(a) Application Within 12 Months of First 111(a) Filing Date



Helpful Hints

Strategy for Getting Early 102(e) Date When Using PCT Process

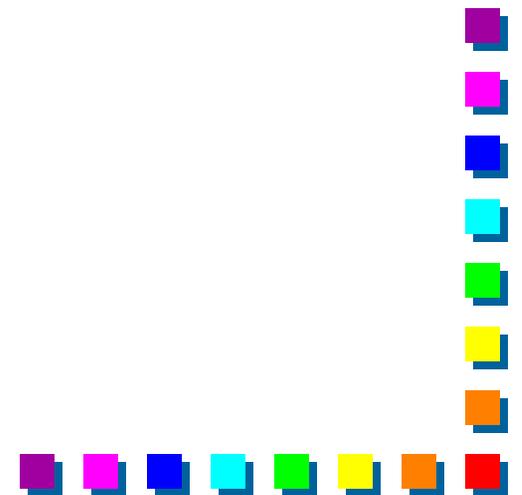
- File 111(b) Application
- File PCT Application
- File Subsequent 111(a) Application Based on PCT

NOTE: Using the PCT Process Will Also Defer Start of Maintenance Fee Due Dates!



Helpful Hints

In Cases Eligible for Transitional After Final Practice, Make Sure You Submit Any §1.181 Petition Early to Minimize Payment of Extension Fees Since Case Must Be Pending When §1.129(a) Fee is Paid!



Things to Think About Now (cont'd)

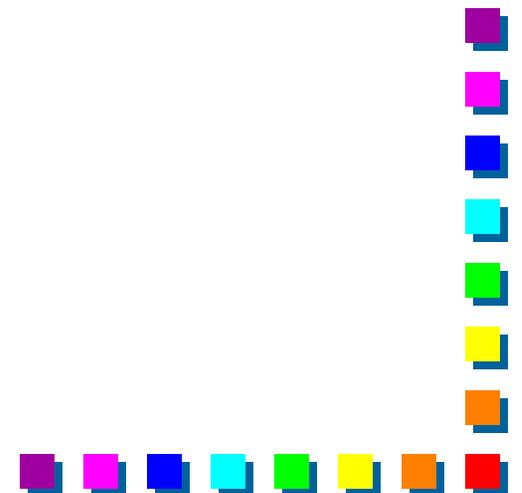
Outstanding Restriction Requirements

Applications Eligible for Transitional Procedures

How You Can Use the Provisional Application

Rule Changes for 20 Year Term

Ways To Expedite Prosecution

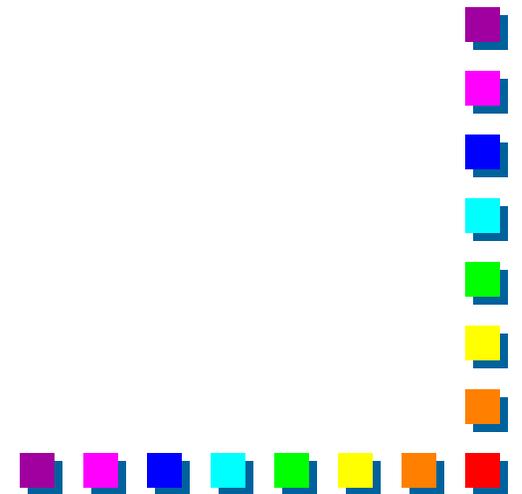


Other Legislation Initiatives Related to the New System

18 Month Publication

Reexamination Reform

Process Patent Legislation



18 Month Publication Proposal

Administration's Proposed Legislation Would

Publish Patent Applications 18 Months After Earliest Effective Filing/Priority Date

“Provisional Rights” (Royalty Claim) Could Be Recovered for Infringement Between Publication Date and Issue Date

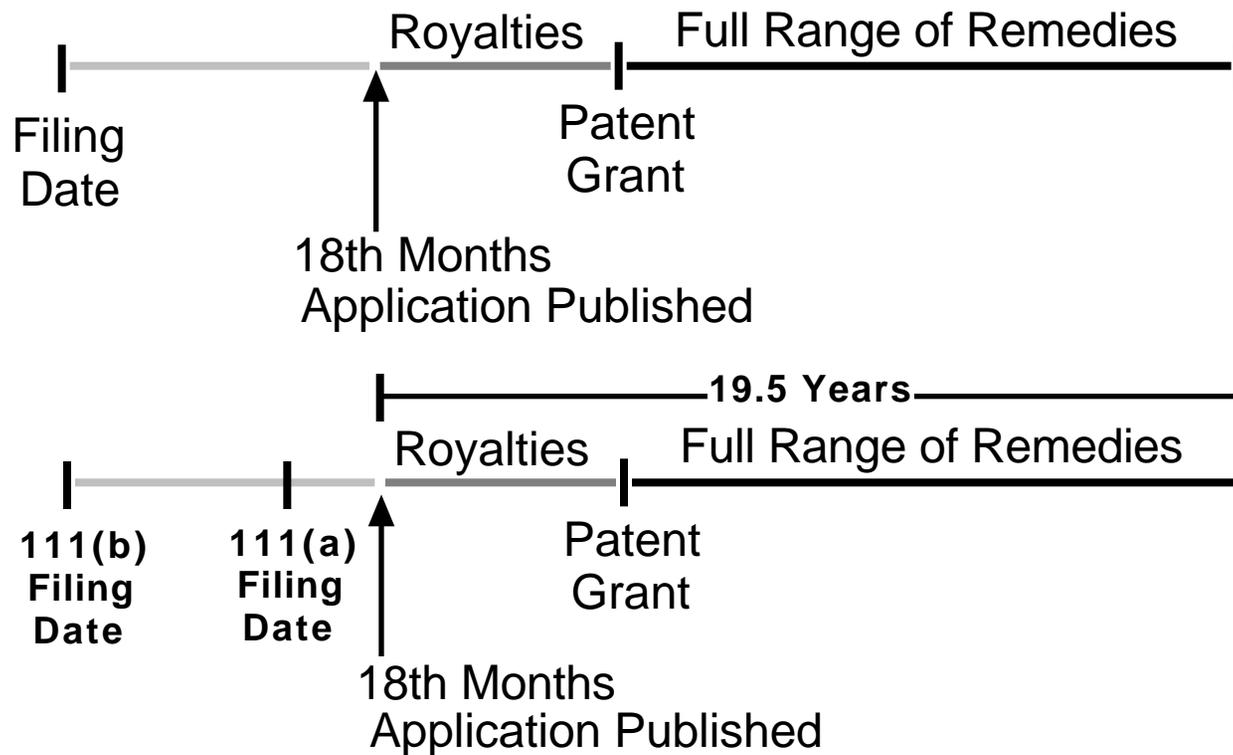
Provide Early English Language Publication of Foreign Originated Applications

Make Complete Application Record Accessible After Publication

Published Application Enjoys Status as Prior Art on Application Filing Date (102(e))



Example of Provisional Rights in 18 Month Publication System



Reexamination Reform

Expands Participation by Third Party Requester

- Right to Respond to Each Action/Response
- Appeal Right with Statutory Preclusion if Appeal to Federal Circuit

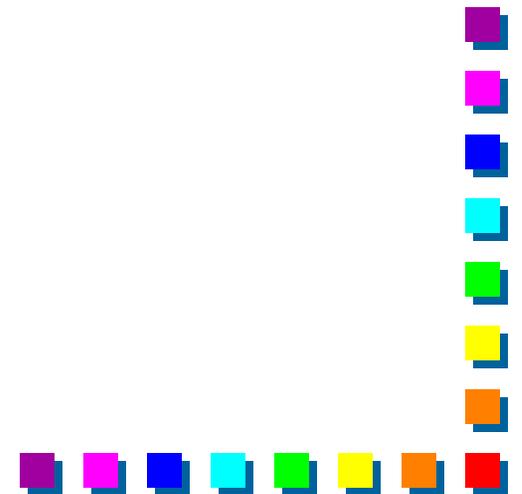
Expands Bases for Requesting Reexamination to Include Section 112 Grounds Except Best Mode



Process Patent Legislation (H.R. 587)

**Would Overrule In re Durden (e.g.,
would place process of making
claims on par with process of using
claims)**

**Currently Limited to “Biotechnology”
Products**



**For Further Information on the
Uruguay Round Agreements Act
Changes, Call Our Help Line at
800-PTO-2224**

Thank You!!

**Patent and Trademark Office
United States Department of Commerce**

