



## ARE Patent Law Alert: USPTO Issues A Final Rule to Implement the Patent Law Treaty

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On October 21, 2013, [the USPTO published a final rule in the Federal Register](#) to implement the provisions of the Patent Law Treaty (PLT) in accordance with the Patent Law Treaties Implementation Act of 2012. The PLT is a multilateral treaty adopted by World Intellectual Property Organization in June of 2000 to harmonize certain patent application procedures to reduce or eliminate formalities and the potential for loss of patent rights. The USPTO's final rule will take effect on December 18, 2013.

The final rule includes the following notable revisions to the USPTO's rules of practice:

### **Filing Date Requirements for a Non Provisional Patent Application:**

The final rules modify the requirements for a non-provisional patent application to qualify to a particular filing date as follows:

- A non-provisional patent application no longer needs to contain at least one claim to be entitled to a filing date. The applicant will be given a period of time within which to file one or more claims and pay the required surcharge (\$140 for a large entity) to avoid abandonment.
- A non-provisional patent application may be filed "by reference" to a previously filed domestic or foreign application in lieu of filing the specification and drawings. To do so, the applicant needs to make a reference in an application data sheet to a previously filed application, indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the IP authority or country in which it was filed. The applicant will be given a period of time within which to file a copy of the specification and drawings from the previously filed application and an English language translation of the previously filed application (if applicable), and pay the required surcharge (\$140 for a large entity) to avoid abandonment.

Both of these changes will make it easier for nonprovisional applications to be filed.



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## **Restoration of Patent Rights:**

The final rule eliminates the current provisions for revival of abandoned applications (37 C.F.R. § 1.137(a)) or acceptance of delayed maintenance fee payments (37 C.F.R. § 1.378(b)) on the basis of a showing of “unavoidable delay.” The final rule provides for the revival of abandoned applications and acceptance of delayed maintenance fee payments solely on the basis of “unintentional delay” and payment of the petition fee (\$1,700 for a large entity).

## **Restoration of Right of Priority to a Prior-Filed Foreign Application:**

If the non-provisional application is filed after the expiration of the 12-month period (6-month period for a design application) set forth in 35 U.S.C. § 119(a), but within two months from the expiration of the 12-month period (6-month period for a design application), the right of priority to a prior foreign application in the subsequent application may be restored upon petition and payment of the petition fee (\$1,700 for a large entity) if the delay in filing the subsequent application within 12-month (6-month) period was unintentional.

## **Restoration of Right to Benefit of a Prior-Filed Provisional Application:**

If the non-provisional application or PCT application designating the United States is filed after the expiration of the 12-month period set forth in 35 U.S.C. § 119(e), but within two months from the expiration of the 12-month period, the benefit of a prior-filed provisional application in the subsequent application may be restored upon petition and payment of the petition fee (\$1,700 for a large entity) if the delay in filing the subsequent application within the 12-month period was unintentional.

## **Reduction of Patent Term Adjustment:**

To prevent an applicant from obtaining a patent term adjustment by taking advantage of the opportunities to delay the examination process provided by the PLT, there will be a reduction of any patent term adjustment if an application is not in condition for examination within 8 months from either the filing date or the date of commencement of the national stage in a PCT application.

Please feel free to contact us if you would like further information regarding the upcoming changes in the Patent Office rules of practice.



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