

**A BILL**

To amend title 35, United States Code, to implement the provisions of the Patent Law Treaty.

*Be it enacted by the Senate and the House of Representatives of the United States of America in Congress Assembled,*

1 **SECTION 1. SHORT TITLE.**

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3 This Act may be cited as the “Patent Law Treaty Implementation Act.”

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5 **SEC. 2. PROVISIONS TO IMPLEMENT THE PATENT LAW TREATY.**

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7 (a) APPLICATION FILING DATE. --

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9 (1) Sections 111(a)(3) and (4) of title 35, United States Code, are amended to read as  
10 follows:

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12 “(3) FEE, OATH, AND CLAIMS. - The application must be accompanied by the  
13 fee required by law. The fee, oath, and one or more claims may be submitted after the  
14 filing date of the application, within such period and under such conditions, including the  
15 payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the

1 fee, oath and one or more claims within such prescribed period, the application shall be  
2 regarded as abandoned.

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4 “(4) FILING DATE. - The filing date of an application shall be the date on which  
5 a specification, with or without claims, is received in the United States Patent and  
6 Trademark Office.”

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8 (2) Sections 111(b)(3) and (4) of title 35, United States Code, are amended to read as  
9 follows:

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11 “(3) FEE. - The application must be accompanied by the fee required by law. The  
12 fee may be submitted after the filing date of the application, within such period and under  
13 such conditions, including the payment of a surcharge, as may be prescribed by the  
14 Director. Upon failure to submit the fee within such prescribed period, the application  
15 shall be regarded as abandoned.

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17 “(4) FILING DATE. - The filing date of a provisional application shall be the date  
18 on which a specification, with or without claims, is received in the United States Patent  
19 and Trademark Office.”

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21 (3) Section 111 of title 35, United States Code, is amended by adding at the end, the  
22 following new subsection (c):

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1           “(c) A reference made upon the filing of an application under subsection (a) to a  
2 previously filed application shall, as prescribed by the Director, constitute the  
3 specification and any drawings of the subsequent application for purposes of a filing date.  
4 A copy of the specification and any drawings of the previously filed application may be  
5 submitted after the filing date of the application, within such period and under such  
6 conditions as may be prescribed by the Director. Upon failure to submit the copy of the  
7 specification and any drawings of the previously filed application within such prescribed  
8 period, the application shall be regarded as abandoned.”

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10 (b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHTS. --

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12 (1) Section 21(b) of title 35, United States Code, is amended to read as follows:

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14           “(b) If the day, or the last day, for taking any action or paying any fee in the  
15 United States Patent and Trademark Office, or of any of the periods fixed in sections 102,  
16 111, 119, 122, 135, 151, 156, 172, 251 and 304 of this title, falls on Saturday, Sunday, or  
17 a federal holiday within the District of Columbia, the action may be taken, or fee paid on,  
18 and the period shall be extended to, the next succeeding secular or business day.”

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20 (2) Unintentional Standard. -- Chapter 2 of title 35, United States Code, is amended by  
21 adding at the end the following new section:

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23           “Sec. 27. Revival of applications; reinstatement of reexamination proceedings.

1           The Director may establish procedures to revive an unintentionally abandoned  
2 application for patent, accept an unintentionally delayed payment of the fee for issuing  
3 each patent, or accept an unintentionally delayed response by the patent owner in a  
4 reexamination proceeding, upon petition by the applicant for patent or patent owner.”

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6 (3) The Director may refund any part of the fee specified in section 41(a)(7) of title 35,  
7 United States Code, in exceptional circumstances as determined by the Director.

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9 (c) RESTORATION OF PRIORITY RIGHT --

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11           (1) Section 119(a) of title 35, United States Code, is amended to read as follows:

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13           “(a) An application for patent for an invention filed in this country by any person  
14 who has, or whose legal representatives or assigns have, previously regularly filed an  
15 application for a patent for the same invention in a foreign country which affords similar  
16 privileges in the case of applications filed in the United States or to citizens of the United  
17 States, or in a WTO member country, shall have the same effect as the same application  
18 would have if filed in this country on the date on which the application for patent for the  
19 same invention was first filed in such foreign country, if the application in this country is  
20 filed within twelve months from the earliest date on which such foreign application was  
21 filed; but no patent shall be granted on any application for patent for an invention which  
22 had been patented or described in a printed publication in any country more than twelve  
23 months before the date of the application for patent in this country, or which had been in

1 public use or on sale in this country more than twelve months prior to such filing. The  
2 Director may prescribe regulations, including the requirement for payment of a  
3 surcharge, under which the twelve-month periods set forth in this subsection may be  
4 extended by an additional two months if the delay in filing the application in this country  
5 within the twelve-month periods was unintentional.”

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7 (2) Section 119(e)(1) of title 35, United States Code, is amended to read as  
8 follows:

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10 “(e)(1) An application for patent filed under section 111(a) or section 363 of this  
11 title for an invention disclosed in the manner provided by the first paragraph of  
12 section 112 of this title in a provisional application filed under section 111(b) of this title,  
13 by an inventor or inventors named in the provisional application, shall have the same  
14 effect, as to such invention, as though filed on the date of the provisional application filed  
15 under section 111(b) of this title, if the application for patent filed under section 111(a) or  
16 section 363 of this title is filed not later than 12 months after the date on which the  
17 provisional application was filed and if it contains or is amended to contain a specific  
18 reference to the provisional application. The Director may prescribe regulations,  
19 including the requirement for payment of a surcharge, under which the twelve-month  
20 period set forth in this subsection may be extended by an additional two months if the  
21 delay in filing the application under section 111(a) within the twelve-month period was  
22 unintentional. No application shall be entitled to the benefit of an earlier filed provisional  
23 application under this subsection unless an amendment containing the specific reference

1 to the earlier filed provisional application is submitted at such time during the pendency  
2 of the application as required by the Director. The Director may consider the failure to  
3 submit such an amendment within that time period as a waiver of any benefit under this  
4 subsection. The Director may establish procedures, including the payment of a  
5 surcharge, to accept an unintentionally delayed submission of an amendment under this  
6 subsection.”

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8 (3) Section 365(b) of title 35, United States Code, is amended to read as follows:

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10 “(b) In accordance with the conditions and requirements of section 119(a) of this  
11 title and the treaty and the Regulations, an international application designating the  
12 United States shall be entitled to the right of priority based on a prior foreign application,  
13 or a prior international application designating at least one country other than the United  
14 States. The Director may establish procedures, including the payment of a surcharge, to  
15 accept an unintentionally delayed claim for priority based on the treaty and the  
16 Regulations, and to accept a priority claim where such priority claim pertains to an  
17 application that was not filed within the priority period specified in the treaty and  
18 Regulations but was filed within the period specified under section 119(a).”

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20 (4) Section 102(b) of title 35, United States Code, is amended to read as follows:

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22 “(b) the invention was patented or described in a printed publication in this or a  
23 foreign country or in public use or on sale in this country, before the earlier of (1) twelve

1 months prior to the date of the application for patent in the United States, or (2) the filing  
2 date of the earliest priority application to which the application is entitled and claims  
3 priority under sections 119(a) - (d) or (f), 172, or 365(a) or (b), or”.

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5 (5) Section 102(d) of title 35, United States Code, is amended to read as follows:

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7 “(d) the invention was first patented or caused to be patented, or was the subject  
8 of an inventor’s certificate, by the applicant or his legal representatives or assigns in a  
9 foreign country prior to the date of the application for patent in this country on an  
10 application for patent or inventor’s certificate filed before the earlier of (1) twelve months  
11 before the filing of the application in the United States, or (2) the filing date of the  
12 earliest priority application to which the application is entitled and claims priority under  
13 sections 119(a) - (d) or (f), 172, or 365(a) or (b), or”.

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16 **SEC. 3. CONFORMING AMENDMENTS.**

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18 (a) FILING DATE FOR APPLICATIONS FOR DESIGN PATENTS. -- Section 171 of  
19 title 35, United States Code, is amended by adding the following sentence:

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21 “The filing date of an application for design patent shall be the date on which the  
22 specification as prescribed by section 112 of this title and any required drawings are  
23 filed.”

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(b) RELIEF IN RESPECT OF TIME LIMITS AND REINSTATEMENT OF RIGHTS. --

(1) Section 41(a)(7) of title 35, United States Code, is amended by deleting at the end thereof the following: “unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110”.

(2) Section 41(a)(7) of title 35, United States Code, as that section is to be administered pursuant to section 801(a) of Division B of Public Law 108-447, is amended by deleting at the end thereof the following: “, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500”.

(3) Section 41(c)(1) of title 35, United States Code, is amended to read as follows:

“(c)(1) The Director may accept the payment of any maintenance fee required by subsection (b) after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.”

1 (4) Section 122(b)(2)(B)(iii) of title 35, United States Code, is amended by deleting at the  
2 end thereof the following: “, unless it is shown to the satisfaction of the Director that the  
3 delay in submitting the notice was unintentional”.

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5 (5) Section 133 of title 35, United States Code, is amended to read as follows:

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7 “Upon failure of the applicant to prosecute the application within six months after  
8 any action therein, of which notice has been given or mailed to the applicant, or within  
9 such shorter time, not less than one month, as fixed by the Director in such action, the  
10 application shall be regarded as abandoned by the parties thereto.”

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12 (6) Section 151 of title 35, United States Code, is amended to read as follows:

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14 “If it appears that applicant is entitled to a patent under the law, a written notice  
15 of allowance of the application shall be given or mailed to the applicant. The notice shall  
16 specify a sum, constituting the issue fee, which shall be paid within six months thereafter,  
17 or within such shorter time, not less than two months, as fixed by the Director.

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19 “Upon payment of this sum the patent may issue, but if payment is not timely  
20 made, the application shall be regarded as abandoned.”

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22 (7) Section 364(b) of title 35, United States Code, is amended to read as follows:

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1           “(b) An applicant's failure to act within prescribed time limits in connection with  
2 requirements pertaining to an international application may be excused as provided in the  
3 treaty and the Regulations.”

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5 (8) Section 371(d) of title 35, United States Code, is amended, in the third sentence, by  
6 deleting the phrase “, unless it be shown to the satisfaction of the Director that such  
7 failure to comply was unavoidable”.

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10 **SECTION 4. EFFECTIVE DATE**

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12 The amendments made by this Act shall be effective on the date that is one year after the  
13 date of enactment of this Act, and shall apply to all patents, whenever granted, and to all  
14 applications for patent pending on or filed after the date that is one year after the date of  
15 enactment of this Act. The amendments made by this Act, however, shall have no effect  
16 with respect to any patent that is the subject of litigation in an action commenced before  
17 the date that is one year after the date of enactment of this Act.