

Section-by-Section Analysis

SECTION 1. SHORT TITLE. This Act may be cited as the “Patent Law Treaty Implementation Act.”

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

This section amends the relevant provisions of title 35, United States Code, to comply with the requirements of the Patent Law Treaty (PLT). The amended provisions are divided into three subsections in section 2 of the bill: (a) those provisions of title 35, United States Code, relevant to patent application filing date; (b) those provisions of title 35, United States Code, relevant to relief in respect of time limits and reinstatement of rights; and (c) those provisions of title 35, United States Code, relevant to restoration of the priority right. Each subsection is addressed separately.

(a) Application Filing Date

This subsection amends sections 111(a)(3) and (4) and sections 111(b)(3) and (4) of title 35, United States Code, and adds a new section 111(c) to title 35, United States Code. The amendments to sections 111(a)(3) and (4) and sections 111(b)(3) and (4) eliminate claims as a filing date requirement for applications filed under section 111(a), more closely align the corresponding provisions of sections 111(a) and 111(b) and more clearly distinguish the filing date requirements in those sections from the more substantive requirements of sections 112 and 113 of title 35, United States Code.

Section 111(a)(3) is amended by changing the heading to include the phrase “AND CLAIMS” and by providing that not only the fee and oath, but also one or more claims, may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director of the United States Patent and Trademark Office. Additionally, the section is amended to provide that upon failure to submit the fee, oath, and one or more claims within such prescribed period, the application shall be regarded as abandoned.

Section 111(a)(4) is amended by changing the heading to “FILING DATE” and by deleting the first sentence and amending the second sentence to provide that the filing date of an application shall be the date on which a description is received in the Patent and Trademark Office. The provision in Article 5(1)(b) of the PLT is noteworthy in the context of a filing date requirement as it permits a Contracting Party to accept a drawing as a description. This ability is considered to be consistent with current decisional law in the United States and no change in that regard is intended. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

Section 111(b)(3) is amended to provide that the application must be accompanied by the fee required by law, that the fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director and that upon failure to submit the fee within such

prescribed period, the application shall be regarded as abandoned. The section is also amended to delete the last clause; with the subject matter therein addressed in new section 27, discussed below.

Section 111(b)(4) is amended by providing that the filing date of a provisional application shall be the date on which a description is received in the Patent and Trademark Office.

Section 111 is further amended by providing a new subsection (c) that provides that a reference made upon the filing of an application to a previously filed application shall, as prescribed by the Director, constitute the description of the subsequent application for purposes of a filing date. New subsection (c) further explains that a copy of the specification and any drawings of the previously filed application may be submitted after the filing date of the application, within such period and under such conditions as may be prescribed by the Director, and that upon failure to submit the copy of the specification and any drawings of the previously filed application within such prescribed period, the application shall be regarded as abandoned.

(b) Relief in Respect of Time Limits and Reinstatement of Rights

This subsection amends section 21(b) of title 35, United States Code, and adds a new section 27 to Chapter 2 of title 35, United States Code.

Section 21(b) of title 35, United States Code, is amended to provide that if the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office, or of any of the periods fixed in sections 102, 119, 122, 135, 156, 172, and 251 of this title, falls on Saturday, Sunday, or a federal holiday within the District of Columbia, the action may be taken, or fee paid on, and the period shall be extended to, the next succeeding secular or business day. As amended, the carry-over provision of section 21(b) will apply to all of the filing period requirements in those enumerated sections of title 35, thereby codifying and extending Ex parte Olah, 131 USPQ 41 (Bd. App. 1960). These amendments are consistent with the PLT requirements that operate to avoid loss of rights due to the unavailability of relief in respect of time limits.

Chapter 2 of title 35, United States Code, is amended by providing a new section 27, with the heading “Revival of applications; reinstatement of reexamination proceedings,” which provides that the Director may establish procedures to revive an unintentionally abandoned application for patent, accept an unintentionally delayed payment of the fee for issuing each patent, or accept an unintentionally delayed response by the patent owner in a reexamination proceeding, upon petition by the applicant for patent or patent owner. This new section is intended to provide a basis for the establishment of a consistent unintentional standard for relief, referred to in the discussion of subsequent amendments and conforming amendments.

(c) Restoration of Priority Right

This subsection amends sections 119(a), 119(e)(1), and 365(b), as well as 102(b) and 102(d) of title 35, United States Code.

Section 119(a) is amended by providing a consistent twelve-month time period throughout and vis-à-vis the amendments made in sections 102(a) and 102(d), discussed below. Additionally, section 119(a) is amended by providing that the Director may prescribe regulations, including the requirement for payment of a surcharge, under which the twelve-month periods set forth in this subsection may be extended by an additional two months if the delay in filing the application in this country within the twelve-month period was unintentional.

Section 119(e)(1) is likewise amended to provide that the Director may prescribe regulations, including the requirement for payment of a surcharge, under which the twelve-month period set forth in this subsection may be extended by an additional two months if the delay in filing the application under section 111(a) within the twelve-month period was unintentional.

Section 365(b) is similarly amended to provide that the Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim for priority based on the treaty and the Regulations, and to accept a priority claim where such priority claim pertains to an application that was not filed within the priority period specified in the treaty and Regulations but was filed within the period specified under section 119(a).

Section 102(b) of title 35 is amended to conform the one-year period to a twelve-month period and to accommodate delayed filings under amended sections 119(a) - (d). The accommodation for delayed filings is necessary to avoid the time bar that would otherwise operate when an application is filed in the United States more than twelve months after the filing of the priority application and, for example, a reference arises in that interval between the filing of the priority application and the delayed filing date in the United States. The same rationale applies to the amendment made to section 102(d), addressed below. As such, amended section 102(b) provides a basis for a lack of novelty if the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, before the earlier of (1) twelve months prior to the date of the application for patent in the United States, or (2) the filing date of the earliest priority application to which the application is entitled and claims priority under sections 119(a) - (d). Delayed filings under section 119(e) are accommodated in section 102(b)(1), as amended.

Section 102(d) of title 35 is also amended to accommodate delayed filings under amended sections 119(a) - (d). To that end, amended section 102(d) provides a basis for a loss of right if the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country or on an

application for patent or inventor's certificate filed before the earlier of (1) twelve months before the filing of the application in the United States or (2) the filing date of the earliest priority application to which the application is entitled and claims priority under sections 119(a) - (d).

SEC. 3. CONFORMING AMENDMENTS.

This section makes conforming amendments to various provisions of title 35, United States Code.

Section 171 of title 35 is amended, in light of the changes to section 111, discussed above, to provide that the filing date of an application for design patent shall be the date on which the specification as prescribed by section 112 of this title and any required drawings are filed.

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".

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".

Section 41(a)(8) of title 35 is amended to delete the reference to "in an application" to apply the extension of time provisions to proceedings in patents, as well as in applications.

Section 41(c)(1) of title 35, United States Code, is amended to conform procedures for the late payment of maintenance fees to those provided for revivals of applications and reinstatement of reexamination proceedings by newly established section 27 of title 35, as discussed above. To that end, the twenty-four month time limit for unintentional delays has been deleted and the provision is limited to relief for unintentional delays, consistent with the unintentional standard set in newly established section 27 of title 35.

Section 133 of title 35, United States Code, is amended to provide for a one-month time period, as opposed to a thirty-day time period, consistent with other amendments to set affected time periods in terms of months, and to conform the standard of relief for delays to the unintentional standard set in newly established section 27 of title 35.

Section 151 of title 35, United States Code, is amended to provide for a six-month period for the payment of the issue fee, which may be shortened as fixed by the Director to not less than two months. Additionally, the second paragraph is amended by changing "shall" to "may," and the third and fourth paragraphs are deleted. The lapsed patent practice in the now deleted, last two paragraphs of section 151 would not have been consistent with PLT Article 10(1).

Section 364(b) of title 35, United States Code, is amended to provide that an applicant's failure to act within prescribed time limits in connection with requirements pertaining to an international application may be excused as provided in the Patent Cooperation Treaty and the Regulations. The reference to an unavoidable standard for relief has also been deleted.

Section 371(d) of title 35, United States Code, is amended to delete the reference to an unavoidable standard for relief.

SECTION 4. EFFECTIVE DATE

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