

Statement of Purpose and Need

Background

The Patent Law Treaty was concluded during a Diplomatic Conference held at the World Intellectual Property Organization (WIPO) in Geneva, Switzerland from May 11 to June 2, 2000. The Patent Law Treaty, Regulations under the Patent Law Treaty and Agreed Statements by the Diplomatic Conference were adopted by the Diplomatic Conference on June 1, 2000.

The Patent Law Treaty traces its roots to substantive patent law reform discussions that began in 1984 to harmonize and/or establish an international grace period. Those discussions continued until June 1991, during which a first part of a Diplomatic Conference to conclude the then-Patent Law Treaty was held. The second part of the Diplomatic Conference was scheduled for July 1993, but was not held. In January 1994, the United States discontinued substantive patent law harmonization discussions due to a lack of domestic support for the effort.

The international community was greatly disappointed by the “loss of momentum” on the subject of substantive patent law harmonization as a result of the position of the United States. Due to the residual interest in international patent law reform, the discussion of harmonization, limited to formal matters, was revived in 1995. Five sessions of the Committee of Experts and three sessions of its successor, the Standing Committee on the Law of Patents, were held to develop the “Basic Proposal” for the Diplomatic Conference, which was held from May 11 to June 2, 2000.

The Final Act of the Treaty, bearing witness to the Diplomatic Conference and its outcome, was signed by 104 countries and three Intergovernmental Organizations; 43 countries actually signed the Patent Law Treaty. The United States signed both the Final Act and the Treaty. The Patent Law Treaty includes 27 articles and 21 rules.

Discussion

The Patent Law Treaty (hereinafter PLT) does not involve WIPO as there are no centralized functions. The PLT sets forth, with one exception, maximum formal/procedural requirements that Contracting Parties may impose on patent applicants and patentees. Otherwise, Contracting Parties are free to provide requirements that, from the viewpoint of applicants and owners, are more favorable than PLT requirements. The one exception to this freedom is the filing date provision, which is both a maximum and a minimum, i.e., a “filing date standard.”

Upon entry into force, the PLT will simplify the formal obligations and reduce associated costs for patent applicants and owners of patents in obtaining and preserving their rights in inventions in many countries of the world. The PLT complements our existing international obligations and furthers our policy of strong intellectual property protection. The PLT will make it easier for United States patent applicants and patent owners to obtain and maintain patents throughout the world, as well as in the United States, by

simplifying and, to a large degree, merging national and international formal requirements associated with patent applications and patents.

The principle features of the PLT offer the following advantages:

- simplifies and minimizes application filing date requirements;
- imposes a maximum on the formal requirements that Contracting Parties may impose;
- eases representation requirements for formal matters;
- provides a basis for means of communications, including the electronic filing of applications;
- provides relief in respect of time limits that may be imposed by the Office of a Contracting Party and re-instatement of rights where an applicant or owner has unintentionally failed to comply with a time limit and that failure has the direct consequence of causing a loss of rights; and
- provides for correction or addition of priority claims and restoration of priority rights.

The proposed Patent Law Treaty Implementation Act makes limited changes to the federal patent law, contained in title 35 of the United States Code and known as the "Patent Act of 1952." The provisions proposed for amendment are contained in three sections: (a) those provisions of title 35, United States Code, relevant to patent application filing dates, (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 the restoration of the priority right. Among other things, the claim requirement for a filing date for a patent application filed under section 111(a) of title 35 is eliminated and reference filing is accommodated in a new section 111(c). Reinstatement of rights is made uniform throughout title 35 and is based on an unintentional standard. Restoration of the priority right is provided by accommodating delayed filings in sections 119(a) and (e)(1), 102(a) and 102(d) of title 35. Additionally, conforming amendments are provided.

In light of the fact that the proposed amendments will simplify and streamline our own patent law and practice, both administratively within the United States Patent and Trademark Office and for all United States patent applicants, the proposed amendments would take effect on the date that is one year after the date of enactment of the Act and would 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 the Act. That is, because the changes required for compliance with the PLT are desirable, in and of themselves, the effective date of the proposed Act is not contingent on entry into force of the PLT.