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## USPTO Publishes Final Rules for Implementation of the Patent Law Treaty

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### **Implementation of the Patent Law Treaty**

On October 21, 2013, the United States Patent and Trademark Office published final rules for implementing the Patent Law Treaty. The Patent Law Treaty seeks to harmonize the filing and processing procedures of patent applications throughout the world. The overall implications of these rules, which become effective on December 18, 2013, will likely be limited for most applications and patents. However, the new rules may protect the rights of applicants and patent owners in certain instances that would have otherwise been fatal. Particularly, the rules modify several US procedures, including: reducing the requirements to obtain a filing date; allowing for the revival of abandoned applications or lapsed patents; and allowing for the restoration of priority claims.

### **Reduced Requirements for Obtaining a Filing Date for a Patent Application**

Under the new rules, the technical requirements for obtaining a filing date for a non-provisional application will be eased. For instance, a non-provisional patent application will be granted a filing date even if the application does not contain a single claim so long as it satisfies the other technical requirements of 35 USC § 111 and 37 CFR §§ 1.51 and 1.53. In contrast, a non-provisional patent application filed today without a claim will not be granted a filing date.

Accordingly, under the new rules, an applicant may have more time to decide what type of claims will be included in an application. However, the applicant will be required to file at least one claim and pay an additional fee (currently set at \$140) before the application can be examined. Also, the current rules allow for a simple placeholder claim to be filed with an application and later amended via preliminary amendment without a fee. Thus, while the new rules may reduce the number of prosecution history estoppel issues, the benefit of the new rules will likely be most useful in avoiding catastrophic situations that may occur under the current rules including, for example, mistakenly filing an application without a claim on the last day before a statutory bar.

The new rules further provide for the filing of a non-provisional application "by reference" to a previously filed application. In filing an application "by reference," the specification and drawings of

the previously filed application will constitute the newly filed application. The usefulness of this filing procedure will also likely be limited, as copies of the specification, drawings and, if applicable, a translation of the previously filed application will be required before examination. Filing "by reference" will also require payment of an additional fee, currently set at \$140. However, if copies of the previously filed application or a translation of the application are not readily available at the time of filing, filing an application "by reference" may prove very useful in protecting an applicant's rights.

### **Revival of Abandoned Applications, Acceptance of Late Fees, and Acceptance of Late Responses in Reexamination Proceedings**

Upon implementation of the new rules, the USPTO may revive abandoned applications and accept delayed maintenance fee payments, delayed issue fee payments, and delayed responses by a patent owner in a reexamination proceeding. However, the USPTO will only revive an application or accept these late fee payments and responses if the delay by the applicant or patent owner was unintentional. The applicant or patent owner must additionally pay a fee, currently set at \$1,700. If the delay was due to a widespread disaster such as an earthquake, the USPTO may refund part or all of the fee. However, the new rules eliminate the current "unavoidable delay" provisions in favor of a single unintentional delay standard.

### **Untimely Priority Claims**

The new rules further allow for the correction of a missed priority claim. Particularly, an applicant will now be able to claim priority to a previously filed provisional application or foreign application after the 12-month statutory deadline (or six-month deadline for design applications). The untimely claim of priority, however, may only be made if the delay was unintentional. Additionally, the applicant must make the claim of priority within two months of the expiration of the 12-month period (or six-month period for design applications) and be accompanied by the required fee, currently set at \$1,700.

### **Patent Term Adjustment**

Finally, the new rules provide for a reduction of patent term if an application is not in condition for examination within eight months of its filing date or commencement of its national stage. This reduction in patent term is part of an effort by the USPTO to avoid any abuse of the new rules that may delay the examination process, such as by filing without a claim or "by reference."

In summary, the new rules taking effect December 18, 2013 move the United States toward harmony with other countries that are signatories to the Patent Law Treaty and affect current procedures in at least three notable ways:

- reduced requirements to obtain a filing date;
- restoration of abandoned applications and lapsed patent rights in the event of an unintentional delay; and
- correction of missed priority claims.

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## *Authors*



**Thomas E.  
Anderson**

PARTNER

✉ [tom.anderson@wilmerhale.com](mailto:tom.anderson@wilmerhale.com)

☎ +1 202 663 6227