

Restoration of Priority

Patent Cooperation Treaty
Advanced Seminar
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The Patent Law Treaty has been around for some seven years

For some seven years, Congress has tried, off and on, to pass legislation to permit the US to satisfy the PLT

Now finally in Fall of 2012, Congress managed to pass the Act that would permit the US to satisfy the PLT

On December 18, 2012, the President signed the Act

This is a big deal and it is very important

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What did the President sign on December 18, 2012?

- The President signed the “Patent Law Treaties Implementation Act of 2012”
- This Act permits the US to join the Hague Agreement (one-stop shopping for international design protection)
- This Act permits the US to satisfy the PLT
- This Act cleans up previous drafting errors made by Congress that are unrelated to Hague or PLT

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What will we learn about today?

- This presentation will skip over the Hague Agreement aspects of the Patent Law Treaties Implementation Act of 2012 (this is Title I of the Act)
- We will talk about the PLT aspects of the Act
- This is contained in Title II of the Act

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Timetable for implementation of Title II of the Act

- Title II of this Act requires USPTO to do “rulemaking”
- First, USPTO will publish a Notice of Proposed Rulemaking in the Federal Register
- Interested parties will file comments
- USPTO will review the comments and design the final rules
- USPTO will publish the Final Rules in the Federal Register

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Timetable for implementation of Title II of the Act

- NPR – around April 18, 2013
- Comments due – two months later, around June 18, 2013
- Final rules – November 18, 2013
- Effect of Final Rules and effect of most of Title II of the Act – December 18, 2013

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Restoration of Priority

- Article 4 of the Paris Convention establishes a 12-month period in which to do a second filing that is intended to enjoy a filing-date benefit from an earlier “priority” application
- We all recall a case where a well-known patent firm faced an \$88M verdict for failing to satisfy the 12-month period for filings outside of the US

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Restoration of Priority

- Until a couple of years ago, if you missed the 12-month period, there was no way to overcome the omission
- PCT came to the rescue! Nowadays, if you miss the 12-month period, but if you discover your mistake before 14 months have passed, you can file a PCT application and ask that the priority benefit be “restored”

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Restoration of Priority

- A request for ROP in a PCT application may be made based upon an “unintentional” standard or a “due care” standard
- The request for ROP is made in the first instance to the Receiving Office
- The RO may or may not grant the request
- If the RO denies the request, then you get another bite at the apple. You can renew the request before the DO/EO

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Picking your RO if you are going to request ROP

- RO/US only entertains ROP requests based upon the “unintentional” standard
- RO/US charges \$1410 for such a request
- RO/IB entertains both kinds of ROP request
- RO/IB charges no fee for the request
- If you are going to use RO/IB, make sure you know whether you need a Foreign Filing License
- If you need an FFL, get it before filing in RO/IB

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But ROP does not work everywhere

- Not every DO/EO will permit ROP
- This means there are places where you might enter the national phase and the ROP would not work
- US is such a place
- But starting on December 18, 2013, US will permit ROP for US national-phase applications
- This is because of Title II of the Act

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WIPO has a very handy table that summarizes the status of ROP around the world

Restoration of the right of priority by receiving Offices (RO) and designated Offices (DO) under PCT Rules 26bis.3 and 49ter.2 (Last updated 24 April 2012)

A | B | C | D | E | F | G | H | I | J | K | L | M | N | O | P | R | S | T | U | V | Z

A

| TWO-LETTER CODE | CONTRACTING STATE OR ORGANIZATION | DOES THE OFFICE ACCEPT REQUESTS FOR THE RESTORATION OF THE RIGHT OF PRIORITY? | IF YES, WHICH CRITERIA DOES THE OFFICE APPLY? | IS THERE A FEE? |
|-----------------|-----------------------------------|---|---|--|
| | | AS RECEIVING OFFICE | AS DESIGNATED OFFICE | |
| AE | United Arab Emirates | See IB¹ | Yes | Please refer to the Office for the applicable criteria and/or any fee payable for such requests. |

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Applicability of ROP for US patent applications

Title II of the Act makes ROP available for any US utility application that is pending on or after December 18, 2013

This will be subject to rules that are not yet final

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Applicability of ROP for US patents

Title II of the Act makes ROP available for any US utility patent issued before, on, or after December 18, 2013

This will of course be subject to rules that are not yet final

This works only for US patents that have avoided being the subject of litigation prior to December 18, 2013

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Applicability of ROP for US patents

Title II of the Act makes ROP available for any US utility patent issued before, on, or after December 18, 2013, from an application that claims benefit from a provisional application

Depending upon the rules established by USPTO, this may prompt patent owners to review their portfolios and to ask for retroactive ROPs for some granted patents

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Sometimes a PCT application claims priority from a prior US application

- When the US national phase is entered from such a PCT application, the relationship between it and the priority application has nothing whatsoever to do with Article 4 of the Paris Convention
- The relationship is defined by 35 USC § 119e or by 35 USC § 120
- We call this “domestic benefit” (or, more sloppily, “domestic priority”)
- Title II of the Act permits ROP to be employed to overcome the problem of missing the 119e 12-month period in such domestic benefit cases

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Sometimes a PCT application claims priority from a prior US application

- Title II of the Act permits ROP to be employed to overcome the problem of missing the 119e 12-month period in such domestic benefit cases
- The practice tip is that if an applicant has missed a 12-month period filing a US non-provisional application from a US provisional application ...
- ROP will save the day
- In such a case, you will file a PCT within 14 months and enter the US national phase. Or you can file a US domestic application under Section 111(a) within 14 months.
- This overcomes the mistake of missing the 12 months under 35 USC § 119e

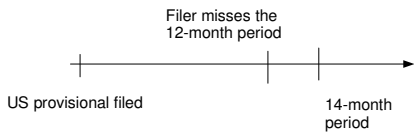
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Title II of the Act

- From this it may be seen that Title II of the Act can serve to remedy a lapse that is purely domestic in its facts – failure to file a non-provisional application within 12 months of the filing of a provisional application

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Example 1: US provisional filer misses 12 months

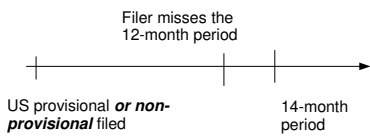


US non-provisional application (35 USC section 111(a)) filed in USPTO within 14 months with granted "unintentional" ROP request (probably \$1410)

US non-provisional application will enjoy restored domestic benefit under 35 USC Section 119(e)

This is no help regarding foreign patent rights

Example 2: US filer misses 12 months

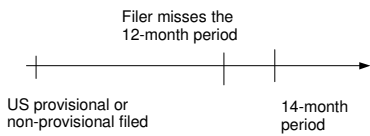


PCT filed in RO/US within 14 months with granted "unintentional" ROP request (\$1410)

Some foreign designations (the Offices that accept "unintentional" ROP) will enjoy restored priority under Article 4 of Paris

(if first filing was a provisional) US designation will enjoy restored domestic benefit under 35 USC Section 119(e)

Example 3: US filer misses 12 months



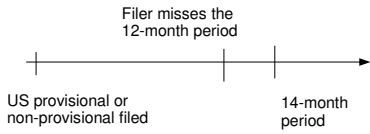
PCT filed *in RO/IB* within 14 months with granted "unintentional" ROP request (**no fee**)

Some foreign designations (the Offices that accept "unintentional" ROP) will enjoy restored priority under Article 4 of Paris

(if first filing was provisional) US designation will enjoy restored domestic benefit under 35 USC Section 119(e)

The FFL in the US provisional might cover the filing in RO/IB

Example 4: US filer misses 12 months



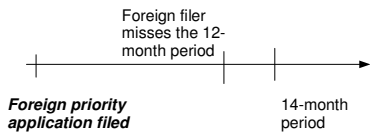
PCT filed in RO/IB within 14 months with granted "due care" ROP request (no fee)

More foreign designations (those Offices that accept either "unintentional" or "due care" ROP) will enjoy restored priority under Article 4 of Paris

(if first filing was provisional) US designation will enjoy restored domestic benefit under 35 USC Section 119(e)

The FFL in the US provisional might cover the filing in RO/IB

Example 5: *inbound PCT within 30 months*



PCT filed in RO/IB (or some other RO) by foreign filer within 14 months with granted "unintentional" or "due care" ROP request (no fee)

Some foreign designations will enjoy restored priority under Article 4 of Paris but that's not our point in this slide

US national-phase entry will enjoy restored priority under Article 4 of Paris
