

USPTO PRESENTATION ON

20 YEAR TERM

FINAL RULE PACKAGE.

United States Patent Practice in a Post Uruguay Round World



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The Uruguay Round Agreement

- ✦ Most Comprehensive Intellectual Property Agreement Ever Negotiated
- ✦ Key Patent Provisions include:
 - Product Patent Protection in Essentially All Fields of Technology
 - Consistent Rights and Remedies
 - Limits on Compulsory Licensing and other Patent Diminishing Foreign Practices
 - 20 Year Patent Term

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Summary of Major Domestic Changes

- ✦ Twenty Year from Filing Date Patent Term
- ✦ Provisional Patent Applications
- ✦ Proving Invention Dates With Foreign-Generated Evidence
- ✦ Infringement by Importation and Offers for Sale

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NOTICE:

- ✦ Proposed rules at **59 FR 63951 (December 12, 1994)** and **1170 OG 377 (January 3, 1995)**.
- ✦ **Final Rules Published April 25 (FR) and May 2 (OG)**

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Twenty Year Patent Term

- ✦ Affects Utility and Plant Patents, *Not Design Patents*
- ✦ Rights Begin on Issue Date and End 20 Years After the Earliest Effective Filing Date *Claimed by the Applicant*
- ✦ 20 Year Term Applies to Any Application filed **ON OR AFTER JUNE 8, 1995**

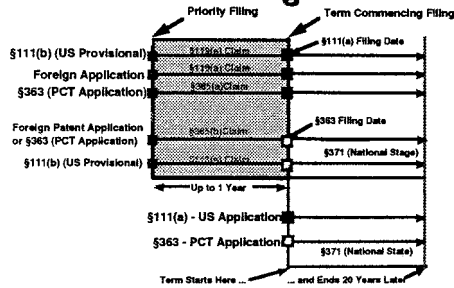
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Twenty Year Patent Term

- ✦ Rights Start on the Issue Date and End 20 Years From the Earliest Effective Filing Date

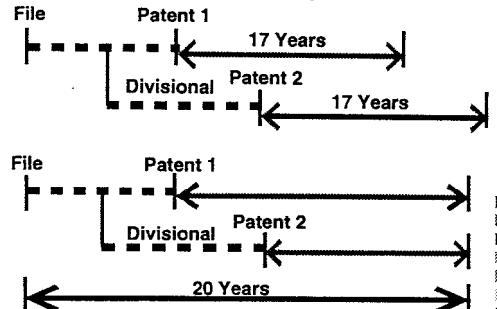
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20 Year Term Filing Scenarios



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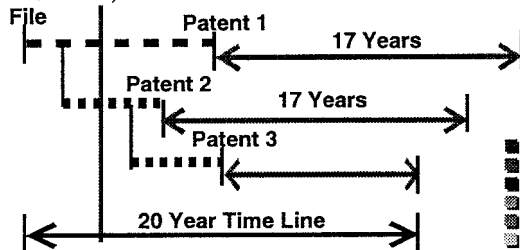
Contrast (17 vs 20) Divisional



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20 Year Term Effective Date

Effective Date
JUNE 8, 1995



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Patent Term Extensions (Rule 701)

- ✦ Patent Term Will Be Extended for Pre-Grant Delays due to Appeals, Interference or Secrecy Orders
 - Some Limits on Appeal Extensions
- ✦ Maximum Extension is 5 Years
- ✦ Independent of Regulatory Delay Extensions under 35 USC § 156

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Patent Term Extensions (Rule 701)

- ✦ Secrecy Orders Under § 181
 - Extension Equal to Days in Period Beginning on Date Secrecy Order Imposed and Ending Date Secrecy Order Rescinded

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Patent Term Extensions (Rule 701)

- ✦ Interference Proceedings Under §135
 - ◊ Extension Equal to Days in Period Beginning on Date Interference Declared and Ending on Date Interference Terminated
 - ◊ Applications Suspended by the Office Due to Interference Determination But Not Involved in Interference May Be Extended for Period of Suspension

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Patent Term Extensions (Rule 701)

- ✦ **Successful Appellate Review at Board or Federal Court (e.g., All Rejections on At Least One Claim Reversed)**
 - ◇ Extension Equal to Days in Period Beginning on Date Appeal to Board Filed and Ending on Date of Final Decision by Board / Federal Court in Favor of Applicant

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Patent Term Extensions (Rule 701)

- ✦ **Limits on Extensions for Appeals:**
 - Patent Not Subject to a Terminal Disclaimer
 - Extension Period Reduced by:
 - ➔ Portion of Appeal that Occurs Before Third Year of Pendency
 - ➔ Time During Appellate Review During Which Applicant Did Not Act With Due Diligence

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Patent Term Extensions (Rule 701)

- ✦ **Acts That Will Constitute *Prima Facie* Lack of Due Diligence During Appeal Period Include:**
 - Abandonment of Application During Appellate Review Period
 - Suspension at Applicant's Request Under §1.103(a) During Appellate Review Period

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Proposed vs. Final §1.701

- ✦ **Proposed § 1.701(d)(2)**
 - Time Period Considered in Determining Lack of Due Diligence is Entire Pendency of Application
- ✦ **Final § 1.701(d)(2)**
 - Time Period Considered in Determining Lack of Due Diligence is Appellate Review Period

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Proposed vs. Final §1.701

- ✦ **Proposed § 1.701(d)(2)**
 - Prima Facie Acts of Lack of Due Diligence are:
 - ◇ Extensions of Time
 - ◇ Filing of Informal Application
 - ◇ Filing of Submissions Not Fully Responsive
- ✦ **Final § 1.701(d)(2)**
 - Prima Facie Acts of Lack of Due Diligence are:
 - ◇ Abandonment of Application
 - ◇ Request for Suspension under §1.103(a)

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Provisional Applications

- ✦ **Simplified Filings (no oath/declaration, no claims required)**
- ✦ **Inexpensive – \$75 for Small Entities**
- ✦ **Is a Regular US National Filing**
 - Provides Internationally Recognized Priority Date

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Provisional Application Requirements (Rules 51(a)(2) and 53(b)(2))

- ✦ Disclosure to Comply with §112 1st ¶**
- ✦ Any Drawings Necessary to Understand Invention**
- ✦ Naming of At Least One Inventor**
- ✦ Cover Sheet to Identify as Provisional Filing**
- ✦ Filing Fee (\$150/\$75)

** Elements Needed for Obtaining a Filing Date

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Perfecting a Provisional Application Filing

(Rules 51(a)(2) and 53(b)(2))

- ✦ Application Which Has Been Given Filing Date But Which Lacks the Filing Fee or a Complete Cover Sheet Can be Perfected
- ✦ Applicant Will be Given Time to File Missing Parts with Payment of \$50/\$25 Surcharge
- ✦ Provisionals May Be Revived Up to 1 Year After They Go Abandoned But Cannot Pending More Than 12 Months

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Elements of the Cover Sheet

- ✦ Identifies Application as Provisional
- ✦ Name and Residence of Each Inventor
- ✦ Title of Invention
- ✦ Name/Registration # of Attorney/Agent (if applicable)
- ✦ Docket Number (if applicable)
- ✦ Correspondence Address
- ✦ Name of US Gov't Agency and Gov't Contract Number Having Interest in Application

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Proposed vs. Final §1.51(a)(2)(ii)

- ✦ Proposed §1.51(a)(2)(ii)
 - No Requirement for Residence of Inventors
 - No Requirement to Note Gov't Interest in Application
- ✦ Final §1.51(a)(2)(ii)
 - Identification of Residence of Each Named Inventor
 - Identification of Government Interest in Application, with Indication of Agency and Contract Number
- ✦ Reason: Necessary Elements for National Security Processing of Application

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Provisional Filing Status

- ✦ §111(a) Application Must be Filed Within 12 Months from Provisional Filing Date to Claim Benefit of Date
- ✦ Provisionals Will Go Abandoned
 - 12 Months After Filing Date By Operation of Law or
 - Upon Failure to Correct Formality Defect (fee not paid or defective cover sheet)
 - You May Correct and "Revive" a Provisional Up to a Year After It Goes Abandoned for Failure to Correct Defect

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Provisional Application Filing Issues

- ✦ May Be Filed in Language Other Than English
- ✦ Verified English Translation and Fee under §1.17(k) Must Be Filed With Application or Within Time Set by Office

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Inventorship in Provisional Applications

- ✦ §111(a)/363 Filing Needs to Have One Inventor in Common to Claim Benefit of Provisional Filing Date, per §119(e)
- ✦ Each Named Inventor Must Have Made Contribution to Invention Described in Provisional Application (37 CFR §1.45(c))
- ✦ Better to be Overinclusive Rather than Underinclusive in Naming of Inventors

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Inventorship in Provisional Applications

- ✦ Inventors May Be Added or Deleted by Filing Petition With Statement that Omission Occurred Without Deceptive Intent
- ✦ If No Common Inventor Between 111(a) and Provisional, Petition with Fee of \$50 Must Be Filed to Add At Least One Common Inventor
- ✦ Statement of Facts and Written Consent of Assignee Required

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Proposed vs. Final §1.48

- ✦ Proposed §1.48
 - Petition Fee of \$50 Subject to 50% Small Entity Reduction
- ✦ Final §1.48
 - Petition Fee of \$50 NOT Subject to 50% Small Entity Reduction

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Proposed vs. Final §1.48

- ✦ Proposed §1.48
 - Inventor May Be Added If Omission Due to Error Without Deceptive Intent and Petition Fee Paid (§1.48(d))
- ✦ New §1.48(e)
 - Inventor May Be Added (§1.48(d)) or Deleted (1.48(e))
 - To Delete Inventor Named on Provisional, Fee, Statement of Facts and Written Consent of Assignee Required

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Features of the Provisional Application

- ✦ Kept in Confidence by Office (Same as §111(a) Patent Applications)
 - Access and Certified Copies Only Given to Parties With Written Authority from a Named Inventor or Assignee/Attorney/Agent of Record
 - Request From Other Party Will Result in Certified Copy Being Sent to Correspondence Address on Application
- ✦ Not Examined and Go Abandoned by Operation of Law After 12 Months

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Features of the Provisional Application

- ✦ Filing Starts the Paris Convention Priority Year
 - You Cannot Claim Priority to an Earlier Domestic or Foreign Filing in a Provisional Application
 - You Can File Multiple Provisional Applications and Consolidate them in the §111(a) Filing
- ✦ Filing Does Not Start Patent Term

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Conversion of §111(a) Applications to Provisionals

- + You May Convert a §111(a) to a §111(b) through a Petition [Rule 53(a)(2)(ii)] if Filed Before the Earlier of the:
 - Payment of Issue Fee or
 - Expiration of 12 Months From the 111(a) Filing Date
 - Abandonment of Application
 - Prior to Conversion of Application to Statutory Invention Registration
- + Petition Fee of \$50 Must Be Paid

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Conversion of §111(a) Applications to Provisionals

- + Why Would You Do This?
 - Push Back Start of Term Up to 1 Year
 - Obtain Some Prosecution During "Provisional" Year
 - Correct Error in Filing - Under Rule 53(a)(2)(i), an Application Filed Without Indication Treated As §111(a) Filing
- + Fees Properly Paid Under §111(a) Will Not be Refunded

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Proposed vs. Final §1.53(a)(2)(ii)

- + Proposed §1.53(a)(2)(ii)
 - Petition Fee for Conversion of 111(a) to 111(b) Subject to 50% Reduction for Small Entities
- + Final §1.53(a)(2)(ii)
 - Petition Fee for Conversion of 111(a) to 111(b) NOT Subject to 50% Reduction for Small Entities

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Proposed vs. Final §1.53(a)(2)(ii)

- + Proposed §1.53(a)(2)(ii)
 - Conversion to Provisional Must Occur Before Payment of Issue Fee or Expiration of 12 Months From Filing Date
- + Final §1.53(a)(2)(ii)
 - Conversion to Provisional Must Also Occur Before Abandonment of Application and Before Conversion to SIR

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Proposed vs. Final §1.53(a)(2)(iii)

- + Proposed §1.53(a)(2)(iii)
 - Requirements for Nucleotide/Amino Acid Sequence Listings in Computer Readable Form [§1.821(e)] "Not Applicable" to Provisional Applications
- + Final §1.53(a)(2)(iii)
 - Requirements related to Nucleotide/Amino Acid Sequence Listings in Computer Readable Form [§1.821 to 1.825] "Not Mandatory" for Provisional Applications

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Provisional Application Reminders

- + Cannot Claim Benefit of Earlier Filing or Priority
- + Cannot Be Used With Design Applications
- + Are Not Examined and Cannot Mature into a Patent
- + Cannot Become Involved in Interferences
- + Cannot Be Converted into SIR Application
- + Cannot be Filed Before June 8, 1995
- + Value Dependent on Breadth of Disclosure

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Additional Rule and Practice Changes

- ✦ §1.1(i) Establishes “Box Provisional Patent Application”
- ✦ §1.9(a) Defines “Provisional Application” as Application Filed under 111(b) and “Nonprovisional Application” as Application Filed Under 111(a) or National Stage Application Filed Under §371

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Additional Rule and Practice Changes

- ✦ § 1.28(a) Provides That a Nonprovisional Application Claiming Benefit Under §119(e), 120, 121 or 365(c) May Rely on Verified Statement Filed in the Prior Application, if Small Entity Status is Still Proper and Desired, by:
 - Referencing the Statement Filed in Earlier Application, or
 - Including Copy of Statement Filed in Earlier Application

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Additional Rule and Practice Changes

- ✦ §1.53(d)(1) - Proposal to Delete Processing and Retention Fee Practice Withdrawn
- ✦ §1.60 - Proposal to Delete Rule 60 is Withdrawn

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Additional Rule and Practice Changes

- ✦ Rule §1.62 Changes
 - Procedures Under §1.62 NOT Available for Filing a 111(a) Application Claiming Benefit of a Provisional Application Through 119(e)
 - Procedures Under §1.62 ARE Available After Payment of Issue Fee in Prior Application Provided Petition Under §1.313(b)(5) Granted in Prior Application

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Additional Rule and Practice Changes

- ✦ §1.78(a)(3) – Clarifies that for Nonprovisional Application to Claim Benefit of One or More Prior Provisional Applications It Must
 - Be Copending with Provisional(s)
 - Have at Least One Inventor in Common With Provisional
 - Claim Invention Disclosed in Provisional in Compliance with §112, First Paragraph
 - Be Complete (§1.51(a)(2)) or Be Entitled to a Filing Date and Have Had Filing Fee Paid

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Additional Rule and Practice Changes

- ✦ §1.78(a)(4) - Any Nonprovisional Application Claiming Benefit to Provisional Must Indicate in First Line After Title Claims to Provisional Application(s) with Indication of Provisional Application Number

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Additional Rule and Practice Changes

- ✦ §1.139(a) Sets Forth Procedures for Reviving a Provisional Application Which Was Abandoned Due to Unavoidable Delay
- ✦ §1.139(b) Sets Forth Procedures for Reviving a Provisional Application Which Was Abandoned Due to Unintentional Delay

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Additional Rule and Practice Changes

- ✦ §3.21 Provides that Assignment of Provisional Application Executed Before Its Filing Date Must Identify the Provisional Application by Name of Each Inventor and Title of Invention

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Transition After Final Practice (Rule 129)

- ✦ Permits Filing and Consideration of a Submission After Final Rejection Has Been Imposed Where Such Submission Would Not Ordinarily Be Entered or Considered
- ✦ Use to Have Office Consider...
 - Information Disclosure Statement
 - New Arguments or New Evidence
 - Amendments

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Transition After Final Practice (Rule 129)

- ✦ Affects Only Those Cases Pending on **June 8, 1995, with an Effective Filing Date Before June 8, 1993.**
- ✦ Can Be Used **Twice**, provided:
 - ➔ **Payment of Fee After Notice of Non-Entry of Submission**
 - ➔ **Submission Is Filed Prior to or With Notice of Appeal**

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Transition After Final Practice (Rule 129)

- ✦ **Examiner Must Withdraw Finality and Consider New Submission in the Same Way As With Any Response to a Non-Final Office Action**
- ✦ **Any Submission After-Final, After an Applicant Has Twice Paid the Transition After-Final Fee, Is Treated in the Same Manner As a Submission After-Final Under Current Practice**

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Proposed vs. Final §1.129(a)

- ✦ **Proposed § 1.129(a)**
 - Submission Filed Prior to Notice of Appeal and Fee Paid Within 1 Month from Notice Refusing Entry of Submission
- ✦ **Final Rule §1.129(a)**
 - **Submission and Fee filed Prior to Filing of Appeal Brief**

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Proposed vs. Final §1.129(a)

- ✦ Proposed §1.129(a)
 - Status of Finality of Previous Rejection Not Specified
- ✦ Final Rule §1.129(a)
 - Specifies that Finality of Previous Rejection Automatically Withdrawn Upon Timely Filing of Submission and Fee

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Proposed vs. Final §1.129(a)

- ✦ Proposed § 1.129(a)
 - § 1.17(r) Fee Not Subject to 50% Reduction for Small Entities
- ✦ Final Rule §1.129(a)
 - § 1.17(r) Fee is Subject to 50% Reduction for Small Entities

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Proposed vs. Final §1.129(a)

- ✦ Proposed § 1.129(a)
 - Submission will be entered "to the extent that it would have been entered and considered if made prior to final rejection."
- ✦ Final Rule §1.129(a)
 - Submission Will Be Treated In Same Manner As If Submission Was Denied Entry In Application Subsequently Refiled As File Wrapper Continuation

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Transition Restriction Practice (37 C.F.R. § 129)

- ✦ Permits Examination of More Than One Patentably Distinct Invention in a Single Application
- ✦ No Restriction Will Be Made in Cases Pending on June 8, 1995, with an Effective Filing Date Before June 8, 1992, Except Where
 - Restriction Requirement Was Made Earlier than April 8, 1995.
 - No Office Action Issued in Present or Parent Application Due to Actions of Applicant
 - Additional Fee Is Not Paid for Each Additional Invention

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Transition Restriction Practice (37 C.F.R. § 129)

- ✦ In Applications Eligible for Transition Restriction Procedure, Applicants will be Notified and Given Time to:
 - Elect and Pay Fee For Each Invention In Excess of One
 - File Petition Under § 1.129(b)(2) Traversing Restriction Requirement
 - ✦ NOTE: Fee Not Required Unless and Until Adverse Determination Made on Petition

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Transition Restriction Practice (37 C.F.R. § 129)

- ✦ In Applications Eligible for Transition Restriction Procedure, Applicants Will Be Able to:
 - Elect and Pay Fee For Each Additional Invention Where No Election Has Been Made Prior to Notice, and
 - Confirm Election in Restriction Requirement Made Prior to Notice, and Pay Fee for Additional Inventions Other Than One Earlier Elected.

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Proposed vs. Final §1.129(b)

- + Proposed § 1.129(b)
 - No Restriction Can Be Made or Maintained Except Where "the examiner has not issued an Office action in the Application due to actions by the applicant."
- + Final § 1.129(b)
 - No Restriction Can Be Made or Maintained Except Where "the examiner has not made a requirement for restriction in the present or parent application prior to 4/8/95 due to actions by the applicant."

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Proposed vs. Final §1.129(b)

- + Proposed § 1.129(b)
 - Applicant given 1 month from notice to pay fee for additional invention(s) in excess of one.
- + Final § 1.129(b)
 - "One Month" time period deleted. Time period for response will be set in the notice, which will usually be one month, but no less than 30 days.

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Proposed vs. Final §1.129(b)

- + Proposed § 1.129(b)
 - First Claimed Invention Will be Searched and Examined if Fee For Additional Invention Not Timely Paid.
- + Final § 1.129(b)
 - Applicant May Respond by (1) Electing and Paying Additional Invention Fee; (2) Confirming Previous Election and Paying Additional Invention Fee; or (3) Filing Petition Traversing Requirement.

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Proposed vs. Final §1.129(c)

- + Proposed § 1.129(c)
 - Transitional Procedures Not Applicable to Applications Filed on or After 6/8/95.
- + Final § 1.129(c)
 - Transitional Procedures Not Applicable to Applications Filed After 6/8/95. Applications Filed on 6/8/95 May Be Eligible for Transitional Procedures, But Will Be Subject to 20 Year From Filing Date Patent Term.

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Transition Patent Term

- + Patents in Force on June 8, 1995, or that Result from an Application Filed Before June 8, 1995, Will Have a Patent Term that Last the Longer of 17 Years From Grant or 20 Years from Filing Date
- + Remedies for the Extended Period May be Limited to Equitable Remuneration

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Additional Term-Related Considerations

- + Maintenance Fee Schedules Unaltered and Continue to Run from Grant Date
- + Applications that Will Yield Grant-Based Patent Term Must be Filed BEFORE JUNE 8, 1995.
- + Provisional Applications Cannot Be Filed Before June 8, 1995.

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Proving Date of Invention to Obtain a Patent

- ✦ §104 Changed to Preclude Discrimination as to Place of Invention
- ✦ Affects Interference and 37 CFR 1.131 Practice

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35 U.S.C. § 104

- ✦ ...an applicant for a patent ... may not establish a date of invention in a foreign country **OTHER THAN A NAFTA COUNTRY OR A WTO MEMBER COUNTRY** except as provided in section 119 and 365
- ✦ Limits on Use of Information Where Foreign Access to Evidence Limited

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37 CFR § 1.131

- ✦ ... facts showing a completion of the invention in this country **OR IN A NAFTA OR WTO MEMBER COUNTRY** before the filing date...

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Invention Date Changes are Prospective

- ✦ Cannot Prove Invention Date In NAFTA or WTO Country Before
 - NAFTA: 08 December 1993
 - WTO: 01 January 1996
- ✦ Does not Affect Prior Art-Related Inventive Activity Provisions [e.g., 102(a), 102(e), 102(g)]

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Notice

- ✦ Final Rules Relating to Changes to Interference Practice Were Published **March 17, 1995 at 60 FR 14488**
- ✦ Final Rule Relating to Changes to 37 CFR §1.131 is Expected to be Published in Early May

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Merits of the New System

- ✦ Most Patents Will Provide a Longer Period of Exclusive Rights than under Previous System
 - Over 75% of Applications are Original Filings
 - Average Pendency on Per Application Basis is 19.0 Months
- ✦ Note: Average Pendency is From Date of Filing to Final Disposition

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Merits of the New System (cont'd)

- ✦ **The Technology Averages Are As Follows**
 - ◇ **Electrical Applications:** the Pendency Average Is 22.2 Months
 - ◇ **Mechanical Applications:** the Pendency Average Is 17.7 Months
 - ◇ **Chemical Applications:** the Pendency Average Is 19.7 Months

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Merits of the New System (cont'd)

- ✦ **With the Provisional Application, 4 Years Must Pass Before Term of Rights in New System Less than That of Old System**
- ✦ **Most Patents Expire Due to Failure to Pay Maintenance Fees Before the 12th Year [Third Maintenance Fee Not Paid in over 75% of Patents]**
- ✦ **Ample Flexibility in New System to Maximize Patent Term**

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Merits of the New System (cont'd)

- ✦ **20 Year Term is Sound Public Policy:**
 - ✓ **Built In Incentive for Rapid Conclusion of Prosecution – Either to Issue or Appeal**
 - ✓ **Only Effective Way to Eliminate Abuses that Have Harmed American Interests**
 - ✓ **Assures Certainty in Expiration of Rights to a Single Inventive Concept**

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Merits of the New System (cont'd)

- ✦ **Patent Term Extensions Compensate For Delays Beyond Control of Applicant**
- ✦ **Applications Pending Today that Mature into Patents Will Have At Least 17 Years of Rights**
- ✦ **Provisional Applications Will Help Many Inventors**
 - Safety Valve for "Unexpected" Inventor Bar Dates
 - Permits Inexpensive Updating of Disclosures
 - Permits Deferral of Patent Term

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Some Additional Benefits...

- ✦ **"Partial" Harmonization Will Help US Inventors Gain Effective Patent Rights in Other Countries**
- ✦ **Two Japan-US Agreements Are Examples:**
 - Will Permit English Language Copy to Serve as Record Copy for Corrections of Errors in Translation
 - Will Eliminate Pre-Grant Oppositions
 - Will Provide 3 Year Examination Option
 - Will Eliminate Dependent Patent Compulsory Licensing Authority

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Things to Think About Now

- ✦ **Evaluate Status of Long-Pending Applications**
 - **Which Applications Do You Need to File Before the June 8 Cut-off Date?**
- ✦ **Factors Influencing Your Decision Should Be:**
 - > Value of the Underlying Invention
 - > Significance of Possibly Reduced Term
 - > Whether You Need to Rely on the Filing Date of the Earlier Application (e.g., CIP, Intervening Art)
 - > Where You Are in Prosecution of Pending Application

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Helpful Hints

- ✦ **Provisional Applications Cannot be Pending More than 12 Months, But Claims under 119(e) Must Be Made Between Copending Applications, So You Must File 111(a) Application Before Provisional Expires**
- ⊙ **Watch Out for Expiration Dates that Occur on Saturday, Sunday or Holidays!**

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Helpful Hints

- ✦ **Strategy for Maximizing Patent Term**
 - File 111(a) Application
 - Request "Special" Status
 - Convert to Provisional and File Second 111(a) Application Within 12 Months of First 111(a) Filing Date

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Helpful Hints

- ✦ **Strategy for Getting Early 102(e) Date When Using PCT Process**
 - File 111(b) Application
 - File PCT Application
 - File Subsequent 111(a) Application Based on PCT
- ✦ **NOTE: Using the PCT Process Will Also Defer Start of Maintenance Fee Due Dates!**

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Helpful Hints

- ✦ **In Cases Eligible for Transitional After Final Practice, Make Sure You Submit Any \$1.181 Petition Early to Minimize Payment of Extension Fees Since Case Must Be Pending When \$1.129(a) Fee is Paid!**

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Things to Think About Now (cont'd)

- ✦ **Outstanding Restriction Requirements**
- ✦ **Applications Eligible for Transitional Procedures**
- ✦ **How You Can Use the Provisional Application**
- ✦ **Rule Changes for 20 Year Term**
- ✦ **Ways To Expedite Prosecution**

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Other Legislation Initiatives Related to the New System

- ★ **18 Month Publication**
- ★ **Reexamination Reform**
- ★ **Process Patent Legislation**

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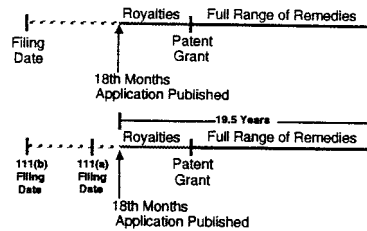
18 Month Publication Proposal

Administration's Proposed Legislation Would

- Publish Patent Applications 18 Months After Earliest Effective Filing/Priority Date
- "Provisional Rights" (Royalty Claim) Could Be Recovered for Infringement Between Publication Date and Issue Date
- Provide Early English Language Publication of Foreign Originated Applications
- Make Complete Application Record Accessible After Publication
- Published Application Enjoys Status as Prior Art on Application Filing Date (102(e))

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Example of Provisional Rights in 18 Month Publication System



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Reexamination Reform

- Expands Participation by Third Party Requester
 - Right to Respond to Each Action/Response
 - Appeal Right with Statutory Preclusion if Appeal to Federal Circuit
- Expands Bases for Requesting Reexamination to Include Section 112 Grounds Except Best Mode

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Process Patent Legislation (H.R. 587)

- Would Overrule In re Durden (e.g., would place process of making claims on par with process of using claims)
- Currently Limited to "Biotechnology" Products

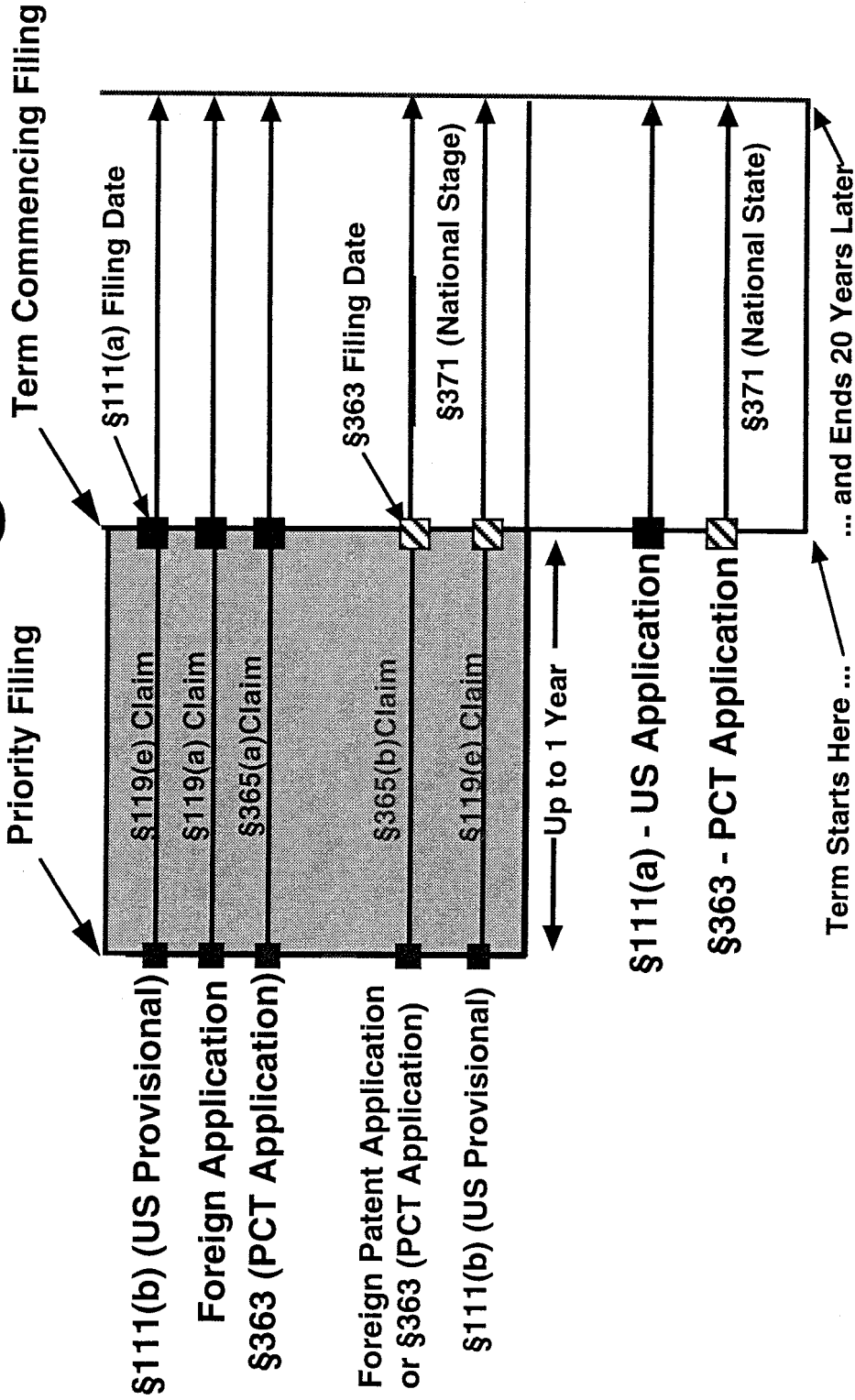
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For Further Information on the Uruguay Round Agreements Act Changes, Call Our Help Line at 800-PTO-2224

Thank You!!

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20 Year Term Filing Scenarios



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