



# Client Memorandum

October 29, 2013

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## Upcoming Changes to U.S. and Foreign Patent Filing Rules

### Introduction

Several new rule changes that will benefit patent filers will soon take effect. First, the U.S. Patent and Trademark Office (USPTO) has published new rules to implement a section of the Patent Law Treaties Implementation Act of 2012. The new rules will take effect December 18, 2013. Second, the European Patent Office has, once again, revised its rules for filing divisional applications, to take effect April 1, 2014.

### USPTO Prepares for the Patent Law Treaties Implementation Act

#### New Two-Month Window for Restoration of Priority Rights from U.S. Provisional and Foreign Applications

Under current rules, U.S. patent applications must be filed within 12 months of an earlier foreign or U.S. provisional application to claim priority from the filing date of the earlier application. Design patent applications must be filed within six months of the earlier-filed foreign application. These filing periods are strictly observed: filing the subsequent U.S. application even a day after the time period expires is considered untimely, and the applicant forfeits the right to claim priority to the foreign or U.S. provisional application. The forfeiture of priority may lead to forfeiture of the entire right to obtain a patent if there have been intervening acts or publications.

Under the new rules, if the 12 month due date (or six month due date, in the case of design applications) is unintentionally missed, applicants will be provided a two-month window after expiration of the filing period to file their U.S. application, as long as the delay in filing was unintentional. Applicants are cautioned not to treat the two-month window as merely an extension of time of the filing period, and may have to provide details if there is a question whether the delay was unintentional. Applicants are also cautioned not to further delay filing their U.S. application once they become aware that the due date was missed and they are still within the two-month window.

#### Modification of Certain Filing Formalities for U.S. Applications

The new rules will also dispense with several formalities concerning the form of U.S. applications that otherwise result in denial of an application filing date. For example, under current law, a filing date is not granted for a nonprovisional application filed without claims or for an application that fails to include drawings referenced in the application. Under the new rules, such applications will be granted a filing date. Nevertheless, best efforts should be made to file the application as complete as possible, because no new subject matter may be added to an application after it is filed. The rule change does not apply to design applications, which still must contain a claim and the necessary drawings.

Additionally, the new rules permit filing of U.S. applications by way of reference to a prior-filed application, which can be either another U.S. application or a foreign application. Under this rule, applicants will be required to identify certain qualifying data of the referenced application, but otherwise need not provide a copy of the application itself. Applications that are filed by reference will be considered as including the description and drawings of the referenced application. Applicants will later be given a period of time to supply the missing description, drawings, and claims.

### **European Divisional Application Filing Deadline**

Under current practice at the European Patent Office, the deadline for filing a divisional application—a continuing application that has the same description and drawings of a prior application—was set at 24 months from the date of one of a number of European Patent Office communications. The new rule, set to take effect on April 1, 2014, will allow the filing of divisional applications as long as the previously-filed application is still pending. Essentially, the deadline will be the date when a patent on the pending application is granted. The new rule will apply to all applications pending on April 1, 2014, and may result in opening previously expired divisional filing deadlines.

These changes benefit applicants by relaxing the deadlines and formalities involved in U.S. and foreign patent filings. Should you have any questions, we invite you to contact your COJK attorney.

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This memorandum is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this memorandum should be directed to your COJK attorney.