

# Avoiding Failed Patent Application Filings, 2023

By Rick Neifeld, Neifeld IP Law PLLC

Contents

I.	INTRODUCTION .....	- 1 -
II.	FILING BY THE DEADLINE.....	- 1 -
II.A	Scope Of The Problem.....	- 1 -
II.B	The Relation Between Missed Deadlines and The Professional Rules Of Conduct.....	- 1 -
II.C	Recognizing When A Risk of Missing A Deadline Arises.....	- 2 -
II.D	Communications With The Client Regarding The Legal Deadline .....	- 2 -
II.E	Benefits Of The Foregoing Communications .....	- 3 -
II.F	Docketing and Procedures For The Foregoing Communications .....	- 3 -
II.G	Exemplary Engagement Agreement Language .....	- 4 -
III.	FILING THE INTENDED DISCLOSURE.....	- 4 -
III.A	Procedures for Reliable Filing.....	- 4 -
III.B	DOCX Issues And Practices.....	- 5 -
III.C	Concerns Due To The Lack Of A Single DOCX File Format.....	- 5 -
III.D	Concerns Due To the PTO Changing the Uploaded DOCX File, Prior to Filing .....	- 7 -
III.E	Concerns Due To Inability To Prove Authenticity Of The Uploaded DOCX File .....	- 8 -
III.F	The “Auxiliary PDF.....	- 8 -
III.G	Performing A Pre Filing Review Using The Patent Center-Generated PDF, Before Filing.....	- 9 -
III.H	Retaining The Auxiliary PDF That You Uploaded to Patent Center, To Show Authenticity Of The Auxiliary PDF .....	- 9 -
III.I	Background Information On DOCX.....	- 12 -
IV.	FOREIGN FILING (FF) LICENSES.....	- 12 -
V.	NON-PUBLICATION REQUESTS .....	- 14 -
VI.	SECURING THE RIGHT OF PRIORITY (ROP).....	- 15 -
VI.A	Paris Article 4.....	- 15 -
VI.B	Rules of Law Relating to Paris Article 4.....	- 16 -
VI.C	The Timing Rule.....	- 16 -
VI.D	The All Applicants Rule.....	- 16 -
VI.E	The Exclusive Or Rule.....	- 17 -
VI.F	The Duly Filed Formal Assessment General Rule.....	- 17 -
VI.G	The “Duly Filed” Formal Assessment Rules Of the EPO .....	- 17 -
VI.H	The EPO Board’s Special Comments Regarding US Provisional Applications And Their Formal Assessment Rule .....	- 18 -
VI.I	The Substantial Legal Assessment To Determine Successor In Title Rule, EPO .....	- 18 -
VI.J	The Equitable Title/Beneficial Interest To Determine Successor In Title Rule, UK .....	- 19 -
VI.K	The Bone Fide Purchaser For Value Without Notice (herein after the “BFP”) Rule, UK.....	- 19 -
VI.L	The ROP Period, And The ROP Period Reset Rule.....	- 20 -

## I. INTRODUCTION

This paper is based upon my presentation at the 2023 annual meeting of the National Association of Patent Practitioners.

Throughout, I refer to certain rules of professional conduct, citing the corresponding rule numbers of the ABA model rules, the VA rules, and the PTO rules. For example, I use the citation form “**ABA/VA/PTO rules 1.4/11.104**” to refer to ABA and VA rule 1.4, and PTO rule 11.104. The ABA and VA rules generally have the same number. All three rules are generally identical.

The issues I cover deal with potential attorney legal error that may result in loss of a client’s rights, and therefore a colorable claim of malpractice. In that case, the attorney must self-report, so that the client can make informed decision how to proceed in view of the error and potential malpractice liability. ABA/VA/PTO rules 1.4/11.104. If there is a significant risk that the attorney cannot loyally represent the client, then the attorney should withdraw. ABA/VA/PTO rules 1.7(a)(2)/11.107. This loyalty issue can arise if the actions and advice the attorney may give can impact their malpractice liability exposure after negligence potentially harming the rights of a client. For example, a patent attorney’s advice regarding claim amendments or countries in which to proceed with national filings may in such a situation affect their malpractice liability exposure. In that case, the attorney may have a responsibility to withdraw.

The rest of this paper covers issues that can result in failed patent applications, prior to application filing, at time of application filing, and later on after application filing. The issues I cover below are filing by the deadline, filing the intended disclosure, foreign filing license requirements, non-publication requirements, and securing the Paris right of priority.

## II. FILING BY THE DEADLINE

### II.A Scope Of The Problem

There are a disturbingly high number of filing deadlines missed by attorneys.

Generally speaking, the standard for a court to accept a belated filing is a showing of excusable neglect.<sup>1</sup> Thus, many substantive court filings whose deadline was missed eventually get entered, with no loss of client rights. Even with that standard, legal malpractice insurers recognize several thousand claims annually, relating to missed deadlines. Fifteen percent of all malpractice claims are based upon missed deadlines.<sup>2</sup>

Belated patent application filings, however, are not belatedly accepted under an excusable neglect standard. And there are certain missed deadlines, such as statutory bar dates and Paris (referring to the Paris Convention for the Protection of Intellectual Property) deadlines, for which there is no complete relief from a missed deadline. Missing a patent application filing deadline can therefore give rise to prior art and statutory bars that makes the claimed invention unpatentable.

It is true that the PLT (Patent Law Treaty) and PLTIA (Patent Law Treaty Implementation Act, which amongst other things implements the PLT in United States national law) provides some relief from missed application filing deadlines. However, the PLT and PLTIA relief is not available at all in some countries, and where it is available it requires a showing of either due care or unintentionality, depending upon national law implementation. Consequently, missing a patent application filing deadline often presents a risk of irrevocably losing the potential to obtain certain patent rights. If that missed deadline is attributable to attorney negligence, then the attorney is also at risk for malpractice liability.

The rigid standard for excusing missed patent application filing deadlines suggests exercising heightened care to avoid missing those deadlines, to drive down the rate to near zero.

Unfortunately, my investigations show that all too often, about 0.2% of the time, patent application filing deadlines are missed.<sup>3</sup>

### II.B The Relation Between Missed Deadlines and The Professional Rules Of Conduct

As I explain below, compliance with the professional rules should substantially reduce the risk and occurrence of missed filing deadlines in general and patent application filing deadlines in particular, as well as substantially protect the attorney from missed-deadline negligence and corresponding malpractice liability.

Two professional rules are central. The rule requiring attorneys be both legally and technically competent. ABA/VA/PTO Rules 1.1/11.101. And the rule requiring that attorneys communicate with their clients sufficiently to “explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.” ABA/VA/PTO Rules 1.4(b)/11.104(b). I explain how complying with these rules in the context of filing deadlines protects both the client and the attorney below. In summary, identifying the risk of missing a deadline, and advising the client of that risk and its consequences, should substantially reduce the fraction of missed deadlines.

## II.C Recognizing When A Risk of Missing A Deadline Arises

Assume the attorney is legally competent, knows the relevant law and identified the correct filing deadlines. I focus on attorney technical competence.

The relevant attorney technical competence is the ability to execute on a client’s instruction to effect a patent application filing. But when that can first occur depends upon the client. The client must provide the disclosure of the application. Depending upon contractual arrangements, the client may have to advance the (substantial) government filing fees. And the client must provide certain other information, executed documents, and of course authorization to file. Hence, it is action by the client that defines that earliest point in time when the attorney can act to effect a patent application filing.

Filing a patent application is generally more complex than filing a court pleadings. Patent application filings require detailed technical knowledge and skills of various types. First, the attorney must know how to properly draft and revise patent specifications and claims, and drawings, including meeting formal requirements for online filing systems. This may include knowing how to convert and reformat drafts provided by clients in various formats. Moreover, there are requirements to know what formal documents are required, and how to prepare those documents. Then, there is specific knowledge how to properly use the USPTO’s (United States Patent and Trademark Office’s) and WIPO’s (World Intellectual Property System’s) patent application filing systems.

For example, the average time to prepare and file an otherwise ready-to-file patent application received from a foreign associate under normal circumstances may be several hours.<sup>4</sup>

However, an important factor that I find patent attorneys often fail to consider is how long it might take to file a patent application under abnormal but foreseeable circumstances that delay such a filing. Specific examples of abnormal but foreseeable circumstances are computer malfunction, power failure, network disruption, filing systems glitches, and personal illness. These things are all foreseeable because they are known to happen from time to time. Most attorneys have experienced these circumstances and understand that they can delay any action, including a patent application filing. This kind of circumstance present a foreseeable risk of delay. Accordingly, attorney should factor this risk into their interactions with clients in a manner that comports with professional rules.

A natural question to ask is how much time does an attorney need in advance of a deadline to avoid all risk of missing the deadline. That is equivalent to the maximum foreseeable period of delay. That maximum foreseeable period of delay sets a practical deadline in advance of the actual legal deadline. This practical deadline is the last date on which an attorney can commence filing with no foreseeable risk of missing the filing deadline.

This maximum foreseeable period of delay may vary from attorney to attorney, for example based upon work environment. However, any attorney should be able to identify their own maximum foreseeable period of delay, and therefore identify a practical deadline for each legal deadline.

Further, it is obvious that, after the practical deadline, the risk of missing the legal deadline increases as the time remaining prior to the legal deadline diminishes.

## II.D Communications With The Client Regarding The Legal Deadline

Having identified their own maximum foreseeable period of delay, an attorney is in a position to advise their client about the risk of loss due to the client’s delay in enabling the attorney to file.

The professional rule for communications with a client requires the attorney to provide the client the information required for the client to evaluate the risks of their potential courses of action so the client can make an informed decision. Regarding filing deadlines, that requirement is to advise the client of the risks and consequences of missing the deadline, when such a risk arises, and how that risk increases as the deadline approaches. I suggest that the attorney should also identify the underlying basis giving rise to that risk. I also suggest the attorney communicate to the client the actions the attorney intends to take prior to the deadline to keep the client advised on the status of responding to the deadline, as explained in more detail below.

## II.E Benefits Of The Foregoing Communications

First, those communications tends to motivate the client to act timely to provide the attorney what is needed to effect the filing.

Second, those communications meets the attorney's professional rule responsibilities to allow the client to make an informed decision about the risk/benefit of the client's potential delay.

Third, specifically identifying the basis of the practical deadline to be foreseeable but unavoidable occurrences clarifies that the attorney is not contractually limiting legal malpractice for a missed deadline. It is generally true that contractual limits on liability for legal malpractice are professional rule violations. ABA/VA/PTO Rule 1.8(h)/11.108(h).

Fourth, if the client does delay and the deadline is missed, then those communications meet the requirement of providing informed consent. *See* ABA/PTO Rule 1.0(e)/11.1. This would preclude an argument in a malpractice suit resulting from missing the deadline that the attorney was negligent per se by failing in their duty to disclose material information about the risks of delay.<sup>5</sup> Those communications would be probative, favorable to the attorney, on the legal malpractice elements of duty, standard of care, and proximate cause.

When should the attorney communicate these facts to the client? The sooner the better. For example, the underlying facts determining why there is a practical deadline and how far the practical deadline is in advance of any legal deadline, can be presented upon first communication with the potential client, in the engagement agreement, and upon commencement of each matter.

In each matter, and for each filing deadline, and each reminder about the deadline, those facts can be restated.

Moreover, if the practical deadline arrives that the attorney is still waiting on the client, the attorney should communicate that fact that a risk of being unable to file by the deadline exists, and that risk will increase as the legal deadline approaches.

Another foreseeable circumstance is client silence. Clients, and their level of professionalism and responsibility, vary. An attorney should recognize this and account for this variation, to protect the client from loss of rights and also to protect the attorney, when a client fails to timely communicate.

For example, some clients, despite repeated prompts are non-responsive. They neither instruct to proceed nor advise they have decided to abandon a matter. Some of those clients abandon by lack of response past the filing deadline. Others send last minute instructions just prior to the filing deadline. This kind of non-responsiveness presents the obvious risks that the filing deadline will either be missed, or rushed and thereby resulting in filing errors. It also is a very stressful event for an attorney, requiring the attorney to be 'chained to the desk' awaiting possible last minute instructions to avoid missing a legal deadline.

An attorney can provide suitable communications blunting the deleterious effects of a non-responsive client.

First, the attorney can expressly communicate early on in the representation that failing to provide sufficient time for the attorney to regularly review can result in filing errors, even if the filing deadline is met. In addition to the risk of being unable to file by the deadline.

Second, the attorney can communicate the fact that the attorney may be unavailable (for whatever reason, such as vacation or travel) during some time period starting before any legal deadline. And explain that the attorney therefore may not be able to perform any filings for instructions received close to a deadline, for that additional reasons. That "may" language casts the unavailability as a possibility. However, as a deadline approaches, and an attorney becomes aware of actual plans to be unavailable in advance of a filing deadline, they should communicate that actual period of unavailability to the client.

Finally, the attorney can, at the outset of communications, explain to the potential client that if the client intends to delay instructions to a point beyond the practical deadline, the attorney will decline to accept the matter and the potential client should seek other counsel.

## II.F Docketing and Procedures For The Foregoing Communications

Regarding communications, there are procedures that can be followed that ensure the client is and remains aware of the deadline and their obligations. These are conventional docketing and escalation procedures.

The docket reminders should include confirming the client received the attorney communication of a deadline and client requirements, and then a sequence of reminders (for example first, second, and a final reminder), a separate notification for when the risk of missing the deadline comes into existence noting the existence of that risk, and a separate notification when the attorney assumes that the client has abandoned the matter due to lack of communication. Finally, a notification once rights have been lost.

For critical communications, the attorney should have a communication escalation procedure. This is a procedure to follow in case the attorney does not receive confirmation that the client received the communication. The escalation procedure includes resends of the original communication, and a series of escalations in case of continuing lack of confirmation of receipt. These escalations include other channels of communication, such as alternate email addresses, alternate client contacts, telephone calls, fax, and postal transmissions.

## II.G Exemplary Engagement Agreement Language

Copied below is exemplary engagement agreement language relating to the foregoing communications.

### **Reporting**

Unless I expressly agree otherwise, I will report out all significant correspondence relating to your legal matters to you, via email.

You must reply by email, confirming your receipt of any email I send to you requesting your instructions.

You must notify me of your new email address, if your email address changes.

You must ensure that you do not block emails from ....

### **Timing of Instructions**

You should always plan on sending your instructions as soon as possible, so that I have time to reliably, and in an orderly manner, act on your instructions.

I advise you to send all instructions via email, and to confirm I timely received your instruction. I will confirm receipt by email.

### **New matters**

For a new application filing, I agree to go forward with the filing, only if you provide the required funds, information, and executed forms to me, not later than one month prior to any legal deadline for the application filing. If you do not believe you can comply, seek other counsel.

### **Ongoing matters, risk of missing a filing deadline due to delayed instructions**

Regarding ongoing matters for you that I am handling, I will always make a best effort to implement any instruction you provide once I have received your instruction and the required funds for implementing your instruction.

However, computer malfunction, power failure, network disruption, filing systems glitches, and personal illness are generally beyond my control and could delay my acting after receipt of your instruction. Consequently, there is a foreseeable risk, which increases as a legal deadline approaches that I will not be able to properly act on instructions you send to me within one month of the deadline. That risk rises rapidly from near zero probability at one month prior to the deadline until the deadline.

### **Consequences of missing a filing deadline**

The consequences of failing to meet a deadline may be irrevocable loss of all your rights for the application and claims. Therefore, by delaying your instructions (and any required funds therefore) to within one month of any deadline results in a risk that you will lose all of rights due to my inability to properly meet the deadline.

## III. FILING THE INTENDED DISCLOSURE

Another mechanism for failing in patent application filings is the filing of the wrong documents. For example, there are known instances of filings parts of one application in another application, and filing of a draft instead of a final version of some document. Moreover, the USPTO recently enabled a "DOCX" option for filing, and DOCX raises separate concerns that what actually is filed is not the intended disclosure.

### III.A Procedures for Reliable Filings

The risk of filing the wrong documents can be substantially reduced by employing suitable policies and procedures. I identify some procedures here.

Include in files, filenames, and folders, their docket number. This allows visual confirmation when viewing the contents of a file, and the name of the file, that the name of the folder, that the file is the intended file in the

intended location. When reviewing and working with documents, check that the internal identification, filename, and folder location all indicate the correct docket number.

Prepare a document filing list for each filing. This is a list of all documents to form the parts of the filing. This list allows the filer to confirm against the list whether all part of the filing have been filed. And then when filing confirm the documents on the list are been filed.

Retain a standard checklist for use with all filings. Act on the elements contained in a standard checklist, prior to filing. The checklist should prompt to check that documents have proper internal identifications, signatures, and format. For example, checking that pages dimensions and number, and claims numbered. That filename extensions (such as “.doc”; “.txt”; “.pdf” or “.docx”) meet the validation requirements of the online filing system. That file properties (such as embedded fonts) meet the validation requirements of the online filing system. Ideally, one could also check and verify that the actual file format of documents prepared for filing are in the file format that the online filing system uses to interpret those documents (see discussion of DOCX herein below).

Perform a pre-filing final review. Make sure that the document you now intend to file relates to the document you were instructed to draft or file. That is, compare the final against an original.

Perform internal cross-checks. Check for a match between the actual figures’ numbers and the description numbers in the Brief Description of the drawings. Check to make sure the brief description of a figure relates to the information portrayed by the figure. Check that the claims relate to the “Summary of the Invention” and figures. Check that the final version of the specification is complete (has not lost pages, for example in a pdf printing process); perform a paragraph by paragraph of page by page check for the presence of all content.

Perform a post filing confirmation. Shortly after completing online filing, when the online file is accessible, download the official file and verify that is what is on file is what you intended to file.

### III.B DOCX Issues And Practices

By way of introduction, for about two decades, the USPTO has provided filing of patent applications and follow-on amendments as PDF documents. Those are documents having a “\*.pdf” filename extension and prepared with a file format defined by the international PDF standard. The design goal of the PDF standard was to provide a file format that would display the same information independent of the hardware and software used to render the file on a computer monitor or printer. The PDF standard states, up front, that PDF is a file format and that it “enables the description of text and graphics in a device-independent and resolution-independent manner.” PDF derives from the PostScript page description language in order to provide “high performance in interactive viewing” on computer displays.<sup>6</sup>

More recently, the PTO has allowed applicants to file certain patent applications with files having the extension “\*.docx”. The PTO refers to this as “DOCX” filing. Effective 1/17/2024, an application that is not filed as a DOCX filing incurs a \$400 surcharge. *See* 37 CFR 1.16(u). In other words, filing an application in pdf format, instead of as a DOCX filing will soon incur a surcharge for that privilege. Moreover, the PTO has signaled that it intends to also require follow-on amendments in DOCX format.

The PTO’s DOCX filing system raises many interrelated reliability concerns.

### III.C Concerns Due To The Lack Of A Single DOCX File Format

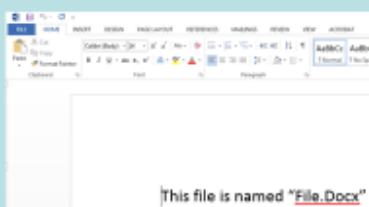
The first concern is that DOCX refers to the “\*.docx” filename extension and not to a uniquely defined file format.

Because “DOCX” does not define a unique file format, different software can render the same file to show different things depending what file format they are configured to use to interpret a file. As a gross example, see the rendering of a file named “File.docx” by Microsoft Word 2016 and Microsoft Notepad, below. This file was generated in Word 2016 and in Word 2016 shows the sentence “This file is named ‘File.Docx’.” However, Microsoft Notepad renders this file to show a bunch of meaningless characters.

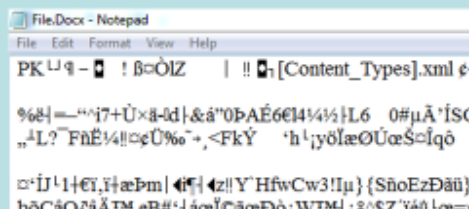
## PTO DOCX – Reliability Concerns

- “.docx” is a file extension, not a file format.
- “.docx” does not specify how the file appears on the screen.

### “File.docx” opened with Word 2016



### “File.docx” opened with Notepad



While Microsoft Notepad is not designed to open “\*.docx” files, this graphical representation illustrates the basis for the concern that the PTO’s “DOCX” filing system and corresponding DOCX rule. The PTO has not defined a single specific file format for DOCX files. Consequently, the file format in which a filer’s software drafts a DOCX and the file format of the PTO’s system uses to interpret a document may differ, and therefore what the PTO deems to be the disclosure in such a filing need not be what the filer intended to file.

Microsoft explains that “MS-DOCX” is the name for its file format specification for MS Word documents, and that this specification has been revised about 50 times since 2009.<sup>7</sup> Accordingly, there exist about 50 versions of file formats for MS Word files since 2009. All of these files formats are associated with the file extension “\*.docx”. Microsoft controls MS-DOCX and is free to further revise that file format standard at will.

There is also a publicly available open standard for file formats for office suite applications, including for word processing documents, which is identified as Office Open XML, often referred to as “OOXML.” OOXML was promulgated by ECMA, a standards organization, as ECMA-376, and subsequently adopted by the ISO as the ISO/IEC 29500 standard.<sup>8</sup>

MS-DOCX and OOSML are not the same thing. The relationship between MS-DOCX and OOXML file formats is that each revision of MS-DOCX includes the file formatting vocabulary of OOXML, but also includes extensions to that vocabulary. This leads to a concern that software programs that rely upon different versions of MS-DOCX will interpret the same file differently.

The OOXML standard allows for a form of compatibility with file formats that expand upon OOXML format, by specifying in OOXML special vocabularies that instruct OOXML to skip certain portions of the file, or replace data values in those portions of the file with dummy values. The MS-DOCX specification requires all of its extensions to include one of the OOXML special vocabularies, so that such a file literally complies with the OOXML public standard. For example, OOXML allows vocabulary instructing a program using OOXML to read a file to ignore certain data in the file when that data requires file format vocabulary not part of OOXML. This fact is significant in that it may explain claims that MS-DOCX is compliant with the OOXML public standard.

Also note that MS Word provides two distinct file formats that both save files with the same “\*.docx” file extension. In MS Word 2016, for example, the “Save As” dialog box presents the following two options: “Word Document (\*.docx)” and “Strict Open XML Document (\*.docx).” The “Word Document (\*.docx)” option may correspond to a transitional specification.<sup>9</sup> The “Word Document (\*.docx)” is the normal default in MS Word, and presumably saves files using that software’s latest updated revision of MS-DOCX.

PTO rule 1.16(u) does not specify a file format. It merely refers to “DOCX.” The only mention in the PTO’s notices promulgating the DOCX rule relating to file format appears in the Federal Register publication of the Final Rule, and only in response to comments. There, the PTO stated that “DOCX is a word-processing file format



that is part of Office Open XML (OOXML), an XML-based open standard approved by the ECMA International® consortium and subsequently by the ISO/IEC joint technical committee.”

However, that assertion is inaccurate. DOCX is not defined by the OOXML specification to be part of the OOXML standard. A standard is defined by its normative, that is, required elements. There is no normative part of the OOXML standard referring to “docx.” Instead, there are a few examples that use the phrase “docx.” Examples in standards appear for clarification, and are not requirements. So the PTO’s sole reference to relating DOCX to a file format is inaccurate. However, the PTO implied in the Final Rule that the file format they intended to use is the OOXML file format for word processing documents. The PTO web site’s guidance on DOCX filing now states that “DOCX is a word processing file format based on open standards, including Extensible Markup Language (XML),” instead of claiming that DOCX is a part of OOXML.<sup>10</sup> Both MS-DOCX and OOXML are open standards, in the sense that both are publicly available for download from the Internet.

Moreover, many commentators have reported that the PTO’s DOCX filing system has mangled uploaded DOCX documents, changing the meaning of chemical and mathematical formulas and computer code in the specifications. The PTO claims to have resolved identified issues. However, the failure of the PTO to identify a file format raises a significant concern that the PTO’s DOCX filing system remains susceptible to unidentified issues.


Still further, it remains unclear to the public what file format the PTO uses to read DOCX files submitted by applicants, and whether the PTO will timely notify the public if that file format changes. Users and the PTO have no control over when Microsoft revises MS-DOCX. And it is unclear how and the extent to which software from vendors other than Microsoft respond to revisions of MS-DOCX.

### III.D Concerns Due To the PTO Changing the Uploaded DOCX File, Prior to Filing

The PTO does not allow a filer to file the DOCX file the filer uploads to the PTO filing system. Instead, PTO software receives the uploaded DOCX file and then revises that file, and then allows the filer to inspect the revised file and decide whether to proceed with the filing the revised file.

The DOCX file that the PTO software makes available for inspection has a different filename than the uploaded file. In Patent Center, the name of file that the PTO software makes available for inspection has “-APP.TEXT” added to the uploaded filename, as shown in the red square below.

#### Total documents uploaded: 1



Please review the DOCX file(s) that is being submitted as your final submission.

 HASH16\_SCA-APP.TEXT.docx (35 KB / Application t  
7 pages )

 [Feedback document](#)

The PTO also notes that “Uploaded .docx file(s) will generate a DOCX equivalent, minus any metadata (e.g., author, comments, bookmarks) for review.<sup>11</sup> Given the changes identified by commentators to file contents of uploaded DOCX files, there is a concern that the PTO’s validation software makes additional changes to the file.

### III.E Concerns Due To Inability To Prove Authenticity Of The Uploaded DOCX File

The PTO retains no publicly available record of the uploaded DOCX. The PTO’s Electronic Acknowledgment Receipt (herein after “EAR”) fails to contain the name of the uploaded DOCX file and does not provide a SHA-512 hash value for the uploaded DOCX file. (The PTO’s EAR does provide SHA-512 values in association with other file names for files identified as being filed.) Accordingly, the PTO filing system, as implemented, provides nothing enabling the filer to prove the authenticity of the DOCX document they uploaded for filing. The ability to prove authenticity is desirable in case the PTO’s official record of the filed specification needs to be corrected, for example as a result of the PTO changing the contents of the specification upon filing. Inability to prove authenticity is of particular concern as a consequence of the perceived unreliability of DOCX filings noted above. However, as I note below, the PTO’s revised policy regarding retention of an Auxiliary PDF and entitlement to file an Auxiliary PDF without surcharge, if employed by a filer, largely moots the inability to prove the authenticity of the uploaded DOCX file.

### III.F The “Auxiliary PDF”

An auxiliary PDF means a PDF prepared by the filer by their DOCX file to PDF format, prior to commencing the filing process in Patent Center. Under the most recent revision to PTO policy relating to DOCX filing, the PTO promised to retain an auxiliary PDF as part of the permanent record for the application. The PTO also agreed to entertain a petition to correct the record (that is, what constitutes the application as filed) relying upon the auxiliary PDF. The limitations respecting auxiliary PDFs is that they can only be filed when filing a new nonprovisional application using Patent Center (as opposed to EFS-Web), and that Patent Center only allows one auxiliary PDF to be filed per submission.<sup>12</sup>

The right to file an auxiliary PDF provide an option to redress the reliability concerns noted above, because it will enable the applicant to correct an inaccurate record of the application, by proving the disclosure actually filed. However the filer must do that in the manner specified by the PTO or they will not have an auxiliary PDF and may be subject to the non-DOCX surcharge. The following graphic shows that the procedure for filing an auxiliary PDF is, once reaching the “Upload documents” tab, to upload the DOCX file containing the specification, abstract, and claims. Once that occurs, the “Upload documents” tab will display a new section at the bottom of the page providing for the upload of the auxiliary PDF.

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## How to File An Auxiliary PDF

DOCX  
UPLOAD

Auxiliary PDF  
Upload Option  
Appears


28

### III.G Performing A Pre Filing Review Using The Patent Center-Generated PDF, Before Filing

After uploading a DOCX in Patent Center, Patent Center generates a new DOCX and allows the filer to download and review that DOCX. (Patent Center also allows the user to download a “Feedback Document.”) But Patent Center also allows the filer to download a PDF version of that new DOCX file created by Patent Center. Because of the file format concerns mentioned above, it should be more reliable to use the PDF version of the new DOCX file created by Patent Center for comparison against the uploaded file. This comparison can reveal changes incorporated into the PTO’s DOCX file which might not other be visible because of differences in filer versus PTO software. The graphic below shows that this PDF can be downloaded using the “Download All Documents” link, and from the three dots drop down menu.

NEIFELD IP LAW PLLC

## How To Download The **PDF** Of The DOCX Prepared By PC



The screenshot shows the Patent Center interface with several key elements highlighted by red boxes and arrows:

- “Upload Document” Tab**: Located at the top of the interface.
- “Download All Documents”**: A button located below the upload area.
- 3 dots drop down menu across from PC’s “DOCX” filename**: A menu icon located next to the filename of the document prepared by Patent Center.

30

### III.H Retaining The Auxiliary PDF That You Uploaded to Patent Center, To Show Authenticity Of The Auxiliary PDF

Upon filing, the EAR shows the filename of the uploaded auxiliary PDF and its SHA-512 hash value, as shown in the graphic below. Consequently, the filer can at a later date, if it becomes necessary, prove the authenticity of the content of the uploaded auxiliary PDF at a later date. They can do that by reproducing the SHA-512 hash value and showing that to be the same as the SHA-512 hash value the PTO provided in the EAR.

The graphics below show, the EAR Digest naming the Auxiliary PDF file and providing its SHA-512 hash value.

## EAR's "Digest" Shows "Auxiliary PDF" Filename And SHA-512 Hash Value

Digest	DOCUMENT	MESSAGE DIGEST (SHA-512)
	HASH19_ADS.pdf	F5D3D11F878F8CDF9EA5E82C4761ED8A40931CEB4C44081082698C58 456208E05F4D0705FEAEA04AF8D83C85B6975823DF0F5F32D53CF75 9E75E6D0077476284
	HASH19_SCA-APPTXT.docx	D508243C7460F3D44B95883665E818FE6ABD00A446C0AC9DEA66E10 7E54F9247DC6ED3AFE357F547B0B493A78E8C242F8DC846B34426DC 3C18D9D33532C602CD
	HASH19_SCA.pdf	227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437 101E3C5E01CB5C18D776F95099B19FA8CB8C85E9FF8AAE5604CDF615D 5549B282BC2F2

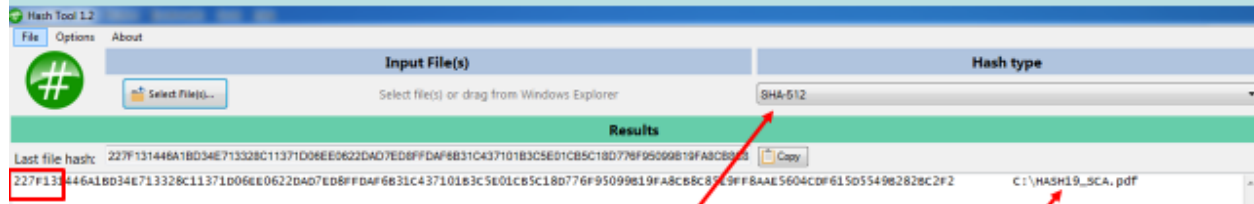
Auxiliary PDF

Auxiliary PDF SHA-512 hash value starts "227F1...."

33

The next graphic shows that a publicly available software program named "Hash Tool" generates the same SHA-512 Hash value for the auxiliary PDF file.

## Uploaded "Auxiliary PDF" Has Same SHA-512 Hash Value



SHA-512 hash value of uploaded Auxiliary PDF also starts with "227F1...."

SHA-512 function selected

Auxiliary PDF filename

34

The PTO stated that it "keep copies of the applicant-generated PDF as part of the permanent record." *Ibid.* The PTO's official file for an application contains a PDF file described as the filed auxiliary PDF. However, the described as the filed auxiliary PDF has a different filename and a different SHA-512 hash value than the uploaded auxiliary PDF. Consequently, one cannot use the file the PTO records describe as the filed auxiliary PDF and the

EAR's SHA-512 has value to prove the contents of the actually filed auxiliary PDF. The graphics below shows the file description, filename, and SHA-512 hash value for the PTO's official file version of the auxiliary PDF.

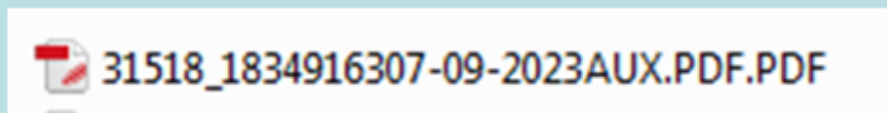
## “Documents & transaction history” Tab Shows “AUX.PDF”

Mail room date	Doc code	Doc description	Pages	Quick download
07/09/2023	N417	Electronic Filing System(EFS) Acknowledgment Receipt	2	<a href="#">Preview</a> <a href="#">PDF</a>
07/09/2023	ADS	Application Data Sheet	12	<a href="#">Preview</a> <a href="#">PDF</a>
07/09/2023	AUX.PDF	Auxiliary PDF of Application	7	<a href="#">Preview</a> <a href="#">PDF</a>
07/09/2023	SPCC	Specification	5	<a href="#">Preview</a> <a href="#">PDF</a> <a href="#">XML</a> <a href="#">DOCX</a>
07/09/2023	CLM	Claims	1	<a href="#">Preview</a> <a href="#">XML</a> <a href="#">DOCX</a> <a href="#">PDF</a>
07/09/2023	ABST	Abstract	1	<a href="#">Preview</a> <a href="#">XML</a> <a href="#">DOCX</a> <a href="#">PDF</a>
07/13/2023	APTEXT	New Application in Text Format	7	<a href="#">DOCX</a>

AUX.PDF      Auxiliary PDF of Application      PDF

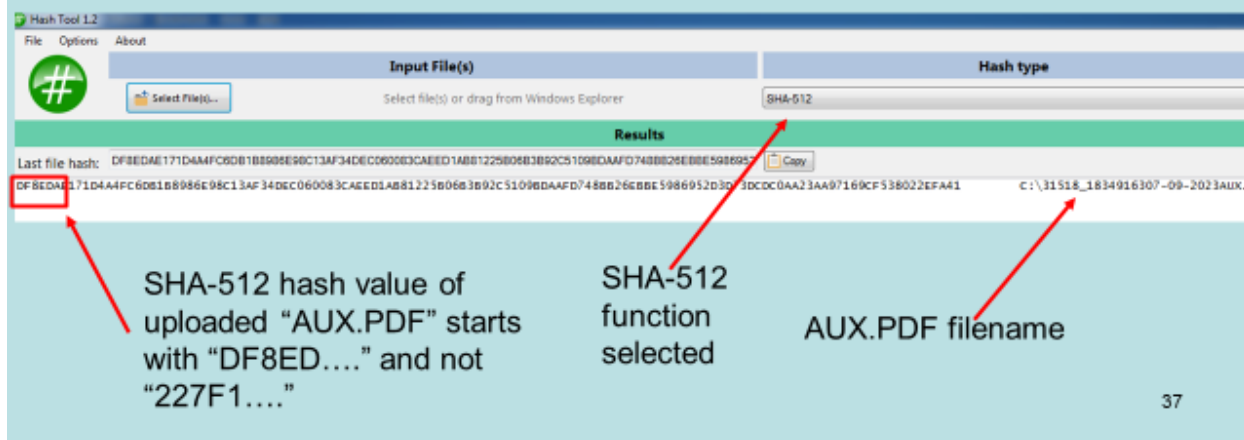
## Filename Of Download of “AUX.PDF”

- “AUX.PDF” download



- Download filename format: “[CusNum]\_[AppNo]\_[DATE]AUX.PDF.PDF”

# “AUX.PDF” Has A Different SHA-512 Hash Value



The EAR contains no SHA-512 hash value for the version of the auxiliary PDF that the PTO stores in the official file. Consequently, the filer cannot rely upon the SHA-512 hash value in the EAR to prove the authenticity of the PTO’s version of the auxiliary PDF stored in the PTO’s official file.

Consequently, the filer should retain their uploaded copy of the auxiliary PDF in their records. That will enable the filer to prove the auxiliary PDF in their records is the auxiliary PDF uploaded to Patent Center at the time of filing, and therefore prove the content of the filed disclosure, regardless what the PTO’s version of the auxiliary PDF shows.

### III.I Background Information On DOCX

DOCX has a long history with the PTO. I outline that history chronologically in tabular form, here.

Date	File format reference	Brief Description
6/14/2012	MS-DOCX	“Text2PTO” (PTO Presentation)
8/31/2012	MS-DOCX	“Text2PTO” (Director’s Blog Post)
8/2017	??-DOCX	EFS-Web enables DOCX filing
9/6/2018	MS-DOCX	PPAC public hearing
7/31/2019	MS-DOCX	Proposed Rule (84FR37398)
8/3/2020	OOXML	(85 FR 46932) – Final Rule Effective 1/1/22
6/2/2021	DOCX	(86 FR 29571) – Evidentiary Change
11/22/2021	DOCX	(86 FR 66192) – Rule Delay to 1/1/23
4/28/2022	DOCX	(87 FR 25226) – “AUX.PDF” until 12/31/22
12/20/2022	DOCX	(87 FR 77812) – “AUX.PDF” until 6/30/23
12/29/2022	DOCX	(87 FR 80073) – Rule Delay to 4/3/23
3/27/2023	DOCX	(88 FR 18052) – Rule Delay to 6/30/23
6/6/2023	DOCX	(88 FR 37036) – “AUX.PDF” extended/revised.
6/6/2023	DOCX	(88 FR 36956) – Rule Delay to 1/17/2024

## IV. FOREIGN FILING (FF) LICENSES

A patent applicant needs wait six months or until they receive a Foreign Filing (herein after “FF”) license for any invention made in the United States, before filing an application for that invention overseas. 35 USC 184

states that an applicant must wait “**six months** after filing” for “an invention made **in this country**,” or until after they receive a Foreign Filing (herein after “FF”) license, to FF. 35 USC 185 provides that a violation of the FF license requirement results in a bar to a patent for the “invention” (“shall not receive a patent for an invention... [and such a patent] shall be invalid.”) Importantly, the statutory bar is to a patent on the “invention” and not merely a bar to a patent on the “application.”

The seminal FF license case is *In re Gaertner*, 604 F. 2d 1348 (CCPA 1979). *Gaertner* clarifies the law. Gaertner filed an application and received a FF license. Gaertner subsequently file a CIP of the earlier application and foreign filed the CIP disclosure without a FF license. The CIP included the parent’s disclosure and claims, and added only new example 6 and new dependent claim 9 directed to that example 6. Gaertner also abandoned the parent.

The examiner rejected all claims in Gaertner’s CIP under 35 USC 185, the Board affirmed, and then the CCPA affirmed.

In *Gaertner*, the CCPA clarified that the FF license requirement applies to “any information or ‘subject matter’ not first disclosed to the PTO.” The CCPA noted that “Gaertner’s CIP foreign applications did contain technical information or ‘subject matter not previously disclosed.’” The CCPA clarified that enablement of example 6 by the parent application was irrelevant to the FF license requirement. The CCPA concluded that rejection of all claims, and not merely the sole claim 9 directed to the CIP matter, was proper. Finally, the CCPA explained that no FF license was required for idiomatic formal revisions.

*Gaertner* held that a FF license was required for any new technical information for inventions made in the United States before that technical information could be foreign filed; and the bar resulting from a FF license was broad and would cover old and new claims.

When *Gaertner* was decided in 1979, 35 USC 184 required a FF license prior to foreign filing an application for patent made in this country.

In 1984, the PTO promulgated "Revision of Foreign Filing License Procedure; Final Rule." 56 FR 13456 (4/4/1984), which promulgated revised foreign filing licensing requirements. The PTO explained, at 13456, that under revised rule 5.11(a), "[a] license from the Commissioner ... is always needed for the act of filing a patent application in a foreign patent office." The PTO explained, at 13459, that revised rule "5.15(a) broadens the scope of the licenses ... [so that each license] includes additional matter which does not change the general nature of subject matter disclosed" in the US application for which the license had been granted. In reply to a comment, the PTO explained, at 13460, that continuation-in-part applications were included in the FF license-authorized additional matter. And at 13459, the PTO explained that these "changes obviate the problems in *In re Gaertner, supra*, by providing a license which covers the type of activity involved in that case."

In 1988, 35 USC 184 was revised (by the "Patent Law Foreign Filing Amendments of 1988," Sec. 9101 of Public Law 100-418). This revised 35 USC 184 added that "The scope of the license shall permit subsequent modifications, amendments, and supplements containing additional subject matter ... [that] do not change the general nature of the invention in a manner which, " in the opinion of the Commissioner of Patents, might be detrimental to national security.

In 1991, the PTO promulgated "Patent Law Foreign Filing Amendments," 56 FR 1924 (1991), which further amended the rules relating to the scope of a foreign filing license. The PTO, at 1925, explained that this rule amendment implemented the 1988 amendment to 35 USC 184. The PTO, at 1925, explained that "a license is not required to file amendments, modifications, and supplements containing additional subject matter to a previously licensed foreign patent application if such amendments, modifications, and supplements do not change the general nature of the invention disclosed in the application in a manner which would require a corresponding United States patent application to be made available for national security inspection under 35 U.S.C. 181." 35 USC 181, required a United States patent application be made available for national security inspection (by other agencies of the government) when "the invention ... might, in the opinion of the Commissioner, be detrimental to the national security." The current version of 35 USC 181 retains this requirement.

In summary, the scope of a FF license was broadened subsequent to *Gaertner*, but the broadened scope of the license is based upon what “might, in the opinion of the Commissioner, be detrimental to the national security.” Thus, deciding whether to foreign file an application containing additional subject matter relative to a licensed US application requires determining if the Commissioner of Patents “might” be of the opinion that subject matter of the foreign application is detrimental to the national security. In other words, rendering a legal opinion. Thus, deciding that the filing a broadened foreign application, without an express FF license, requires a conclusion that the Commissioner of patents would be of the opinion that the subject matter of the foreign application could not detrimental to the national security.<sup>13</sup>

## V. NON-PUBLICATION REQUESTS

An applicant can file a request that the PTO not publish their application, if the applicant meets certain requirements relating maintaining the contents of the application private. Specifically, 35 USC 122(b)(2)(B)(i) provides that the PTO will honor a request made with the filing including a certification “certifying that *the invention disclosed* in the application *has not and will not* be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing” That provision includes Patent Cooperation Treaty (herein after “PCT”) applications since the PCT requires publication of PCT applications 18 months after filing.

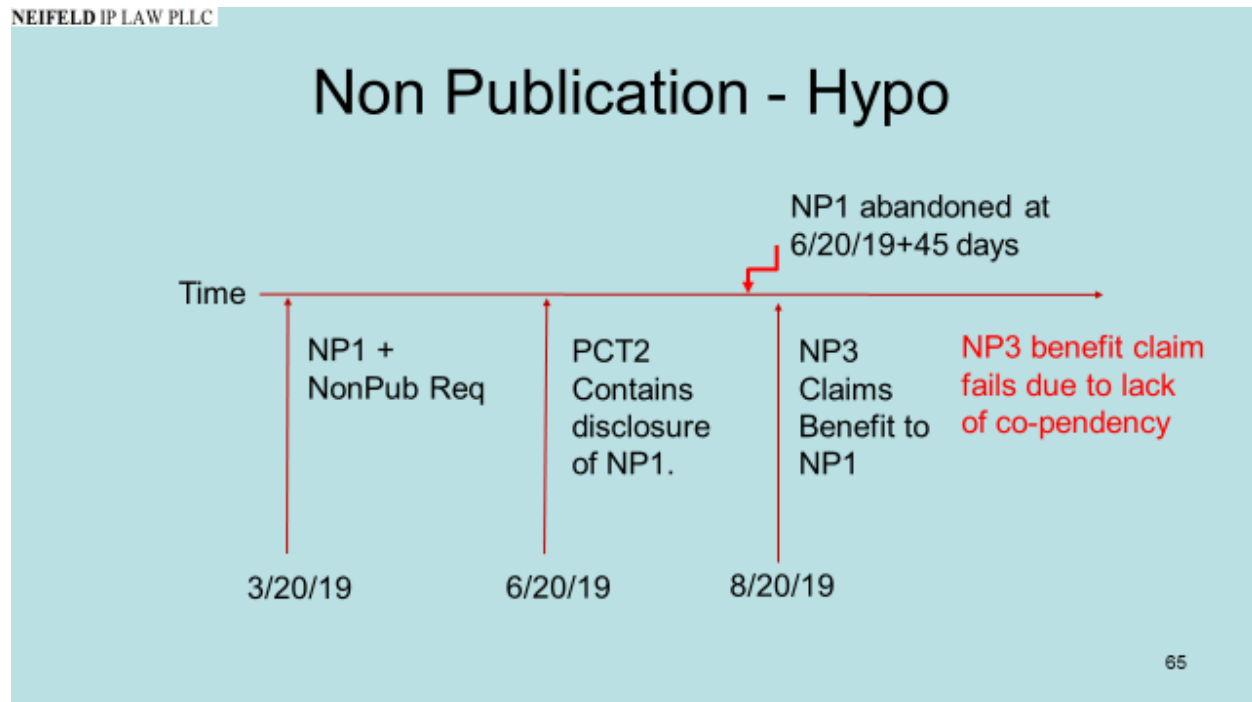
An applicant has the right to rescind their nonpublication request. Specifically, 35 USC 122(b)(2)(B)(iv) provides “If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published.”

The applicant must notify the PTO of the fact of a subsequent foreign filing within 45 days thereof, to avoid the US application becoming abandoned. Specifically, 35 USC 122(b)(2)(B)(iii) provides that “[a] failure of the applicant to provide such notice within the prescribed period [of 45 days] shall result in the application being regarded as abandoned.” Likewise 37 CFR 1.213(c) provides an application is abandoned in case the applicant fails to notify the PTO of a foreign filing for the invention disclosed in the application.

The statute fails to expressly provide the consequences for an incorrect certification. One court however concluded that certification violation also results in abandonment. *See Arrow Intern., Inc. v. Spire Biomedical, Inc.*, 06-cv-11564-DPW, 635 F. Supp. 2d 46, 60 (D. Mass 7/10/2009)(“The statutory penalty for violating the certification is abandonment of the underlying patent. See 35 U.S.C. § 122(b)(2)(B)(iii).”).

The nonpublication certification refers to disclosed subject matter, not to claimed subject matter. Therefore a CIP application claiming only new matter first disclosed in the CIP but also disclose subject matter from the parent, even if it claims subject matter not disclosed in the parent, triggers the 45 day time limit to notify the PTO. Violation of the 45 day statutory notice requirement can result (and has in fact resulted) in lack of benefit for downstream applications, as shown in the fact patent in the following graphic.

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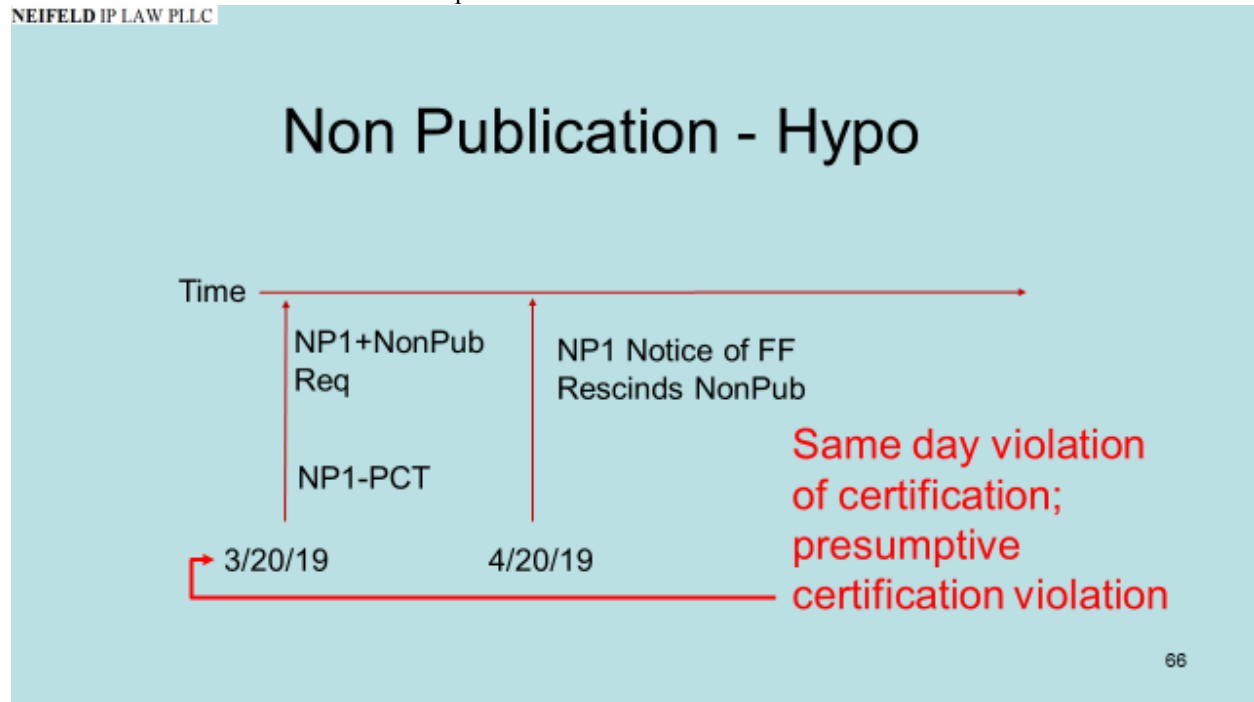
In *Asghari-Kamrani v. USAA*, 2:15cv478., 220 F. Supp. 3d 707 (EDVA 12/9/2016); affirmed under rule 36, 2017-2504, 2017 (Fed. Cir. 9/11/2018), the court concluded that “if the invention has previously been the subject of a foreign-filed application, then another application in that family [sic; disclosing that invention] must be



published.” Accordingly, a nonpublication request for an application containing the subject of a prior foreign filing would be improper.

Violation of the certification requirement, even if complying with the notice requirement, could result abandonment of the application. As shown in the following graphic, a same day filing of a foreign and a US application containing a nonpublication request is suspect. This is because filing a foreign (or PCT) application the same day as the nonpublication request in the corresponding US application suggests the filer of the applications had an intent to file the PCT application when certifying that the US application “has not and will not” be foreign filed, and therefore violated the certification requirement.

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## VI. SECURING THE RIGHT OF PRIORITY (ROP)

### VI.A Paris Article 4

The Right Of Priority (herein after “ROP”) is a right to treat disclosure of subject matter in your application that was present in an earlier application as if your application was filed on the date of the earlier application, for purposes of determining patentability.

Article 4 of the Paris Convention for the Protection of Intellectual Property (herein after “Paris”) defines the ROP. Paris Article 4 is incorporated into and forms the basis for the ROP in all major IP treaties and regional and national law. EPC Art. 87; UK section 7; PCT Art 8; Hague 1960 and 1999 Agreements; and the PLT all incorporate Paris Article 4. Paris Article 4 is the model for its US national implementation in 35 USC 119(a)-(d).

Paris Article 4A.(1) reads as follows, with particular words and phrases that have been subject of judicial decisions to be discussed below, bolded.

**Any person** who has **duly filed** an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, **or his successor in title, shall enjoy, for the purpose of filing** in the **other** countries, a **right of priority during the periods hereinafter fixed.**

## VI.B. Rules of Law Relating to Paris Article 4

Case law on Paris Article 4 comes from various jurisdictions. While each jurisdiction can develop an independent body of law, Paris Article 4 is likely to be interpreted similarly across jurisdictions. I present below rules of law for Paris Article 4 derived from cases from the England and Wales High Court (Patents Court) (EWHC) and EPO Board. I synthesize the rules of law, for each issue, followed by case law quotations supporting my synthesis.

## VI.C. The Timing Rule

The ROP must be owned by the filer **when** filing their subsequent application.

This rule construes Paris 4A.(1) "Any person ... **shall** enjoy, **for the purpose of filing** in the other countries "

Case law: *Edwards Lifesciences AG v Cook Biotech Inc.*, HC08 C 00934, (EWHC 6/12/2009)

95. In my judgment the effect of Article 4 of the Paris Convention and section 5 of the Act is clear. A person who files a patent application for an invention is afforded the privilege of claiming priority only if he himself filed the earlier application from which priority is claimed or if he is the successor in title to the person who filed that earlier application. If he is neither the person who filed the earlier application nor his successor in title then he is denied the privilege. Moreover, his position is not improved if he subsequently acquires title to the invention. It remains the case that he was not entitled to the privilege when he filed the later application and made his claim. Any other interpretation would introduce uncertainty and the risk of unfairness to third parties. In reaching this conclusion I derive a measure of comfort from the fact that the Board of Appeal of the EPO has adopted the same approach to the interpretation of Article 87 EPC in two cases: J 0019/87 and T 0062/05.

## VI.D. The All Applicants Rule

When there are multiple applicants, the ROP attaches to the later application, **only if, all those applicants (or successors in title)** are also applicants of the later filed application.

This rule construes Paris 4A.(1) "**Any person** who has duly filed .. shall enjoy ... a right of priority"

Case law: *Edwards Lifesciences AG v Cook Biotech Inc.*, HC08 C 00934, (EWHC 6/12/2009), Kitchin, Judge)

99. That leaves the alternative argument advanced by Cook, namely that it always owned Mr Obermiller's interest in the invention and that is sufficient. I can deal with this argument quite shortly. The US application was filed in the names of Mr Obermiller, Mr Osse and Ms Thorpe, all as joint inventors. It was not filed by Mr Obermiller alone and therefore he was not 'a person' who had 'duly filed an application for a patent' within the meaning of Article 4A(1) of the Paris Convention. Once again, this approach is consistent with that adopted by the Board of Appeal of the EPO in case T 0788/05."

Case law: *Boston Scientific Scimed, Inc. v. Terumo Kabushiki Kaisha*, T 0788/05 (EPO Board 5/8/2007).

In the case of D1 in which two co-applicants (Terumo and Tokin) are present, this means that the priority right belongs simultaneously and jointly to the two applicants, who thus constitute a legal unity unless one of them decides to transfer his right to the other applicant, who then becomes his successor in title and this before the filing of the later application. Since no evidence for such a transfer was submitted to the Board, D1 ... could only serve as a basis for claiming a priority right for the filing of a later application designating both applicants.

Case law: *Schlich et al. v. The Broad Institute, Inc.*, T 0844/18 (EPO Board 11/7/2020).

How is the expression ‘any person’ in Article 87(1) EPC to be interpreted? \*\*\* the Board finds that the words ‘any person’ in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application.

#### VI.E. The Exclusive Or Rule

If there is a “successor in title” that gains the ROP, then the original person that filed the earlier application loses the ROP.

This rule construes the “or” in Paris Article 4A.(1) “Any person ...**or** his successor in title”

Case Law: *Archer-Daniels-Midland Co. v. Furanix Technologies B.V.*, T 0725/1 (EPO Board 1/21/2019); bold, italics, in the original.

5.1 ... Article 4 of the Paris Convention of Article 87 EPC, in particular the wording "*Any person who has duly filed...an application for a patent... **or his successor in title**, shall enjoy...a right of priority*" (emphasis added by the board) renders perfectly clear that the mentioned right of priority pertains **either** to the first applicant **or** to its successor in title. In other words, contrary to what was submitted by the respondent, the ‘or’ in Article 87 EPC and Article 4 of the Paris Convention must unambiguously be read as an ‘exclusive or’.

#### VI.F. The Duly Filed Formal Assessment General Rule

Determination of the person who duly filed the priority application is conclusively governed by a formal assessment of the applicants named in the priority application.

This rule construes the Paris Article 4A.(1) recitation “person who ... duly filed.” However, the construction of “Any person who has duly filed” is a question of national law, and therefore there may be exceptions.

#### VI.G. The “Duly Filed” Formal Assessment Rules Of the EPO

This subsection covers the EPO law; choice of national law; EPO’s view of US national law and Paris Article 4 per se. However, the relevant rule is the formal assessment rule. The Board concluded that the phrase “Any person who has duly filed,” in Paris and EPC 87(1), limits the EPO to “a formal assessment of the person (‘any person’) who has performed the act of filing the [prior] patent application.”

Under EPO law:

Rule 1: The law determining the EPO’s interpretation of who “duly filed,” is Paris.

Rule 2: Paris requires interpretation of who “duly filed,” based upon national law.

Rule 3: US choice of law for interpreting who “duly filed,” is Paris, *per se*.

Rule 4: Paris limits to a **formal** assessment, determining who “duly filed.”

Case law: *Schlich et al. v. The Broad Institute, Inc.*, T 0844/18 (EPO Board 11/7/2020).

By way of background, *Schlich* is a famous case dealing with rights to Crispr-CAS9 Broad claimed the ROP to US provisionals that each listed at least one person as one of the applicants that was not listed as an applicant in the EPO application. The EPO Board held that the EPO application did not enjoy priority from those provisionals. In reaching its conclusion, the EPO Board asked and answered 3 questions.

The Board’s first question was “1) Should entitlement to priority be assessed by the EPO?” The Board concluded yes, the EPO will determine priority and determine who “duly filed.”

The Board’s second question was “2) How is the expression ‘any person’ in Article 87(1) EPC to be interpreted?” The Board concluded, as I noted above, that the “all applicants” rule applies. In doing so the Board conclude that the legal concepts in EPC article 87(1) and Paris Article 4a for the phrase “any person” were “the same.” That is because the choice of law for interpreting the EPC for the EPC’s ROP, was Paris Article 4A. The

Board found “that the words ‘any person’ in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application.”

The Board’s third question was “3) Does national law (in this case US law) govern the determination of ‘any person’ who has ‘duly filed’ in Article 87(1) EPC?” The Board concluded in the affirmative, that Paris Article 4 “Any person who has duly filed” is determined by national law. From this, the Board concluded that Paris Article 4, per se, was the relevant choice of US law. The Board reasoned that the US constitution was the supreme law of the land. I note that the Board ignored 35 USC 119(a)-(d), which is the US national implementation of Paris Article 4, and ignored the fact that US Supreme Court law holds that treaties are not self-implementing in US law.

The Board concluded, italics added for emphasis, that:

15. Article 87(1) EPC does not require that the "any person" who has filed the patent application is actually legally entitled to do so, merely that they have done so. Thus, as regards the "any person" of Article 87(1) EPC, the EPO does not carry out any substantial assessment of the legal entitlement to property rights, it does not go beyond a formal assessment of the person ("any person") who has performed the act of filing the patent application.

110. It is thus clear that the Paris Convention, being an integral part of US law, determines who "any person" is, and that this determination is a purely formal one. It does not require that the "any person" is actually legally entitled to make the filing, but merely that they did so. Thus the Paris Convention and the EPC provide self-contained definitions of the person who claims priority, both treaties define this person by means of the action that this person has performed.

## VI.H The EPO Board’s Special Comments Regarding US Provisional Applications And Their Formal Assessment Rule

Regarding US provisional priority application, the Board had special comments.

113. The appellants refer to further special characteristics of US provisional applications, that is they can contain several different inventions and several named inventors who have made different contributions to different inventions. A subsequent filing using such a US provisional application as its priority application would most likely fail the EPO’s "identity of applicants" test for assessing "any person". For the appellants this is tantamount to compelling a change in US practice and failing to follow the instructions of the President of the EPO. The appellants consider that this is contrary to the principle of national treatment.

114. As regards changing US practice [sic], it is clear that applicants wishing to use US provisional applications should be aware of the difficulties they may face if they use these applications to claim priority for a European patent application. This is simply a consequence of the US’s adherence to the Paris Convention. The Notice from the President of the EPO cannot exempt the EPO from applying the Paris Convention and there is no evidence that this was its intention.

## VI.I The Substantial Legal Assessment To Determine Successor In Title Rule, EPO

EPO Rule: The EPO will conduct a substantive legal assessment to determine who is a successor in title. This rule construes Paris Article 4A.(1) “Any **person** who has **duly filed ... or his successor in title**”  
Case law: *Schlich et al. v. The Broad Institute, Inc.*, T 0844/18 (EPO Board 11/7/2020).

20. The EPO only assesses, and for this it is the practice of the EPO to require evidence, that a successor in title is in fact the successor in title of the original applicant; an assessment which indeed involves a substantial legal assessment but not an assessment of legal entitlement to a priority right.

## VI.J The Equitable Title/Beneficial Interest To Determine Successor In Title Rule, UK

UK Rule: So long as the applicant has “equitable or beneficial title to the priority right,” that is “good enough” for the applicant to enjoy the ROP. (Note: Equitable ownership refers to the right to acquire title. Beneficial interest refers to a right to benefit from a property.)

This rule construes Paris Article 4A.(1) “Any **person** who has **duly filed ... or his successor in title**”

Case law: *Accord Healthcare Limited v. Research Corporation Technologies, Inc.*, HP-2016-000038 (EWHC 11/7/2017).

67. Edwards v Cook has been followed and applied at first instance on a number of occasions including at least the following: Arnold J in KCI Licensing v Smith & Nephew [2010] EWHC 1487 (Pat) and Idenix v Gilead [2014] EWHC 3916 (Pat), Henry Carr J in Fujifilm v Abbvie [2017] EWHC 395 (Pat); and me in HTC v Gemalto [2013] EWHC 1876 (Pat). In KCI Licensing v Smith & Nephew and HTC v Gemalto the judges (Arnold J and myself respectively) accepted a significant softening to what otherwise might have been the rigour of the rule that the title must be secured by the time the international application is made, by accepting an analysis based on common law principles distinguishing the equitable and legal title to property. If the relevant local law meant that the equitable or beneficial title to the priority right was in the hands of the person making the priority claim in the international application, that was held to be good enough even though that person did not then hold the legal title under the local law and could only perfect their title after the event.

68. The critical passage in KCI is as follows. Arnold J had held that on its true construction the relevant agreement there did convey the legal title to the applicant but he went on to hold that even if that was wrong, the agreement was effective to transfer the entire beneficial interest. The applicant had an enforceable legal right to call for a conveyance of the bare legal title and that made the applicant the “successor in title” for the purposes of a claim to priority under Article 87(1) of the EPC and Article 4(A)(1) of the Paris Convention even if KC Inc had not acquired the bare legal title at the relevant date.

Case law: *KCI Licensing v Smith & Nephew*, HC09C02624, 1487 (EWHC 6/23/2010).

60. ... in consideration of employment [Mr. Lina agreed to] \*\*\* assign and agree to assign to ... KC ... all right, title and interest in all confidential information, inventions and improvements conceived or developed by me, alone or in conjunction with others, during my employment and for a period of three (3) years after termination for whatever reason, which relate to any phase of the Company's business.

69. The Lin agreement ‘was plainly effective to transfer the entire beneficial interest in the invention, including the right to file patent applications in respect of it \*\*\* that was sufficient to make [KCI the] \*\*\* ‘successor in title’ for the purposes of a claim to priority under Article 87(1) of the EPC and Article 4(A)(1) of the Paris Convention even if \*\*\* [KCI] had not acquired the bare legal title at the relevant date.

## VI.K The Bone Fide Purchaser For Value Without Notice (herein after the “BFP”) Rule, UK

UK Rule: A BFP is a successor in interest that enjoys the ROP.

This rule construes Paris Article 4A.(1) “**successor in title**”.

Case law: *Accord Healthcare Limited v. Research Corporation Technologies, Inc.*, HP-2016-000038 (EWHC 11/7/2017).

119. I turn to the \*\*\* common law concept of a bona fide purchaser for value without notice had been codified in statute at 35 USC §261. \*\*\* 123. I find that on 4th February 1997 RCT was not on notice of any possible conflicting interest held by the university. Therefore RCT acquired good title to the invention including any priority right. Any equitable interest in the invention which the university did hold prior to the assignment was destroyed or overridden by the assignment to RCT. 124. Accordingly RCT had the substantive priority right when the PCT application was filed.

## VI.L The ROP Period, And The ROP Period Reset Rule

Rule: The first filing of subject matter starts the ROP *period* for that subject matter. And the ROP period is 12 months for patents and 6 months for designs and trademarks. That period can only be reset under narrow and legally untested circumstances.

This rule construes the Paris Convention Articles 4A.(1)-(4). Specifically the recitations:

4A.(1) “shall enjoy \*\*\* a right of priority during the periods hereinafter fixed.”; “twelve months for patents \*\*\* six months for industrial designs and trademarks”; 4C.(2) “start from the date of filing of the first application”; 4C.(3) extended to the next working day “If the last day of the period is an official holiday, or a day when the Office is not open.”

The ROP priority period reset rule is defined in Paris Article 4C.(4) in such a way that it cabins the priority period rule noted above, preventing later filings from service as the start date for the priority period. I copy in below the Paris Article 4C.(4) ROP period reset rule and bold the most relevant language.

A **subsequent application concerning the same subject** as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be **considered as the first application**, of which the filing date shall be the starting point of the period of priority, if, **at the time of filing** the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

Because this reset provision is narrow and generally untested, it should not be relied upon for determining a restart of the Paris period.

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<sup>1</sup> See for example Federal Rule of Civil Procedure 6(b)(1) (“ In General. When an act may or must be done within a specified time, the court may, for good cause, extend the time: ... after the time has expired if the party failed to act because of excusable neglect.”).

<sup>2</sup> Vincent R. Johnson, “The Informed Consent Doctrine in Legal Malpractice Law,” 11 St. Mary’s J. Legal Mal. & Ethics 362 (2011); and Mark Bassingthwaite, ALPS, private communication (including: failure to calendar; failure to ascertain; failure to react).

<sup>3</sup> These are my estimates, and they are based upon private communications with Michael Richardson, WIPO IB, Charles Pearson, USPTO IPLA, circa 2017.

<sup>4</sup> See for example the AIPLA 2015 “Report Of The Economic Survey.” Divide average cost for filing a ready to file application by average billing rate to arrive at an estimated time for filing. My personal experience is that filing a ready for filing application normally takes 2-3 hours.

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<sup>5</sup> See, for example, Vincent R. Johnson, “The Informed Consent Doctrine in Legal Malpractice Law,” 11 St. Mary’s J. on Legal Malpractice & Ethics 362 (2021).

<sup>6</sup> The PDF standard is specified by ISO 32000.

<sup>7</sup> See “[MS-DOCX]: Word Extensions to the Office Open XML (.docx) File Format” at [https://learn.microsoft.com/en-us/openspecs/office\\_standards/ms-docx/b839fe1f-e1ca-4fa6-8c26-5954d0abbccd](https://learn.microsoft.com/en-us/openspecs/office_standards/ms-docx/b839fe1f-e1ca-4fa6-8c26-5954d0abbccd)

<sup>8</sup> ECMA-376 is available at URL: <https://www.ecma-international.org/publications-and-standards/standards/ecma-376/>

<sup>9</sup> See the Library of Congress descriptions of transitional and strict “DOCX” at URLs:

<https://www.loc.gov/preservation/digital/formats/fdd/fdd000397.shtml> and

<https://www.loc.gov/preservation/digital/formats/fdd/fdd000400.shtml>.

<sup>10</sup> See <https://www.uspto.gov/patents/docx>, which now provides the following description of what DOCX means::

What is DOCX?

DOCX is a word processing file format based on open standards, including Extensible Markup Language (XML). DOCX is supported by many popular word processing applications, such as Microsoft Word 2007 or higher, Google Docs, Office Online, LibreOffice and Pages for Mac. As an open standard format, DOCX offers a safe and stable basis for authoring and processing intellectual property documents. Currently, the USPTO is accepting DOCX for these submission types.

<sup>11</sup> See the PTO’s DOCX Quick Start Guide, at URL:

[https://www.uspto.gov/sites/default/files/documents/DOCX\\_QSG\\_Final.pdf](https://www.uspto.gov/sites/default/files/documents/DOCX_QSG_Final.pdf)

<sup>12</sup> See 88 FR 37036, Notice “Extension of the Option for Submission of a PDF With a Patent Application Filed in DOCX Format” (6/6/2023). This Notice states in relevant parts:

**Error! Main Document Only.**In response to stakeholder requests, the USPTO is extending, until further notice, the option to submit an applicant-generated PDF of the application along with the validated DOCX file(s) when filing an application in Patent Center. [at 37037]

**Error! Main Document Only.**However, in view of stakeholder requests, the USPTO will now keep copies of the applicant-generated PDF as part of the permanent record, regardless of whether a petition is filed. [at 37037]

As discussed in the April 2022 Notice, patent applicants who choose to submit an applicant-generated PDF with the validated DOCX file(s) when filing an application in Patent Center will not have to pay additional fees, such as an application size fee, as a result of filing the applicant-generated PDF and, on petition, will be able to rely on the applicant-generated PDF if a discrepancy occurs during the filing process. [at 37037]

To avoid incurring additional fees for the PDF, applicants must follow the process for submitting an applicant-generated PDF (Auxiliary PDF) set forth in the quick reference guide available at [www.uspto.gov/sites/default/files/documents/Aux\\_PDF\\_QRG\\_Final\\_2022.docx](http://www.uspto.gov/sites/default/files/documents/Aux_PDF_QRG_Final_2022.docx). The USPTO will continue to waive the petition fee under 37 CFR 1.17(f) for a petition under 37 CFR 1.182 that relies on an applicant-generated PDF that was filed in Patent Center as the source to make a correction to the record. [at 37037]

<sup>13</sup> Thanks to helpful discussions with Scott Nielson on the NAPP forum discussion thread “Scope of a Foreign Filing License.”