

Restoration of Priority

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I. WHAT IS A RIGHT OF PRIORITY?

Restoration of a right of priority depends upon the meaning of a right of priority.

A right of priority is defined in the "Paris Convention for the Protection of Industrial Property" (Paris).² Paris article 4B indicates that a right of priority to a "filing" has the consequence that "any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design." For patents, a right of priority means a right to avoid unpatentability and invalidation due to acts occurring after the first filing. Paris article 4B provides this right when a first filing is in one nation and the second filing is in another nation (international filings).

The period of priority for international filings of patents (but not for industrial designs³) is defined by Paris article 4C, which states that the "period of priority" for patents is "twelve months," (4C(1)) with "the day of filing ... not be included in the period," (4C(2)), and that the period of priority is extended to "the first following working day" after "a day when the Office is not open for the filing of applications in the country where protection is claimed" (4C(3)).

United States (US) national law distinguishes between a right to "benefit" (see 35 USC 119(e) and 35 USC 120) to US patent applications and a right to "priority" (see 35 USC 119(a)-(d)) to foreign applications. The 35 USC 120 right to "benefit" applies for claims to "an application previously filed in the United States." The 35 USC 119(e) right to "benefit" applies to claims to "a provisional application filed under section 111(b)." The 35 USC 119(a)-(d) right to priority applies to claims to "an application for a patent ... in a foreign country ... or in a WTO member country". Both domestic "benefit" and foreign "priority" provide the right to the "effect" in the later filed application as if the later filed application had been filed on the date of filing of the earlier filed application for the "invention" disclosed in the earlier filed application.⁴

The term "Priority Period" herein below generically refer to priority periods, such as the Paris article 4C(1) "period of priority" for foreign applications and corresponding 35 USC 119(e) period for domestic benefit to US provisional applications. The term "foreign" application herein below to refer to an application that is not a US patent application and not a PCT application.

II. WHAT IS RESTORATION OF PRIORITY?

Restoration of priority provides for the benefit or right of priority in an application filed after the Priority Period associated with an earlier filed application has past. Restoration of priority is a savings provision which is only available in certain limited circumstances associated with error by the applicant in having failed to file the later application within the Priority Period.

III. TREATIES, LAWS, AND RULES GOVERNING RESTORATION OF PRIORITY BY THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

The Patent Cooperation Treaty (PCT) and the Patent Law Treaty (PLT) are administered by the World Intellectual Property Organization (WIPO).⁵ Corrections to priority claims and a right of restoration of priority are incorporated into PLT article 13 and PLT rule 14.⁶ The right to correct priority claims and a right to restoration of priority before the Receiving Office (RO)⁷ are incorporated into PCT rule 26bis.⁸ The right to restoration before the RO appears in 26bis.3(a). The effect of restoration by any RO on each DO⁹ is provided by PCT rule 49ter.1.¹⁰ PCT rule 49ter.2 provides a right to restoration of priority before the DOs.¹¹ The PCT rules providing for restoration of priority came into effect April 1, 2007.¹²

The US became bound by the PCT on January 24, 1978.¹³ US rule 37 CFR 1.452 provides for restoration of priority for a PCT application filed in RO/US.¹⁴ 37 CFR 1.452 came into effect November 9, 2007. The US became bound by the PLT December 18, 2013,¹⁵ which is the date the "Patent Law Treaty Implementation Act of 2012" (PLTIA) became effective.¹⁶ The PLTIA, Title II, section 201(c), amended 35 USC 119(a); 119(e); and 365(b) to provide inter alia for restoration of priority in US applications under examination by the USPTO.¹⁷ While PLTIA made these amendments effective 12/18/2013, they apply to "any patent issued before, on, or after" and to "any application for patent that is pending on or filed" after 12/18/2013, except for patents involved in litigation commenced before or on 12/18/2013.¹⁸ In other words, the right to restore priority is generally available, even for applications and patents pre-existing the PLTIA.

The US also promulgated regulations implementing PLTIA.¹⁹ 37 CFR 1.55 was amended to provide for restoration of foreign priority and 37 CFR 1.78 was amended to provide for restoration of domestic benefit to a US provisional application. The PLTIA substantially amended and rearranged these rules, so that now 37 CFR 1.55(c) provides for restoration of priority to a foreign application and 37 CFR 1.78(b) provides for restoration of benefit to a US provisional application.²⁰

IV. THE PLTIA CHANGED THE PRIORITY PERIOD FOR US PROVISIONAL APPLICATIONS

The PLTIA redefined the Priority Period of a US provisional application claimed in a PCT application so that the Priority Period depends upon the RO in which the PCT application is filed.²¹ Specifically, the PLTIA added the following sentence to the end of 35 USC 119(e)(3): "For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351." The effect of this provision is to make the holiday extension of the Priority Period for benefit of a US provisional application depend upon holidays applicable to the RO. The Priority Period is extended to the next day that foreign RO is open for filings, when the "12-month" period falls on a day that foreign RO is not open for filings. That amendment to 119(e)(3) changes the extension of the Priority Period for PCT applications, from what used to be based solely upon whether RO/US was closed on the "12-month" date, to whether the RO in which the PCT application was filed, is closed on the "12 month" date.²²

Because this statutory change requires no action by the applicant to be effective, there are no corresponding changes to US regulations. Presumably, the USPTO will change its internal procedures, however, to recognize on the USPTO's official filing receipts and in the USPTO's bibliographic databases the provisional priority claims made effective by application of the PCT rule 80.5. Applicants whose priority claim to a US provisional was previously denied due to improvident reliance upon PCT rule 80.5 may want to request the USPTO issue a corrected official filing receipt showing and, for issued patents, a certificate of correction for issued patents.

It may be desirable to file a PCT application in the RO that provides the greatest extension of the Priority Period for benefit to a US provisional application. Which RO that is, depends upon national holidays applicable each RO.²³ Any RO must be a competent RO, which requires at least one of the applicants be a national or resident of a state served by that RO.²⁴ It may be possible to add to a PCT application an applicant whose residence or nationality makes a desired RO competent.²⁵

V. SIGNIFICANCE OF RESTORATION OF PRIORITY

Before actually discussing restoration of priority, consider the significance of both the existence of restoration and the change to the 119(e)(3) Priority Period. Applicants file with ROs about 400-450 requests for restoration annually; RO/IB receives around 90 of those requests, and RO/US receives over a 100 of those requests.²⁶ This means restoration is requested before ROs in about 0.2 percent of all PCT applications, and about 0.3 percent of RO/US filed PCT applications.²⁷ Restoration is available in a growing number of jurisdictions, but still unavailable on several major jurisdictions.²⁸

The changes to 119(e)(3) and the ability to retroactively obtain an earlier priority date are issues that patent prosecutors and counselors need to consider and act upon relative to US patents and applications. Patent claims which might have been written off due to denied priority and corresponding intervening prior art should be identified and reconsidered. At least in the US, the denied priority claim might now be restorable. Opinions rendered in reliance upon a denied priority claim (and intervening prior art) should be reconsidered, particularly for US applications and patents in view of the PLTIA. Likewise, priority may be restored in a growing number of foreign jurisdictions, and therefore similar considerations apply to foreign rights.

VI. RESTORATION REQUIRES MEETING A STANDARD FOR DELAY

Restoration of priority provisions in PLT and PCT require that the delay in filing the later application from the expiration of the Priority Period meet some standard supporting excuse of the delay. These standards are (1) despite due care required by the circumstances and (2) unintentional. PLT Article 13(2)(iv); PCT Rule 26bis.3(a)(I) and (ii).

PLT article 13(3) requires an Office to restore priority if the Office finds the delay was despite due care, and allows the Office to restore priority if the Office finds that the delay was unintentional. WIPO indicates that the

PLT is in force in some thirty States.²⁹

PCT rule 26bis.3(a) requires each RO to apply at least one of the two standards to requests to restore priority, and to restore priority if the request meets the standard that Office applies, or to notify WIPO that they do accept an RO's restoration of priority. Only about fifteen PCT States have not notified WIPO that they do not restore priority based upon a RO restoration of priority (under PCT rule 49ter.1(g)).³⁰ If an RO applies both standards, it should first determine whether the due care standard is met and decide the request on that basis before considering unintentionality.³¹ A finding of delay despite due care should be effective in designated states that apply either the due care or the unintentionality standard.³² PCT rule 49ter.1(a). If the RO restores under the unintentional standard, restoration is only effective in each designated State that allows restoration due to unintentional delay. PCT rule 49ter.1(a). There are a large number of countries that provide for restoration only based upon a finding of delay despite due care.³³ RO/IB provides for restoration under both standards, and charges no fee for request for restoration.³⁴ All PCT applicants have the right to select RO/IB by filing their application with RO/IB. PCT regulation 19.1(iii). Consequently, PCT applicants desiring restoration in the international phase or stage³⁵ under the "due care" standard, when their national Office does not provide for restoration under the due care standard, generally must file at RO/IB to obtain restoration under this standard.³⁶

The US does not provide for restoration under the due care standard, and therefore there is a strong incentive for US applicants (those which are only residents and nationals of the US, PCT rule 19.1(a)) to file at RO/IB, if they require restoration).³⁷ In addition, RO/US charges a fee for deciding restoration requests, whereas RO/IB does not. However, filing an application for an invention outside the US, including filing at the IB, requires the applicant to have a US license for foreign filing before filing, unless an application for the invention had been on file in the USPTO for more than six months and has not been subject to a secrecy order.³⁸ Foreign filing licences may be obtained from the USPTO even for subject matter for which a US patent application has not been filed.³⁹

VI. TIME LIMITS APPLICABLE TO RESTORATION

There are several relevant types of time limits. First, there is the amount of time after the expiration of the priority period in which the later application must have been filed to be able to be entitled to restoration of priority. Second, there is the amount of time that one has in which to request or petition for restoration of priority. Third, there is the amount of time one has to claim the priority or benefit of an earlier application. Fourth, there is the amount of time that one has to file a certified copy of a foreign priority document.

PLT Article 13(2)(ii) requires a request for restoration be made within time limits "prescribed in the Regulations." PLT Article 14(a)(I) defines "prescribed in the Regulations" to mean regulations annexed to the PLT treaty (as opposed to PCT regulations). PLT rule 14(4) requires that the PLT time limit for requesting restoration of priority "shall expire not less than two months from the date on which the priority period expired."

PCT rule 26bis.3(e) provides that the time limit for requesting restoration of priority before an RO "shall be two months from the date on which the priority period expired."

Both PLT and PCT have narrow exceptions that could shorten the two months period for requesting restoration, but only if the Office has completed preparation for publication of the application prior to the two months period.⁴⁰ Thus, time limit for both filing and requesting restoration of priority in an RO for a PCT application is generally 2 months from the date the priority period expired.

PCT rule 49ter.2(b) provides that the time limit for requesting restoration of priority before a DO is "one month from the applicable time limit under Article 22" (which is the deadline for providing the application, translation, and paying fees to the DO). However, PCT rule 49ter.2(f) allows for national law to provide more favorable treatment.

Regardless of restoration, PCT rule 26bis.1 allows a priority claim to be presented in a PCT application up to the later of 16 months from the priority filing date and 4 months after PCT filing date. If the filing date of the application of such a priority claim provided a Priority Period that expired within 2 months of the date the PCT application was filed, the RO and the IB will not consider the claim void, even though the claim may be ineffective. Even beyond that date, up to the 30 month date, PCT rule 26bis.1(e) entitles an applicant to, upon request, have the IB to publish information concerning an untimely claim to priority. The PLT defers to the PCT on the time limit for when a priority claim can be presented, stating in PLT rule 14(3) that such time limit "shall be not less than the time limit applicable under the Patent Cooperation Treaty."

PCT Article 2(xi) defines "priority date" to mean "the filing date of the earliest application whose priority is so claimed". PCT rule 26bis.1(c) resets all dates running in the PCT application (such as article 22 thirty month

date), when the "priority date" for the PCT application changes via correction, addition, or restoration. Hence, it is very important to change all docketed dates for a PCT application to be based upon the priority date of any correction, addition, or restoration, requested during the international phase, regardless of whether the request is granted or denied.

The PLTIA allows for restoration of priority if the later application is filed within 2 months of the end of the Priority Period.⁴¹ The PLTIA does not define a time limit in which restoration must be requested, leaving that to the discretion of the USPTO and its regulations.⁴² USPTO regulations promulgated in response to the PLTIA provide for restoration of priority to foreign applications in 1.55(c) via petition, and restoration of benefit to US provisional applications in 1.78(b) via petition. Neither of these rules imposes a time limit, per se, on petitioning for restoration of priority. However, other subsections of rules 1.55 and 1.78 each impose time limits on claims to priority and benefit, and on the filing of a certified copy of a foreign priority document. All of these US rules for both restoration and claiming priority are reviewed below, followed by various fact patterns and discussion of what might be required to restore priority in each fact pattern in the USPTO.

VIII. USPTO LAW AND REGULATIONS RELATING TO RESTORATION OF PRIORITY TO A FOREIGN APPLICATION

Claims to the right of priority of a foreign application, in a US application, are authorized by 35 USC 119(a) and 37 CFR 1.55(a). The requirements for the right of priority are specified in subsequent subsections of 35 USC 119 and 37 CFR 1.55.

35 USC 119(b)(1) requires that the applicant for a US patent make a claim to foreign priority, and that the claim be made "during the pendency of the application." 35 USC 119(b)(2) and (3) authorizes the USPTO Director to require a fee for unintentionally delayed claims, and to require a certified copy and translation into English of the foreign application.⁴³

VIII.A USPTO FOREIGN PRIORITY RESTORATION RULES

37 CFR 1.55(b) provides for restoration of "the right of priority in the subsequent application," via petition. The petition which must include a priority claim in an Application Data Sheet (ADS), a 1.17(m) fee, and an assertion that the delay in the filing of the subsequent application during the period from the expiration date of the priority period was unintentional.⁴⁴ 1.55(b) sets the two month period for restoration to run from a date based upon the Priority Period, which is defined to include the weekend and holiday extension of both 35 USC 21(b) and PCT rule 80.5.⁴⁵

VIII.B USPTO PRIORITY CLAIM RULES

37 CFR 1.55(b) does not include a deadline by which the petition for restoration must be made. However, US regulations have long imposed deadlines for claiming priority, and 1.55(b) requires that the restoration petition also present a claim to foreign priority. In addition, US regulations have long imposed deadlines for filing a certified copy of the foreign priority application. 37 CFR 1.55(d) and (f) impose the deadline for claims to foreign priority and filing of a certified copy, respectively.⁴⁶ 37 CFR 1.55(d)(1) imposes that deadline for "applications under 111(a)" to be "the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application." 1.55(d)(2) requires the claim to priority "in an international application entering the national stage under 35 U.S.C. 371" to "have been made in the international stage within the time limit specified in the PCT and the Regulations under the PCT." PCT rule 26bis.1 requires that claim be within the later of 16 months from the priority date and 4 months from the PCT filing date.

VIII.C USPTO PRIORITY CLAIM PROCEDURES

However, both 37 CFR 1.55(d)(1) and (2) provide an exception, a savings provision, allowing belated claims to priority to foreign applications under certain conditions. The exception is specified by rule 37 CFR 1.55(e).⁴⁷ Rule 1.55(e) provides for the filing of a petition for acceptance of a belated claim for priority; one made beyond the 16/4 month time periods specified in 1.55(d)(1) for US 111(a) applications, or beyond the time periods specified in 1.55(d)(2) by the PCT for a PCT application entering the national stage. This petition requires an ADS containing the priority claim, a certified copy of the foreign application, a 1.17(m) petition fee, and an assertion that the "entire delay between the date the priority claim was due under paragraph (d) of this section and the date the priority claim was filed was unintentional." 37 CFR 1.55(d)(2) requires the priority claim in a PCT application to

have been made at 16/4 months period authorized by PCT regulations. 37 CFR 1.55(e)(4) specifically states that the "entire delay" period to which the petition must aver, and that this period starts on "the date the priority claim was due under paragraph (d) of this section." Given that those recitations, the most likely construction of 1.55(e)(4) is that the period for which one must aver there was unintentional delay starts on the date the priority claim was due in the international phase, not upon the date of entry into the US national phase.

The procedure available to an applicant to add a priority claim depends upon the time at which they recognize the priority claim was missing, assuming the likely construction of 1.55(e)(4). Under US law, belated priority or benefit cannot be claimed and therefore priority or benefit cannot be restored, once there is intentional delay. Accordingly, an important time is when an applicant realizes that they failed to make the missing priority or benefit claim.

Relative to PCT applications, if the applicant realizes the priority claim is missing at a time in the international phase of a PCT application after when the priority claim may be added before the RO (the 16/4 months period), then the applicant must still act promptly to avoid intentional delay. That would require (1) filing of a 1.55(e) petition in the USPTO prior to national stage entry, (2) or filing a US national stage entry and 1.55(e) petition, or (3) filing a 111(a) bypass application and 1.55(e) petition. Given the construction of the rules, it is unclear whether filing of a 1.55(e) petition in the USPTO prior to national stage entry would be sufficient to avoid intentional delay in making the priority claim.⁴⁸ Consequently, at this time, the safer course of action in this situation is to immediately enter the US national stage and immediately petition under US rule 1.55(e) for entry of a belated claim to priority. The same analysis applies if the earlier application is a US provisional application instead of a foreign application.

Finally, 1.55(g) requires that the claim for foreign priority be filed "within the pendency of the application and before the patent is granted."⁴⁹ If an application issues prior to when the applicant realizes that there was a failure to claim priority or benefit, that defect can be corrected by filing an application to reissue the patent and petitioning under 1.55(e) to have a belated claim to priority or benefit entered.⁵⁰

US rules have also long required a certified copy of the priority document be filed to be entitled to foreign priority. Rule 1.55(f) contains the current version of this requirement, and this rule has time limits. 1.55(f)(1) requires the certified copy to be filed in a 111(a) application within the later of 16 months from the filing date of the priority application and 4 months from the US filing date. 1.55(f)(2) requires the certified copy in a PCT US national stage entry to have been filed in the international stage of a PCT application, but if not, then filed within the later of 16 months from the filing date of the foreign application and 4 months entry into the US national stage.⁵¹ However, US rule 1.55(f)(1) and (2) also have exceptions (saving provisions) allowing for belated filing of the certified copy of the priority document. First, 1.55(h) excuses the time limit for filing the certified copy if the foreign application was filed in an Office with which the USPTO has a priority document exchange program, the applicant requests the USPTO obtain the priority document from that other Office, and the USPTO receives the foreign priority document prior to the date the US application issues. Second, 1.55(i) excuses the time limit for filing the certified copy if the applicant timely files an uncertified interim copy of the foreign application and subsequently files a certified copy of the foreign application prior to the date the US application issues. If neither of the 1.55(h) and 1.55(i) exceptions apply, 1.55(f)(3) authorizes the applicant to petition for belated acceptance of the certified copy. A 1.55(f)(3) petition requires a showing of good cause why the delay in providing the certified copy should be excused, and the 1.17(g) fee.

Finally, 1.55(g) requires that a certified copy of a foreign priority application must be filed "within the pendency of the application and before the patent is granted."

VIII.D USPTO PRIORITY CLAIM CHAIN LAW

Consider a foreign priority claim, followed by a PCT or US application, followed by a US continuing application. A strange twist on entitlement to foreign priority is the USPTO official position that no claim for foreign priority need be made in a parent application for a continuing application to be entitled to priority to the foreign application. Instead, all the USPTO deems to be necessary is that the parent application was filed within 12 months of the foreign priority application.⁵² This has significant ramifications for restoring priority in priority claim chain cases, allowing both restoration and foreign priority in a continuing application despite lack of foreign priority in earlier applications in the claim chain. Thus, one may be able to restore foreign priority in continuing applications without having to restore priority in intervening applications.

IX. USPTO LAW AND REGULATIONS RELATING TO RESTORATION OF BENEFIT TO A US PROVISIONAL APPLICATION

Claims to the benefit of the filing date of a US provisional application are authorized by 35 USC 119(e)(1) and 37 CFR 1.78(a). The requirements for the benefit of a prior filed provisional application are specified in 35 USC 119(e)(1)-(3) and subsections of 37 CFR 1.78(a). 35 USC 119(e)(1) requires a "specific reference" to the provisional application "during the pendency" of the application claiming benefit. 35 USC 119(e)(1) required payment of a fee associated with filing the provisional application. 35 USC 119(e)(3) specifies the Priority Period discussed herein above. Rule 1.78(a)(1) sets the Priority Period at twelve months subject to the weekend and holiday extension of 35 USC 21(b) and PCT rule 80.5. Rule 1.78(b) provides for restoration of "the benefit of the provisional application", if the latter application was filed within 2 months of the expiration of the Priority Period.

IX.A USPTO US PROVISIONAL APPLICATION BENEFIT RESTORATION RULES

Restoration in an application of benefit under 1.78(b) requires the filing of a petition. The petition must include an ADS containing the benefit claim, the 1.17(m) fee, and an assertion that the delay in filing the application within the Priority Period was unintentional.⁵³

IX.B USPTO US PROVISIONAL APPLICATION BENEFIT CLAIM RULES

37 CFR 1.78(b) contains no time limit for filing a petition for restoration of benefit. However, 1.78(a)(4) provides the same 16/4 months time limit for claims to benefit as 1.55(d) provides for claims to foreign priority. 37 CFR 1.78(a)(4) provides the same requirement that the claim to benefit be made during the "pendency" of the application, as the 1.55(g) requirement that the claim to priority and the certified copy be filed during the "pendency" of the application.

37 CFR 1.78(c) provides for unintentionally delayed claims to benefit, via petition. This petition requires an ADS making the benefit claim, the 1.17(m) fee, and an assertion that the entire delay from the date the benefit claim was due was unintentional.

X. WHO HANDLES REQUESTS AND PETITIONS FOR RESTORATION OF PRIORITY IN THE USPTO

In the USPTO, the Office of PCT Legal Administration decides requests for restoration of PCT applications in the international stage pursuant to PCT Rule 26bis.3. In the USPTO, the Office of PCT Legal Administration also decides petitions for restoration of priority or benefit for any PCT US national stage, and any US non provisional application which includes a PCT application in its priority claim chain. In the USPTO, the Office of Petitions decides petitions for restoration for any application other than those decided by Office of PCT Legal Administration.⁵⁴

XI. USPTO PROCESSING OF REQUESTS AND PETITIONS FOR RESTORATION OF PRIORITY

Timing and timeliness of action on restoration may be important. A current estimate of the time for decision on a petition by the Office of Petitions is two to four months from the date the petition is filed.⁵⁵ A current estimate of the time for a decision on a petition by the Office of PCT Legal Administration is less than two months from the date the petition is filed.⁵⁶

However, one can petition, pursuant to 37 CFR 1.182 (questions not specifically provided for), for expedited processing, for example, for processing of another petition. The 1.182 petition requires paying the 1.17(h) fee. The effect of grant of a petition for expedited processing of a petition for restoration of priority directed to the Office of Petitions is that the petition for restoration of priority will be moved to the head of the line, on the docket of the petitions examiner, and should be the very next petition reviewed and decided by that examiner.⁵⁷ It is very advisable to notify the Office of Petitions of the filing of a petition for expedited review of another petition. Otherwise, the delay in deciding the petition for expedited review will defeat the goal of expediting review of the underlying petition. My anecdotal experience is that petitioning for expedited review of a petition along with notifying the Office of Petitions of the petition for expedited review, results in the decision on the underlying petition in under two weeks. Whether expediting a petition before the Office of PCT Legal Administration would be effective is unclear.

XII. RELIABILITY OF A USPTO RESTORATION PETITION DECISION

I spoke at length with various USPTO officials in the Commissioner's office, the Office of Petitions, and the Office of PCT Legal administration regarding various restoration of priority situations. However, their guidance is unpublished guidance and therefore lacks legal certainty. In any case, if a petition for restoration is granted, practitioners can take some comfort that courts will not be likely to second guess the grant of the petition. This is based upon decisions including Magnivision, Inc. v. Bonneau Co., 115 F.3d 956 (Fed. Cir. 1997) and Aristocrat Technologies Australia Pty Limited v. International Game Technology, 543 F.3d 657, 663 (Fed. Cir. 2008) (excluding from defense to validity the propriety of certain USPTO procedural actions). These cases stand for the general proposition that if the USPTO grants a petition on some matter unrelated to core issues of patentability, the correctness of that action is unlikely to form a basis for a Court to invalidate the resulting patent. Hence, a USPTO official granting a petition may, in effect, be the ultimate authority on the petition issue.

XIII. CONSIDERATION OF VARIOUS FACT PATTERNS

All fact patterns below assume the failure to timely file the later application was unintentional, and that the delay in filing the claim to the earlier application was unintentional, unless otherwise expressly stated.

1. Changes to the Priority Period of a US Provisional Claimed in a PCT Application

A PCT application is filed on a Tuesday in a RO that was closed on Monday. Monday was the Priority Date for a filing in the USPTO and the USPTO was open for filings on that Monday, and that Monday was not a Federal Holiday in the District of Columbia. A US national stage is subsequently filed after 12/18/2013. The US national stage is entitled to priority to the US provisional application. The US (under PLTIA) applies the PCT rule 80.5 local office rule.

2. Restoration in a US Application - No Chain

A US nonprovisional application is filed after the Priority Period (of a foreign application or US provisional application expires), but within 2 months after the Priority Period expires. Within the 16/4 period (which is the later of 16 months from the priority date and months from the filing date), and after 12/18/2013, the applicant files a petition for restoration and a claim for priority/benefit. The USPTO should restore priority.

3. Restoration in a US Application - No Chain

A US nonprovisional application is filed after the Priority Period (of a foreign application or US provisional application) expires, but within 2 months after the Priority Period expires. After the 16/4 period (for presenting a priority/benefit claim in a US application), and after 12/18/2013, the applicant files a petition for restoration and a claim for foreign priority. The USPTO is likely to deny priority. The applicant failed to petition for entry of the belated claim to priority/benefit, and the applicant failed to make the assertion that the entire delay in claiming priority/benefit was unintentional.

4. Restoration in a US Application - No Chain

The same facts as in the preceding fact pattern, except that applicant files a petition for entry of the belated claim to priority/benefit and a petition for restoration. The USPTO is likely to grant the petitions and restore priority.

5. Claim Chain continuation seeking restoration of foreign priority

A first US nonprovisional application is filed after the Priority Period of a foreign application expires, but within 2 months after the Priority Period expires. A second US nonprovisional claiming domestic benefit to the first US nonprovisional application, that is, a continuation application, is filed. The first US nonprovisional application is abandoned. That applicant seeks to restore priority in the continuation application to the foreign application and does not care about priority in the first US nonprovisional application. The applicant files in the continuation application a petition for a belated claim to priority and a petition for restoration of priority. Informal guidance from USPTO officials indicate that the USPTO will grant the petitions and restore priority in the continuation application.

6. Claim Chain continuation seeking restoration of US provisional benefit

Same facts as in the preceding fact pattern, except that the earliest application is a US provisional

application instead of a foreign application. The USPTO will deny restoration because there is no continuous chain of benefit claims; specifically there is no benefit claim in the first US nonprovisional application to the US provisional application.

7. Claim Chain continuation seeking restoration of US provisional benefit

Same facts as in the preceding fact pattern, except that, in addition to the steps taken in the prior fact pattern, without delay the applicant files an application to reissue the patent that issued from the first US non provisional and without delay files a petition in the reissue application for entry of a belated claim to benefit. It might also be necessary to file a petition for restoration in the reissue application, but the USPTO is likely to restore priority.

8. Restoration in a PCT application

A PCT application is filed in RO/IB after the Priority Period (of a foreign application or US provisional application) expires, but within 2 months after the Priority Period expires. Within fourteen months of the provisional filing date and two months of the PCT application's filing date, the applicant files a request for priority and a request to restore priority under the despite all due care standard. The IB determines that the applicant's evidence only supports restoration under the unintentional standard. The IB will deny the request to restore based upon the despite due care standard, and grant the request to restore based upon the unintentional standard. The applicant enters the US national stage on or after 12/18/2013. The USPTO will accept the international restoration for the US national stage. (The EPO will not accept the restoration for the EP regional stage.)

9. Restoration in a PCT application

The facts as in the preceding fact pattern, except that the applicant entered the US national stage before 12/18/2013. Whether the USPTO will accept the international restoration of priority for the remainder of the US national stage is unclear. No rules govern this situation, and a USPTO official questioned in January 2014 could provide no immediate guidance. No USPTO rule or PLTIA amendment expressly to cover this situation.

10. Restoration in the US national stage of a PCT application

A PCT application is filed in RO/IB after the Priority Period (of a foreign application or US provisional application) expires, but within 2 months after the Priority Period expires. After the 16/4 period for claiming priority in the international stage the applicant realizes that the priority claim was missing, and files a request for priority in the international stage. Several months later, the applicant enters the US national stage in which the applicant represents the priority/benefit claim and petitions for restoration of priority. The USPTO will deny the priority/benefit claim as untimely because it was not timely presented in the international stage. The USPTO will deny the petition for restoration because it has not entered the benefit claim.

11. Restoration in the US national stage of a PCT application

The same facts as the preceding fact pattern, except that the applicant enters the US national stage without delay upon realizing the belated priority claim. The USPTO will deny the priority/benefit claim as untimely because it was not timely presented in the international stage. The USPTO will deny the petition for restoration because it refused entry of the priority/benefit claim.

12. Restoration in the US national stage of a PCT application

The same facts as the preceding fact pattern, except that the applicant without delay from realizing the missed priority claim enters the US national stage and without delay files therein a petition for belated entry of the priority/benefit claim, and files therein a petition for restoration of priority/benefit. The USPTO will likely grant restoration in the US national stage.

13. Restoration in the US national stage of a PCT application

The same facts as the preceding fact pattern, except that the applicant intentionally delays 6 months before filing the petition for restoration of benefit/priority. The USPTO will likely grant restoration in the US national stage because there is no express time limit on when a petition for restoration may be filed, and the averment of unintentional delay in a petition for restoration does not refer to the delay in petitioning for restoration.

1. I can be reached via telephone at 1-703-415-0012, extension 100, or via the firm website:
<http://www.neifeld.com/cv.html#neifeld>
2. The Paris convention is posted by WIPO at: http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html
See also Bodenhausen, "Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967," WIPO Publication No. 611(E), ISBN 92-805-0368-5. WIPO posts a copy of Bodenhausen in pdf format at:
http://www.wipo.int/export/sites/www/freepublications/en/intproperty/611/wipo_pub_611.pdf
3. Paris article 4(C) refers to "patents and ... industrial designs". This distinction explains why US design patents have a six month Priority Period. See 35 USC 172, which states: "The right of priority provided for by subsections (a) through (d) of section 119 shall be six months in the case of designs. The right of priority provided for by section 119(e) shall not apply to designs."
4. See 35 USC 119(a) ("same invention ... same effect"); 35 USC 119(e) and 120 ("same effect, as to such invention").
5. WIPO maintains a list of treaties it administers at: <http://www.wipo.int/treaties/en/>
WIPO maintains a copy of the PLT at: http://www.wipo.int/treaties/en/text.jsp?file_id=288996#P181_28674
WIPO maintains a copy of the PLT Regulations at:
http://www.wipo.int/treaties/en/text.jsp?file_id=289512#P170_28754
WIPO maintains a copy of the PCT at: <http://www.wipo.int/pct/en/texts/articles/atoc.htm>
WIPO maintains a copy of the PCT Regulations at: <http://www.wipo.int/pct/en/texts/rules/rtoc1.htm>
6. PLT Article 13 states:

Article 13 - Correction or Addition of Priority Claim; Restoration of Priority Right
(1) [Correction or Addition of Priority Claim] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application ("the subsequent application"), if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed within the time limit prescribed in the Regulations; and (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.
(2) [Delayed Filing of the Subsequent Application] Taking into consideration Article 15, a Contracting Party shall provide that, where an application ("the subsequent application") which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed within the time limit prescribed in the Regulations; (iii) the request states the reasons for the failure to comply with the priority period; and (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.
(3) [Failure to File a Copy of Earlier Application] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, if: (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations; (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5); (iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and (iv) a

copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

PLT Rule 14 states:

Rule 14 - Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [Exception Under Article 13(1)] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [Time Limit Under Article 13(1)(ii)] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [Time Limits Under Article 13(2)] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired. (b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [Requirements Under Article 13(2)(i)] A Contracting Party may require that a request referred to in Article 13(2)(i): (i) be signed by the applicant; and (ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [Requirements Under Article 13(3)] (a) A Contracting Party may require that a request referred to in Article 13(3)(i): (i) be signed by the applicant; and (ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request. (b) A Contracting Party may require that: (i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office; (ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [Time Limit Under Article 13(3)(iii)] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

7. The PCT Glossary defines "Receiving Office" to mean "The national Office, intergovernmental or international organization with which the international application is filed and which checks and processes it according to the PCT and its Regulations," citing to PCT Articles 2(xv) and 10. The PCT glossary is at:

<http://www.wipo.int/pct/en/texts/glossary.html>.

8. PCT Rule 26bis states:

Rule 26bis - Correction or Addition of Priority Claim

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct a priority claim or add a priority claim to the request by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

(b) Any notice referred to in paragraph (a) received by the receiving Office or the International Bureau after the applicant has made a request for early publication under Article 21(2)(b) shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

26bis.2 Defects in Priority Claims

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim: (I) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted; (ii) that the priority claim does not comply with the requirements of Rule 4.10; or (iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (I), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, unless the receiving Office has notified the International Bureau under Rule 26bis.3(j) of the incompatibility of Rule 26bis.3(a) to (I) with the national law applied by that Office.

(b) If the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim, that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit.

(c) A priority claim shall not be considered void only because: (I) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing; (ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or (iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.

(d) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(e) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26bis.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information.

26bis.3 Restoration of Right of Priority by Receiving Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant, and subject to paragraphs (b) to (g) of this Rule, restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period: (i) occurred in spite of due care required by the circumstances having been taken; or (ii) was unintentional. Each receiving Office shall apply at least one of those criteria and may apply both of them.

(b) A request under paragraph (a) shall: (i) be filed with the receiving Office within the time limit applicable under paragraph (e); (ii) state the reasons for the failure to file the international application within the priority period; and (iii) preferably be accompanied by any declaration or other evidence required under paragraph (f).

(c) Where a priority claim in respect of the earlier application is not contained in the international application, the applicant shall submit, within the time limit applicable under paragraph (e), a notice under Rule 26bis.1(a) adding the priority claim.

(d) The submission of a request under paragraph (a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration, payable within the time limit applicable under paragraph (e). The amount of that fee, if any, shall be fixed by the receiving Office. The time limit for payment of the fee may be extended, at the option of the receiving Office, for a period of up to two months from the expiration of the time limit applicable under paragraph (e).

(e) The time limit referred to in paragraphs (b)(i), (c) and (d) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a) or any notice referred to in paragraph (c) submitted, or any fee referred to in paragraph (d) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

(f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(iii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau a copy of any such declaration or other evidence filed with the receiving Office, in which case the International Bureau shall include such copy in its files.

(g) The receiving Office shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (f).

(h) The receiving Office shall promptly: (i) notify the International Bureau of the receipt of a request under paragraph (a); (ii) make a decision upon the request; (iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

(i) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(j) If, on October 5, 2005, paragraphs (a) to (i) are not compatible with the national law applied by the receiving Office, those paragraphs shall not apply in respect of that Office for as

long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

9. The PCT glossary defines a DO to be "A national office of or acting for a State designated in an international application under Chapter I of the PCT," citing PCT articles Article 2(xiii) and 20.

10. PCT Rule 49ter.1 states:

49ter.1 Effect of Restoration of Right of Priority by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion.

(c) A decision by the receiving Office to restore a right of priority under Rule 26bis.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of or acting for that designated State finds that a requirement under Rule 26bis.3(a), (b)(I) or (c) was not complied with, taking into account the reasons stated in the request submitted to the receiving Office under Rule 26bis.3(a) and any declaration or other evidence filed with the receiving Office under Rule 26bis.3(b)(iii).

(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in paragraph (c) was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for that doubt and giving the applicant an opportunity to make observations within a reasonable time limit.

(e) No designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

(f) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49ter.2(a) within the time limit under that Rule.

(g) If, on October 5, 2005, paragraphs (a) to (d) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.⁸

11. PCT rule 49ter.2 states:

49ter.2 Restoration of Right of Priority by Designated Office

(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it ("criterion for restoration") is satisfied, namely, that the failure to file the international application within the priority period: (i) occurred in spite of due care required by the circumstances having been taken; or (ii) was unintentional. Each designated Office shall apply at least one of those criteria and may apply both of them.

(b) A request under paragraph (a) shall: (i) be filed with the designated Office within a

time limit of one month from the applicable time limit under Article 22; (ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (c); and (iii) be accompanied by any fee for requesting restoration required under paragraph (d).

(c) The designated Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b)(ii) be filed with it within a time limit which shall be reasonable under the circumstances.

(d) The submission of a request under paragraph (a) may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

(e) The designated Office shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under paragraph (c).

(f) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraphs (a) and (b), the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under those paragraphs.

(g) Each designated Office shall inform the International Bureau of which of the criteria for restoration it applies, of the requirements, where applicable, of the national law applicable in accordance with paragraph (f), and of any subsequent changes in that respect. The International Bureau shall promptly publish such information in the Gazette.

(h) If, on October 5, 2005, paragraphs (a) to (g) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

12. See http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration
13. See: http://www.wipo.int/pct/guide/en/gdvoll/annexes/annexa/ax_a.pdf
14. And for which RO/US is the competent RO. 37 CFR 1.452 states:

1.452 Restoration of right of priority.

(a) If the international application has an international filing date which is later than the expiration of the priority period as defined by PCT Rule 2.4 but within two months from the expiration of the priority period, the right of priority in the international application may be restored upon request if the delay in filing the international application within the priority period was unintentional.

(b) A request to restore the right of priority in an international application under paragraph (a) of this section must be filed not later than two months from the expiration of the priority period and must include: (1) A notice under PCT Rule 26bis.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application; (2) The petition fee as set forth in §1.17(m); and (3) A statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

(c) If the applicant makes a request for early publication under PCT Article 21(2)(b), any requirement under paragraph (b) of this section filed after the technical preparations for international publication have been completed by the International Bureau shall be considered as not having been submitted in time. [72 FR 51563, Sept. 10, 2007, as amended at 78 FR 62407, Oct. 21, 2013]

15. See http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=4

16. The PLTIA is Public Law 112-211 (2012). Title II of the PLTIA reads "Patent Law Treaty Implementation" and implements in US national law aspects of the PLT that were not already present in US national law, specifically including a right to restoration of priority.

17. 35 USC 119(a), as amended by the PLTIA, with text added by PLTIA underlined and text deleted by PLTIA in ~~strikeout~~, reads:

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within ~~twelve~~ 12 months from the earliest date on which such foreign application was filed. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

119(e), as amended by PLTIA, with text added by PLTIA underlined and text deleted by PLTIA in ~~strikeout~~, reads:

(e) (1) An application for patent filed under section 111(a) or section 363 for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b), if the application for patent filed under section 111(a) or section 363 is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. The Director may prescribe regulations, including the requirement for payment of the fee specified in section 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application under section 111(a) or section 363 within the 12-month period was unintentional. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, ~~including the payment of a surcharge~~ including the payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this subsection ~~during the pendency of the application~~

(2) A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day. For an application for patent filed under section 363 in a Receiving Office other than the Patent and Trademark Office, the 12-month and additional 2-month period set forth in this subsection shall be extended as provided under the treaty and Regulations as defined in section 351.

365(b) as amended by the PLTIA, with text added by PLTIA underlined and text deleted by PLTIA in ~~strikeout~~, states:

(b) In accordance with the conditions and requirements of section 119(a) and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed claim for priority under the treaty and the Regulations, and to accept a priority claim that pertains to an application that was not filed within the priority period specified in the treaty and Regulations, but was filed within the additional 2-month period specified under section 119(a) or the treaty and Regulations.

18. See PLTIA, Title II, sec. 203(a)(2) and (b)(2). Sec. 203 states:

SEC. 203. EFFECTIVE DATE.

(a) IN GENERAL. - The amendments made by this title - (1) shall take effect on the date that is 1 year after the date of the enactment of this Act; and (2) shall apply to— (A) any patent issued before, on, or after the effective date set forth in paragraph (1); and (B) any application for patent that is pending on or filed after the effective date set forth in paragraph (1).

(b) EXCEPTIONS. - (1) SECTION 201(a).—The amendments made by section 201(a) shall apply only to applications that are filed on or after the effective date set forth in subsection (a)(1). (2) PATENTS IN LITIGATION. - The amendments made by this title shall have no effect with respect to any patent that is the subject of litigation in an action commenced before the effective date set forth in subsection (a)(1).

The effective date is December 18, 2013. PLTIA, Title II, Sec. 203 makes the restoration provisions of Sec. 201(c) applicable to "any patent issued before, on, or after" and "any application for patent that is pending on or filed after" December 18, 2013. With the Sec 203(b) exceptions that these restoration provisions are inapplicable for a "patent that is the subject of litigation in an action commenced before" December 18, 2013.

The only applications to which the PLTIA is inapplicable are those applications abandoned prior to 12/18/2013. However, normally abandoned applications can be revived via petition for certain purposes. *Cf.* Manual of Patent Examining Procedure, (MPEP) 711.02 "Failure To Take Required Action During Statutory Period."

19. See "Changes To Implement the Patent Law Treaty; Final Rule" 78 FR 62368 (October 21, 2013).

20. *Id.*, at page 62377 ("§ 1.55(c) contains the provisions relating to the restoration of the right of priority"); at page 62380 ("§ 1.78(b) as adopted in this final rule contains the provisions pertaining to the restoration of the right to the benefit of a provisional application.")

37 CFR 1.55(c), as amended, states:

(c) Delayed filing of subsequent application. If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b) of this section, but within two months from the expiration of the period set forth in paragraph (b) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b) of this section was unintentional. A petition to restore the right of priority under this paragraph filed in the subsequent application must include: (1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted; (2) The petition fee as set forth in §

1.17(m); and (3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

37 CFR 1.78(b), as amended, states:

(b) Delayed filing of the nonprovisional application or international application designating the United States of America. If the nonprovisional application or international application designating the United States of America has a filing date which is after the expiration of the twelve-month period set forth in paragraph (a)(1) of this section but within two months from the expiration of the period set forth in paragraph (a)(1) of this section, the benefit of the provisional application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the nonprovisional application or international application designating the United States of America within the period set forth in paragraph (a)(1) of this section was unintentional. (1) A petition to restore the benefit of the provisional application under this paragraph filed in the nonprovisional application or international application designating the United States of America must include: (i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted; (ii) The petition fee as set forth in § 1.17(m); and (iii) A statement that the delay in filing the nonprovisional application or international application designating the United States of America within the twelve-month period set forth in paragraph (a)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. (2) The restoration of the right of priority under PCT Rule 26bis.3 to a provisional application does not affect the requirement to include the reference required by paragraph (a)(3) of this section to the provisional application in a national stage application under 35 U.S.C. 371 within the time period provided by paragraph (a)(4) of this section to avoid the benefit claim being considered waived.

21. "Office" refers to the authority of the Contracting Party entrusted with granting patents within the meaning of the definition in PLT article 1(I); and the national office or intergovernmental authority entrusted with the task of granting regional patents within the meaning of the definition in PCT Article 2(xii).

22. 35 USC 119(e)(3) as amended is not a model of clarity. It has the problem that "extended as provided under the treaty and Regulations as defined in section 351" refers to the PCT which has PCT article 8 to define priority, which in turn refers to Paris to define priority. However, Paris is only applicable to international filings, and 119(e)(3) deal with a US-US intra national priority claim, not an international claim in the sense intended by Paris. However, the only reasonable interpretation of this provision is that it is intended to invoke PCT rule 80.5, the local office closure rule that extends deadlines during the days a local RO is closed.

23. Some URLs listing national holidays are:

<http://www.feiertagskalender.ch/cal.php?geo=0&jahr=2014&hl=en&hidepast=0&klasse=3>
<https://www.cia.gov/library/publications/the-world-factbook/fields/2109.html>
<http://www.infoplease.com/ipa/A0907876.html>

24. PCT rule 19.1 specifies that an Office is an RO for a PCT application if any of the applicants are a national or a resident of a PCT contracting state served by that RO, or the Office is the IB. PCT Rule 19.4 specifies that if an Office receives a PCT application and none of the applicants are a resident or national of the contracting states served by that Office, then the IB is the de jure RO. Hence, choice of RO for a given applicant is limited.

25. An applicant whose residence or nationality makes a desired RO competent, can be added to a PCT application's Request, for example, as an applicant only for some state of lesser consequence.

26. Private communication from Michael Richardson, Deputy Director for business development, at WIPO, and private communication from an official in the Office of PCT Legal Administration.

27. The number of PCT applications filed in RO/US is available from WIPO in its "2013 PCT Yearly Review," available at: http://www.wipo.int/export/sites/www/freepublications/en/patents/901/wipo_pub_901_2013.pdf

28. Whether a DO is bound to accept a restoration decision by an RO is indicative but not conclusive of whether restoration exists in that country, for a PCT application. Whether the PLT is in force in that country indicates whether restoration is available for all applications. WIPO provides the following information, country by country, showing whether the DO accepts restoration by an RO, and whether the PLT is in force, as of January 23, 2014.

JURISDICTION: PCT/DO practice; PLT in force

US: PCT/DO yes; PLT Yes

GB: PCT/DO yes; PLT Yes

AU: PCT/DO yes; PLT Yes

RU: PCT/DO yes; PLT Yes

EP: PCT/DO yes; PLT NO

IL: PCT/DO, yes; PLT NO

IN: PCT/DO NO, PLT NO

BR: PCT/DO No, PLT NO

CN: PCT/DO No, PLT NO

CN: PCT/DO No, PLT NO

JP: PCT/DO No, PLT NO

KR: PCT/DO No, PLT NO

DE: PCT/DO No, PLT NO

This information is not conclusive. For example, a German colleague informed me that German law provides for restoration but with a time limit of 24 months from priority.

29. See http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=4

30. WIPO lists States that have reservations to provisions of the PCT, by provision, on

http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

See countries having reservations under 26bis.3(j); 49ter.1(g); and 49ter.2(h). The 49ter.1(g) reservation means such countries do not honor restoration determine by an RO. Currently, the list of codes for all such countries are: BR; CA; N; CO; CU; CZ; DE; DZ; ID; JP; KR; LT; MX; NO; PH; and TR. However, WIPO documents indicate that other offices refuse to recognize restoration of priority in the international stage but have not provided WIPO with a 49ter.1(g) reservation and therefore do not appear on this list.

31. See paragraph 166G, PCT/GL/RO/12, 6/25/2013 ("PCT RECEIVING OFFICE GUIDELINES"), at:

<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ro.pdf>.

32. See "PCT RECEIVING OFFICE GUIDELINES", and therein chapter VII, paragraph 166H, at:

<http://www.wipo.int/export/sites/www/pct/en/texts/pdf/ro.pdf>. Chapter VII, paragraphs 166A-O contain details of the requirements for requests for restoration.

33. WIPO provides a chart showing, by Office, the acceptable standards for finding restoration. See:

<http://www.wipo.int/pct/en/texts/restoration.html>. Currently that chart lists 27 DOs that only accept only the due care standard; and 15 DOs that accept the unintentional standard.

34. See: <http://www.wipo.int/pct/en/texts/restoration.html>.

35. The PCT Glossary (see <http://www.wipo.int/pct/en/texts/glossary.html>) defines the "international phase."

36. There is an exception to the rule that the RO in which a PCT application is received decides a request for restoration of priority under "PCT RECEIVING OFFICE GUIDELINES", paragraph 166B. The RO has discretion to transfer to the application to RO/IB in case it does not provide for restoration under the standard requested by the applicant. However, that appears to be discretionary with the RO. A PCT application must be filed with either the IB or an RO of a PCT contracting State in which the (or an) applicant is a resident or national, or the national office or intergovernmental association to which a contracting State has delegated the responsibility to act as their RO. PCT rule 19.1 and 19.2. However, PCT rule 19.4(a)(iii) provides for optional transmittal of the PCT application to RO/IB if both RO/US and RO/IB agree to the transfer and the applicant also agrees. When RO/US will transfer a PCT application to RO/IB in relation to restoration requests is discussed in "April 2007 Revision of Patent Cooperation Treaty Regulations, Final Rule" 72 FR 51559 2007), in response to comment 3. That appears to limit transfers only to situations where the PCT application is on file in RO/US before the applicant realizes that priority needs restoration. A private communication with an Office of PCT Legal Administration officer indicated, however, that such transfer may occur when it does not burden either RO/US or RO/IB, which generally means early on after filing of the PCT application in RO/US.

37. The PLTIA revised US law to provide a uniform "unintentional" standard for all loss of right types of situations, including restoration of priority.

38. 35 USC 184 states in part:

Except when authorized by a license obtained from the Commissioner of Patents a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country.

See also 37 CFR 5.11.

35 USC 181 states in part:

Whenever publication or disclosure by the publication of an application or by the grant of a patent on an invention in which the Government has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner of Patents upon being so notified shall order that the invention be kept secret and shall withhold the publication of an application or the grant of a patent therefor under the conditions set forth hereinafter.

39. See 37 CFR 5.13. See also: http://www.uspto.gov/faq/faqs_lr.jsp:

40. 35 USC 119(a) provides for priority claims to foreign applications. PLTIA, Title II, section 201(c) amends 35 USC 119(a) to provide that the "period ...may be extended ... if the delay in filing the application in this country ... was unintentional."

35 USC 119(e)(1) provides for benefit claims to United States provisional applications in US 111(a) nonprovisional applications and PCT applications. PLTIA, Title II, section 201(c) amends 35 USC 119(e)(1) to provide "the ...period ... may be extended ...if the delay... under section 111(a) or section 363 ... was unintentional." The PCT provides for either unintentional or due care standards for requests to restore priority. The USPTO acting as the RO/US has elected to only consider the unintentional standard, as indicated by WIPO. See: <http://www.wipo.int/pct/en/texts/restoration.html>

41. The PLTIA, Title II, section 201(c), amendments to 119(a); 119(e); 119(e)(3); and 365(b) all recite the "additional 2 months".

42. The PLTIA, Title II, section 201(c), amendments to 119(a) and 119(e) both recite that "The Director may prescribe regulations ... pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months...." and amends 365(b) to recite that "The Director may establish procedures ...to accept a

priority claim ... was filed within the additional 2-month period....".

43. 35 USC 119(b) states:

(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

44. 37 CFR 1.55(b) states in relevant part:

A petition to restore the right of priority under this paragraph filed in the subsequent application must include: (1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted; (2) The petition fee as set forth in § 1.17(m); and (3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b) of this section was unintentional.

37 CFR 1.55(f) states:

(f) Time for filing certified copy of foreign application -

(1) Application under 35 U.S.C. 111(a). A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraphs (h) and (I) of this section. The time period in this paragraph does not apply in a design application.

(2) Application under 35 U.S.C. 371. A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371. If a certified copy of the foreign application is not filed during the international stage, a certified copy of the foreign application must be filed within four months from the date of entry into the national stage as set forth in § 1.491 or sixteen months from the filing date of the prior-filed foreign application, except as provided in paragraphs (h) and (I) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371, and the exceptions in paragraphs (h) and (I) of this section are not applicable, the certified copy of the foreign application must be accompanied by a petition including a showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

45. 37 CFR 1.55(b) also provides a 6 month period for US design applications.

46. Design applications are not subject to application publication. 37 CFR 1.55(d) states that it is inapplicable to design applications.

47. 37 CFR 1.55(e) states:

(e) Delayed priority claim. Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) not presented in the manner required by paragraph (d) of this section within the time period provided by paragraph (d) of this section is considered to have been waived. If a claim for priority is presented after the time period provided by paragraph (d) of this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), or 365(a) or (b) in an application data sheet (§ 1.76(b)(6)), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application if required by paragraph (f) of this section, unless previously submitted;

(3) The petition fee as set forth in § 1.17(m); and

(4) A statement that the entire delay between the date the priority claim was due under paragraph (d) of this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

48. This is because 1.55(e) is applicable to 1.55(d) and 1.55(d)(2) refers to an application entering the US national stage. It is therefore unclear whether a 1.55(e) petition would be applicable to an application not entering the US national stage when the 1.55(e) petition was filed. I discussed this issue with an official in the Office of PCT Legal Administration on 1/23/2014. At that time, there was no clear answer how the USPTO would handle this situation.

49. 37 CFR 1.119(g) states:

(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application.

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application and before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must also be accompanied by the processing fee set forth in § 1.17(i), but the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section: (i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding; (ii) When necessary to overcome the date of a reference relied upon by the examiner; or (iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except: (i) When the application is involved in an interference (see § 41.202 of this title) or derivation (see part 42 of this title) proceeding; (ii) When necessary to overcome the date of a reference relied upon by the examiner; or (iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

50. Reissue for the sole purpose of perfecting a foreign priority claim is not broadening and therefore can be made at any time. Fontijn v. Okamoto, 518 F. 2d 610, 622 (CCPA 1975). MPEP 1402 authorizes addition of a claim to benefit of a US provisional application in a reissue application, relying upon Fontijn for authority. Distinguish situations where a claim was present in an earlier application, but not in a form required by USPTO regulations.

51. Entry into the US national stage is defined in 1.491, which requires complying with 35 USC 371(c)(1) and (c)(2) within 30 months of the 30 month time limit specified in 1.495. The 35 USC 371(c)(1) requirement is the payment of the national fee specified in 35 USC 41(a). The 35 USC 371(c)(1) requirement is the submission of a copy of the application if the USPTO did not previously receive a copy and translation into English of non English specifications.

52. MPEP 201.14, third paragraph:

Where a claim for priority under 35 U.S.C. 119(b) has not been made in the parent application, the claim for priority may be made in a ** > continuing application < provided the parent application has been filed within 12 months from the date of the earliest foreign filing. ** > See In re Tangsrud, 184 USPQ 746 (Comm'r Pat. 1973).

See also Inter Partes Reexamination Control Number 95/001,921, Action closing prosecution, at page 2 (USPTO 12/16/2013):

As to the issue of foreign priority: After consultations with USPTO attorneys and reconsideration of 35 U.S.C. 119 and 37 C.F.R. 1.55, PO is correct that for foreign priority claims under 35 U.S.C. 119, each application in a "chain" of priority applications need not have the foreign priority claim as long as there is an application in the chain filed within 12 months of the foreign application for which priority is sought. Therefore, the '281 patent is entitled to claim priority to the '028 French application.

But see Medtronic Corevalve LLC v. Edwards Lifesciences Corp., Case No. 11-CV-0961 (C.D. Cal. 11/13/2012):

Accordingly, the Court finds that § 119, in addition to the requirements expressly laid out in subsections (a) and (b), requires that all intermediate applications in a priority chain contain a specific reference to the earlier-filed foreign application. [Footnote 8 omitted.] Medtronic admits that not every intervening application in the priority chain claims priority to French Application 1b. (See Pls.' Opp'n & Cross-Mot. Br. 12). Therefore, based on the Court's interpretation of § 119, the '281 Patent is not entitled to the benefit of the October 31, 2000 filing date of French Application 1b.

53. 37 CFR 1.78(b) states the requirement for the petition as follows:

(1) A petition to restore the benefit of the provisional application under this paragraph filed in the nonprovisional application or international application designating the United States of America must include: (i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(3) of this section to the prior-filed provisional application, unless previously submitted; (ii) The petition fee as set forth in § 1.17(m); and (iii) A statement that the delay in filing the nonprovisional application or international application designating the United States of America within the twelve-month period set forth in paragraph (a)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

54. Private communications with officials in both the Office of Petitions and the Office of PCT Legal Administration. This division of labor is an internal policy within the USPTO and therefore subject to change without notice to the public.

55. Private communication with the Director of the Office of Petitions and another member of that Office.
56. Private communication with a supervisor in the Office of PCT Legal Administration.
57. Private communication with the Director of the Office of Petitions and a member of his Office