

# Restoration Of Priority AIPLA Webinar February 12, 2014

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# WHAT WE WILL COVER

- Overview and significance of changes to restoration and priority
- Paris priority and changes to 35 USC 119(e)(3)
- Restoration examples based upon a Priority/PCT/US application chain
- Foreign priority, US provisional
- Non PCT priority claim chains

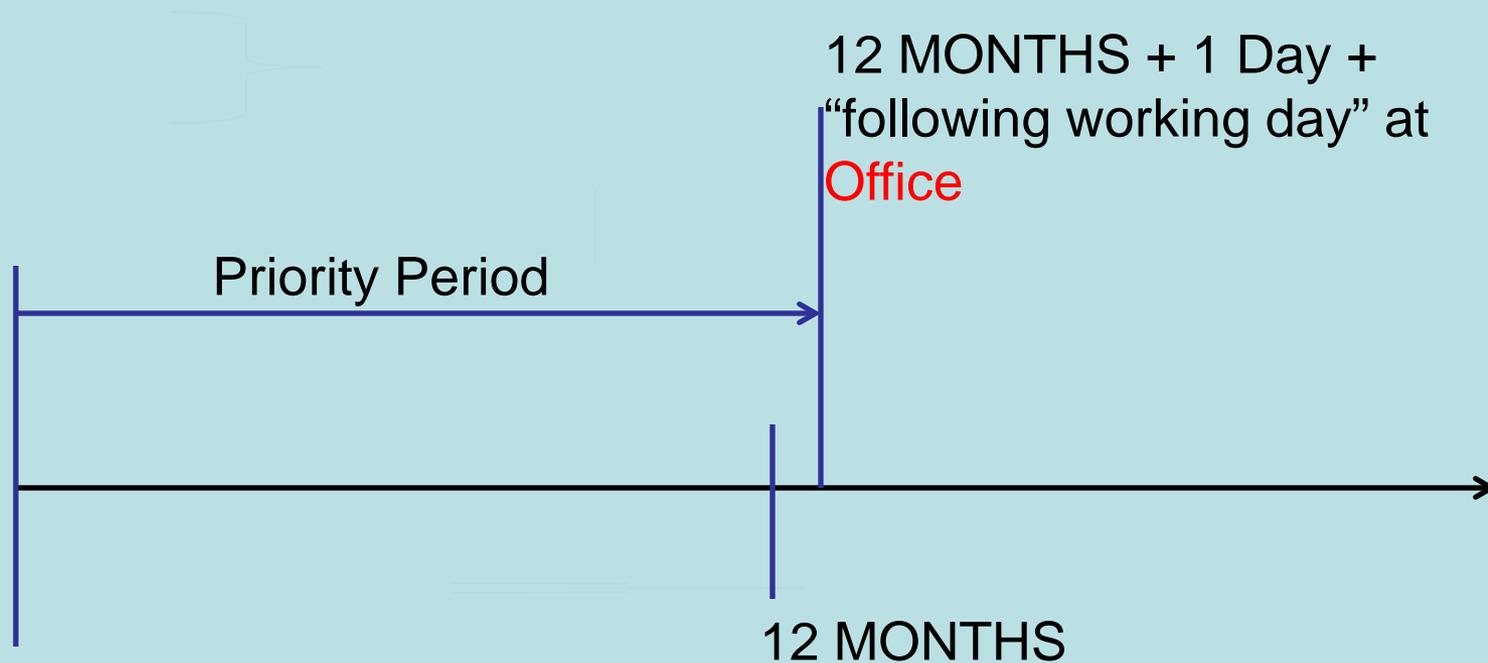
# RESTORATION OF PRIORITY (ROP) OVERVIEW

- Possible for filings within 2 months from the end of the Priority Period
- PLT, PCT, National Law
- WIPO Lists Reservations and Notifications
- Consult competent counsel in each jurisdiction

# SIGNIFICANCE OF RESTORATION

- Numbers and percent of restorations
- Restoration is a growing trend
- Do you know where priority can be restored?
- Have you considered the impact on your client?
  - As a Counselor
  - As a Prosecutor

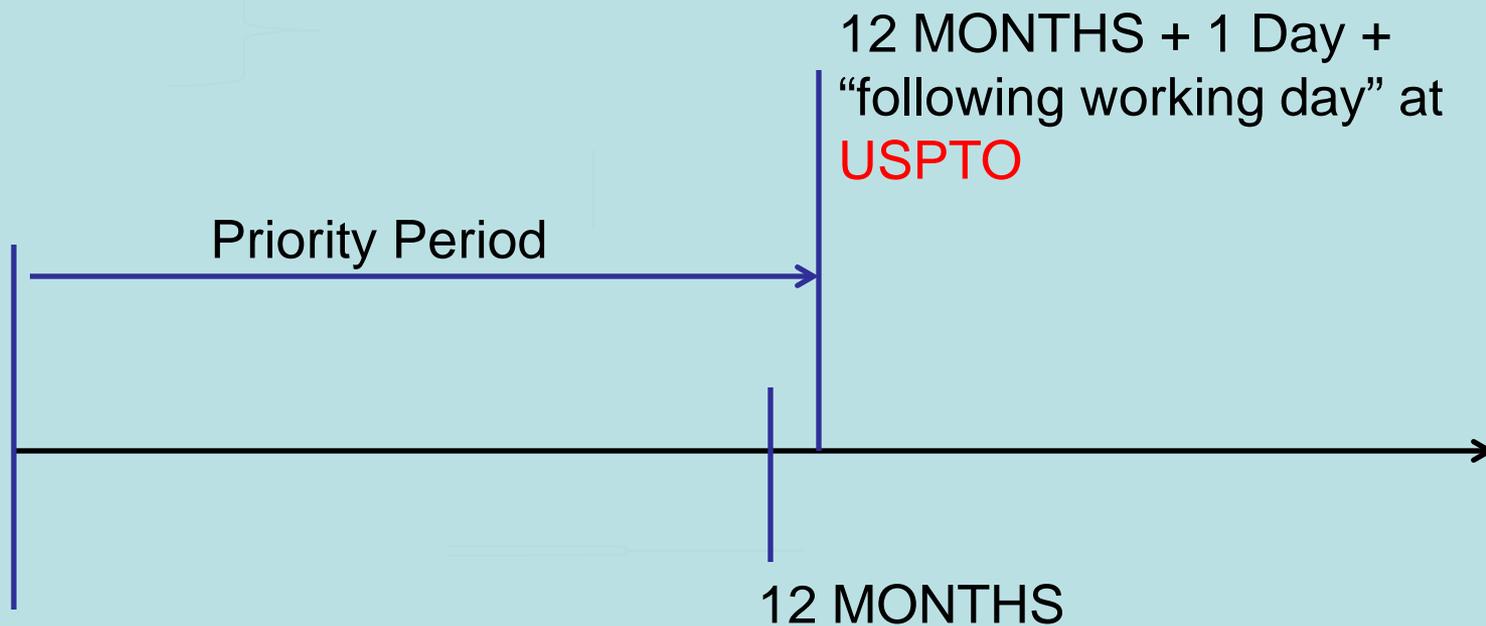
# PARIS PRIORITY FOR PATENTS



## PD

- Paris Article 4C(1) – “twelve months for patents”
- Paris Article 4C(2) - “day of filing shall not be included “
- Paris Article 4C(3) – “following working day” after “official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed”

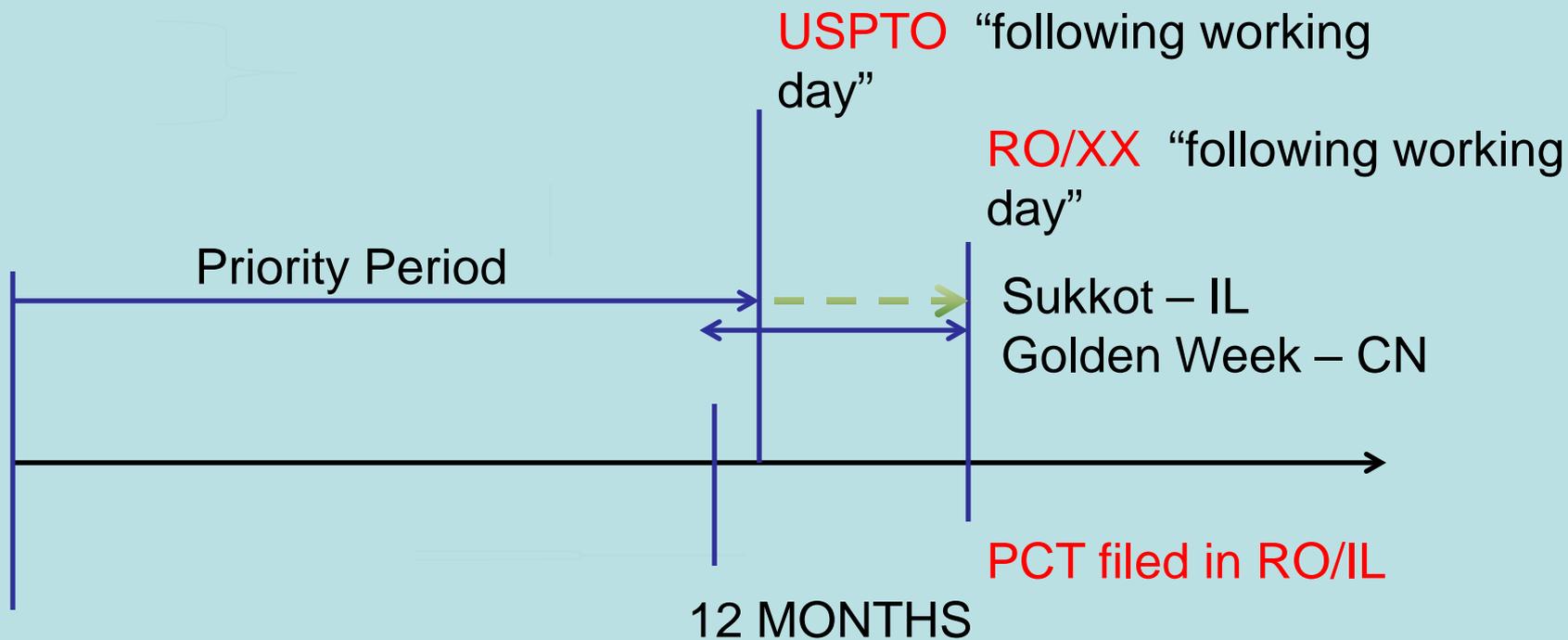
# US PROVISIONAL – PRE PLTIA



## PD

- 35 USC 119(e)(1) “12 months after the date”
  - 35 USC 119(e)(3) – “extended to the next succeeding secular or business day” after “Saturday, Sunday, or Federal holiday within the District of Columbia”
- (See also 35 USC 21; 37 CFR 1.7; 1.9(h))

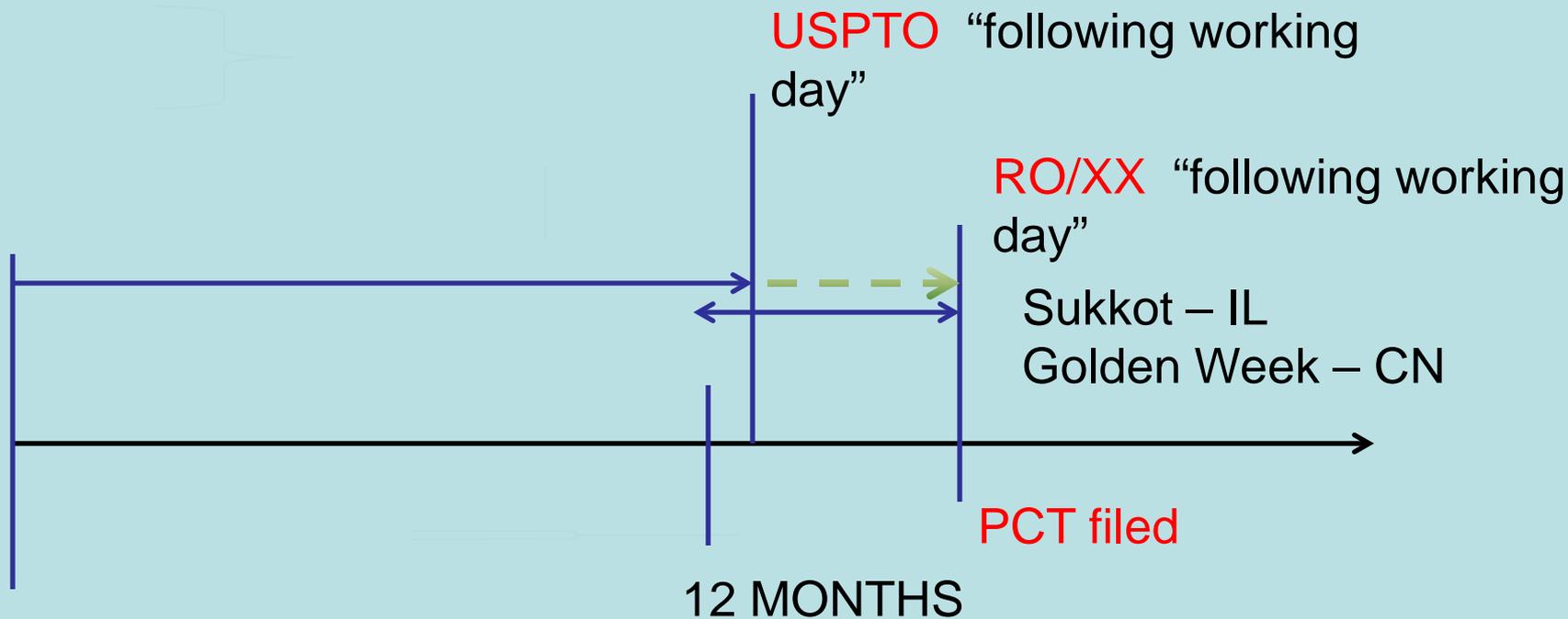
# PROV FOLLOWED BY PCT – PRE PLTIA



## PD

- Paris Article 4(A)(1) Right of priority “for the purpose of filing in the *other* countries”
- PCT Article 8(2)(b) Intra-national priority “governed by the national law of that State”
- PCT Rule 80.5 – Local Office rule

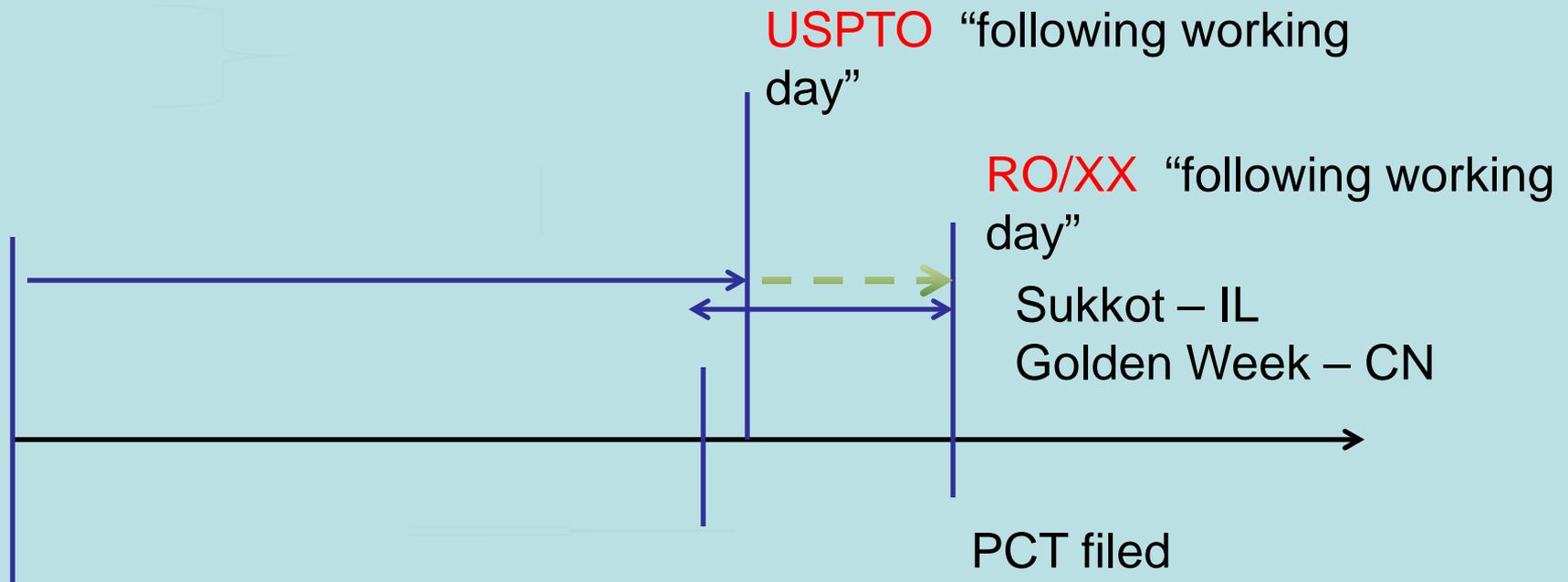
# PROV FOLLOWED BY PCT – PRE PLTIA



PD

- **Outside US – There IS a priority right.** Per PCT Article 8, PCT rule 80.5 extends priority period to next day RO in which PCT filed was open for filings.
- **Inside the US – There IS NO priority right.** Per PCT Article 8, intra national priority “governed by the national law”

# PROV FOLLOWED BY PCT – *POST PLTIA*



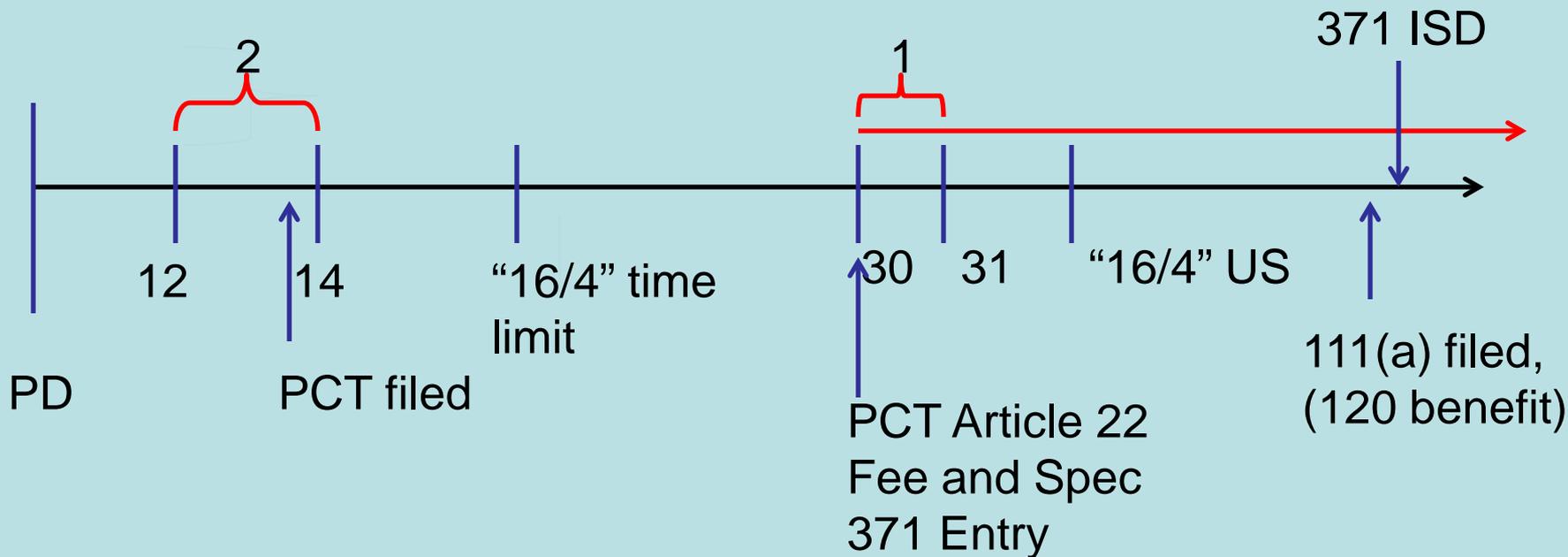
## PD

- **Outside US – There IS a priority right.** Per PCT Article 8, PCT rule 80.5 extends priority period to next day RO in which PCT filed was open for filings.
- **Inside the US – There IS ALSO a priority right.** Per PCT Article 8, intra national priority “governed by the national law”

# PLTIA AMENDED 119(e)(3)

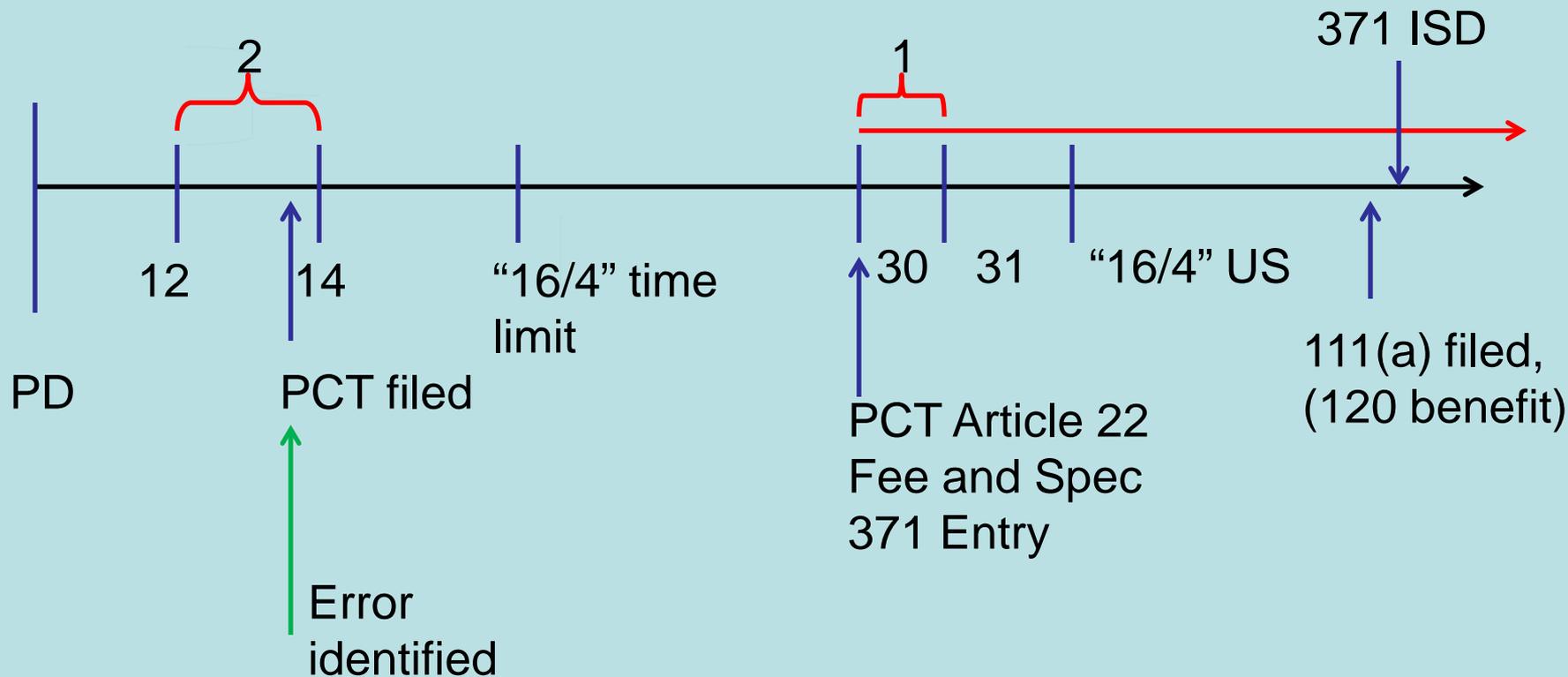
- 119(e)(3): For a PCT filed in an RO “other than” RO/US Priority Period is “extended as provided under the [PCT] ...and [its] Regulations”
- PCT rule 80.5 – Period extended when the RO is closed.
- PLTIA 119(e)(3) change is *RETROACTIVE AND AUTOMATIC* (Corrected OFR, COC)
- 119(e)(3) and RO shopping

# RESTORATION - PRIORITY/PCT CHAIN



- When is the failure to claim the PD recognized?
- What must be done, and when, to restore priority?
- **PCT time limits reset to earliest claimed PD. 26bis.1(c)**

# RESTORATION - PRIORITY/PCT CHAIN

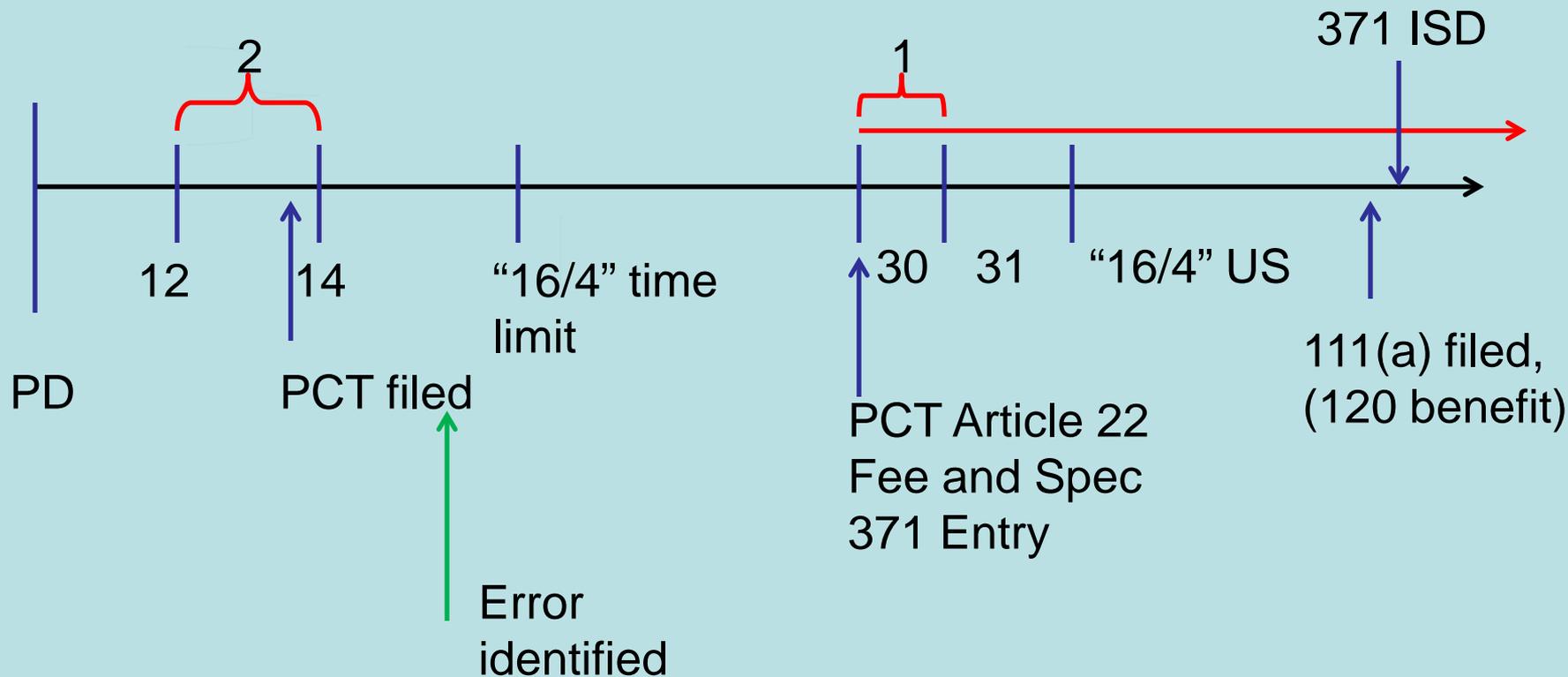


- RO: Request to restore + Claim to Priority filed by 14 months from PD. 26Bis.3(a), (c).
- If restoration granted by RO, no further action required in the US cases.
- Time limits reset; 26bis.1(c).

# US Transition Cases - Outstanding Issues

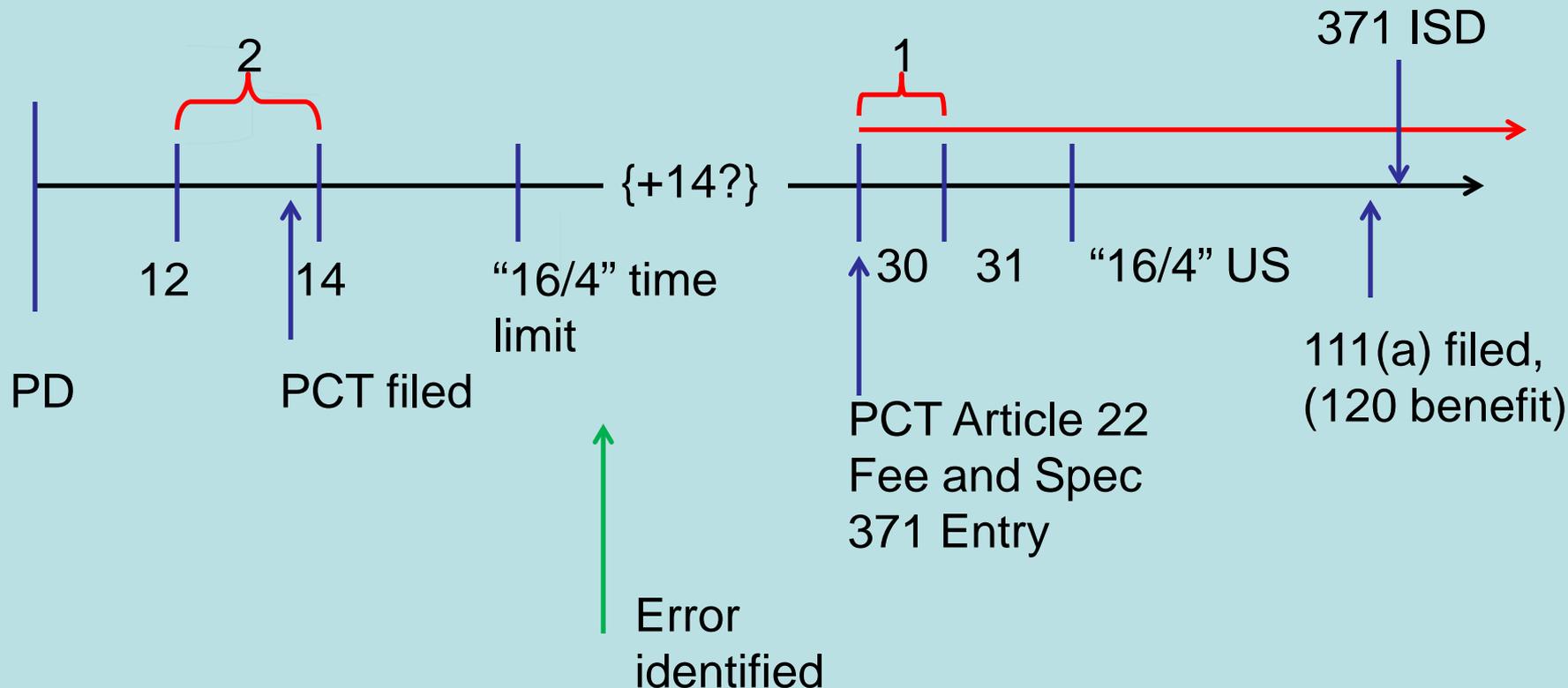
- What if the RO restoration occurred *before* PLTIA?  
(Before 12/18/2013)
- If the PCT enters the US national stage after  
12/17/2013?
- If the PCT entered the US national stage before  
12/18/2013?

# RESTORATION - PRIORITY/PCT CHAIN



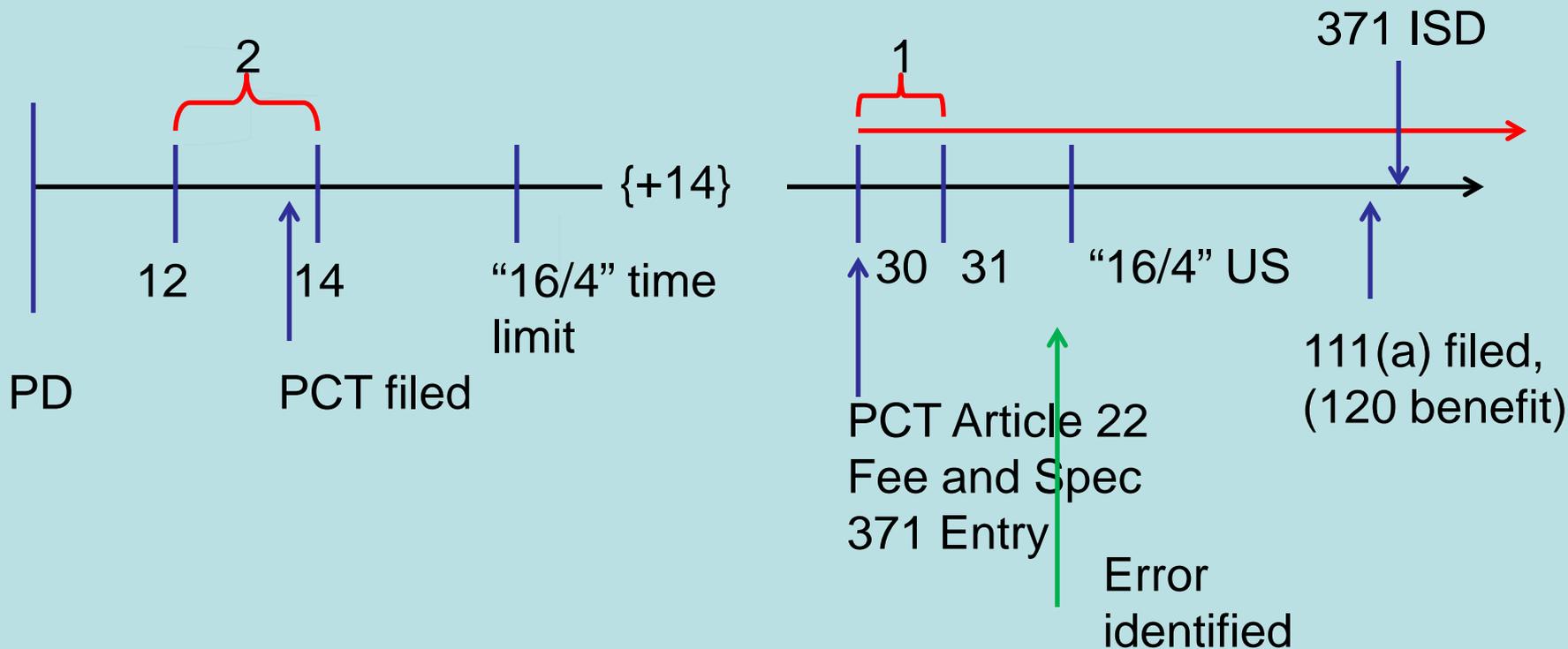
- RO: Claim to priority can be made up to "16/4" (priority/filing). 26bis.1(a).
- RO: Claim Priority, 26Bis.1(a). Certified Copy, 17.1(a).
- DO: Request Restoration before the DO, upon national entry, 49Ter
- Time limits reset; 26bis.1(c).

# RESTORATION - PRIORITY/PCT CHAIN



- RO: Too late for RO to accept priority claim. 26Bis.1(a).
  - Immediate 371 entry or 111(a) bypass so you can immediately petition for priority/benefit.
- (IB: 26bis.2(e) allows applicant to have IB publish the claim up to 30 months from PD, but that does not reset time limit, and that is not recognized in the international stage.)

# RESTORATION - PRIORITY/PCT CHAIN

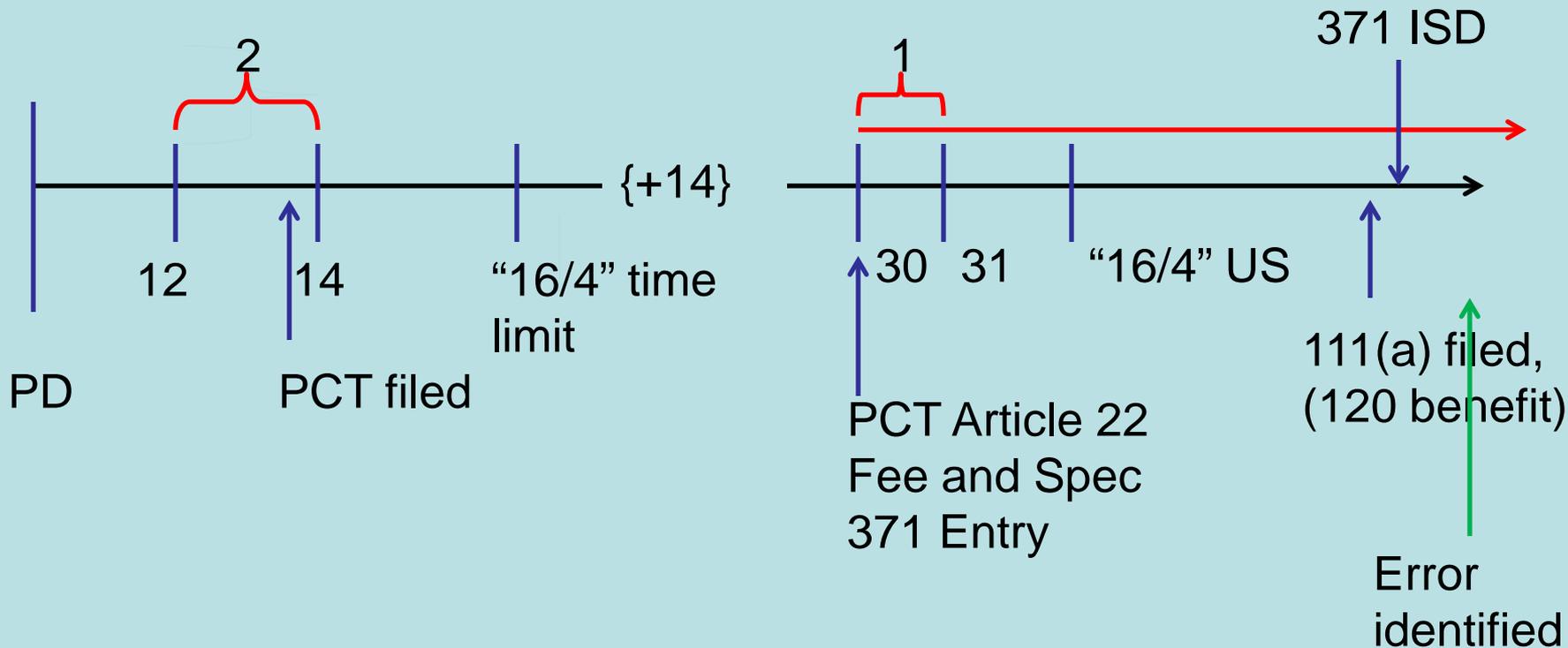


- Petition for restoration , in 371 application, 1.78(b) or 1.55(c): ADS/claim; fee; delayed filing unintentional.
- Petition for belated claim to benefit/priority, in 371 application 1.78(c)/1.55(e): ADS/claim; fee; entire delay in claiming unintentional; certified copy for foreign priority document

# Certified Copy Delays

- You do not have a certified copy
- Delay is harmful to an unintentionality
  - 1.55(h) Priority Document exchange request
  - 1.55(i) Interim Copy, followed by certified copy
  - 1.55(f)(3) Petition for good cause for delayed submission, only if 1.55(h), (i) unavailable.

# RESTORATION - PRIORITY/PCT CHAIN



Can you restore priority to the 111(a) application? **Yes.**

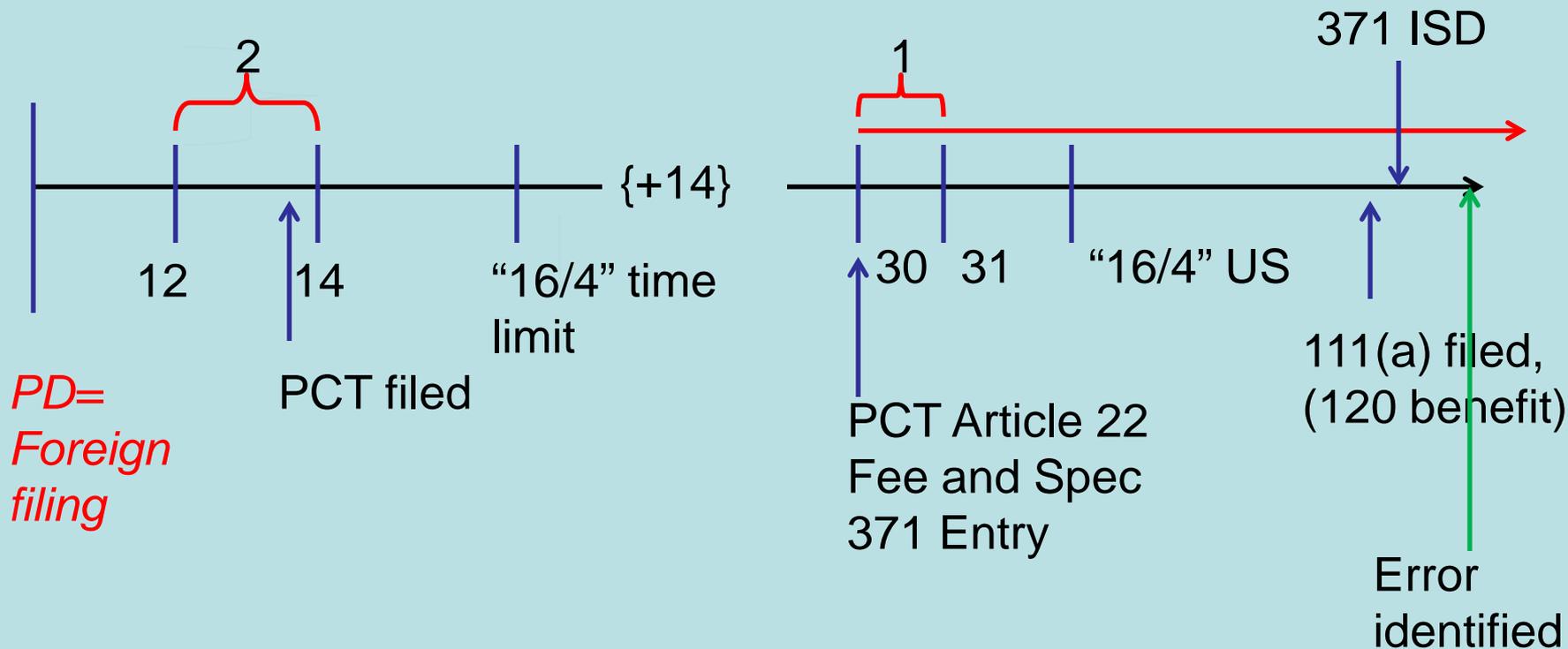
# Restoring Priority in *Priority Claim Chain* Situations

- Requirements to restore priority depend upon which type of priority
  - Foreign claim, 119(a)-(d)
  - US provisional claim, 119(e)

# Foreign Priority *Claim Chain* Situations

- Foreign claim, 119(a)-(d) apply
- PTO position is that **FP need not be claimed in intervening applications**. MPEP 201.14, third paragraph; In re Tangsrud, 184 USPQ 746 (Comm'r Pat. 1973); also Inter Partes Reexamination Control Number 95/001,921, action closing prosecution, at page 2 (USPTO 12/16/2013)
- But see Medtronic Corevalve LLC v. Edwards Lifesciences Corp., Case No. 11-CV-0961 (C.D. Cal. 11/13/2012)(foreign priority must be claimed in all intervening applications)
- USPTO only requires first US application in a chain filed within 12 months of foreign filing date

# RESTORATION - FOREIGN/PCT CHAIN



•In 111(a), petition for priority, and petition for restoration. (PTO provisional guidance.)

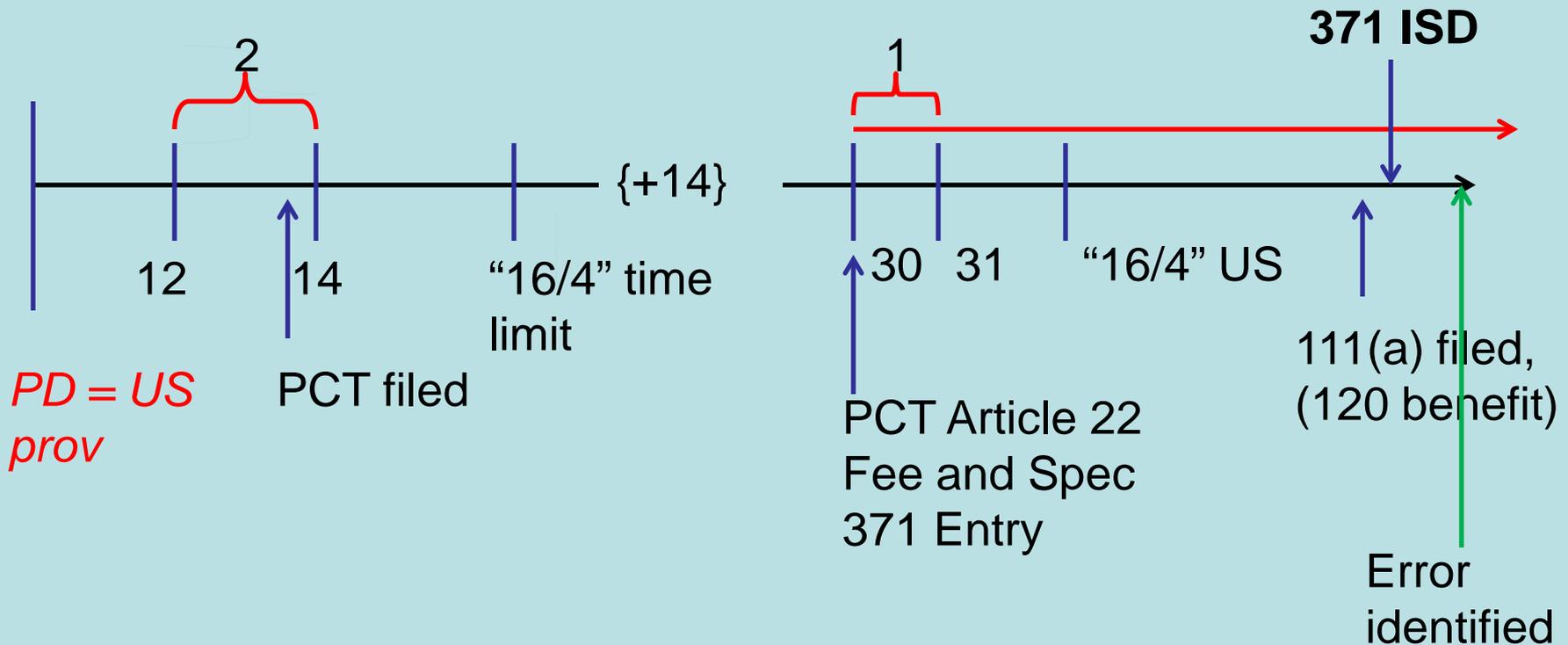
OR

•(In view of Medtronic Corevalve ), file application to reissue the 371 Patent, petition for priority in the reissue and 111(a), and petition for restoration in one or both reissue and 111(a). (PTO guidance lacking)

# Domestic Benefit *Claim Chain* Situations

- 119(e)(1) claim to a US provisional : application must “contain a specific reference to the provisional application” for benefit.
- 119(e)(1) the specific reference must be present “during the pendency of the application”
- 120 has the same “specific reference” requirement
- “each [intermediate] application in the chain of priority to refer to the prior applications” Medtronic Corevalve, LLC v. Edwards Lifesciences Corp., (Fed. Cir. 1/22/2014)(quoting Encyclopaedia Britannica, 609 F.3d at 1352).

# RESTORATION - PROV/PCT CHAIN



- File application to reissue 371 PCT patent.
- Petition for benefit claim in 371 reissue.
- Petition for benefit in 111(a).
- Petition for restoration in one or both pending applications. (PTO guidance lacking; open legal questions)

# Non PCT Claim Chains

- The claim chain analysis just presented did not depend upon the presence of a PCT in the chain.
- Where petitions are decided depends upon pedigree
  - PCT pedigree: Office of PCT Legal Administration
  - No PCT pedigree: Office of Petitions
- All petitions can be expedited, via a petition to expedite (1.182)

# MORE INFORMATION?

- [Oppedahl-lists.com](http://Oppedahl-lists.com)
- [\*\*Rick Neifeld's Case Law book\*\*](#)
- [Restoration of Priority Paper, Rick Neifeld](#)

# THANK YOU! QUESTIONS?

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