

The USPTO Deems Changes to 35 USC 119(e)(3) Made in the PLTIA Automatic and Retroactive

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The Patent Law Treaty Implementation Act (PLTIA)² changed 35 USC 119(e)(3), as explained in section IV, in my prior article "Restoration of Priority."³

There is now a USPTO decision on 35 USC 119(e)(3), as amended by the PLTIA. The decision is from a "petition under 37 CFR 1.78(b), ... to regain benefit of the provisional application under 35 USC 119(e)," in application 11/792,391. In the decision, the USPTO concluded that the change to 119(e)(3) is retroactively and automatically effective.

The decision on the petition dismisses the petition, as moot. The USPTO's decision that the petition is moot is based upon the USPTO's conclusion that "[t]he change to 35 USC 119(e) is retroactive and thus would permit a proper priority [sic; benefit] claim to [the] provisional application without the need for the present petition." The decision also notes that "[t]he \$850 petition fee filed with the instant petition will be refunded to petitioner's credit card in due course."

Accordingly, PCT US national stage applications and patents fitting the peculiar fact pattern of:

- being filed after a day on which the USPTO was not officially closed;
 - which day was one year, or more than one year, after the date of filing of a US provisional application; and
 - which PCT application claimed priority (under PCT Article 8 and PCT rule 4.10) to the US provisional application;
- will now automatically and retroactively be entitled to US domestic benefit under 35 USC 119(e)(3) to the filing date of the US provisional application.

So long as the formal requirement of a proper claim to benefit to the provisional application exists in such a PCT US national stage application or patent, the USPTO's decision confirms that entitlement to domestic benefit to the provisional application is automatic and retroactive. However, if the claim to benefit was not recognized by the USPTO in the official filing receipt or issued patent, I advise requesting the USPTO to provide an updated official filing receipt or a certificate of correction, in order to make entitlement to benefit clear on the record.

1. I can be reached via the contact information on our firm's web site:

<http://www.neifeld.com/cv.html>.

2. The PLTIA is Public Law 112-211 (2012), 126 STAT. 1527. PLTIA Title II reads "Patent Law Treaty Implementation of 2012." Title II of the PLTIA implements in US national law aspects of the Patent Law Treaty (PLT) that were not already present in US national law.

3. A copy of my prior article "Restoration of Priority" is available from:
<http://www.neifeld.com/advidx.html>.