

REPORT

限定要求/選択要求に対する2ヶ月の新規応答期間

2014年1月23日

2013年12月13日、米国特許商標庁(USPTO)は、特許関連全職員に対して本スペシャルレポートに添付の覚書を発行しました。この覚書には、特許法条約(PLT)と2012年特許法条約実施法(PLTIA)に基づく米国特許法と業務における著しい変更についての要約が記載されています。2013年11月7日付けスペシャルレポート「特許法条約を実施するUSPTOによる最終規則の発行」には、この覚書中の多数の変更について詳細に記載されています。しかし、この覚書には、多数のオフィスアクションとその他の特許庁からの通知に対して、少なくとも2ヶ月の応答期間が与えられる必要があるとも記載されています。当事務所では、この覚書中にある表を下記のように再作成してみました。また、この表には、この変更により影響が及ぶオフィスアクションと通知が記載されています。

特に、限定要求/選択要求に対して2ヶ月の応答期間が適用されます。従って、審査官は、2013年12月18日以降に郵送された限定要求/選択要求に対して、通知郵送日から2ヶ月の応答期間が適用されることを示すはずで

す。現在でも、最大応答期間は、6ヶ月です。従って、嘆願書提出と延長手数料納付の上、2ヶ月の応答期間に、更に4ヶ月の期間延長を行うこともできます。

提案

審査官による正確な2ヶ月の応答期間の設定を確実にするため、2013年12月18日以降に発行された全ての限定要求/選択要求を注意深く見直すことをお勧めします。場合によっては、従来どおり、USPTOの審査官によっては、2013年12月18日以降に発行された限定要求/選択要求について、1ヶ月の応答期間を誤って設定するかもしれません。このような場合、延長手数料納付を避けるため、限定要求/選択要求への応答を、1ヶ月以内に提出する必要があります。

しかし、審査官が、(例えば、面接概要書面等で)正確な2ヶ月の応答期間を示す正式な記録を残している場合、審査官の間違いを訂正することは可能です。この点につきまして、審査官が誤って1ヶ月の応答期間を設定した場合、当事務所から審査官に連絡を入れます。

2014年1月23日

PLT time period impact on current one month response times	
Action Type Currently with one month response	Response Time period after PLT goes into effect 12/18/13
Mail Restriction Requirement (Restriction/Election only without rejections)	Increased to 2 Months
Mail Notice of Informal or Non-Responsive Amendment	Increased to 2 Months
Mail Notice of Informal or Non-Responsive RCE Amendment	Increased to 2 Months
Mail Notice of Required Fees Due	Increased to 2 Months
Mail Letter Requiring CRF (Unreadable, Non-Compliant, Not Submitted)	Increased to 2 Months
Mail PCT Chapter I Form 206	No Change (remains 1 Month)
413FP Mail Pre-Interview Communication	No Change (remains 1 Month)
413 FA Mail First Action Interview Office Action	No Change (remains 1 Month)
Mail First Action without Interview (Optional FAI Step)	No Change (remains 1 Month)
Mail Noncompliant FAI	No Change (remains 1 Month)
Mail Pre-interview First Office Action	No Change (remains 1 Month)

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS

MEMORANDUM

DATE: December 13, 2013

TO: All Patent Employees

FROM: Andrew Faile, Deputy Commissioner for Patent Operations *AF*
Andrew Hirshfeld, Deputy Commissioner for Patent Examination Policy *DHH*
Bruce Kisliuk, Deputy Commissioner for Patent Administration *BK*

SUBJECT: **Changes Pertaining to the Patent Law Treaty and Patent Law Treaties
Implementation Act of 2012 – Effective December 18, 2013**

The Patent Law Treaty harmonizes and streamlines formal procedures pertaining to the filing and processing of patent applications. The Patent Law Treaties Implementation Act of 2012 amends the U.S. patent laws for consistency with the requirements of the Patent Law Treaty. The Patent Law Treaty and the Patent Law Treaties Implementation Act of 2012 are referred to collectively in this memorandum as the “PLT.”

Summary: The notable changes to the U.S. patent laws and practice resulting from the PLT that pertain to patent examination involve—

(1) Procedures for filing patent applications: A nonprovisional application (other than a design) may be filed without claims and/or drawings or may be filed by a reference to a previously filed application. However, an application will **not** be placed on an examiner’s docket until the application includes a specification including at least one claim.

(2) Restoration of the right of priority to a foreign application or a provisional application. An application may now claim priority to a foreign or provisional application filed up to fourteen months earlier (eight months for designs) if the application includes a petition to restore the right of priority that has been granted by the Office of Petitions.

(3) Time for reply to Office actions and other notices: Most Office actions and other Office notices must set a time period for reply by the applicant of at least **two months**. For example, any Office action containing only a requirement for restriction or for an election of species posted for credit after December 13, 2013 must set a time period for reply by the applicant of

two months (rather than one-month or thirty days). Please see the table (below) which outlines which actions now have a minimum 2 month response period.

Detailed Provisions:

1) PLT Application Filing Procedures: The PLT changes application filing date requirements and adds a provision for filing an application “by reference” to a previously filed application. **These changes become effective December 18, 2013, and apply only to applications under 35 U.S.C. 111 filed on or after December 18, 2013.**

Changes to Filing Date Requirements: The filing date of a provisional or nonprovisional application, other than an application for a design patent, is the date on which the USPTO receives a specification, with or without claims.

No claim: An application (other than an application for a design patent) is not required to include a claim to be entitled to a filing date. If an application is filed without any claims, the Office of Patent Application Processing (OPAP) will issue a notice giving the applicant a time period within which to submit at least one claim in order to avoid abandonment.

An application will **not** be placed on an examiner’s docket unless and until the application includes at least one claim.

No drawings: An application (other than an application for a design patent) is not required to include any drawings to be entitled to a filing date. If the subject matter of the application admits of illustration by a drawing to facilitate understanding of the invention, including where a drawing is necessary for the understanding of the invention, the USPTO will continue the practice of requiring a drawing. See MPEP 608.02(item IV). As discussed in MPEP 608.02, this requirement prior to examination should continue to be extremely rare and limited to the situation in which no examination can be performed due to the lack of an illustration of the invention.

No changes to filing date requirements for design applications: The filing date of an application for a design patent is the date on which the Office receives the specification (including at least one claim), and any required drawings.

Claims and/or Drawings Submitted after the Filing Date of an Application: As is currently the case, any claim and any drawing submitted after the filing date of an application may **not** contain new matter.

Reference Filing: A nonprovisional application may be filed by a reference in the application data sheet (ADS) or PLT Model International Request Form to a previously filed application (foreign, international, provisional, or nonprovisional) indicating that the specification and any drawings of the application are replaced by the reference to the previously filed application. If an

application is filed by reference to a previously filed application, the OPAP will issue a notice giving the applicant a time period within which to submit an English language copy of the specification and drawings from the previously filed application in order to avoid abandonment. The English language copy of the specification and drawings from the previously filed application will be used as the specification and drawings of the application filed by reference.

An application will **not** be placed on an examiner's docket unless and until the application includes a specification including at least one claim.

2) Restoration of Priority Rights: The PLT provides for the restoration of the right of priority to a foreign application in an application filed after the expiration of the twelve-month period (six-month period for designs) in 35 U.S.C. 119(a) and provides for the restoration of the right to claim the benefit of a provisional application in an application filed after the expiration of the twelve-month period in 35 U.S.C. 119(e). The PLT requires that the delay in filing the application within the period must have been unintentional and that the application must have been filed within two months of the expiration of the period.

The notable change in practice is that an application may now validly claim priority to or the benefit of a foreign or provisional application filed up to fourteen months earlier (eight months for designs to validly claim foreign priority). Any application that claims priority to a foreign application or the benefit of a provisional application filed more than twelve months earlier (except as a continuing application of another nonprovisional application) must include a petition to restore the right of priority to the foreign application (37 CFR 1.55(c)) or a petition to restore the benefit of the provisional application (37 CFR 1.78(b)) that has been granted by the Office of Petitions. **These changes become effective December 18, 2013.**

3) Time for Reply to Office actions and other notices: The PLT provides for a time period of at least two months for replies to most Office actions and other notices. This change primarily impacts Office actions containing only a requirement for restriction or an election of species, Office notices treating a reply by the applicant as non-responsive or noncompliant, and Office notices requiring compliance with the sequence regulations (37 CFR 1.821 et seq.). The USPTO has certain pilot programs that are not encompassed by this requirement of the PLT (e.g., the pre-appeal brief conference program and the pre-first Office action on the merits interview program) and that will continue to set a time period of less than two months for reply. **These changes apply to any Office action mailed on or after December 18, 2013 in any application.**

Accelerated Examination: Office actions (other than a notice of allowance) will set a shortened statutory period for reply of at least two months. Extensions of time under 37 CFR 1.136(a) will be permitted, but filing a petition for extension of time will result in the application being taken out of the Accelerated Examination program.

The PLT also requires that time periods for replies to most Office actions and other notices be extendable by at least two months. The PLT provisions expand the USPTO's pre-existing

practice for granting extensions of time under 37 CFR 1.136(a), and a few forms and form paragraphs have been modified to permit extensions of time under 37 CFR 1.136(a) in additional situations.

The USPTO has modified the forms and form paragraphs in the Office Action and Correspondence Subsystem (OACS) for consistency with the PLT. The current updated version of OACS is version 3.8. For example, because a two-month period rather than a one-month period is to be set for reply to certain notices of non-compliant amendment, form PTOL-324 was revised to set a two month period rather than the previous one-month period set for such replies.

These forms and form paragraphs should now be used, and must be used in any Office action posted for credit after December 13, 2013.

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