

REPORT

**NEW TWO-MONTH SHORTENED STATUTORY PERIOD FOR REPLY
TO RESTRICTION/ELECTION OF SPECIES REQUIREMENTS****January 23, 2014**

On December 13, 2013, the USPTO issued the attached memorandum to all patent employees summarizing the notable changes to U.S. patent laws and practice resulting from the Patent Law Treaty (PLT) and the Patent Law Treaties Implementation Act of 2012 (PLTIA). Many of the changes outlined in the memorandum are discussed in detail in our November 7, 2013 Special Report entitled "USPTO Issues Final Rules Implementing the Patent Law Treaty." However, the memorandum also states that most Office Actions and other Office notices must set a time period for reply of at least two months. We have reproduced a table below that appears in the memorandum and identifies the Office Actions and notices affected by this change.

Significantly, the new two-month shortened statutory period for reply applies to Restriction/Election of Species Requirements. Thus, for any Restriction/Election of Species Requirement mailed on or after December 18, 2013, the Examiner should indicate that the shortened statutory period for reply is set to expire two months from the mailing date of the communication.

We note that the full statutory period for reply remains six months. Thus, the new two-

month shortened statutory period for reply may be extended for up to an additional four months, upon petition and payment of appropriate extension fees.

Recommendations

We recommend carefully reviewing all Restriction/Election of Species Requirements that issued on or after December 18, 2013 to ensure that the correct two-month shortened statutory period for reply has been set by the Examiner. In some cases, USPTO Examiners may inadvertently continue to set the former one-month period for reply, even for Restriction/Election of Species Requirements that issued on or after December 18, 2013. Under these circumstances, a reply to the Restriction/Election of Species Requirement must be filed within one month to avoid paying extension fees.

The Examiner's error may be corrected, however, if the Examiner places a formal communication on the record indicating the correct two month shortened statutory period for reply (e.g., in an Interview Summary). In that regard, we will attempt to contact Examiners if they erroneously set a one-month period for reply.

January 23, 2014

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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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)