

REPORT

CHANGES IN U.S. INTELLECTUAL PROPERTY LAW UNDER THE URUGUAY ROUND AGREEMENT ACT

March 1995

U.S. Intellectual Property Law is changing in significant ways as a result of the recent GATT implementing legislation.

Any patent issuing on an application (including a continuation, division or continuation-in-part application) that is filed by June 7 will receive a patent term measured by the greater of 17 years from the issue date or 20 years from the earliest parent filing date. However, any patent issuing on an application filed on or after June 8 will receive a patent term of 20 years measured from the earliest parent filing date. Therefore, it is advantageous to file patent applications before June 8 to ensure a maximum patent term.¹

Because of the June 8 deadline, many commentators are predicting an increased number of patent application filings in the immediate future. Based on this increase, it is also feared that the U.S. Patent and Trademark Office will develop an increased backlog of applications that will affect the speed (and possibly also the quality) of prosecution in the years to come. A twenty year patent term (for applications filed on or after June 8) may thus be significantly reduced as compared with the current seventeen-year patent term due to longer pendencies arising from the predicted backlog of applications. Therefore, to ensure maximum patent terms, we recommend filing applications prior to June 8 to ensure the greatest possible

¹ Representative Rohrbacher and Senator Dole recently introduced bills (HR359 and S284) in Congress to amend the GATT implementing legislation to set all patent terms at seventeen years from the date of grant, or twenty years from the earliest filing date, whichever is greater. However, many commentators believe it is unlikely these bills will be approved by Congress prior to June 8; thus, we recommend assuming that applications filed after June 7 will receive a twenty-year-from-filing patent term.

patent term (i.e., the longer of seventeen years from issue or twenty years from filing).

In particular, we recommend filing all possible presently contemplated continuing applications, continuation-in-part applications, divisional applications and new applications prior to June 8. You should also consider voluntarily filing divisional applications for applications that are likely to receive a restriction requirement.² This would avoid having to file a divisional application after June 7 that would result in a patent having a shortened twenty-year patent term measured from the parent filing date.³

Additionally, applicants may begin filing provisional applications as of June 8. Provisional applications were included in the legislation to help educational institutions

² However, if you file a voluntary divisional application, the Examiner may assert an obviousness-type double patenting rejection of the voluntary divisional application over the parent application because a restriction requirement was never issued. It might then be necessary to file a terminal disclaimer in the divisional application to obviate the double patenting rejection, thereby reducing the term of the voluntary divisional application.

³ The GATT legislation provides two important transitional provisions to lessen the impact of the change in patent terms starting June 8. The PTO's current draft rules implementing those provisions would permit an applicant to obtain entry and consideration of a "submission" (amendment, argument, Information Disclosure Statement, etc.) after final rejection, if the application has been pending for two or more years as of June 8, 1995. Additionally, for applications pending three or more years as of June 8, 1995, the rules provide that a requirement for restriction will not be made, provided such a requirement was not made before April 8, 1995. Both of these provisions require payment of substantial PTO fees.

March 1995

obtain an early filing date when faced with an unavoidably imminent publication that may bar a future patent. However, provisional applications may be used by all applicants.

For example, many U.S. and foreign companies are considering filing provisional applications. Provisional applications need not be signed by the inventor or include any claims, but must otherwise provide a specification satisfying 35 U.S.C. §112, first paragraph. Like regular applications, provisional applications may be filed in a foreign language.⁴ The government filing fee is \$150 for a provisional application (\$75 for a small entity).

Additionally, a regular application can then be filed up to one year later, claiming priority from the provisional application.

In many cases, it may be desirable to file a U.S. provisional application simultaneously with the filing of an important foreign application. Subsequently, the regular U.S. application filed within one year should claim priority from both the foreign application and the provisional application. By filing the provisional application, the grace period under §102(b) will extend one year prior to the filing date of the provisional application. Additionally, a patent issuing from an application claiming priority from a provisional

application will be considered a §102(e) reference against other applications and patents as of the provisional application filing date. However, the 20 year patent term will not be measured from the provisional application filing date, but rather will be measured from the regular application filing date. Please consider the advantages of provisional applications and consider whether they may be advantageous to you starting June 8.

* * *

Oloff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including individual entrepreneurs, major universities, and businesses ranging from small privately owned companies to large multinational corporations.

This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

For further information, please contact our office by telephone at (703) 836-6400, facsimile at (703) 836-2787, or mail at 700 South Washington Street, Alexandria, Virginia 22314.

⁴ The current draft rules do not change the requirement to file an English translation of an application filed in a foreign language.