

March 31, 2013

The Honorable James Pooley
Deputy Director General, Innovation and Technology Sector
World Intellectual Property Organization
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Via email: claus.matthes@wipo.int
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Re: WIPO Circular C. PCT 1372, concerning Proposed Modification to the PCT Receiving Office Guidelines, February 20, 2013

Dear Deputy Director General Pooley:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to comment on the Proposed Modification to the Patent Cooperation Treaty (“PCT”) Receiving Office Guidelines contained in WIPO Circular PCT 1372, dated February 20, 2013, and Annex (the “Circular”).

AIPLA is a U.S.-based national bar association whose approximately 15,000 members are primarily lawyers in private and corporate practice, government service, and the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, unfair competition, and trade secret law, as well as other fields of law affecting intellectual property, in the United States and in jurisdictions throughout the world.

The United States of America enacted enabling legislation for the Patent Law Treaty in December, 2012.¹ An important change to United States law concerns the “Restoration of the Right of Priority.” This change relates to an effective modification of what previously was an absolute deadline of one year from the filing date of a provisional application under U.S. law by which either a PCT application or a section 111 non-provisional application had to be filed under title 35 of the United States Code. As a result of the legislation, under certain circumstances, there may be a degree of flexibility if certain standards are met. 35 U.S.C. §§119(a)(2), 119(e), Publ. L. 112-211 §201(c), 126 Stat. 1534-1537.²

¹ Patent Law Treaties Implementation Act of 2012, Publ. L. 112-211, 126 Stat. 1527 (112th Cong., 2nd Sess. 2012).

² See also Section 201 of the Act (containing a 2-month possible extension period to recoup the one year for late 111(a) non-provisionals), which will become effective on December 18, 2013.

I. BACKGROUND: U.S. standards for “unavoidably abandoned” applications and “unintentionally abandoned” applications

The United States currently has two procedures in its patent regulations for applicants who, for one reason or another, have missed some type of deadline and their application has gone abandoned: a “Petition to Revive Unavoidably Abandoned Application,” and a “Petition to Revive Unintentionally Abandoned Application.”

The standard to revive an “unavoidably abandoned” application is higher than the standard for an “unintentionally abandoned” application. For recent pending applications, a Petition to Revive Unintentionally Abandoned application is usually granted upon a) payment of a fee, b) accomplishment of the action which was not timely completed (e.g., the filing of a reply to an office action), and c) submission of a statement that “[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.” Such petitions are very common, to the point that there is an automated system to handle them. See 37 CFR 1.137(b), MPEP ¶711.03(c), Form SB/64. The U.S. standard to revive an “unintentionally abandoned” application is comparable to the PCT Rule 26bis.3(a)(ii) “unintentionality” standard, which states: “the receiving Office should restore the right of priority if it finds that the failure to file the international application within the priority period was unintentional.” This standard would be further defined under proposed ¶166I of the Circular.

By contrast, in order for a Petition to Revive Unavoidably Abandoned Application to be granted, the U.S. applicant must, in addition to steps a) and b), enclose a statement demonstrating “an adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable...” 37 CFR 1.137(a); MPEP ¶711.03(c); Form SB/61. The U.S. standard to revive an “unavoidably abandoned” application is comparable to the PCT Rule 26bis.3(a)(i) “due care” standard, which states: “the receiving Office should restore the right of priority if it finds that the failure to file the international application within the priority period occurred in spite of ‘due care’ required by the circumstances having been taken.” This standard would be further defined under proposed ¶166J of the Circular.

II. COMMENTS AND RECOMMENDATIONS

General Comment

The PCT system is focused on providing a procedurally convenient mechanism for applicants to obtain protection outside of their particular national jurisdiction, and generally does not prescribe substantive standards. Nevertheless, because applicants can elect to proceed in the International Bureau (IB), there must often be some agreed-upon substantive standard for the IB to apply. Because the proposed revisions to the Guidelines go beyond mere procedures and verge on substantive law-making concerning the applicable standards, AIPLA requests that specific language be inserted to the effect that the proposed changes to the Guidelines are intended to

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specifically apply to the International Bureau, but they may also be adopted in whole or in part by member States. This could be accomplished by a general statement to the following effect:

“Each receiving Office may apply its own substantive standards for unintentionality and due care. The standards set out in the Guidelines and accompanying examples are *not* intended to mandate changes to established national practices or standards in Receiving Offices.”

Such a statement would be consistent with the procedural nature of the PCT. Of course, national offices may voluntarily choose to modify their standards to correspond to those of the Guidelines.

Paragraph 166E([e])

The subparagraph after subparagraph 166D(d) of the Circular (which should probably be numbered as 166E(e)) addresses time limits for complying with requirements. AIPLA suggests adding the following words or equivalent at the end of the first proposed sentence of that subparagraph: “or a reasonable time limit, whichever is longer.” The full amended sentence would read as follows:

“If any of the above requirements are not complied with, and the applicable time limit has not yet expired, the receiving Office shall promptly invite the applicant (Form PCT/RO/132) to comply with such requirement(s) within the applicable time limit or a reasonable time limit, whichever is longer.”

The “or a reasonable time limit, whichever is longer” language will cover situations in which the receiving Office is not timely with its invitation, and for that reason the applicable time limit would expire without leaving sufficient time for the applicant to respond.

Paragraph 166F

Paragraph 166F gives the impression that there must be a great deal of explanation to meet the “unintentionality” criterion. This would be inconsistent with U.S. practice on unintentional abandonment. AIPLA recommends that the procedure where the unintentionality standard is applicable should be relatively simple, as in the first sentence of Paragraph 166G as suggested below, and in fact would not normally require any explanation beyond the statement that the delay is unintentional. This recommendation fits with maintaining the straightforward language of Paragraph 166G as proposed. It is consistent with present U.S. practice and is familiar to applicants from the United States, as well as the many users from other States who are familiar with U.S. practice in the context of their U.S. national stage entry applications.

On the other hand, it is appropriate to require a more detailed explanation as to why the “due care” criterion has been met.

Paragraphs 166G and 166I

Proposed Paragraph 166G of the Circular states: “For the unintentionality criterion, a statement indicating that the failure to comply with the priority period was not *on purpose* should generally be sufficient.” [Emphasis added.] Most of the other references to the unintentionality standard use “unintentional” throughout the proposed Guidelines; see, for example, the first sentence of proposed paragraph 166I.

AIPLA recommends that Paragraph 166G retain the present wording of “not intentional,” so that the sentence would read: “For the ‘unintentionality’ criterion, a statement indicating that the failure to comply with the priority period was not intentional should generally be sufficient.”

Paragraphs 166H, 166I, and 166N

In contrast to Paragraph 166G, the standard of unintentionality set forth in Paragraph 166H seems to create an unintended overlap between the unintentionality standard and the due care standard. With respect to Paragraph 166H, it is not clear when it would be appropriate to apply both standards, or why the second sentence referencing both criteria is needed. AIPLA suggests that the second sentence of Paragraph 166H be deleted.

With respect to the language of Paragraph 166N, applicants are primarily interested in whether or not the right of priority was restored, and it is not clear why the articulation of one standard versus the other will be illuminating. A statement that “The grounds for grant or denial of (partial) restoration shall be given” would simply and directly cover the point in lieu of the last sentence of Paragraph 166N.

Because Paragraph 166I seems to go beyond the mere short statement required by section 166G, AIPLA recommends that Paragraph 166I be eliminated. Paragraph 166I potentially expands the standard for “unintentionality” by articulating a broader statement that could be required by the receiving Office, and suggesting that the receiving Office focus on the applicant’s intent. Elimination of Paragraph 166I would be consistent with our proposed language in relation to Paragraph 166G. It would also be consistent with present U.S. practice and would be familiar to the many users from other States who are familiar with U.S. practice in the context of their U.S. national stage entry applications.

Further, the requirement that “due care” be considered before considering “unintentional,” when both standards apply, undermines the very reason for having a simpler alternative and a more complex alternative. In the US, the “unintentional” petition is simple and quick, but more expensive. If that route is chosen by the applicant, it is not necessary to go through the more burdensome procedures for proving “unavoidable.” If the conditions for filing a petition on the basis of “unintentional” do not pertain (e.g., if the additional cost cannot be borne), then the applicant can decide to petition on the more stringent basis of “unavoidable,” and at that time submit the more burdensome supporting information.

Paragraph 166J

AIPLA recommends that Paragraph 166J relating to the “due care” standard be retained, along with the preamble and examples of paragraph 166M, subject to the comments below.

Paragraph 166K and 166L

Paragraph 166K and 166L appear to make a distinction between corporate applicants and agents on the one hand, and “small applicants or agents, such as an individual inventor or a small and medium enterprise” on the other hand. In general, AIPLA believes that all persons should be treated equally under the rule of law, regardless of the corporate form they have selected and regardless of their size. In a sense, the restoration of the right of priority is intended to provide some flexibility to help overcome the maxim of “everybody makes mistakes.” Part of what is foreseen is that certain applicants will, for whatever reason, simply not understand the process to meet the priority period, will miss the deadline, and then will retain an agent who will attempt to rectify the situation. Due care is inevitably a facts and circumstances test, as Paragraph 166J reflects in its present language.

While it may be less credible that a large corporation made a particular error, for the application of the due care standard, AIPLA recommends that Paragraphs 166K and 166L not be added, and that the proposed language of Paragraph 166J be utilized with the examples in paragraph 166M, as modified in our comments below.

Paragraph 166M

There are many solo practitioners who have no office staff and do not have “backup” as that term seems to be referenced. Further, large entities using small practitioners may make errors and small entities using large practitioners may make errors. The intent is to be applicant-neutral, consistent with the spirit of the PCT, and ascertain whether the facts and circumstances support the heightened standard of due care, thereby justifying restoration of the right of priority.

Comments on the specific examples follow.

Paragraphs 166M(b) and 166M(e) both deal with varieties of human errors. These examples could be grouped into one subparagraph.

With respect to example 166M(h), AIPLA recommends that only the first sentence and the last sentence be retained. Setting a proposed limit of five days would be unlikely to advance the application of the standard.

Example 166M(g) allows for express mail to arrive after the deadline and to constitute due care in certain circumstances, which is inconsistent with 166M(h) in some circumstances. Where unintentional delay is the criterion, the act of sending the “express mail” would show that there was not intentional delay.

As more and more receiving Offices move to electronic filing, it would be useful to clarify that, in the event the electronic system of a particular receiving Office was

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inoperable, a filing on the day following the business day that the system becomes operable should be deemed timely. Rule 80.5 does appear to address closures of a receiving Office, but it does not address “electronic closure” or electronic inaccessibility. If this is already contemplated in the Regulations or Treaty, a cross-reference would be useful in these Guidelines.

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AIPLA appreciates the opportunity to provide comments on this Proposal. AIPLA looks forward to further dialogue with WIPO and the PCT Member States in finding solutions and defining programs to maintain and enhance the PCT, and the global patent system.

Sincerely,

A handwritten signature in black ink, appearing to read "Jeffrey I.D. Lewis". The signature is written in a cursive, flowing style.

Jeffrey I.D. Lewis

President

American Intellectual Property Law Association