

O.G. NOTICE
INTERIM PROCEDURES FOR IMPLEMENTING THE APRIL 1, 2007, CHANGES TO THE
REGULATIONS UNDER THE PATENT COOPERATION TREATY
AND STATUS OF PROPOSED FEE CHANGES

On February 16, 2007, the United States Patent and Trademark Office (USPTO) published a notice of proposed rule making in the Federal Register (See April 2007 Revision of Patent Cooperation Treaty Procedures, 72 Fed. Reg. 7583) proposing to amend the rules of practice in title 37 of the Code of Federal Regulations (CFR) to conform them to certain amendments made to the Regulations under the Patent Cooperation Treaty (PCT) that will take effect on April 1, 2007. The amendments to the PCT Regulations will: (1) result in the addition of a mechanism to the PCT system whereby applicants may request that the right to claim priority be restored in applications that meet certain requirements; (2) provide a means for applicants to insert a missing portion of an international application without the loss of the international filing date; and (3) clarify the circumstances and procedures under which the correction of an obvious mistake may be made in an international application. In that the proposed changes to the U.S. rules of practice will not become effective until after the effective date of the changes to the PCT Regulations, the USPTO is hereby giving notice of the interim procedures that it will follow until such time as the proposed changes to title 37 of the Code of Federal Regulations become final. This notice also serves to clarify the status of the proposed changes to the search and supplemental search fees.

With respect to the PCT Rule changes which are directed to providing a means for applicants to insert a missing portion of an international application without the loss of the international filing date and clarifying the circumstances and procedures under which the correction of an obvious mistake may be made in an international application, the USPTO will implement these changes under the general authority granted under 35 U.S.C. 364(a), which provides that “[i]nternational applications shall be processed by the Patent and Trademark Office when acting as a Receiving Office, International Searching Authority, or International Preliminary Examining Authority, in accordance with the applicable provisions of the treaty, the Regulations, and this title.” The specific provisions relating to the later submission of drawings currently present in 37 CFR 1.437(a) and (b) are hereby waived, *sua sponte*, pursuant to 37 CFR 1.183 in favor of the more applicant friendly provisions of amended PCT Rule 20.

The USPTO will treat requests for the restoration of the right of priority under the provisions of 37 CFR 1.182, until the rule making process is completed. Grantable requests for restoration of the right of priority must be filed within two months from the date of expiration of the priority period as defined by new PCT Rule 2.4, and must be accompanied by: (i) the requisite fee for a petition under 37 CFR 1.182 as set forth in 37 CFR 1.17(f) (currently \$400); (ii) a notice under PCT Rule 26bis.1(a) adding the priority claim, if the priority claim in respect of the earlier application is not contained in the international application; and (iii) in accordance with the USPTO’s notification to the World Intellectual Property Organization that it only intends to decide these matters under the unintentional standard provided in new PCT Rule 26bis.3(a)(ii), a statement that the delay in filing the international application within the priority period was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. If the applicant makes a request for early publication under PCT Article 21(2)(b), any of requirements (i), (ii), or (iii) above which are filed after the technical preparations for international publication have been completed by the

International Bureau shall be considered as not having been submitted in time. Restoration of a right of priority to a prior application by the United States Receiving Office under this section, or by any other Receiving Office under the provisions of PCT Rule 26bis.3, will not entitle applicants to a right of priority to such prior application in any application which enters the national stage under 35 U.S.C. 371, or in any application filed under 35 U.S.C. 111(a) which claims benefit under 35 U.S.C. 120 and 365(c) to an international application in which the right to priority has been restored.

Finally, regarding the proposed changes to the search fee and supplemental search fee set forth in 37 CFR 1.445(a)(2) and (3), the fees currently in effect will remain until such time as a final rule is issued and becomes effective. Specifically, until a final rule becomes effective the international search fee will continue to be \$300.00 where there is a prior U.S. national application under 35 U.S.C. 111(a) which meets the requirements set forth in 37 CFR 1.445(a)(2)(i) or (ii) and \$1000.00 in all other situations, and the supplemental search fee will continue to be \$1000.00 per invention.

Questions regarding this notice may be directed to Richard R. Cole, Senior Legal Examiner, Office of PCT Legal Administration (OPCTLA) directly by telephone at (571) 272-3281, or by facsimile at (571) 273-0459.

March 30, 2007

Date

Charles Pearson for

JOHN LOVE

Deputy Commissioner for
Patent Examination Policy