

STROOCK

SPECIAL BULLETIN

Update: Patent Office Publishes Final Rules for Patent Law Treaties Implementation Act – Effective December 18, 2013

November 11, 2013

On October 21, 2013, the Patent Office published final rules to implement the Patent Law Treaties Implementation Act of 2012 (“PLT Act”),¹ which was enacted as Public Law 112-211 on December 18, 2012.² The effective date of the PLT Act is **December 18, 2013** and it applies to all design applications filed on or after December 18, 2013. The final rules are substantially the same as the previously proposed rules that were reported in a previous *Stroock Special Bulletin*.³

The PLT Act implements two international patent treaties: the Hague Agreement Concerning International Registration of Industrial Designs (the “Hague Design Treaty”) and the Patent Law Treaty.

The PLT Act better aligns United States law with that of the international patent community and, according to the Congressional Research Service’s summary of the law, “[s]tandardizes application procedures to be consistent with other member countries.” As such, the changes should benefit

patent applicants and owners by providing a more uniform system to apply for and maintain patents.

Hague Design Treaty Implementation

The first part of the PLT Act implements the Hague Design Treaty by adding new Chapter 38 to Title 35 of the United States Code. Chapter 38 establishes a procedure for filing international design patent applications, allowing an applicant to file a single design application in the United States and request registration in other treaty countries. The process is similar to the procedure for filing international utility applications under the Patent Cooperation Treaty (PCT).

More specifically, the PLT Act:

1. Establishes a procedure for filing a single “international design application” with the United States Patent Office, instead of separate applications in multiple countries;

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| <ol style="list-style-type: none"> 2. Allows applicants to designate “Contracting Parties,” which are other treaty countries in which the applicant desires to have an international design registration; 3. Authorizes applicants to claim priority to or from an international design application; 4. Provides that the international design application will be examined under existing design patent laws in Chapter 16, unless otherwise required by the Hague Design Treaty or its regulations; 5. Extends the term of all design patents to 15 years; and 6. Expands the availability of provisional rights – the limited ability to obtain reasonable royalties for infringement occurring before patent issuance – to include an international design application. | <p>claims priority to another application by an additional two months if the delay in filing the non-provisional application within the 12-month period was unintentional;</p> <ol style="list-style-type: none"> 2. Non-provisional and provisional applications need not include a claim or fee to obtain a filing date, but failure to timely submit a claim or pay the required fee will result in abandonment of the application; 3. Applicants may revive patents for delayed payment of the maintenance fee using the unintentional standard of revival. In addition, the 24-month time limit for revival of an application using the unintentional standard or the unavoidable standard has been eliminated. 4. Applicants may generally use the unintentional standard of revival for abandoned applications and/or delayed responses. The unavoidable standard has been eliminated in this context as well. |
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These provisions all take effect on December 18, 2013, and generally apply to applications filed on or after December 18, 2013, as well as any design patents issuing therefrom.

Patent Law Treaty Implementation

The second part of the PLT Act implements the Patent Law Treaty by making various amendments throughout Title 35 of the United States Code. These changes affect a variety of aspects of obtaining and maintaining patents, including filing of applications, payment of fees and surcharges, and recording changes to ownership.

More specifically, the Patent Law Treaty implementation provides that:

1. Applicants may extend the 12-month period for filing a non-provisional application that

These provisions take effect on December 18, 2013 and apply to all patents and applications, except they do not apply to patents in litigation commenced before the effective date, and certain changes will only apply to applications filed on or after the effective date.

A copy of the PLT Act as implemented can be found [here](#), and a copy of the final Patent Office rules can be found [here](#).

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For More Information

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1. Changes To Implement the Patent Law Treaty; Final Rule, 78 Fed. Reg. 62368 (October 21, 2013).
2. Patent Law Treaties Implementation Act of 2012, Public Law 112-211, 126 Stat. 1527 (2012).
3. “Patent Office Publishes Proposed Rules Under the Patent Law Treaties Implementation Act of 2012,” *Stroock Special Bulletin*, April 16, 2013, available at <http://www.stroock.com/SiteFiles/Pub1328.pdf>.

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