

Impact of the Patent Law Treaties Implementation Act of 2012

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PRACTICES Intellectual Property

The Patent Law Treaties Implementation Act of 2012 (PLT Act) was enacted on December 18, 2012 as Public Law 112-211. The PLT Act implements two international patent treaties that Congress approved in 2007, but then never finalized until late last month: the [Hague Agreement Concerning International Registration of Industrial Designs](#) (the Hague Design Treaty) and the [Patent Law Treaty](#).

Like most patent legislation over the past dozen years, 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;
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.

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 claims the benefit of a foreign-filed application by an additional 2 months if the delay in filing the non-provisional application within the 12-month period was unintentional;
2. Applicants may extend the 12-month period for filing a non-provisional or PCT application that claims the benefit of a provisional application by an additional 2 months if the delay in filing the non-provisional or PCT application within the 12-month period was unintentional;
3. Non-provisional applications need not include claims, a fee, or an oath to obtain a filing date, but failure to submit one or more claims, pay the required fee, or submit an oath will result in abandonment of the application; and
4. Provisional applications need not include a fee to obtain a filing date, but failure to pay the required fee will result in abandonment of the application.

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](#).