

INSIGHTS

## No Claims, No Drawings, No Problems

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As part of efforts to unify international procedural rules for patent applicants, the United States Patent and Trademark Office (USPTO) recently released new rules that have important procedural consequences generally deemed to be quite favorable for patent applicants and owners. The new rules go into effect on December 18, 2013, and affect several significant aspects of obtaining patent protection, particularly in reducing the requirements to receive an application filing date—a critical date in the patent prosecution process—and the requirements to revive an abandoned application. This is good news for patent applicants when filing in the United States.

Although the USPTO made several minor rule revisions,<sup>1</sup> the rules' major changes affect:

- the requirements to receive a filing date,
- the revival of abandoned applications,
- the acceptance of late maintenance fees,
- the availability to restore the right of priority to a provisional or foreign application filed more than one year later than the provisional or foreign application, and
- the reduction of patent term adjustments in some circumstances that could arise under the PLT provisions.

For a comparison of these notable rule revisions between the old and new rules, click [here](#).

### Major Rule Changes

The first major rule change includes a new and less burdensome set of requirements to receive a filing date. An application's filing date has significant impact on whether the application can eventually issue as a patent and, if it does issue, on the life span of the patent. Currently, a non-provisional utility application must have a description, a drawing if a drawing is necessary to understand the invention, and at least one claim to receive a filing date.<sup>2</sup> The new rules, however, drastically change the requirements: only a description is required.<sup>3</sup> The USPTO will now treat a non-provisional utility application submitted without any claims similarly to how it treats applications submitted without an oath or declaration.<sup>4</sup> That is, the USPTO will accept the claims, but it may levy a surcharge for the late filing.

The USPTO emphasized in its release of the new rules that merely satisfying this new standard to receive a filing date does **not** necessarily satisfy other statutory requirements to receive a patent, such as the written description and enablement requirements of Section 112.<sup>5</sup> An

application entitled to receive a filing date may nevertheless be doomed if it fails to satisfy other statutory requirements. An application may satisfy the filing date requirements yet fall short of the requirements to function as a priority document for a later application. Consequently, patent applicants likely should not submit applications without claims and any necessary drawings as a matter of course. In fact, the USPTO has recommended that applicants consider the new rules merely to reduce risks associated with inadvertent omissions in an application.<sup>6</sup> Still, the filing date requirements change is significant and should be beneficial to patent applicants.

### **More Changes-Unintentional Delay**

Two other significant changes are being implemented by the new rules: elimination of the concept of "unavoidable" delay previously used for abandoned applications, maintenance fees, and responses in reexamination proceedings and implementation of "unintentional" delay when claiming priority to either provisional applications or applications filed first in other countries. Currently, the USPTO allows the revival of abandoned applications, late payment of maintenance fees, and late filing of responses in reexamination proceedings in some circumstances upon a showing of "unavoidable" delay, and under different circumstances when "unintentional" delay can be shown.<sup>7</sup> The new rules implement a single standard: unintentional delay.<sup>8</sup> In addition, the existing rules require the filing of a non-provisional utility application within one year—six months for a design application—of filing a provisional or foreign application.<sup>9</sup> The new rules, however, permit an applicant who has missed that deadline to file within two months of the deadline upon a showing of unintentional delay,<sup>10</sup> yet another benefit to patent applicants.

The new rules also address patent term adjustment in that some of the new provisions give applicants an opportunity to stretch out the application process. For example, an applicant could initially file an application without any claims and then later claim entitlement to a patent term adjustment. The USPTO has consequently implemented a rule that it will reduce any patent term adjustment that it would otherwise grant for an application that is not in condition for examination within eight months of the filing date or the commencement of the national stage of the application.<sup>11</sup> This underscores the reasons to continue filing applications with claims and any drawings necessary to examine the application, or at least relatively soon after the initial filing date.

### **Consequences of New Rules**

As a result of unifying international procedural rules for patent applicants, the USPTO has made it much easier for patent applicants to obtain earlier filing priority dates, including even dropping current requirements for claims and drawings. With the recent implementation of the Leahy-Smith America Invents Act's first-to-file provisions that went into effect on March 16, 2013, these new rules further streamline the patent application filing process in the U.S. making it much easier to obtain a patent application priority filing date and to keep a patent application active.

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<sup>1</sup> For example, the new rules implement some changes to add references to the supplemental examination procedure. Id. at 62,396 (available [here](#)) (correspondence in a supplemental examination treated similarly to correspondence in a reexamination); see id. at 62,374 (available [here](#)) (describing changes).

<sup>2</sup> See 35 U.S.C. § 111(a) (available [here](#)); 37 C.F.R. § 1.51(b).

<sup>3</sup> Act effective Dec. 18, 2013, Pub. L. No. 112-211, §§ 201(a), 203, 126 Stat. 1533, 1536 (available [here](#)); 78 Fed. Reg. 62,398 (available [here](#)). Notably, the new rules do not change the requirements to receive a filing date for design applications, however.

<sup>4</sup> 78 Fed. Reg. 62,398 (available [here](#)).

<sup>5</sup> Id. at 62,369 (available [here](#)).

<sup>6</sup> Id.

<sup>7</sup> 37 C.F.R. § 1.137.

<sup>8</sup> 78 Fed. Reg. 62,405 (available [here](#)).

<sup>9</sup> 35 U.S.C. §§ 119, 172.

<sup>10</sup> 78 Fed. Reg. 62,399, 62,402 (available [here](#) and [here](#)).

<sup>11</sup> Id. at 62,408 (available [here](#)).