

Patent Harmonization Expert Panel (PHEP)

New Topics

Industry IP5 Update

*IP5 Heads of Office with IP5 Industry Meeting
June 12, 2019*

AIPLA

Serving the

Creative and **Legal** Communities

- ◆ **Goal: Advance deregulation to streamline prosecution, reduce costs to applicants and increase certainty.**
- ◆ **Selection Factors:**
 - Procedural or administrative in nature, rather than requiring change in law
 - Large impact on patent applicant
 - Relatively small impact on the public
 - Quick wins and long - term improvements

- ◆ A patent application in a language other than English was filed as a PCT international stage application in a country other than the US. It was subsequently translated into English and entered the US national phase. During US examination, it was found that the translation into English was poor.
- ◆ Remedy-Correcting the poor English translation is considered rephrasing or correcting an obvious error (see MPEP 2163.07).
 - The US application specification can be amended until the patent issues by filing an amendment.
 - If the patent has already issued, then the specification may be amended by filing a reissue application to correct the issued patent.

- ◆ Applicant for a US patent unintentionally does not claim foreign priority on time.
- ◆ 37 CFR 1.55(d)(in part) *Time for filing priority claim*—
 - (1) *Application under 35 U.S.C. 111(a)*. The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a), except as provided in paragraph (e) of this section.
- ◆ Remedy
 - ◆ Claims for foreign priority not presented within the time period specified in 37 CFR 1.55 are considered to have been waived.
 - ◆ If a claim for priority under 35 U.S.C. 119(a) - (d) or (f), 365(a) or (b), or 386(a) or (b) is presented after the time period set in 37 CFR 1.55, the priority claim may be accepted if it includes the required identification information and is accompanied by a grantable petition to accept the unintentionally delayed claim for priority.
 - ◆ See MPEP § 214.02 for the treatment of unintentionally delayed priority claims.

Thank You