



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 5

[Docket No. PTO-P-2019-0033]

RIN 0651-AD43

Facilitating the Use of WIPO's ePCT System to Prepare International Applications for Filing with the United States Receiving Office

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) is proposing to amend the foreign filing license rules to facilitate use of ePCT (a World Intellectual Property Organization (WIPO) online web-based service) to prepare an international application for filing with the USPTO in its capacity as a Receiving Office under the Patent Cooperation Treaty (PCT). ePCT offers many benefits to users, including real time up-to-date validation features to help users properly complete the PCT Request. ePCT resides on WIPO's servers abroad and is accessed via an internet browser on the user's system. While the current foreign filing license rules would authorize the export of technical data to ePCT for purposes of preparing an international application for

filing in a foreign PCT Receiving Office, the current rules do not authorize the export of technical data to ePCT for purposes of preparing an international application for filing with the USPTO as a Receiving Office. The USPTO is thus proposing to amend the foreign filing license rules to provide that a foreign filing license from the USPTO would authorize the export of technical data abroad for purposes relating to the use of ePCT to prepare an international application for filing with the USPTO in its capacity as a Receiving Office under the PCT.

DATES: Written comments must be received on or before [INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE *FEDERAL REGISTER*].

ADDRESSES: Comments should be sent by e-mail addressed to:

AD43.comments@uspto.gov. Comments also may be submitted by postal mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of Boris Milef, Senior Legal Examiner, International Patent Legal Administration.

Comments further may be sent via the Federal eRulemaking Portal. Visit the Federal eRulemaking Portal website (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the USPTO prefers to receive comments by e-mail. E-mailed comments are preferred to be submitted in plain text, but also may be submitted in Adobe® portable document format or Microsoft Word®

format. Comments not submitted by e-mail or via the Federal eRulemaking Portal should be submitted on paper in a format that facilitates convenient digital scanning into Adobe® portable document format.

The comments will be available for viewing via the USPTO's website (<https://www.uspto.gov/patent/laws-and-regulations/comments-public-response-specific-requests-uspto>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Michael Neas, Deputy Director, International Patent Legal Administration, at (571) 272- 3289, or Boris Milef, Senior Legal Examiner, International Patent Legal Administration, at (571) 272-3288.

SUPPLEMENTARY INFORMATION:

Executive Summary: *Purpose:* The rules of practice in 37 CFR Part 5 are proposed to be amended to expand the scope of a foreign filing license from the USPTO to allow U.S. applicants to use WIPO's ePCT web-based service to help prepare their international applications for filing with the USPTO acting as a PCT Receiving Office.

Summary of Major Provisions: Under current 37 CFR 5.11(b), a foreign filing license from the Commissioner for Patents authorizes the export of technical data abroad for purposes relating to the preparation, filing or possible filing and prosecution of a foreign application, including an international application for filing in a PCT Receiving Office

other than the USPTO acting as a Receiving Office. *See* 37 CFR 5.1(b)(2). 37 CFR 5.11 does not authorize the export of technical data abroad for purposes relating to the preparation of an international application for filing with the USPTO acting as a Receiving Office. WIPO's ePCT web-based service, residing on servers abroad, offers many benefits to U.S. applicants seeking to prepare and file an international application with the USPTO as a Receiving Office, including real time up-to-date validation features to help applicants properly complete the PCT Request. The provisions of 37 CFR 5.11(b) are proposed to be amended to provide that a foreign filing license from the Commissioner for Patents would authorize the export of technical data abroad for purposes relating to the use of WIPO's online service for preparing an international application for filing with the USPTO as a Receiving Office.

Costs and Benefits: This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

Background: On June 1, 2016, the United States Receiving Office (RO/US) began accepting international applications filed electronically with zip files created by the World Intellectual Property Organization's (WIPO) online service, ePCT. *See Use of WIPO's ePCT System for Preparing the PCT Request for Filing as Part of an International Application with the USPTO as Receiving Office*, 81 FR 27417 (May 6, 2016). ePCT is a web-based service that provides for electronic filing of international applications with certain PCT Receiving Offices and includes validation features to help

users properly complete the PCT Request. ePCT also provides for secure electronic access, file management, and document submissions for international applications held by the International Bureau (IB). ePCT is accessed via an internet browser on the user's system, and all information input into ePCT is stored securely on WIPO's servers.

Detailed information on ePCT can be found at

<https://pct.eservices.wipo.int/direct.aspx?T=EN&UG=4>.

WIPO also makes available and maintains PCT Secure Applications Filed Electronically (PCT-SAFE) software, which must be installed on the user's system. Both PCT-SAFE and ePCT include validation features to help users properly complete the PCT Request. Since the PCT-SAFE validation can only be made against the version of the software installed on the user's system, the most up-to-date version of PCT-SAFE is required in order to ensure accurate validation. In contrast to PCT-SAFE, validation in the ePCT system is made in real time and does not require software updates. Furthermore, like PCT-SAFE, the zip file generated by ePCT, which contains a PCT Request in character coded format, also entitles the applicant to the same reduction in international filing fees as indicated in item 4(b) of the PCT Schedule of Fees

(http://www.wipo.int/pct/en/texts/rules/rtax.htm#_S). The use of the ePCT zip file would still require all other documents and application parts to be prepared and loaded separately in EFS-Web for filing of the international application.

By using ePCT, an international application will be associated with the user's ePCT

account, even before the application is filed, thereby allowing users to share access rights with others prior to filing, if needed. In addition, after the record copy is received by the IB, the application file may be viewed online via ePCT without the need to separately request access rights.

Applicants who are residents and/or nationals of the United States and its territories can file international applications directly with the Receiving Office of the IB via ePCT or other means, provided that any national security provisions have been met prior to filing, including obtaining any required foreign filing license. *See* 37 CFR 5.11 and MPEP 140. The current provisions of 37 CFR 5.11(b) authorize U.S. applicants having a foreign filing license to export technical data abroad to servers located outside the United States hosting ePCT to prepare international applications for filing with the IB as a Receiving Office, without having to separately comply with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy). *Id.* The current provisions of 37 CFR 5.11(b), however, do not authorize the export of technical data to such servers for the purpose of preparing international applications for filing with the USPTO as a Receiving Office (RO/US). Applicants wishing to use ePCT to prepare an international application for filing with the RO/US currently must ensure compliance with the regulations set forth in 37 CFR 5.11(b).

The changes to the regulations proposed in this document would permit applicants having a foreign filing license from the USPTO to use ePCT to prepare an international application for filing with the RO/US without having to separately comply with the regulations set forth in 37 CFR 5.11(b). In addition, the information that the USPTO collects from a PCT Request form electronically prepared via ePCT is the same information that it collects from the paper PCT Request form, which has been reviewed and previously approved by the Office of Management and Budget (OMB) under control number 0651-0021.

Discussion of Specific Rules

The following is a discussion of proposed amendments to Title 37 of the Code of Federal Regulations, part 5.

Section 5.1: Section 5.1(b)(2) is proposed to be amended to change the text “foreign patent office, foreign patent agency, or international agency” to “foreign or international intellectual property authority,” for consistency, as the term “intellectual property authority” is generally used in the patent statutes and other patent rules. *See, e.g.*, 35 U.S.C. 111(c) and 119(b)(1) and (b)(3), and 37 CFR 1.55, 1.57(a), and 1.76(b)(6).

Section 5.11: Section 5.11(a) is proposed to be amended to change the text “foreign

patent office, foreign patent agency, or any international agency” to “foreign or international intellectual property authority,” consistent with the change to § 5.1(b)(2).

Section 5.11(b) is proposed to be amended to provide that a license from the Commissioner of Patents under 35 U.S.C. 184 referred to in § 5.11(a) (“foreign filing license”) would additionally authorize the export of technical data abroad for purposes relating to the use of a World Intellectual Property Organization (WIPO) online service for preparing an international application for filing with the USPTO as a Receiving Office (RO/US) under the Patent Cooperation Treaty.

The proposed amendment would authorize applicants having a foreign filing license from the USPTO to use ePCT to prepare an international application for filing with the RO/US without having to separately comply with the regulations identified in § 5.11(b), i.e., the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

Section 5.11(e)(3) is proposed to be amended to change “foreign patent application” to “foreign application” for consistency with the definition of foreign application in § 5.1(b)(2).

Section 5.12: Section 5.12(a) is proposed to be amended to clarify that for an application on an invention made in the United States to be considered to include a petition for license under 35 U.S.C. 184, the application must be filed in the United States Patent and Trademark Office. An application that is filed abroad on an invention made in the United States but which comes to the United States for examination, for example, in the case of an international design application designating the United States that is filed abroad, would not be considered to include a petition for a foreign filing license. Where an application was filed abroad through error without the required license under § 5.11 first having been obtained, applicants should consider filing a petition for retroactive license under § 5.25.

Section 5.15: Section 5.15(a) is proposed to be amended for clarity to include a reference to § 5.11(b) concerning the export of technical data. In addition, “foreign patent agency or international patent agency” is changed to “foreign or international intellectual property authority.” *See* discussion of § 5.1(b)(2), *supra*. Section 5.15(a) also is proposed to be amended to clarify that the grant of the license also covers material submitted under § 5.13, where there is no corresponding U.S. application.

Sections 5.15(b) and 5.15(e) are proposed to be amended consistent with the proposed amendments to § 5.15(a).

Rulemaking Considerations:

A. Administrative Procedure Act: This document proposes changes to the rules of practice to facilitate use of WIPO's ePCT system to prepare international applications for filing with the United States Receiving Office. The changes being proposed in this document do not change the substantive criteria of patentability. These proposed changes involve rules of agency practice and procedure, and/or interpretive rules. *See Bachow Commc'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for these proposed changes are not required pursuant to 5 U.S.C. 553(b) or (c) (or any other law). *See Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for "interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice") (quoting 5 U.S.C. 553(b)(A)). The USPTO, however, is publishing these proposed changes for comment as it seeks the benefit of the public's views on the USPTO's proposed implementation of the proposed rule changes.

B. Regulatory Flexibility Act: For the reasons set forth herein, the Senior Counsel for Regulatory and Legislative Affairs in the Office of General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that changes proposed in this document will not have a significant economic impact on a substantial number of small entities. *See* 5 U.S.C. 605(b).

The changes proposed in this document will facilitate use of WIPO's ePCT system to prepare international applications for filing with the United States Receiving Office and will apply to any entity, including a small or micro entity, that uses ePCT to prepare an international patent application under the PCT for filing with the RO/US. The changes proposed in this document will not result in a change in the burden imposed on any patent applicant, including a small entity.

For the foregoing reasons, the changes proposed in this document will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866

(Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563. Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13771 (Reducing Regulation and Controlling Regulatory Costs):

This proposed rule is not expected to be an Executive Order 13771 regulatory action because the rule as proposed would not be significant under Executive Order 12866.

F. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

G. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

H. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

I. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

J. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

K. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

L. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 *et seq.*), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this document are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this document is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

M. Unfunded Mandates Reform Act of 1995: The changes set forth in this document do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. *See 2 U.S.C. 1501 et seq.*

N. National Environmental Policy Act: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. *See 42 U.S.C. 4321 et seq.*

O. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

P. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*) requires that the Office consider the impact of paperwork and other information

collection burdens imposed on the public. This rulemaking involves information collection requirements which are subject to review by OMB under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501-3549). The collection of information involved in this rulemaking has been reviewed and previously approved by OMB under control number 0651-0021. This rulemaking does not impose any additional collection requirements under the Paperwork Reduction Act which are subject to further review by OMB. The collections of information already approved under control number 0651-0021 support the actions proposed in this rulemaking. Therefore, no changes are required in the collection.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 5

Classified information, Exports, Foreign relations, Inventions and patents.

For the reasons set forth in the preamble, 37 CFR part 5 is proposed to be amended as follows:

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

1. The authority citation for 37 CFR part 5 is revised to read as follows:

Authority: 35 U.S.C. 2(b)(2), 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 *et seq.*; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 *et seq.*; the Nuclear Non Proliferation Act of 1978, 22 U.S.C. 3201 *et seq.*; and the delegations in the regulations under these Acts to the Director (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

2. Section 5.1 is amended by revising paragraph (b)(2) to read as follows:

§ 5.1 Applications and correspondence involving national security.

* * * * *

(b) * * *

(2) Foreign application as used in this part includes, for filing in a foreign country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)) any of the following: An application for patent, international application, international design application, or application for the registration of a utility model, industrial design, or model.

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3. Section 5.11 is amended by revising paragraphs (a), (b) and the introductory text of paragraph (e)(3) to read as follows:

§ 5.11 License for filing in, or exporting to, a foreign country an application on an invention made in the United States or technical data relating thereto.

(a) A license from the Commissioner for Patents under 35 U.S.C. 184 is required before filing any application for patent including any modifications, amendments, or supplements thereto or divisions thereof or for the registration of a utility model, industrial design, or model, in a foreign country or in a foreign or international intellectual property authority (other than the United States Patent and Trademark Office

acting as a Receiving Office for international applications (35 U.S.C. 361, 37 CFR 1.412) or as an office of indirect filing for international design applications (35 U.S.C. 382, 37 CFR 1.1002)), if the invention was made in the United States, and:

(1) An application on the invention has been filed in the United States less than six months prior to the date on which the application is to be filed; or

(2) No application on the invention has been filed in the United States.

(b) The license from the Commissioner for Patents referred to in paragraph (a) of this section would also authorize the export of technical data abroad for purposes relating to (i) the preparation, filing or possible filing and prosecution of a foreign application and (ii) the use of a World Intellectual Property Organization online service for preparing an international application for filing with the United States Patent and Trademark Office acting as a Receiving Office (35 U.S.C. 361, 37 CFR 1.412) without separately complying with the regulations contained in 22 CFR parts 120 through 130 (International Traffic in Arms Regulations of the Department of State), 15 CFR parts 730 through 774 (Export Administration Regulations of the Bureau of Industry and Security, Department of Commerce), and 10 CFR part 810 (Assistance to Foreign Atomic Energy Activities Regulations of the Department of Energy).

* * * * *

(e) * * *

(3) For subsequent modifications, amendments and supplements containing additional subject matter to, or divisions of, a foreign application if:

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4. Section 5.12 is amended by revising paragraph (a) to read as follows:

§ 5.12 Petition for license.

(a) Filing of an application in the United States Patent and Trademark Office on an invention made in the United States will be considered to include a petition for license under 35 U.S.C. 184 for the subject matter of the application. The filing receipt or other official notice will indicate if a license is granted. If the initial automatic petition is not granted, a subsequent petition may be filed under paragraph (b) of this section.

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5. Section 5.15 is amended by revising the introductory text of paragraph (a) and paragraphs (a)(1), (b) and (e) to read as follows:

§ 5.15 Scope of license.

(a) Applications or other materials reviewed pursuant to §§ 5.12 through 5.14, which were not required to be made available for inspection by defense agencies under 35 U.S.C. 181, will be eligible for a license of the scope provided in this paragraph. This license permits subsequent modifications, amendments, and supplements containing additional subject matter to, or divisions of, a foreign application, if such changes to the application do not alter the general nature of the invention in a manner that would require the United States application to have been made available for inspection under 35 U.S.C.

181. Grant of this license authorizes the export of technical data pursuant to § 5.11(b) and the filing of an application in a foreign country or to any foreign or international intellectual property authority when the technical data and the subject matter of the foreign application corresponds to that of the application or other materials reviewed pursuant to §§ 5.12 through 5.14 upon which the license was granted. This license includes authority:

(1) To export and file all duplicate and formal application papers in foreign countries or with foreign or international intellectual property authorities;

* * * * *

(b) Applications or other materials which were required to be made available for inspection under 35 U.S.C. 181 will be eligible for a license of the scope provided in this paragraph. Grant of this license authorizes the export of technical data pursuant to §5.11(b) and the filing of an application in a foreign country or to any foreign or international intellectual property authority. Further, this license includes authority to export and file all duplicate and formal papers in foreign countries or with foreign or international intellectual property authorities and to make amendments, modifications, and supplements to, file divisions of, and take any action in the prosecution of the foreign application, provided subject matter additional to that covered by the license is not involved.

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(e) Any paper filed abroad or transmitted to a foreign or international intellectual property authority following the filing of a foreign application that changes the general

nature of the subject matter disclosed at the time of filing in a manner that would require such application to have been made available for inspection under 35 U.S.C. 181 or that involves the disclosure of subject matter listed in paragraph (a)(3)(i) or (ii) of this section must be separately licensed in the same manner as a foreign application. Further, if no license has been granted under § 5.12(a) on filing the corresponding United States application, any paper filed abroad or with a foreign or international intellectual property authority that involves the disclosure of additional subject matter must be licensed in the same manner as a foreign application.

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Dated: January 21, 2020.

Andrei Iancu,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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