

## Chemin user manual

*Why you need Chemin.* Chemin is for the filer who is filing any of the following:

- papers for entry into the US national stage from a PCT application
- a bypass continuation from a PCT application
- a continuation, divisional, or continuation-in-part of the above.

Imagine that you are getting ready to enter the US national phase from a PCT application. This might be because you yourself filed the PCT application. Or it might be because someone else filed the PCT application and they have asked you to enter the US national phase. Either way, you are going to have no choice but to provide an ADS (given the new rules promulgated by the USPTO in its Federal Register notice of August 14, 2012). And you are going to want the ADS to be a computer-readable ADS so that as much of the bib data as possible will auto-load into USPTO's computer databases.

Or imagine that you are getting ready to file a bypass continuation from a PCT application. Again this may be because you yourself filed the PCT application, or because someone else filed the PCT application and has asked you to attend to this task.

In any of these cases, traditionally this means you (or someone whose work you supervise) will be laboriously preparing an ADS completely by hand. Yes maybe you will be able to copy and paste most of the information, but there is still the risk of accidentally pasting into the wrong field, or forgetting to populate a field, or missing the third inventor out of seven inventors. And no matter how diligent you are about copying and pasting most things, there will be some items that you will have to hand-key. The whole process is error-prone and requires a lot of checking and double checking.

So here is what you will do instead. Using Chemin, you will start with the PCT bibliographic data from Patentscope or from ePCT. For example, you will tell Chemin the PCT application number that you want, and Chemin will obtain the PCT bibliographic data from Patentscope. Chemin will parse the PCT bibliographic data and will display it for your review and editing. When you are done, you will save an XML file to be used in creating the ADS. You will open a blank ADS, and with a few mouse clicks you will import the XML file into the ADS. You will review the ADS and save it as a PDF file. You will then upload the ADS into EFS-Web and e-file it. The bibliographic data will auto-populate into USPTO's Palm system. You can then check the bibliographic data in Private PAIR and in the official Filing Receipt.

Optionally Chemin will generate formal documents ready for signing, including an inventor's Declaration and a Power of Attorney.

Using Chemin will save time. Using Chemin, typically you will arrive at a completed ADS in just a few minutes instead of half an hour. You will have your formal documents instantly. But the real benefits of Chemin go far beyond saving ten or twenty minutes of document preparation time.

*Reduced risk of embarrassment or professional liability.* When you are preparing a detailed document

such as an ADS or Declaration or Power of Attorney, it is all too easy to mistype a value, or to forget to provide a value, or to paste a piece of information into the wrong place in the document. This can be embarrassing because you may need to send papers to a client a second time, or may need to carry out corrective steps at the USPTO. Worse, there are mistakes you could make which might lead to loss of substantive rights. Chemin will reduce these risks in two ways:

- by filling the fields of the ADS in an automatic way, thus reducing errors and omissions;
- by carrying out validations and providing warnings and suggestions.

*Typical workflow.* A typical user sequence will be this:

1. Run Chemin
2. Load the PCT bibliographic data into Chemin
3. View validation displays and act upon them if necessary
4. View display of address information for each person (inventor, assignee, applicant)
5. For each person, drag and drop address elements (city, state, post code) into place
6. Specify a non-inventor applicant (for cases filed on or after September 16, 2012)
7. Specify an assignee (for PCT cases with an international filing date prior to September 16, 2012)
8. Click to insert a correspondence-address customer number
9. Click to insert the “representative” (power of attorney) customer number
10. Click to insert electronic signature
11. Save the XML file which will be imported into the ADS
12. Optionally, generate inventor declarations and/or power of attorney
13. Open an empty ADS (Chemin will suggest whether to use Form PTO/SB/14 or Form PTO/AIA/14)
14. Import the XML file into the ADS
15. Review the ADS
16. Save the ADS
17. Upload the ADS to EFS-Web
18. e-file the ADS

*Four ways to load PCT bibliographic data into Chemin.* The starting point is the loading of bibliographic data into Chemin. There are four ways to do this:

1. The user clicks a button in Chemin and specifies a PCT patent application number and Chemin obtains the XML IASR file directly from Patentscope.
2. The user manually downloads the XML International Application Status Report from ePCT and opens it in Chemin.
3. The user manually downloads the XML International Application Status Report from Patentscope and opens it in Chemin.

4. The user manually exports an XML file from an old ADS and opens it in file/open in Chemin.

Path number 1 is the easiest one, requiring the fewest mouse clicks by the user, but this path is not always available. For example if a PCT application has not yet been published by the International Bureau, probably the only available path is path number 2.

- With path 2 or path 3, there is the risk that a user might manually download an International Application Status Report and then might allow too much time (maybe some weeks or months) to pass before opening it in Chemin. Things might have changed during those weeks or months that would make a difference in the US filing. For example there might have been *92bis* changes, or an International Search Report may have been established. To reduce this risk, Chemin will check to see when the IASR was created and will warn the user if it is “stale”.

*What Chemin will **not** do for you.* The use of Chemin is no substitute for the proofreading and review that you should carry out anyway. Any and all proofreading and review steps that you would and should have taken without Chemin, you should take anyway. Here are just a few examples of review steps that Chemin cannot do for you:

- US patent law requires that you disclose the existence of any priority applications the filing dates of which predate the PCT filing date by more than a year. Such applications may not have been listed in the PCT application in which case Chemin could not possibly know of their existence.
- The PCT application may be a continuation or a C-I-P of some US application filed more than a year prior to the PCT filing date. This will have been mentioned (or should have been mentioned) in the Supplemental Box of the PCT Request. Chemin will not know of such things. You will need to add such domestic benefit claims to the ADS.
- The US patent application that will result from your filing efforts may be a “transition” application under the America Invents Act. If so, then you must determine whether or not to “check the box” indicating whether or not the application contains, or ever contained, a claim the effective filing date of which is on or after March 16, 2013. Chemin cannot tell you whether or not to check that box for a transition application.
- The filer of the PCT application might have overlooked or omitted or mistyped a priority claim that should have been listed in the PCT Request. This may mean that it would be better to file a bypass continuation rather than entering the US national stage. Chemin cannot detect such an omission or error.
- The ISR and WO may have been prepared by ISA/US and may be favorable as to all claims being presented in the US application. If so, then you might not have to pay a search fee or examination fee at all. Chemin cannot know of this.
- Chemin cannot tell you whether some circumstance (such as licensing of the invention) may render the US applicant ineligible for Small Entity status.

- There are advantages and disadvantages to the national-phase approach on the one hand and the bypass continuation approach on the other hand. Chemin cannot make that decision for you.
- In the case of a US application filed within one year of the priority date of the PCT (which might be the PCT filing date), you have the discretion to connect your US application to the PCT application through 35 USC 119(a-e) rather than through 35 USC 120. Chemin is not able to make that decision for you.

The patent practitioner who serves clients with the filing of PCT applications or with the filing of papers to enter the US national stage from PCT applications needs to know all about the Patent Cooperation Treaty itself and its PCT Rules, as well as applicable US statutes and rules. This requires among other things a thorough study of the PCT Applicant's Guide and of the USPTO Manual of Patent Examining Procedure. WIPO offers a variety of free-of-charge resources including webinars, recorded video programs, and distance learning programs. Where a non-practitioner such as a paralegal or administrative assistant carries out some of the steps, it is crucial that this person be supervised by a competent patent practitioner. The patent practitioner needs to know exactly how to do the work that the paralegal or administrative assistant is carrying out, to know whether or not the work is being carried out correctly. Importantly, the use of Chemin is no substitute for such knowledge on the part of the patent practitioner and is no substitute for thorough training and supervision by the patent practitioner of the paralegal or administrative assistant.

The patent practitioner must also be fully aware of the America Invents Act and its consequences for PCT applications and US patent applications. While Chemin does carry out some validations that are intended to draw your attention to some AIA-related issues, Chemin cannot and will not identify everything about AIA that may be pertinent to a particular patent application.

*Validations* Chemin carries out several validations, including the following.

- Is the priority date more than 30 months in the past? (You might want to file a Petition to Revive.)
- Has an International Search Report been established? (This affects the amount of the search fee you will need to pay)
- Has the IB published the PCT application? (This can affect whether or not you will need to file a copy of the PCT application with the USPTO.)
- Are there outstanding certified copies of priority documents? (You may need to provide certified copies yourself.)
- is the ISR/WO from an ISA that is "approved" for US PCT-PPH purposes? (If so then you may want to look at the WO for possible PCT-PPH use.)
- Chemin will suggest whether to use the "old" ADS (Form PTO/SB/14) or the "new" ADS (Form PTO/AIA/14)

- Chemin will suggest whether to use the "old" declaration language (Form PTO/SB/01A) or the "new" declaration language (Form PTO/AIA/01)
- Chemin will suggest whether to use the "old" power of attorney (Form PTO/SB/80 and a Rule 3.73 statement) or the "new" power of attorney (Form PTO/AIA/82B and Form PTO/AIA/82A)
- Chemin will warn you if the International Application Status Report that you are using is stale. (You may wish to download a fresh IASR.)
- Is the 30-month date in the future? (You might want to file an Express Request for immediate national-stage processing.)
- Are you filing a bypass continuation or "other" and is the present date within one year of the priority date? (You may wish to connect your new application to the PCT application by means of 35 USC 119(a-e) rather than by means of 35 USC 120.)
- Is the earliest of the priority application filing dates more than 12 months prior to the IFD but no more than 14 months before? (You may wish to look at the Restoration of Priority situation.)

*Report generation.* At any time the user can click a button that generates a simple report that communicates all of the validations and status indications. Chemin then copies the report into the Windows "paste" buffer. The user can then paste the report into an email or into a word processor program (or Notepad) for printing to a printer. For a user located at a corporation or patent firm located outside the US, it may be convenient to email all or portions of this report to US counsel. A paralegal or administrative assistant using Chemin may wish to email the report to a supervisor for review, or may wish to print it out along with a printout of the ADS, for review by a supervisor.

*Selecting a filing type.* Chemin constructs your ADS differently depending on whether you are entering the US national phase, filing a bypass continuation, or filing some other type of application. Chemin cannot choose for you which of these filing types is needed or which is better for your client in a particular situation.

- US national phase. This is a first way to pursue US patent protection from a PCT application.
- Bypass continuation. This is a second way to pursue US patent protection from a PCT application.
- Other. If you are filing a new US application that claims domestic benefit from either of the previous two filing types, then pick "other". You may then specify the number of blank lines of continuity data you wish to have in your ADS. Later in the PDF file you can manually enter the intervening continuity data.

*Bypass continuations and priority documents.* If you pick "bypass continuation" and if there is at least one priority application that is not from the US, Chemin will display a warning that the user will have to provide a certified copy of the priority document. The user will be invited to make use of PDX/DAS

provide the “access code” for each such application. If the user provides the code, then this code will get populated into the “access code” field for that priority document in the ADS.

*Cleaning up party addresses.* The IASR lumps together everything about a party address other than the post code and the country. In contrast, the ADS expects you to enter the city and state separately, and invites you to break up the remaining portion of the address into first and second “address” fields. To do this, Chemin displays the party addresses one by one. When an address is displayed, you are invited to drag and drop the various address elements from the IASR into the various fields of the ADS. Hopefully a place can be found in the ADS for each element from the IASR.

Alternatively, the client may have specified that some particular address should be used for each inventor (for example the address of the employer/assignee). Chemin lets you keep an address book with address entries for this purpose. You can set a default that if a particular party is the assignee or non-inventor applicant, an address associated with that party will be inserted for each of the inventors.

*Picking an assignee for an application having a filing date before September 12, 2012.* For an application having a filing date prior to September 16, 2012, it is possible to pick a party to be listed as the assignee in the ADS. The chief significance of this listing is that the party will be listed as such on the front page of the application as published at 18 months by the USPTO. (This happens for example if you are entering the US national phase from a PCT application filed prior to September 16, 2012.) You can set a default behavior so that if the PCT applicant list includes only one party that is not a natural person, this party will get listed in such an ADS as the assignee. You will of course want to check independently to see whether such a listing is appropriate and is in keeping with the client's wishes.

If you have not set such a default, Chemin will ask you whether you wish to appoint an assignee. If so, you may pick from among the PCT applicants for this purpose. Of course later when you are viewing the PDF file you can change or update all of the ADS information including the assignee if any.

Chemin assumes by default that any assignee is a legal person. You can turn off this default.

*Picking an assignee or a non-inventor applicant for an application having a filing date on or after September 12, 2012.* For an application having a filing date on or after September 16, 2012, it is possible to pick a party to be listed as a non-inventor applicant (“NIA”) in the ADS, or it is possible to pick a party to be listed as the assignee in the ADS.

As for the listing of a party in such an application as the assignee, the chief significance of this listing is that the party will be listed as such on the front page of the application as published at 18 months by the USPTO.

As for the listing of a party in such an application as the non-inventor applicant, this has many consequences for the applicant:

- the party will be listed as such on the front page of the application as published at 18 months by the USPTO;

- the manner of obtaining a power of attorney in the application is simpler than if there were no NIA;
- the NIA, if established, can sign various papers such as Substitute Statements.

Many practitioners feel that it is a Best Practice to appoint a NIA unless there are facts that make this impossible. Chemin permits you to set a default behavior so that if the PCT applicant list includes only one party that is not a natural person, this party will get listed in such an ADS as the non-inventor applicant. You will of course want to check independently to see whether such a listing is appropriate and is in keeping with the client's wishes. In particular you will need to indicate whether the NIA enjoys NIA status due to its being an assignee, an obligated assignee, or a PTWIIOTA. Chemin cannot make this decision for you.

If you have not set such a default, Chemin will ask you whether you wish to appoint a non-inventor applicant or an assignee. If so, you may pick from among the PCT applicants for this purpose. Of course later when you are viewing the PDF file you can change or update all of the ADS information including the NIA or assignee if any.

Chemin assumes by default that any assignee or NIA is a legal person. You can turn off this default.

*Licensed use of Chemin.* Depending on the version of Chemin that you are using, it may have a limit to the number of sessions (defined as saving an XML file for an ADS) and it will count down until it has used up the number. To see if your version of Chemin has such a limit, check the “about” box. If there is a limit to the number of sessions, the “about” box will tell you how many sessions remain. If the number of remaining sessions drops to zero, Chemin will not work any more. In such an event, to get Chemin to keep working, the user will then have to purchase more sessions. The “about” box will explain how to do this.

*Picking a user interface language.* Chemin permits the user to pick a user interface language. Choices include English and simplified Chinese. The selection is saved when Chemin is closed and when Chemin is launched the language of the saved choice will be employed in the user interface. The user can change this selection as desired.

*Generating inventor declarations and powers of attorney.* Chemin permits you to generate an inventor declaration or a power of attorney with appropriate language as a function of the filing date (prior to September 12, 2012 or on or after that date). This can be done in Microsoft Word or in OpenDocument format. Sample templates in each of these formats are provided. You can customize the templates to suit particular needs. For example for an inventor declaration for an application filed on or after September 12, 2012, some practitioners choose to include the legacy language about the duty of disclosure and having read and understood the application including the claims, despite such language not being required by law. Some practitioners choose to provide a dual-language declaration, for example in both English and simplified Chinese. Still other practitioners choose to include assignment language in the inventor's declaration. (Some practitioners feel it is not a Best Practice to attempt to use a single document for both inventor declaration and assignment purposes.)

To generate an inventor declaration, click the button and select one of the stored “declaration” word

processor templates. Chemin will generate the declaration.

To generate an application-specific power of attorney, click the button and select one of the stored “application-specific power of attorney” word processor templates. Chemin will generate the application-specific power of attorney.

To generate a general power of attorney, click the button and select one of the stored “general power of attorney” word processor templates. Chemin will generate the general power of attorney.

*Authorizing access to PDX/DAS.* The ADS provides a check box by which the user may authorize release of the application to PDX/DAS. Many practitioners feel it is a Best Practice to routinely check this box. You can set a default behavior in Chemin for this box to be checked. Keep in mind that later when you are reviewing the PDF file, you can uncheck this box if desired.

*Rules file.* Chemin relies upon a “rules” file which is stored in your computer. The “rules” file tells Chemin how to carry out its various tasks. If for example WIPO were to change the appearance of the Patentscope web site, it might be possible to adapt to the change simply by releasing a revised “rules” file. This would be faster and easier than releasing a new version of the Chemin software. Likewise this might make it possible to adapt to WIPO or USPTO changing the format of its XML files without having to release a new version of the Chemin software.

When Chemin launches, it tries to do a lookup to a Chemin server to find out if there has been an update to the “rules” file or a release of a new version of Chemin. If the lookup fails, it fails silently. If the lookup succeeds, then Chemin looks to see if there is a new version of either file. If there is a new version of “rules” then you will be told of this development and you will be invited to click a button telling Chemin to download the new “rules” file and install it to your computer. Likewise if there is a new version of Chemin, then you will be told of this development.

*Manual loading of bibliographic data into Chemin.* Although the easiest way to load bibliographic data into Chemin is the automatic approach, there are three ways to manually load bibliographic data into Chemin. It is important to know how to do such a manual loading of data, for several reasons. First, for a PCT application that has not yet been published, the automatic approach will not work. Second, sometimes the automatic approach will not work even for a published PCT application, due to factors beyond Chemin's control. Third, you may wish to load data from an old ADS in a parent case that had previously been e-filed in the USPTO.

The manual approaches are not difficult.

Manually downloading the XML International Application Status Report from ePCT

Log in at Private ePCT. (To do this you need to have already obtained a WIPO user ID and a WIPO cryptographic certificate, and uploaded the public key of the certificate to the ePCT system.) Open the international application of interest. In “file view”, right-click on the blue IASR XML icon. Save the file to your computer.

**File View** | Upload Documents | Time Line | Access Rights | History

Title : (EN) ██████████

International Filing Date : 27 Aug 2013

Priority Date : 27 Aug 2012

International Publication Date : ⓘ

International Publication Number :

IA Status : **Not yet Published**

International Application Status Report : PDF XML [document icon]

Processing Team at IB : PT03 [Send ePCT Message](#)  
Tel. +41 22 338 74 03  
e-mail: pt03.pct@wipo.int

Address for Service ⓘ : 🏠

Manually downloading the XML International Application Status Report from Patentscope

In Patentscope, open the international application of interest. Go to the “documents” tab. Right-click on the blue XML link. Save the file to your computer.

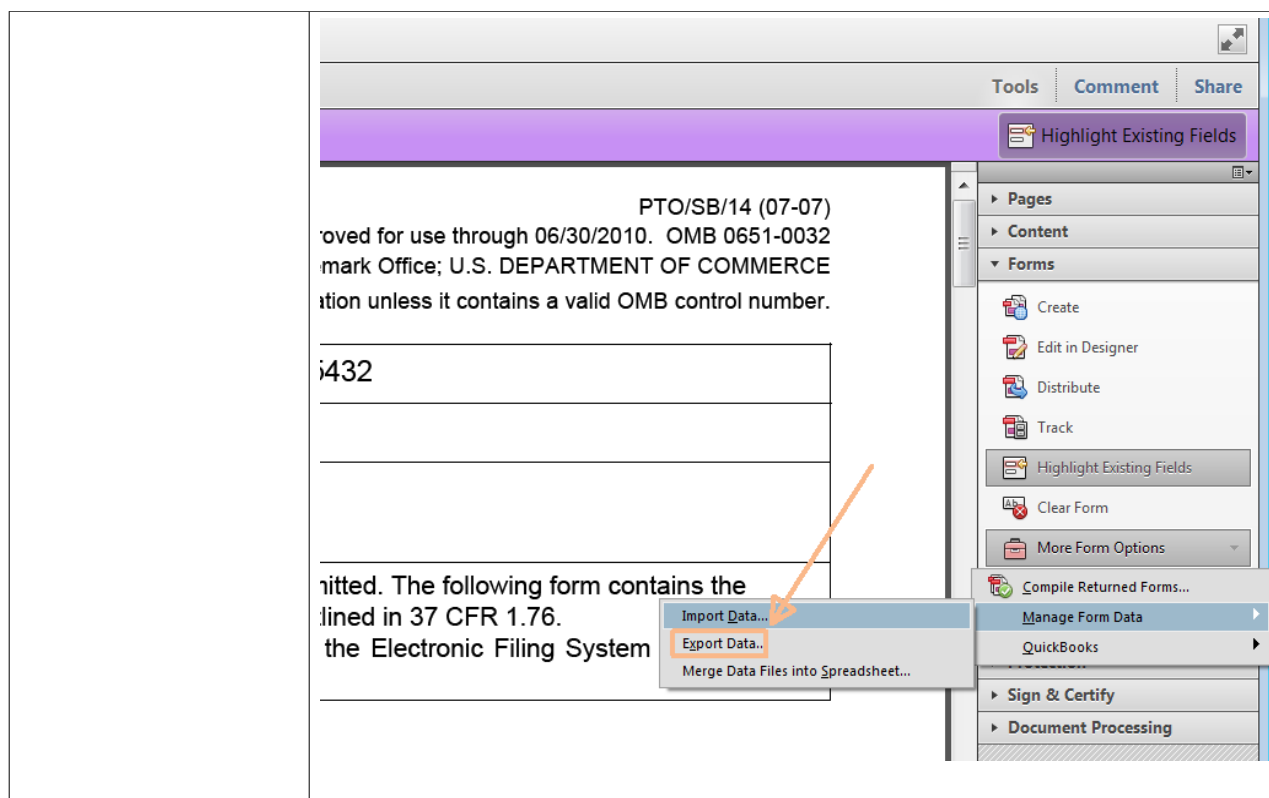
PCT Biblio. Data | Description | Claims | National Phase | Notices | Drawings | Documents

International Application Status ⓘ

Date	Title	View	Download
22.09.2013	International Application Status Report	HTML, PDF	PDF XML

Manually exporting an XML file from an old ADS

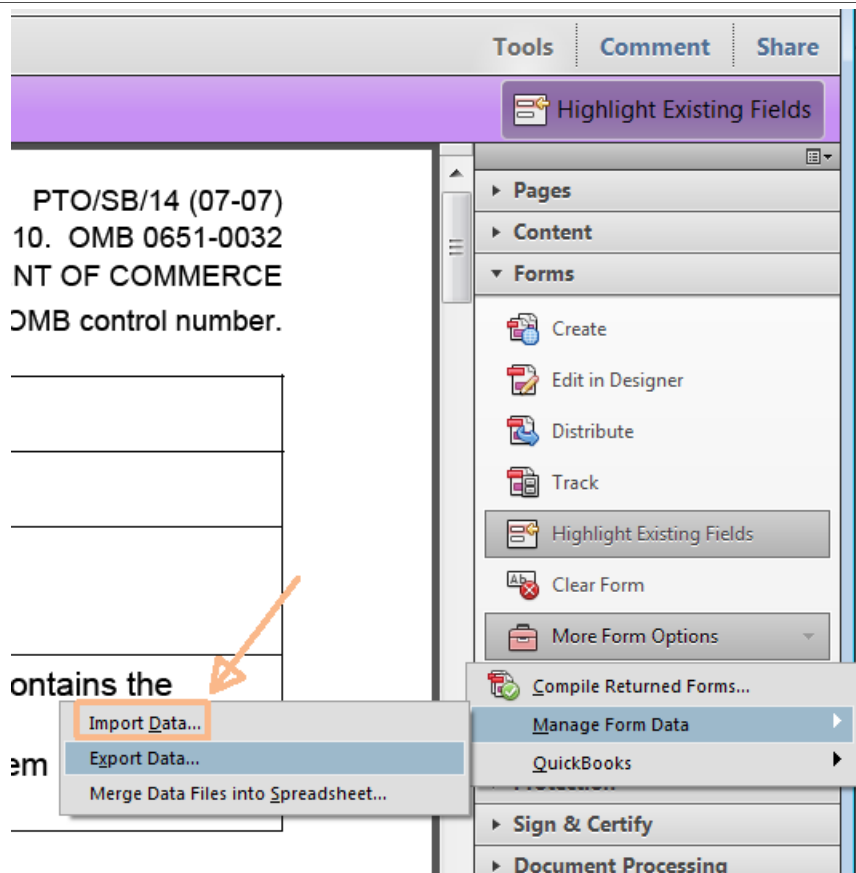
Open the ADS. Click on “tools” and “forms” and “more form options” and “manage form data” and “export data”. Save the file to your computer.



*Loading the bibliographic XML file into your ADS.* At this point you will have already used Chemin to save an XML ADS file to your computer. Make sure you know which ADS form to use – Form PTO/SB/14 or Form PTO/AIA/14.

Open the form in Acrobat. (For this task you can use paid-for Acrobat or free-of-charge Acrobat.) Click on “tools” and “forms” and “more form options” and “manage form data” and “import data” as shown in the figure. Select the XML ADS file. The contents of the file will load into your PDF ADS.

After loading the information into your ADS, you should proofread it and review it just as you would a manually created ADS.



*Customer numbers.* The USPTO ADSs permit the filer to indicate the correspondence mailing address by means other than a customer number, and permit the filer to indicate the “power of attorney” representative by means other than a customer number, but many practitioners feel that this is not a Best Practice. Many practitioners feel that the Best Practice is to use a customer number to indicate a correspondence address and to use a customer number to indicate the POA representative. (If you wish to use a means other than a customer number, you can do this manually in the PDF ADS after loading the Chemin XML file into the ADS.)

Chemin permits you to set up a saved list of customer number combinations. Thus for example whenever you file papers for Client A you might wish to use customer number 12345 for the correspondence address and customer number 23456 for the POA. You can save this combination in the saved list. Within an ADS project in Chemin, you can then select this combination and the two customer numbers will automatically populate into these fields in the ADS.

You can also set up a default behavior, so that if a particular assignee or NIA is selected, a matching entry from the saved list will be applied to the customer number fields in the ADS.

*Title.* If the PCT application was filed in English, then there will be an English-language title in the PCT bibliographic data. If the PCT application was not filed in English, then the International Bureau will provide an English-language title shortly after the PCT filing date. In either case, Chemin will

extract the title from the PCT data and will display the title so that you may edit it if you wish. Importantly, Chemin will convert the title to “sentence case”, meaning that the first letter is capitalized and the rest of the title is in lower-case letters. If there are acronyms or proper names in the title, you may wish to capitalize them. When you are done, you can click “save” and Chemin will save the title into the XML file.

*Attorney docket number.* When you file papers at the USPTO which lead to assignment of a new US application number, many practitioners feel that it is a Best Practice to provide an “attorney docket number”. At the time of filing the PCT application, or at some later time after filing, the filer may have provided a “file reference”. Chemin will extract the file reference from the PCT data and will display the text for possible use as all or part of the attorney docket number. For example:

- You yourself may have filed the PCT application, with a reference ending in “WO” such as “12345-WO”. Now you are entering the US national phase. Your file numbering system may call for the same numerals to be used but a different ending such as “12345-NP”. Chemin makes it easy to do this without having to retype the numerals, thus eliminating what might otherwise be a possible source of error.
- Foreign counsel may have filed the PCT application, with a reference such as “M023”. Now you are entering the US national phase. Your file numbering system calls for your file number to be “12345-NP”. As a courtesy to foreign counsel, you may wish to include their file reference at the end of the attorney docket number, for example “12345-NP M023”. Chemin makes it easy to do this without having to retype the foreign file reference, thus eliminating what might otherwise be a possible source of error.

You may edit or replace the attorney docket number as you wish. Chemin will carry out a validation for the 25-character limit in USPTO's systems. When you are done, you can click “save” and Chemin will save the title into the XML file.

*E-signature.* USPTO rules require that the ADS be signed. Chemin permits you to save a list of e-signatures. When the time comes to finalize an ADS in Chemin, you can select an e-signature from the list. This will populate the signature fields including the date of the e-signature. Alternatively you can leave the e-signature blank in Chemin and you can do the e-signing in the PDF ADS file.

*Fields left blank in Chemin.* As you will see when you view a PDF ADS that has been populated from Chemin, there are many fields which Chemin leaves blank. These include for example “suggested technology center” and “suggested class”. In our experience USPTO neither notices or cares whether the filer completes these fields. If, however, you nonetheless wish to complete one or more of the fields left blank by Chemin, you may do so in the PDF ADS file.