

# National Phase at the USPTO

PCT at the EPO  
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# Who is the applicant?

- As Mike Neas of USPTO explained, for PCT applications filed on or after September 16, 2012, the Request can often be simplified
- Where the inventors have assigned their rights to an entity, or are obligated to assign their rights to an entity, then the entity can be the applicant for purposes of the US, just as has generally been the case in the past for purposes of designations other than the US

# Declaration of Inventorship for purposes of the US

- A PCT filer can include a Declaration of Inventorship when filing a PCT application in the Receiving Office
- US counsel may give you a discount on professional fees for US national-phase entry if you do this
- You avoid having to worry about an inventor disappearing or refusing to cooperate
- This is a Best Practice

**Box No. VIII (iv) DECLARATION: INVENTORSHIP (only for the purposes of the designation of the United States of America)**

*The declaration must conform to the following standardized wording provided for in Section 214; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (iv). If this Box is not used, this sheet should not be included in the request.*

**Declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv))  
for the purposes of the designation of the United States of America:**

I hereby declare that I believe I am the original inventor or an original joint inventor of a claimed invention in the application.

This declaration is directed to the international application of which it forms a part (if filing declaration with application).

This declaration is directed to international application No. PCT/ [redacted] (if furnishing declaration pursuant to Rule 26ter).

I hereby declare that the above-identified international application was made or authorized to be made by me.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Name: [redacted]

Residence: [redacted]  
(city and either US state, if applicable, or country)

Mailing Address: [redacted]

Inventor's Signature: .....  
(The signature must be that of the inventor, not that of the agent)

Date: [redacted]

# You don't need to hire US counsel to record an assignment

- You can do the recordation yourself, on the web site of USPTO
  - You can pay the fee with a credit card
- US sends the Notice of Recordation to you by email

## FILE

- [EFS-Web - unregistered](#)
  - Basic initial filing
- [EFS-Web - registered](#)
  - Enhanced filing and follow on processing, saved submissions
- [Biotechnical Sequence listings/Computer Readable Forms - Checker and PatentIn](#)
- [Priority Document Exchange -PDX](#) with participating foreign IP offices
- [Record Assignment \(Changes of Ownership\)](#)
- [File Interference Documents](#)
- [File application and other documents online - TEAS](#)
- [Record Assignment \(Changes of Ownership\) - ETAS](#)
- [File TTAB documents online - ESTTA](#)

## Conveyance Type

Select nature of conveyance

|  |  |
|--|--|
| <input type="radio"/> <a href="#">Assignment</a>                                 |  |
| <input type="radio"/> <a href="#">Change Of Name</a>                             |  |
| <input type="radio"/> <a href="#">Merger</a>                                     | Effective date: <input style="width: 80px;" type="text"/> Format: MM/DD/YYYY |
| <input type="radio"/> <a href="#">Nunc Pro Tunc Assignment</a>                   | Effective date is required for 'Merger' and 'Nunc Pro Tunc' types            |
| <input type="radio"/> <a href="#">Security Agreement</a>                         |  |
| <input type="radio"/> <a href="#">Government Interest Agreement</a>              |  |
| <input type="radio"/> <a href="#">Executive Order 9424, Confirmatory License</a> |  |
|  | to correct the <input style="width: 450px; height: 20px;" type="text"/>      |

# Recording assignments yourself

The fee for recordation of a US patent document will drop on January 1, 2014 from \$40 to zero

The fee for recordation of a US trademark document is \$40 and will not change on January 1, 2014

# Recording assignments yourself

There is no good reason to postpone recordation of an assignment until 30 months after priority

The recordation can be carried out with respect to the international application number

Such recordation automatically covers any later entry into the US national base

You avoid having to worry about an inventor disappearing or refusing to cooperate

This is a Best Practice

# Using ePCT

- It is a Best Practice to make sure all of your past and present cases are visible to you in ePCT
- When you enter the US national phase, all you need to do is give access to US counsel in ePCT
- This requires only one click of a mouse
- This saves you having to guess (or remember) which documents are needed by US counsel

# Giving access to US counsel in ePCT

- This gives automatic and instant access to US counsel to the Written Opinion and any work done by an IPEA in Chapter II of the Treaty

# Want to save money on US professional fees and save proofreading burdens for yourself?

- Complete the USPTO Application Data Sheet yourself
- Do this instead of preparing your usual “information sheet” that lists inventors, priority etc.
- US counsel should give you a discount for doing this work
- You do not need to worry about US counsel or USPTO personnel mistyping these things

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

|  |                        |  |
|--|------------------------|--|
| <b>Application Data Sheet 37 CFR 1.76</b>  | Attorney Docket Number |  |
|  | Application Number     |  |
| Title of Invention   |                        |  |
| <p>The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76. This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.</p> |                        |  |

## Secrecy Order 37 CFR 5.2

Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

## Inventor Information:

|  |                      |                      |                      |                      |                      |
|--|----------------------|----------------------|----------------------|----------------------|----------------------|
| Inventor   | 1                    |                      |                      |                      | Remove               |
| Legal Name   |                      |                      |                      |                      |                      |
| Prefix   | Given Name           | Middle Name          | Family Name          | Suffix               |                      |
| <input type="text"/>   | <input type="text"/> | <input type="text"/> | <input type="text"/> | <input type="text"/> |                      |
| Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service |                      |                      |                      |                      |                      |
| City   | <input type="text"/> | State/Province       | <input type="text"/> | Country of Residence | <input type="text"/> |

# Getting ready for sending instructions to US counsel

Consider whether to use national phase or a continuation application

If you have an international filing date prior to September 16, 2012 and a missing or uncooperative inventor, consider the continuation

This will permit use of “substitute statement” practice which is easier than “Rule 47” practice

# National phase versus continuation

- If the case is a national phase, then the US examiner will use the unity-of-invention standard to figure out whether to restrict
- If the case is not a national phase, then the US examiner will use the US distinct-invention standard to figure out whether to restrict
- Usually you are better off with unity of invention
- This is a factor favoring use of national phase

# Getting ready for sending instructions to US counsel

## **Multiple dependent claims**

If you have an MDC depending from an MDC ...

This is not permitted in US practice

US counsel will generally discard all MDCs

If some particular dependencies are important, let US counsel know so that they can preserve them

# PCT-PPH

- If you have a favorable result from ISA/EP or IPEA/EP ... or ISA/AT, IPEA/AT, ISA/FI, IPEA/FI ISA/XN, IPEA/XN, ISA/ES, IPEA/ES, ISA/SE, or IPEA/SE ...
- Consider using this to get on the Patent Prosecution Highway in the US

# Benefits of PCT-PPH in the US

- Yes you get your first office action sooner
- But perhaps more important, on average you will reach disposal of the case in fewer Office Actions – maybe 1½ OAs to disposal instead of 2½ OAs to disposal
- The “special” status is a gift that keeps on giving
- If you need to appeal a “special” case, the Board of Appeals will take up the case instantly instead of waiting maybe five years to take up the case

# Benefits of PCT-PPH in the US

- The USPTO does not promise that it will give full faith and credit to ISA or IPEA results in Highway cases
- But in our experience the allowance rate for PCT-PPH cases is much higher than for normal cases
- Allowance rate of 80-90% as compared with 45-55%

# PCT-PPH

- USPTO does not charge any fee for a PCT-PPH request

# PCT-PPH

- If you are going to use PCT-PPH, there is no good reason (other than perhaps cash flow) to postpone the US national-phase entry until 30 months
- Consider entering US national phase within a day or two of the favorable ISA or IPEA results

# Shared customer numbers

- Your US counsel can set up a “shared customer number” for you
- The shared customer number can be set up so that USPTO will automatically send you an email when USPTO mails something
- You can then docket to check for a report from US counsel
- US counsel should do this for you free of charge

# If you do a continuation instead of national phase ...

- US counsel should be able to obtain the certified copy of the priority document in electronic form by means of PDX or DAS
- This will save money as compared with sending a physical certified copy by courier
- US counsel should not charge you for this

# Restoration of priority

- As Matthew Bryan mentioned, the US is making changes to come into compliance with the Patent Law Treaty
- One benefit of these changes is that ROP will work for US cases beginning on about December 19, 2013
- This will work in the US regardless of whether the ROP grant is for a “due care” lapse or an “unintentional” lapse

# “checking the box”

- For any US case with an actual filing date on or after March 16, 2013, the filer is required to figure out whether or not to “check the box”
- The box determines whether the US examiner will use the “old section 102” (first to invent) or the “new section 102” (first inventor to file) to determine patentability
- This is scary because regardless of whether you check the box or not, it may later be suggested that you made the wrong choice

## **Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications**

■ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

# Avoiding having to decide whether to “check the box”

For an international application with a filing date  
prior to March 16, 2013 ...

avoid filing a continuation ...

use national-phase to pursue US patent protection

# Duty of disclosure

- You are familiar with the Duty of Disclosure
- This duty persists through the entire pendency of the application
- Even after the Issue Fee has been paid
- There are mechanisms to deal with the problem of a reference that pops up at the last moment (e.g. QPIDS)

# Join a community of several hundred alert PCT users

- Join the PCT-L listserv
- <http://www.oppedahl.com/pct/>
- Your email address will not be communicated outside of OPLF
- You can always unsubscribe later
- Get real-time answers from colleagues around the world to PCT questions

Thank you!