

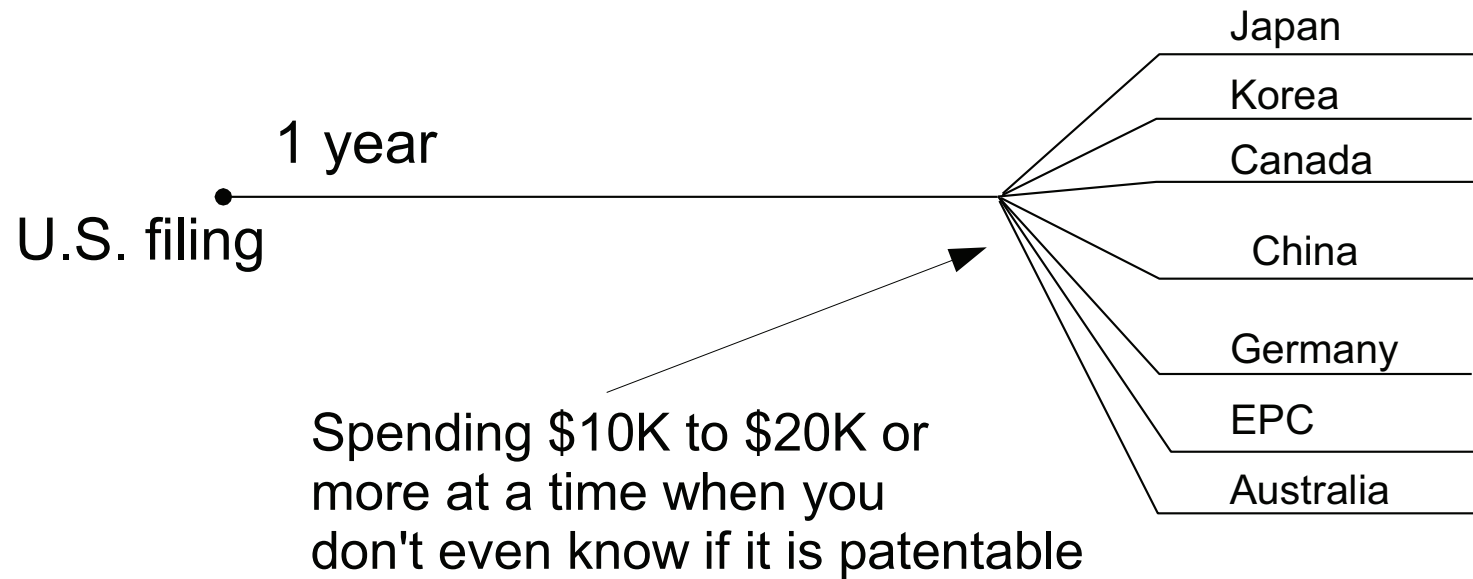
INTRODUCTION TO AND BENEFITS OF THE PATENT COOPERATION TREATY

AIPLA
PCT Seminar
July 2015

Foreign filing can be expensive

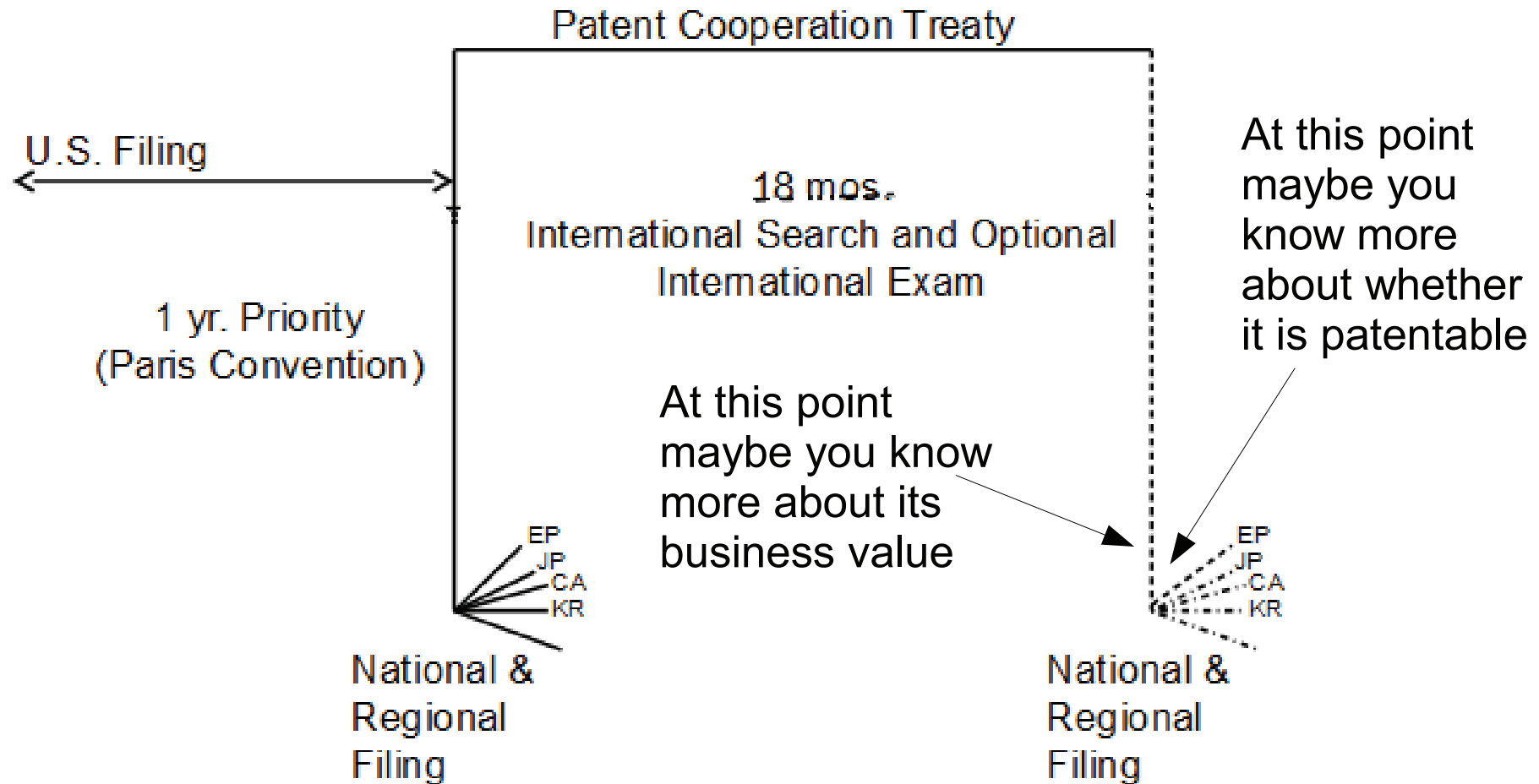
It is easy to spend \$10K or \$20K
or more on foreign filings

Non-PCT route



- The procedure is very costly.
- Within 1 year you rarely have enough information on importance of invention.
- Within 1 year you rarely have enough information on the selection of countries.
- Generally, the deferral of money is important for clients.
- Often cases are dropped early on.

FOREIGN FILING USING THE PCT



PCT DEFERS

HIGH COST OF FOREIGN FILING

- Translation Costs
 - Claim fees
 - Agent Fees
 - Government fees
 - Examples
 - Japan – about \$300 per page (typing and translation)
 - Germany – about \$200 per page (translation)
 - Claim fees
- Europe – \$258 for every claim above 15 (further increases in the future)
- Japan – \$50 per claim

OTHER BENEFITS

•

- Search, written opinion, and optional examination
- Opportunity for Patent Prosecution Highway
- Opportunity to “get to know your invention”

BRIEF SUMMARY OF SOME BENEFITS OF USING THE PCT

- Provides additional 18 months after priority year (30 months) before making foreign filing decisions
- Some offices permit 31 months
- While it adds additional international costs (about \$3,000-\$5,000), it defers high costs of national filing (\$25,000-\$50,000)
- Preserves priority rights in all member countries
- Gives client more time to assess importance of invention and make better decisions on foreign filing
- Can file in English – No translation costs on filing
- Will get an International Search and Written Opinion & optional examination process
- Can use one application for “global” filing
- Can use for Patent Prosecution Highway



An Overview of the PCT System

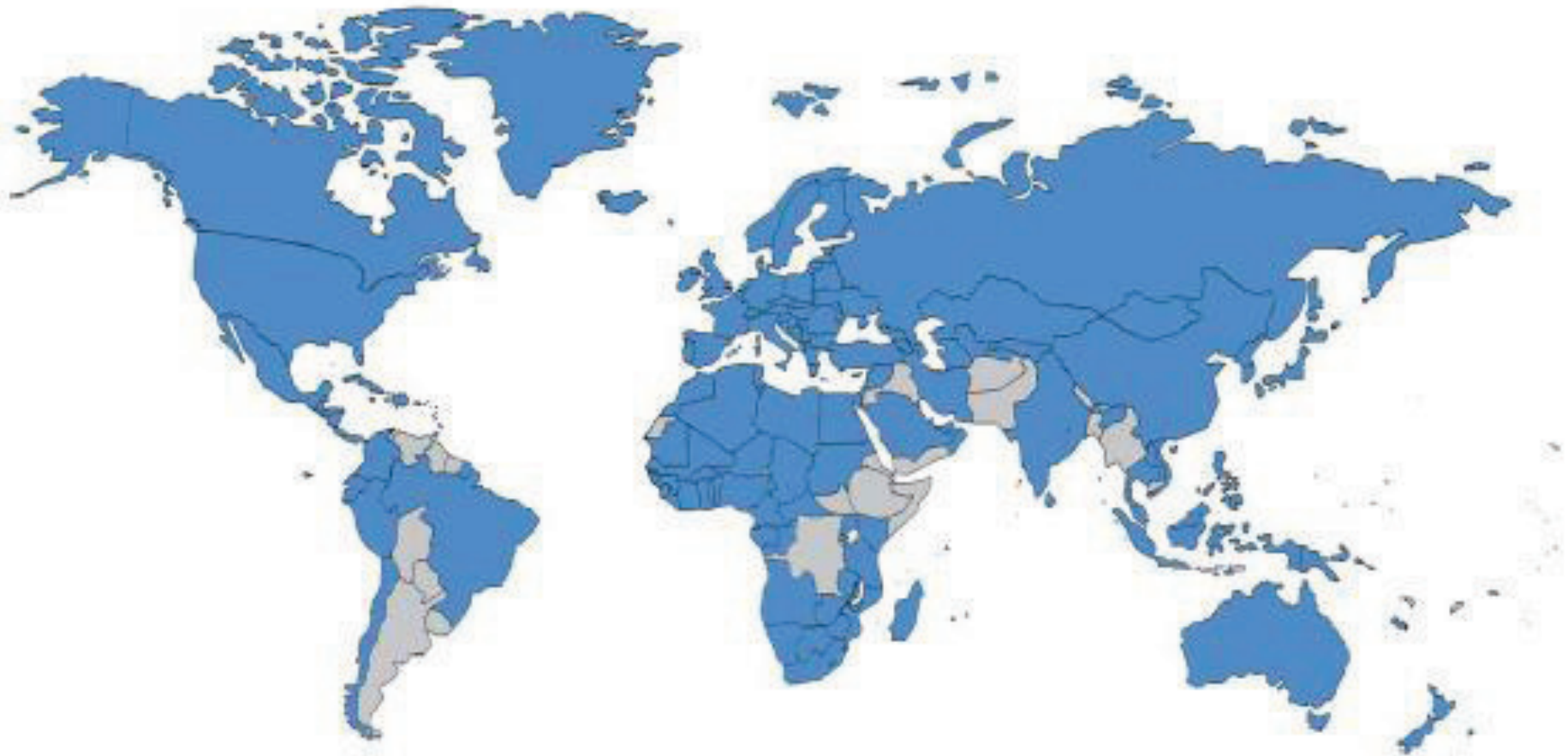
General remarks on the PCT system (1)

- The PCT system is a patent “filing” system, not a patent “granting” system
 - there is no “PCT” or “international” patent
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase
- All PCT Contracting States must also be party to the Paris Convention
- Any international application having been accorded an international filing date has the effect of a regular national application (including establishment of a priority date) in each designated State as of the international filing date

General remarks on the PCT system (2)

- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles
- Design and trademark protection cannot be obtained via the PCT
 - design protection may be obtained via the Hague Agreement
 - trademark protection may be obtained via the Madrid Agreement and Protocol
- The PCT is administered by World Intellectual Property Organization (WIPO) as are other international conventions in the field of industrial property, such as the Paris Convention

PCT Contracting States (148 on 4 October 2013)



-  PCT member
 Country not party to the PCT

PCT Contracting States (148) - Regional Offices (1)

States designated for regional and national protection except where otherwise indicated

EP European Patent

AL	Albania	▲ GR	Greece	▲ MT	Malta
AT	Austria	HR	Croatia	▲ NL	Netherlands
▲ BE	Belgium	HU	Hungary	NO	Norway
BG	Bulgaria	▲ IE	Ireland	PL	Poland
CH	Switzerland	IS	Iceland	PT	Portugal
▲ CY	Cyprus	▲ IT	Italy	RO	Romania
CZ	Czech Republic	LI	Liechtenstein	RS	Serbia
DE	Germany	▲ LT	Lithuania	SE	Sweden
DK	Denmark	LU	Luxembourg	▲ SI	Slovenia
EE	Estonia	▲ LV	Latvia	SK	Slovakia
ES	Spain	▲ MC	Monaco	SM	San Marino
FI	Finland	MK	The former Yugoslav Republic of Macedonia	TR	Turkey
▲ FR	France				
GB	United Kingdom				

▲ Regional patent only

PCT Contracting States (148) - Regional Offices (2)

States designated for regional and national protection except where otherwise indicated

AP ARIPO Patent

BW Botswana
GH Ghana
GM Gambia
KE Kenya
LR Liberia
LS Lesotho
MW Malawi
MZ Mozambique
NA Namibia
RW Rwanda
SD Sudan
SL Sierra Leone
ST Sao Tome & Principe
▲ SZ Swaziland
TZ United Republic of Tanzania
UG Uganda
ZM Zambia
ZW Zimbabwe

EA Eurasian Patent

AM Armenia
AZ Azerbaijan
BY Belarus
KG Kyrgyzstan
KZ Kazakhstan
RU Russian Federation
TJ Tajikistan
TM Turkmenistan

OA OAPI Patent

▲ BF Burkina Faso
▲ BJ Benin
▲ CF Central African Republic
▲ CG Congo
▲ CI Côte d'Ivoire
▲ CM Cameroon
▲ GA Gabon
▲ GN Guinea
▲ GQ Equatorial Guinea
▲ GW Guinea-Bissau
▲ KM Comoros
▲ ML Mali
▲ MR Mauritania
▲ NE Niger
▲ SN Senegal
▲ TD Chad
▲ TG Togo

▲ Regional patent only

PCT Contracting States (148)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	IN	India	NZ	New Zealand
AG	Antigua and Barbuda	IR	Islamic Republic of Iran	OM	Oman
AO	Angola			PA	Panama
AU	Australia	JP	Japan	PE	Peru
❖ BA	Bosnia and Herzegovina	KN	Saint Kitts and Nevis	PG	Papua New Guinea
BB	Barbados	KP	Democratic People's Republic of Korea	PH	Philippines
BH	Bahrain			QA	Qatar
BN	Brunei Darussalam			SA	Saudi Arabia
BR	Brazil	KR	Republic of Korea	RS	Serbia
BZ	Belize	LA	Lao People's Democratic Republic	SC	Seychelles
CA	Canada			SG	Singapore
CL	Chile			SV	El Salvador
CN	China	LC	Saint Lucia	SY	Syrian Arab Republic
CO	Colombia	LK	Sri Lanka		
CR	Costa Rica	LR	Liberia	TH	Thailand
CU	Cuba	LY	Libya	TN	Tunisia
DM	Dominica	▼ MA	Morocco	TT	Trinidad and Tobago
DO	Dominican Republic	MD	Republic of Moldova	UA	Ukraine
DZ	Algeria			US	United States of America
EC	Ecuador	❖ ME	Montenegro		
EG	Egypt	MG	Madagascar	UZ	Uzbekistan
GD	Grenada	MN	Mongolia	VC	Saint Vincent and the Grenadines
GE	Georgia	MX	Mexico		
GT	Guatemala	MY	Malaysia	VN	Viet Nam
HN	Honduras	NG	Nigeria	ZA	South Africa
ID	Indonesia	NI	Nicaragua		
IL	Israel				

❖ Extension of European patent possible

▼ Validation of EP patent in Morocco will be possible upon payment of a fee for IA's filed on or after 1 March 2015

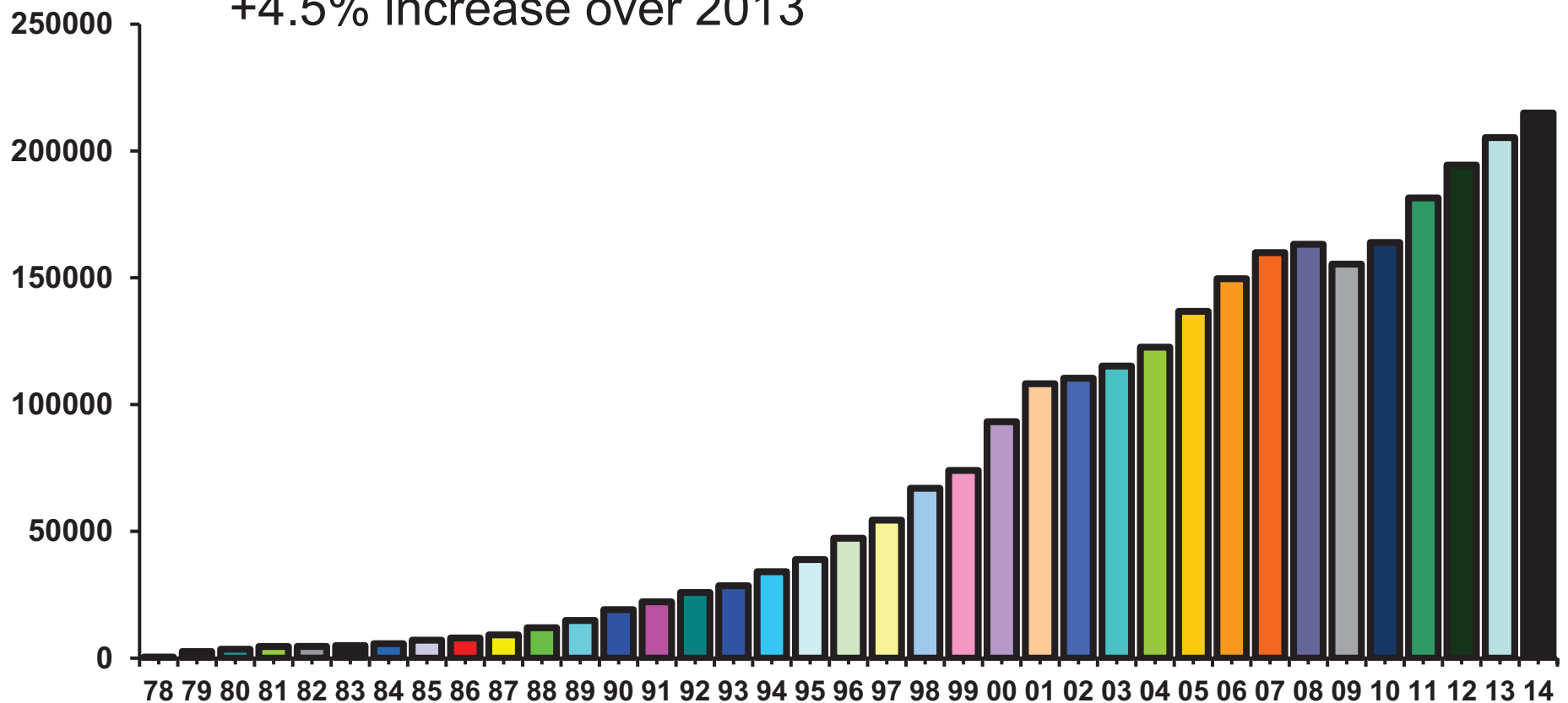
Countries that are not PCT Contracting States

Afghanistan	Haiti	Palau
Andorra	Iraq	Paraguay
Argentina	Jamaica	Samoa
Bahamas	Jordan	Solomon Islands
Bangladesh	Kiribati	Somalia
Bhutan	Kuwait	South Sudan
Bolivia	Lebanon	Suriname
Burundi	Maldives	Taiwan*
Cambodia	Marshall Islands	Timor-Leste
Cape Verde	Mauritius	Tonga
Democratic Republic of Congo	Micronesia	Tuvalu
Djibouti	Myanmar	Uruguay
Eritrea	Nauru	Vanuatu
Ethiopia	Nepal	Venezuela
Fiji	Pakistan	Yemen
Guyana		

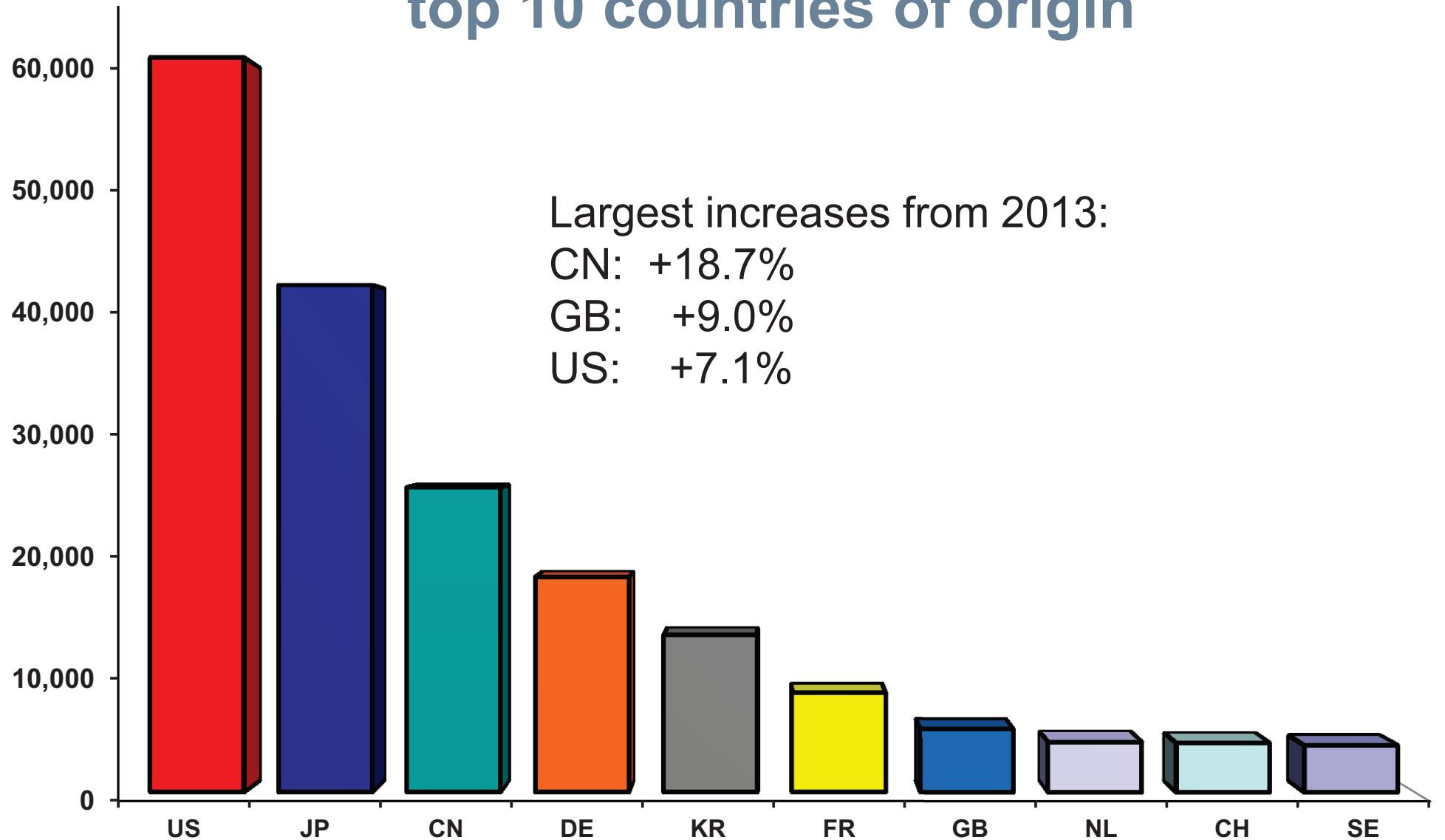
* The United Nations considers Taiwan to be a province of China

PCT filing statistics 1978 - 2014

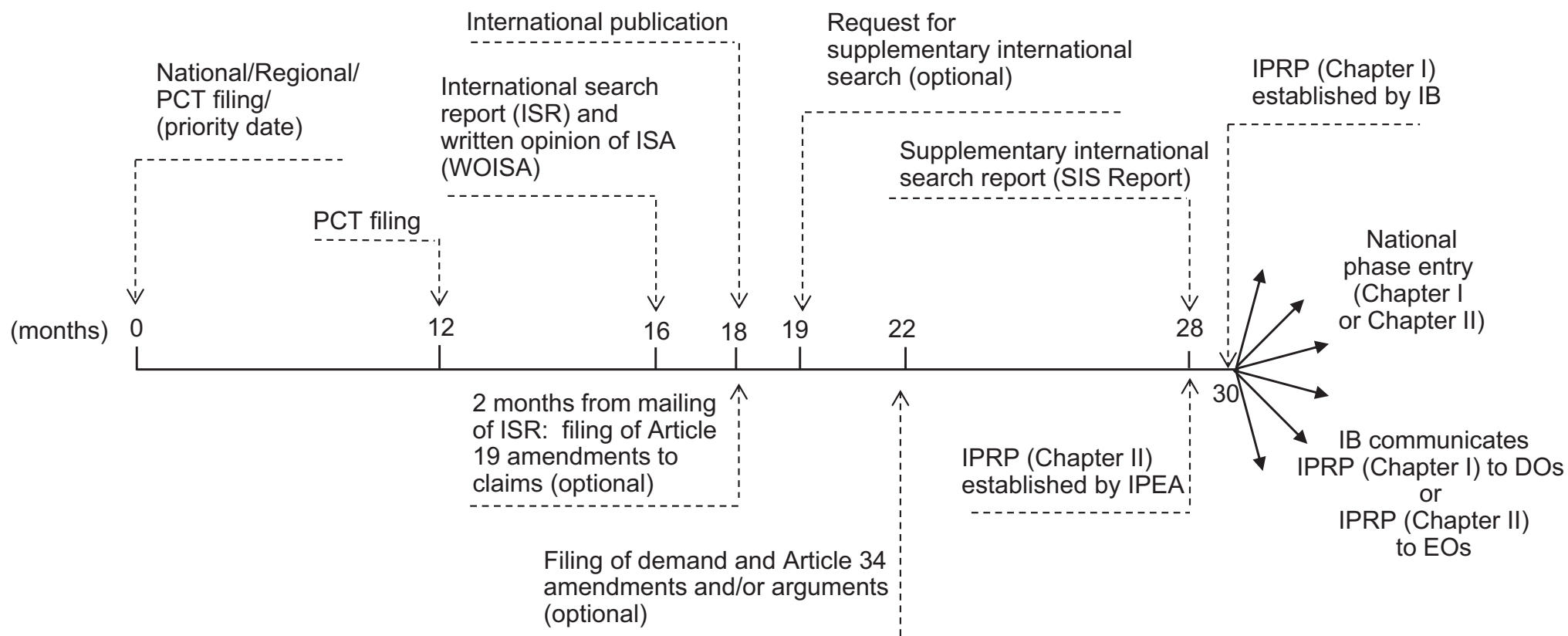
~215,000 PCT applications filed
+4.5% increase over 2013



PCT applications 2014 top 10 countries of origin



PCT timeline



Note: The national Offices of the following States have notified the International Bureau that they will not apply the 30 month time limit under Chapter I, as of 1 April 2002, for as long as modified Article 22(1) is not compatible with their national law:

LU	Luxembourg
TZ	United Republic of Tanzania
UG	Uganda

If no demand is filed before the expiration of 19 months, the national phase will have to be entered before the expiration of 20 months (LU) or 21 months (TZ & UG) from the priority date. This reservation to the modified Article 22(1) timing does not apply when seeking patent protection in these countries via the EPO (LU) or ARIPO (TZ & UG).

Minimum requirements to file an international application (Article 11(1))

- At least one applicant must be a national or resident of a PCT Contracting State
- The application must be in a prescribed language
- The application must contain at least:
 - an indication that it is intended as an international application (Rule 4.2)
 - a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
 - the name of the applicant (Rule 4.5)
 - a description (Rule 5)
 - a claim (Rule 6)

Competent receiving Office (RO)

- In order for a RO to be competent to accord an international filing date
 - ☐ at least one of the applicants must have the right to file with the RO for reasons of nationality or residence and
 - ☐ the application must be in a language accepted by the RO
- Note that if:
 - ☐ at least one of the applicants is a resident or national of a PCT Contracting State but none of the applicants have the right to file with the RO for reasons of residence or nationality or
 - ☐ the application is filed in a language not accepted by the RO for that purpose

that Office will transmit the application to the receiving Office of the International Bureau (RO/IB) for further processing upon payment of a fee equal to the transmittal fee

Not required for obtaining an international filing date

- Payment of fees
- Translation into language of search or publication
- Applicant's signature
- Title of the invention
- Abstract
- Drawings, whether formal or not
 - however, attention should be given to the question of whether the drawings are necessary for the understanding of the invention;
 - later furnishing of drawings will, under certain conditions, result in a change of the international filing date (see Article 14(2) and Rule 20.5)

Concept and operation of designation system

- The Treaty requires the designation of at least one Contracting State at the time of filing the international application
 - all States bound by the Treaty as of the international filing date are now automatically designated by the filing of the request form
 - exception to the all-inclusive designation is possible for DE, JP and KR, that is, countries with rules on “self-designation”
 - but only if the international application contains a priority claim to an earlier application filed in the State that is to be excluded (see Annex B1 of the PCT Applicant’s Guide for DE, JP and KR)
 - otherwise withdrawals of designations are possible
- Choice of type of protection is postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- PCT request form may include specific reference to earlier to “parent” application for continuation or CIP applications

The PCT applicant

- The applicant may be any natural person or legal entity, for example, the assignee or the inventor
- It is possible to indicate
 - different applicants for different designated States
 - multiple applicants for any given State
- The America Invents Act expanded who may qualify to be an applicant for the purposes of the US designation to include:
 - the inventor(s)
 - legal representative of a deceased or legally incapacitated inventor
 - assignee
 - obligated assignee
 - party with proprietary interest in the matter

Naming inventors as applicants to file in RO/US

- Where an applicant, e.g., a legal entity, is neither a US national or US resident, it is acceptable to the USPTO to continue to name an inventor who is US national or resident as
 - ❑ “applicant and inventor” and
 - ❑ applicant for the purposes of the US designation only
 - ❑ in this situation the RO/US is competent to accord an IFD
- Some practitioners request the IB to record a change from “applicant and inventor” to “inventor only” under PCT Rule 92*bis* before 30 months

Applicant of convenience

- How can the USPTO be competent to act as a receiving Office for an international application where the applicant
 - ❑ is neither a national or resident of a PCT Contracting State, e.g., a Taiwanese company or
 - ❑ is not entitled to file in RO/US by reasons of nationality or residence, e.g., a Canadian company
 - and
 - ❑ none of the inventors is a US national or resident
- Name someone who is a US national or resident as
 - ❑ “applicant only” and
 - ❑ co-applicant only for the purposes of a PCT Contracting State of very low commercial importance to the main applicant
- Some who use this practice prepare a document signed by the main applicant that assigns a small portion of the rights to invention for that State to the co-applicant

A**PCT Contracting States¹****A**

Name of State followed by the two-letter code	Date on which State became bound by the PCT ¹	Name of State followed by the two-letter code	Date on which State became bound by the PCT ¹
Albania AL	4 October 1995	France FR ^{2,6}	25 February 1978
Algeria DZ ²	8 March 2000	Gabon GA	24 January 1978
Angola AO	27 December 2007	Gambia GM	9 December 1997
Antigua and Barbuda AG	17 March 2000	Georgia GE ²	25 December 1991
Armenia AM ²	25 December 1991	Germany DE	24 January 1978
Australia AU	31 March 1980	Ghana GH	26 February 1997
Austria AT	23 April 1979	Greece GR	9 October 1990
Azerbaijan AZ	25 December 1995	Grenada GD	22 September 1998
Bahrain BH ²	18 March 2007	Guatemala GT	14 October 2006
Barbados BB	12 March 1985	Guinea GN	27 May 1991
Belarus BY ²	25 December 1991	Guinea-Bissau GW	12 December 1997
Belgium BE	14 December 1981	Honduras HN	20 June 2006
Belize BZ	17 June 2000	Hungary HU ²	27 June 1980
Benin BJ	26 February 1987	Iceland IS	23 March 1995
Bosnia and Herzegovina BA	7 September 1996	India IN ²	7 December 1998
Botswana BW	30 October 2003	Indonesia ID ²	5 September 1997
Brazil BR	9 April 1978	Iran (Islamic Republic of) IR	4 October 2013
Brunei Darussalam BN	24 July 2012	Ireland IE	1 August 1992
Bulgaria BG	21 May 1984	Israel IL	1 June 1996
Burkina Faso BF	21 March 1989	Italy IT	28 March 1985
Cameroon CM	24 January 1978	Japan JP	1 October 1978
Canada CA	2 January 1990	Kazakhstan KZ ²	25 December 1991
Central African Republic CF	24 January 1978	Kenya KE	8 June 1994
Chad TD	24 January 1978	Kyrgyzstan KG ²	25 December 1991
Chile CL ²	2 June 2009	Lao People's Democratic Republic LA	14 June 2006
China CN ^{3,4}	1 January 1994	Latvia LV	7 September 1993
Colombia CO	28 February 2001	Lesotho LS	21 October 1995
Comoros KM	3 April 2005	Liberia LR	27 August 1994
Congo CG	24 January 1978	Libya LY	15 September 2005
Costa Rica CR	3 August 1999	Liechtenstein LI	19 March 1980
Côte d'Ivoire CI	30 April 1991	Lithuania LT	5 July 1994
Croatia HR	1 July 1998	Luxembourg LU	30 April 1978
Cuba CU ²	16 July 1996	Madagascar MG	24 January 1978
Cyprus CY	1 April 1998	Malawi MW	24 January 1978
Czech Republic CZ	1 January 1993	Malaysia MY ²	16 August 2006
Democratic People's Republic of Korea KP	8 July 1980	Mali ML	19 October 1984
Denmark DK	1 December 1978	Malta MT ²	1 March 2007
Dominica DM	7 August 1999	Mauritania MR	13 April 1983
Dominican Republic DO	28 May 2007	Mexico MX	1 January 1995
Ecuador EC	7 May 2001	Monaco MC	22 June 1979
Egypt EG	6 September 2003	Mongolia MN	27 May 1991
El Salvador SV	17 August 2006	Montenegro ME	3 June 2006
Equatorial Guinea GQ	17 July 2001	Morocco MA	8 October 1999
Estonia EE	24 August 1994	Mozambique MZ ²	18 May 2000
Finland FI ⁵	1 October 1980	Namibia NA	1 January 2004

[Continued on next page]

(4 October 2013)

A**PCT Contracting States¹****A***[Continued]*

Name of State followed by the two-letter code	Date on which State became bound by the PCT ¹	Name of State followed by the two-letter code	Date on which State became bound by the PCT ¹
Netherlands NL ⁷	10 July 1979	Slovakia SK	1 January 1993
New Zealand NZ	1 December 1992	Slovenia SI	1 March 1994
Nicaragua NI	6 March 2003	South Africa ZA ²	16 March 1999
Niger NE	21 March 1993	Spain ES	16 November 1989
Nigeria NG	8 May 2005	Sri Lanka LK	26 February 1982
Norway NO ⁵	1 January 1980	Sudan SD	16 April 1984
Oman OM ²	26 October 2001	Swaziland SZ	20 September 1994
Panama PA	7 September 2012	Sweden SE ⁵	17 May 1978
Papua New Guinea PG	14 June 2003	Switzerland CH	24 January 1978
Peru PE	6 June 2009	Syrian Arab Republic SY	26 June 2003
Philippines PH	17 August 2001	Tajikistan TJ ²	25 December 1991
Poland PL ⁵	25 December 1990	Thailand TH ²	24 December 2009
Portugal PT	24 November 1992	The former Yugoslav Republic of Macedonia MK	10 August 1995
Qatar QA ²	3 August 2011	Togo TG	24 January 1978
Republic of Korea KR	10 August 1984	Trinidad and Tobago TT	10 March 1994
Republic of Moldova MD ²	25 December 1991	Tunisia TN ²	10 December 2001
Romania RO ²	23 July 1979	Turkey TR	1 January 1996
Russian Federation RU ²	29 March 1978 ⁸	Turkmenistan TM ²	25 December 1991
Rwanda RW	31 August 2011	Uganda UG	9 February 1995
Saint Kitts and Nevis KN	27 October 2005	Ukraine UA ²	25 December 1991
Saint Lucia LC ²	30 August 1996	United Arab Emirates AE	10 March 1999
Saint Vincent and the Grenadines VC ²	6 August 2002	United Kingdom GB ¹⁰	24 January 1978
San Marino SM	14 December 2004	United Republic of Tanzania TZ	14 September 1999
Sao Tome and Principe ST	3 July 2008	United States of America US ^{11, 12}	24 January 1978
Saudi Arabia SA	3 August 2013	Uzbekistan UZ ²	25 December 1991
Senegal SN	24 January 1978	Viet Nam VN	10 March 1993
Serbia RS ⁹	1 February 1997	Zambia ZM	15 November 2001
Seychelles SC	7 November 2002	Zimbabwe ZW	11 June 1997
Sierra Leone SL	17 June 1997		
Singapore SG	23 February 1995		

(Total: 148 States)

¹ All PCT Contracting States are bound by Chapter II of the PCT relating to the international preliminary examination.² With the declaration provided for in PCT Article 64(5).³ Applies also to Hong Kong, China with effect from 1 July 1997.⁴ Not applicable to Macau, China.⁵ With the declaration provided for in PCT Article 64(2)(a)(ii).⁶ Including all Overseas Departments and Territories.⁷ Ratification for the Kingdom in Europe, the Netherlands Antilles and Aruba. The Netherlands Antilles ceased to exist on 10 October 2010. As from that date, the PCT continues to apply to Curaçao and Sint Maarten. The PCT also continues to apply to the islands of Bonaire, Sint Eustatius and Saba which, with effect from 10 October 2010, have become part of the territory of the Kingdom of the Netherlands in Europe.⁸ Date of ratification of the Soviet Union, continued by the Russian Federation as from 25 December 1991.⁹ Serbia is the continuing State from Serbia and Montenegro as from 3 June 2006.¹⁰ The United Kingdom extended the application of the PCT to the Isle of Man with effect from 29 October 1983.¹¹ With the declarations provided for in PCT Articles 64(3)(a) and 64(4)(a).¹² Extends to all areas for which the United States of America has international responsibility.

Pros & Cons of Using RO/US and RO/IB

A reminder that you should be e-filing

SM

And should create your Request in
PCT-SAFE File Manager or ePCT

e-filing path for RO/US:
Create zip file Request in PCT-SAFE FM
Upload zip file to EFS-Web
e-file in EFS-Web

e-filing path for RO/IB:
E-file in PCT-SAFE FM or in ePCT

Alexandria or Geneva?

■ Fax for IA Filing (not a Best Practice)

■ RO/US: No

■ RO/IB: Yes, with a hard copy filed within 14 days

■ Express Mail provisions (not a Best Practice)

■ RO/US: Yes but \$400 penalty

■ RO/IB: No, filing date will be actual date of receipt at the RO/IB

■ E-Filing

■ RO/US: EFS-Web by midnight in Alexandria (now 99.6%)

■ RO/IB: PCT SAFE or ePCT by six (or so) hours earlier

■ Filing fee reductions for e-filing

■ RO/US:

- \$104 – e-filed (EFS-Web) but the Request is not a zip file
- \$208 – e-filed (EFS-Web) and the request is a zip file (***Best Practice***)
- And note that when you e-file you avoid a penalty of \$400 or \$200

RO/IB:

\$208 – e-filed (PCT-SAFE FM or ePCT) but the application is not XML

\$312 – e-filed (PCT-SAFE FM or ePCT) and the application is XML

Transmittal Fee

■ RO/US: \$240, but:

- \$120 if filing as a small entity
- \$60 if filing as a micro-entity

■ RO/IB: \$104

Alexandria or Geneva?

■ Restoration of the Right of Priority

- RO/US: unintentional criterion only

- RO/IB: in spite of due care or unintentional criterion (important for later filings in AM, BH, BW, CH, CR, DK, EE, EG, EP, ES, FI, GT, HR, HU, IL, IS, JP, LT, NZ, PE, PL, PT, RS, RU, SE, SK)

■ Fee for Requesting Restoration of the Right of Priority

- RO/US: \$1,700

 - \$850 if filing as a small entity or micro-entity

- RO/IB: None

- IF YOU NEED TO RESTORE PRIORITY, THINK RO/IB

Alexandria or Geneva?

■ Languages Accepted

■ RO/US: English

■ RO/IB: Any language, but

- If the language is not accepted by the ISA, the applicant will have to furnish a translation. If the language is not a language of publication, the applicant will have to furnish a translation of the application into one of the languages of publication.

■ ISA Choices

■ RO/US: AU, EP, IL, JP, KR, RU, US

■ RO/IB: For a US filer, RO/IB offers at least as many choices as RO/US, but may have additional choices depending on whether there is any non-US nationality or residence among the applicants

Alexandria or Geneva?

■ Certified copies of US priority documents

- RO/US: very easy – you just check a box in the Request

- RO/IB: you can use WIPO's DAS system

- Either approach is free of charge

■ Foreign Filing License

- RO/US: RO/US reviews the IA and grants a foreign filing license before the record copy is sent to IB

- RO/IB: If the invention was made in the US, then you must obtain a foreign filing license before filing the IA with the RO/IB (you might already have an FFL because of the priority application)

Alexandria or Geneva?

- Processing Time for Initial Review is roughly comparable as between RO/US and RO/IB
- Time Difference
 - RO/US: Eastern time zone
 - RO/IB: Central European time zone (often six hours earlier)

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



America Invents Act (AIA) Implications on PCT Practice

**Michael Neas
Deputy Director
International Patent Legal Administration**

UNITED STATES
PATENT AND TRADEMARK OFFICE



Applicants for U.S. Patent Applications

- Persons qualified to be an applicant has been **expanded** by 35 U.S.C. 118 as amended by the AIA
 - inventors are no longer the only possible applicants
 - applicants may be persons:
 - to whom the inventor has assigned
 - to whom the inventor is under an obligation to assign
 - who otherwise shows sufficient propriety interest in the matter
 - applies to U.S. patent applications filed under 35 U.S.C. 111 or 363 on or after 16 Sep 2012
 - includes applications filed under 35 U.S.C. 371 that originate from an international application having an international filing date on or after 16 Sep 2012



Establishment of Micro Entity

- §10(b) of the AIA
 - authorizes the Director of the USPTO to set or adjust patent fees for micro entities
- §11(g) of the AIA
 - defines micro entity status
 - see page 75033 at:
 - http://www.uspto.gov/sites/default/files/aia_implementation/77fr75019.pdf
 - effective 19 March 2013
 - reduction of 75% in most domestic fees for qualifying applicants
 - effective 01 January 2014
 - international fees set by USPTO have small/micro amounts
 - see page 4212 at:
 - <http://www.gpo.gov/fdsys/pkg/FR-2013-01-18/pdf/2013-00819.pdf>

Micro Entity Qualifications

- AIA defines two ways to qualify as micro entity
 - Gross Income Basis
 - Institution of Higher Education Basis



Claiming Micro Entity Status

- A claim for micro entity status requires
 - a certification of entitlement to micro entity status
 - Office forms are available
 - PTO/SB/15A (Gross Income Basis)
 - PTO/SB/15B (Institution of Higher Education Basis)
- A proper certification must be made prior to or with payment of a micro entity fee
- Entitlement to micro entity status must be evaluated when paying any micro entity fee



AIA & International Stage



Applicants for PCT Applications - International Stage (1)

- For international applications with a filing date on/after 16 Sept 2012
 - an applicant for the **purposes of the United States** may be
 - inventor
 - legal representative of deceased or legally incapacitated inventor
 - assignee
 - obligated assignee
 - person who otherwise shows proprietary interest
 - proof of proprietary interest will be required in the national stage
- **Example:** Inventor X assigns all rights in the invention to Assignee Y. Assignee Y may be indicated on the PCT Request form (Box II) as an applicant for “**all designated States**” and Inventor X indicated (in Box III) as “**inventor only**”

Applicants for PCT Applications - International Stage (2)

- Change to 35 U.S.C. 118 allowed the PCT Request Form to be simplified

Box No. I TITLE OF INVENTION	
PROCESS FOR FOLDING WRAPPING PAPER FOR CHOCOLATES	
Box No. II APPLICANT ☐ This person is also inventor	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i> CANDY WRAP UNLIMITED, INC. 300 Colorado Street Baltimore, Maryland 21201-4307 United States of America	Telephone No. (+1-301) 876-5432 Facsimile No. (+1-301) 876-5555 Applicant's registration No. with the Office
E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so. ☐ as advance copies followed by paper notifications; or ☒ exclusively in electronic form (no paper notifications will be sent). E-mail address: candy@anumma.com	
State <i>(that is, country)</i> of nationality: US	State <i>(that is, country)</i> of residence: US
This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box	

Applicants for PCT Applications - International Stage (3)

Sheet No. ...2...	
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S) <i>If none of the following sub-boxes is used, this sheet should not be included in the request.</i>	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i> JONES, Mary 1600 South Eads Street Arlington, Virginia 22202-2913 United States of America	This person is: ☐ applicant only ☐ applicant and inventor ☒ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	
State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
This person is applicant for the purposes of: ☐ all designated States ☐ the States indicated in the Supplemental Box	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i>	

Important Practice Tips

- If naming a non-inventor applicant as applicant for “all designated States”
 - review residence and nationality of the applicant(s) because residence/nationality of the applicant(s), not the inventor(s), is used to determine
 - the competence of the receiving office (RO/US)
 - whether a U.S. practitioner may be appointed to represent the applicant
 - whether an applicant is entitled to file international application under the PCT



International Stage Fees (1)

International Application Fees (Chapter I)				
DESCRIPTION	Regular	Small entity	Micro entity	Fee Code
Transmittal Fee	\$ 240	\$ 120*	\$ 60	1601/2601/3601
Fee for Transmitting IA to the International Bureau to Act as Receiving Office	\$ 240	\$ 120	\$ 60	1621/2621/3621
United States Patent and Trademark Office (USPTO) as International Searching Authority (ISA)	\$ 2080	\$ 1040**	\$ 520	1602/2602/3602
Supplemental search fee, per additional invention (payable only upon invitation)	\$ 2080	\$ 1040	\$ 520	1604/2604/3604
Non-electronic filing fee (additional fee for applications filed in paper)	\$ 400	\$ 200	\$ 200	1609/2690

* Payment in the small entity amount is treated as a written assertion of small entity status.

** Payment in the small entity amount is treated as a written assertion of small entity status **only** when filing in an RO other than US.

See 37 CFR 1.27(c)(3).



International Stage Fees (2)

International Application Fees (Chapter II, optional)				
DESCRIPTION	Regular	Small entity	Micro entity	Fee Code
USPTO as International Preliminary Examining Authority (IPEA) where USPTO was ISA	\$ 600	\$ 300	\$ 150	1605/2605/3605
USPTO as International Preliminary Examining Authority (IPEA) where USPTO was not ISA	\$ 760	\$ 380	\$ 190	1606/2606/3606
Additional examination fee, per additional invention (payable only upon invitation)	\$ 600	\$ 300	\$ 150	1607/2607/3607



AIA & U. S. National Stage



Applicants for 35 U.S.C. 371 National Stage Applications (1)

- Applicants for 35 U.S.C. 371 applications of IA having an **international filing date** on or after 16 Sept 2012
 - will be those applicants identified in the international stage for the United States
 - unless changed in the national stage (37 CFR 1.46(c))
 - for a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including
 - the fee set forth in 37 CFR 1.17(g)
 - a showing that such person has sufficient proprietary interest and
 - a statement that making the application is appropriate to preserve the rights of the parties (37 CFR 1.46(b)(2))



Applicants for 35 U.S.C. 371 National Stage Applications (2)

- Once an applicant has been specified, under 37 CFR 1.46(b)
 - any request to correct or update the name of an applicant must
 - include an ADS, or amended ADS, specifying the corrected or updated name in the applicant information section (37 CFR 1.76(b)(7))
 - any request to change the applicant must
 - include an ADS specifying the applicant in the applicant information section (§1.76(b)(7)), and
 - comply with 37 CFR 3.71 and 3.73



Inventorship in 35 U.S.C. 371 National Stage Applications (1)

- Inventorship in a §371 application of IA having an **international filing date** (IFD) on or after 16 Sep 2012 (37 CFR 1.41(e))
 - Will be taken from the ADS
 - if a **signed** ADS is included **with the initial §371 submission**
 - otherwise, inventorship will be that set forth in the international stage
 - including any change effected under PCT Rule 92*bis*



Inventorship in 35 U.S.C. 371 National Stage Applications (2)

- Correction of inventorship and/or an inventor's name
 - has been simplified under 37 CFR 1.48
 - request under §1.48 need only include
 - an ADS, or amended ADS, and
 - a processing fee (37 CFR 1.17(i))
 - an inventor's oath or declaration will be required for each actual inventor who has not yet executed such oath or declaration



Inventor's Oath or Declaration (1)

- 35 U.S.C. 115 as amended by the AIA
 - still requires that the inventors execute an oath or declaration
 - except as otherwise provided
 - now requires statements that
 - the application was made by or authorized to be made by the affiant or declarant
 - the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention
 - Any willful false statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both



Inventor's Oath or Declaration (2)

- 35 U.S.C. 115 as amended by the AIA (*continued*)
 - no longer requires the following statements
 - citizenship
 - that the inventor believes himself or herself to be the “first” inventor of the subject matter
 - “duty to disclose”
 - “reviewed and understands”
 - “true or believed to be true”



Substitute Statements

- Where an inventor's signature cannot be obtained on a declaration, a substitute statement may be executed with respect to that inventor (37 CFR 1.64)
 - can be submitted where the inventor is
 - deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute
 - divergent from old 37 CFR 1.42, §1.43, and §1.47 practice
 - no petition is required to execute the substitute statement
 - the Office has created a new PTO form for this purpose
 - PTO/AIA/02



Assignment-Statement (1)

- An assignment may serve as the inventor's oath or declaration ("assignment-statement")
 - where it contains the required information and statements
 - no PTO form has been provided for this purpose
 - no surcharge will be assessed for a late declaration where
 - an application is filed via EFS-Web, and
 - the assignment-statement is filed for the application number received in EFS-Web via the EPAS system on same day



Assignment-Statement (2)

- For proper recordation of the assignment-statement
 - application number must be on the EPAS cover sheet
 - not the executed assignment-statement
 - the box in EPAS must be checked so that a copy of the assignment-statement will be placed in the application file
 - the assignment-statement must identify the application in some way
 - *e.g.*, name of inventors, attorney docket number or title of the invention on the SPEC as filed



Important Practice Tips

- Include a signed ADS with the initial §371 submission
 - if inventorship has changed and
 - to indicate the relationship, *i.e.*, continuation, CIP, etc., to any non-provisional US application to which benefit was claimed in the international application
 - if not in the Request or first page of the international publication
- Applicability of the AIA is
 - determined by the international filing date
 - **NOT** the date the 371 submission is filed



Questions?

Michael Neas
Deputy Director, International Patent Legal Administration
Michael.Neas@uspto.gov

PCT Help Desk
(571) 272-4300
Monday – Friday 8:30am – 5:00pm ET

UNITED STATES
PATENT AND TRADEMARK OFFICE





AIA strategies for PCT filers

Figuring out whether to "check the box"

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

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.



NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.



Should you check the box?

How do you know whether or not to “check the box”?

- That is not the question!
- The question is, how may I proceed in such a way that years from now in litigation, the infringer will be unable to claim that I got it wrong
- It is in the best interests of the client if I proceed in such a way that years from now in litigation, the infringer will be unable to claim that I got it wrong

How do you know whether or not to “check the box”?

- The related question is, how may I proceed in such a way that years from now, the client will be unable to claim that I got it wrong
- It is in my own best interest to minimize the risk that the client will be able to claim that I got it wrong

“old” versus “new” section 102

- The question whether a particular patent application is better off under “old” 102 or “new” 102 is extremely fact-dependent and extremely fact-specific
- It is impossible to state in any general way that all patent applications are better off under one of the 102's or the other of the 102's
- But recall that many patent practitioners pulled all-nighters in the weeks leading up to March 16, wanting to preserve the ability to get “old” 102 if desired

A one-way door

- If you have an application that is subject to the “new” 102, it is impossible to change it so that the “old” 102 applies instead of the “new” 102
- On the other hand, if you have an application that is subject to the “old” 102, you can effortlessly change it so that the “new” 102 applies instead of the “old” 102
- Note that it is the ***entire application***, not any particular claim, that is subject to one 102 or the other

How does the Examiner know which 102 applies to a particular application?

14/007,121 Intravitreal Injection Device									
Select New Case	Applications with Status Changes	Application Data	Transaction History	Image File Wrapper	Continuity Data	Fees	Published Documents	Address & Attorney/Agent	Assignments
Bibliographic Data									
Application Number:	14/007,121					Correspondence Address Customer Number:	168		
Filing or 371 (c) Date:	12-10-2013					Status:	Nor		
Application Type:	Utility					Status Date:	06-		
Examiner Name:	HALL, DEANNA K					Location: 	ELE		
Group Art Unit:	3763					Location Date:	-		
Confirmation Number:	7975					Earliest Publication No:	US		
Attorney Docket Number:	11UMC003					Earliest Publication Date:	03-		
Class / Subclass:	604/506					Patent Number:	-		
First Named Inventor:	Chetan Rasiklal Soni , Springfield, MO (US) all inventors					Issue Date of Patent:	-		
First Named Applicant:	-					International Registration Number (Hague):	-		
Entity Status:	Small					International Registration Publication Date:	-		
AIA (First Inventor to File):	No								
Title of Invention: Intravitreal Injection Device									

Contains, or ever contained ...

- There are two very easy fact patterns
 - Easy case #1 – Application was filed prior to March 16, 2013
 - Easy case #2 – Application was filed on or after March 16, 2013 and has no priority or domestic benefit claim to a date prior to March 16, 2013

In either of these fact patterns it is clear and unambiguous as to whether the application contains or ever contained a claim with an effective filing date on or after March 16, 2013

- It is clear now and it will be clear in litigation

Now the difficult case

- The difficult case is an application filed on or after March 16, 2013 ... that claims priority or domestic benefit to an application filed before March 16, 2013
- USPTO calls this a “transition application”
- In such a case, the USPTO wants the Examiner to follow some simple mechanical rule
- The simple mechanical rule for the Examiner is to look at that field in Palm (PAIR)
- Which in turn is based on whether you “checked the box”

New matter in a case filed on or after March 16, 2013

- Suppose you file a CIP (meaning it contains new matter as compared to the priority application or domestic benefit parent)
- For example a US national phase from a PCT/CIP
- Does this mean you need to check the box?
- No!
- You need to check the box only if a claim *claims* some of that new matter (or if a claim once claimed some of that new matter)

Best practices

- PCT application filed before March 16, 2013
- Now you are entering the US national stage
- You are on safe ground if you did not check the box
- It is safe ground regardless of what amendments you may make whilst entering the US national phase
- This could easily happen until September 15, 2015

Best practices

- PCT application filed before March 16, 2013
- Now you are filing a bypass continuation instead of entering the US national stage
- Best practice is to file an ***exact copy*** of the PCT application as your bypass continuation
- Then wait at least one day, and only then file a preliminary amendment with your changes
- If the Examiner later decides the amendment contains new matter, then you will cancel the new matter and you will be under the old 102
- This could easily happen until September 15, 2015

Difficult fact patterns

- Provisional application or priority application filed before March 16, 2013
- PCT is filed on or after March 16, 2013
- You are pretty sure that all claims are fully supported by the provisional
- Now you are getting ready to enter US national phase, or file a bypass continuation
- Can you confidently not check the box?
- Is there anything you can do to reduce the risks?
- Note that this could easily happen until September 15, 2015

Scenario from the listserv

- PCT application filed prior to March 16, 2013. US national phase is entered.
- No need to have checked the box or to have avoided checking the box, because no statement was needed one way or the other
- Old 102 applies
- Now we are filing an amendment
- Suppose the Examiner ***refuses to enter it*** saying it's new matter. Will we now be subject to the new 102?
- Answer: no. If the Examiner refuses to enter it, then it was never in the application. Old 102 still applies.

When September 16, 2015 arrives ...

Priority application filed on or after March 16,
2013

30 months is September 16, 2015

National phase filed on or after September 16,
2015 will not require any decision as to whether or
not to check the box

But even after September 16, 2015 ...

You have a pending case that is a national phase
of a PCT filed before March 16, 2013 ...

Maybe long after September 16, 2015, the need
arises to file a continuation or divisional ...

You will still need to worry about whether or not to
“check the box”

But even after September 16, 2015 ...

You have a pending case that is a national phase of a PCT filed on or after March 16, 2013, that claims priority from an application filed before March 16, 2013 ...

Maybe long after September 16, 2015, the need arises to file a continuation or divisional ...

You will still need to worry about whether or not to “check the box”

Trap for the unwary

- US continuation or divisional or bypass is being filed now
- Parent was filed prior to March 16, 2013
- The trap for the unwary is to file the preliminary amendment ***on the same day*** as the continuation or divisional
- Years from now the infringer will claim that the PA contained new matter, and that the case was thus really a CIP, and thus the new 102 applies
- It would have been smarter to delay the PA by at least one day

Signature Requirements, Agents, Common Representatives, Withdrawals, Recording Changes and Provisional Protection

Carol Bidwell
July 2015

Signature of the international application (Rules 4.15, 26.2bis(a))

- In principle, the request must be signed by all persons (legal entity or natural persons) indicated as “applicant” and “applicant and inventor”
 - a person named on the request as “inventor only” does not need to sign the request
 - so long as the request is signed by one of the applicants, the lack of signature of the other applicants will not be considered a defect
- If the request is only signed by an agent, a separate power of attorney signed by all applicants must be filed (either an original power of attorney or copy of a general power of attorney) unless the receiving Office has waived the requirement

Waiver of power of attorney requirement (Rules 90.4(d) and 90.5(c))

- An RO, ISA, IPEA and the IB may waive the requirement that
 - ❑ a separate power of attorney and/or
 - ❑ a copy of a general power of attorneymust be furnished
- All Offices and Authorities may nevertheless require that a power of attorney has to be furnished in particular instances even if it has waived the requirement in general
- Information as to whether an Office or Authority has made such a waiver is available on the WIPO Internet site

Signing on behalf of legal entities

- The RO/US accepts the signature of an authorized officer of a legal entity, for example, President, Vice President, Secretary, Treasurer, etc., as someone having the apparent authority to sign the request
- The RO/US also allows someone without apparent authority to make a self-certifying statement as to their entitlement to sign the request on behalf of the legal entity
 - see MPEP Section 1820 for additional information
- A legal representative may sign the request
 - if the applicant is a natural person who is deceased or legally incapacitated
 - if the applicant is a bankrupt company

Agents and common representatives

■ Who can act as agent?

- ☐ any person (attorney, patent agent, etc.) who has the right to practice before the RO can act as agent and automatically has the right to practice before the IB, ISA and IPEA
- ☐ an agent who has the right to practice before the ISA and/or IPEA can be appointed specifically for the purposes of the procedure before the IB, ISA or IPEA
- ☐ agents may appoint sub-agents

■ Who can act as common representative?

- ☐ one of the applicants who is entitled to file an international application (that is, who is a resident or national of a PCT Contracting State) may be appointed by all the other applicants to act on the application

Address for correspondence

- Where no agent or common representative is being appointed either
 - ☐ on the request form or
 - ☐ on a power of attorney or copy of a general power of attorney submitted together with the request forman address for correspondence may be indicated in Box IV of the request form
- If an international application is transmitted to RO/IB under Rule 19.4(a)(i) because none of the applicants is indicated as a resident or national of the country where the IA was filed,
 - ☐ RO/IB will change *ex officio* the indication of “agent” to “address for correspondence”
- PCT forms will be sent to the address for correspondence
 - ☐ any responses or other papers will need to be signed by one of the applicants

Withdrawals under Chapter I and Chapter II (1)

- Chapter I: international application, designations, priority claim
- Chapter II: in addition to those listed above, the demand and elections
- When
 - ☐ before the expiration of 30 months from the priority date
- How
 - ☐ by a notice of withdrawal (form PCT/IB/372 recommended)
 - signed by all applicants, their appointed agent or appointed common representative
 - in Chapter I: filed with the RO or IB
 - in Chapter II:
 - filed with the RO, IB or IPEA to withdraw the IA or priority claim
 - filed with IB to withdraw a demand or elections

Withdrawals under Chapter I and Chapter II (2)

■ Effect

- ❑ withdrawal effective upon receipt by the appropriate Authority
- ❑ withdrawal has no effect in DOs/EOs where national processing or examination has already started
- ❑ if notice of withdrawal received by the IB before completion of technical preparations for international publication, there will be no international publication
 - withdrawal can be made conditional on receipt in time to prevent publication
- ❑ withdrawal of priority claim
 - time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal

PATENT COOPERATION TREATY

PCT

NOTICE OF WITHDRAWAL

(PCT Rules 90bis.1, 90bis.2,
90bis.3, 90bis.3bis and 90bis.4)

To:

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

Facsimile No: +41 22 338 82 70

Applicant's or agent's file reference	
International application No.	International filing date (day/month/year)
Applicant	Priority date (day/month/year)

The applicant hereby **withdraws**:

- ☐ the **international application** identified above (Rule 90bis.1) (where the international application is withdrawn, the international processing of the international application will be discontinued (Rule 90bis.6(b)):
- ☐ the withdrawal is made conditional on it being received by the International Bureau in time to prevent international publication
- ☐ the **designations** specified below (Rule 90bis.2) (withdrawal of **all** designated States will be treated as withdrawal of the international application under Rule 90bis.1. In such a case, the check-box "the international application" should preferably be marked instead):
- ☐ the following designation(s):
- ☐ all designations except:
- ☐ the **priority claim(s)** specified below (Rule 90bis.3) (if multiple priorities have been claimed, this notice relates to the following priority claim(s)) (withdrawal of the earliest priority claim will result in the re-calculation of time limits which have not already expired (Rule 90bis.3(d))):
- ☐ the withdrawal is made conditional on it being received by the International Bureau in time to prevent international publication
- ☐ the **demand** (Rule 90bis.4) (where the demand is withdrawn, the processing of the international application by the International Preliminary Examining Authority will be discontinued (Rule 90bis.6(c)))
- ☐ the **election(s)** specified below (Rule 90bis.4) (where **all** elections are withdrawn, the processing of the international application by the International Preliminary Examining Authority will be discontinued (Rule 90bis.6(c)). In such a case, the check-box "the demand" should preferably be marked instead):
- ☐ the **supplementary search request** (Rule 90bis.3bis) (where the supplementary search request is withdrawn, the processing of the international application by the Authority(ies) specified for supplementary search will be discontinued (Rule 90bis.6(b-bis)))
_____ (indicate the Authority specified for supplementary search)

ATTENTION Under Rule 90bis.6(a), withdrawal of the international application, of any designation, of any priority claim, of the demand or of any election under Rule 90bis will have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or 40(2).

Signature of applicant(s), agent or common representative (in order for the withdrawal to be effective, the notice of withdrawal must be signed by (all) the applicant(s), their appointed agent or appointed common representative. Where one of the applicants is considered to be the common representative under Rule 90.2(b), all applicants must sign (see Rule 90bis.5)).

Date:

Withdrawal: refund of certain fees by the RO

- If an international application is withdrawn
 - before the record copy is sent to the IB and/or
 - the search copy is sent to the ISA
- the receiving Office will refund the international filing fees and the search fee, respectively
- Refund of these fees also applies where
 - an international application is declared withdrawn by the RO because the requirements of Article 11(1) were not met

Uses of Rule 92*bis* to record various changes

- Change of the name of the applicant
- Change of the address: applicant, agent, inventor
- Change of the nationality or residence of the applicant
- Addition or removal of an applicant/inventor
- Death of an applicant/inventor
- Change of the agent

Request for recording a change under Rule 92bis

- The request must be made in writing
- It may be filed with the IB or the RO
- Generally no evidence of the change is required during the international phase; the designated Offices may, however, require that evidence (for example, assignment) be submitted once the national phase has been entered
- The IB will notify the applicant (using Form PCT/IB/306) that the requested change has been recorded
- The request must reach the International Bureau before the expiration of 30 months from the priority date
Recommendation: use ePCT to file it directly with the International Bureau to ensure that the change is recorded before 30 months
- The IB will record a change affecting multiple pending international applications with a single written request

Request for recording a change under Rule 92bis (cont'd)

- If the request reaches the IB after the expiration of 30 months, the change will not be recorded and the applicant will have to proceed with such request before each designated or elected Office concerned
- If the applicant wishes that a particular change be taken into account for the international publication of the international application, the request for recording of that change must reach the IB before the completion of technical preparations for international publication (normally, 15 days before the actual date of publication)
- If the request for recording of a change reaches the IB too late to be reflected in the international publication, the IB will notify all designated or elected Offices concerned

Recording of a change in the person of the applicant under Rule 92*bis*

- Where the request for recording the change is made by a person not yet named in the PCT Request form (“the new applicant”) without the written consent of the (“old”) applicant, the International Bureau will require that a copy of an assignment or other documentary evidence supporting the change in person be filed with the request for the change
- Where such request is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time
- Where such request is made by the agent of record, the new applicant should sign a power of attorney appointing the agent

Provisional protection

- International publication entitles applicants to provisional protection in the designated States, if such protection is granted for published national applications
 - such protection may be made conditional
 - on the furnishing of a translation (which may be of the claims only)
 - on receipt by the designated Office of a copy of the international application as published under the PCT, and/or
 - in the case of early publication under Article 21(2)(b), on the expiration of 18 months from the priority date
 - for further information on the specific requirements of a given Office, see the *PCT Applicant's Guide*, International Phase, General Information (Annexes B1/B2)

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Prosecution Highway (PPH)

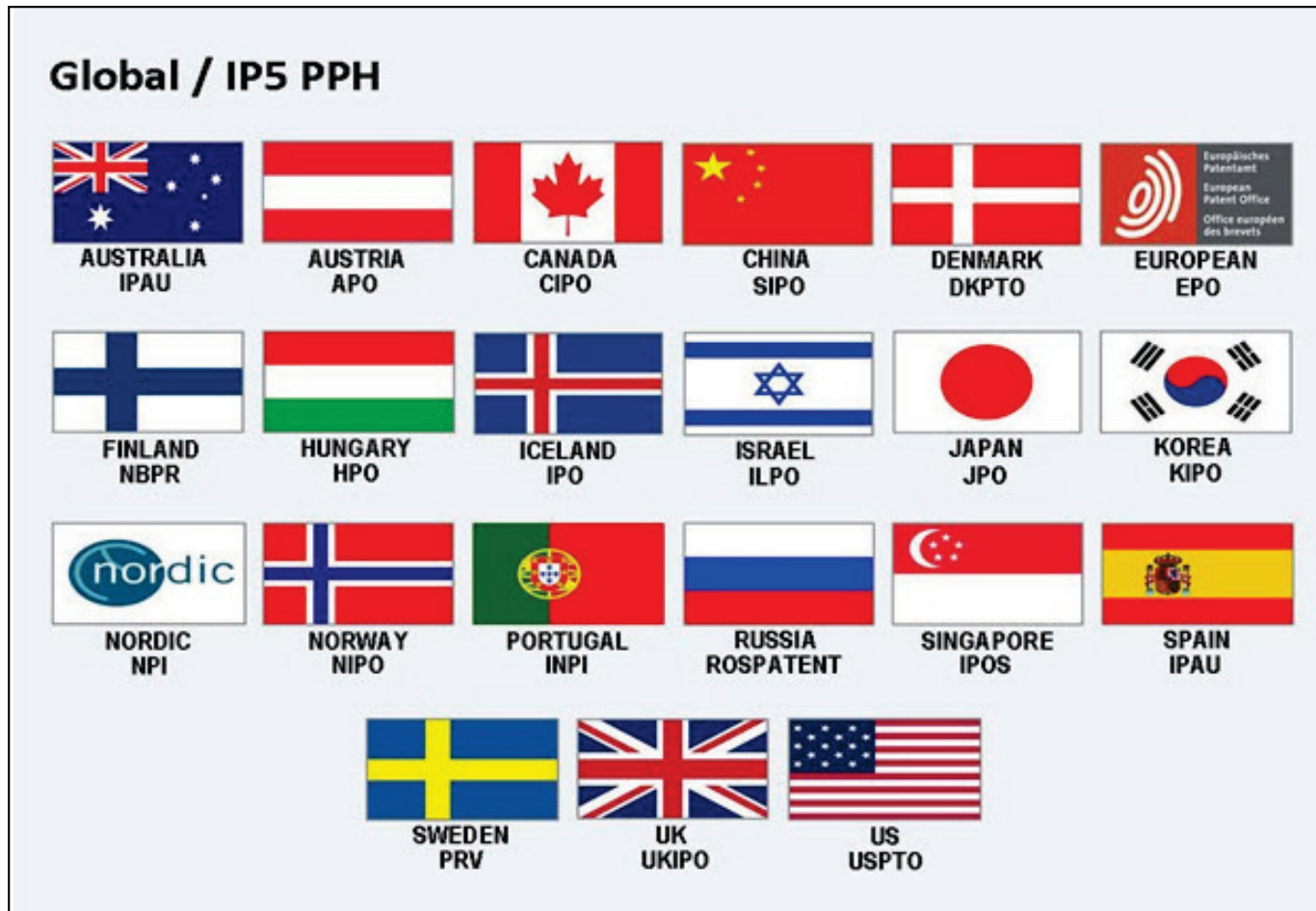
**Michael Neas
Deputy Director
International Patent Legal Administration**

Types of PPH Agreements

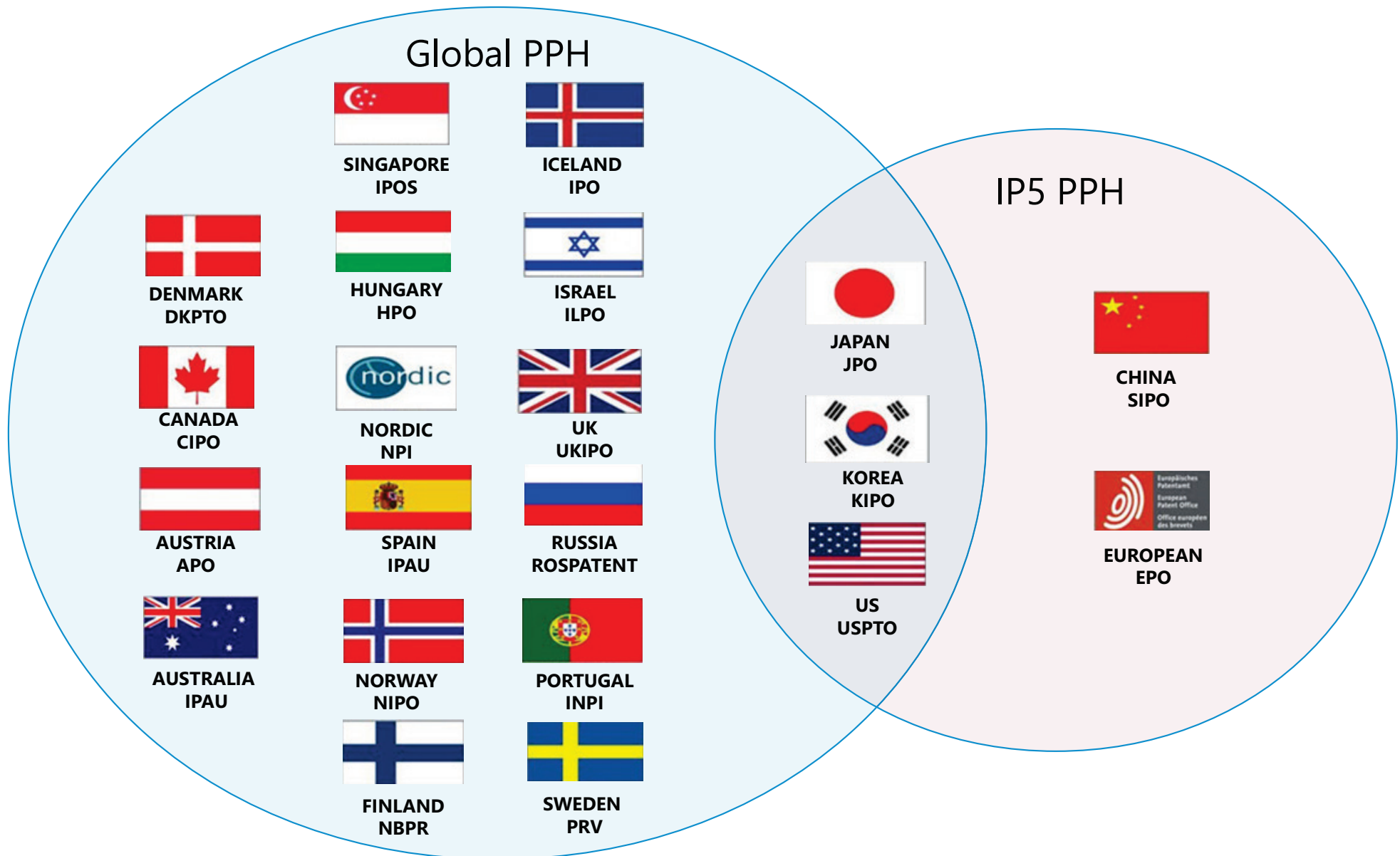
- IP5 / Global
- Bilateral Agreements



Global/IP5 PPH Countries



Global PPH and IP5 PPH



Bilateral PPH Agreements

	PPH between USPTO and Colombia
	PPH between USPTO and Czech Republic
	PPH between USPTO and Germany
	PPH between USPTO and Mexico
	PPH between USPTO and Nicaragua
	PPH between USPTO and Philippines
	PPH between USPTO and Poland (Bilateral agreement under global principles)
	PPH between USPTO and Romania (Bilateral agreement under global principles)
	PPH between USPTO and Taiwan Intellectual Property Office



How Do I Submit a PPH Request?

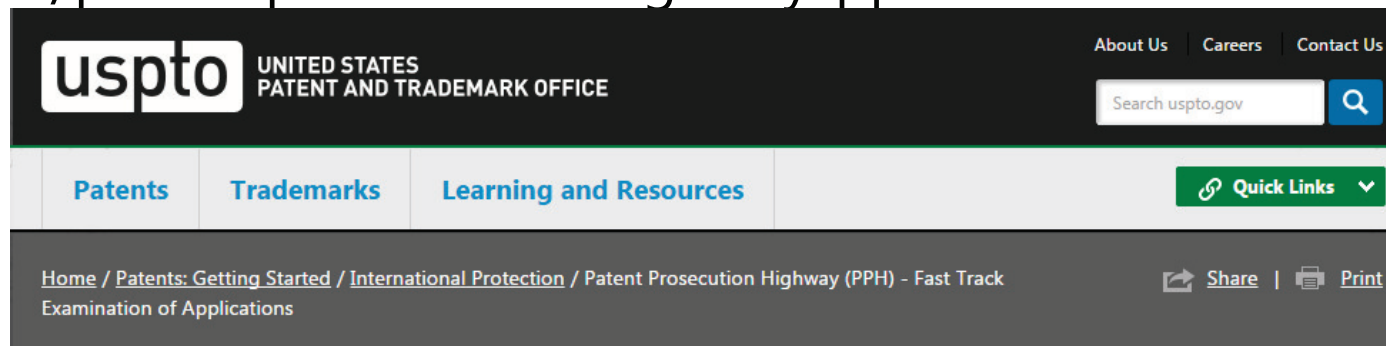
- All claims in each U.S. application must sufficiently correspond to the allowable claims in the application in the Office of First Filing.
- Refer to the PPH Web site for the request form and more information.
- e-File the Request/Petition to Make Special Form and the supporting documents via EFS-Web.



PPH Web Site for Global / IP5 PPH and Other PPH Forms

- PPH Web site for the request form and more information

<http://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>



Helpful 14



Patent Prosecution Highway (PPH) - Fast Track Examination of Applications

The Patent Prosecution Highway (PPH) speeds up the examination process for corresponding applications filed in participating intellectual property offices.

Under PPH, participating patent offices have agreed that when an applicant receives a final ruling from a first patent office that at least one claim is allowed, the applicant may request fast track examination of corresponding claim(s) in a corresponding patent application that is pending in a second patent office. PPH leverages fast-track examination procedures already in place among participating patent offices to allow applicants to reach final disposition of a patent application more quickly and efficiently than standard examination processing.

There is no fee under the PPH programs. For further information, please see this [Federal Register notice](#).



Example of Global / IP5 PPH Form (1)

- Application Number and Filing Date
- First Named Inventor
- Attorney Docket Number and Title of the Invention
- **Office of earlier examination (OEE)***
- OEE application number
- Both the OEE application and identified U.S. application have the earliest filing or priority date
- **Type of OEE work product relied upon***
- Mailing date of OEE work product

Doc Code: PPH.PET.652		PTO/SB/20GLBL (04-15)	
Document Description: Petition to make special under Patent Pros Hwy		Approved for use through 04/30/2018. OMB 0651-0058	
		U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE	
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.			
REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS-APPLICATION-PROCESS/FILING-ONLINE/ABOUT-EFS-WEB.			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE): ☒			
OEE application number: _____			
Both the OEE application and the above-identified U.S. application have the following earliest date (filing or priority date): _____			
Type of OEE work product relied upon: ☒			
Mailing date of OEE work product: _____			
Supporting Documents			
One or more of the required documents below may be available electronically from the Dossier Access System or PATENTSCOPE (see https://www.jpo.go.jp/pph-portal/filewrapper.htm). If the applicant requests the USPTO to attempt to obtain a document electronically and such attempt is unsuccessful, the applicant will be required to supply the document. Accordingly, to avoid dismissal of the initial PPH request and potential denial of participation in the PPH program, the applicant should verify that the document is actually available via the Dossier Access System or PATENTSCOPE before requesting retrieval. If the applicant is unable to verify availability, then the applicant should submit the document with the PPH request.			
1. OEE Work Product and Translation			
A copy of the OEE work product and translation if not already in English:			
☐ Attached ☐ Previously submitted ☐ Not required because the decision to grant a patent was the first office action ☐ Applicant requests the USPTO to attempt to obtain the document(s) from the Dossier Access System or PATENTSCOPE			
2. References Cited in OEE Work Product			
A listing of references cited in the OEE work product and document copies (except U.S. patents and U.S. published patent applications):			
☐ Attached ☐ Previously Submitted ☐ Not required because no references were cited in the OEE work product ☐ Applicant requests the USPTO to attempt to obtain the document(s) from the Dossier Access System or PATENTSCOPE			

* Drop down for selection
July 2015

Example of Global / IP5 PPH Form (2)

Doc Code: PPH.PET.652		PTO/SB/20GLBL (04-15)	
Document Description: Petition to make special under Patent Pros Hwy		Approved for use through 04/30/2018. OMB 0651-0058	
U.S. Patent and Trademark Office; U.S DEPARTMENT OF COMMERCE			
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.			
REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS-APPLICATION-PROCESS/FILING-ONLINE/ABOUT-EFS-WEB.			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE): 			
OEE application number:	 - Australia (IP Australia) - Austria (Austrian Patent Office) - Canada (Canadian Intellectual Property Office) - Denmark (Danish Patent and Trademark Office) - European Patent Office - Finland (National Board of Patents and Registration of Finland) - Hungary (Hungarian Intellectual Property Office) - Iceland (Icelandic Patent Office) - Israel (Israeli Patent Office) - Japan (Japan Patent Office) - Korea (Korean Intellectual Property Office) - Nordic Patent Institute - Norway (Norwegian Industrial Property Office)		
Both the OEE application and the a			
the following earliest date (filing or			
Type of OEE work product relied up			
Mailing date of OEE work product:			
Supporting Documents	One or more of the required documents be https://www.jpo.go.jp/ppph-portal/filewrap such attempt is unsuccessful, the applican and potential denial of participation in the Access System or PATENTSCOPE before requesting retrieval. If the applicant is unable to verify availability, then the applicant should submit the document with the PPH request.		

Example of Global / IP5 PPH Form (3)

Doc Code: PPH.PET.652		PTO/SB/20GLBL (04-15)	
Document Description: Petition to make special under Patent Pros Hwy		Approved for use through 04/30/2018. OMB 0651-0058	
		U.S. Patent and Trademark Office; U.S DEPARTMENT OF COMMERCE	
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.			
REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS-APPLICATION-PROCESS/FILING-ONLINE/ABOUT-EFS-WEB.			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE): _____ OEE application number: _____ Both the OEE application and the above-identified U.S. application have the following earliest date (filing or priority date): _____ Type of OEE work product relied upon: ▼ Mailing date of OEE work product: _____			
Supporting Documents One or more of the required documents below must be submitted. If the applicant's attempt is unsuccessful, the applicant will be required to supply the document. Accordingly, to avoid dismissal of the initial PPH request and potential denial of participation in the PPH program, the applicant should verify that the document is actually available via the Dossier Access System or PATENTSCOPE before requesting retrieval. If the applicant is unable to verify availability, then the applicant should submit the document with the PPH request.		Decision to grant a patent Notice of refusal to grant a patent (where such notice indicates allowable claims) Written Opinion of the International Searching Authority (WO/ISA) Written Opinion of the International Preliminary Examining Authority (WO/IPEA) International Preliminary Examination Report (IPER)	

Global / IP5 PPH Form Requirements (1)

I. **Required Documents:**

- a) A copy of the most recent office action prior to the decision to grant a patent or the most recent PCT work product (along with an English translation)
- b) An information disclosure statement listing the documents cited in the Office of Earlier Examination (OEE) work product
- c) Copies of all cited documents (except for U.S. patents or U.S. patent application publications)

II. **Claims Correspondence Table**

- III. **All the claims in the U.S. application sufficiently correspond to the patentable/allowable claims in the OEE application**



Global / IP5 PPH Form Requirements

Supporting Documents

One or more of the required documents below may be available electronically from the Dossier Access System or PATENTSCOPE (see <https://www.jpso.gov.jp/ppph-portal/filewapper.htm>). If the applicant requests the USPTO to attempt to obtain a document electronically and such attempt is unsuccessful, the applicant will be required to supply the document. Accordingly, to avoid dismissal of the initial PPH request and potential denial of participation in the PPH program, the applicant should verify that the document is actually available via the Dossier Access System or PATENTSCOPE before requesting retrieval. If the applicant is unable to verify availability, then the applicant should submit the document with the PPH request.

1. OEE Work Product and Translation

A copy of the OEE work product and translation if not already in English:

- ☐ Attached ☐ Previously submitted ☐ Not required because the decision to grant a patent was the first office action
- ☐ Applicant requests the USPTO to attempt to obtain the document(s) from the Dossier Access System or PATENTSCOPE

2. References Cited in OEE Work Product

A listing of references cited in the OEE work product and document copies (except U.S. patents and U.S. published patent applications):

- ☐ Attached ☐ Previously Submitted ☐ Not required because no references were cited in the OEE work product
- ☐ Applicant requests the USPTO to attempt to obtain the document(s) from the Dossier Access System or PATENTSCOPE

[Page 1 of 2]

REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PPH PILOT PROGRAM IN THE USPTO (continued)																																																																			
Application No.:																																																																			
First Named Inventor:																																																																			
3. Claims Correspondence Certification Statement All of the claims in this application sufficiently correspond to the patentable/allowable claims in the OEE application.																																																																			
4. Claims Correspondence Table <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th style="width: 20%;">Claims in US Application</th> <th style="width: 20%;">Patentable Claims in OEE Application</th> <th style="width: 60%;">Explanation regarding the correspondence</th> </tr> </thead> <tbody> <!-- Generating 20 empty rows --> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td></tr> </tbody> </table>		Claims in US Application	Patentable Claims in OEE Application	Explanation regarding the correspondence																																																															
Claims in US Application	Patentable Claims in OEE Application	Explanation regarding the correspondence																																																																	
Signature	Date																																																																		
Name (Print/Typed)	Registration Number																																																																		

Doc Code: PPH.PET.652		PTO/SB/20CO (04-15)	
Document Description: Petition to make special under Patent Pro Hwy		Approved for use through 04/30/2018. OMB 0651-0058	
		U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE	
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.			

REQUEST FOR PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM BETWEEN THE COLOMBIAN SUPERINTENDENCE OF INDUSTRY AND COMMERCE AND THE USPTO

Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			

THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT WWW.USPTO.GOV/PATENTS-APPLICATION-PROCESS/APPLYING-ONLINE/ABOUT-EFS-WEB

APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.

The above-identified application (1) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more corresponding CO application(s) or to a PCT application that does not contain any priority claim, or (2) is a national stage entry of a PCT application that does not contain any priority claim.

The CO/PCT application number(s) is/are: _____

The filing date of the CO/PCT application(s) is/are: _____

I. List of Required Documents:

- a. A copy of all CO office actions which are relevant to patentability in the above-identified CO application(s)

☐ is attached.
- b. A copy of all claims which were determined to be patentable by the Colombian Superintendence of Industry and Commerce in the above-identified CO application(s)

☐ is attached.
- c. English translations of the documents in a. and b. above, along with a statement that the English translations are accurate, are attached (if the documents are not in the English language).
- d. (1) An information disclosure statement listing the documents cited in the CO office actions

☐ is attached.
☐ has already been filed in the above-identified U.S. application on _____

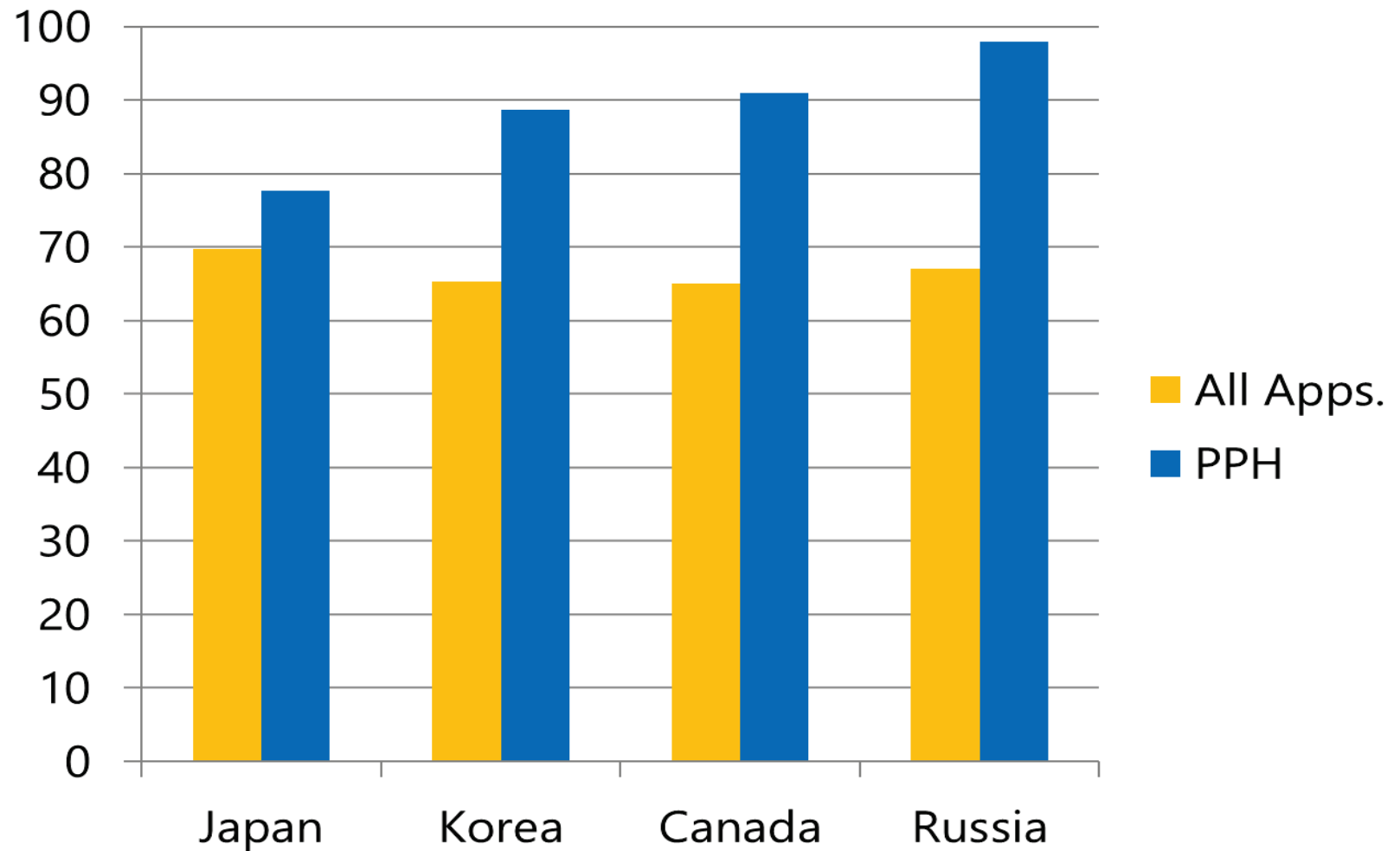
 (2) Copies of all documents (except for U.S. patents or U.S. patent application publications)

☐ are attached.
☐ have already been filed in the above-identified U.S. application on _____

[Page 1 of 2]

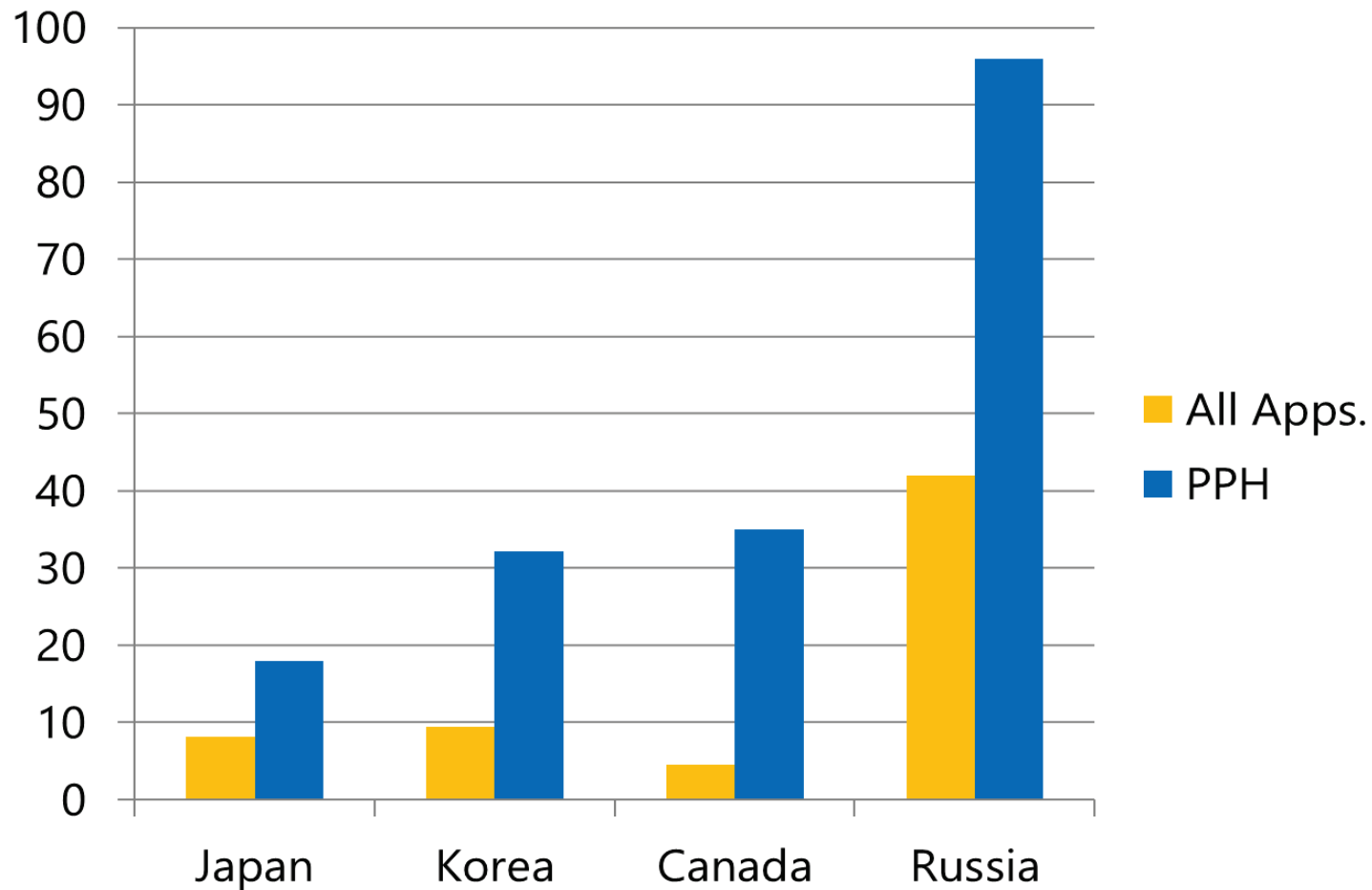
July 2015

Foreign PPH Grant Rates



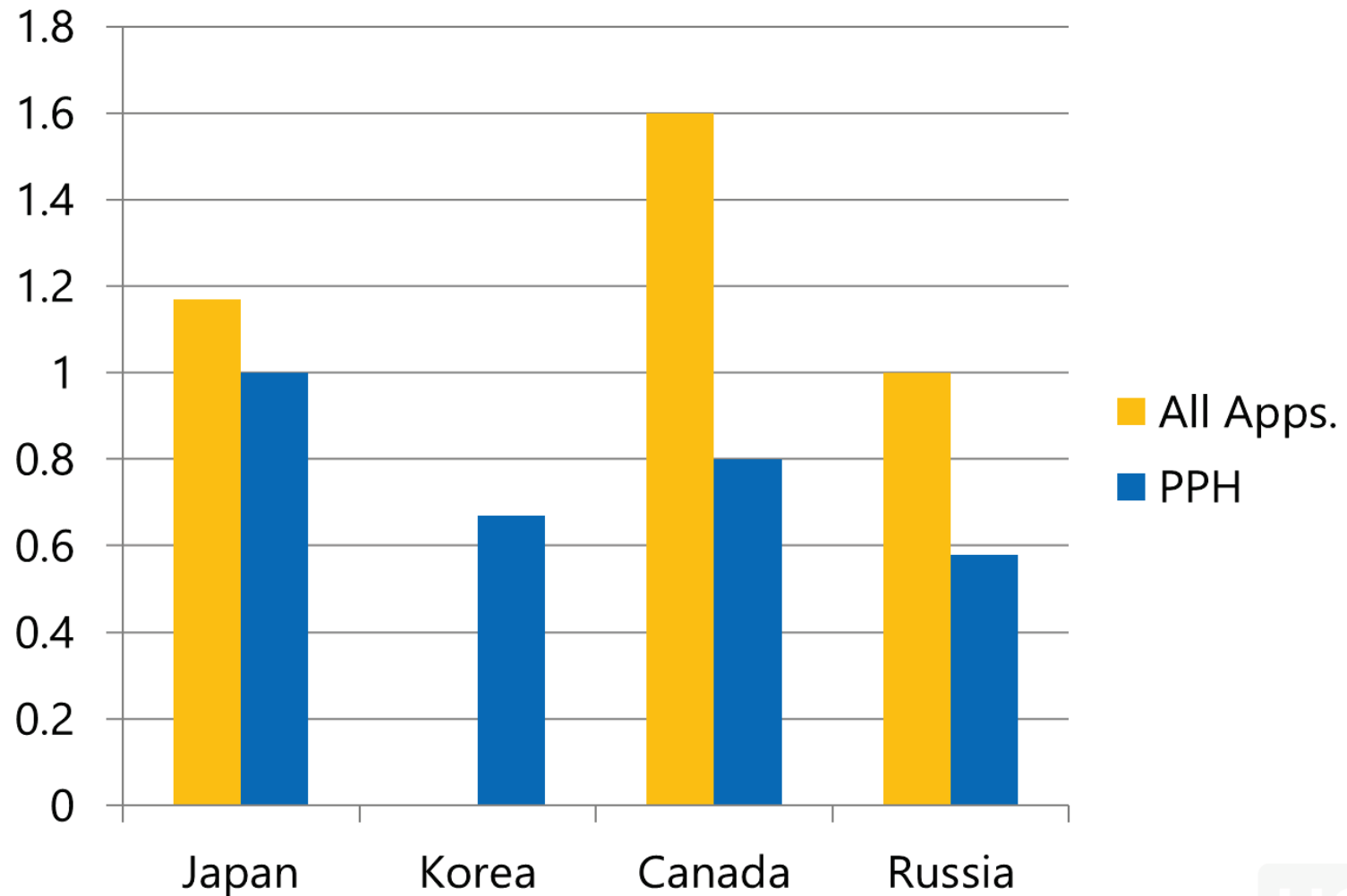
[http://
www.jpo.go.jp/ppph-portal/statistics.htm](http://www.jpo.go.jp/ppph-portal/statistics.htm)

First Action Allowance Rates



<http://www.jpo.go.jp/ppph-portal/statistics.htm>

Average Number of Office Actions



<http://www.jpo.go.jp/ppph-portal/statistics.htm>



PPH Statistics – IP5 Offices

New Applications with PPH requests among the IP5 offices

(as of December 2014)

	<i>Office of Earlier Examination</i>						
<i>Office of Later Examination</i>		<i>EPO</i>	<i>JPO</i>	<i>KIPO</i>	<i>SIPO</i>	<i>USPTO</i>	<i>Total</i>
	<i>EPO</i>		<i>3,006</i>	<i>63</i>	<i>137</i>	<i>1,777</i>	<i>4,983</i>
	<i>JPO</i>	<i>1,400</i>	<i>3,704</i>	<i>488</i>	<i>150</i>	<i>4,040</i>	<i>9,782</i>
	<i>KIPO</i>	<i>252</i>	<i>4,275</i>	<i>203</i>	<i>97</i>	<i>2,206</i>	<i>7,033</i>
	<i>SIPO</i>	<i>279</i>	<i>5,580</i>	<i>788</i>		<i>2711</i>	<i>9,358</i>
	<i>USPTO</i>	<i>4,758</i>	<i>13,198</i>	<i>5,827</i>	<i>1,252</i>	<i>713</i>	<i>25,748</i>
	<i>Total</i>	<i>6,689</i>	<i>29,763</i>	<i>7,369</i>	<i>1,636</i>	<i>11,447</i>	<i>56,904</i>

Terminal Disposal Comparison between PPH and non-PPH Prosecution – FY 2013

	<i>Percent of Applications with at least one RCE*</i>	<i>Reduced Appeal Rates*</i>	<i>Overall Allowance Rate**</i>	<i>First Action Allowance Rate***</i>
PPH Applications	12%	0.3%	82.3%	23.0%
Non-PPH Applications	25%	2.5%	68.3%	13.0%

Examiner Actions include restrictions, non-final rejection, final rejection, ex parte Quayle, allowance, Interference, SIR disposal, Rule 105 requirement, examiner's answer, advisory action, miscellaneous action with SSP, first action interview actions, examiner initiated suspension and abandonment after PTAB decision

* Cases completed in CY 2013

** Cases completed between January and June 2014

*** Cases completed between July and December 2014



PPH Cost Savings Estimate

Savings due to reduced number of actions

USPTO Costs*

PPH applications total cost to completion - **\$4,787**

All Utility total cost to completion - **\$5,237**

USPTO Cost Deferral - \$450

Applicant Costs Responses

Minimal Complexity Average Cost per response to Action = **\$2,297****

Complex Average Cost per response to Action = **\$3,329****

Fees

Reduction in need for RCE - **\$1,200**

Reduction in Appeal Related Fees - **\$2,800**

**Estimates from 2014 USPTO ABI Cost Analysis*

*** Estimates are based on 2013 cost savings data from the
AIPLA Report of the Economic Survey*



PPH Cost Savings

Added Cost Savings for Office Fees and Prosecution

- **Applicable USPTO Fees**

RCEs – 21% probability of RCE in PPH vs 44% probability in all applications
\$1,200 fee for an average savings of \$285

Appeals – 0.28% probability of appeal in PPH vs 2.67% probability of appeal in all applications
\$2,800 fee for an average savings of \$67

- **Hypothetical complex case – Average approximate cost savings based on responses to examiner actions**

Fewer Response to Actions - \$2,085
Fewer Restriction Requirements - \$45
Fewer After Final Responses - \$90
Fewer Appeal Briefs - \$109

- **Total Applicant Savings = \$2681**



Other PPH Benefits

- **Special status**

PPH applications are advanced out of turn for examination, reducing the amount of time to receive office actions and patents.

- **Improved search/examination quality**

Search results are shared among offices. E.g., a JP examiner is normally more adept than a US examiner at searching Japanese art. The JP search results are used by the US examiner to produce a more thorough examination.

- **Reduced overall pendency**

The efficiencies gained by work sharing help patent offices to reduce the overall application backlog, which affects all cases.

For More Information

- For general information concerning PPH, visit www.uspto.gov/web/patents/pph/index.html
- If you have specific questions about PPH, please e-mail PPHfeedback@uspto.gov
- To receive future USPTO updates on PPH, sign up for USPTO's e-Commerce e-Alerts by visiting: <http://www.uspto.gov/ebc/optin.html>



Questions?

Michael Neas
Deputy Director, International Patent Legal Administration
Michael.Neas@uspto.gov

PCT Help Desk
(571) 272-4300
Monday – Friday 8:30am – 5:00pm ET

UNITED STATES
PATENT AND TRADEMARK OFFICE





PCT-PPH practice tips

Carl Oppedahl

Oppedahl Patent Law Firm LLC

www.oppedahl.com

Filing a Demand?

- PCT-PPH provides a strong incentive to file a Demand in the event of a less than fully favorable WO.
- If by some chance the IPRP is more favorable than the WO, then this permits a more favorable PCT-PPH result.

Things you have to e-file in your PPH request to USPTO

- All references from the ISR/WO/IPRP-II
- A copy of the ISR
- A copy of the WO/IPRP-II (most recent work) if not already in the file
- An IDS (form PTO/SB/08A) listing all of the above
- If not already in English ...
 - A translation of WO (or IPRP) into English (WIPO will translate these documents by 30 months)
 - A translation of the favorably treated claims (in the WO or IPRP) into English
 - An accuracy statement for the claims

Trap for the unwary

- Many filers will put off filing thorough IDSs until months after getting the US application number.
- But when you file a PCT-PPH petition, you might get a Notice of Allowance at any time thereafter, perhaps within mere days.
- Make sure that all of your IDSs (not only the IDS required by the PCT-PPH procedure) have been filed ***before*** you file your PCT-PPH petition.

Most commonly made mistakes when petitioning for PCT-PPH status

- failing to provide all references from the ISR
- failing to file an IDS detailing those references
- failing to cancel claims that were not treated favorably
- failing to e-file
- failing to index the petition correctly - "Petition to make special under PCT-Patent Pros Hwy"
- failing to provide a copy of the WO
- failing to cause the US claims to “sufficiently correspond”

If a petition is dismissed?

- Trap for the unwary: If the Examiner picks up the file while you are sitting around not responding to the dismissal, you lose your chance for PCT-PPH. So don't let the whole month go by. Respond sooner.

Searching authorities

- What Searching Authorities do PCT-PPH applicants use in USPTO?
 - Most often ISA/KR, then ISA/EP, also ISA/JP
 - Other ISAs are used less often

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



International Search and Preliminary Examination

**Michael A. Neas
Deputy Director
International Patent Legal Administration**

UNITED STATES
PATENT AND TRADEMARK OFFICE



PCT System

Chapter I



International preliminary examination

Chapter II

30

Enter national stage

30

uspto

Chapter I Procedures

- The receiving Office sends a “search copy” of the international application to the International Searching Authority (ISA) after
 - completion of the formalities review
 - granting of the foreign filing license and
 - payment of the search fee
- The ISA mails Form PCT/ISA/202 to applicant and the IB notifying the date of receipt of the search copy



The International Searching Authority (1)

- Checks for the presence of multiple inventions
 - if more than one invention present, invites applicant to pay for the search of the additional inventions
- Checks the title of the invention
 - establishes one if the title is not short and precise
- Checks the abstract
 - establishes one if the abstract
 - is not concise (more than 150 words)
 - is not present



The International Searching Authority (2)

- Searches the claimed invention for relevant prior art
- Takes into account earlier search results where the applicant has so requested and the required copies have been supplied
- Prepares an international search report and a written opinion of the ISA



Relevant Prior Art for the International Search (1)

- For the ISR
 - must have been made available to the public
 - anywhere in the world
 - by means of written disclosure
 - prior to the international filing date
- For the WOISA
 - must have been made available to the public
 - anywhere in the world
 - by means of written disclosure
 - prior to the “relevant date” which is
 - the international filing date or
 - the priority date if the international application has a valid priority
 - claim to a prior application



Relevant Prior Art for the International Search (2)

- Includes applicant's own work
 - there is no one year grace period
- Also includes "admitted prior art"
- Exceptions to the prior art definition
 - Written document published on or after the international filing date which describes an earlier oral disclosure, use or exhibition
 - "O" reference
 - US or foreign patent or patent application published on or after the international filing date but having a filing or priority date prior to the international filing date
 - "E" reference
 - cited in the ISR but not applied in the WOISA



International Search Report (ISR) Form PCT/ISA/210

- Indicates the International Patent Classification (IPC) for the claimed invention
 - also indicates the CPC if searched by ISA/US
- Indicates any finding of lack of unity
- Lists the relevant prior art documents
 - categorizes the references found as to their relevance
 - cites the references
 - lists the claims to which the references are relevant



Declaration Under Article 17(2)(a)

- In very rare instances the ISA may not be able to issue an ISR because
 - all the claims are directed to subject matter for which no searches are carried out, *e.g.*, excluded subject matter under PCT Rule 39
 - USPTO will search all subject matter in an international application as it would in a U.S. patent application
 - the description, claims or drawings fail to meet a requirement such as clarity or support of the claims to such an extent that no meaningful search can be carried out
 - a complaint sequence listing is not provided in response to Form PCT/ISA/225 – Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing and to Pay, Where Applicable, Late Furnishing Fee
- The ISA would issue a form PCT/ISA/203 (Declaration of Non-Establishment of International Search Report)

Written Opinion of the ISA

Form PCT/ISA/237

- The ISA establishes a written opinion at the same time that it establishes the international search report (or declaration under Article 17(2)(a))
- The written opinion of the ISA
 - indicates whether the international application
 - satisfies the criteria of novelty, inventive step and industrial applicability; and
 - complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA)
 - notifies applicant that if a demand for international preliminary examination is made, the written opinion may be considered to be the written opinion of the IPEA



Unity of Invention (Rule 13)

- An international application must relate to
 - one invention only or,
 - if there is more than one invention, those inventions must be so linked as to form a single general inventive concept



Unity of Invention

- Inventions are considered linked so as to form a single general inventive concept only when there is a technical relationship involving one or more of the same or corresponding special technical features
 - the expression “special technical features” means those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art (Rule 13.2)

For further explanation and examples concerning unity of invention see Chapter 10 of the PCT International Search and Preliminary Examination Guidelines found on the WIPO Internet site: (<http://www.wipo.int/pct/en/texts/gdlines.htm>)



Unity Example

Claim 1: A method of making chemical substance X

Claim 2: Substance X

Claim 3: A method of using chemical substance X

The technical feature common to all of the claims is substance X. Unity exists among claims 1, 2 and 3 where substance X is applicant's contribution over the prior art and is therefore a special technical feature.

However, if substance X is known in the prior art, then unity would be lacking.



When a Lack of Unity of Invention is Found

- The first mentioned invention will always be searched
- Applicant can pay for the search of additional inventions
 - all of the additional inventions
 - some of the additional inventions or
 - none of the additional inventions
- Applicant has the right to protest the lack of unity requirement so long as the fees are paid for each invention that is being protested
 - Protest fee is required by some ISAs
 - for example, EP, KR, RU



Main Features of the International Search and Preliminary Examination System

- International search report (or declaration under Article 17(2)(a)) plus written opinion of ISA is issued for every international application
- International preliminary report on patentability (IPRP) is issued for every international application
 - IPRP (Chapter I) = repackaged written opinion of the ISA
 - IPRP (Chapter II) = IPER
- Main distinction:
 - IPRP (Chapter I) issued when no demand for IPE filed:
 - based on application as originally filed
 - IPRP (Chapter II) is issued when demand is filed:
 - timely filed amendments and/or arguments taken into account before establishment of IPRP (Chapter II)



IPRP (Chapter I)

- If applicant does not file a Demand
 - IB will establish “International Preliminary Report on Patentability” IPRP (Chapter I) by placing form PCT/IB/373 onto the written opinion of the ISA
- IPRP (Chapter I) and any comments on the written opinion filed by applicant
 - are sent to designated Offices by the IB
 - are made publicly available by the IB (but not “published” like application and ISR)
 - but not before the expiration of 30 months from the priority date



International Preliminary Examination - Chapter II

- Is an optional process
 - a demand for international preliminary examination (form PCT/IPEA/401) electing at least one eligible State is made with a competent International Preliminary Examining Authority (IPEA)
- Results in examination of the international application
 - IPEA issues a non-binding opinion on the novelty, inventive step and industrial applicability of the claimed invention (international preliminary examination report)
 - applicant has an opportunity to amend the description, claims and drawings



Time Limit for Making a Demand

- Time limit for filing a Demand
 - three months from the date of transmittal of the international search report (or declaration referred to under Article 17(2)(a)) and written opinion of the ISA or
 - 22 months from the priority date
- whichever is later
- however, a demand made after expiration of this time limit will be considered as not having been submitted
- A demand should be filed before 19 months from the priority date in order to delay the time limit for national phase entry to at least 30 months in all PCT Contracting States
 - Chapter I national phase entry deadline for Luxembourg, United Republic of Tanzania and Uganda is still 20 months
 - all are members of regional Offices with 31 month national phase entry deadline from Chapter I



Amendments

- Applicant has the opportunity to amend the description, claims and drawings under Article 34 during the preliminary examination
- Amendments shall not go beyond the disclosure in the international application as originally filed
- Applicant may file Article 34 amendments
 - with the Demand or within the time period under PCT Rule 54*bis*
 - this may be a response to the written opinion of the ISA
 - entry of amendments filed at other times is at the discretion of the examiner



Claims Eligible for International Preliminary Examination

- Only claims relating to the inventions searched by the International Searching Authority (ISA) are eligible for examination by the International Preliminary Examining Authority (IPEA)



Lack of Unity in Chapter II

- The IPEA applies the same lack of unity criteria as the ISA
 - the IPEA issues an invitation to restrict or pay additional fees where unity is lacking
 - applicant can decide which invention is the “main invention”
 - applicant must pay fees in order to have the additional inventions examined
 - applicant has the right to protest the lack of unity requirement so long as the fees are paid for each invention that is being protested
 - Some IPEAs require a protest fee
 - » For example, EP, KR, RU



Start of International Preliminary Examination

- The international preliminary examination starts only after the IPEA has received
 - the demand
 - the international search report (or declaration of non-establishment thereof) and written opinion of the ISA
 - the preliminary examination fee and the handling fee
 - see Rule 69.1
- The IPEA cannot start examination before the expiration of the time limit under Rule 54bis.1(a) unless applicant expressly requests an earlier start

International Preliminary Examination

(1)

- Written opinion of the ISA will be considered as the written opinion by IPEA
 - IPEA may decide not to accept written opinions by certain ISAs
 - IPEA/US will accept written opinions issued by ISA/AU, ISA/EP, ISA/KR, ISA/RU, and ISA/JP
- IB does not send the applicant's "informal" comments on written opinion of the ISA to the IPEA
 - applicant may submit formal response to the Written Opinion of the ISA in the form of arguments and/or amendments under Article 34 directly to the IPEA

International Preliminary Examination (2)

- “New” written opinion of IPEA (form PCT/IPEA/408) will be issued only in rare circumstances by IPEA/US
 - Some IPEAs issue written opinion in Chapter II where IPRP would otherwise be negative
- International Preliminary Report on Patentability (Chapter II) or IPRP (Chapter II) will usually be the only office action prepared by the IPEA



IPRP (Chapter II)

- The IPRP (Chapter II) is sent to the applicant and the International Bureau (IB)
 - the IB forwards copies to the elected Offices
 - where the IPRP (Chapter II) is in a language other than English, the IB translates it into English and forwards to elected Offices where required
 - the IB does not translate the annexes* to the IPRP (Chapter II)
- Once the IPRP (Chapter II) has been issued, there is no provision for appeal or further prosecution during the international phase

* Annexes are the amendments taken into account in preparing the report and any letter accompanying the amendment as provided for in Rules 46.5 and 66.8.



Competent IPEAs for U.S. Applicants Filing International Applications with RO/US or RO/IB*

- ISA/US
 - IPEA/US,KR,RU
- ISA/AU
 - IPEA/AU,KR,RU,US
- ISA/EP
 - IPEA/EP,KR,RU,US
- ISA/KR
 - IPEA/KR,RU,US
- ISA/RU
 - IPEA/RU,KR,US
- ISA/IL**
 - IPEA/IL,KR,RU,US
- ISA/JP
 - IPEA/JP,KR,RU,US

		COMPETENT IPEA						
C H O S E N I S A		US	AU	EP	KR	RU	IL	JP
	US	✓	✗	✗	✓	✓	✗	✗
	AU	✓	✓	✗	✓	✓	✗	✗
	EP	✓	✗	✓	✓	✓	✗	✗
	KR	✓	✗	✗	✓	✓	✗	✗
	RU	✓	✗	✗	✓	✓	✗	✗
	IL*	✓	✗	✗	✓	✓	✓	✗
	*							
	JP	✓	✗	✗	✓	✓	✗	✓

*this chart applies where at least one applicant is a U.S. national or resident

**selection of ISA/IL not possible through RO/IB



ISA Competency Considerations (1)

- ISA/AU
 - Not competent to act as ISA for international applications filed by U.S. applicants in RO/US or RO/IB if
 - more than 250 IAs have been received in the relevant fiscal quarter
- ISA/EP
 - As of 01 Jan 2015, competent to act as ISA for IAs filed by U.S. applicants in RO/US or RO/IB without any competency restrictions
 - Including claims directed to business methods involving technical means
 - ISA/EP will not search claims directed to mere business methods
 - For details, see
([http://documents.epo.org/projects/babylon/eponet.nsf/0/fe9b7f7048bf6529c1257d7900469114/\\$FILE/No_more_limitations_to_PCT_work_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/fe9b7f7048bf6529c1257d7900469114/$FILE/No_more_limitations_to_PCT_work_en.pdf)) for details



ISA Competency Considerations (2)

- ISA/IL
 - Not competent to act as ISA for IAs filed by U.S. applicants in RO/US or RO/IB with
 - one or more claims directed to business methods
 - Numerical limitation of no more than 75 IAs per fiscal quarter
 - see http://www.uspto.gov/sites/default/files/patents/law/notices/ilpo_isa-ipea.pdf for details



ISA Competency Considerations (3)

- ISA/JP
 - The following restrictions apply:
 - the applications are submitted in the English language;
 - the claims of the application are directed to the field of green technology as defined by certain International Patent Classification classes;
 - Quota has not yet been met
 - Not to exceed 5,000 international applications from the USPTO during the 3 year period from July 1, 2015 to June 30, 2018
 - Not more than 300 applications per quarter during the first year
 - Not more than 475 application per quarter during the second and third years



Choice of ISA for International Applications filed in RO/US

	ISA/US	ISA/EP	ISA/KR	ISA/AU	ISA/RU	ISA/IL	ISA/JP
FY2009	34%	39%	27%	0%	N/A	N/A	N/A
FY2010	33%	37%	29%	1%	N/A	N/A	N/A
FY2011	34%	35%	30%	1%	N/A	N/A	N/A
FY2012	32%	35%	31%	<1%	2%	N/A	N/A
FY2013	29%	38%	29%	<1%	4%	N/A	N/A
FY2014	32%	37%	27%	<1%	3%	<1%	N/A
FY2015 to date	36%	36%	25%	<1%	2%	<1%	TBD

Questions?

Michael Neas
Deputy Director, International Patent Legal Administration
Michael.Neas@uspto.gov

PCT Help Desk
(571) 272-4300
Monday – Friday 8:30am – 5:00pm ET

UNITED STATES
PATENT AND TRADEMARK OFFICE





Picking an International Searching Authority

Jeremy Smith
July 2015

Picking an International Searching Authority

- You are getting ready to file a PCT application for a client
- There's no choice about it, you (the client) must pick an International Searching Authority
- If your habit is to always pick the same ISA, because “we've always done it that way”, then this is an opportunity to provide better service to the client

Which ISAs can you choose from?

- The Receiving Office sets the available ISA(s)
 - rO must be a national/regional office where at least one applicant is resident or national, or the IB
- If rO=IB, the available ISAs are any that could have been selected for any possible rO that IA could validly have been filed at
- If >1 applicant, best to consider available ISAs when selecting rO
- On filing, can include applicant of another nationality for the purpose of enabling filing at another rO
 - Extra applicant can be made applicant only for one obscure country
- Can use PCT-SAFE File Manager (for RO/US) or ePCT (for RO/IB) to prepare your Request. The software will look at your applicants and will tell you if you picked a competent RO, and will tell you which ISAs you can pick

You picked RO/US?

- Available ISAs:
- AU (Australia)
- EP (EPO)
- RU (Russia)
- IL (Israel)
- JP (Japan)
- KR (South Korea)
- US (USPTO)

Factors to Consider in Choosing an ISA

- PPH benefit
- Cost
- Timeliness
- Effect on later national/regional stage
- Characteristics of ISRs from the different ISAs
- Language competency
- Who does the work (outsourcing)
- Provision of cited references
- Competencies
- Keep in mind that some clients do not care at all about the ISR/WO

PPH Benefit

- AU, IL, JP, KR, RU, US are all part of the Global PPH pilot. Positive results from any of those ISAs may form the basis for PPH status in:
- AT, AU, CA, ES, DK, FI, HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, UK, US
- EP, JP, KR, and US are part of the IP5 PPH pilot. Positive results from any of those ISAs may form the basis for PPH status in:
- CN, EP, JP, KR, US
- So if you know now in which Offices you might enter national/regional phase, and if you might want PPH benefit in those Offices, then this may influence your choice of ISA
- Note that EPO has the PACE program which offers fast examination without having to qualify for PPH
- PPH generally ineffective with EPO as office of second filing, but can be effective elsewhere with EPO as office of first filing

Search Fee as of July 1, 2015

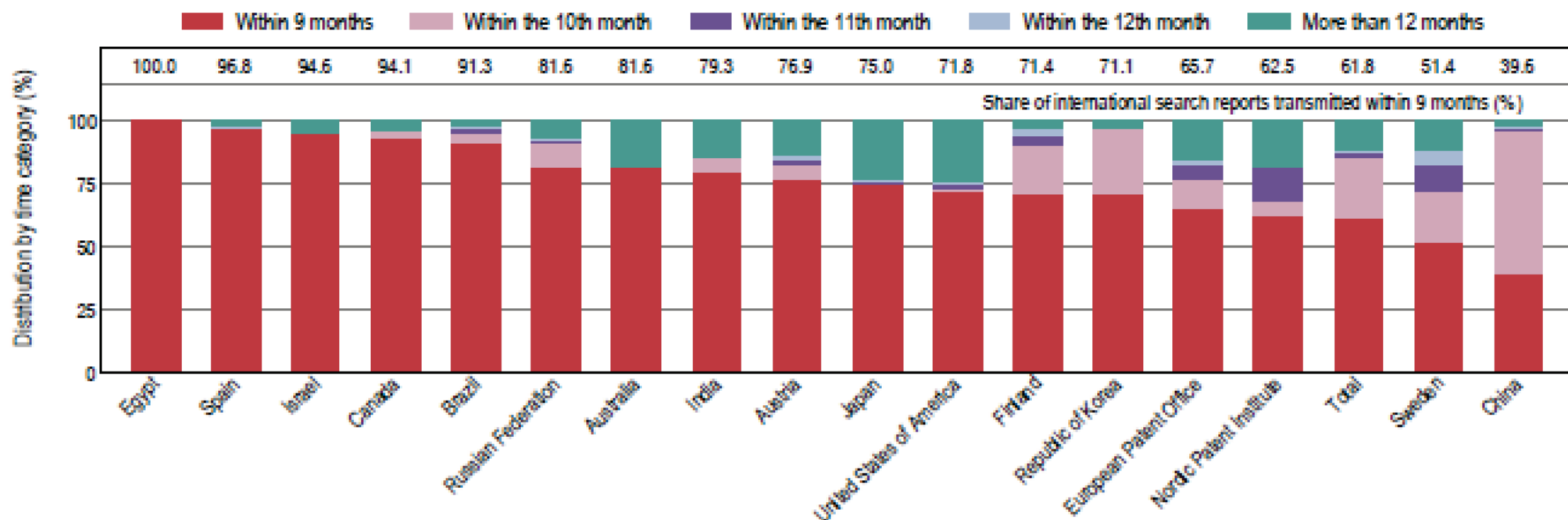
- AU: \$1789 (second and subsequent inventions \$1789 each)
- EP: \$2125 (second and subsequent inventions \$2125 each)
- IL: \$909 (second and subsequent inventions \$909 each)
- JP: \$577 (second and subsequent inventions \$577 each)
- KR: \$1219 (second and subsequent inventions KRW 225000 each, or about \$201 each)
- RU: \$525 (second and subsequent inventions \$525 each)
- US: \$2080 (second and subsequent inventions \$2080 each
 - \$1040 if the applicant is a small entity (second and subsequent inventions \$1040 each)
 - \$520 if the applicant is a micro-entity (second and subsequent inventions \$520 each)
- If you think you are likely to have multiple inventions, consider ISA/KR

Additional Search Fees in the Event of Lack of Unity of Invention

- Where there is lack of unity the ISA will only search the first invention
- To have the additional inventions searched, applicant has to pay an additional search fee for each invention in the ISA's local currency
- Consider the comparative cost of search if there is a likelihood of lack of unity

Timeliness

Figure C.3.2.3: Timeliness in transmitting ISRs to the IB, measured from priority date by time by category, and by ISA, 2014



- Source – WIPO
- Among ISAs available to RO/US filers:
- Ranking on “within 9 months” – IL, RU, AU, JP, US, KR, EP
- Ranking on “more than 12 months” – KR, IL, RU, EP, AU, JP, US

Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional stage, you don't have to pay a search fee to the DO/EP
- EPO “drinks its own Champagne”
- If you pick ISA/US and get a favorable WO or pick IPEA/US and get a favorable IPRP (Chapter II) and later enter the US national stage, you get out-of-order examination and reduced search and examination fees (37 CFR 1.496)
- If you pick IPEA/AU, you get reduced examination fee in EO/AU

Rate limiting

- ISA/AU limited to 250 cases per quarter
- ISA/IL limited to 75 cases per quarter
- ISA/JP limited to 300 cases per quarter (later, 475 per quarter)

Language Competency

- An ISA/AU or ISA/US searcher might read only English
- ISA/EP searchers read at least English, German, and French, and some also read additional languages
- ISA/IL searchers read Hebrew and English and most also read Russian
- ISA/JP searchers read Japanese and English
- ISA/KR searchers read at least Korean and English and most also read Japanese
- ISA/RU searchers read at least Russian and English and some also read additional languages
- Client may or may not want prior art in other languages to be found

Excluded subject matter and subject matter not required to be searched

- An International Authority may exclude certain subject matter from its agreement with WIPO to act as an ISA and IPEA
- If all the claims are directed to such subject matter, ISA will issue an Article 17(2) (a) declaration of non-establishment of the ISR

EP: Excluded Subject Matter

- Where the IA is filed by a national or resident of the US ...
 - and where the application was filed in RO/US or RO/IB ...
 - Then a claim directed to “a business method as such” will not be searched.
 - Other claims containing technical features will be searched.

EP: Limitation on Number of Independent Claims in a Category

- Where there are two or more independent claims in the same category of invention (i.e. product, method) that are in unity of invention:
 - ISA/EP may issue an informal communication telling applicant that the description, claims or drawings fail to comply with the PCT requirements to such an extent that a meaningful search cannot be carried out because the plurality of independent product claims lack conciseness as required by PCT Article 6
 - Applicant may need to choose which independent claim should be searched
 - Unlike a unity of invention requirement, applicant cannot pay for the search of the other independent claims in that category
 - Best to ensure that most important independent claim is listed first

JP – subject matter limitation

- ISA/JP is available to RO/US filers only if the subject matter is “green”.
- A seven-page listing of permitted IPC classes is available.

Subject Matter Not Searched

- AU
 - Methods of treatment
 - Plant and animal varieties
- KR
 - Methods of treatment of the human body by therapy
- RU
 - Methods of doing business
 - Software per se
 - BUT RU does search methods of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (PCT Rule 39.1 (iv))

Outsourcing

- ISA/US searches are outsourced
- Continued user concern that USPTO examiners in US national phase may not give full faith and credit to outsourced ISA/US searches and written opinions
- USPTO focus on ensuring the quality of work from ISA/US contractor

Provision of Cited References

- ISA/AU provides copies of cited references upon payment of AUD 50 (about \$38) per document
- ISA/EP provides copies of cited references
- ISA/IL provides copies of cited references upon payment of ILS 44 (about \$12) per document
- ISA/JP provides copies of cited references upon payment of JPY 1400 (about \$12) per document
- ISA/KR provides a temporary link to a web page containing electronic copies of cited references
- ISA/RU provides copies of cited documents
- ISA/US provides copies of cited non-US patent documents and non-patent literature

Supplementary international search

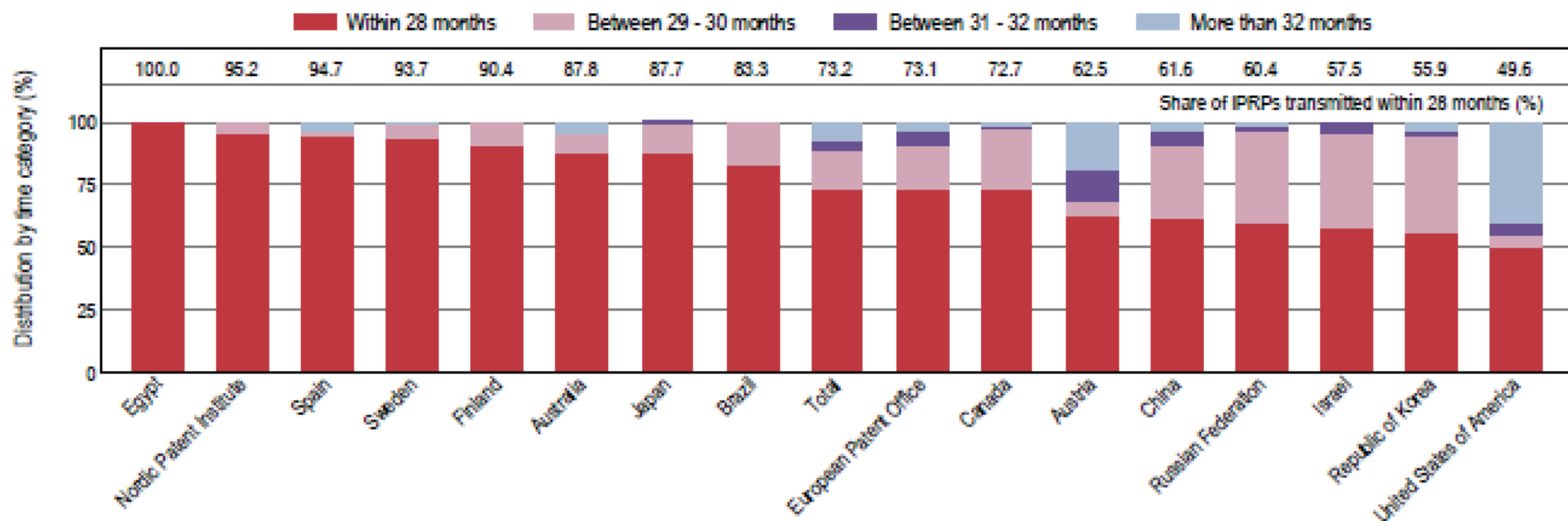
- Can ask another ISA to do its own search in addition to the standard ISA search, if other ISA allows this
- Most ISAs do not allow this, but notably the EPO does offer to do SIS
- Deadline to do this is 19 months from priority
- Supplementary search fee to be paid to IB
- SIS Report is produced by the SISA
- Result of using EPO as SISA is that when entering European regional phase, application is treated in same manner as if EPO had been the ISA
- If e.g. EP and US are both important, can get both to do international search to have a clearer view of what prior art will be cited in the national phase, before incurring national/regional phase entry costs

Your choice of ISA affects your later choice of IPEA

- AU/EP/IL/JP will be available as IPEA to the US filer in a particular PCT application only if that IPEA was also the ISA
- Bear this in mind when selecting ISA

IPEA timeliness

Figure C.5.2.2: Timeliness in transmitting IPRPs to the IB by time by category and by IPEA, 2014



- Among IPEAs available to RO/US filers –
- Ranking is AU, JP, EP, RU, IL, KR, US
- US ranks particularly poorly

Thank you

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Amending the International Application and Filing Informal Comments

Carol Bidwell
July 2015

Comparison of Article 19 and Article 34 amendments

Chapter I (Article 19)

- claims only
- one opportunity only
- for provisional protection and to overcome prior art applied by ISA
- effective in all DOs
- filed within the later of 2 mos. of transmittal of the ISR or 16 mos. from the priority date
- filed directly with IB
- formality review by IB
- published together with the international application as filed
- serve as basis for examination by IPEA where a demand is filed unless reversed

Chapter II (Article 34)

- description, claims, drawings
- multiple opportunities possible*
- to overcome prior art applied by ISA and IPEA
- effective in all EOs
- filed together with the demand or within the 54bis.1 time limit for filing a demand; later amendments possible
- filed directly with IPEA
- formality review and substantive examination by IPEA
- are not published but are available in PATENTSCOPE after 30 mos.
- serve as basis for examination by IPEA unless superseded

* Amendments need not be considered if received after examiner has begun to prepare another written opinion or the report

How to make amendments to the claims (Rules 46.5 and 66.8)

- Where claims are amended under Article 19 or 34, they must be presented in the form of replacement sheets containing a complete set of claims
- In case of cancelation of certain claims, no renumbering of the remaining claims is required
- A letter, signed by the applicant or the agent, must accompany the amendment that
 - ❑ identifies claims that differ because of the amendment from the original claims
 - ❑ draws attention to the differences between the original claims and the amended claims
 - ❑ identifies claims that are canceled and
 - ❑ indicates the basis for the amendments in the application as filed

How to make amendments to the description and drawings (Rule 66.8)

- Where the description or drawings are amended under Article 34, replacement pages are required for every sheet which differs from the sheet previously filed
- A letter, signed by the applicant or the agent, must accompany the amendment that
 - ☐ draws attention to the difference between the replaced sheets and the replacement sheets
 - ☐ indicates the basis for the amendments in the application as filed and
 - ☐ preferably explains the reasons for the amendment

Practical Advice

Indicating the basis for amendment of the international application

Q: Further to the entry into force of the amendment to PCT Rule 46.5 concerning the additional requirement to indicate in a letter the basis for the amendments to the claims under PCT Article 19, please could you explain how such indications should be made. What is the difference between this letter, and the statement under PCT Rule 46.4?

A: First of all, it is recalled that when filing amendments to the claims under PCT Article 19 or, if a demand for international preliminary examination has been filed, under PCT Article 34(2)(b), the applicant is required to submit, in the language of publication, replacement sheet(s) containing a full set of claims in replacement of all the claims originally filed (PCT Rules 46.5(a) and 66.8(c)).

On 1 July 2010, amendments to both PCT Rule 46.5, concerning amendments to the claims under PCT Article 19, and PCT Rule 66.8, concerning amendments to the claims, the description and the drawings under PCT Article 34, entered into force. As a result of these amendments, the applicant is required to include in the letter accompanying the amendments, an explanation of the basis for the amendments in the application as filed, in other words, an indication of where in the application as filed there is support for the amendments. This is required in addition to the previously existing requirements for an accompanying letter which, in the case of the claims, indicates the differences between the claims as filed and those as amended (PCT Rules 46.5 and 66.8(c)).

As far as the basis for the amendment is concerned, the letter must make specific references to particular parts of the description or the drawings. This is so that the examiner may, by consulting those precise references in the application, assess whether the amendments contain subject-matter which extends beyond the disclosure of the application as filed (see PCT Articles 19(2) and 34(2)(b)). Therefore, non-specific indications such as “see the description as filed” or “see the claims as filed” are generally not considered sufficient for an indication of the basis for the amendment.

The following is an example of an explanation of the basis for some amendments to claims:

“Claim 1 amended; claims 2 to 7 unchanged; claims 8 and 9 amended; claims 10 to 14 cancelled; claims 15 to 17 unchanged; new claim 18 added.

- (i) Basis for the amendment: Claim 1 has been amended at lines 4 and 11 to 14 and now indicates that the filter comprises a periodic backwashing means serially coupled to a first and second chamber. The basis for this amendment can be found in original claims 2 and 4 as filed.
- (ii) Basis for the amendment: Concerning amended claims 8 and 9, the indication of ‘quick-fire piston’ is in paragraphs Nos. 2 and 19 in the description as filed.
- (iii) Basis for the amendment: Claim 18 is new, the indication is in drawing no. III of the original application.”

Note that, in the case of amendments under PCT Article 19, which should be filed with the International Bureau (IB), where the international application is not in the same language as the accompanying letter (which should be furnished in English or French – see PCT Rule 92.2(d)),

references may be made to the international application in the language of the application where to do so will facilitate the work of the examiner in finding the reference, for example:

“Basis for the amendment: Concerning amended claim 2, the indication of “請求項1に基づくパーキングアシストシステム” is in paragraphs Nos. 23, 46 and 85 in the description as filed.”

Note that substantive compliance with the requirement to submit a letter indicating the basis for amendments in the application is not checked during the international phase unless the applicant requests international preliminary examination. If the IPEA finds that the replacement sheets were either not accompanied by such a letter or that the letter failed to indicate the basis for the amendment, it is not obliged to invite correction, and may establish the international preliminary report on patentability (Chapter II of the PCT) as if such amendment had not been made (PCT Rule 70.2(c-bis)). Compliance with this requirement may also be important during the national phase, when it may be checked by the designated Offices, and failure to comply may result in disallowance of the amendments.

The *PCT Applicant's Guide* will be updated shortly with guidance on how to include information on the basis of the amendments in the accompanying letter.

With regard to your question concerning the difference between the letter accompanying the amendments and the statement under PCT Rule 46.4: whereas the purpose of the accompanying letter is to help examiners understand exactly what the amendments consist of, and to give the examiner a tool to help him/her verify that no new matter was added, any amendment to the claims under PCT Article 19 may be accompanied by a brief statement by the applicant explaining why the amendments were made and indicating any impact it might have on the description and the drawings.

Unlike the letter, the statement is optional and is published together with the international application itself. Whereas the letter accompanying the amendments under PCT Article 19 must be in either English or French, the statement must be in the language in which the international application is published (for further information on the drafting of the statement, see PCT Rule 46.4). The statement explaining the amendments must therefore not be confused with and must be clearly distinguished from the letter indicating the differences between the claims as filed and those as amended and the basis for the amendments (it is also distinct from the “statement concerning amendments” in Box No. IV of the demand form which should be completed when filing a demand for international preliminary examination). This is why it must be identified as such by a heading “Statement under Article 19(1)”, and presented on a separate sheet.

Additional remarks on amendments

- Article 19 and Article 34 amendments must not go beyond the disclosure of the international application as filed
 - Article 19 amendments are not reviewed by the IB for compliance
 - if Article 34 amendments go beyond the disclosure of the international application, the international preliminary report on patentability (Chapter II)
 - will be established as if that amendment had not been made
 - will indicate the reasons why the amendment is considered to go beyond the disclosure in the international application as filed
 - will include the amended sheets as annexes
- If the letter indicating the basis for the amendments in the application as filed is missing, the international preliminary report on patentability by the IPEA may be established as if the amendments had not been made

Amendments upon entry into the national phase (Articles 28 and 41; Rules 52 and 78)

- All parts of the international application may be amended (including title and abstract)
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments possible for different DOs and EOs
- Generally any claims fee due for the national phase will be calculated on the basis of the number of claims valid at the time of entry into the national phase

Informal comments on the written opinion of the ISA

- Applicant may file informal comments on the written opinion of the ISA with the IB
- Informal comments should be filed by 28 months from the priority date
- The IB will send the informal comments to the DOs together with the IPRP (Chapter I) but not before 30 months from the priority date
- It is up to the DOs to decide whether and to what extent to take the informal comments into account in the national phase
- DOs may require translation of informal comments
- Where a demand is filed, the IB will not forward any informal comments to the IPEA
- Informal comments will be open to public inspection as part of the file of the international application at the IB but not before 30 months from the priority date

Article 19 & Article 34

Jeremy Smith
July 2015

Article 19 & Article 34

- You have your ISR/WO
- What should you do now?

1

Article 19

Docketing Article 19 amendment deadline

- Art. 19 amendment is allowed between receipt of the ISR and the latest of:
 - **Two months** from date of mailing of ISR
 - **Sixteen months** from priority date
 - Date upon which WIPO completes **technical preparations** for publication
 - Usually fifteen days before the scheduled publication date
 - Scheduled publication date is usually the first Thursday after the 18-month date
- Can use the ePCT Time Line
- Can calculate using PCT Time Limit Calculator:
www.wipo.int/pct/en/calculator/pct-calculator.html

Where to file Art. 19 amendment?

- File with the International Bureau
- Can e-file in ePCT as an “upload document”

What does Article 19 allow?

- One opportunity to amend
- **Claims** only
 - must file complete set
- Must file accompanying **letter**
 - identify amendments and/or cancelled claims
 - indicate basis for amendments

What does Article 19 allow?

- May also file **brief statement**
 - “explaining the amendments”
 - no disparaging comments on ISR or the relevance of citations in ISR
 - can say claim is amended with reference to a particular citation
 - no more than 500 words
- Brief statements are rarely filed, in practice
- Statement may be considered as an admission regarding disclosure of referred citation, so best avoided

Effect of Article 19 amendments

- Amended claims and, if present, brief statement (provided it complies with provisions) will be published
- Publication is usually with the international application (as well as the original claims)
- If too late to be included with IA, published separately afterwards
 - Best to ensure amendments are filed in time to be included with IA (i.e. in time for “technical preparations” deadline)

Should you do an Article 19 amendment?

- Use Article 19 Amendments:
 - For Provisional Protection
 - particularly useful if plan to broaden scope of independent claims from scope as filed
 - If you don't want to use IPE (Art. 34), but would like to centrally amend IA to avoid having to file amended claims in each dO
- If planning to use Art. 34, then no need to amend under Art. 19, unless provisional protection benefit

Should you do an Article 19 amendment?

- Art. 19 amendments have no effect on the IPRP, which will repeat the ISR+WO and be based on the claims as filed (assuming no Art. 34 amendment)

1

2

Article 34

Docketing the Demand and Article 34 amendment deadline

- Must file Demand by later of:
 - **Three months** from date of mailing of ISR+WO
 - **22 months** from priority date
- Can use the ePCT Time Line
- Can calculate using PCT Time Limit Calculator:
www.wipo.int/pct/en/calculator/pct-calculator.html
- Handling fee and preliminary examination fee to be paid to IPEA by later of:
 - **One month** after Demand filed
 - **22 months** from priority date
 - Can pay late but with surcharge

Where to file?

- File with the IPEA
- Can e-file as an “action” in ePCT

What does Article 34 allow?

- May amend claims, description and drawings
 - If Art. 19 claims were filed, may amend claims again or use Art. 19 claims
 - If amending claims, file complete set of claims with letter indicating basis
 - If letter not provided, amendment may be ignored
- May file response to objections in WOISA
- Substantive examination by IPEA on (amended) claims
- May be allowed further amendment after examination
- IPRP will be based on situation at end of IPEA

What does Article 34 allow?

- Amendments should be filed with demand
 - If filed later, will be ok if IPEA has not yet started to draw up IPER, but this date is not known
- “Trick” to get more time to file amendments (in emergency):
 - When filing demand, state that amendments under Art. 34 are submitted with the demand, but don’t actually include any amendments (R. 53.9)
 - Will then be invited to file the amendments within a time limit (R. 60.1(g))
 - IPE won’t begin until amendments filed (provided filed within time limit) (R. 69.1(e))

Effect of filing a Demand and Article 34 amendment

- May be able to turn a negative WOISA into a positive IPRP
 - This can lead to quick grant, particularly at the eO that carried out IPE
- Guaranteed quick action from IPEA
- Getting 30 months from Luxembourg, Uganda, and Tanzania (otherwise deadline to enter national phase is 20/21 months)
- IPE is confidential, but IPER is sent to eOs and may then become available through them

Should you file a Demand and Article 34 amendment?

- Reasons to file demand:
 - If you are seeking early grant, as grant may be quicker at eO (particularly eO=IPEA) following positive IPRP
 - Better view of prospects before paying for national phase entry
 - If you would like to centrally amend IA to avoid having to file amended claims in each eO
 - Some eO's do not examine, so patent will likely grant in this form
 - If you believe a “clean” IPRP will help in licensing or other exploitation of the invention
 - May be fee reductions at eO=IPEA
 - Use of PCT-PPH to get accelerated prosecution in PPH member countries
 - Need positive IPRP to do this

Should you file a Demand and Article 34 amendment?

- Reasons not to file demand:
 - Increased costs, and costs brought forward
 - Many eO's do not follow the IPRP and will examine independently
 - Amendments that suit the IPEA may not be necessary/desirable in another eO
- A demand is not filed on the majority of PCT applications

Particular case: ISA was ISA/EP

- If ISA was ISA/EP, and if the applicant plans later to enter EP regional phase ...
- Then it may be smart to do a Demand and Article 34 amendment, with a goal of getting IPEA/EP to say that it is patentable
- EP regional phase should then proceed smoothly with quick grant
- PCT-PPH can be used in other countries, many of which respect the EPO's positive opinion

Thank you

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Patent and Trade Mark Attorneys

Kilburn & Strobe



An Overview of ePCT

ePCT

- ePCT is WIPO's online portal that provides
 - PCT services to both applicants and Offices
 - secure and direct interaction with international applications maintained by the IB
- A web-based electronic filing system is available for filing in RO/IB as well as 21 other receiving Offices*
- Applicants can conduct most PCT transactions with the IB electronically using ePCT

* As of 1 July 2015

ePCT modes

■ “Public” services

- ☐ only requires a WIPO User Account (username and password)
- ☐ functionality limited to document upload, fee payment and third party observations
- ☐ can be used to upload documents for applications filed with
 - RO/IB upon receipt of form PCT/RO/105
 - any RO upon receipt of form PCT/IB/301

■ “Private” services

- ☐ requires authentication using both a WIPO User Account (username and password) and a digital certificate
- ☐ gives access to the full range of services and functions including:
 - access to applications filed as of January 1, 2009, including access before publication

ePCT Portal

The ePCT system offers two distinct types of online services:

- ePCT *public* services, requiring the creation of a standard WIPO user account, enable the upload of documents, access to documents previously uploaded by the account holder and the use of the third party observation service.
- ePCT *private* services, requiring additional authentication by uploading a digital certificate to a WIPO user account, provide a full suite of functions to authorized users for international applications filed as 1 January 2009.

ePCT private services

[Access ePCT private services](#)

(requires WIPO user account and digital certificate)

Smartcard holders using Internet Explorer should log in by clicking [here](#).

ePCT public services

[Access ePCT public services](#)

(requires only WIPO user account)

[Create an account](#)

[Obtain/Upload a certificate](#)

Highlight of the latest ePCT Release



The ePCT user interface is now available in all the languages of international publication

Email updates

PCT Newsletter – News and information for users of the PCT System, including fee tables and seminars. Monthly.

[Sign up](#) | [All WIPO newsletters](#)

SHORTCUTS

- [Getting started](#)
- [Applicant user guide](#)
- [ePCT-Filing guidelines](#)
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- [ePCT for document upload](#)
- [Observations by Third Parties](#)
- [What's new for Applicants?](#)

SHORTCUTS FOR OFFICES

- [Getting started for Offices](#)
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- [What's new for Offices?](#)

OTHER SHORTCUTS

- [Try ePCT in DEMO mode](#)
- [PCT Resources](#)

<https://pct.wipo.int/LoginForms/epct.jsp>

- Create an user account
- Request a WIPO digital certificate for uploading to access ePCT private services

WIPO ACCOUNTS

ePCT

[My profile](#)
[Login](#)

REGISTRATION

[Create an account](#)
[Request confirmation code](#)
[Reset password](#)
[Forgotten username](#)

HELP

[Getting started](#)
[ePCT for document upload](#)
[Observations on prior art](#)
[User guide](#)
[FAQ](#)
[What's new in ePCT?](#)

Create an account

Please fill in your details below in order to register for an online user account.
All fields marked with * are mandatory.

User information

Username *	
First Name *	
Last Name *	
Company/Organization	
Phone	
Address	
Country *	
Language (interface + notifications) *	

E-mail

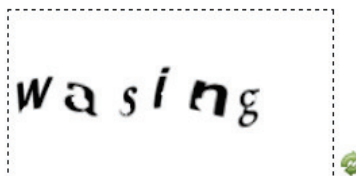
Please indicate an **individual** e-mail address below. **The same e-mail address cannot be used with another account.**

E-mail *	
Confirm E-mail *	

You will receive confirmation by e-mail about the creation of your user account. Please check that your e-mail address is indicated correctly.

Password

Password * (password policy)	
Confirm password *	
Verification *	Type the characters displayed below.



Characters:

[Create an account](#)

Using ePCT public services to upload documents

- Go to the ePCT home page (<https://pct.wipo.int/LoginForms/epct.jsp>)
- Click on “Access ePCT public services” button
- Enter your username and password and click the “Login” button

Authentication

To log in, enter your username and password.

Username:

Password:

[Create an account](#)

[Forgotten username?](#)

[Forgotten password?](#)



ePCT public services



Current time in Geneva, Switzerland  Sunday, 28 September 2014, 0:21 CEST

ePCT

Search IA

My History

Portfolios

Search International Application

International Application Number :

International Filing Date :

Search

Reset

- Click on the “Search IA” tab
- Enter the IA number and IFD
- Click “Search” button to bring up the application

ePCT “public services” to upload documents

File View

Upload Documents

Third Party Observations

Title	:	(EN) PIXEL ARRAY, IMAGE SENSOR INCLUDING THE SAME, AND METHOD OF DRIVING THE SAME (FR) MATRICE DE PIXELS, CAPTEUR D'IMAGES LA COMPRENANT, ET PROCÉDÉ DE COMMANDE CORRESPONDANT
International Filing Date	:	29 Apr 2011
Priority Date	:	13 Apr 2011
International Publication Date	:	18 Oct 2012
International Publication Number	:	WO/2012/141372
IA Status	:	Published on 18 Oct 2012
Applicant Name	:	LG INNOTEK CO., LTD. (+1)
Inventor Name	:	PARK, Seong Hyung
Portfolio	:	
Processing Team at IB	:	PT01 Tel. +41 22 338 74 01 e-mail: pt01.pct@wipo.int

1. Select document type >>

-  Article 19 Amendments
 -  Letter accompanying Amended claims
 -  Amended Claims Statement
 -  Amended Claims
- +  Supplementary International Search
- +  Other
- +  Declarations under Rule 4.17
- +  Withdrawal
- +  **Add Document**

Examples of documents that can be uploaded using ePCT public services

- Article 19 amendments + letters
- Notices of withdrawal (form PCT/IB/372)
- Rule 92bis changes for individual or multiple IA's
- Request for indication of availability for licensing purposes
- Third party observations
- Powers of attorney
- General correspondence
- Declarations under Rule 4.17
- Correction or additions of priority claims
- Requests for supplementary international search
- For more information, download “ePCT for Document Upload”
www/pct/en/epct/pdf/transition__to_epct_for_document_upload.pdf

ePCT private services uses

- Prepare the request form using web-based software and file the international application
 - ☐ directly with RO/IB or
 - ☐ with certain other receiving Offices
- Use the Notifications feature as a back up for your docketing system – you can specify reminders of various deadlines
- Preview the front page of the WO pamphlet prior to publication
- Give access rights to others
- View all papers in the record copy file - online file inspection
- Submit various documents to the IB
- Prepare the demand form using web-based software and file it with the IB

WIPO digital certificate

- Each user must obtain his/her own WIPO digital certificate to take advantage of ePCT private services
 - USPTO digital certificate is not supported by ePCT
- WIPO digital certificate
 - small electronic file with data that identifies the user
 - available free-of-charge from WIPO
 - valid for 2 years
 - renewable
- The requester has one opportunity to install it within a week of its issuance into the same browser on the computer used to request it
 - supported browsers for requesting WIPO digital certificates are Mozilla Firefox 3.6+ (**recommended**); Internet Explorer 7-10; Internet Explorer 11 only if 'compatibility mode' setting used
 - copies can be installed on other computers and used with other browsers after the initial installation

Access Rights

- eOwner
 - complete control over all aspects of the PCT application
- eEditor
 - can do everything except assign access rights
- eViewer
 - “Look” but don’t “Touch”

e-Handshake

- You need to establish e-Handshakes with each of the individuals that you want to give access to your international applications
- The e-Handshake consists of the association and trusted recognition between different WIPO User Accounts
 - e-Handshakes do not directly result in access rights
 - after an e-Handshake has been established, you then have to specifically assign access to the applications
- It is possible to create a default list of e-Handshake users

Logging in to ePCT private services (1)

ePCT Portal

The ePCT system offers two distinct types of online services:

- ePCT *public* services, requiring the creation of a user account and the upload of documents previously uploaded by the applicant.
- ePCT *private* services, requiring additional authentication for authorized users for internal use.

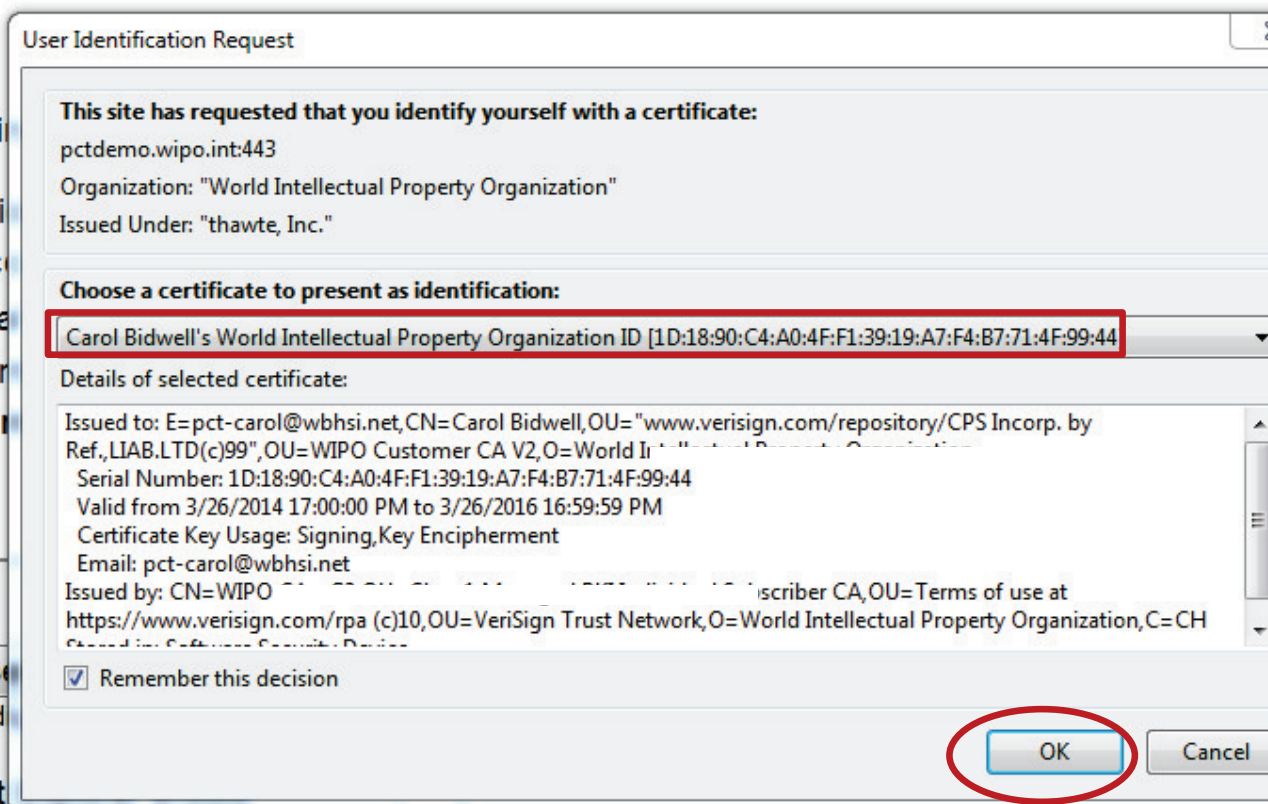
As of March 1, 2014, the filing of new international applications is now possible in addition to RO/IB.

ePCT private services

Access ePCT private services

(requires WIPO user account and digital certificate)

Smartcard holders using Internet Explorer can log in by clicking [here](#).



- When you click "Access Private Services", your browser ask you to choose a digital certificate
- Pick your WIPO digital certificate from the list
- Click "OK"

Logging in to ePCT private services (2)

ePCT *private* services

The system has successfully detected a digital certificate for login to ePCT *private* online services.
Please enter your Username and Password to confirm your identity.

- Enter you Username and Password
- Click “Login”

Authentication

To log in, enter your username and password.

Username:

Password:

[Create an account](#)

[Forgotten username?](#)

[Forgotten password?](#)

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OTHER SHORTCUTS

- [Try ePCT in DEMO mode](#)
- [PCT Resources](#)

Supported browsers: Mozilla Firefox 3.6+ (recommended), Internet Explorer 7+
The system may not work correctly with other browsers and we will not be able to give assistance in these cases.

Taking eOwnership

- eOwnership is automatic for users who electronically file with RO/IB using ePCT-Filing software
- Anyone filing in RO/US who has a WIPO digital certificate can request an eOwnership code for insertion into the PCT-SAFE request form in order to establish eOwnership at the time of filing
 - ☐ log into ePCT private services and
 - ☐ request an eOwnership code
- Otherwise eOwnership can be established after filing on paper or electronically filed with a non-supported digital certificate, e.g., in RO/US, where an access code was not entered into PCT-SAFE

Taking “eOwnership” when preparing the request using PCT-SAFE (1)

[ePCT](#) **[eOwnership](#)** [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [ePCT-Filing](#) [Draft Actions](#)

Default access rights to be given to my eHandshake users when I am confirmed as eOwner

Manage my default access rights [Edit/view](#)

Confirm eOwnership

All fields marked with * are mandatory

Confirm eOwnership

☒ Single IA ☐ Multiple IAs

International Application Number *

International Filing Date *

Confirmation Code * 

Only for unpublished IAs

[Confirm](#)

[Clear](#)

Request eOwnership Code for use in PCT e-filing software

Request eOwnership Code

For use at the time of filing a new application

[Request Code](#)

Taking “eOwnership” when preparing the request using PCT-SAFE(2)

eOwnership Code

Copy/Paste your Customer ID and eOwnership Code to the fields on the e-filing software signature screen.

NOTE: This eOwnership Code can only be used at the time of filing, for one application and is not required when using ePCT-Filing.

Customer ID	user_US_BIDWELL_CAROL_1376
eOwnership Code	FZA5A922D7J3X0

Close

Signature

Legal Signature

☒ Alphanumeric

☐ Facsimile

☐ Advanced Digital (No more signatures can be applied - this signature should be finalizing the signing process.)

Assign eOwnership in ePCT (optional)

ePCT Customer ID:

ePCT eOwnership code:

Apply Signature Cancel

Taking “eOwnership” after filing on paper or with a non-supported digital certificate

- Log into ePCT private services
- Enter the international application number, IFD and confirmation code found at the bottom right-hand corner of the PCT/IB/301
 - this will trigger an on-line form for the International Bureau to approve or reject the request

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Authorized officer Bardini Ann e-mail pt04.pct@wipo.int Telephone No. +41 22 338 74 04
Form PCT/IB/301 (July 2010) I/EYK64AFLSN7PW0	

How to create an new international application for ePCT-filing

WIPO PCT The International Patent System

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Current time in Geneva, Switzerland Sunday, 30 March 2014, 17:35 CEST

ePCT eOwnership Notifications My History Portfolios Workbench **ePCT-Filing** Draft Actions

ALL per page Filter: All

Create new IA

File reference ▲	IA Number ⇅	My rights	Type	Status ⇅	Creation date ⇅	Last update ⇅	My comments	Warning	Action
POIUY		eOwner	New IA	Draft	22 Jan 2014 23:17 CET	22 Jan 2014 23:39 CET			rename delete backup

Go to top

ePCT-Filing 2.0.002 #369 | Terms of use

- Click on the ePCT-Filing tab and
- Click “create new IA”

Create new IA

File reference * **ABC-234**

Receiving Office * IB - International Bureau of WIPO

Create **Cancel**

eOwner New IA Draft 22 Jan 2014 23:17 CET 22 Jan 2014 23:39 CET

- Enter the file reference number for the new IA
- Select the Receiving Office where the IA will be filed from the drop down menu
- Click “Create” to begin preparing the IA for filing

Click on the various tabs to create the IA

Current time in Geneva, Switzerland  Thursday, 15 January 2015, 0:29 CET

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [ePCT-Filing](#) [Draft Actions](#)

ABC-234 

New IA: ABC-234

RO/IB
ISA/
Filing language: EN - English

[Preview request](#)

[Validation Report:](#) No errors have been detected 

[Filing options](#) [Priority claims](#) [Designations](#) [Names](#) [International search](#) [Declarations](#) [Biology](#) [IA contents](#) [Accompanying items](#) [Fees](#) [Signature](#) [Access rights](#) [Summary + File IA](#) 

Warning: 

[Clone as New IA](#)

Filing Options

File reference * ABC-234 [Edit](#)

Receiving Office * IB - International Bureau of WIPO [Look up national security requirements](#)

Filing method * [ePCT-Filing](#)

Language of Request * EN - English

Language of filing of the international application * EN - English

Notifications tab: a backup to your docketing system

■ Preferences

- ☐ specify the events in the lifecycle of an international application for which you want to receive notifications
- ☐ specify how you want to receive notifications

■ Filters

- ☐ received date, read date, date range

■ Clearing notifications

- ☐ removing notifications from the list

Notification Preferences



Notify me about events in IAs where my access rights are:

- ☒ eEditor
- ☒ eOwner
- ☒ eViewer

Method of Notification:

- ☒ e-mail
- ☒ Notifications tab

Notify me about the following events for all IAs in my workbench:

- ☐ I am eOwner and access rights changes are made by another eOwner
- ☐ Priority document(s) still outstanding and international publication is scheduled to take place in 2 weeks
- ☐ Time limit for submitting Article 19 amendments expires in 2 weeks
- ☐ Technical preparations for publication scheduled to close in 2 weeks
- ☐ Time limit for submitting Rectification of Obvious Mistakes to ISA Office (Rule 91.1) expires in 2 weeks
- ☐ Republication event has been scheduled by the IB
- ☐ Time limit to request supplementary international search expires in 2 weeks
- ☐ Time limit to file Chapter II Demand expires in 2 weeks
- ☐ 30 month time limit (end of the international phase) expires in 1 month
- ☐ IA Warning added/modified
- ☐ New document processed and/or new form issued

OK

Cancel

Workbench tab

- View all applications as eOwner, eEditor and eViewer
- Click on a specific IA from the workbench to view the file contents and other information

Current time in Geneva, Switzerland  Tuesday, 23 September 2014, 23:52 CEST

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) **[Workbench](#)** [ePCT-Filing](#) [Draft Actions](#)

Items 1-6 of 6 per page  

☐	IA Number▼	IA Status▲	File Ref▲	IFD▲	Priority▲	Portfolio▲	IASR	Applicant Name▲	My Rights▲	My Comments▲	Warning▲
☐	PCT/IB2014/030404	Not yet Published	testPOA	14 Feb 2014				EPCT TEST COMPANY	eOwner		
☐	PCT/IB2013/033088	Not yet Published	rghghs	25 Oct 2013				DOE, John	eOwner		
☐	PCT/IB2013/030651	Not yet Published	11March2013	11 Mar 2013				METCALFE, Aino	eOwner		
☐	PCT/IB2012/030581	Not yet Published	Demo-101	02 Aug 2012				Sim, Quan-Ling	eOwner		 Priority period ex pir ...
☐	PCT/IB2012/030282	Not yet Published	epct24	11 May 2012	29 Apr 2011			EPCT COMPANY	eOwner		 Erik is o n holiday ne ...
☐	PCT/IB2012/030274	Not yet Published	epct17	11 May 2012	29 Apr 2011			EPCT COMPANY	eOwner		

« « « « « » » » » »

Perform action on selected applications

File inspection

- Open the IA of interest from the Workbench tab
- Click the File View tab

Navigation tabs: ePCT | eOwnership | Notifications | My History | Portfolios | Workbench | ePCT-Filing | Draft Actions | **PCT/IB2013/030651** [X]

Header: PCT/IB2013/030651 - File reference: 11March2013 IA Status : Not yet Published [i] Send ePCT Message [icon]

Sub-tabs: **File View** | Upload Documents | Time Line | Access Rights | History | Actions | Bibliographic Data

Applicant(s) METCALFE, Aino
Inventor(s) METCALFE, Aino
Int. Filing Date 11 Mar 2013
Priority Date No Priority Claim
Title (EN) TEST

IA Status Report [PDF] [XHTML] Warning [icon]
Portfolio [icon] My Comments [icon] Team at IB R&PT
Search Copy Status Not yet sent

Record as held by the IB | Documents for ISA/FI | Documents for IPEA

☐	Documents [Doc ID] ^	Date ^	Status	Pages	[icon]	[icon]
☐	Related Documents					
☐	[icon] ePCT Cover Letter [12]	22 Oct 2013	[icon]	1	[icon]	
☐	[icon] Power of Attorney [11]	22 Oct 2013	[icon]	1	[icon]	
☐	[icon] ePCT Message [10]	02 Oct 2013	[icon]	1	[icon]	
☐	[icon] ePCT Cover Letter [9]	17 Jun 2013	[icon]	1	[icon]	
☐	[icon] General Correspondence [8]	17 Jun 2013	[icon]	1	[icon]	
☐	[icon] Fee Calculation Sheet [7]	11 Mar 2013	[icon]	1	[icon]	

Need help with ePCT

- Use the “CONTACT US” link in the ePCT header
- PCT e-Services
 - Tel: +41-22-338-9523 (Monday to Friday, 9am-6pm Geneva time)
 - E-mail: ePCT@wipo.int
- ePCT User's Guide
 - www/pct/en/epct/pdf/pct_wipo_accounts_user_guide.pdf
- ePCT Filing Guidelines
 - www/pct/en/epct/pdf/epct_filing_guidelines.pdf

Practitioner perspective on ePCT

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

Avoiding looking stupid in front of the client

- ePCT lets you generate a report of all of your cases that have priority-document problems
- You can generate this report every few weeks
- You can then get to work trying to get the priority document problem fixed

Avoiding looking stupid in front of the client

- ePCT lets you generate a report of all of your cases that are missing Form PCT/ISA/202
- You can generate this report every few weeks
- You can then get to work trying to get the ISA to admit that they received the Search Copy

Avoiding looking stupid in front of the client

- ePCT can be configured to send you an email when the end of the 30-month period is near (indeed this is a default behavior)
- This can be part of a multilayered approach to minimizing the risk of missing the 30-month date

Best Practice for filing in RO/US

In ePCT go to “eOwnership” and obtain an
“eOwnership Code”

In PCT-SAFE File Manager, prepare the Request.
When e-signing, include the eOwnership Code

Generate the zip file

In EFS-Web, upload the zip file

This gets your application into ePCT on the
fastest track

Avoiding looking stupid in front of the client

- It is easy to look stupid in front of the client
- There are many ways a PCT filer could look stupid
- PCT-SAFE FM carries out many validations that protect the filer from looking stupid later
- If you are filing in RO/US, use PCT-SAFE FM instead of filling in a Request manually

Best Practice for filing in RO/IB

Use ePCT

This gets your application into ePCT within minutes of your successful e-filing

Avoiding looking stupid in front of the client

- It is easy to look stupid in front of the client
- There are many ways a PCT filer could look stupid
- PCT-SAFE FM carries out many validations that protect the filer from looking stupid later
- ePCT carries out all of the validations that PCT-SAFE FM carries out, plus many more
- If you are filing in RO/IB, use ePCT rather than PCT-SAFE FM

Best Practice for filing a Demand

- Filing a Demand in an IPEA other than IPEA/US?
- Best Practice is to e-file it in ePCT rather than faxing it to the IPEA
- Wire the money using a bank wire system, mentioning the international application number

Best Practice for filing a 92*bis* request

- e-filing in EFS-Web is not a Best Practice
- faxing to WIPO is not a Best Practice
- e-filing to WIPO as a “document upload” is not a Best Practice
- the Best Practice is to do an “action” in ePCT

Best Practice for filing an Article 19 amendment

- e-filing in EFS-Web is not a Best Practice
- faxing to WIPO is not a Best Practice
- e-filing to WIPO as a “document upload” is a Best Practice
- in future, WIPO will offer an “action” for this at which time the “action” will be the Best Practice

Permitting clients, colleagues, and inventors to see filed PCT applications

- ePCT allows you to give access in ePCT to clients, foreign colleagues, and inventors for PCT applications that you have filed
- This permits them to check the status of the case
- They will be notified when papers are filed
- They will be notified of communications from Offices

Permitting clients and inventors to see submission packages that have not yet been e-filed

- ePCT allows you to give access in ePCT to clients and inventors for e-filing submission packages that have not yet been e-filed
- This permits clients and inventors to review the Request and the Application Body for correctness

Same-day corrections

- ePCT offers a “same-day corrections” button

Submit same-day corrections

Time remaining for same-day corrections : 12:20

What?

You aren't yet set up to use ePCT?

- Each person in your firm or department should get a WIPO user ID and password
- Each such person should also obtain a WIPO cryptographic certificate
- Each such person should upload the public portion of the WIPO crypto certificate to ePCT
- Then get each of your PCT applications, going back to January of 2009, loaded into ePCT

Best Practice

Insert the Permalink to your docketing system or intranet

The screenshot shows a web interface for a patent docketing system. At the top, there is a navigation bar with buttons: ePCT, eOwnership, Notifications, My History, Portfolios, and Workbench. Below this is a header bar with a chain-link icon (permalink) highlighted by a green box, followed by the text "PCT/US2009/036433 - File reference DANA-P001-WO" and "IA St". Below the header bar is another navigation bar with buttons: File View, Upload Documents, Timeline, Access Rights, History, and Action. The main content area displays a table with the following information:

Applicant(s)	STANGEL, Dana
Inventor(s)	STANGEL, Dana
Int. Filing Date	06 Mar 2009
Priority Date	06 Mar 2008

To the right of the table, there are two sections: "IA Status Report" with PDF and XML icons, and "Portfolio" with a folder icon labeled "MISC".

Strategies for PCT Filing

AIPLA PCT Seminar
July, 2015



CHINA PAT Intellectual Property OFFICE
Beijing · Hong Kong

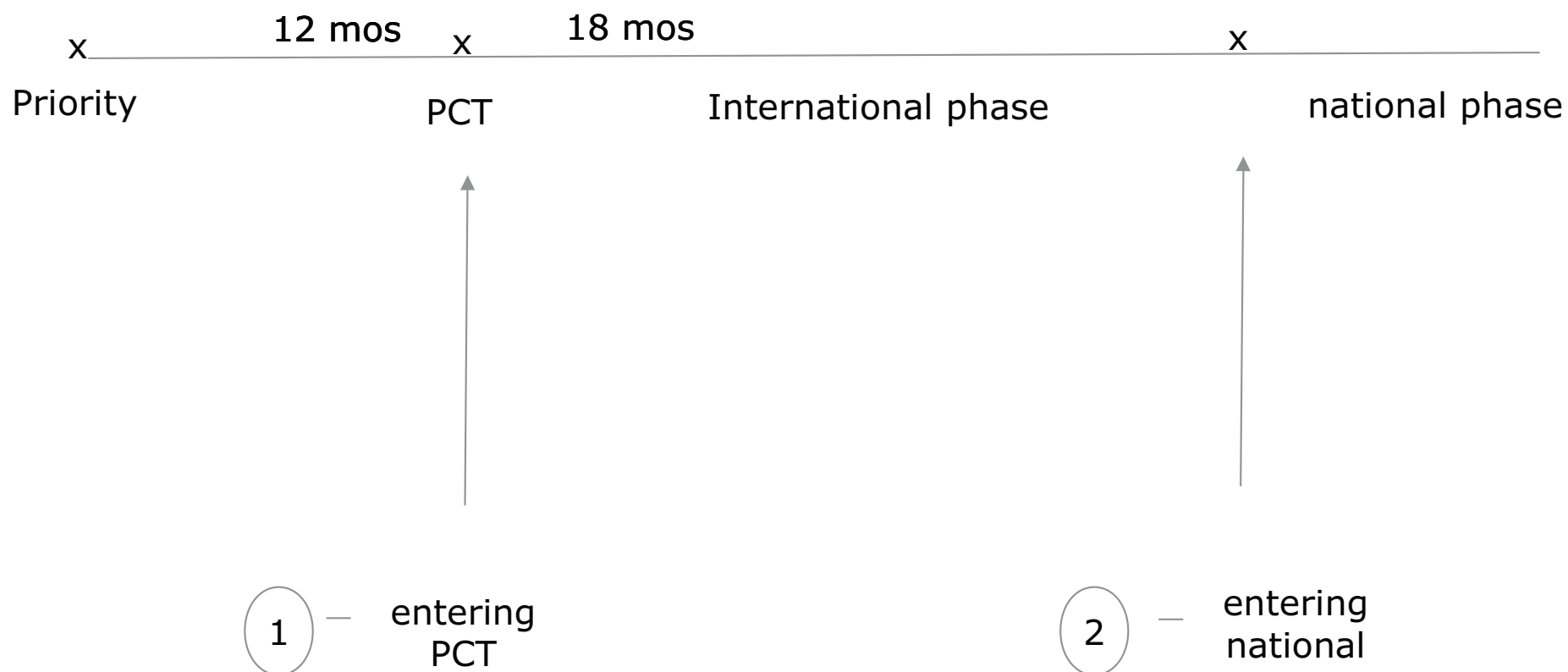
[Http://www.china-pat.com](http://www.china-pat.com)

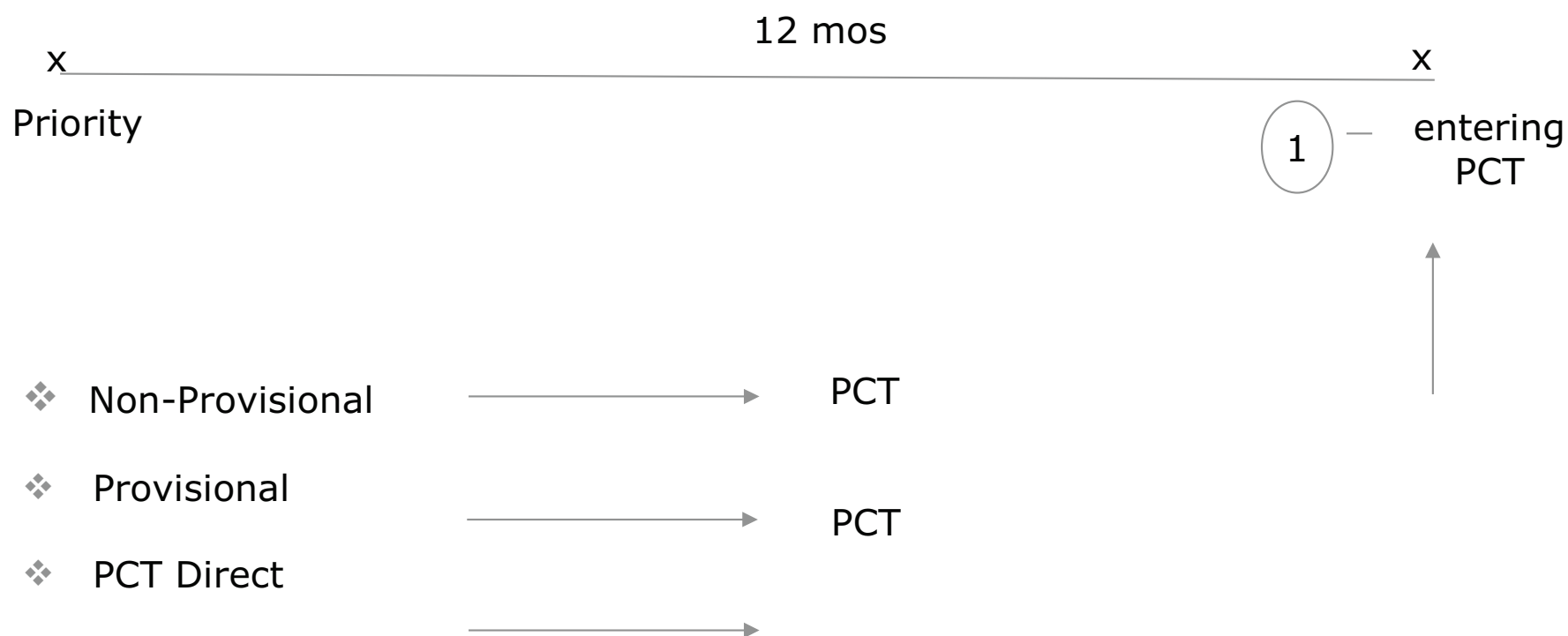
- ❖ Historically US had a number of differences than the rest of the world
 - First-to-invent vs. First-to-file
 - Grace Period
 - What constitutes prior art (local novelty vs. absolute novelty)
 - Commercialization vs. Divuligation
 - e.g. Experimental use
 - Offer for sale
- ❖ AIA has made US law substantially similar to the rest of the world – but still some differences.
 - Grace Period
 - Secret Prior Art
- ❖ However, we will have essentially 2 sets of laws at least until March 15, 2034

- ❖ Do not delay – don't rely on the Grace Period
- ❖ Consider using Confidential Agreements if disclosure is required
- ❖ File application quickly – “race to the patent office”
- ❖ However, still need full disclosure
- ❖ Can't think of just US – must think globally

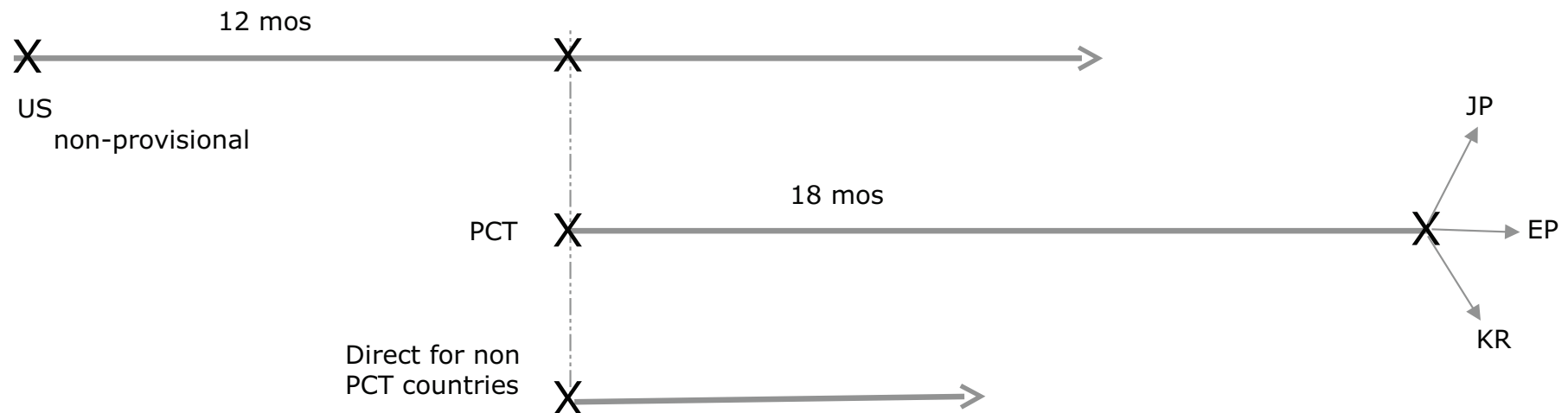
- ❖ There are different available routes for foreign filing, even using the PCT
- ❖ We must be able to combine available “tools”
 - Provisional Application
 - PCT
 - EPC
 - Paris Convention
 - Bilateral Treaties, e.g. Taiwan
- ❖ Each case should be analyzed to determine best strategy for filing

❖ Two “access” points:





- ❖ File US as Non-provisional
- ❖ File PCT within year & Paris for non PCT countries
- ❖ Use PCT for foreign countries and continue with US non-provisional



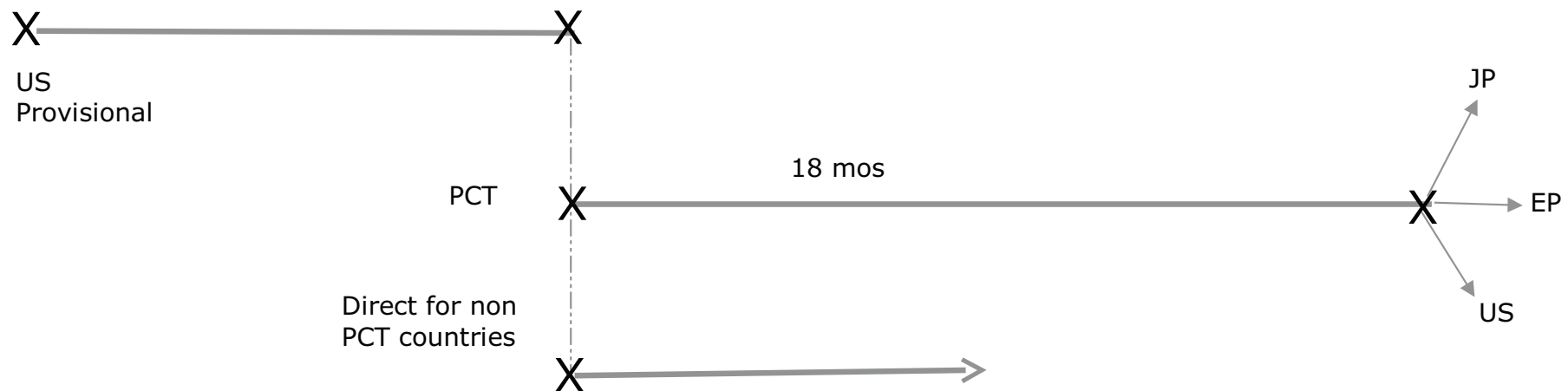
Benefits

- ❖ PCT search may get earlier search results than US case
- ❖ Can get PCT search from another Patent Office
- ❖ Can still use PCT into US for a second US case

Concerns

- ❖ Significant upfront costs for complete US preparation and prosecution
- ❖ Term of US patent one year less than foreign

- ❖ File US as Provisional but do not file the US non-provisional at 12 months
- ❖ File PCT within year and Paris for non PCT countries
- ❖ Use PCT for US and foreign filing



Benefits

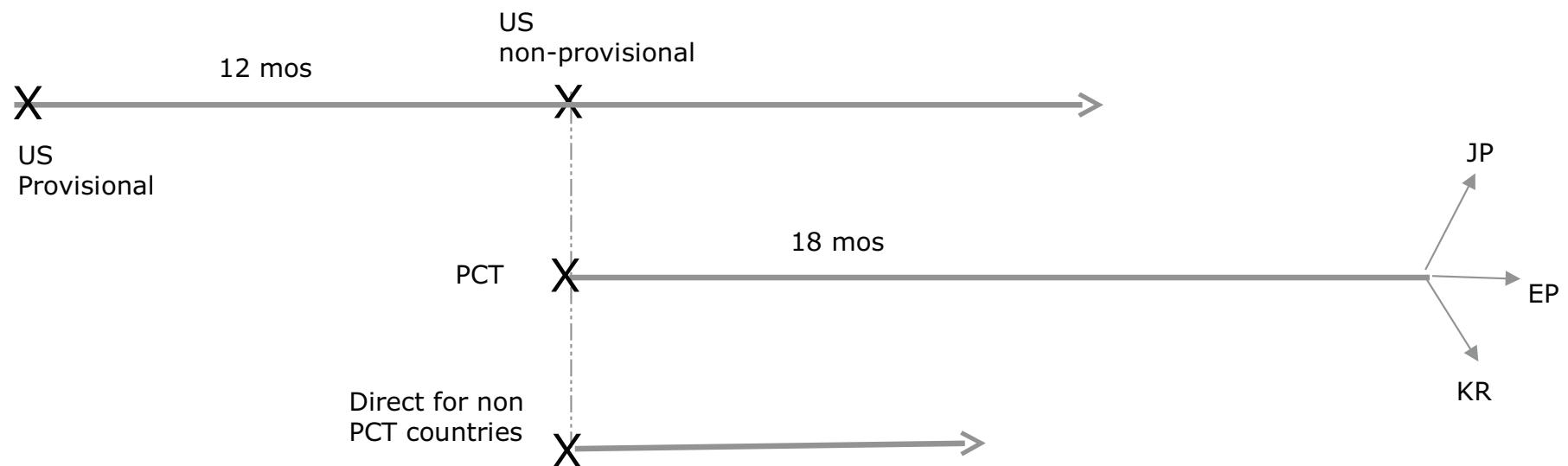
- ❖ Lower up front costs
- ❖ Can choose when to prosecute in US
- ❖ May get search results before big investment
- ❖ Get benefit of extra year of term of US Patent. All patents will expire at same time

Concerns

- ❖ May delay prosecution in US

Provisional, then non-provisional and pct

- ❖ File US as provisional and within year file both US non-provisional and PCT, and Paris for non PCT countries



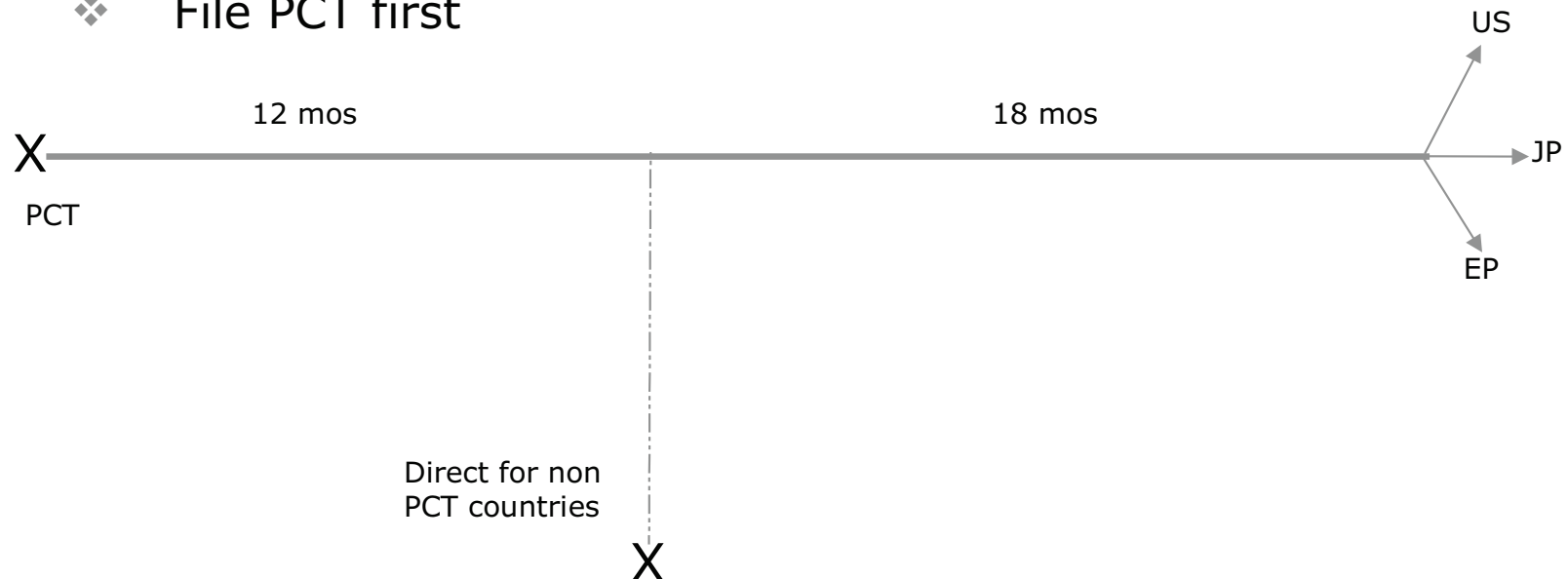
Benefits

- ❖ Limited front end costs
- ❖ PCT search may get earlier result than US case
- ❖ If use EPO for PCT search can get US & EPO search before foreign filing
- ❖ Can still get a second US case from the PCT
- ❖ All patents will expire at the same time

Concerns

- ❖ Must invest in US filing without benefit of search
- ❖ More expenses come sooner

❖ File PCT first



Benefits

- ❖ Cheap way to start the process
- ❖ Can get search before any real investment
- ❖ Longest time for amending claims
- ❖ Can file US case during International Phase, do not need to wait 30 months

Concerns

- ❖ Will lose one year on term for all patents
- ❖ Delay in getting US patent

❖ **Using a Provisional as priority**

- 35USC 119(e) for US
- Internal Priority for US
- Paris convention for other countries

❖ **Using a Non-Provisional as priority**

- 35USC 120 for US
- PCT is actually a “continuation” application for US
- Paris convention for other countries

Using a Provisional as priority for PCT

- ❖ Include priority information on Request Form for US and foreign filing (all part of 35USC 119)

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application:* regional Office	international application: receiving Office
item (1) 26 JANUARY 2012 (26.01.12)	60/349,014	US		
item (2)				
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) *(only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office)* identified above as:

☐ all items ☒ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

Using a Non-Provisional as priority for PCT

- ❖ Include priority information on Request Form for foreign countries. (35USC 119)

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application:* regional Office	international application: receiving Office
item (1) 26 JANUARY 2012 (26.01.12)	11/349,014	US		
item (2)				
item (3)				

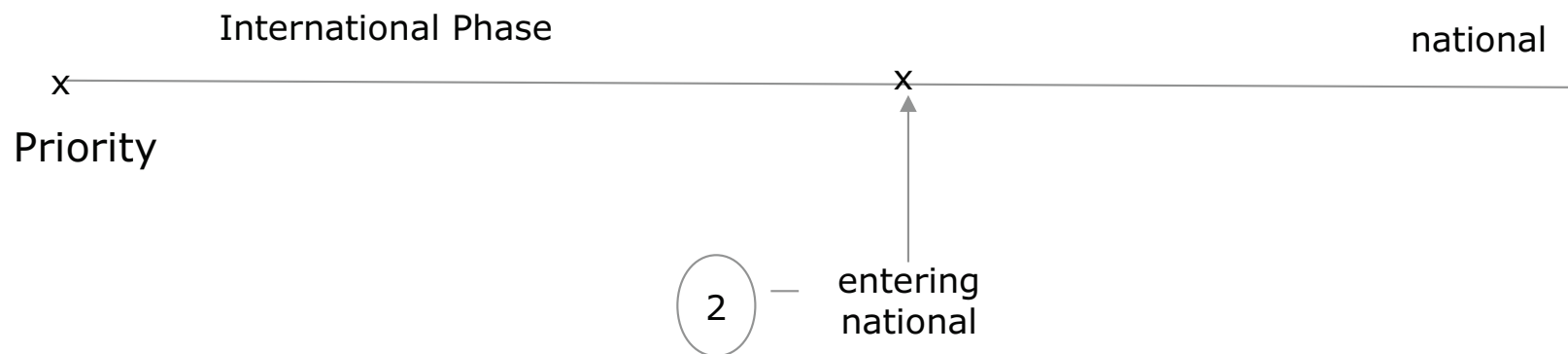
☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office) identified above as:

☐ all items ☒ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

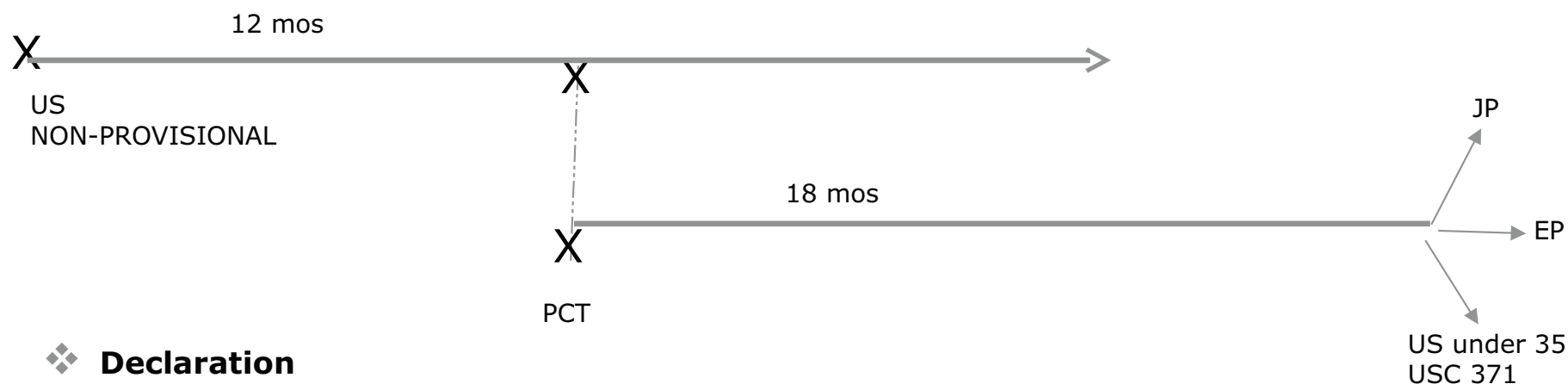
- ❖ Since for the US the PCT is a continuation under 35USC 120, should include separate designation
 - ❖ Should include priority information in Supplemental Box 3, item 3, where the PCT is to be treated as a continuation or a continuation-in-part of an earlier US non-provisional application.
 - ❖ Supplemental Box on the request form should include:
 - “US” or “United States of America”
 - the indication of continuation or continuation-in-part
 - The application number, and the filing date
3. If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation in continuation-in-part of an earlier applicant: in such case, write “United States of America” or “US” and the indication “continuation” or “continuation-in-part” and the number and the filing date of the parent application (Rules 4.11(a)(iv) and 49 bis.1(d)).
- US, continuation-in-part,
10/999,888, 4 November 2012
(04.11.2012)
- ❖ Note: This is not needed to enter PCT, but to preserve rights should applicant want to enter the US through the by-pass route, the intermediate application (i.e. PCT) must include continuation information.



- ❖ **Can enter USPTO in 2 ways:**
 - National Phase Entry: (35 USC 371) – i.e. same case
 - By-Pass Route: (35 USC 111) – i.e. – new case (cont or cip)
- ❖ **Upon Entry into USPTO, must provide:**
 - Declaration
 - Fees
 - “Pedigree” – How you got here

US Non-Provisional-PCT-371 US National Phase Application When entering into the US from PCT Non-Provisional Priority

❖ National Phase Entry



❖ **Declaration**

- Can file Box No. VIII(iv) Declaration of Inventorship sheet of the Request form during the International Phase or can file a US Declaration at national entry for 371 National Phase Entry

❖ **"Pedigree"**

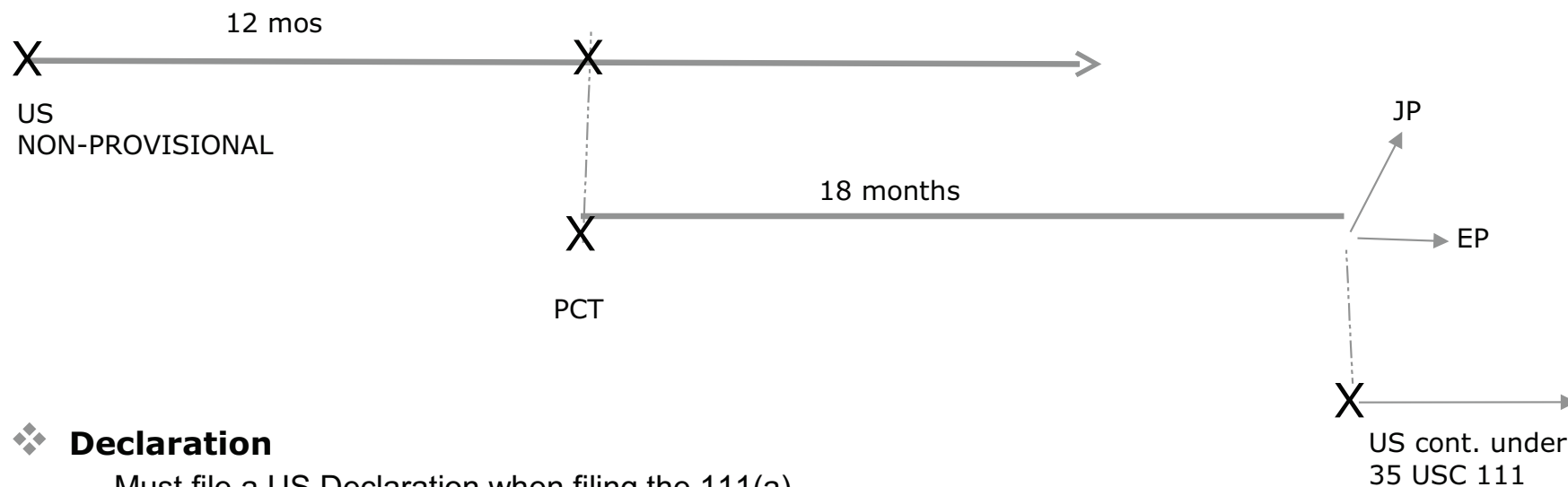
- Must refer to earlier applications in Application Data Sheet, as this is a continuation of the earlier US application

❖ **Fees**

- Must pay on entry

US Non-Provisional-PCT-US Continuation (bypass) Application

❖ By-Pass



❖ **Declaration**

- Must file a US Declaration when filing the 111(a)

❖ **"Pedigree"**

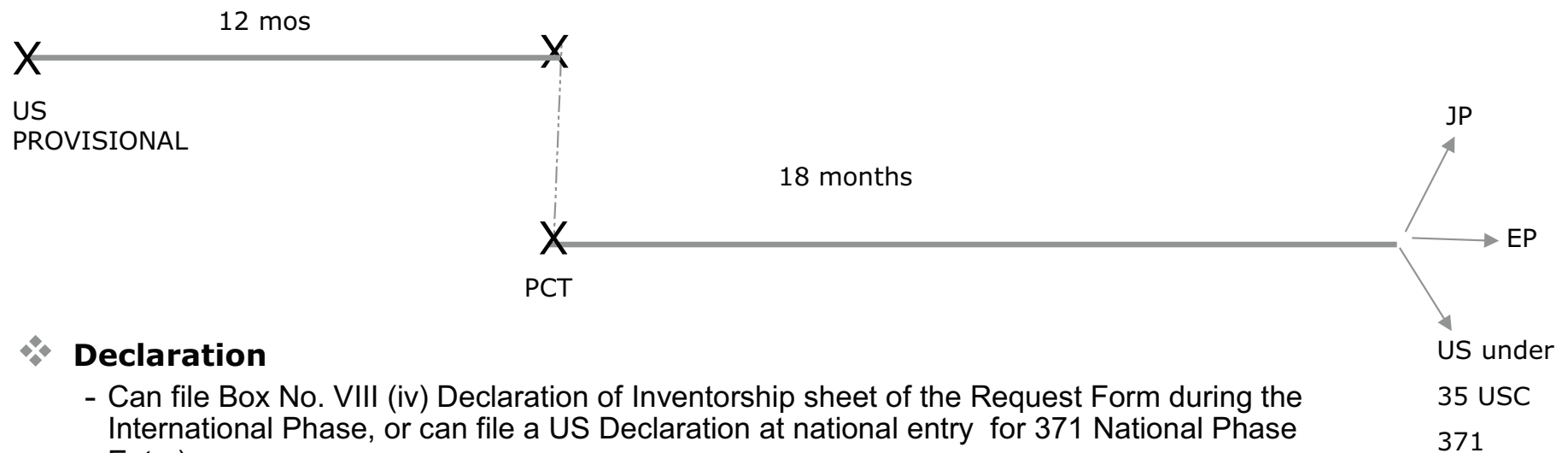
- Must refer to earlier applications in Application Data Sheet, as this is a continuation of PCT which is a continuation of the earlier US application
- Must have filled out Supplemental Box 3 when filing PCT

❖ **Fees**

- Can be delayed

When entering into the US from the PCT-Provisional Priority

❖ National Phase Entry



❖ **Declaration**

- Can file Box No. VIII (iv) Declaration of Inventorship sheet of the Request Form during the International Phase, or can file a US Declaration at national entry for 371 National Phase Entry)

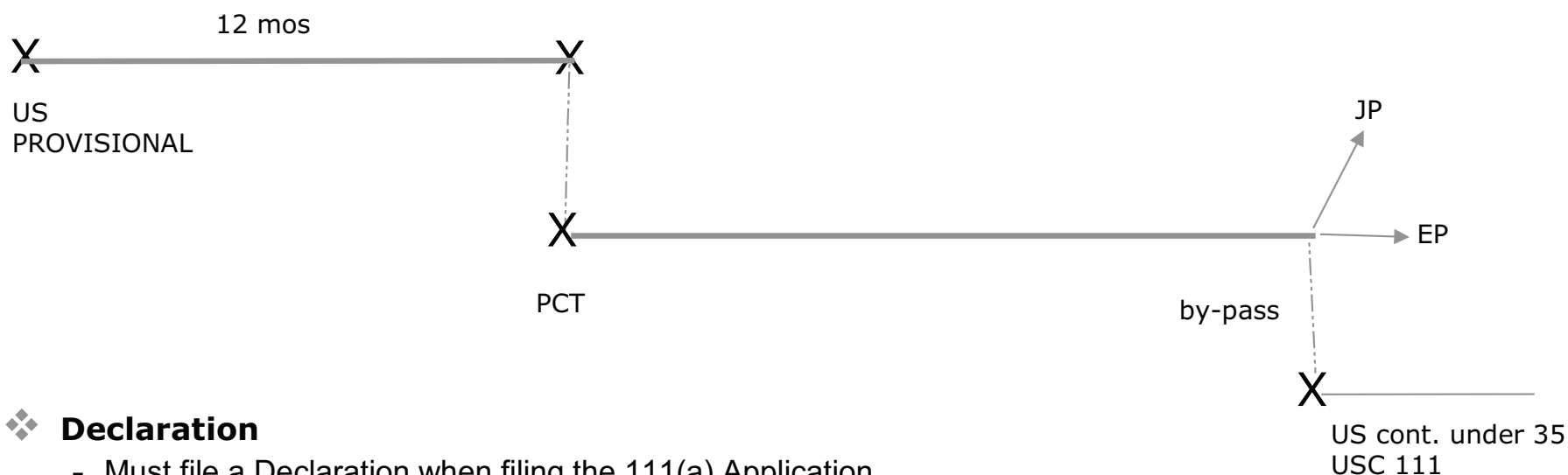
❖ **"Pedigree"**

- Must refer to earlier application in Application Data Sheet, as this claims benefit of earlier US application

❖ **Fees**

- Can be delayed

❖ By-Pass



❖ **Declaration**

- Must file a Declaration when filing the 111(a) Application

❖ **"Pedigree"**

- Must refer to earlier applications in Application Data Sheet, as this is a continuation of the PCT and claims benefit of the earlier US application

❖ **Fees**

- Can be delayed

- ❖ Can file PCT in RO/US as long as one applicant is indicated as a national or resident of US, or
- ❖ Name a person who is a national or resident of the US as an “applicant of convenience” on the Request form and indicate that the person is from US.

❖ List foreign priority in Request Form

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application:* regional Office	international application: receiving Office
item (1) 25 JANUARY 2012 (25.01.12)	IT XXXXX	IT		
item (2)				
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

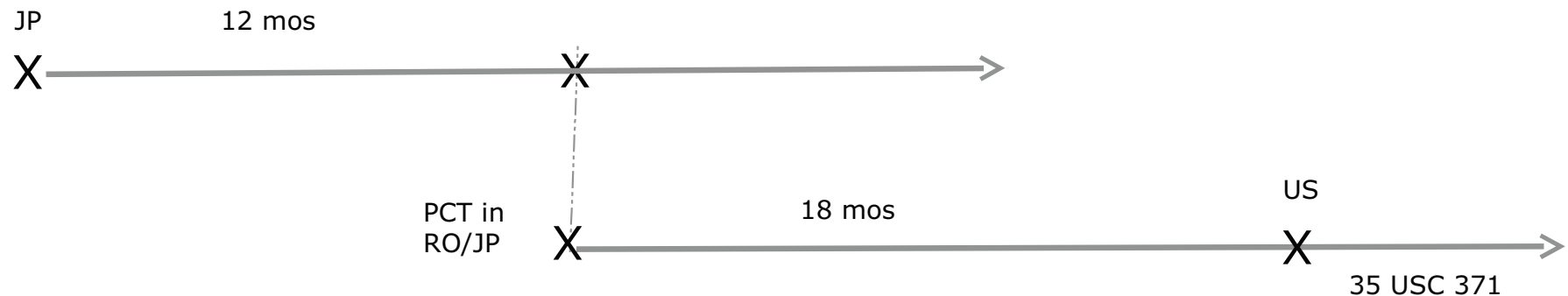
The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office) identified above as:

☐ all items ☐ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

FOREIGN PRIORITY AND PCT

National Phase Entry



Declaration

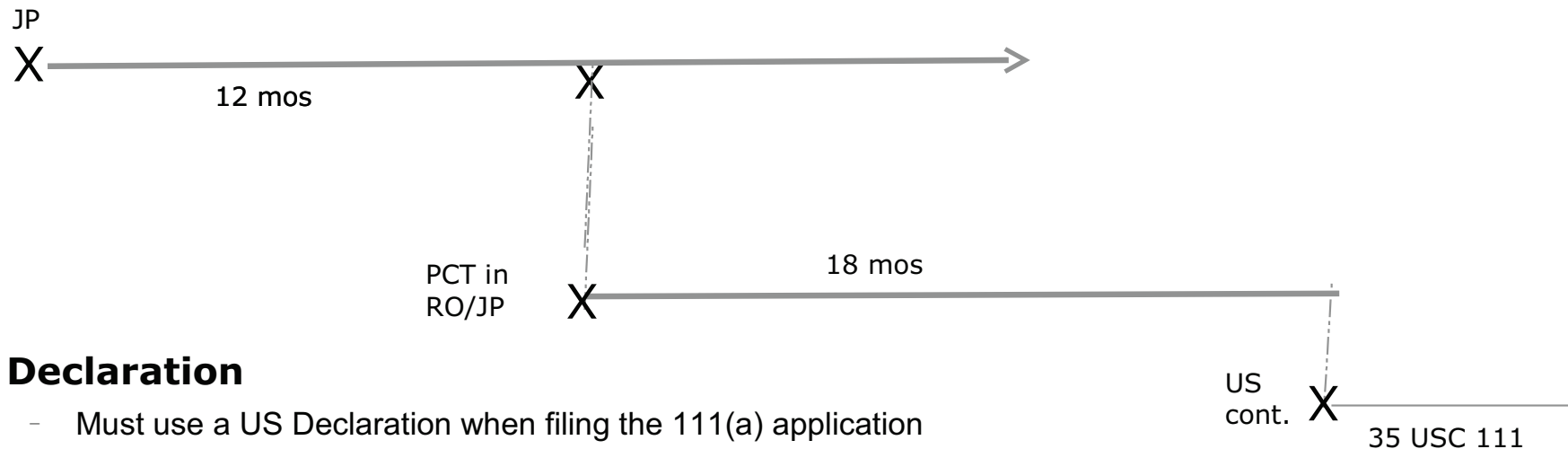
- Can file Box No. VIII(iv) Declaration of Inventorship sheet of the Request form during the International Phase or a US Declaration at national entry for 371 National Phase Entry



“Pedigree”

- List Foreign Priority applications that were indicated in the Request in the ADS at national phase entry

By-Pass



❖ Declaration

- Must use a US Declaration when filing the 111(a) application

❖ "Pedigree"

- Must claim Foreign Priority under 35 USC. 119(a)-(d) and indicate continuation of earlier PCT application in ADS
- Must file a certified copy of foreign patent application (unless Office of priority country is a DAS/PDX Participating Office)

- ❖ Benefit of a Provisional application is made under 35 USC 119(e)
- ❖ Benefit of a Non-Provisional application is made under 35 USC 120
- ❖ PCT Declaration of Inventorship only useful for National Phase Entry not By-Pass Applications
- ❖ Application Data Sheet must make specific reference to all corresponding US provisional and non-provisional applications claimed under 35 USC 119 (e) and 35 USC 120 respectively (i.e. Application No., filing date, and relationship) and to all foreign priorities (assuming they were claimed during the International Phase).
- ❖ By-pass applications are continuations (or c-i-p's) under 35 USC 120 and 365(c).

- ❖ Many available filing strategies for use of PCT
- ❖ Examine which way is best for particular cases and particular applicants
- ❖ Must become familiar with procedures of using each strategy

- ❖ MPEP Section 201.11 on claiming the benefit of an earlier filing date under 35 USC 120 and 119(e)
- ❖ MPEP Section 201.13 on the right of priority of a foreign application
- ❖ MPEP Section 201.13(b) on the right of priority based upon an international application filed under the PCT
- ❖ MPEP Section 1895 on Continuation, Divisional or CIP application of a PCT designating the US

- ❖ **A second-tier patent system that offers a quick, no-examination, inexpensive protection system for inventions that may not meet the traditional patent requirements**
 - Available in a considerable number of countries, including China, Germany, Korea, Russia, Ukraine, Japan, Spain, Brazil, Czech Republic, and Australia
 - Benefits from 12-month right of priority
 - Novelty a requirement, but sometimes a relaxed standard of non-obviousness
 - Shorter duration (6-15 years)
 - Registration required
 - Examination only for formalities, not for substance
 - Limited subject matter scope



Thank you

Skype: chenyan88661

email: chenyan@china-pat.com

China PAT Intellectual Property Office

Hong Kong PAT IP Limited

www.china-pat.com



Incorporation by Reference, Restoration of the Right of Priority, Reinstatement of Rights

Carol Bidwell
July 2015

Incorporation by reference of missing elements and parts of the international application

■ Objective:

To enable inclusion of accidentally omitted elements or parts that are contained in priority application without affecting the international filing date

- ☐ element = all of the description or all of the claims
- ☐ part = part of the description, part of claims or part or all of pages of drawings

■ Conditions:

- ☐ priority application contains the element or part (Rule 20.6(b))
- ☐ request contains statement of (conditional) incorporation by reference (Rule 4.18)
- ☐ timely confirmation of incorporation by reference (Rules 20.6 and 20.7)

■ Competent Authority: RO

Confirmation of incorporation by reference (1)

(Rules 20.6 and 20.7)

- Time limit: 2 months from filing or from invitation to correct (Rule 20.7)
- Documents to be filed (Rule 20.6):
 - ☐ notice of confirmation
 - ☐ missing sheets
 - ☐ copy of earlier application as filed unless priority document already submitted
 - ☐ translation if not in language of international application
 - ☐ indication as to where in the priority document (and translation) the missing sheets are contained

Confirmation of incorporation by reference (2) (Rules 20.6 and 20.7)

- If not all requirements for incorporation by reference are fulfilled (for example, if a missing element or part is not entirely contained in the earlier application):
 - the international application is assigned a later filing date (date of receipt of missing element or part),
 - applicant may request that missing part be disregarded (Rule 20.5(e))

Invitation by RO to correct defect under Article 11(1) (Rule 20.3)

- Where entire description or all claims are missing, the RO invites applicant to either:
 - furnish a correction under Article 11(2) and international application is accorded a later filing date or,
 - confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained

Effect of incorporation by reference in national phase (Rule 82*ter*.1(b))

- DOs may, to a limited extent, review decision allowing the incorporation by reference
- Declarations of incompatibility with national law (reservations) were made by a number of ROs and DOs
See WIPO web site at:
http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

Incorporation by reference

Declarations of incompatibility with national law

- The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 with its national/regional law:
 - ❑ Incompatibility as RO (Rule 20.8(a)):
BE, CU, CZ, DE, ID, IT, KR, MX
 - ❑ Incompatibility as DO (Rule 20.8(b)):
CN, CU, CZ, DE, ID, KR, LT, MX, TR

Restoration of the right of priority

■ Competent Authorities:

- ❑ RO during the international phase (Rule 26*bis*.3)
- ❑ DO during the national phase (Rule 49*ter*.2)

Criteria for restoration of the right of priority

- Two possible criteria for restoration:
 1. failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
 2. failure to file the application within the priority period was unintentional
- All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law
 - ❑ RO/US will apply the unintentional criterion only
 - ❑ RO/IB will apply both criteria

Restoration by RO (Rule 26*bis*.3)

■ Conditions:

- ☐ request to restore must be filed with the RO
- ☐ time limit: within a period of 2 months from the date of the expiration of the priority period
- ☐ filing of statement of reasons for failure to comply with the time limit
- ☐ statement should preferably be accompanied by a declaration or other evidence to support such statement
- ☐ where applicable, payment of the required fee
 - RO/US fee for requesting restoration is \$1700*
 - RO/IB does not charge a fee for requesting restoration

* Reducible by 50% for small and micro-entities

Effects if priority right is not restored by RO (Rule 26bis.3)

- Any priority claim to an earlier application filed less than 14 months before the international filing date
 - will not be declared void even if priority is not restored by the RO
 - will serve as a basis to calculate time limits during the international phase
- The validity of such a priority claim in the national phase is not assured

Effect of RO restoration in the national phase (Rule 49ter.1)

- RO restoration based on the “due care” criterion is effective in all DOs
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible
- RO refusal to restore is not binding on DOs
- Declarations of incompatibility with the national law (reservations) can be found on the WIPO website at:
www.wipo.int/pct/en/texts/reservations/res_incomp.html
- A chart of the restoration of the right of priority by ROs and DOs can be found on the WIPO website at:
www.wipo.int/pct/en/texts/restoration.html

Reservations to restoration of priority

■ The following Offices have notified the International Bureau of the incompatibility of Rule 26*bis*.3(a) to (i), Rule 49*ter*.1(a) to (d) and/or Rule 49*ter*.2(a) to (g) with their national/regional law:

❑ Incompatibility as RO (Rule 26*bis*.3(j)):

BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, JP*, KR, NO, PH

❑ Incompatibility of the effect of decision of RO on DO (Rule 49*ter*.1(g)):

BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP*, KR, LT, MX, NO, PH, TR

❑ Incompatibility as DO (Rule 49*ter*.2(h)):

BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP*, KR, MX, NO, PH, TR

* JP withdrew its reservations with effect from 1 April 2015

Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
 - ☐ unintentionally
 - or, at the option of the Office,
 - ☐ in spite of due care required by the circumstances
- Applicants may submit a request for reinstatement and enter the national phase within:
 - ☐ 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
 - ☐ 12 months from the date of expiration of the time limit to enter national phase;whichever period expires first

Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Longer time limits and/or further requirements may apply depending on the applicable national law
- For further details, see for each DO/EO, the relevant National Chapter in the PCT Applicant's Guide, National Phase

DO/EOs to which Rule 49.6 does not apply

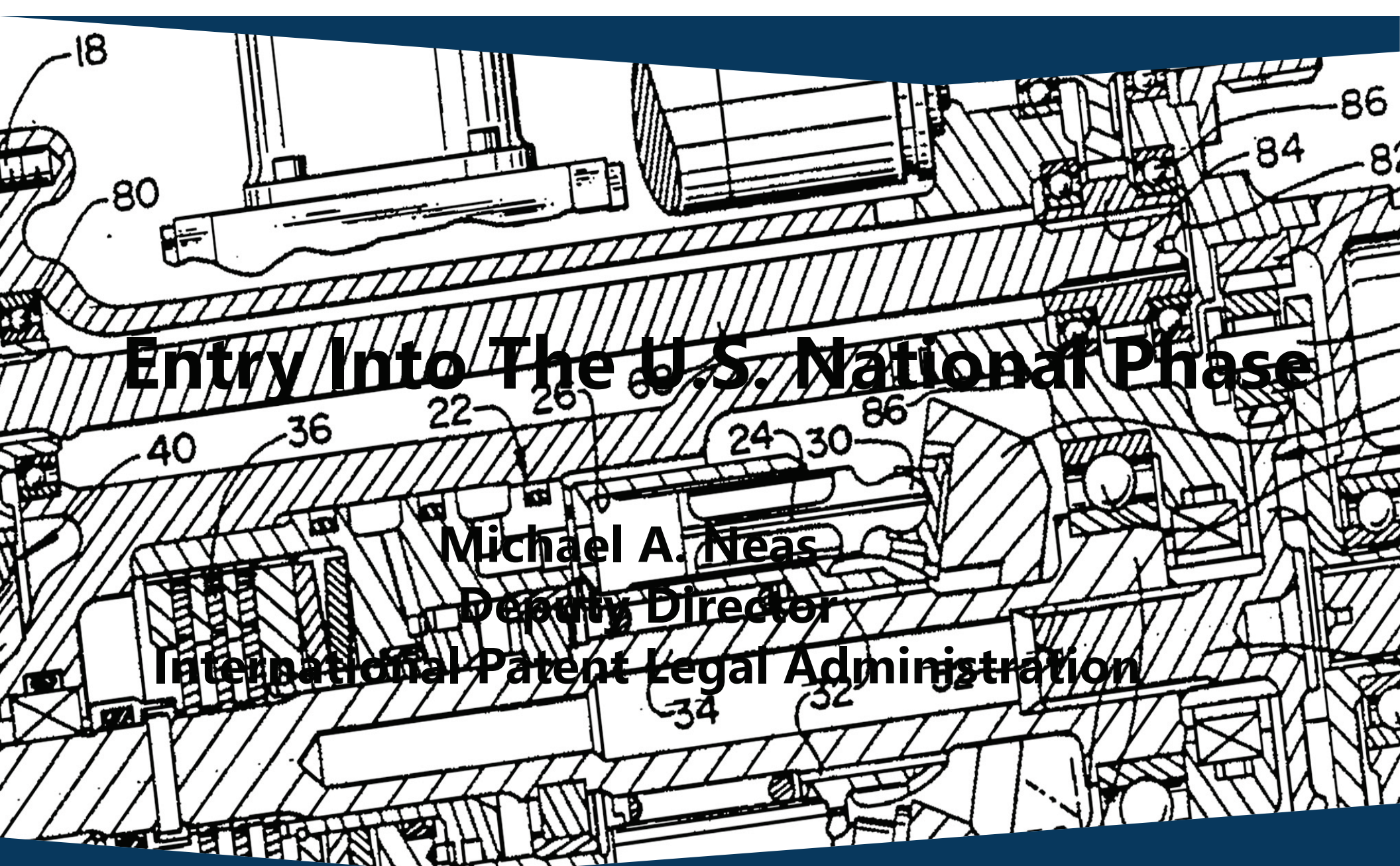
- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f) :

CA Canada	LV Latvia
CN China	MX Mexico
DE Germany	NZ New Zealand
IN India	PH Philippines
KR Republic of Korea	PL Poland

- Nevertheless the national law applicable by some of these Offices may provide for other forms of protection against loss of rights
 - for further details, see the relevant National Chapter in the PCT Applicant's Guide for each DO/EO

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





18 80 86 84 82 40 36 22 26 24 30 86 34 32

Entry Into The U.S. National Phase

Michael A. Neas
Deputy Director
International Patent Legal Administration

UNITED STATES
PATENT AND TRADEMARK OFFICE

uspto

35 U.S.C. 371 (c) Requirements

- (1) National stage fees
- (2) Copy of the international application* and an English translation (if not in English)
- (3) Copy of Article 19 amendments and translation (if not in English)
- (4) Oath or declaration of inventor(s)
- (5) Translation of annexes** to the IPER (if not in English)

* not required if the IA was filed in RO/US or published by the IB

** amendments that formed the basis of the Report



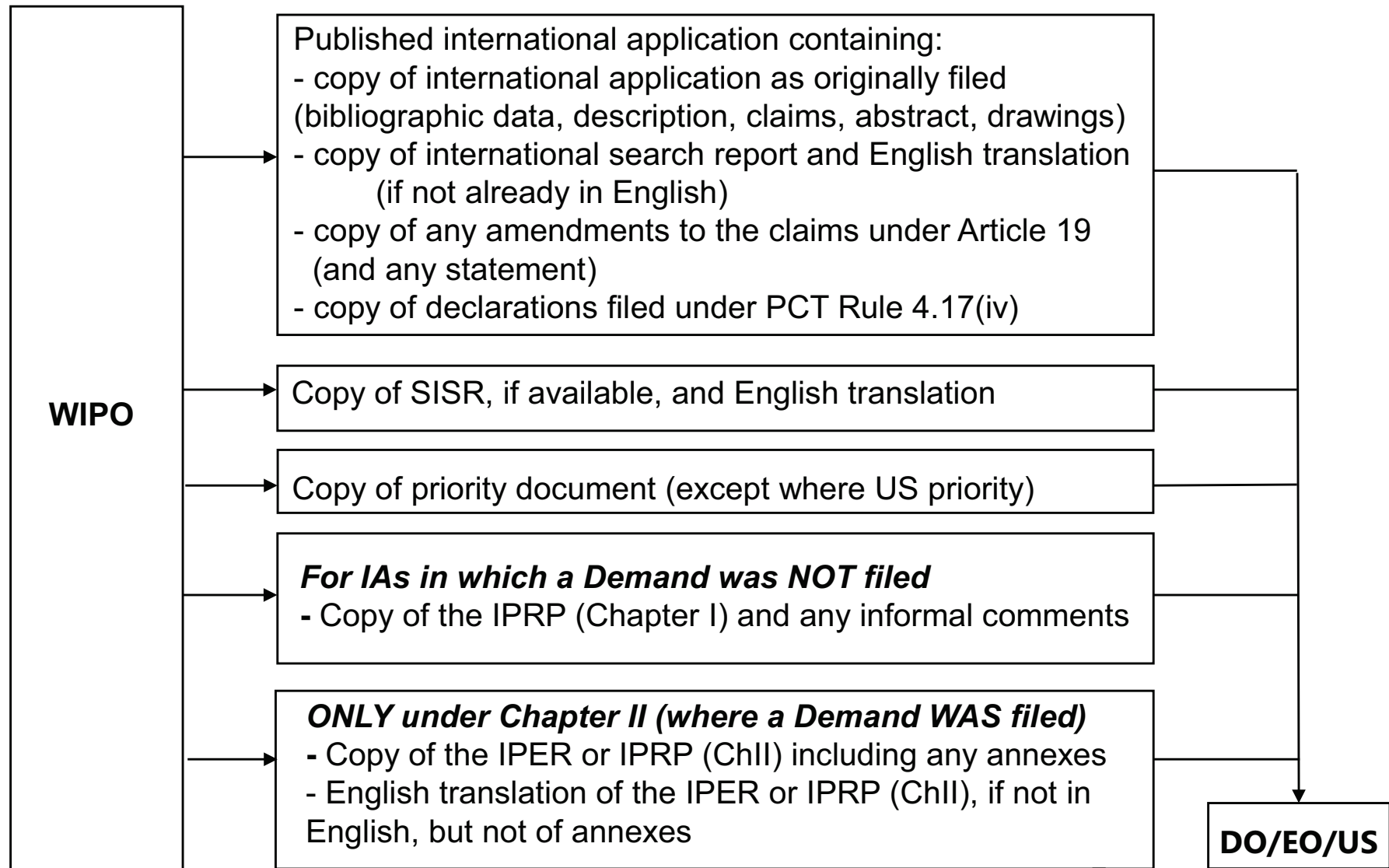
Commencement of U.S. National Stage

- 30 months from earliest priority date
 - from either Chapter I or Chapter II
 - 37 CFR 1.495
- Early commencement
 - at applicant's express request
 - 35 U.S.C. 371(f)
- See PCT Applicant's Guide, National Stage,
National Chapter (US)



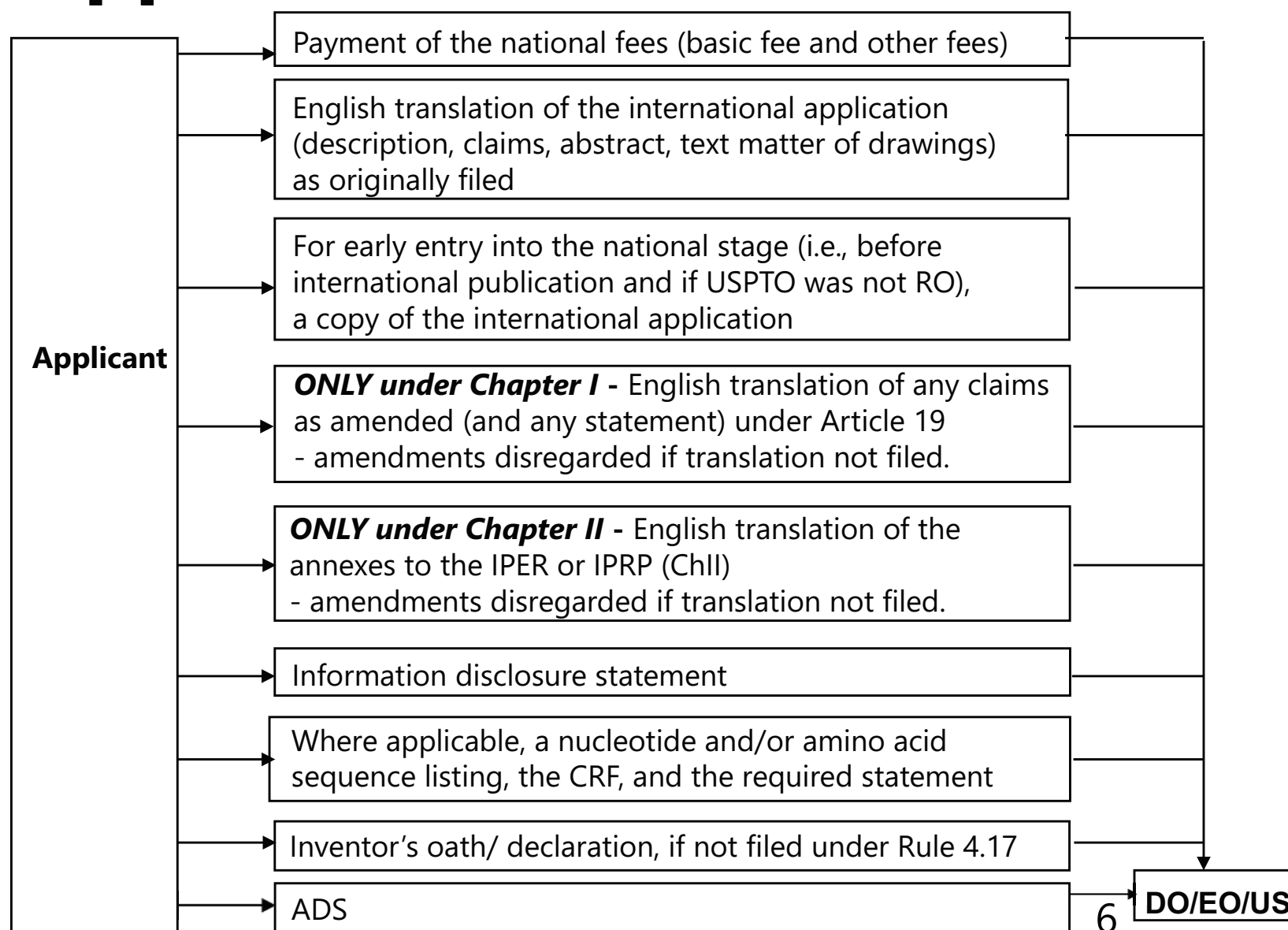
Entry into National Stage

WIPO Transmission to DO/EO/US



Entry into National Stage

Applicant Submission to DO/EO/US



National Stage Fees (1)

- Basic national fee..... \$280*
- Search Fee
 - WO of the ISA/US or IPER prepared by the IPEA/US indicates that all claims satisfy the provisions of Article 33(1)-(4)** \$0
 - international search fee paid to USPTO as ISA.....\$120*
 - ISR prepared by an ISA other than the US and provided to US or previously communicated to the US by the IB.....\$480*
 - all other situations.....\$600*

*reducible by 50% for small entity and 75% for micro entity

**novelty, inventive step and industrial applicability



National Stage Fees (2)

- Examination fee
 - Written Opinion of the ISA/US or IPER prepared by the IPEA/US and indicates that all claims satisfy the provisions of Article 33(1)(4)**.....\$0
 - all other situations.....\$720*

*reducible by 50% for small entity and 75% for micro entity

**novelty, inventive step and industrial applicability



Other National Stage Fees

- For each independent claim in excess of 3.....\$420*
- For each claim in excess of 20.....\$80*
- For each application containing a multiple dependent claim.....\$780*
- For every 50 sheets or fraction thereof of the SPEC and DRW that exceeds 100 sheets (excluding any sequence listing or computer program listing filed in electronic medium)..... \$400*

*reducible by 50% for small entity and 75% for micro entity



English Translation of the International Application

- May be filed
 - by 30 months from the priority date
 - in response to a Notice of Missing Requirements
 - time limit set in Notice may be extended under 37 CFR 1.136(a)
 - after the 30-month date
 - with processing fee of \$140
 - reducible by 50% for small entity and 75% for micro entity
- Translation must be an accurate translation of the international application as originally filed
 - no changes permitted



Copy of Article 19 Amendments* and English Translation

- Due by 30 months from the priority date
- Canceled if translation not timely submitted
 - may still be made by preliminary amendment

* copy of the Article 19 amendment not required if communicated to the DO/EO/US by the IB



Oath or Declaration

- May be filed as
 - part of the PCT Request form, that is, Box No. VIII (iv), or within the time period set in PCT Rule 26ter
 - IB will provide DO/EO/US with PCT Request declaration of inventorship sheets upon national stage entry
 - USPTO generated
 - form PTO/SB/01 or PTO/SB/01A (pre-AIA (Oath/Dec))
 - form PTO/AIA/01 or PTO/AIA/08 (AIA (Oath/Dec))
 - applicant created form
 - for AIA (Oath/Dec) applications
 - substitute statements
 - assignment as the oath/declaration



Time for Filing of Oath/Declaration (Pre-AIA (Oath/Dec))

- By 30 months from the priority date
- In response to Notice of Missing Requirements
 - time limit set in Notice may be extended
 - (37 CFR 1.136(a))
- After 30 months from the priority date
 - with a surcharge of \$140 (37 CFR 1.492(h))
 - reducible by 50% for small entity and 75% for micro entity



Time for Filing of Oath/Declaration

- AIA (Oath/Dec) (1)

- May postpone submission until application is in condition for allowance (37 CFR 1.492(c))
 - if an ADS is filed identifying
 - each inventor by his or her legal name
 - for each inventor, a mailing address where the inventor customarily receives mail
 - and residence, if the inventor lives at a location different than the mailing address
 - if postponed, must be filed no later than the time period set in the “Notice of Allowability” to avoid abandonment



Time for Filing of Oath/Declaration

- AIA (Oath/Dec) (2)

- Exceptions to postponement of oath/dec until allowance
 - Early commencement under 35 U.S.C. 371(f)
 - Request for Continued Examination (RCE)
 - PUBLIC LAW 106-113-APPENDIX I 113 STAT. 1501A-**560** (SEC. 4403) adds section (b) to 35 U.S.C. 132
 - Which grants the Director [of the USPTO] the ability to prescribe regulations for continued examination of patent applications
 - However, PUBLIC LAW 106-113-APPENDIX I 113 STAT. 1501A-**561** sets forth the applicability of 35 U.S.C. 132(b) to
 - “[...] all applications **complying with** section 371 of title 35, United States Code, [...]”
 - 35 U.S.C. 371(**c**) requires the filing of an oath/dec of the inventor



English Translation of Annexes to the IPRP (Chapter II)

- Due by
 - 30 months from the priority date or
 - within any time period set to furnish
 - translation of application
 - oath or declaration
 - any outstanding national stage fee
- Canceled if not timely submitted
 - may still be made by preliminary amendment
- If provided after 30-month date
 - processing fee of \$140
 - reducible by 50% for small entity and 75% for micro entity

37 CFR 1.492(h)

- A surcharge of \$140 is required if any of
 - the search fee
 - the examination fee, or
 - the oath or declaration

is filed after the date of commencement

- the surcharge is reducible by 50% for small entity and 75% for micro entity



Abandonment in the United States

- Abandonment results from failure to
 - submit by the 30-month date
 - basic national fee
 - a copy of the international application
 - if not published by the IB, or
 - if not filed in RO/US
 - timely furnish
 - the proper reply to the Notice of Missing Requirements and other notices
- May be possible to revive (37 CFR 1.137)



Preliminary Amendments

- Made in accordance with 37 CFR 1.121
 - may be used in lieu of translating
 - Article 19 amendment and/or annexes to the IPER
 - to eliminate multiple dependent claims
 - to reduce the number of claims
- See PCT Applicant's Guide – National Stage - National Chapter – US, The Procedure in the National Phase, paragraph US.34
 - for details regarding amendments and claim status identifiers
 - <http://www.wipo.int/pct/guide/en/gdvol2/annexes/us.pdf>

Dates in a National Stage Application

- International filing date
- 35 U.S.C. 371(c) date



International Filing Date

- 35 U.S.C. 363 states that
 - an international application designating the United States shall have the effect,
 - from its IFD,
 - of a national application for patent regularly filed in the Patent and Trademark Office



35 U.S.C. 371(c) Date

- Pre-AIA (Oath/Dec)
 - date of completion of 35 U.S.C. 371(c)(1), (2), (4) requirements
 - date listed as the “filing or 371(c) date” on the filing receipt
- AIA (Oath/Dec)
 - the “filing or 371(c) date” on the filing receipt no longer based on date of receipt of oath/declaration



Foreign Priority Claims in a National Stage Application

- Under 35 U.S.C 365(b); must be in accordance with
 - 35 U.S.C 119(a)
 - the PCT and its Regulations
- Must have been made
 - in Box No. VI of the Request, or
 - within the time limit set forth in PCT Rule 26*bis*
- Can be added during the national stage on petition under 37 CFR 1.55(e)



Certified Copy of Foreign Application

- WIPO will provide a copy to DO/EO/US
 - if timely filed during the international stage
 - the copy satisfies the requirement of 37 CFR 1.55(f)(2)
 - the Notice of Acceptance will indicate presence
- If a certified copy was not filed during the international stage
 - applicant will be given the opportunity to provide one during the national stage
 - see 37 CFR 1.55(f)(2) for required time period for furnishing



Domestic Benefit Claims in National Stage Application

- Domestic benefit may be claimed to
 - a provisional application under 35 U.S.C. 119(e)
 - a non-provisional application under 35 U.S.C. 120 or 35 U.S.C. 121
 - an international application designating the US under 35 U.S.C. 365(c)



How to Claim Domestic Benefit

- In the PCT Request form
 - or as otherwise shown on the front page on the international publication

OR

- On an Application Data Sheet within the later of
 - 4 months from commencement
 - 4 months from the initial submission under 35 U.S.C. 371
 - 16 months from the filing date of the prior-filed application



Restoration of Right of Priority in the International Stage

- For an international application filed on/after 01 Apr 2007
 - international filing date may be
 - more than 12 months from the priority date, but
 - within 2 months of the expiration of the priority period
 - under the PCT, a priority claim that is restoration eligible
 - establishes the priority date for timeline purposes
 - remains in the international application, despite
 - failure to request restoration, or
 - refusal of a request for restoration



Restoration of the Right of Priority in the US National Stage (1)

- Restoration of the right of priority has been effective for all applications in the U.S.
 - since 18 Dec 2013 when the PLT provisions of the Patent Law Treaties Act of 2012 went into effect
- Restoration by RO/US or any other RO under unintentional or due care criterion **is effective** in the corresponding U.S. national stage application
 - Form PCT/RO/159 issued by the Receiving Office indicating restoration of the right of priority is satisfied

Restoration of Right of Priority in the US National Stage (2)

- Where priority was not restored in the international application, applicant can petition to
 - restore the right of priority to a foreign application
 - 37 CFR 1.55(c)
 - restore domestic benefit to a provisional application
 - 37 CFR 1.78(b)
- The delay in filing the international application must have been unintentional



Restriction

- The unity of invention standard is applied for restriction in a national stage application
- More claims may be kept together if multiple inventions present

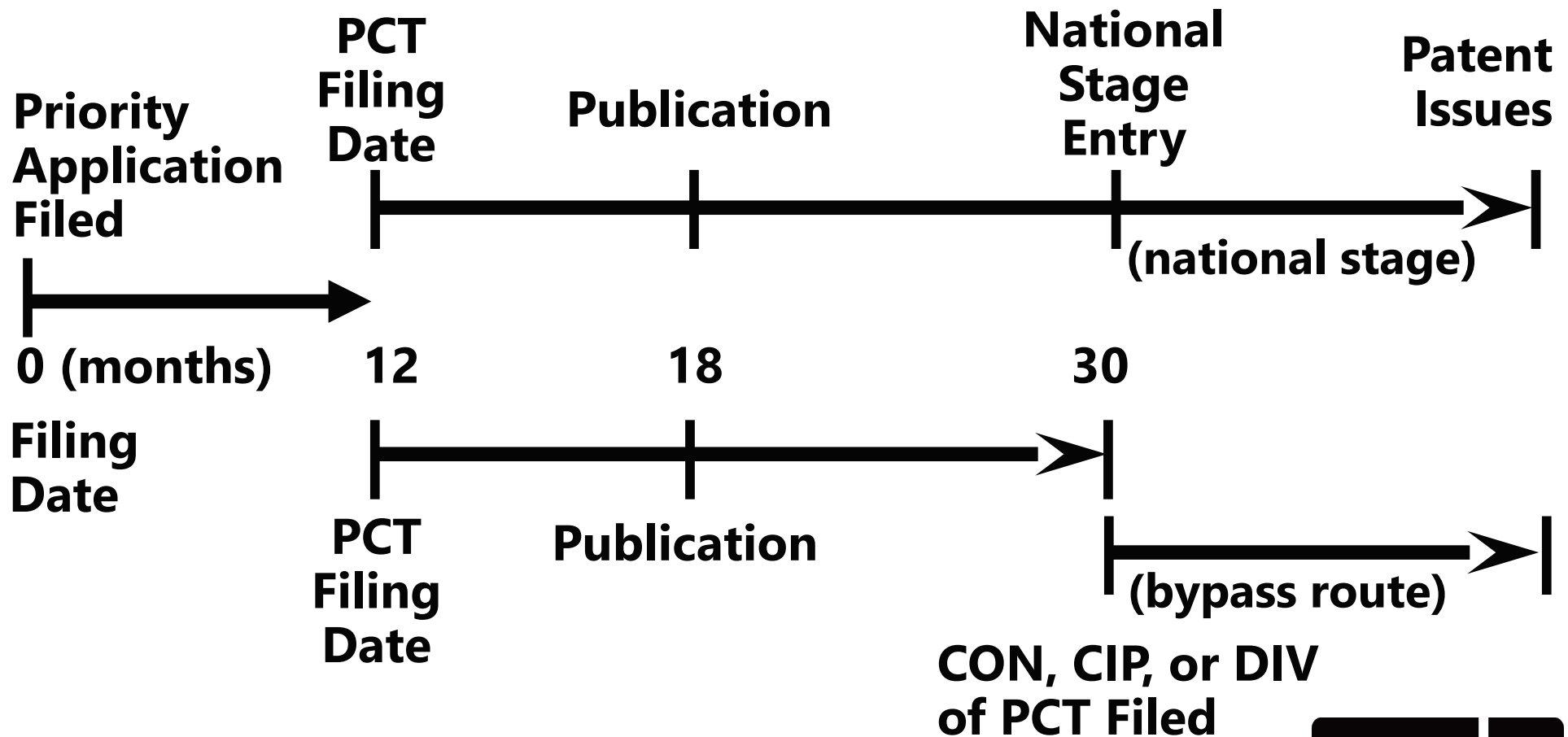


“Bypass Route” - an Alternative to 35 U.S.C. 371

- A U.S. application under 35 U.S.C 111(a)
 - can claim benefit under
 - 35 U.S.C 365(c)
 - 35 U.S.C 120, or
 - 35 U.S.C. 121
- of an international application that designates the US
- See MPEP sections 1895 and 1896



National Stage vs. Bypass Route



Conflicting Instructions

111(a) or 371

- Prior to 16 Sept 2012
 - an initial application submission containing conflicting information as to treatment under 35 U.S.C. 111(a) or 371 was treated as a new U.S. national patent application under 35 U.S.C. 111(a)
- On or after 16 Sept 2012
 - an initial application submission containing conflicting information as to treatment under 35 U.S.C. 111(a) or 371 will be treated as a U.S. national stage application under 35 U.S.C. 371
- 37 CFR 1.495(g)



Advantages of Bypass Route

- Exact translation of the international application not required
- New matter may be added to the disclosure by filing a CIP
- Extension of time for payment of basic filing fee
 - 37 CFR 1.136(a)
- Foreign priority claim omitted in the international application may be added (37 CFR 1.55) without petition
- Track 1 Prioritized Examination and Accelerated Examination procedures available
- May postpone oath/dec submission without exception



Disadvantages of Bypass Route

- A complete application must be filed
 - including any required formal drawings
- Certified copies of any foreign priority documents must be filed*
 - Within the time period set forth in 37 CFR 1.55(f)(1)
- Restriction based on the U.S. independent and distinct standard
 - instead of broader unity of invention standard
- Petition under 37 CFR 1.78(d) required for benefit claim where
 - the international application claims benefit but does NOT specify its relationship (CON, DIV, CIP) to the earlier application filed under 35 U.S.C. 111(a)

* EPO, JPO, KIPO, SIPO priority documents normally retrieved automatically via Priority Document Exchange Program (PDX)

* AU, DK, ES, FI, GB, SE and RO/IB priority documents can be retrieved automatically via WIPO's Digital Access Service (DAS)



Advantages of National Stage Entry Under 35 U.S.C. 371

- Restriction standard is unity of invention
 - more claims/inventions may stay together
- Ease of filing
 - applicant provides
 - transmittal letter
 - fees
 - IB provides
 - copy of the international application (if nationalized after publication)
 - priority document (if provided to IB at international stage)
 - ISR and IPRP
- Search fee and examination fees may be \$0
 - where WO of ISA/US or IPER of IPEA/US indicates all claims satisfy the criteria of Article 33(1)-(4)

Disadvantages of National Stage Entry Under 35 U.S.C. 371

- Cannot add subject matter
 - which goes beyond the IA as filed
- Literal English translation of IA required
- May need extensive preliminary amendment
 - clean up translation
 - reduce/eliminate multiple dependent claims
- Must pay basic national fee by 30 months
- Requires oath/dec submission for
 - Early commencement
 - RCE filing



Helpful Hints (1)

- Use the national stage transmittal letter (PTO-1390)
 - two versions available
 - one with transition application check box for international applications filed on or after 16 March 2013
- Do not wait for a Notice of Missing Requirements (PCT/DO/EO/905)
 - supply the additional fees, translations, etc. as soon as possible
 - filing Receipt and Notification of Acceptance (Form PCT/DO/EO/903) issued more quickly
- File assignments using the Electronic Patent Assignment System (EPAS)
 - ensures timely recordation
 - EFS-Web Legal Framework does not allow the filing of assignments via EFS-Web
 - access EPAS via www.uspto.gov



Helpful Hints (2)

- Check PAIR and Notification of Acceptance (PCT/DO/EO/903)
 - to ensure that DO/EO received certain documents
 - e.g. preliminary amendment, IPER with Annexes, priority document, etc.
- If submitting translation of the annexes
 - ensure the translated annexed sheets can replace page by page of the translated application sheets



Helpful Hints (3)

- List the references cited during the international stage on an IDS
 - to ensure
 - consideration of
 - references cited on the ISR/SISR/IPRP
 - 3rd party observations made at international stage
 - reference citation on any resulting patent
- Provide copies of any non-U.S. patent documents
 - foreign patent documents
 - Non-Patent Literature (NPL)



Questions?

Michael Neas
Deputy Director, International Patent Legal Administration
Michael.Neas@uspto.gov

PCT Help Desk
(571) 272-4300
Monday – Friday 8:30am – 5:00pm ET

UNITED STATES
PATENT AND TRADEMARK OFFICE





Strategies for National Filing

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

National-stage versus bypass

Is your case at risk of an n-way restriction requirement?

If so, use national stage

The Examiner will have to use unity-of-invention rather than domestic restriction practice

National-stage versus bypass

Is your case a mess?

If so, clean up the mess and file it as a bypass continuation

National-stage versus bypass

Do you want to add new matter?

If so, add the new matter and file it as a bypass
continuation-in-part

National-stage versus bypass

Do you want to take advantage of an opportunity to file without having to pay the money?

If so, file it as a bypass continuation

Have a favorable Written Opinion
or IPRP from an eligible ISA or
IPEA?

AT, AU, CA, CN, DE, DK, EE, EP, ES, FI, GB,
HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, US, XN

Use PCT-PPH

National-stage versus bypass

Recall the certified copies of the priority documents

You get to skip this if you use national stage

For bypass, maybe you will get lucky and you can use DAS

National-stage versus bypass

USPTO gives a filing-fee discount for those who
e-file (if they are a small entity)

But not for national-stage filings!

Scenarios

30-month time draws near, but there is already a pending US case

It may be smart to enter the US national stage anyway

You never know when you may run into an n-way restriction requirement in the pending US case

You never know when the pending US case may get abandoned by accident

(but see next slide)

The “short list” – the bare minimum to avoid abandonment at 30 months

Provide the PCT application number.

Pay base national-stage filing fee.

A copy of the IA if USPTO does not already have it. Note that if it was published at 18 months, USPTO almost certainly already has it. Note that if USPTO was the RO, then USPTO already has it.

So the likely bare minimum is to use EFS-Web, provide the PCT application number, check the national-stage box, pay the base fee.

The “long list” – what it takes to avoid a notice of missing requirements

All necessary fees (search fee, exam fee, extra claims fee, page count fee)

Translation of the application into English

Translation of the Annexes to the Chapter II IPRP, if any

Trap for the unwary – blanket fee authorizations

Some firms and patent departments choose to include with any new filing at USPTO a blanket authorization to charge any and all fees to a deposit account.

If you feel you must do this in an entry into the US national phase, then be vigilant about getting your preliminary amendment into the case by the date that DO/EO will commence processing of the case.

That date is the priority date plus 30 months, or the date that you expressly request national-stage processing, whichever is earlier.

If you don't pay attention to this, you can end up with USPTO charging extra-claims fees based upon the claims as they existed in the international phase ... and you will not be able to get those fees back

The better approaches are:

- avoid giving a blanket authorization to charge any and all fees to a deposit account, or
- make sure that your preliminary amendment is in the case by no later than the 30-month date (or the date of your express request is made)

National-stage best practices

AIA permits you to play “hide the ball” with your signed inventor declarations until payment of the Issue Fee

Do not do this!

Make sure to e-file your signed inventor declarations as early as possible – for example on the day after filing the IA in the first place

National-stage best practices

See if the foreign agent planned ahead and got a
US-style inventor's declaration signed and filed
(declaration iv of the Request)

It will be visible in PATENTSCOPE

If so, there is no need to get an inventor's
declaration signed now

Thank the foreign agent!

National-stage best practices

Best practice for inventor's declaration is the
“short-form” declaration of form SB01a or
AIA01

This is filed with an Application Data Sheet

National-stage best practices

Best practice is to include an Application Data Sheet in the initial filing (the filing that gets you your domestic application number)

This will auto-populate a few fields PALM and thus will auto-populate a few fields of the continuity data in PAIR

This reduces the risk of keying errors or omissions at USPTO

There is no reason to postpone this. Do it the day after you file the PCT case.

National-stage best practices

File each item as soon as it is available. There is no good reason to postpone such filings to 30 months.

File the IDS as soon as you receive the ISR.

File the Declaration right away.

Record the Assignment right away.

National-stage best practices

Note that you are ***not*** required to provide an opening sentence in the specification reciting the 371 relationship. Nor are you required to provide an opening sentence reciting any domestic benefit claims.

Not only that, an opening-sentence recitation of domestic benefit claims will no longer satisfy Rule 78. You must do this in the ADS.

National-stage best practices

Corporate applicants should require that outside counsel *not* insert power of attorney or correspondence address instructions in the oath or declaration

Such language makes it much more difficult to discharge outside counsel (makes it harder to reuse the oath or declaration in a child case)

Such language risks a conflict of interest as between assignee and inventors

National-stage best practices

Are you entering the US national stage ***prior to*** the end of the 30 months?

Then you should file an “express request to begin national examination procedures” per 35 U.S.C. § 371(f)

What are the consequences of failing to file an “express request to begin national examination procedures”?

The application will sit “on ice” in DO/EO/US until the 30 months has run out

You may lose some Patent Term Adjustment

You will lose your place in line to be examined

Your “371 completion” date will be worse than it could have been

It's not enough merely to request immediate processing!

You also need to actually do everything that is required to perfect national-phase processing (translation, fees, oath or declaration)

How do you file an “express request to begin national examination procedures”?

One choice is to file Form PTO-1390, and check box 1
(used to be box 3)

When Form PCT/DO/EO/903 arrives, review it closely to make sure USPTO gave you credit for making the “express request”.

This means reviewing the "371 completion date" on the form

Resources

EFS-Web list serve:

www.oppedahl.com/efswweb

PCT list serve:

www.oppedahl.com/pct

Entering the European Regional Phase, London Agreement, Divisionals, Unitary European Patent

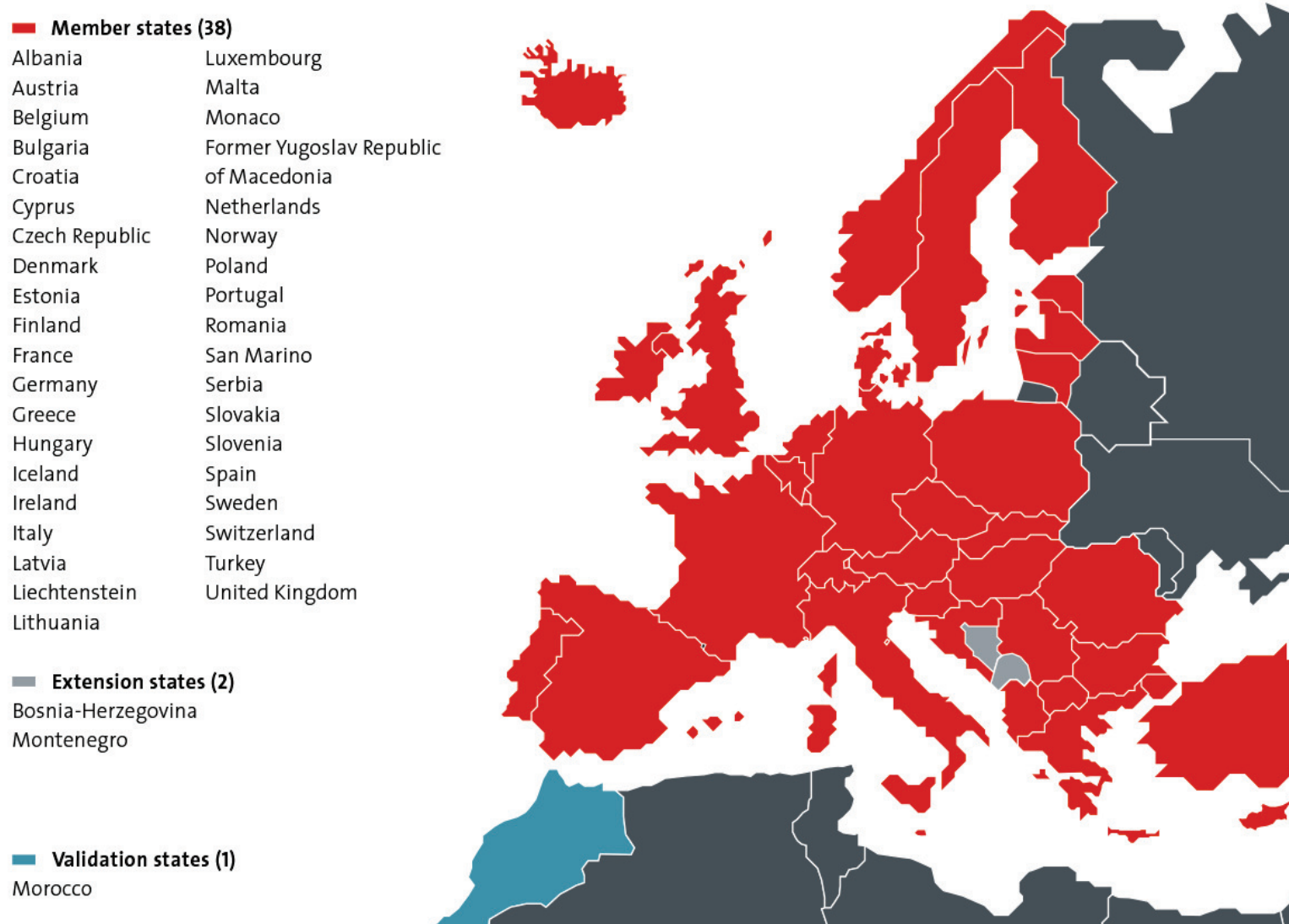
Jeremy Smith
July 2015

The European Patent Convention

European Patent System

- Single application, handled centrally by EPO
- EPO has offices in Munich, The Hague, Berlin, Vienna, Brussels
- On grant, separate validation in each country (“state”) – bundle of patents

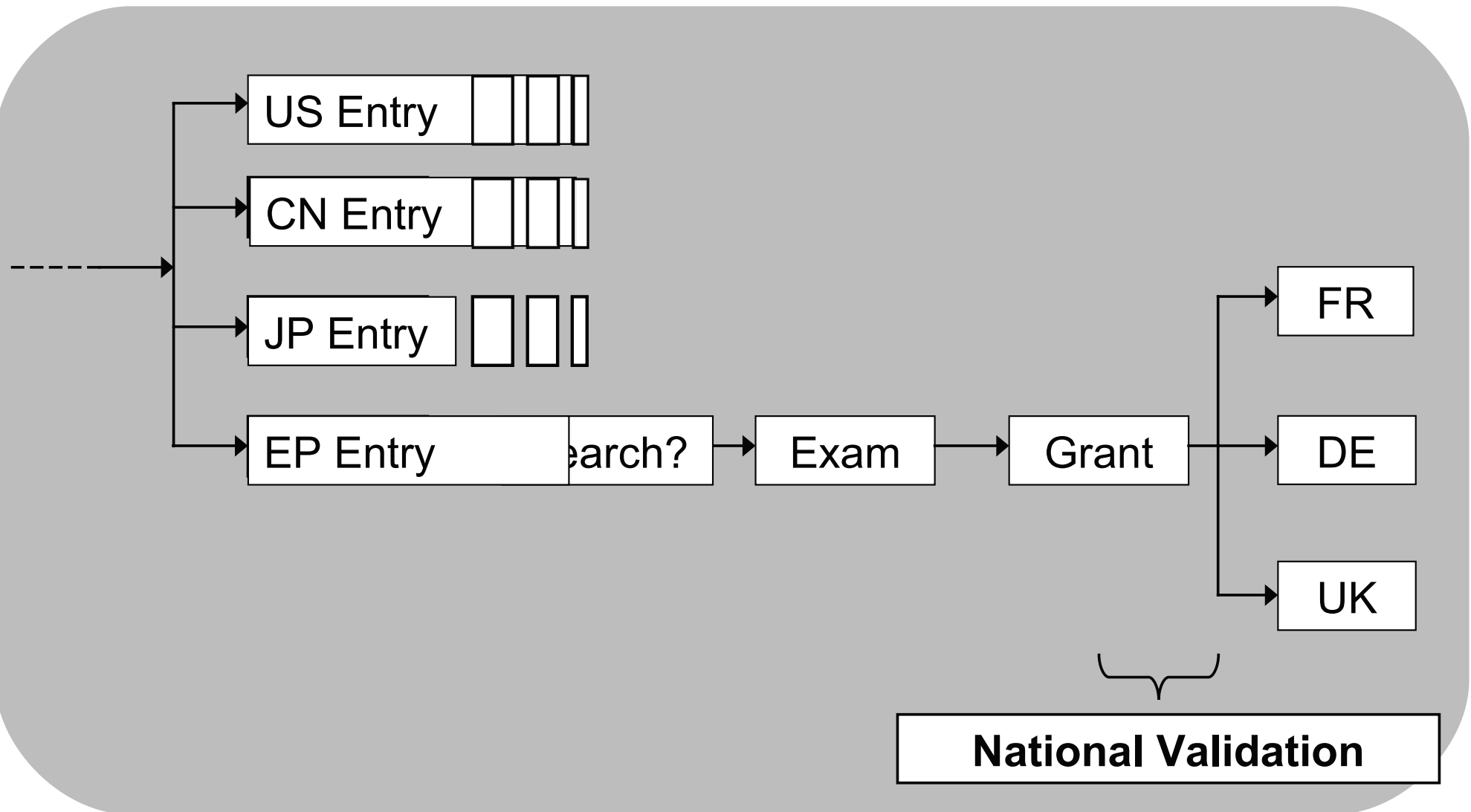
European patent application



[http://documents.epo.org/projects/babylon/eponet.nsf/0/e65e85faf2f200f4c125744a00294866/\\$FILE/European_patents_coverage_en.png](http://documents.epo.org/projects/babylon/eponet.nsf/0/e65e85faf2f200f4c125744a00294866/$FILE/European_patents_coverage_en.png)

EP Regional Phase - The Basics

Regional Phase Procedure



Basic Procedure

- Deadline for entry: 31 months
- What has to be filed?
 - Simple form only
 - EP associate needs just the PCT or WO number from you
 - No copy of application needed, unless amendments being filed
 - Translation (if applicable)

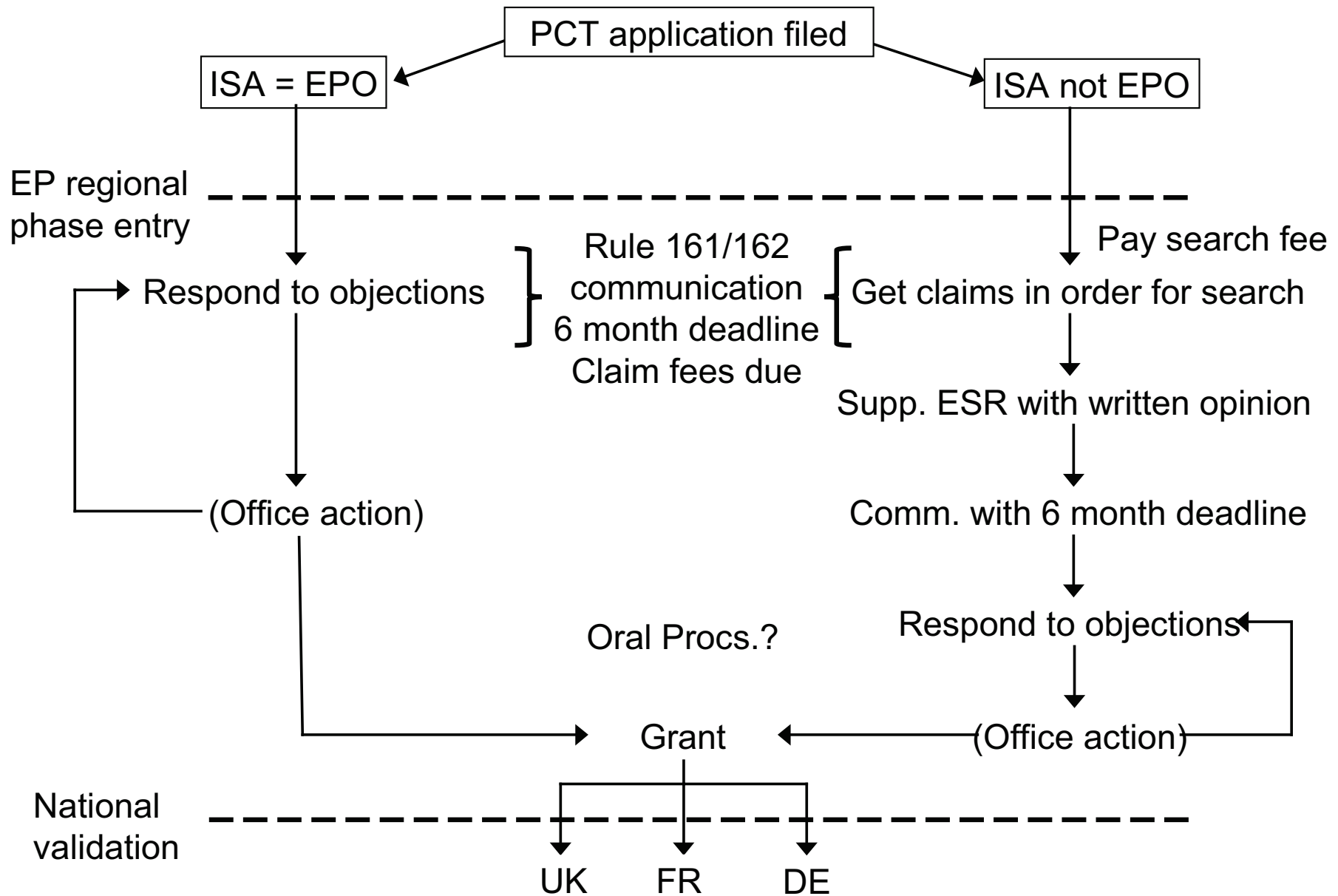
Basic Procedure

- Fees due on entry:
 - Filing fee (includes a fee for each page over 35)
 - Search fee (if applicable)
 - Designation fee + extension fees if required (due on entry unless ISR published less than 6 months ago)
 - Examination fee (due on entry unless ISR published less than 6 months ago)
 - Any renewal fees due (due if entry after end of month in which 2nd anniversary of PCT filing date falls)
- Fees due after entry:
 - Excess claims fees for more than 15 claims (although you can pay them on entry). Can amend claims after entry before fees due.

Basic Procedure

- Search Fee - €1285 (US \$1750)
 - No search in EP phase if EPO was ISA or SISA
 - €190 (US \$260) reduction if ISA or SISA was:
 - US, JP, KR, CN, RU, AU
 - €990 (US \$1350) reduction if ISA or SISA was:
 - AT, FI, ES, SE, XN
- Examination Fee - €1620 (US \$2200)
 - 50% reduction if EPO was IPEA
 - Rises to €1805 (US \$2450) if EPO was ISA but no IPE
- Excess Claims Fees
 - €235 (US \$320) for claims 15 to 49
 - €580 (US \$790) for claims 50+

EP Regional Phase - Advanced



EPO = ISA: After Entry

- Requirements:
 - Response to Written Opinion of ISA/IPEA [Rule 161 EPC]
 - Amendments and/or comments. This is compulsory if no amendments filed on entry, and optional if amendments filed on entry.
 - Payment of excess claim fees [Rule 162 EPC]
 - Last opportunity for voluntary amendments
 - Further amendments at discretion of Examining Division
- 6 month period set by Rule 161/162 EPC Communication
 - Issued shortly after EPO entry
- If no amendments filed on entry, failure to respond = application deemed withdrawn

EPO = ISA: Further search

- If claims at end of six-month period include one or more inventions that were not searched by the EPO as ISA, have to pay a search fee to get these claims searched by the EPO at this stage
- Although more than one invention can be searched, eventually the application will have to contain claims relating to only one invention. A divisional application can be filed to seek protection for other inventions.

EPO not ISA: After Entry

- No response to WOISA/IPRP required
- Rule 161/162 EPC Communication sets 6 month period for:
 - Payment of excess claim fees
 - Last opportunity for voluntary amendments
- Supplementary European search carried out on your claims at this stage
 - Important to get claims in order for search – see next slide

Supplementary European Searches – must get claims in order for search!

- Restrictions on voluntary amendments [Rule 137(2),(3) EPC]
- Multiple independent claims in same category [Rule 62a EPC]
 - Elect one claim in each category to be searched
- No meaningful search possible [Rule 63 EPC]
 - Statement can be filed in response
- Restrictions on amending to unsearched subject matter later [Rule 137 (5) EPC]
- Lack of unity? First mentioned invention will be searched, with opportunity to pay further search fee(s) for other inventions to be searched as well [Rule 164(1) EPC]. Will eventually have to reduce to only one invention.

Tips and Tricks

- Delaying and accelerating entry
- Saving money
- Streamlining prosecution

Quick quick slow...

– **Delaying Entry**

- Further processing can be used
 - If 31 month date missed, letter noting “loss of rights” will issue (sent to applicant)
 - Two-month deadline from date of letter to enter regional phase
- But...50% surcharge on fees

– **Accelerating Entry**

- Complete the usual steps, but early
- Expressly request early regional phase processing
- Waive right to receiving Rule 161/162 EPC communication

Saving \$\$\$ Before Entry

- Record any name changes and assignments at IB before 30 month date
- File replacement pages to reduce no. of pages, but note:
 - A4 paper only
 - Minimum text margins: 2.5cm (L), 2cm, 2cm and 2cm
 - 1.5 line spacing
 - Capital letters minimum 0.21cm (11 point Times New Roman is OK)

Saving \$\$\$ on Entry

- Avoid excess claims fees:
 - Use multiple claim dependencies and combine lesser claims
 - Think hard about multiple independent claims in the same category
 - Incorporate claim language into description?
- File only a single page of claims on entry (to reduce excess page fees)
 - Amend claims later under Rule 161 (no extra excess page fees due)

Streamlining Prosecution

- Full response to Written Opinion of ISA/Search Opinion
- Provide detailed basis for amendments [r. 137(4) EPC]
- Use “problem-and-solution approach” to argue inventive step
- Give ground to Examiner in less-important areas?
- Use “auxiliary requests”?
- Speak with the Examiner
- Can ultimately save you money

Divisionals

Divisionals

- Previous two-year deadline for filing divisional applications abolished
- Divisional filing window re-opened for cases where previous two-year deadline had expired
 - Do you need to re-visit those European FTOs?
- Token increase in filing fee for 2nd and subsequent generation divisionals
 - Negligible compared to back renewal fees payable for the divisional

London Agreement

Current Status

–No post-grant translation:



UK



Germany



France



Switzerland



Liechtenstein



Monaco



Ireland



Albania



Luxembourg

–Translation of claims only:



The Netherlands



Iceland



Latvia



Croatia



Slovenia



Denmark



Sweden



Lithuania



Finland



Hungary



Republic of Macedonia

The Unitary Patent and Unified Patent Court

Unitary Patent and Unified Patent Court

- Unitary Patent
 - Additional validation option for European applications
 - Renewal fees not yet known
 - Some EPC countries missing
- Unified Patent Court System
 - opt in / opt out
- Here by 2016...?

UNITARY PATENT

(Must be an EU member state)

Austria	Latvia
Belgium	Lithuania
Bulgaria	Luxembourg
Cyprus	Malta
Czech Rep.	Netherlands
Denmark	Portugal
Estonia	Romania
Finland	Slovakia
France	Slovenia
Germany	Sweden
Greece	UK
Hungary	
Ireland	

CURRENTLY NOT PART OF UP and/or UPC

Italy *

Poland **

Spain

Croatia

* Italy has signed the UPC Agreement, so EP(IT)s will be litigated at the UPC

** Poland has signed up to the UP but not the UPC Agreement

EPC MEMBERS BUT NOT EU MEMBERS

Iceland †

Serbia †

Macedonia †

Turkey †

Albania

Norway

Switzerland

Liechtenstein

Monaco

San Marino

† EU candidate country

AWAITING RATIFICATION**RATIFIED****Coming soon?**

Bulgaria
Cyprus
Czech Rep.
Estonia
Finland
Germany
Greece
Hungary
Ireland

Italy
Latvia
Lithuania
Luxembourg
Netherlands
Portugal
Romania
Slovakia
Slovenia

Austria
France
Sweden

Belgium
Denmark
Malta
United Kingdom

- Need 13 countries to ratify the UPC Patent agreement for it to come into force
- Must include France, Germany and the United Kingdom

Thank you

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Patent and Trade Mark Attorneys

Kilburn & Strobe

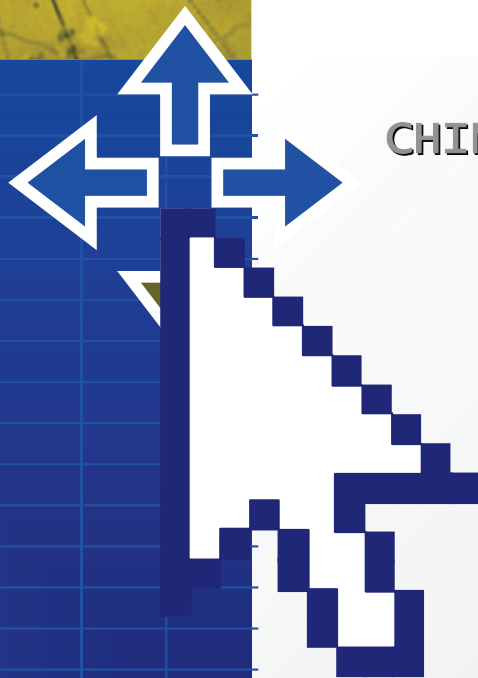


Entering the Chinese National Phase

AIPLA PCT Seminar
July, 2015

CHINA PAT Intellectual Property OFFICE
Beijing · Hong Kong

[Http://www.china-pat.com](http://www.china-pat.com)



Reasons of getting protection in China

- ❖ Lots of things are manufactured in China
- ❖ Two real examples (enforcement factor; Filing utility model even lack of novelty)
- ❖ Defensive publication
- ❖ Important proposed amendments in fourth revision of Chinese patent law

- ❖ Due date for entry: 30 months
- ❖ Two-month grace period with additional fees
- ❖ Unavoidable revival available
- ❖ No unintentional revival

❖ Chinese translation of specification and claims in the international publication

- 1. In the US, English translation is not required for avoiding the case going abandoned;*
- 2. Making good use of the traditional Chinese translation filed in Taiwan;*

❖ Type of patent application

- 1. Invention application (similar to utility application) or Utility model*
- 2. when you use the term “utility patent”, be careful, it might be misunderstood as “utility model” by people from a country which has utility model*

❖ Application fee, publication fee and fee for grace period

- ❖ Invention patent (similar to utility patent in the US)
 - subject matter: machine, manufacture, process, composition of matter;
 - term: 20 years from Chinese filing date (international filing date);

- ❖ Utility model (no such category in the US)

Less than 1% filed by foreign applicants Why?

	Year 2005	2006	2007	2008	2009	2010	2011
From domestic applicants	138,085	159,997	179,999	223,945	308,861	407,238	581,303
From foreign applicants	1481	1369	1325	1641	1910	2598	4164

Number of utility model applications filed recently



派特恩

Utility Model

- subject matter: fixed shape and/or structure (exclude process, microstructure, unfixed shape or structure);
- preliminary examination (between formality review and substantive examination);
- no prior art search;
- lower inventive step requirement;
- low cost;
- short pendency: three years (invention) v. eight months (utility model);
- enforce patent earlier;
- term: 10 years from Chinese filing date (international filing date);
- good for short-life product;
- the largest damage ever granted by a Chinese court was awarded to an utility model patentee (Schneider v. Chint USD47 million);
- filing invention and utility model on the same day is not available for Chinese national stage cases;

Invalidation Rates of Utility Model v. Invention Patents

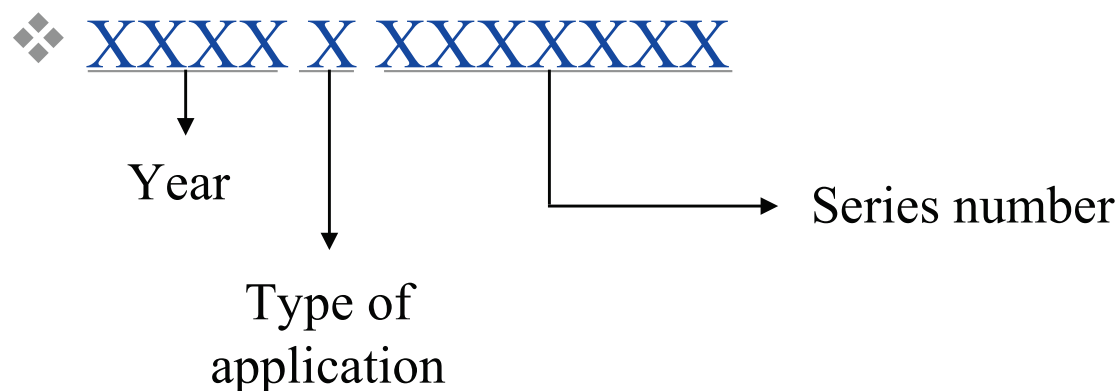
Type of patent	Partial invalidation rate	Complete invalidation rate
Utility model patent	11.53%	33.26%
Invention patent	16.47%	25.39%



派特恩

Number of Chinese national phase cases

- ❖ In 2013, SIPO received 73,583 Chinese national phase cases from PCT applications .
- ❖ 72,867 were invention patent applications and 716 were utility model applications.
- ❖ Account for 51% of total number of applications from abroad



- ❖ Year: year of international filing date
- ❖ Type: 8-invention application from a PCT;
9-utility model of a PCT;
- ❖ Patent number and application number share the same number

Basic Procedure – Full list

- ❖ Fee for claiming a priority;
- ❖ Additional claim fee and application Size Fee

Matters	Chinese Patent Practice	US Patent Practice
Additional Claim fee	More than 10 claims; no more claim fee after application is filed or after the PCT is entered the Chinese national stage; For a PCT entry case, it is calculated based on the claims filed on the International Filing date.	1. More than three independent claims; 2. More than 20 claims; 3. Multiple dependent claims; For a PCT entry case, it is calculated based on the preliminary amendment when the claim fee is paid.
Application size fee	specification including drawings each page in excess of 30 pages or each page in excess of 300 pages	each additional 50 sheets that exceeds 100 sheets

- ❖ Request for immediate processing if the case is entered before 30-month due date;
- ❖ Examination basis

Matter	Chinese Patent Practice	US Patent Practice
Examination Basis	Choose from Article 19, 34, 28 or 41 amendment	last amendment made during the international stage

- ❖ Chinese translation of amendment if it is chosen as examination basis (two month from the date of entering)
- ❖ Chinese translation of abstract and drawings
- ❖ If there is an assignment in the international stage, document proving the assignment is needed

- ❖ Examination fee: three years from the earliest priority date;
 - No examination fee if SIPO was ISA and IPEA;
 - 20% reduction if ISA was JP, EP, SE;
 - If the ISR is not provided to SIPO when request of examination is filed, the applicant submitting the ISR at SIPO before Notice of Entering the Substantive Examination is issued could get a refund of 20% examination fee;

Voluntary amendment - Invention

- ❖ Scope: specification, claims, abstract, drawings
- ❖ No new matter (strict)
- ❖ Timelimits:
 - Entering the Chinese national stage (Article 28 or 41)
 - Filing request for examination
 - Three months from receipt of Notice of Entering the Substantive Examination (receipt date: issue date of notice + 15 calendar days)
- ❖ No government fee for filing voluntary amendment
- ❖ No additional claim fee after entering the Chinese national stage

Voluntary amendment – Utility Model

- ❖ Scope: specification, claims, abstract, drawings
- ❖ No new matter (strict)
- ❖ Two month from the date of entering Chinese national stage
- ❖ No government fee for filing voluntary amendment
- ❖ No additional claim fee after entering the Chinese national stage



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Amendment after Office Action

- ❖ Amendments made only for addressing rejection/objection in Office Action
- ❖ Applicant cannot do the following:
 - broadening scope of protection of an independent claim on applicant's own initiative; (amending or deleting limitation)
 - adding claims which lack of unity of invention with the examined claims;
 - adding new independent claim which is not in the original claims;
 - adding new dependent claim which is not in the original claims;

Correction of Chinese Translation

- ❖ Benefit of entering the Chinese national stage through a PCT: correct the Chinese translation based on the PCT international publication
(No incorporation by reference in China – cannot amend application document based on the priority case)
- ❖ Voluntary correction
- ❖ Correction required by SIPO
- ❖ Government fee
- ❖ Time limits:
 - before preparation for pre-grant publication of invention application;
 - before preparation for issuance of utility model application;
 - three months from receipt of Notice of Entering the Substantive Examination (receipt date: issue date of notice + 15 calendar days)

- ❖ After issuance, if Chinese translation has a broader scope of protection, the scope of protection of the patent is determined by the original PCT application;
- ❖ After issuance, if Chinese translation has a narrower scope of protection, the scope of protection of the patent is determined by the issued Chinese patent;

Common Defects in Drawings

- ❖ Drawings are not reproducible for publication purpose;
Problem: adding new matter when we submit clearer drawings
Suggestion: 1) replace the drawings during international phase; or
2) ask the International Bureau to republish the drawings to make them clearer;
- ❖ Drawings and reference numerals must be computer-generated

- ❖ Reasons of filing in Hong Kong:
 - the port of Hong Kong is one of the largest in the world
 - home to some of the largest trade shows in the world (Hong Kong Electronics Fair, the Hong Kong Optical Fair, and the Hong Kong Houseware Fair)
 - patent certificate is the necessary title document for making complaint to the Legal Adviser of Fairs about patent infringement by another exhibitor.

- ❖ Application document can be filed either in English or Chinese
- ❖ Filing a request to record a designated patent application (about USD480): six months from publication at SIPO
- ❖ Filing a request for registration: six months from issuance at SIPO (about USD280)

- ❖ Application step and registration step
- ❖ Two approaches to carry out the two steps.
- ❖ Approach One:
 - carry out the application step at any time when the Chinese national stage case is pending.
 - after the Chinese case is issued, carry out the registration step within three months from the issue date of the Chinese case.
- ❖ Approach Two
 - within three months from the issue date of the Chinese case, we just take the application and registration steps together as a single step.
- ❖ Approach Two is recommended

Accelerate/shorten prosecution and reduce its cost

- ❖ Average pendency for invention applications: 22.2 months
- ❖ Average pendency for utility model applications: 4.3 months
- ❖ Reduce number of Office Actions
 - 1) if necessary Contacting examiner before sending in a response to an Office Action;
 - 2) Contacting the examiner again to follow up after filing the response and inviting the examiner to call us when any issue comes up
- ❖ PCT-PPH/PPH
 - 1) From our experience, Office Action is issued in about two months from the date of filing PCT-PPH;
 - 2) Majority Office Action only points out some formality issues;



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Accelerate/shorten prosecution and reduce its cost (Cont.)

❖ Accelerated Examination:

The applicant may file a request for accelerated examination if the case falls into one of the following circumstances (no evidence needs to be shown):

- (a) The invention has great significant to national interests or public interests;
- (b) Any entity or individual exploits the invention after its publication, which has impacted the interests of the applicant significantly; and
- (c) Filing an invention application is used as an important part of an investment of intangible asset.

Time frame: The Chinese Patent Office must issue an Office Action within 30 working days from the date the petition of expedited examination is granted.

Applicant must respond to an Office Action within two months.

Comparison with US patent practice and Chinese patent practice

- ❖ Importance of understanding the differences (change practice according to the differences);

Matters	Chinese Patent Practice	US Patent Practice
Request for Continued Examination	No	Yes
Divisional application	Yes (due date of filing: issue date of Notice of Allowance + 15 calendar days + 2 months)	Yes copending
Continuation in part	No Practice: claim a domestic priority within 12 months	Yes

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Inventorship	1. Inventors only have a right to put their names onto the patent application/patent; 2. Wrong inventorship cannot be used to invalidate a patent	Wrong inventorship can cause a patent to be invalid or unenforceable
Grace period following public disclosure	6 months; In practice, it is almost never used (do not rely on it)	12 months;
Duty of information disclosure	No, unless the examiner asks for search result from an office. A favorable written opinion or an Office Action from other countries would be helpful to get a patent fast or save cost.	Yes

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
References used for 102 rejection	1) Publicly used before the priority date; 2) Publicly known before the priority date; 3) Patented or described in a printed publication before the priority date; 4) Filed before the priority date and published at SIPO after the priority date; for a PCT application, it must be published by SIPO after entering the Chinese national stage It does not matter entity; (1), (2) and (3) are worldwide	102
References used for 103 rejection	1) Publicly used before the priority date; 2) Publicly known before the priority date; 3) Patented or described in a printed publication before the priority date;	102

Comparison with US patent practice and Chinese patent practice (Cont.)

Matter	CN Patent Practice	US Patent Practice
Determining Obviousness/Inventive Step	1. Identify the closest reference – <u>disclose most limitations</u>; 2. Ascertaining the differences between the claimed invention and identify <u>object</u> of application based on technical effect archived by the differences; and 3. Resolving the level of ordinary skill in the pertinent art	1. identify the prior art; 2. Ascertaining the differences between the claimed invention and the prior art; and 3. Resolving the level of ordinary skill in the pertinent art.

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
“Same invention type” double patenting	Same priority date or Chinese filing date Same owner: pick one or amend Different owners: owners make agreement of the ownership; amend claims; Otherwise, both applications are rejected	It is not possible to overcome the rejection other than by canceling or amending the identical claim
“Obviousness type” double patenting	Canceling or amending the claims	Canceling or amending the claims or Terminal Disclaimer
Applicant	Can be a legal entity; No need to record an assignment if the legal entity files the application from the start	After September 16, 2012, can be non-inventor applicant

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Appeal	Yes, but it is called reexamination	Yes
First Office Action Prediction	No	Yes
Nonobviousness (35 USC 103)	Inventive step: a limitation not disclosed in prior art + technical effect	a limitation not disclosed in prior art
Secondary considerations	(1) long felt but unresolved needs; (2) skepticism by experts; (3) unexpected result; (4) the invention's commercial success;	(1) the invention's commercial success, (2) long felt but unresolved needs, (3) the failure of others, (4) skepticism by experts, (5) praise by others, (6) teaching away by others, (7) recognition of a problem, (8) copying of the invention by competitors.



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Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Restriction practice	distinct inventions (unity of invention); traverse/adding special technical feature into claims/delete claims which do not comply with Unity of Invention	distinct inventions/ distinct species Traverse (not often)/pick a group



Thank you

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China PAT Intellectual Property Office

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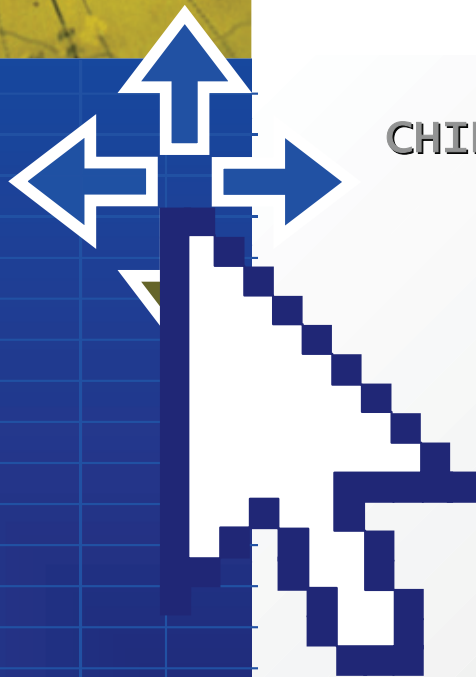


Strategies for National Filing

AIPLA PCT Seminar
July, 2015

CHINA PAT Intellectual Property OFFICE
Beijing · Hong Kong

[Http://www.china-pat.com](http://www.china-pat.com)



- ❖ Business need for exclusivity
- ❖ Initial and long-term cost
- ❖ General evaluation of countries
- ❖ Overview of patent system of country
- ❖ A big problem is that what you really care about might be “what will be the answers to these questions in ten or fifteen years?”

- ❖ Where is the market of the invention?
- ❖ Where is the field of invention crowded?
- ❖ Where is the claimed product manufactured or the claimed process used?
- ❖ Where do your competitors manufacture the product?
- ❖ Which country do your competitors hold patents in the same/similar field of the invention?
- ❖ Which country are your competitors taking developments direction into the same/similar field of the invention?

- ❖ Would it be easy (or difficult) for your competitors to design around the claimed invention?
- ❖ Would it be easy (or difficult) for a third party to copy the invention?
- ❖ Is there an incentive to copy the invention in “unprotected” countries?
- ❖ Would it be costly for a third party to copy and market the invention?
- ❖ Is the market there for the invention growing, declining or stagnant?

- ❖ Is the invention on-point with your marketing strategy?
- ❖ Is the invention defensive?
- ❖ Is it a break-through invention?
- ❖ Is it a minor improvement/an alternate embodiment to an existing invention?
- ❖ Is it a significant consequence to your business if the invention is copied there?
- ❖ Is there licensing, cross-licensing value?
- ❖ Which country represents a big portion of your total market?

- ❖ Are there other developments competing for budget money?
- ❖ What is the anticipated life span of the invention?
- ❖ Bottom line question; if we do not file a patent, so what?

- ❖ Are there other developments competing for budget money?
- ❖ EPO - \$10K
- ❖ Japan - \$12K
- ❖ Korea - \$12K
- ❖ China - \$8K
- ❖ Canada - \$1K
- ❖ Australia - \$1K
- ❖ These are all approximate!

- ❖ Many foreign patent offices charge “annuities”?
- ❖ In many foreign countries the annuities must be paid in a pending application even if a patent has not yet been granted
- ❖ This can add up to thousands of dollars over the life of the patent application even if it never becomes a patent
- ❖ Cost of maintaining that patent once it has been obtained

- ❖ Population
- ❖ Market potential
- ❖ Emerging or industrialized country
- ❖ Industry size and growth rate
- ❖ Client's activities within country

- ❖ The “IP5” Offices - US, EPO, Japan, Korea, China
- ❖ BRICS countries - Brazil, Russia, India, China, South Africa
- ❖ NAFTA countries - Canada, US, Mexico
- ❖ MINT countries - Mexico, Indonesia, Nigeria, Turkey
- ❖ Next Eleven - Bangladesh, Egypt, Indonesia, Iran, Mexico, Nigeria, Pakistan, the Philippines, Turkey, South Korea, Vietnam

General evaluation of countries

GNP ranking

❖ US	❖ India	❖ Saudi Arabia
❖ China	❖ Canada	❖ Switzerland
❖ Japan	❖ Australia	❖ Argentina
❖ Germany	❖ Spain	❖ Sweden
❖ France	❖ Korea	❖ Poland
❖ UK	❖ Mexico	❖ Belgium
❖ Brazil	❖ Indonesia	❖ Norway
❖ Italy	❖ Netherlands	❖ Nigeria
❖ Russia	❖ Turkey	❖ Iran



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BRIC countries



How recently did you start filing into the BRIC countries (Brazil, Russia, India and/or China)?

2014 Global Patent & IP Trends Indicator, a study commissioned by inovia

- ❖ Type of patents available in the country
- ❖ Pendency of patent applications in the country
- ❖ Quality of examination; competence and reasonableness of examiners
- ❖ Patentable subject matter in the country

- ❖ Enforceability of patents in the country: ways of enforcement; availability of preliminary injunction; amount of damages; availability of border protection; adequacy of permanent injunction; ability to enforce court decision; availability of and rules of discovery; neutral or pro or anti patent; neutral or pro or anti foreign patentees; availability of willful infringement.
- ❖ Expected future state of patent law in the country

Suggested set of Recommendations

<u>Type of invention/product</u>	<u>Recommendations</u>
System, assembly, complex machine	Limited filing in industrialized countries
Components and materials	Broad filing in all major countries
High technology product	Limited filing in industrialized countries and sourcing countries
World-wide consumer product	Broad filing in major market countries
Industrial product	Limited filing in industrialized countries
Pharmaceutical/chemical products	Broad filing especially where product is easily producible
Labor-intensive product	Low-cost manufacturing countries



Thank you

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Drafting an International Application as a Global Application – EP View

Jeremy Smith
July 2015

“...separated by a common language”

- Different patent offices want and allow different things
- We must account for different audiences when drafting
- It can be too late after PCT filing

Added Matter

Added Matter

- Article 123(2) EPC:

“The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.”

- Requirement for grant
- Ground of opposition and revocation post-grant
 - Inescapable trap!

Added Matter

- Amendments must be “directly and unambiguously derivable” from the application as originally filed
- A strict requirement: some examiners are looking for almost word-for-word textual basis (i.e. “support” in US-speak)
- Generally, implicit or explicit basis is OK
- Usually not allowed to add wording based on what is shown in a Figure
- Incorporation by reference usually not allowed

Added Matter

- The EPO will object to picking one feature from a passage without the other
- So must be clear that:
 - The feature applies to all embodiments
 - The feature can be isolated from related features
 - i.e. the feature should be in a dependent claim

Added Matter: Intermediate Positions

- To add some but not all features from a dependent claim:
 - Need something that says or implies the features need not all come together
- To include multiple features from various dependent claims:
 - Need something that says or implies the features can come together
 - Selection from multiple lists: include intermediates
- To amend to a generalised form of specific feature in the description:
 - Need something that says or implies the feature could be more general
 - Introduction of a feature appearing in specific example into generalised claim otherwise not allowable

Added Matter: Essential v Optional Features

- EPO reads an independent claim as saying “The following features are essential...”
- EPO reads a dependent claim as saying “The following features are optional (but must all come together)...”
- To broaden an independent claim by removing a feature, we must have basis
 - Need something that says or implies the removed feature is not essential
 - What is said elsewhere in the application is therefore very important

Added Matter: Example

- If I claim:
 1. An automobile comprising a radio.
 2. The automobile of claim 1, comprising an anti-theft device.
 3. The automobile of claim 2, wherein the automobile is powered by a rocket.
 4. The automobile of claim 1, wherein the automobile is black and has a retractable roof.
- Can I amend to just a rocket-powered automobile?
- Can I amend to just a black automobile?
- Can I delete the radio?

Added Matter: Example

- More options for amendment if I originally had:
 1. An automobile.
 2. The automobile of claim 1, wherein the automobile has a radio.
 2. The automobile of claim 1 or 2, wherein the automobile has an anti-theft device.
 3. The automobile of any preceding claim, wherein the automobile is powered by a rocket.
 4. The automobile of any preceding claim, wherein the automobile is black.
 5. The automobile of any preceding claim, wherein the automobile has a retractable roof.

Added Matter: What does this mean for the draft?

- We need a “reservoir” of potential amendments from outset
 - Aim is to give maximum room for manoeuvre
 - This can be done in the claims, the Summary or the specific description
- Include:
 - Lots of intermediate statements between broad generalisations and specific embodiments
 - Multiple claim dependencies
 - Basis for optional features of one aspect of invention (e.g. product) also being optional features of other aspects of invention (e.g. method)
- Consider whether features are optional or essential

Added Matter: Bonus “incorporation by reference” slide

- T 689/90 states that it must be obvious:
 - (i) protection is or may be sought for such features;
 - (ii) such features contribute to solving the technical problem underlying the invention;
 - (iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and
 - (iv) such features are precisely defined and identifiable within the disclosure of the reference document.
- Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90):
 - (i) a copy of the document was available to the EPO on or before the date of filing of the application; and
 - (ii) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

Priority

Priority

- Claims are priority entitled:

“... only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.”

Enlarged Board of Appeal decision G2/98

- Test for priority is effectively same as for added matter, a strict novelty standard
 - A generalisation or intermediate position not appearing in priority document will not be priority entitled

Priority: Ensuring ability to validly claim priority in Europe

- Paris Convention requires party filing priority claiming application (your PCT) to be the same as the party who filed application from which priority is claimed (or their successor in title)
- Chain of title needs to be in place before claiming priority
- Ideally, execute assignment before PCT filing
- Continuations and CIPs can complicate matters

Priority: What does it mean for the draft?

- Consider priority application when drafting claims
- If application is not a full repeat of priority document, retain basis for a priority-entitled position (e.g. include claims of priority application, or equivalent statements in the Summary)
- Remember, in Europe a priority document cannot be used as basis for amendment
- Make sure you have entitlement to claim priority
- Best practice is to draft provisional application in final form, including claims (or at least wording identical to claims)

Unity and Independent Claims

Unity of Invention

- Article 82 EPC:

“The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

- All independent claims should share the same, or a corresponding, novel and non-obvious concept
 - A requirement for grant, but not a ground of opposition or revocation
- EPO, whether searching as ISA or in EP phase, will search only the first invention appearing in the claims (but can pay additional search fees)

Unity of Invention: What does this mean from the draft?

- Lack of unity possible between claims or within a single claim (e.g. in a Markush grouping)
- Ensure your most important subject matter appears first in the claims
 - Can correct this on EP regional phase entry
- Prepare your client for potentially expensive divisionals?

Number of Independent Claims

- Single independent claim only in each claim “category”
 - Usually no more than single independent product claim and single independent method claim allowed. Get a choice of which one is searched.
- Three exceptions [r.43(2)]:
 1. Inter-related products (plug-and-socket-type situation)
 2. Different uses of product or apparatus
 3. Alternative solutions to same problem
- You can amend to correct this problem (e.g. make them dependent claims), but you might need a divisional

Number of Independent Claims: What does this mean for the draft?

- Identify your most important independent claim
- Consider including a generic claim on filing (or basis for amendment to one)

Clarity

Clarity

- EPO very strict on what it sees as “clear”
 - EPC states claims should usually be clear in isolation
 - Examiner not usually native English speaker
- Concerned with whether the skilled person easily determine the scope of the claim
- Added matter rules apply: **must have basis** for any amendment to cure lack of clarity
 - Without basis to amend, a lack of clarity could be fatal

Clarity: Types of objections

- Claim does not define “essential features” of the invention
 - Means you haven’t claimed technical solution to technical problem
- Claim defines result to be achieved
 - Must claim how problem is solved, not that it is solved
- Relative and/or inherently ambiguous terminology
 - High, low

Clarity: What does this mean for the draft?

- Must claim **how** effect is achieved, not **that** it is achieved
- Mentally rehearse inventive step argument – are all the features you rely on in the independent claims?
- If not in claim on filing, make sure have basis to add later
- Consider back up/alternative wording for “difficult” terms
- Keep a word version of the specification

Inventive Step

Inventive Step



- The EPO loves the problem-and-solution approach!
 1. Select the closest prior art document
 2. Identify novel features of claimed invention over CPA
 3. What is the technical effect of these features?
 4. What technical problem do these features therefore solve?
 5. Would it have been obvious to skilled person, starting from (1), and set the problem (4), to adapt (1) by adding the features (2), and thereby arrive at the solution of the claimed invention?

Inventive Step: What does this mean for the draft?

- Set up a technical problem in the Background
 - Setting the scene, rather than tying yourself to a position
 - Problem can be reformulated during prosecution
- Explain technical nature of your solution
 - Explain technical nature of optional features
- Consider scope of claims
 - Is problem solved over whole scope?
- Express all advantages
 - Not tied to exact wording

Excluded Subject Matter

Excluded Subject Matter

- Art 52 EPC says *discoveries, scientific theories, mathematical methods, aesthetic creations, mental acts, methods for playing games, business methods and computer programs* are not inventions...
- ...but case law says that it's not excluded if non-obvious **technical solution to technical problem**
- A matter of substance, not form, so...
 - Make title sound technical, not business-related
 - Set up a technical problem in Background
 - Explain technical nature of solution in Summary

Excluded Subject Matter: Methods of treatment/diagnosis

- Art 53(c) EPC excludes methods of treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body
- Include basis for medical use claims
 - EPC2000-style
- Include basis for non-excluded diagnostic method
 - Method without all four diagnostic steps (i) collect data; (ii) compare data with standard, (iii) note deviation; and (iv) attribute a diagnosis
 - Method without interaction with body, i.e. performed on a sample “obtained” from a patient, rather than always including step of obtaining the sample (*ex vivo* methods)

Summary

- Title
 - Excluded matter: make it sound technical
- Background
 - Excluded matter: set up a technical problem
 - Inventive step: telling a story; set up problem to be solved
- Summary section
 - Added matter: formal support for wording of the claims
 - Added matter: keep options open: reservoir of basis for amendment
 - Added matter: optional features, intermediates, independent “claims” ...
 - Excluded matter: explain technical nature of solution
 - Inventive step: Mention advantageous effects of features as results

Summary

- Specific Description
 - Added matter: describe preferred and alternative embodiments
 - Added matter: include “reservoir” if you don’t like Summary sections
 - Clarity: give multiple definitions for “difficult” terms
- Claims
 - Clarity: are you relying on a feature’s name for novelty?
 - Clarity: have you recited features needed for inventive step argument?
 - Unity: novel and inventive features common to independent claims?
 - Number of independent claims
 - Multiple dependencies

The Opposition Division or Appeal Board

- Grounds of post-grant opposition:
 - Excluded subject matter, novelty, inventive step, industrial applicability
 - Added matter – inescapable trap!
 - Insufficiency
- Unity, clarity and support don't appear
- Additional amendment requirement
 - No extension of claim scope allowed during Opposition.

The Judge (UK)

- Case will usually turn on scope of claims
 - Claim interpretation therefore critical
 - Same interpretation for both validity and infringement
- Grounds for revocation:
 - Excluded subject matter, novelty, inventive step, industrial applicability
 - Added matter
 - Extended scope of protection
 - Insufficiency
 - Entitlement
- Priority entitlement in the UK
 - Needs to be in place before claiming priority

Thank you

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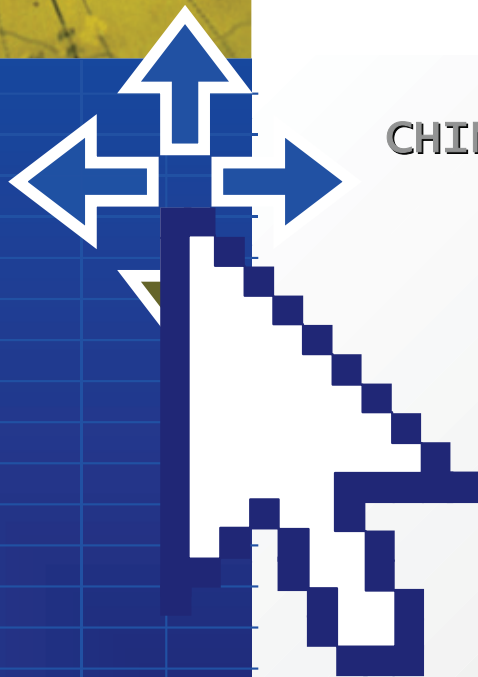
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Drafting an International Application as a Global Application – CN View

AIPLA PCT Seminar
July, 2015

CHINA PAT Intellectual Property OFFICE
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- ❖ Regular words
- ❖ Regular meaning
- ❖ Short sentence
- ❖ Easy to understand and translate
- ❖ Concise

Measuring Unit

- ❖ China: International measuring unit (metric)
It might incur additional cost to convert
- ❖ US: inches, pounds

Abstract

- ❖ Not viewed as part of original disclosure
- ❖ Keep it short
- ❖ Cannot amend the application based on the content only mentioned in the abstract

- ❖ Independent claim shall describe the essential limitations necessary for fulfilling object of the invention or utility model.
 - ground of invalidation;
 - it may cause the scope of protection narrower than it in the US;
 - more than one object;
 - technical effect and technical solution help to determine object if specification does not describe it, or problems mentioned in background;
 - each independent claim has to satisfy this requirement;
- ❖ Dependent claim

Matter	Chinese Patent Practice	US Patent Practice
Definition of dependent claims	1. must be about the same subject matter; 2. must include all the limitations; 3. must be in the same category (apparatus or method claim)	Determined by preamble



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Claims (Cont.)

- ❖ Apparatus claim is preferred
 - easy to enforce because China does not have discovery procedure;
- ❖ Multiple dependent claims are recommended;
- ❖ Multiple dependent claim cannot depend on another multiple dependent claim;
- ❖ Omnibus claim is not allowed (might work in other countries, such as India);
- ❖ Beauregard claim is not allowed;
- ❖ Machine or transformation also works in China;



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Claims (Cont.)

- ❖ The claims shall be definite
 - ground of invalidation;
 - “preferably” is indefinite; “substantially” is indefinite in most situation;
 - at least, define the meaning of “substantially” in the specification;
- ❖ Means-plus-function or step-plus-function;
 - similar to the US;
 - at enforcement stage, it is construed narrower than it at EPO

❖ Background

Matter	Chinese Patent Practice	US Patent Practice
Reference mentioned in background	No admission	Concede it as an admission of prior art

❖ Summary of invention

- Make it short, just has independent claims

❖ Brief description of drawings

- Make it short

❖ Embodiment

- No best mode requirement

❖ Written description is more strict in China (word-to-word textual basis)

- has claims for China in specification, even not in claims

Specification (Cont.)

- ❖ Enablement: similar to the US
- ❖ Incorporation by reference:

Matter	Chinese Patent Practice	US Patent Practice
Incorporation by reference	No Practice: to satisfy enablement, simply include the content in the application instead using incorporation by reference	Yes

- ❖ Technical effect
 - it is not only helpful for patentable subject matter determination but also helpful for inventive step argument
 - cannot be added into the specification later
- ❖ Avoid using trademark to identify a product

- ❖ No requirement: all limitations in claims must be shown in drawings;
- ❖ Computerized drawings
- ❖ Minimize English text in drawings. (Reduces translation costs.)



派特恩

Purpose of filing applications

- ❖ Protect products
- ❖ Block others
- ❖ License out
- ❖ Marketing purpose – additional value to products
- ❖ Different purposes might change how you draft and organize a patent application



Thank you

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Paris Convention for the Protection of Industrial Property

Carol Bidwell
July 2015

Priority date and priority period (Article 2(xi) and Rule 2.4)

- The priority date for the purposes of computing time limits means:
 - where the international application contains a priority claim, the filing date of the application whose priority is claimed
 - where the international application contains several priority claims, the filing date of the earliest application whose priority is claimed
 - where the international application does not contain any priority claim, the international filing date
- The “priority period” is the period of 12 months from the filing date of the earlier application whose priority is claimed
 - the day of filing of the earlier application is not included in that period

Claiming priority (PCT Article 8, Rule 4.10)

- The conditions for and the effects of any priority claim are as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property
- The international application may contain a declaration claiming the priority of one or more earlier applications
 - filed in or, by way of a regional or international application, for any country party to the Paris Convention and/or
 - filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

Article 4 – Paragraph A

A. — (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

Article 4 - Paragraph B

B. —Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

Article 4 - Paragraph C

C. — (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

Article 4 - Paragraph D

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

Article 4 - Paragraphs E and F

E. — (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. — No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country. With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

Article 4 - paragraphs G and H

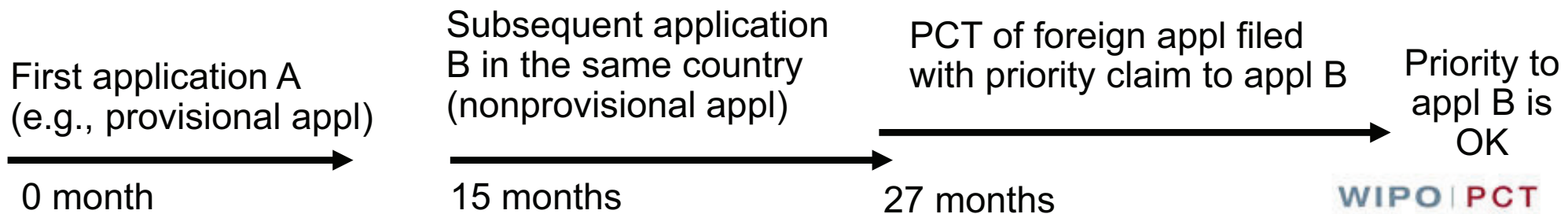
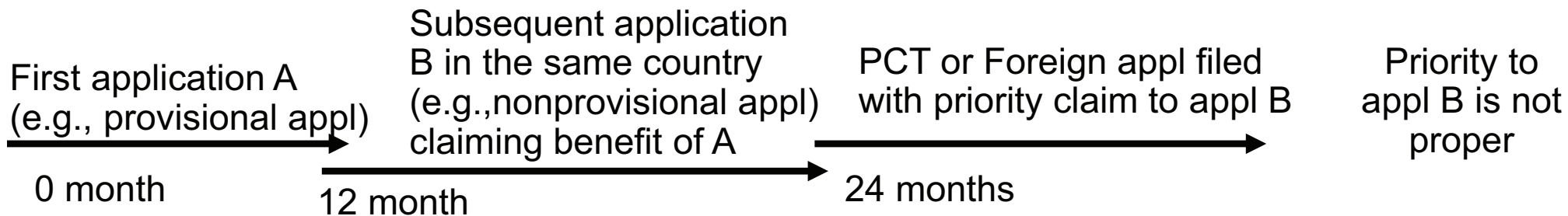
G. — (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. — Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

When is a subsequent application concerning the same subject matter considered the “first” application within the meaning of Article 4 C (4)?

1. First application has been withdrawn, abandoned or refused AND
2. First application has not been laid open to public inspection AND
3. First application has left no rights outstanding AND
4. First application has not yet served as the basis for claiming the right of priority AND
5. First application may not thereafter serve as a basis for claiming a right of priority



Different language in the U.S. Statutes than in the Paris Convention

- 35 U.S.C. 21(b) states:

When the day or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday or a Federal holiday within the District of Columbia, the action may be taken or fee paid on the next succeeding secular or business day

- 35 U.S.C. 119(e)(3) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next secular or business day

- Under US law applicants are permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing

Possible legal consequences of the USPTO accepting electronic applications on Saturday and Sunday

- International applications (or any other patent document) can be filed electronically in the USPTO during the hours of operation of EFS-Web every day of the week, including weekends and holidays
- Paris Convention Article 4C(3) says “If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day”
- Applicants should consider possible adverse consequences regarding the validity of a Paris Convention priority claim if they wait until Monday to file an international application in the RO/US where the priority year ends on a Saturday or Sunday

http://www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.js

C6. Are there any legal consequences of the USPTO's accepting electronic patent applications on Saturday and Sunday? Applicants may file patent applications electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. EFS-Web will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holidays. In addition, 35 U.S.C. 21(b) states:

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

Further, 35 U.S.C. 119((e)(3)) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

Thus, under United States law, applicants will be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period and in Article 4(c)(3) it states:

If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

Further, as stated above, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants are cautioned to consider possible adverse consequences regarding the determination in other countries of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications with the United States Receiving Office. Specifically, the ability to file applications electronically on weekends and holidays in the USPTO **may** result in loss of priority rights in foreign jurisdictions designated in international applications filed with the United States Receiving Office, if applicants elect, in accordance with 35 U.S.C. 21(b) or 119(e)(3), to file an international application on the next succeeding business day in the event that the twelve-month Paris Convention priority period set out in Article 4(C)(1) falls on a Saturday, Sunday, or Federal Holiday. In such circumstances, other patent offices may deny the priority claim on the basis that the international application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(c)(3) and considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants may prefer not to rely upon the "next business day" provisions of 35 U.S.C. 21(b) and 119(e)(3) when filing international applications with the USPTO, and instead file the international application before the Paris Convention twelve-month priority period has expired.

US Provisional patent applications

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“Shovel” provisionals

- We all do it. We receive a disclosure of very limited quality from the client, and we e-file it as a US provisional patent application
- Maybe it is a set of presentation slides that will be shown tomorrow
- Maybe it is an article that will get published tomorrow
- We “shovel” the disclosure into an e-filing submission package, we hold our noses, and we click “submit”

“Shovel” provisionals

- If a shovel provisional has been filed, it is poor practice to allow 11½ months to pass before preparing and filing a non-provisional application
- Client should be hounded for permission to prepare and file a non-provisional application very soon after the filing of the shovel provisional

Provisional applications of high quality

- Let's suppose that a patent application of good quality has been prepared
- Should it be filed as a US ordinary patent application, with a PCT application to follow at 12 months?
- Maybe it should be filed as a PCT application
- Or if we are trying to maximize patent term, maybe it should be filed as a US provisional application