Introduction to and Benefits of the Patent Cooperation Treaty

BENEFITS

- PCT is generally being used because client is considering foreign filing.
  - Buying time and deferral of costs

PCT GIVES YOU MORE TIME TO DECIDE WHERE TO FOREIGN FILE YOUR APPLICATION

Paris Convention Route

1 year

U.S. filing

Japan

Korea

Canada

England

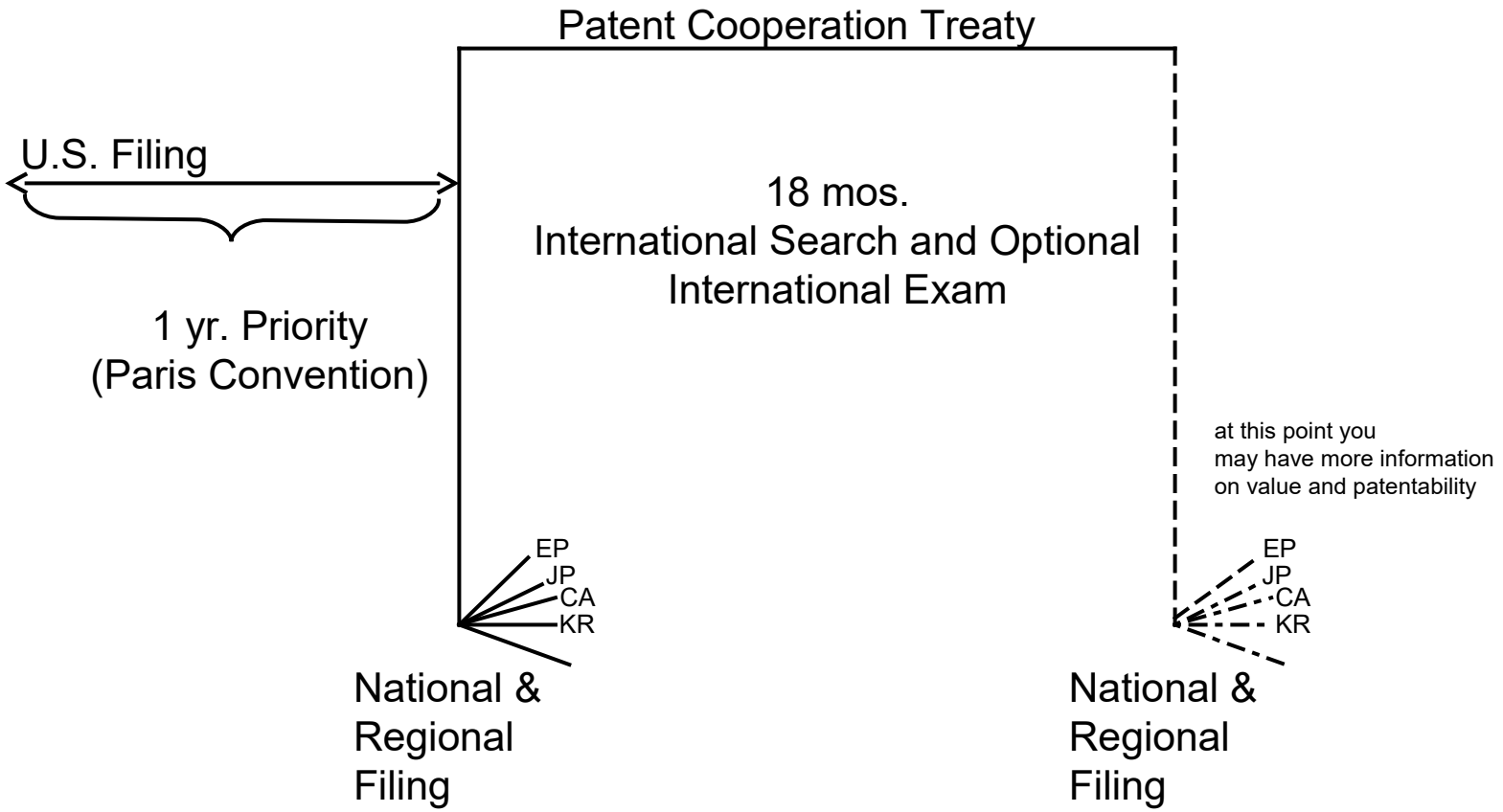
Germany

EPC

Australia

- 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 – $300 for every claim above 15 (further increases in the future)

    Japan – $50 per claim

- Lifetime costs (not including cost of writing application)
  - U.S. approximately - $25,000
  - Europe (8 countries) approximately - $150,000 (will be less in the future using the London Protocol)
  - Japan approximately - $75,000

OTHER BENEFITS

- However, there are other benefits we get using the PCT.
  - 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 PATENT COOPERATION TREATY (PCT)

- provides additional 18 months after priority year (30 months) before making foreign filing decisions
- some countries permit 31 months
- While it adds additional International Costs (about $3,000-$5,000) 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

OUR CHALLENGE

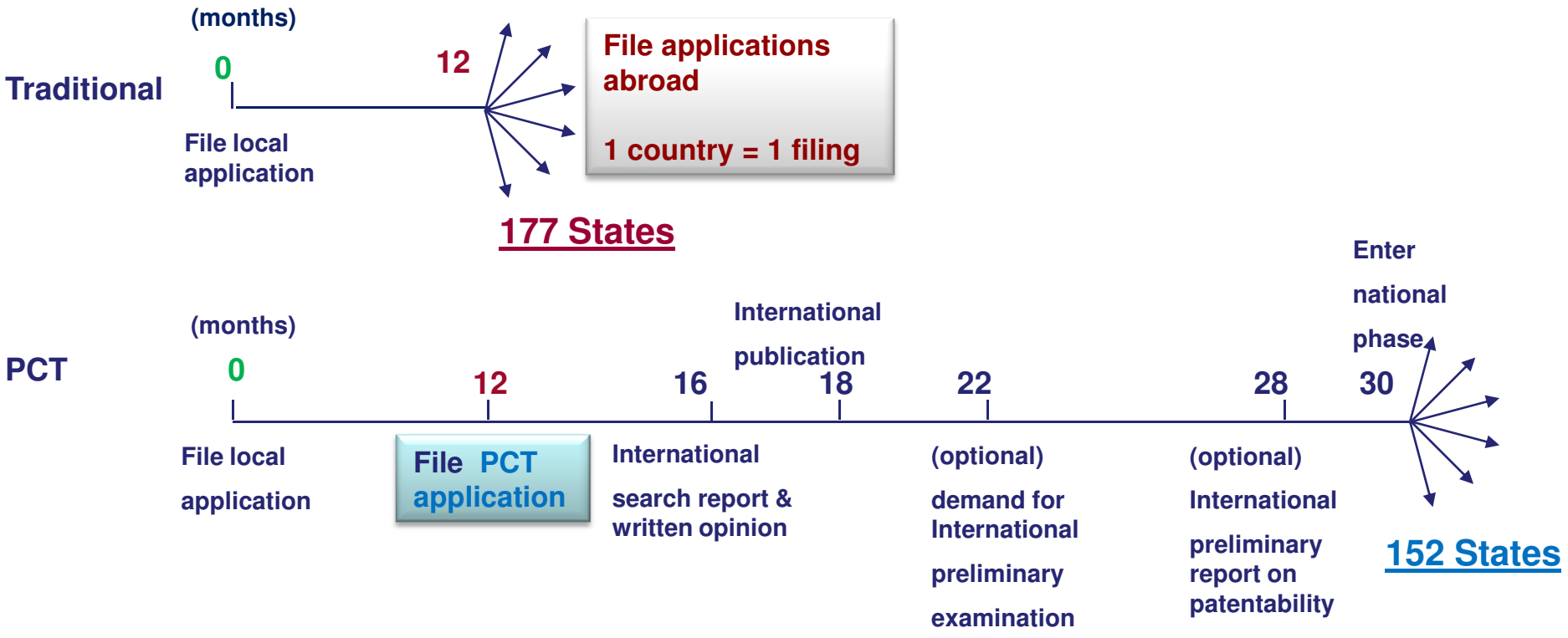
- How to use the PCT system.
- How to make the best strategic use of the system.

WIPO | PCT
The International Patent System

An Overview of the PCT System

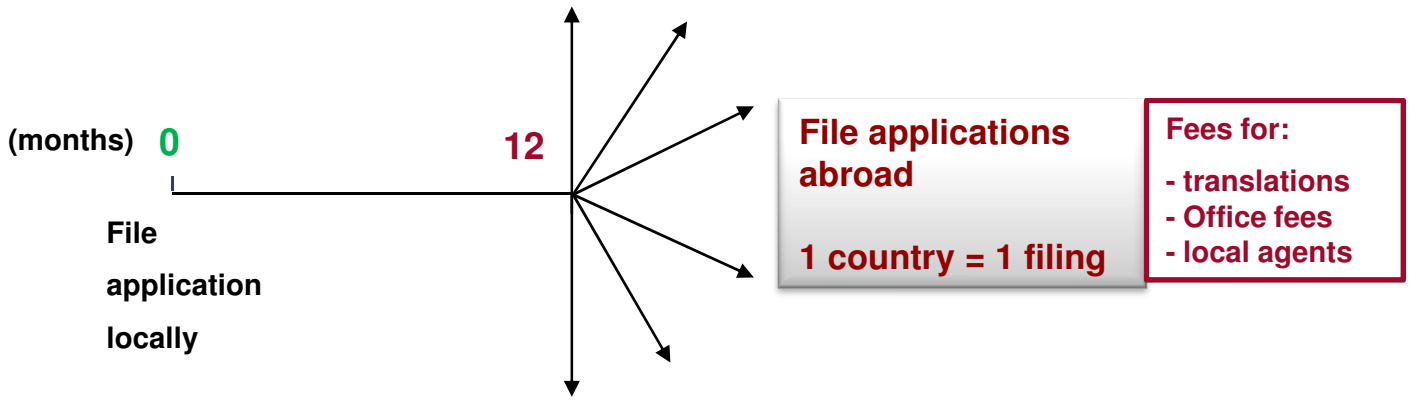
Matthias Reischle-Park
WIPO – AIPLA 21st Annual PCT Seminar, July 2017

Seeking patents multinationally: Traditional patent system ("Paris Route") vs. PCT system



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Traditional patent system



- Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:
  - multiple formality requirements
  - multiple searches
  - multiple publications
  - multiple examinations and prosecutions of applications
  - translations and national fees required at 12 months
- Some rationalization because of regional arrangements: ARIPO, EAPO, EPO, OAPI

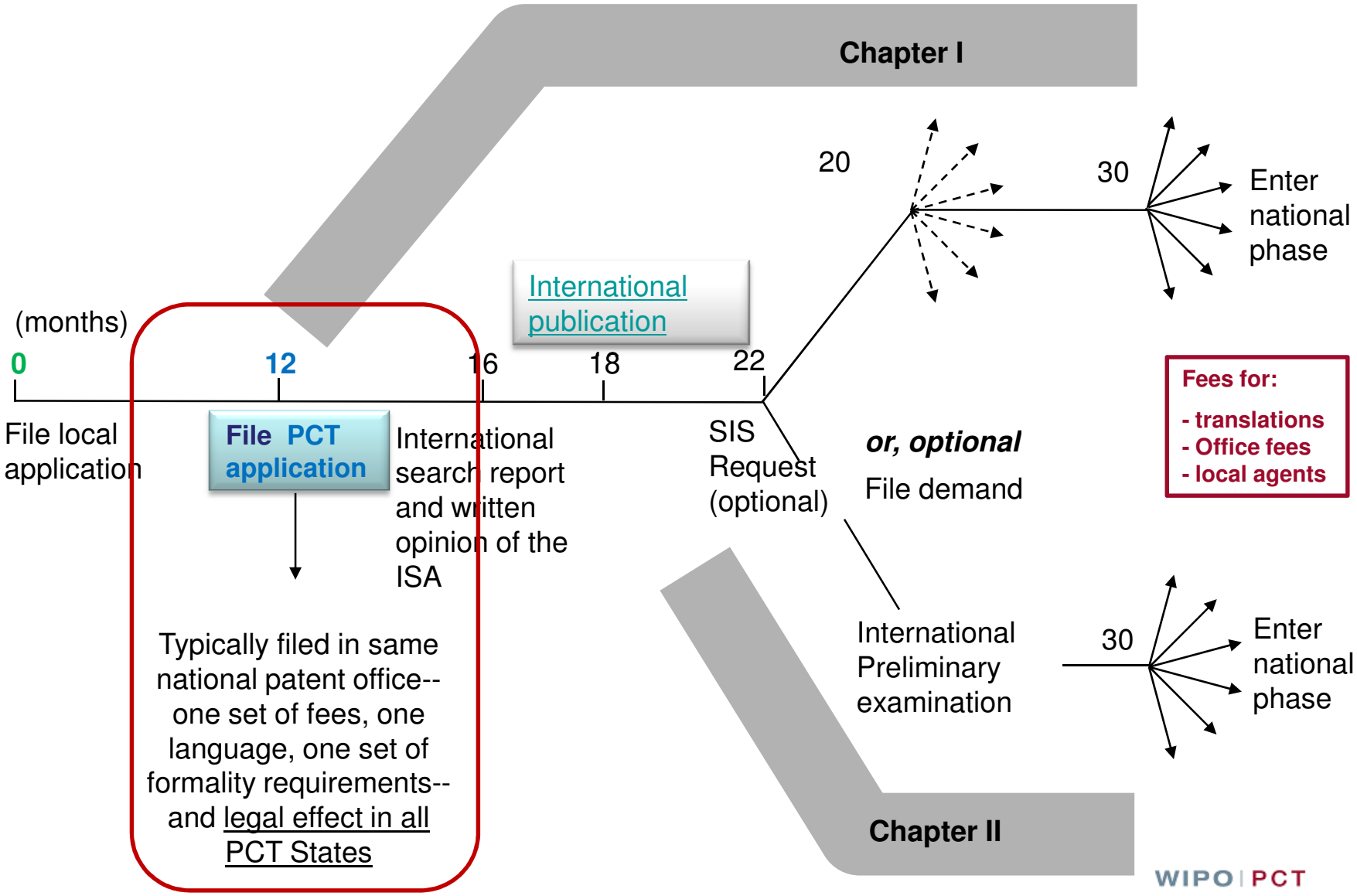
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The PCT system

- Local patent application followed within 12 months by one (single) international application under the PCT
  - containing, by default, the designation of all States
  - claiming Paris Convention priority
  - with “national phase” commencing at 30 months
- Has the effect of a regular national filing (including establishment of a priority date) in each designated State: the international filing date is the filing date in each designated State
  - one set of formality requirements
  - one international search
  - one international publication
  - one international preliminary examination
  - the international application can be put in order before national phase
  - translations and national fees required at 30 months, (if applicant wishes to further proceed)

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The PCT system



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General remarks on the PCT system (1)

- The PCT system is a patent "filing" system, not a patent "granting" system. There is no "PCT patent"
- The PCT system provides for
  - an international phase comprising:
    - filing of the international application
    - international search and written opinion of the ISA
    - international publication and
    - international preliminary examination
  - a national/regional phase before designated Offices
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase

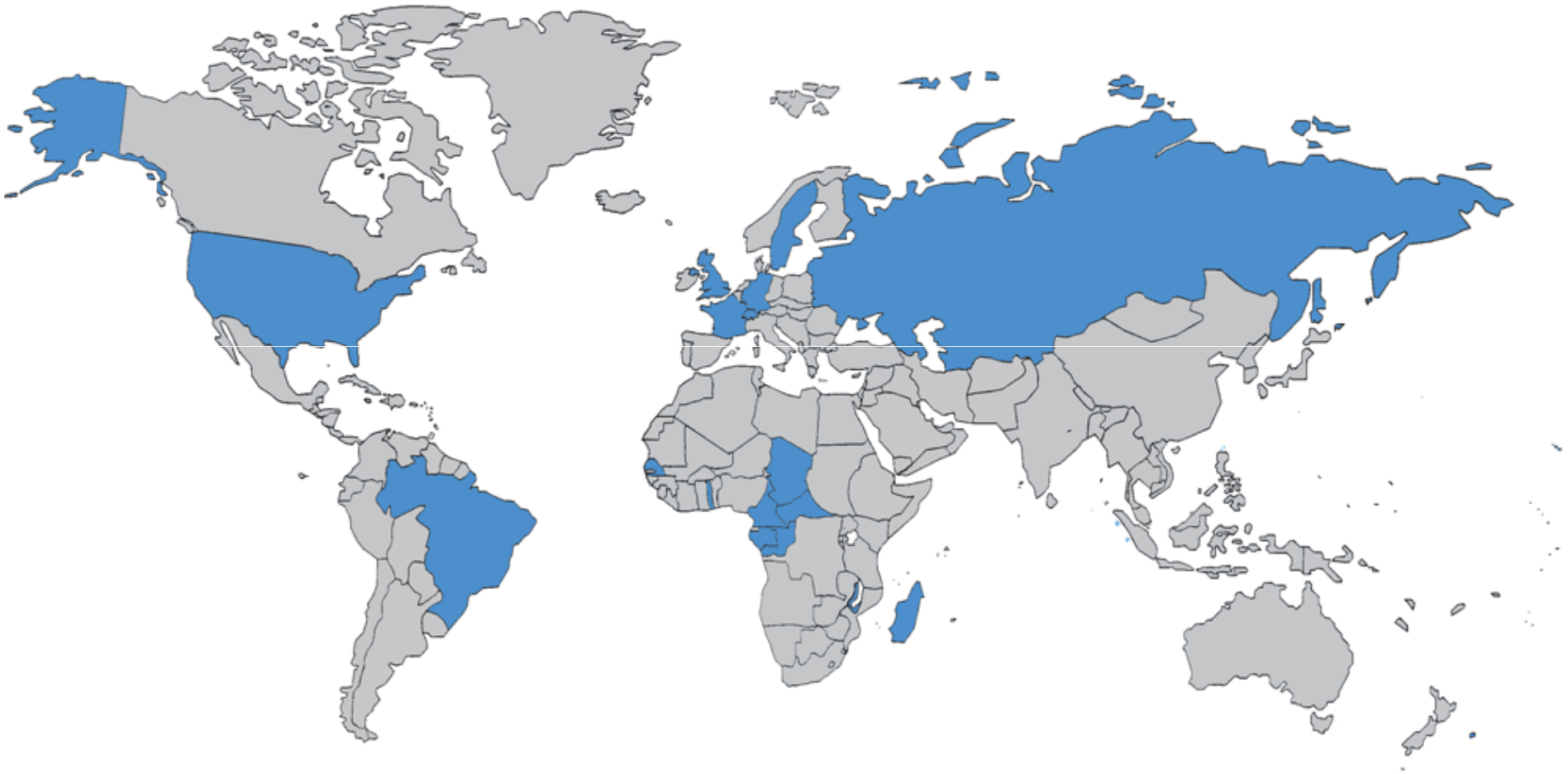
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General remarks on the PCT system (2)

- 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. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively). Appellations of origin are also dealt with by another international instrument, the Lisbon Agreement.
- The PCT is administered by WIPO as are other international treaties in the field of industrial property, such as the Paris Convention.

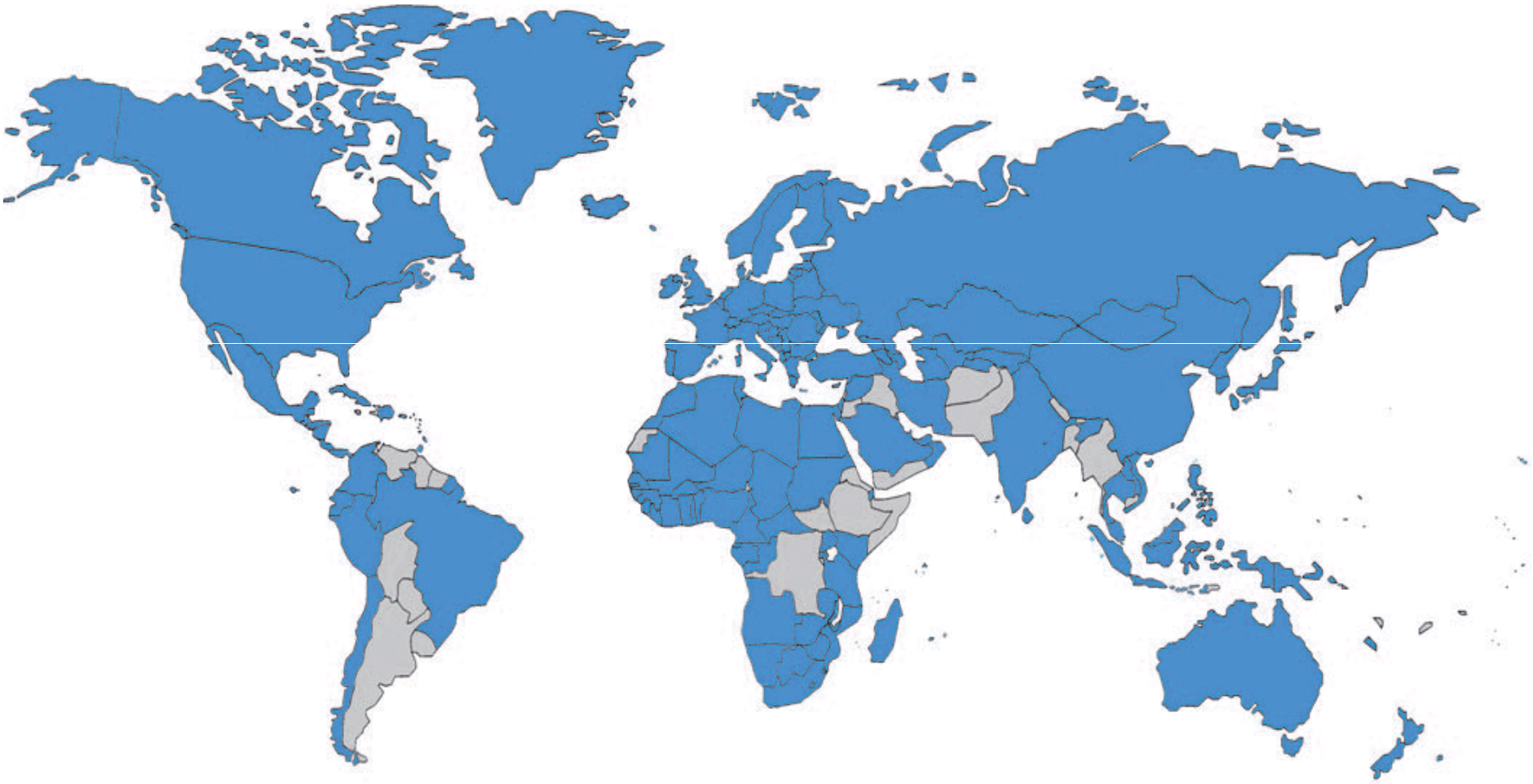
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PCT in 1978: 18 Contracting States



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PCT Coverage today
152 PCT Contracting States



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Patent System

PCT Contracting States (152)

States designated for regional protection and also, unless otherwise indicated, national protection

EA Eurasian Patent

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

EP European Patent

	AL	Albania[1]
	AT	Austria
*	BE	Belgium
	BG	Bulgaria
	CH	Switzerland
*	CY	Cyprus
	CZ	Czech Republic
	DE	Germany
	DK	Denmark
	EE	Estonia
	ES	Spain
	FI	Finland
*	FR	France
	GB	United Kingdom
*	GR	Greece
	HR	Croatia[1]
	HU	Hungary
*	IE	Ireland
	IS	Iceland
*	IT	Italy
	LI	Liechtenstein
*	LT	Lithuania
	LU	Luxembourg
*	LV	Latvia
*	MC	Monaco
	MK	The former Yugoslav Republic of Macedonia[1]
*	MT	Malta
*	NL	Netherlands
	NO	Norway
	PL	Poland
	PT	Portugal
	RO	Romania
	RS	Serbia[1]
	SE	Sweden
*	SI	Slovenia
	SK	Slovakia
	SM	San Marino
	TR	Turkey

* Regional patent only

1 Extension agreement continues to apply to applications filed before 1 January 2008 (for HR), 1 January 2009 (for MK), 1 May 2010 (for AL) or 1 October 2010 (for RS)

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PCT Contracting States (152) (continued)

States designated for regional protection and also, unless otherwise indicated, national protection

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 and Principe
*	SZ	Swaziland
	TZ	United Republic of Tanzania
	UG	Uganda
	ZM	Zambia
	ZW	Zimbabwe

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

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PCT Contracting States (152) (continued)

States designated for national protection only except where otherwise indicated

	AE	United Arab Emirates
	AG	Antigua and Barbuda
	AO	Angola
	AU	Australia
*	BA	Bosnia and Herzegovina
	BB	Barbados
	BH	Bahrain
	BN	Brunei Darussalam
	BR	Brazil
	BZ	Belize
	CA	Canada
	CL	Chile
	CN	China
	CO	Colombia
	CR	Costa Rica
	CU	Cuba
	DJ	Djibouti
	DM	Dominica
	DO	Dominican Republic
	DZ	Algeria
	EC	Ecuador
	EG	Egypt
	GD	Grenada
	GE	Georgia
	GT	Guatemala
	HN	Honduras
	ID	Indonesia
	IL	Israel
	IN	India
	IR	Islamic Republic of Iran
	JO	***JORDAN (as from 9 June 2017)***
	JP	Japan
	KH	Cambodia
	KM	Union of the Comoros
	KN	Saint Kitts and Nevis
	KP	Democratic People's Republic of Korea
	KR	Republic of Korea
	KW	Kuwait
	LA	Lao People's Democratic Republic
	LC	Saint Lucia
	LK	Sri Lanka
	LY	Libya
**	MA	Morocco
**	MD	Republic of Moldova
*	ME	Montenegro
	MG	Madagascar
	MN	Mongolia
	MX	Mexico
	MY	Malaysia
	NG	Nigeria
	NI	Nicaragua
	NZ	New Zealand
	OM	Oman
	PA	Panama
	PE	Peru
	PG	Papua New Guinea
	PH	Philippines
	QA	Qatar
	SA	Saudi Arabia
	SC	Seychelles
	SG	Singapore
	ST	Sao Tome and Principe
	SV	El Salvador
	SY	Syrian Arab Republic
	TH	Thailand
	TN	Tunisia
	TT	Trinidad and Tobago
	UA	Ukraine
	US	United States of America
	UZ	Uzbekistan
	VC	Saint Vincent and the Grenadines
	VN	Viet Nam
	ZA	South Africa

* Extension of European patent possible

** Validation of European patent possible

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Countries not yet PCT Contracting States (41)

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

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Testimonial: PCT time advantage

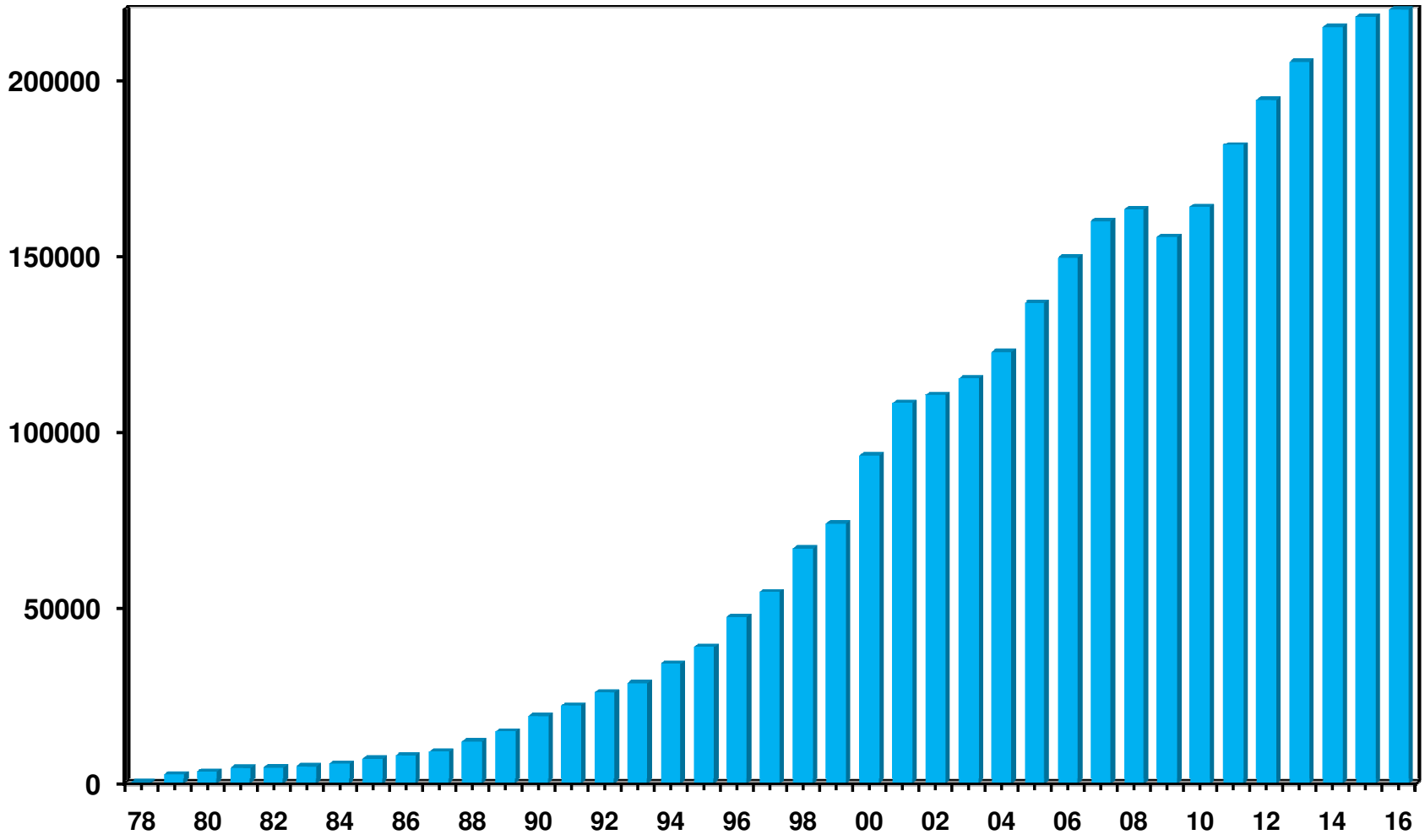
- Professor Shuji Nakamura—co-winner of the 2014 Nobel Prize for Physics for his work on blue LED technology—is quoted in a December 2014 *WIPO Magazine* article:



"… The PCT is critical for these early stage technologies because it gives us the opportunity to protect our patents globally while allowing the market and the technology to mature further before determining which countries might be most valuable to commercial partners."

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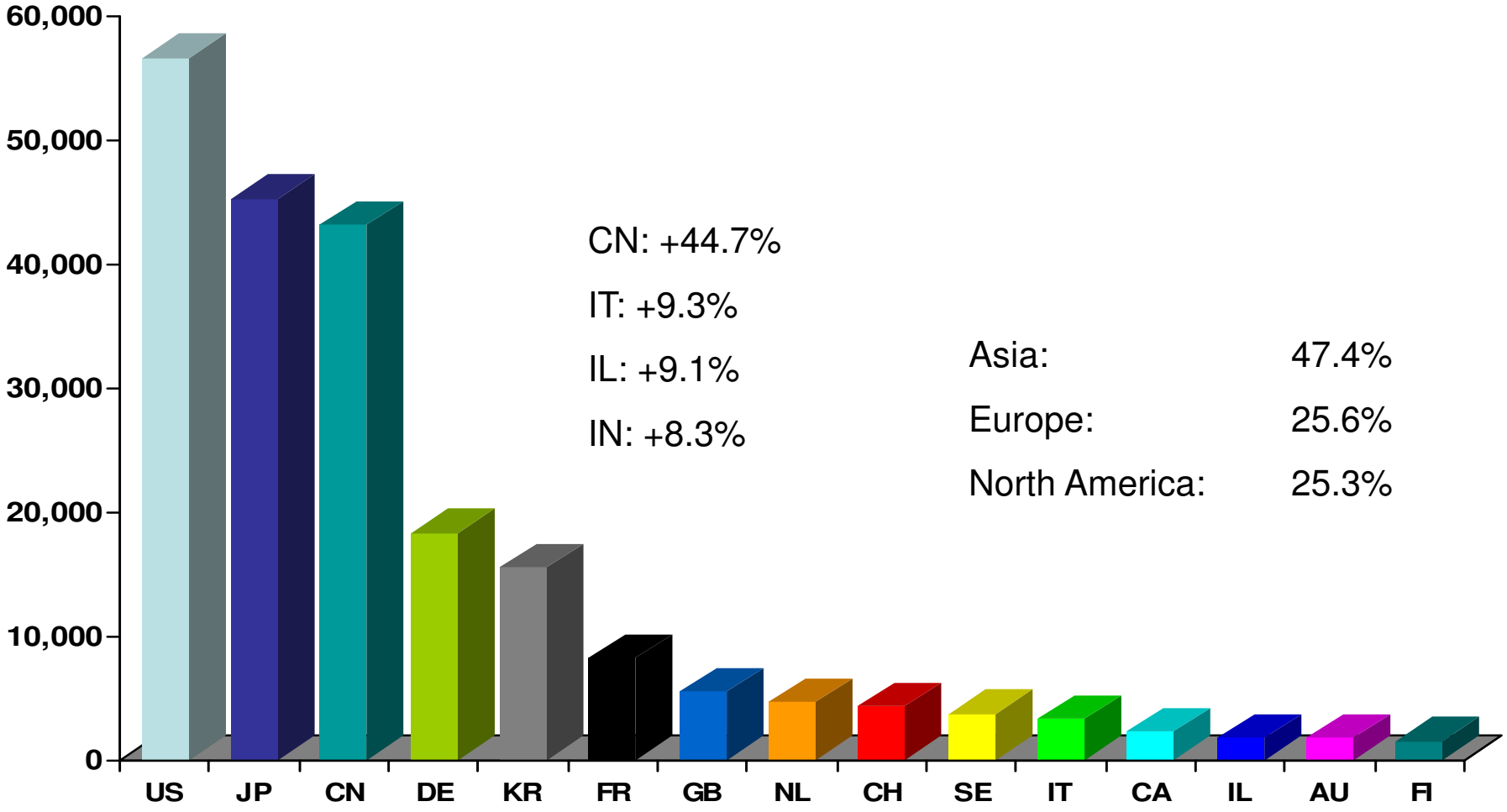
PCT Applications



2016: 233,000 **(+7.3%)**

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International applications received in 2016 by country of origin



CN: +44.7%

IT: +9.3%

IL: +9.1%

IN: +8.3%

Asia:	47.4%
Europe:	25.6%
North America:	25.3%

- 25+% originating in US
- 76% from top 5 countries; 92+% of filings from top 15 countries

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Top PCT Applicants 2016

() of published PCT applications

1. ZTE—CN (4,123)
2. Huawei Technologies—CN (3,692)
3. Qualcomm—US (2,466)
4. Mitsubishi Electric—JP (2,053)
5. LG Electronics—KR (1,888)
6. Hewlett-Packard—US (1,742)
7. Intel—US (1,692)
8. BOE Technology Group—CN (1,673)
9. Samsung—KR (1,672)
10. Sony—JP (1,665)
11. Ericsson—SE (1,608)
12. Microsoft—US (1,528)
13. Bosch—DE (1,274)
14. Sharp—JP (1,205)
15. Panasonic—JP (1,175)
16. Shenzhen China Star Optoelectronics—CN (1,163)
17. Siemens—DE (1,138)
18. Philips—NL (1,137)
19. Halliburton—US (1,097)
20. Olympus— JP (1,077)

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Top University PCT Applicants 2016

1. University of California (US)
2. MIT (US)
3. Harvard University (US)
4. Johns Hopkins (US)
5. University of Texas (US)
6. Seoul National University (KR)
7. University of Tokyo (JP)
8. Stanford University (US)
9. Hanyang University (KR)
10. University of Florida (US)
11. University of Pennsylvania (US)
12. University of Michigan (US)
13. Korea University (KR)
14. Shenzhen University (CN)
15. Korea Advanced Institute of Science and Technology (KR)
16. Tsinghua University (CN)
17. China University of Mining and Technology (CN)
18. CalTech (US)
19. King Abdullah University of Science and Technology (SA)
20. Kyoto University (JP)

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

PCT Testimonial





Qualcomm:

- Started in 1985 with 7 people
- Today more than 170 offices in more than 40 countries, and 33,000 employees
- $25.3 billion in revenue in FY 2015
- #3 user of PCT in 2016: 2,466 PCT applications published

Qualcomm CEO Paul Jacobs video from 2011 PCT 2 Million Event

PCT Testimonial

Nokero—which stands for "No Kerosene"—produces solar-powered lights which replace kerosene lamps and candles used in developing and least - developed countries. It has so far distributed over 1.4 million lights in 120 countries and is the only solar company to win the United States Patent and Trademark Office's Patents for Humanity Award.

"When it comes to patenting, because we operate in so many different markets, we use WIPO's Patent Cooperation Treaty (PCT). Every start-up has limited funds and the PCT is a great mechanism for delaying patent filing costs, allowing time to test the market and overcome any unforeseen technical problems. Without the PCT, protecting an invention in international markets would be a high-risk strategy with huge upfront costs."



Source: WIPO Magazine, February 2016

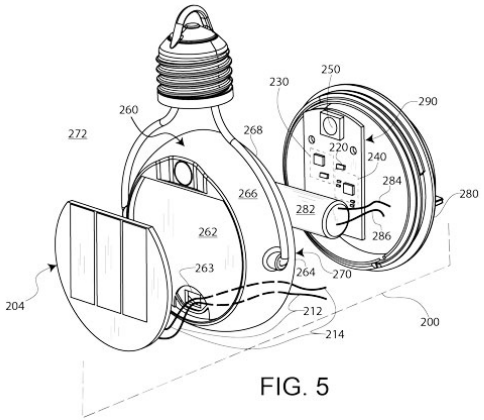


FIG. 5

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

- At least one applicant must be a national or resident of a PCT Contracting State
- The application must be in the prescribed language
- The application must contain at least:
  - an indication that it is intended as an international application
  - 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)

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What is not needed –at the time of filing –to get an international filing date?

- Payment of fees (△ Careful: ultimately is the fees are not paid, the application can be considered withdrawn)
- Applicant's signature
- Title of the invention
- Abstract
- Drawings, whether formal or not
  - however, attention should be given to the question whether the drawings are necessary for the understanding of the invention;
  - since later furnishing of drawings may result in a change in the international filing date (see Article 14(2) and Rule 20.5))
- Translation into language of search or publication

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Concept and operation of designation system (Rule 4.9)

- The PCT requires the designation of at least one Contracting State at the time of filing of the international application
  - all States bound by the PCT as of the international filing date are now automatically designated by the filing of the request form
    - exceptions to the all-inclusive designation possible for DE, JP and KR (countries with particular 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
  - otherwise withdrawals of designations possible
- Choice of types of protection postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- “Parent” information (continuation applications, patents of addition) may be included in PCT request form for search purposes

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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 (‘12) 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

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Naming inventors as applicants to file in RO/US

- Where the main applicant e.g. a legal entity, is neither a US national or US resident, some practitioners continue to name inventors who are US nationals and/or residents as
  - "applicant and inventor" and
  - an applicant for the purposes of the US designation
  - in this situation the RO/US is competent to accord an international filing date
- Some practitioners subsequently request the IB to record a change from "applicant and inventor" to "inventor only" under PCT Rule 92*bis*

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“Applicant of convenience”

- What can be done where the applicant, or if there are multiple applicants, none of the applicants
  - is a national or resident of a PCT Contracting State or
  - is not entitled to file with a receiving Office, e.g. RO/US, by reasons of nationality or residence
- Name an applicant on the request form who is entitled to file an international application or to use a particular receiving Office, e.g., the RO/US as
  - an “applicant only” and
  - a co-applicant only for the purposes of a PCT Contracting State of very low commercial importance to the main applicant
- It has been suggested that the main applicant execute a document that assigns a small portion of the rights to invention for that State to the co-applicant

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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 of residence
  - 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 (given) RO for reasons of residence or nationality (e.g. application filed with RO/US in the name of IL applicants) or
  - the application is filed in a language not accepted by the given (RO) for that purpose (e.g. IA filed in Spanish with RO/US)

  that Office will transmit the international application to the Receiving Office of the International Bureau (RO/IB) (Rule 19.4) for further processing upon payment of a fee equal to the transmittal fee.

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Choice of RO, language of filing and ISA, (US applicant(s)) (1/3)

Receiving Offices	RO/US (USPTO)	RO/IB* (WIPO)
Filing language(s)	English	Any language
ISA(s)	US, AU, EP, IL**, JP, KR, RU, SG	US, AU, EP IL, JP, KR, RU, SG

* *Possible national security restrictions*

** *Subject to restrictions* see www.uspto.gov/patents/law/notices/ilpo_isa-ipea.pdf

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Choice of RO, language of filing and ISA (2/3) (US applicant + MX applicant)

Receiving Offices	Filing language(s)	ISA(s)
RO/US	English	US, AU, EP, IL**, JP, KR, RU, SG
RO/MX*	Spanish	EP, SG, CL, ES, KR, SE, US
RO/IB*	Any language	US, AU, EP, IL ES, CL, JP, KR RU, SE, SG

* *Possible national security restrictions*

** *Subject to restrictions* see www.uspto.gov/patents/law/notices/ilpo_isa-ipea.pdf

WIPO | PCT
The International Patent System

Choice of RO, language of filing and ISA (3/3) (3 applicants US, CA and JP)

Receiving Offices	Filing language(s)	ISA(s)
RO/US	English	US, AU, EP, IL**, JP, KR, RU, SG
RO/CA*	English, French	CA
RO/JP*	Japanese, English	JP, EP, SG
RO/IB*	Any language	US, AU, CA, EP, IL, JP, KR, SG, RU

* *Possible national security restrictions*

** *Subject to restrictions* see www.uspto.gov/patents/law/notices/ilpo_isa-ipea.pdf

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Amendments to the PCT Regulations as from 1 July 2017

PCT Rule Changes (1)

- Amendment to PCT Rule 45*bis.1*
  - Extension of the deadline for requesting supplementary international search from 19 to 22 months from the priority date
  - Effective for international applications in respect of which the 19-month time limit for filing a supplementary search request has not yet expired on July 1, 2017

PCT Rule Changes (2)

- Amendment to PCT Rules 12*bis*, 23*bis* and 41
  - Transmittal of earlier search and/or classification results by ROs to ISAs
    - General Rule: ROs forward the search/classification results from priority applications without the applicant's express permission
    - Exception:
      - ROs which have notified the IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law are not required to do so
      - Even in cases in which an RO in principle applies the procedure above, they may allow applicants to request, at the time of filing of the PCT application, to not have the earlier search results forwarded to the ISA, if the RO notified the IB accordingly (before April 14, 2016)
  - Effective as from 1 July 2017 for applications filed on or after that date

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PCT Rule Changes (3)

- Amendment to PCT Rules 86 and 95
  - Obligation for designated Offices to timely send national phase entry and related data to the IB (complements the existing national phase data already provided by a number of offices)
  - Data required to be transmitted:
    - Date national phase entered
    - National application number
    - Number and date of national publication
    - Date of grant, and number and date of national publication as granted
  - Time limit for reporting: 2 months from event (or as soon as reasonably possible thereafter)
  - Objective: visibility of the status of PCT application during the national phase on PATENTSCOPE under the “National phase” tab
  - Effective as from 1 July 2017 for applications in respect of which the acts referred to in Article 22 or Article 39 are performed on or after that date

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Picking a Receiving Office

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 (seven, eight, or nine…) hours earlier

Filing Fee Reductions for E-Filing

- RO/US:
  - $102 – e-filed (EFS-Web) but the Request is not a zip file
  - $205 – 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:
  - $205 – e-filed (PCT-SAFE FM or ePCT) but the application is not XML
  - $307 – 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: $102

Alexandria or Geneva ?

- Restoration of the Right of Priority
  - RO/US: unintentional criterion only
  - RO/IB: unintentional criterion or in spite of due care (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, SG, 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
  - Share of PCT applications transmitted to the IB within 4 weeks of receipt in 2015:
    - RO/US: 91.5%
    - RO/IB: 89.3%
- Time Difference
  - RO/US: Eastern time zone
  - RO/IB: Central European time zone (generally six - nine hours earlier)


UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

Filing an International Application under the PCT

Michael Neas
Deputy Director
International Patent Legal Administration

UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

Parts of an International Application

- A Request
  - Form PCT/RO/101 or
  - Computer-generated Request
    - PCT-SAFE Request
    - ePCT Request
- A description of the invention
- One or more claims
- One or more drawings, where necessary, to illustrate the invention; and
- An abstract

Article 11(1) Requirements for According an International Filing Date (1)

- Right to file with receiving Office (RO)
  - based on residence or nationality (Rules 18 and 19)
  - application transmitted to IB as RO under Rule 19.4(a)
    - if at least one applicant is a resident or national of a PCT Contracting State
      - but not of the national or regional Office where filed
- Application is in a language prescribed by the RO (Rule 12.1)
  - application transmitted to IB as RO under Rule 19.4(b)
    - if not in a language prescribed by the national or regional Office where filed

Article 11(1) Requirements for According an International Filing Date (2)

- Application must contain the following elements
  - an indication that it is intended as an international application filed under the PCT (Rule 4.2)
  - a designation of at least one Contracting State
  - name of the applicant (Rule 4.5)
  - a description (Rule 5)
  - one or more claims (Rule 6)

Article 11(1) Defects

- The RO will invite the applicant to file required corrections within a prescribed time limit
- If applicant
  - complies with the invitation within the prescribed time limit
    - the RO will accord the date corrections received as the IFD
      - for missing description or claims, incorporation by reference may be available to maintain original date of submission as the IFD
  - does not comply within the prescribed time limit or if the correction does not fulfill the requirements
    - the RO will notify applicant that the application is not and will not be treated as an international application
- See Article 11 and Rules 20.3 and 20.7

Not Required for an International Filing Date

- Payment of fees
- Applicant's signature
- Title of the invention
- Abstract
- Formal drawings

Correction of Formality Defects

- The RO reviews the IA for compliance with Rule 11
  - only to the extent necessary for "reasonably uniform publication"
- The RO will invite correction of a listing of defects and set a prescribed time period for correction of
  - crudely executed drawings, e.g., drawn by hand, lines not uniformly thick
  - missing or incomplete payment of fees
  - improper signature, *e.g.,* improper S-signature
  - incorrect margins
  - use of incorrect size paper, etc.
- Correction of these defects does not affect the IFD
- New and/or changed sheets are to be presented **without** a label, such as "Substitute" or "Replacement"
- See Article 14 and Rule 26

Filing International Applications in the RO/US

- Patent attorneys or agents
  - registered to practice before the USPTO
  - may represent applicants, who are residents/nationals of the United States, in international applications
- All international applications filed in RO/US
  - are screened for compliance with U.S. national security provisions
    - before forwarding the record copy (or IA under Rule 19.4) to the IB
- RO/US does not accept international applications filed by facsimile

Conventional Request Form - PCT/RO/101

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference *(if desired) (12 characters maximum)* CHOCO 95549

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: *(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.)*

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 *(that is, country)* of nationality: US

State *(that is, country)* of residence: US

This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

☒ Further applicants and/or (further) inventors are indicated on a continuation sheet.

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: ☒ agent ☐ common representative

Name and address: *(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)*

DAVIS, Catherine
2500 Virginia Avenue, N.W.
Washington, D.C. 20037-1902
United States of America

Telephone No. (+1-301) 557-3054

Facsimile No. (+1-301) 557-3060

Agent's registration No. with the Office 44,111

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: davispatents@anumma.com

☐ **Address for correspondence:** Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.

Form PCT/RO/101 (first sheet) (16 September 2012) *See Notes to the request form*

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: *(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.)*

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 *(that is, country)* of nationality: US

State *(that is, country)* of residence: US

This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

☒ Further applicants and/or (further) inventors are indicated on a continuation sheet.

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE

uspto

Request Form Prepared with PCT-SAFE Software

- The PCT-SAFE software
  - available at http://www.wipo.int/pct-safe/en/download/download_client.html
  - creates the Request in a validated electronic form
  - contains software for electronic filing of IAs in certain ROs
- Request prepared using PCT-SAFE
  - contains the same information as the PCT/RO/101
    - But in character coded format (XML)

uspto

PCT SAFE Request

CHOCO95549

PCT REQUEST

1/4

Original (for **SUBMISSION**)

0	**For receiving Office use only**	
0-1	International Application No.	
0-2	International Filing Date	
0-3	Name of receiving Office and "PCT International Application"	
0-4	**Form PCT/RO/101 PCT Request**	
0-4-1	Prepared Using	PCT-SAFE [EASY mode] Version 3.51.056.232 MT/FOP 20121001/0.20.5.19
0-5	**Petition** The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
0-6	**Receiving Office (specified by the applicant)**	United States Patent and Trademark Office (USPTO) (RO/US)
0-7	**Applicant's or agent's file reference**	CHOCO95549
I	**Title of Invention**	PROCESS FOR FOLDING WRAPPING PAPER FOR CHOCOLATES
II	**Applicant**	
II-1	This person is	Applicant only
II-2	Applicant for	All designated States
II-4	Name	CANDY WRAP UNLIMITED, INC.
II-5	Address	300 Colorado Street Baltimore, Maryland 21201-4307 United States of America
II-6	State of nationality	US
II-7	State of residence	US
II-8	Telephone No.	301-876-5432
II-9	Facsimile No.	301-876-5555
II-10	e-mail	candy@anumma.com
II-10(a)	E-mail authorization The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:	exclusively in electronic form (no paper notifications will be sent)

CHOCO95549

PCT REQUEST

2/4

Original (for **SUBMISSION**)

III-1	**Applicant and/or inventor**	
III-1-1	This person is	Inventor only
III-1-4	Name (LAST, First)	JONES, Mary
III-1-5	Address	1600 South Eads Street Arlington, Virginia 22202-2913 United States of America
IV-1	**Agent or common representative; or address for correspondence** The person identified below is hereby/ has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	Agent
IV-1-1	Name (LAST, First)	DAVIS, Catherine
IV-1-2	Address	2500 Virginia Avenue, N.W. Washington, District of Columbia 20037-1902 United States of America
IV-1-3	Telephone No.	301-557-3054
IV-1-4	Facsimile No.	301-557-3060
IV-1-5	e-mail	davispatents@anumma.com
IV-1-5(a)	E-mail authorization The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:	exclusively in electronic form (no paper notifications will be sent)
IV-1-6	Agent's registration No.	44,111

Request Form Prepared with ePCT

- As of 01 June 2016, U.S. applicants are able to use WIPO's ePCT to create the Request in validated electronic form
  - Contains the same information as the PCT/RO/101
    - In character-coded format (XML)
  - Caveat
    - A foreign filing license does not authorize the export of subject matter into ePCT (*i.e.* the title and, optionally, the abstract) when the international application is to be filed with the RO/US
    - See the Federal Register Notice for the full details https://www.gpo.gov/fdsys/pkg/FR-2016-05-06/pdf/2016-10733.pdf

ePCT Request

USFILING1

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PCT REQUEST

Print Out (Original in Electronic Form)

0	**For receiving Office use only**	
0-1	International Application No.	
0-2	International Filing Date	
0-3	Name of receiving Office and "PCT International Application"	
0-4	**Form PCT/RO/101 PCT Request**	
0-4-1	Prepared Using	ePCT-Filing for EFS-Web Version 2.11.000
0-5	**Petition** The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty	
0-6	**Receiving Office (specified by the applicant)**	United States Patent and Trademark Office (USPTO) (RO/US)
0-7	**Applicant's or agent's file reference**	USFILING1
I	**Title of Invention**	TITLE1
II	**Applicant**	
II-1	This person is	Applicant only
II-2	Applicant for	All designated States
II-4	Name	DEMO COMPANY
II-5	Address	Creation Avenue NW 444 New York, New York 10598 United States of America
II-6	State of nationality	US
II-7	State of residence	US
II-8	Telephone No.	+122255555
II-9	Facsimile No.	+144878896
II-10	e-mail	demo.comp@domain.com

USFILING1

2/5

PCT REQUEST

Print Out (Original in Electronic Form)

III-1	**Applicant and/or inventor**	
III-1-1	This person is	Applicant and inventor
III-1-2	Applicant for	All designated States
III-1-4	Name (LAST, First)	BANNER, Bruce
III-1-5	Address	452, Green Boulevard Dayton, Ohio OH10KD United States of America
III-1-6	State of nationality	US
III-1-7	State of residence	US
III-1-10	e-mail	hulk@comics.com
III-1-10(a)	E-mail authorization The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:	as advance copies followed by paper notifications
IV-1	**Agent or common representative; or address for correspondence** The person identified below is hereby/ has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	Agent
IV-1-1	Name (LAST, First)	DEVIL, Freddy
IV-1-2	Address	225 West Drive Memphis, Tennessee 52456 United States of America
IV-1-3	Telephone No.	000111222333
IV-1-4	Facsimile No.	000111222555
IV-1-5	e-mail	devil@freddy.com
IV-1-5(a)	E-mail authorization The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:	as advance copies followed by paper notifications

Request Form Prepared with PCT-SAFE or ePCT

- When filing the international application electronically via EFS-Web
  - the .ZIP file created using PCT-SAFE or ePCT is to be attached
    - EFS-Web will extract the Request and Fee sheet from the .ZIP file
    - PDF of the abstract must be separately uploaded since the EFS-Web does not extract the abstract from the .ZIP file

Applicant

- The applicant can be
  - a legal entity such as the assignee
    - no requirement to file an assignment during the international stage
  - a person other than the inventor
  - the inventor

Applicant for US

- For international applications with a filing date on/after 16 Sep 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**"

Applicant – Legal Entity

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference *(if desired) (12 characters maximum)* CHOCO 95549

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: *(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.)*

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:

State *(that is, country)* of nationality: US

State *(that is, country)* of residence: US

This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box

Inventor

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)

If none of the following sub-boxes is used, this sheet should not be included in the request.

Name and address: *(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.)*

JONES, Mary
1600 South Eads Street
Arlington, Virginia 22202-2913
United States of America

This person is:

- ☐ applicant only
- ☐ applicant and inventor
- ☒ inventor only *(If this check-box is marked, do not fill in below.)*

Applicant's registration No. with the Office

State *(that is, country)* of nationality:

State *(that is, country)* of residence:

This person is applicant for the purposes of: ☐ all designated States ☐ the States indicated in the Supplemental Box

Important Practice Tip

- 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 an international application under the PCT

Signing the Request Form

- Each applicant must sign the Request (Rule 4.15)
- The agent named in Box No. IV can sign the Request
  - applicant can sign a power of attorney (POA) appointing that agent
  - generally an invitation for POA not issued
    - USPTO has waived the requirement (see next slide)
- RO/US will not issue an invitation to correct defects where
  - one applicant signs the Request
    - where there are two or more applicants, the signature of one applicant on the Request is sufficient for Article 14(1)(a)
- A designated Office may require
  - an applicant signature not provided during the international stage (Rule 51*bis*.1(a)(vi))

USPTO Waiver of Requirement

- As RO, ISA, and IPEA
  - USPTO has waived the requirement
    - to submit either a separate power of attorney and/or a copy of a general power of attorney
  - a power of attorney or copy of a general power of attorney
    - is required where it is unclear whether a purported agent
      - has the power to act on behalf of the applicant, for withdrawals, and for certain changes under Rule 92*bis*

Signatures

- S-signatures are acceptable
  - in international applications (IAs) or related papers filed with the USPTO
  - 37 CFR 1.4(d)(2)
  - can be inserted in the PCT-SAFE Request
    - See instructions on the WIPO Web site:

      http://www.wipo.int/export/sites/www/pct-safe/en/support/guides/pdf/us_e_easy_v7.pdf
    - See the "Practical Advice" in *PCT Newsletter* (No. 12/2006, page 8) for clarification of S-signature requirements for an agent
    - Also see "Filing and Processing of International Applications in Electronic Form" in the *PCT Newsletter* (No. 08/2007)

Priority Claims

- The conditions for and the effect of any priority claim are
  - governed by Article 4 of the Paris Convention
- The priority claim
  - is made in the PCT Request
    - can be corrected or added under Rule 26*bis*

Box No. VI of the Request

Box No. VI PRIORITY CLAIM AND DOCUMENT

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 October 2011 (26.10.2011)	61/274,654	US		
item (2) 13 December 2011 (13.12.2011)	11187654.4		FP	
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

Furnishing the priority document(s):

☒ 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(s) was filed with the receiving 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

☐ The **International Bureau** is requested to obtain from a digital library a certified copy of the earlier application(s) identified above, using, where applicable, the access code(s) indicated below *(if the earlier application(s) is available to it from a digital library)*:

☐ item (1) access code _____ ☐ item (2) access code _____ ☐ item (3) access code _____ ☐ other, see Supplemental Box

Certified Copy of Earlier Application

- The U.S. Receiving Office may be requested
  - to prepare and transmit a certified copy when the earlier application
    - was filed with the USPTO
    - preferred method for transmitting U.S. priority documents to the IB
- The International Bureau may be requested
  - to obtain a certified copy when the earlier application
    - was filed with an Office that participates as a WIPO Digital Access Service (DAS) depositing Office
    - has been made available to the International Bureau
      - via access permission, publication, or patenting
      - the Access Code has been indicated
    - real-time look-up in WIPO DAS to
      - check availability of the priority document in WIPO DAS
      - determine if the IB has been given access rights

uspto

Continuation or CIP

- If the international application is to be treated as a continuation or continuation-in-part of an earlier filed U.S. application
  - the earlier application number, filing date and relationship must be provided in
    - Supplemental box of the conventional Request (form PCT/RO/101), or
    - Designations section of the PCT-SAFE or ePCT Request
  - see following slides (*i.e.*, 54-56) for examples

Supplemental box of conventional Request (form PCT/RO/101)

Supplemental Box *If the Supplemental Box is not used, this sheet should not be included in the request.*

1. *If, in any of the Boxes, except Boxes Nos. VIII(i) to (v) for which a special continuation box is provided, **the space is insufficient** to furnish all the information: in such case, write "Continuation of Box No...." (indicate the number of the Box) and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient, in particular:*

   (i) *if **more than one person is to be indicated as applicant and/or inventor** and no "continuation sheet" is available: in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III. 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;*

   (ii) *if, in Box No. II or in any of the sub-boxes of Box No. III, the indication **"the States indicated in the Supplemental Box"** is checked: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is applicant;*

   (iii) *if, in Box No. II or in any of the sub-boxes of Box No. III, **the inventor or the inventor/applicant is not inventor for the purposes of all designated States**: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the inventor(s) and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is inventor;*

   (iv) *if, in addition to the agent(s) indicated in Box No. IV, there are **further agents**: in such case, write "Continuation of Box No. IV" and indicate for each further agent the same type of information as required in Box No. IV;*

   (v) *if, in Box No. VI, there are **more than three earlier applications whose priority is claimed**: in such case, write "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI.*

2. *If the applicant intends to make an indication of the wish that the international application be treated, in certain designated States, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition: in such case, write the name or two-letter code of each designated State concerned and the indication "**patent of addition**," "**certificate of addition**," "**inventor's certificate of addition**" or "**utility certificate of addition**," the number of the parent application or parent patent or other parent grant and the date of grant of the parent patent or other parent grant or the date of filing of the parent application (Rules 4.11(a)(i) and 49bis.1(d)).*

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 or continuation-in-part of an earlier application: 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)(ii) and 49bis.1(d)).*

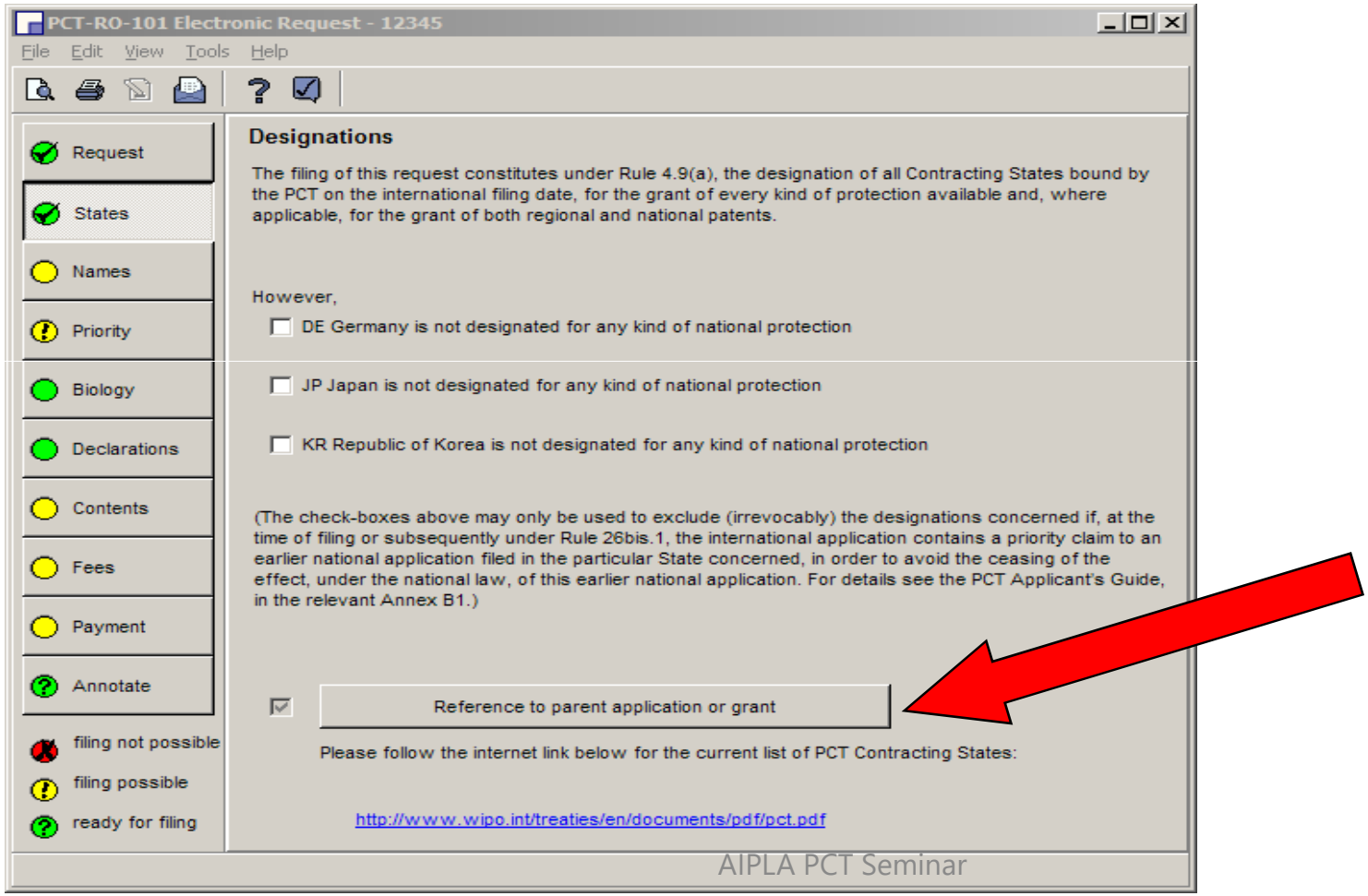
US, continuation-in-part
13/999,888 04 November 2010 (04.11.2010)

Form PCT/RO/101 (supplemental sheet) (16 September 2012) *See Notes to the request form*

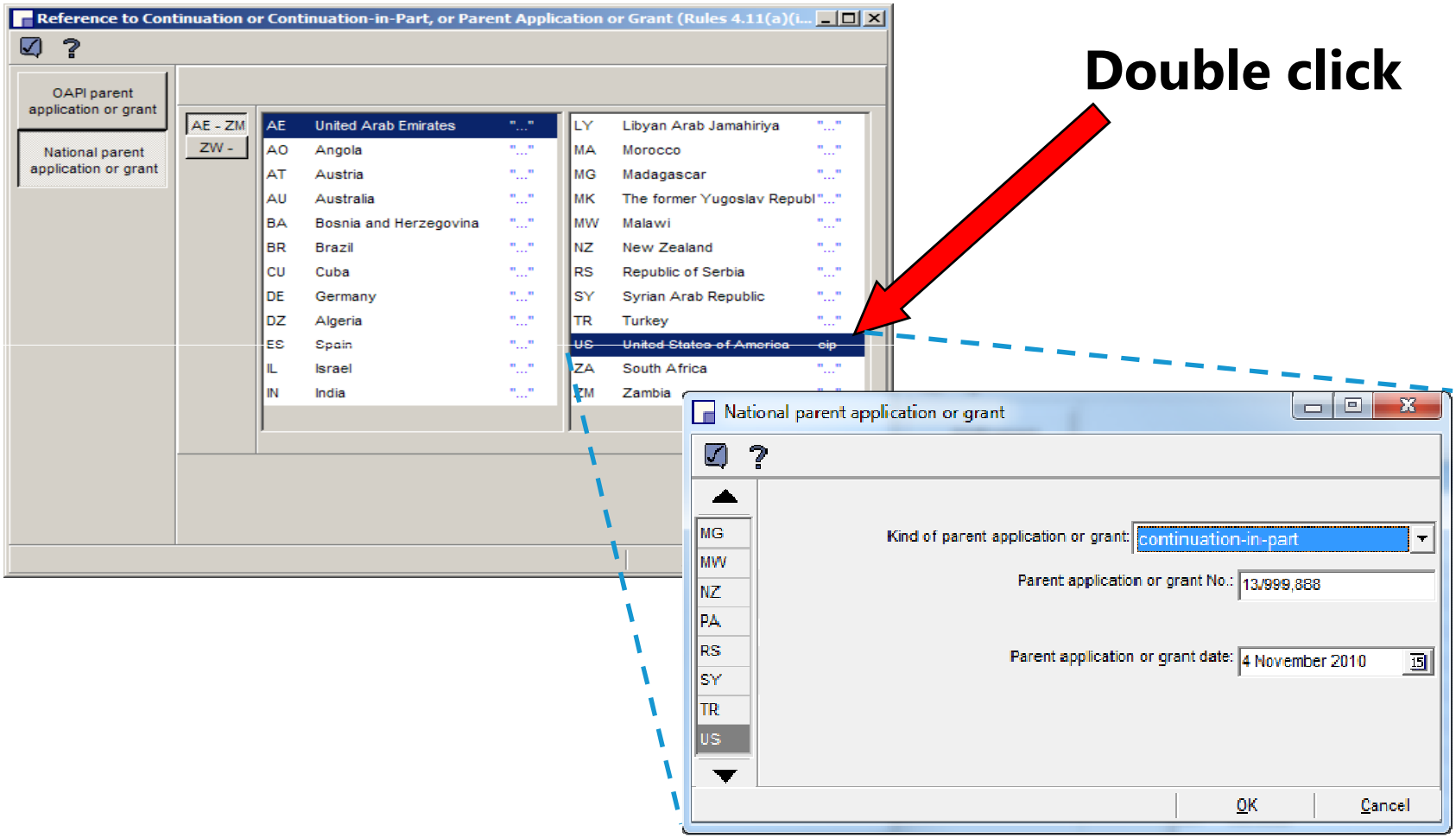
3. *If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation or continuation-in-part of an earlier application: in such case, write "United States of America" or "US" and the indication "**continuation**" or "**continuation-in-part**" and the number and the filing date of the parent application (Rules 4.11(a)(ii) and 49bis.1(d)).*

US, continuation-in-part
13/999,888 04 November 2010 (04.11.2010)

Designations Section of PCT Safe Request (1)



Designations Section of PCT Safe Request (2)



Optional Declarations

- Applicant may, for the purposes of the national law in one or more designated States
  - provide under Rules 4.1(c)(iii) and 4.17 as part of the Request form any of the following declarations
    - as to the identity of the inventor
    - as to the applicant's entitlement, as at the IFD, to apply for and be granted a patent
    - as to applicant's entitlement, as at the IFD, to claim priority of an earlier application
    - of inventorship
    - as to non-prejudicial disclosures or exceptions to lack of novelty

Fees

Chapter I Fees

- Transmittal fee
- Search fee
- International filing fees
- http://www.uspto.gov/patents-getting-started/international-protection/patent-cooperation-treaty/pct-fees-us-dollars

Transmittal Fee

- The fee for processing the international application by the U.S. Receiving Office
  - Basic portion - $240
    - reducible by 50% for small entity
    - reducible by 75% for micro entity
  - Electronic filing incentive fee portion - $400
    - for international applications filed other than by EFS-Web
    - reducible to $200 for small entity / micro entity

Search Fee

- Fee for preparation by the International Searching Authority (ISA) of the
  - International search report & written opinion of ISA
    - ISA/US - $ 2080
      - reducible by 50% for small entity and 75% for micro entity
    - ISA/EP - $ 1992
    - ISA/KR - $ 1114
    - ISA/AU - $ 1688
    - ISA/RU - $ 482
    - ISA/IL - $ 963
    - ISA/JP - $1372
    - ISA/SG - $1552

International Filing Fee

- Fee for the International Bureau to
  - publish the international application
  - send copies to the designated Offices
    - $1367 for the first 30 sheets of the IA
    - $15 per sheet for each sheet over 30

Reduction of International Filing Fee – International Application Filed Electronically

- $103 Reduction applies where
  - the international application is filed electronically via EFS-Web without the PCT-SAFE or ePCT .ZIP file
    - be sure to attach the .PDF version of the Request (form PCT/RO/101)
- $206 Reduction applies where
  - the international application is filed electronically via EFS-Web with the PCT-SAFE or ePCT .ZIP file attached
    - be sure to attach the .PDF version of the abstract

Sequence Listing
Part of the Description (1)

- For international applications filed in **PAPER**
  - the sequence listing part of the description **must** be **filed on paper**
    - standard fee applies to the total number of sheets
    - a text file sequence listing must be filed
      - for search purposes
      - along with a statement indicating the paper and text copies are identical

Sequence Listing
Part of the Description (2)

- For international applications filed electronically via EFS-Web,
  - the sequence listing part of the description
    - (Preferred) is filed only in text format (.txt) in compliance with Annex C/ST.25
      - no fee is charged for the text format
      - the text format is also used for search purposes
    - (Alternative) is filed in PDF format (.pdf)
      - standard fee applies to the total number of sheets
      - a text format sequence listing must be filed
        - » for search purposes
        - » along with a statement pursuant to Rule 13ter

Time Limit for Fee Payment

- Fees should be paid upon filing
- May be paid within 1 month
  - from the date of receipt of the IA by the RO
    - transmittal, search, international filing fee
- If any portion of the fees are not timely paid
  - an invitation to pay the required fees together with a late payment fee is mailed
    - Rule 16*bis*

Late Payment Fee

- 50% of the fees due
  - but not less than the transmittal fee and
  - not greater than 50% of the international filing fee
    - not taking into account any fee for sheets in excess of 30
- **Not** assessed if fees paid in full before mailing of the invitation - Form PCT/RO/133
- Due (along with remaining unpaid fee balance) within **ONE month** from the date of mailing of the invitation
  - failure to timely pay fees results in **withdrawal** of the IA
- Notification of the withdrawal - Form PCT/RO/117
  - IA **not** withdrawn if fees are paid in full before the mailing of the notification

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
uspto


UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

Practitioner comments on the PCT filing process

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

Small Entity?

You can knock down your RO/US transmittal fee from $240 to $120

You can knock down your ISA/US search fee from $2080 to $1040

You can knock down your IPEA/US exam fee from $600/760 to $300/380

Asserting small entity status?

We are by now very accustomed to not having to expressly assert small entity status

We are used to the idea that merely paying the small entity fee counts as asserting small entity status

Not every small-entity fee accomplishes this

- Fee for USPTO transmitting an IA to RO/IB does not accomplish this
- ISA/US search fee (when filing in RO/US) does not accomplish this
- ISA/US search fee for 2nd through nth inventions does not accomplish this
- Penalty for paper filing does not accomplish this
- IPEA/US exam fees do not accomplish this

Micro entity?

Through strenuous effort you could knock down your RO/US transmittal fee from $120 (small entity) to $60 (micro entity)

It is also possible to knock down your ISA/US search fee from $1040 (small entity) to $520 (micro entity)

You can also knock down your IPEA/US exam fee from $300/380 (small entity) to $150/190 (micro entity)

Micro Entity?

If you don't pick US as your ISA or IPEA, it may not be worth the $60 savings (transmittal fee) to go to the trouble of certifying micro entity status

WIPO | PCT
The International Patent System

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

Matthias Reischle-Park

WIPO – AIPLA 21st Annual PCT Seminar, July 2017

Signature of the international application (request) (1) (Rules 4.15, 26.2*bis*(a))

- In principle, the request must be signed by all persons (legal entity or natural persons) indicated as "applicant" or "applicant and inventor"
  - a person named on the request as "inventor only" does not need to sign the request
  - if only one of the applicants signs, 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 the applicant(s) should be filed (either original individual power or copy of general power, no "domestic" power), unless waiver applies
- Any notice of withdrawal would have to be signed by or on behalf of all applicants (including "applicant and inventors")

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Waiver of requirement that a power of attorney be furnished (Rules 90.4(d) and 90.5(c))

- RO, ISA, IPEA and IB may waive the requirement that:
  - a separate power of attorney; and/or
- RO, ISA and IPEA may waive the requirement that
  - a copy of a general power of attorney has to be furnished
- Any Office or Authority that has waived the requirement in general may nevertheless require that a power of attorney be furnished in particular instances
- Information as to whether an Office or Authority has made such a waiver, is available on WIPO's website at www.wipo.int/pct/en/texts/pdf/p_a_waivers.pdf

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The International Patent System

Signature on behalf of legal entities

- In general, the signature by a person not named as applicant (FOR---ON BEHALF OF---AS AUTHORIZED SIGNATORY OF) depends on national law applied by receiving Office
- The RO/US accepts signature of an authorized officer of a legal entity, for example, President, Vice-President, Secretary, Treasurer, Chief Executive Officer, 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 applicant
  - See MPEP Section 1820 for additional information
- A legal representative may sign the request
  - if the applicant is a natural person who is incapacitated
  - if the applicant is a bankrupt company

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The International Patent System

Agents and Common Representatives

- Who can act as agent? (Rule 90.1)
  - 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, the ISA and the IPEA (Article 49);
  - 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 that ISA or IPEA (Rule 90.1(b) and (c));
  - sub-agents may be appointed by agents (Rule 90.1(d))
- Who can act as common representative? (Rule 90.2(a))
  - one of the applicants, who is entitled to file an international application (i.e., who is a resident or national of a PCT Contracting State), may be appointed by all the other applicants to act on the international application
- Who can act as "deemed" common representative? (Rule 90.2(b))
  - where neither a common agent or a common representative is being appointed,
    - the first named applicant in the request
    - who is entitled to file an international application with the RO with which the international application was filed is automatically "deemed" to be common representative

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The International Patent System

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

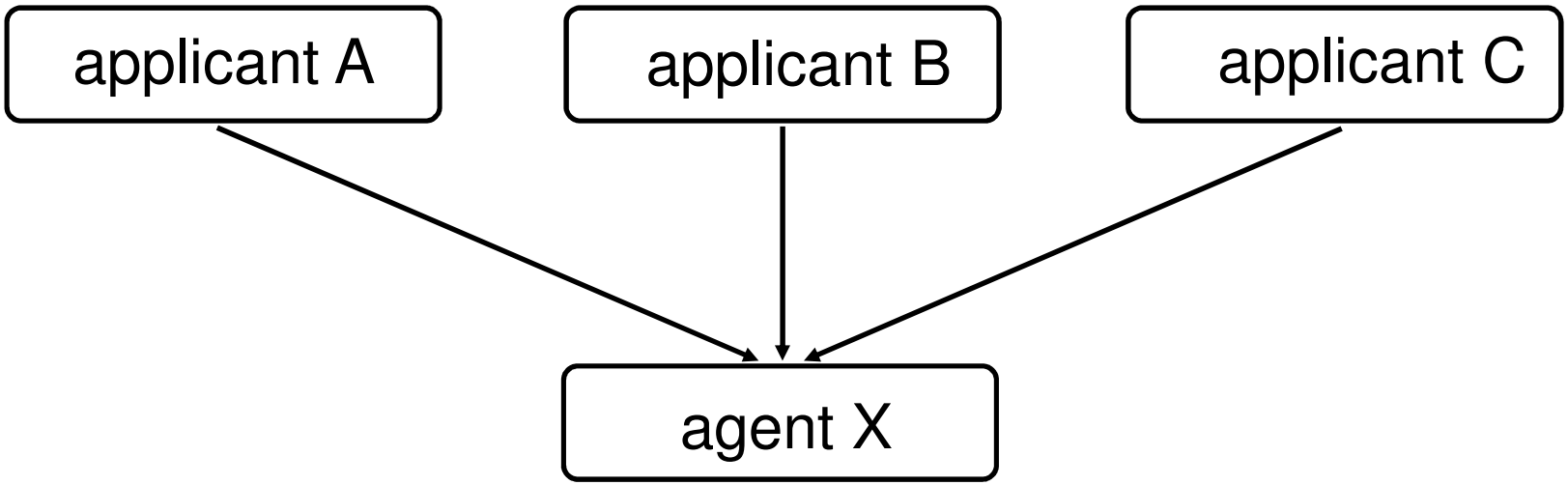
  an address for correspondence may be indicated in Box No. IV of the request form (PCT/RO/101)

- 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 changes *ex-officio* the indication of "agent" [if not relevant] into an 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, all applicants, or "by the address for correspondence "for and on behalf of the applicant"

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The International Patent System

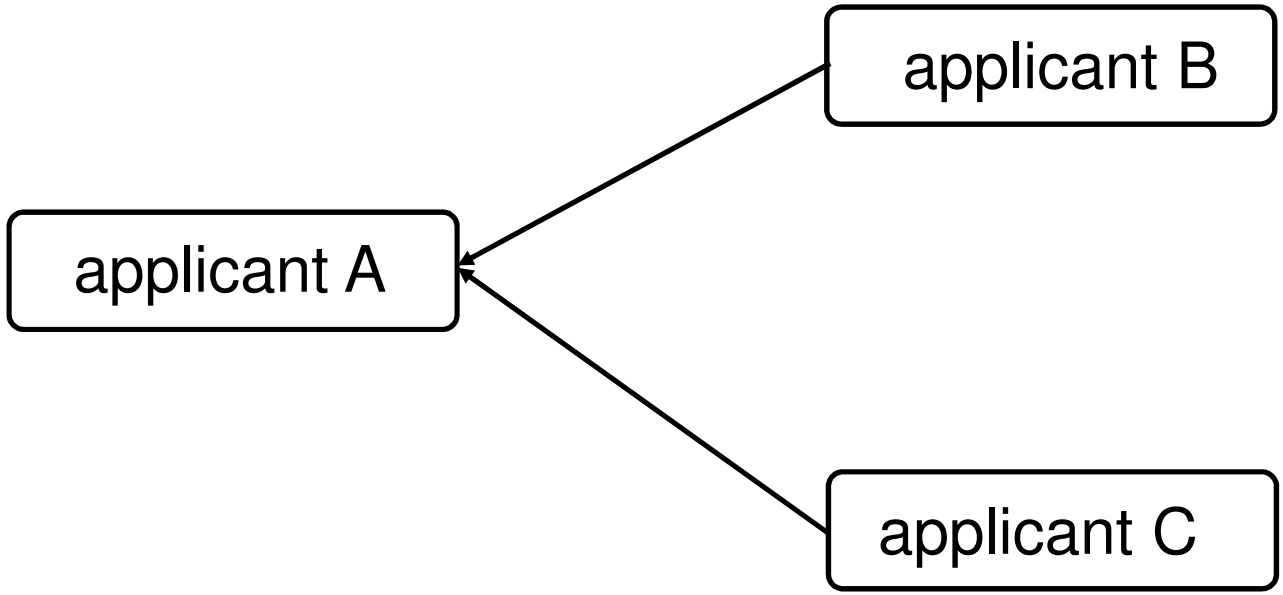
Common agent



- Agent X is a common agent if he/she has been appointed by all applicants
  - In practice, (purported) appointed common Agent X reads in Box No. IV, but no power of attorney is submitted upon filing (waiver applies)

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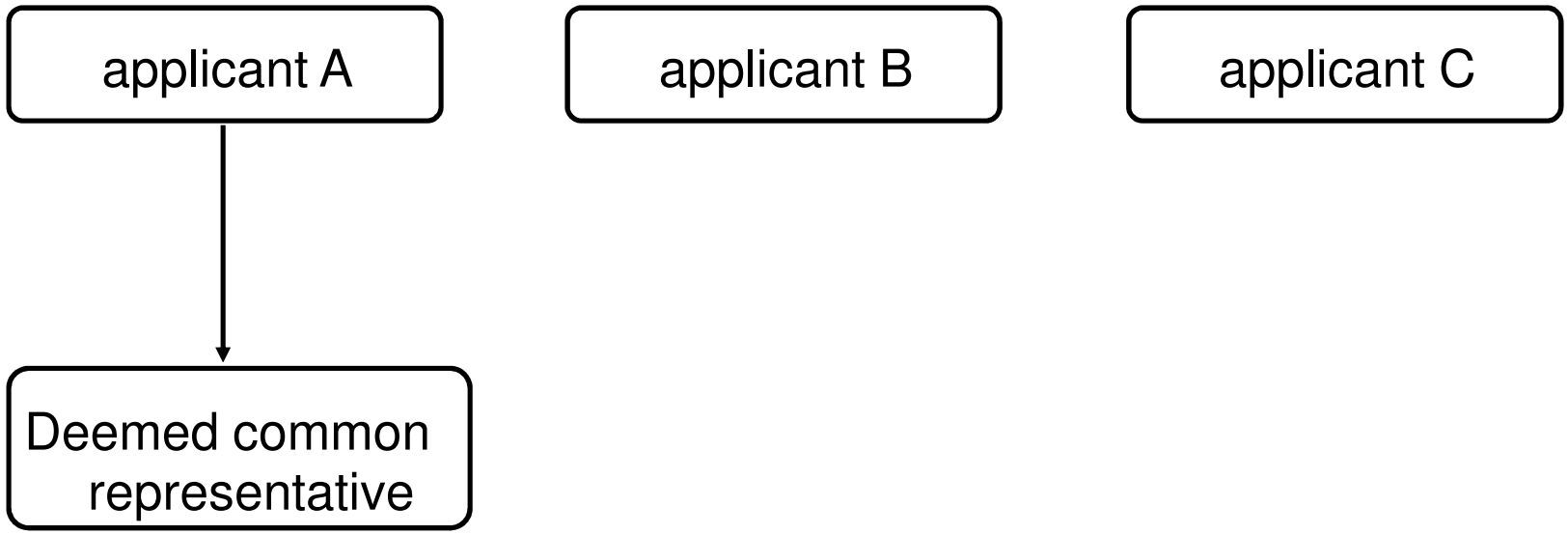
Appointed common representative (Rule 90.2(a))



- Applicant A may be appointed common representative by applicants B and C only if national or resident of a PCT Contracting State
  - e.g. AG co-applicant cannot be appointed common representative
  - e.g. MX applicant could be appointed common representative in relation to an IA filed with RO/US

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“Deemed” common representative (Rule 90.2(b))



- There is no common agent and the applicants have not appointed a common representative. Consequently applicant A is the “deemed” common representative (i.e., the first applicant named in the Request, who has the right to file an international application with the receiving Office with which the international application was filed)
- The deemed common representative CANNOT file a notice of withdrawal without the signature of all other applicants

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Withdrawals under Chapter I and Chapter II (1)

- What?
  - Chapter I: international application, designations, priority claim(s)
  - 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 (use of Form PCT/IB/372 recommended)
    - signed by all applicants, their appointed agent or common representative (power of attorney needed if not yet submitted)
    - In Chapter I: filed with the RO, SISA or the IB
    - In Chapter II:
      - filed with the RO, the IB or the IPEA to withdraw the IA or priority claim(s)
      - filed with the IB to withdraw the demand or elections

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Withdrawals under Chapter I and Chapter II (1)

- Effect:
  - withdrawal effective upon receipt by competent Authority
  - withdrawal has no effect in DOs/EOs where national processing or examination has already started
  - withdrawal of international application or designations:
    - 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)
    - effect ceases in each designated State concerned, with same consequences as withdrawal of a national application in that State
  - 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

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Withdrawal: refund of certain fees by the RO (2)

- If an international application is withdrawn
  - before the Record Copy is sent to the International Bureau and/or
  - before the Search Copy is sent to the International Searching Authority
- The receiving Office shall refund the international filing fee 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
  - If an international application is not treated as such due to national security prescriptions

WIPO | PCT
The International Patent System

Recording of changes under (Rule 92*bis*)

- What can be recorded under Rule 92*bis?*
  - Change of name
  - Change of address
  - Change of nationality
  - Adding/deleting an inventor
  - Change of applicant (assignment, addition, deletion)
  - Change of agent
- What CANNOT be recorded under that Rule?
  - License agreements
  - Security measures, etc.

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The International Patent System

Recording of changes under Rule 92*bis* (cont'd)

- The request must be made in writing [no email communications]
- May be filed with the IB [or the RO]
  - Recommendation: use the 'Action' in ePCT
- 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 IB before the expiration of 30 month from priority date
- The IB will record a change affecting multiple pending international applications with a single written request

Recording of changes under Rule 92*bis* (cont'd)

- If the applicant wants a particular change to be taken into account for the international publication of the IA, the request for the recording of that change must reach the IB before the completion of technical preparations for international publication (normally, 15 calendar 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, it will nevertheless be acted upon and notified to the DOs/EOS
- If the request reaches the IB AFTER the expiration of 30 months, the change will not be recorded and the applicant will have to further proceed with such request before each DO/EO concerned

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The International Patent System

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 request ("the new applicant") without the written consent of the ("old") applicant, the IB will require 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 (e.g. new agent very likely) , 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", a power of attorney signed by the new applicant appointing this agent should be submitted, unless the waiver applies

WIPO | PCT
The International Patent System


UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

Patent Prosecution Highway (PPH)

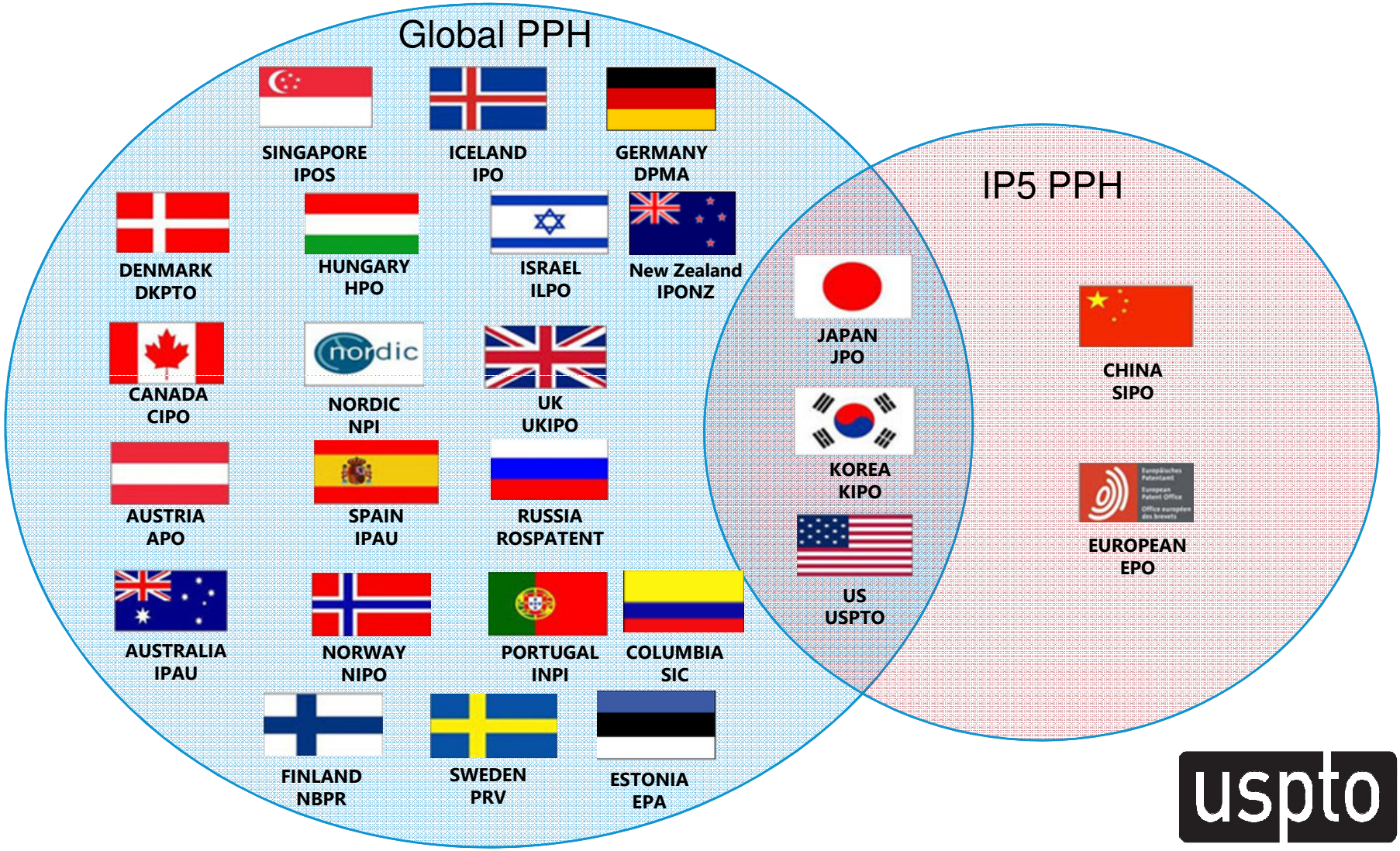
Michael Neas
Deputy Director
International Patent Legal Administration

UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

Types of PPH Agreements

- IP5 / Global
- Bilateral Agreements

Global PPH and IP5 PPH



Bilateral PPH Agreements



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.

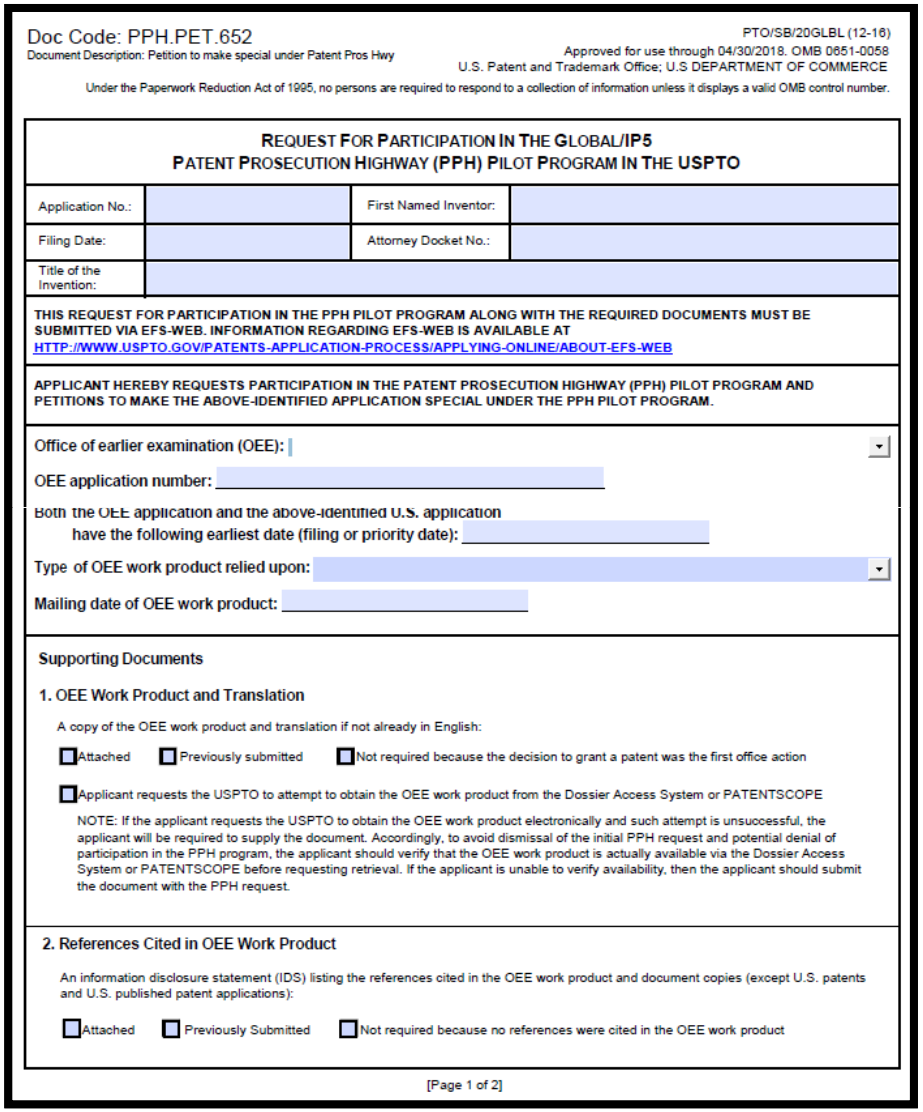
PPH Web Site for Global / IP5 PPH and Other PPH Forms

- 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



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
Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (12-16)
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/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.

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

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 OEE work product from the Dossier Access System or PATENTSCOPE

NOTE: If the applicant requests the USPTO to obtain the OEE work product 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 OEE work product 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.

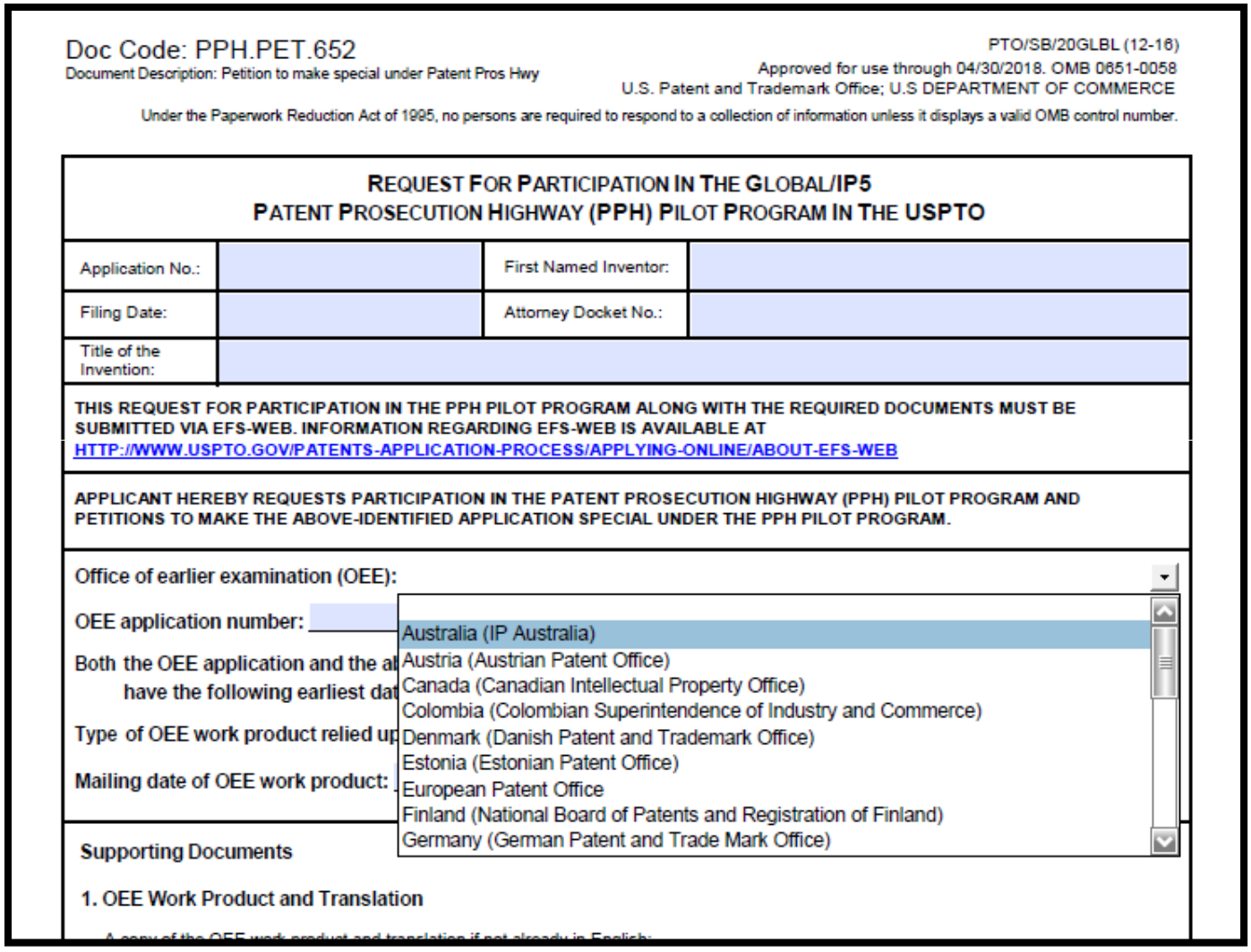
2. References Cited in OEE Work Product

An information disclosure statement (IDS) listing the 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

[Page 1 of 2]

Example of Global / IP5 PPH Form (2)



Doc Code: PPH.PET.652
Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (12-16)
Approved for use through 04/30/2018. OMB 0651-0058
U.S. Patent and Trademark Office; U.S DEPARTMENT OF COMMERCE

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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/APPLYING-ONLINE/ABOUT-EFS-WEB

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Office of earlier examination (OEE):

OEE application number:

Both the OEE application and the al
have the following earliest dat

Type of OEE work product relied up

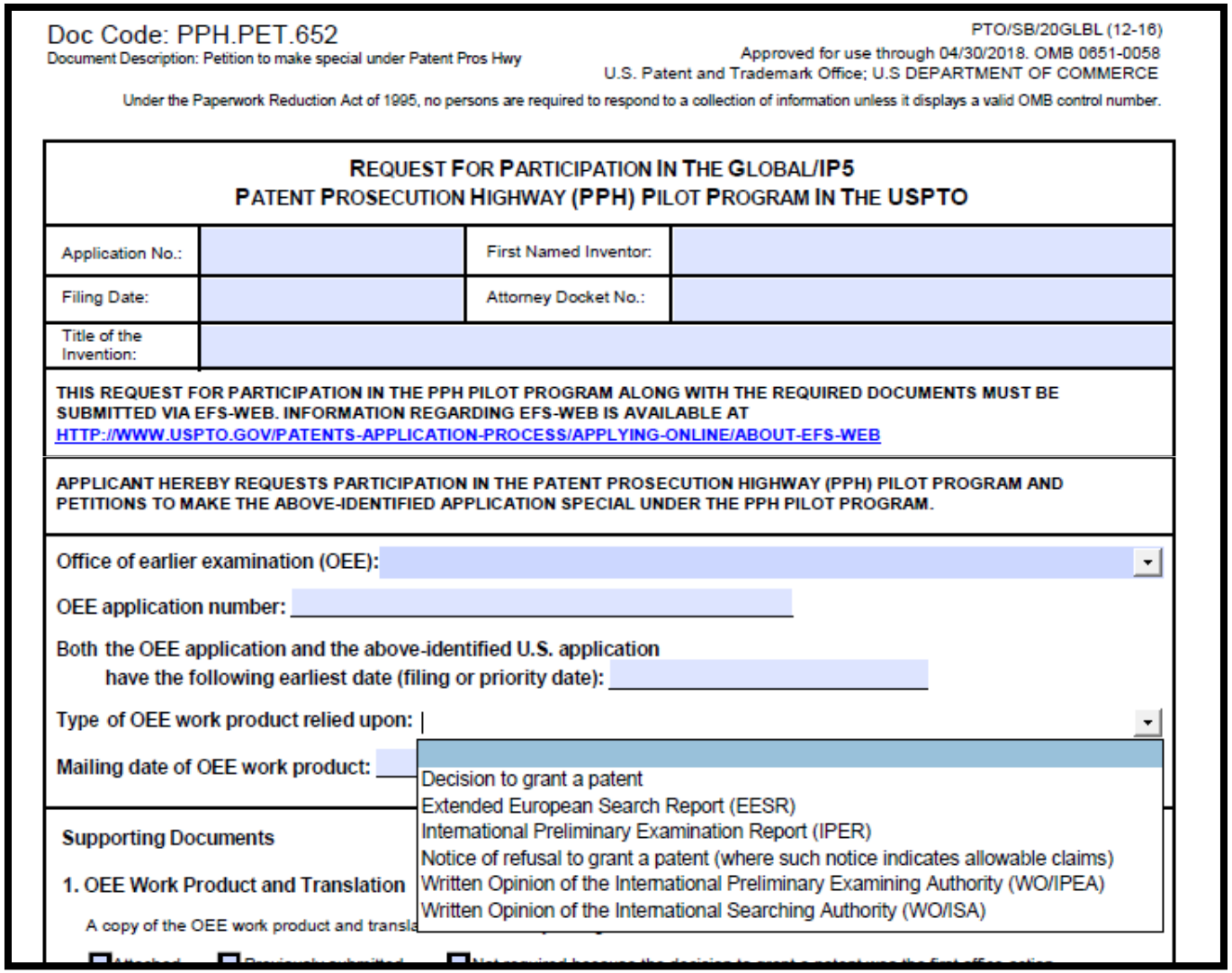
Mailing date of OEE work product:

- Australia (IP Australia)
- Austria (Austrian Patent Office)
- Canada (Canadian Intellectual Property Office)
- Colombia (Colombian Superintendence of Industry and Commerce)
- Denmark (Danish Patent and Trademark Office)
- Estonia (Estonian Patent Office)
- European Patent Office
- Finland (National Board of Patents and Registration of Finland)
- Germany (German Patent and Trade Mark Office)

Supporting Documents

1. OEE Work Product and Translation

Example of Global / IP5 PPH Form (3)



Doc Code: PPH.PET.652
Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (12-16)
Approved for use through 04/30/2018. OMB 0651-0058
U.S. Patent and Trademark Office; U.S DEPARTMENT OF COMMERCE

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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/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.

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:

- Decision to grant a patent
- Extended European Search Report (EESR)
- International Preliminary Examination Report (IPER)
- Notice of refusal to grant a patent (where such notice indicates allowable claims)
- Written Opinion of the International Preliminary Examining Authority (WO/IPEA)
- Written Opinion of the International Searching Authority (WO/ISA)

Supporting Documents

1. OEE Work Product and Translation

A copy of the OEE work product and transla

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)

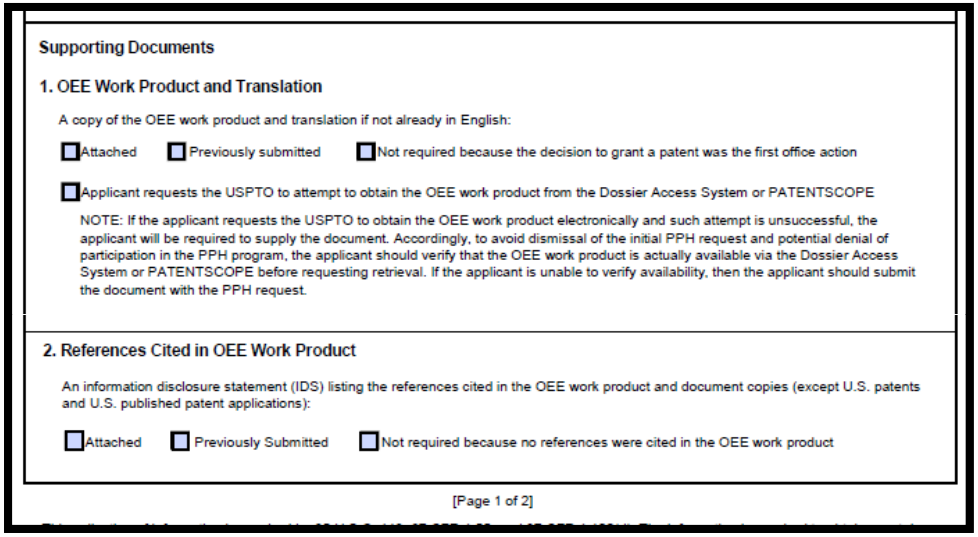
b) An information disclosure statement listing the documents cited in the Office of Earlier Examination (OEE) work product

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 (2)



Supporting Documents

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 OEE work product from the Dossier Access System or PATENTSCOPE

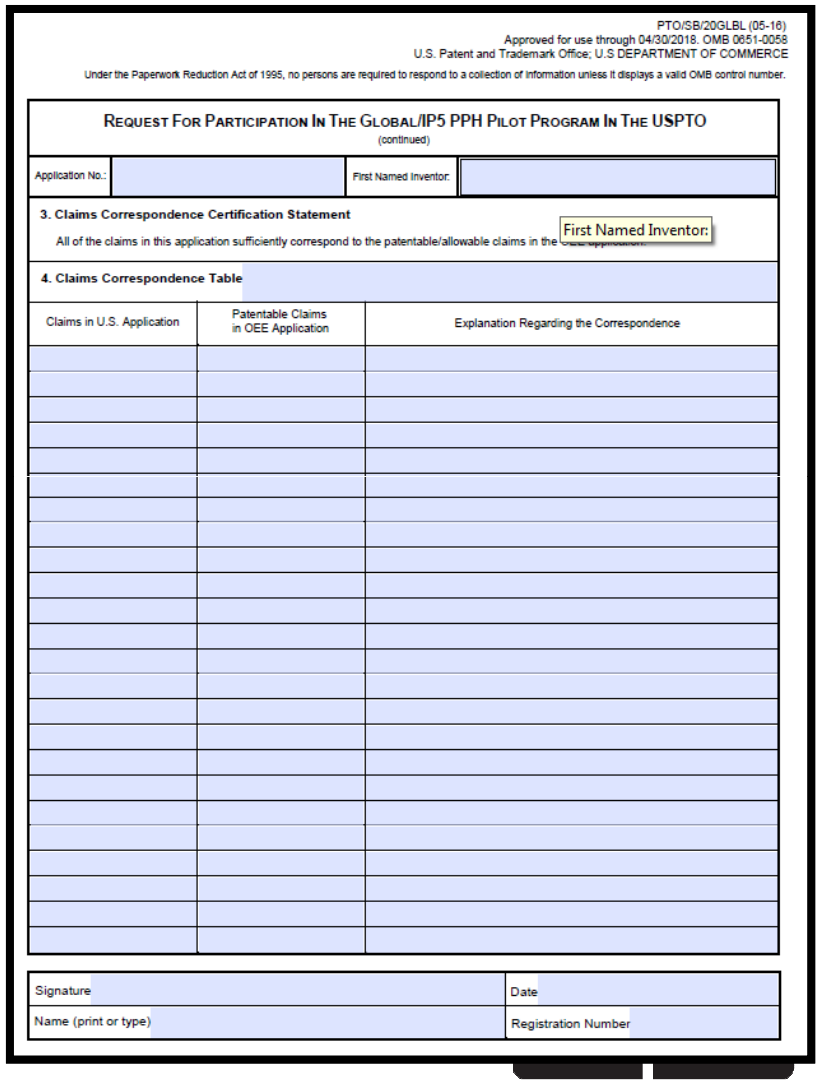
NOTE: If the applicant requests the USPTO to obtain the OEE work product electronically and such attempt is unsuccessful, the applicant will be required to supply the document. Accordingly, to avoid dismissal of the initial PPH request and potential denial of participation in the PPH program, the applicant should verify that the OEE work product 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.

2. References Cited in OEE Work Product

An information disclosure statement (IDS) listing the 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

[Page 1 of 2]



PTO/SB/20GLBL (05-16)
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 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

First Named Inventor:

4. Claims Correspondence Table

Claims in U.S. Application	Patentable Claims in OEE Application	Explanation Regarding the Correspondence

Signature	Date
Name (print or type)	Registration Number

Example of Bilateral PPH Request Form

Doc Code: PPH.PET.652

Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20BR (01-16)
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 BRAZILIAN NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY (INPI) 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: HTTP://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.

Office of earlier examination (OEE): BRAZIL (National Institute of Industrial Property)

INPI application number: _____

Both the INPI application and the above-identified U.S. application have the following earliest date (filing or priority date): _____

Type of INPI work product relied upon:

Mailing date of INPI 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/ppph-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. INPI Work Product and Translation

A copy of the INPI 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 INPI Work Product

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

☐ Attached ☐ Previously submitted ☐ Not required because no references were cited in the INPI work product

☐ Applicant requests the USPTO to attempt to obtain the document(s) from the Dossier Access System or PATENTSCOPE

[Page 1 of 2]

PTO/SB/20BR (01-16)
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 PPH PILOT PROGRAM BETWEEN THE INPI AND 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 INPI application.

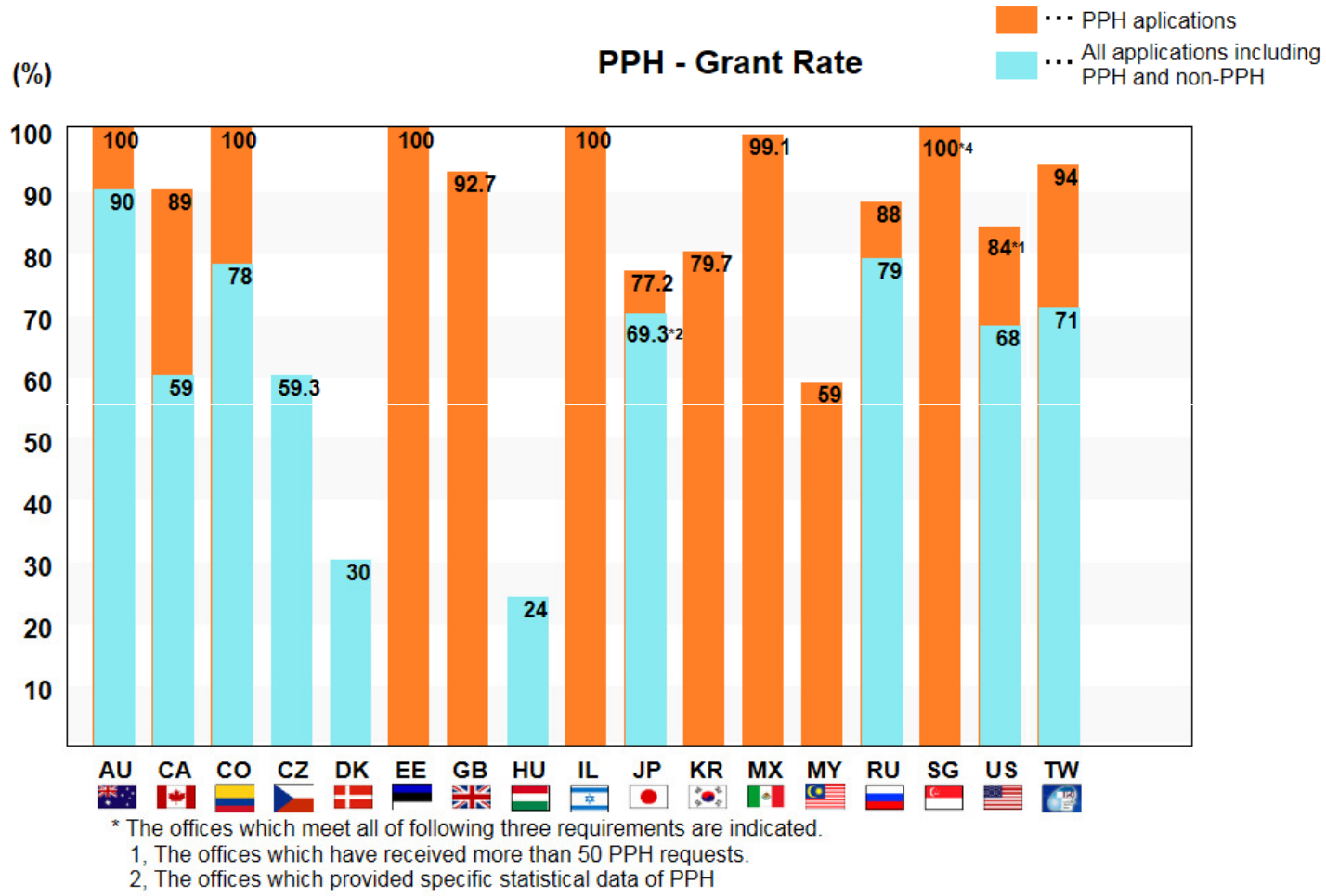
4. Claims Correspondence Table

Claims in US Application	Patentable Claims in INPI Application	Explanation regarding the correspondence

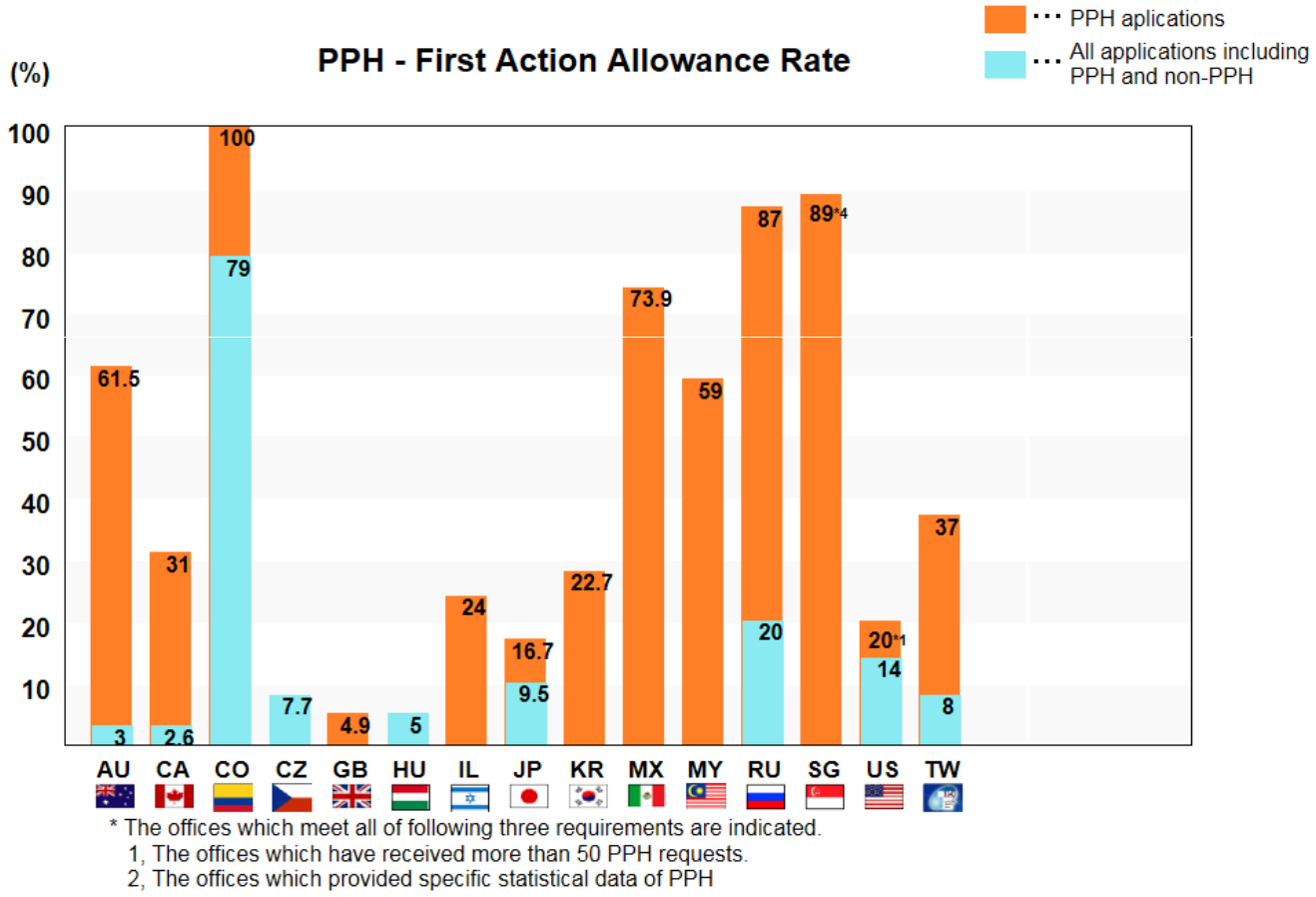
Signature		Date	
Name (Print/Typed)		Registration Number	

[Page 2 of 2]

Foreign PPH Grant Rates

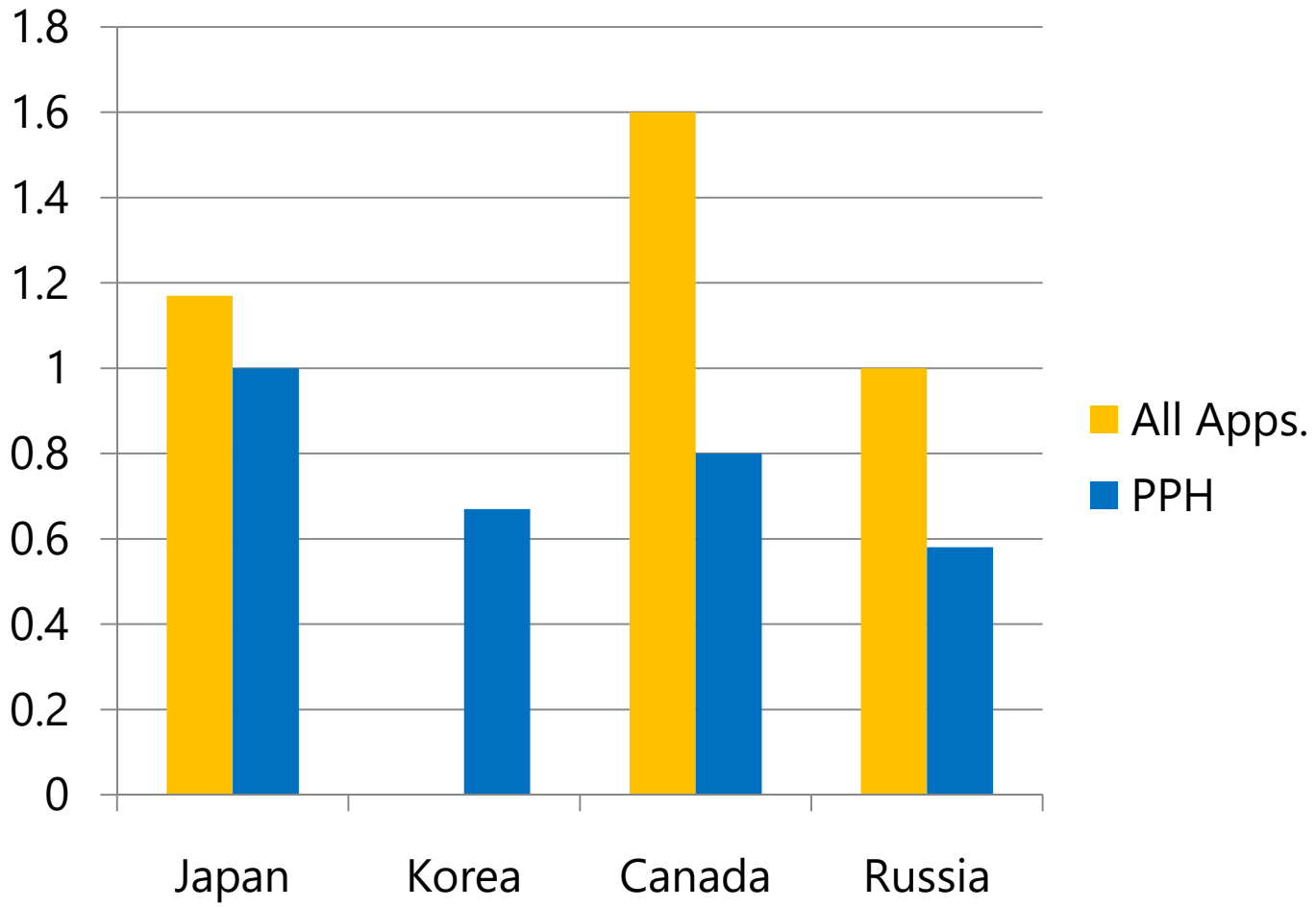


First Action Allowance Rates



* The offices which meet all of following three requirements are indicated.
1, The offices which have received more than 50 PPH requests.
2, The offices which provided specific statistical data of PPH

Average Number of Office Actions



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

PPH Timeliness at USPTO

(The average time in months between February 1, 2016 and January 31, 2017)

Action	Months
Petition to First Action	7.5
Petition to Allowance	14.2
Petition to Allowance (No RCE)	10.8
Petition to First Disposal	13.1
First Action to First Disposal	5.4
File to First Disposal	17.6
File to First Action	11.9

The average pendency from filing to decision on PPH requests is approximately 66 days for the year-to-date.

Terminal Disposal Comparison between PPH and Non-PPH Prosecution at USPTO

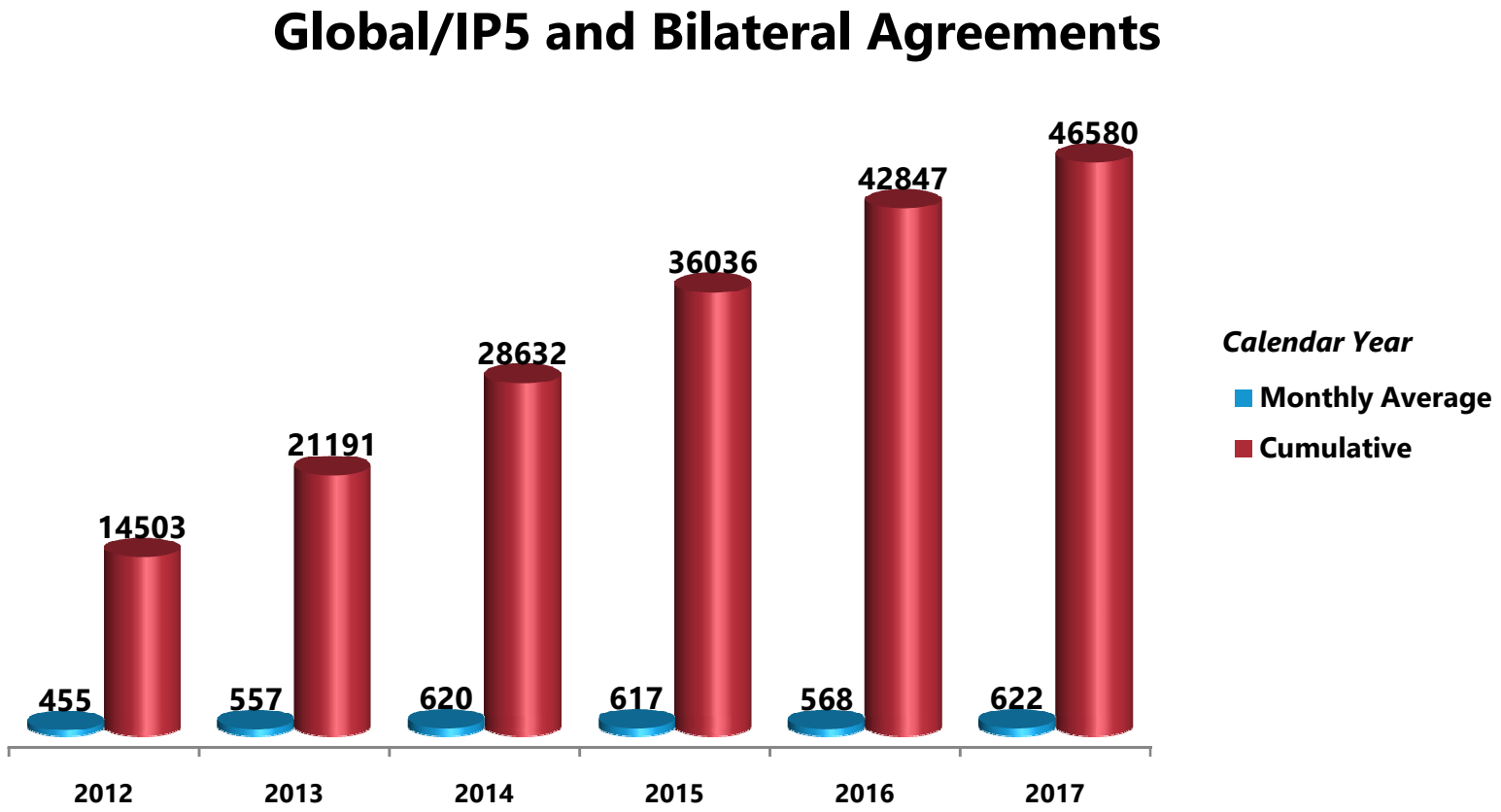
	Percent of Applications with at least one RCE*	Reduced Appeal Rates*	Overall Allowance Rate*	First Action Allowance Rate**
PPH Applications	26.8%	1.0%	81.1%	21.8%
Non-PPH Applications	28.9%	3.5%	67.9%	15.6%

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

** Appeal rates - Cases completed in Fiscal Year 2016 (October 1, 2015 – September 30, 2016)*

*** First action completed in Fiscal Year 2016*

Application with Petition Requests



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
uspto


UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

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 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

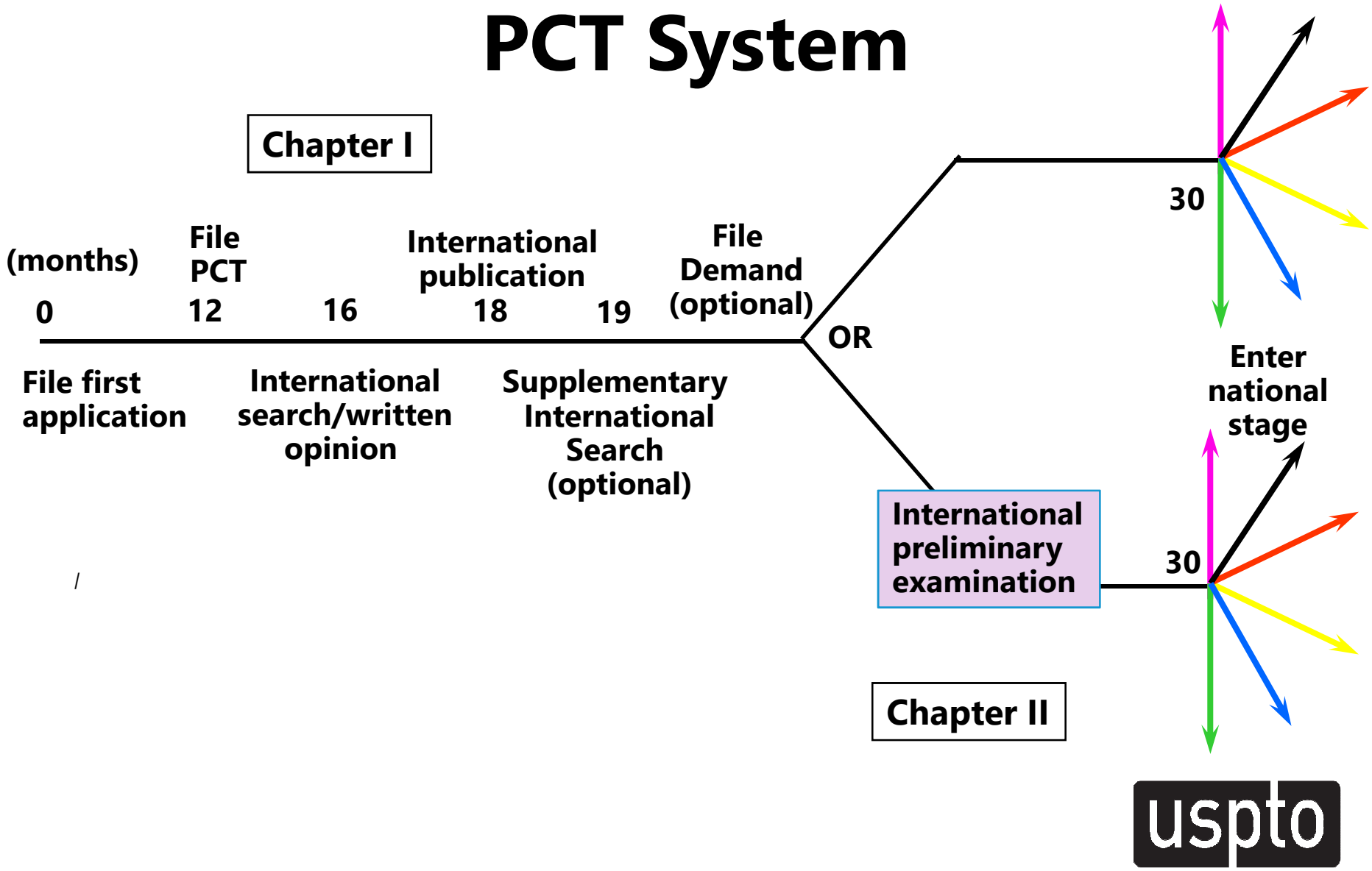

UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

International Search and Preliminary Examination

Michael A. Neas
Deputy Director
International Patent Legal Administration

UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

PCT System


Chapter I
(months)
File PCT
International publication
File Demand (optional)
0
12
16
18
19
30
OR
File first application
International search/written opinion
Supplementary International Search (optional)
Enter national stage
International preliminary examination
30
Chapter II
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

International Search Report

Form PCT/ISA/210 (second sheet)

Documents Considered to be Relevant



INTERNATIONAL SEARCH REPORT

International application No.
PCT/US 10/25555

A. CLASSIFICATION OF SUBJECT MATTER
IPC(8) - G06Q 50/00 (2010.01)
USPC - 705/3
According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
USPC: 705/3

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
705/ 1, 2; 700/1, 90

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)
USPTO WEST (PGPB, USPT, EPAB, JPAB); Google
Search Terms Used: patient, medical, record, identifier, information, allergy, reaction, graphic, visual, display, print, update, barcode, scanner, access, retrieve, procedure, locate, drug

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X ----- Y	US 2007/0125844 A1 (LIBIN et al.) 07 June 2007 (07.06.2007), entire document, especially para [0002]-[0003], [0005], [0015]-[0017], [0021]-[0025], [0030], [0036] and abstract	1-2, 4-5, 7-15, 17-18, 20-22 ---------- 3, 6, 16, 19
Y	US 2005/0222873 A1 (NEPHIN et al.) 06 October 2005 (06.10.2005), entire document, especially para [0102], [0223]-[0227]	3, 6, 16, 19
A	US 2009/0043611 A1 (NADAS et al.) 12 February 2009 (12.02.2009)	1-22
A	US 2005/0086071 A1 (FOX et al.) 21 April 2005 (21.04.2005)	1-22
A	US 2008/0149701 A1 (LANE) 26 June 2008 (26.06.2008)	1-22

☐ Further documents are listed in the continuation of Box C. ☐

* Special categories of cited documents:
"A" document defining the general state of the art which is not considered to be of particular relevance
"E" earlier application or patent but published on or after the international filing date
"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
"O" document referring to an oral disclosure, use, exhibition or other means
"P" document published prior to the international filing date but later than the priority date claimed
"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"&" document member of the same patent family

Date of the actual completion of the international search
30 March 2010 (30.03.2010)

Date of mailing of the international search report
14 APR 2010

Name and mailing address of the ISA/US
Mail Stop PCT, Attn: ISA/US, Commissioner for Patents
P.O. Box 1450, Alexandria, Virginia 22313-1450
Facsimile No. 571-273-3201

Authorized officer:
Lee W. Young
PCT Helpdesk: 571-272-4300
PCT OSP: 571-272-7774

Form PCT/ISA/210 (second sheet) (July 2009)

International Search Report
Cited Documents (References)

Document Categories

Document Citations & Relevant Passages

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X ---- Y	US 2007/0125844 A1 (LIBIN et al.) 07 June 2007 (07.06.2007), entire document, especially para [0002]-[0003], [0005], [0015]-[0017], [0021]-[0025], [0030], [0036] and abstract	1-2, 4-5, 7-15, 17-18, 20-22 ---------- 3, 6, 16, 19
Y	US 2005/0222873 A1 (NEPHIN et al.) 06 October 2005 (06.10.2005), entire document, especially para [0102], [0223]-[0227]	3, 6, 16, 19
A	US 2009/0043611 A1 (NADAS et al.) 12 February 2009 (12.02.2009)	1-22
A	US 2005/0086071 A1 (FOX et al.) 21 April 2005 (21.04.2005)	1-22
A	US 2008/0149701 A1 (LANE) 26 June 2008 (26.06.2008)	1-22

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)

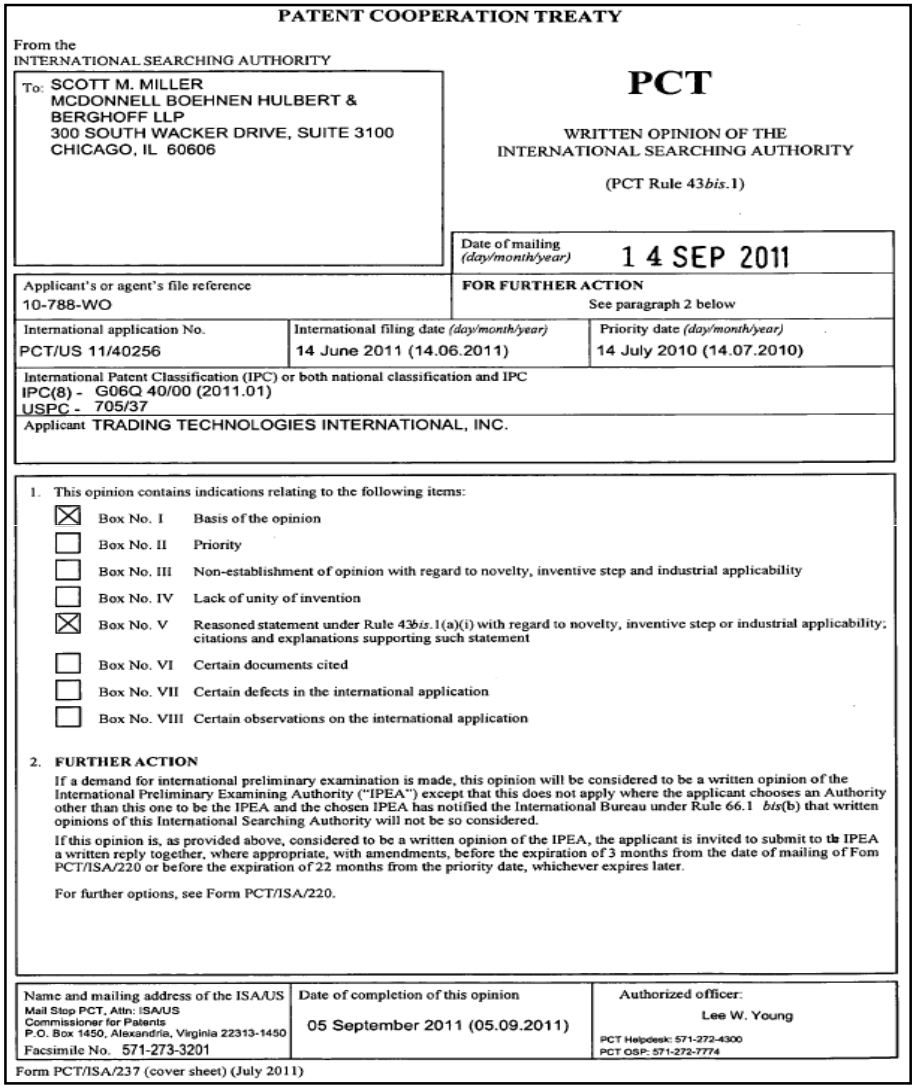
Written Opinion of the ISA
Form PCT/ISA/237

- 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

Written Opinion of the ISA Cover Sheet

Form PCT/ISA/237 (cover sheet)

Contents of the WOISA



PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To: SCOTT M. MILLER
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 SOUTH WACKER DRIVE, SUITE 3100
CHICAGO, IL 60606

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43*bis*.1)

Date of mailing (day/month/year): 14 SEP 2011

Applicant's or agent's file reference: 10-788-WO

FOR FURTHER ACTION: See paragraph 2 below

International application No.	International filing date (day/month/year)	Priority date (day/month/year)
PCT/US 11/40256	14 June 2011 (14.06.2011)	14 July 2010 (14.07.2010)

International Patent Classification (IPC) or both national classification and IPC
IPC(8) - G06Q 40/00 (2011.01)
USPC - 705/37

Applicant TRADING TECHNOLOGIES INTERNATIONAL, INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1 *bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Fom PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

Name and mailing address of the ISA/US	Date of completion of this opinion	Authorized officer:
Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 Facsimile No. 571-273-3201	05 September 2011 (05.09.2011)	Lee W. Young PCT Helpdesk: 571-272-4300 PCT OSP: 571-272-7774

Form PCT/ISA/237 (cover sheet) (July 2011)

Written Opinion of the ISA
Basis of this Opinion

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY	International application No. PCT/US15/40256

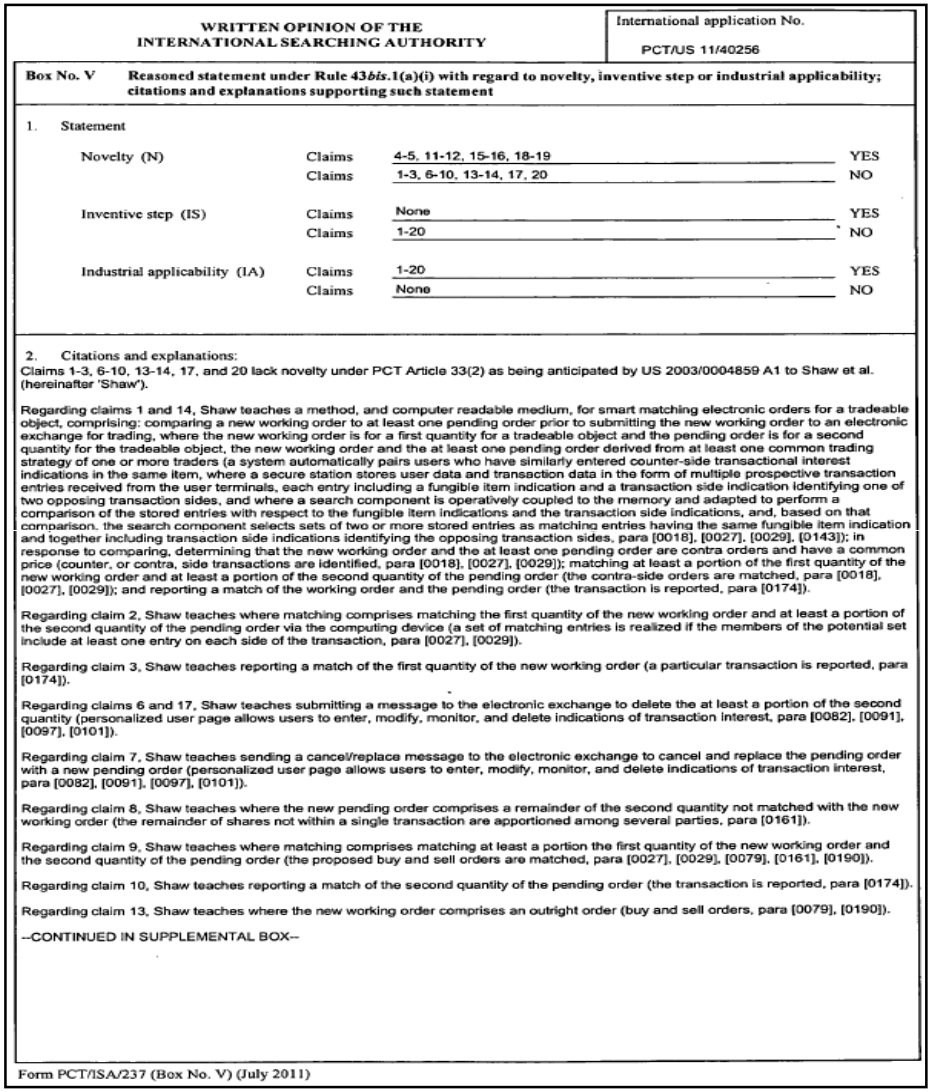
Box No. I Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of:
   - ☒ the international application in the language in which it was filed.
   - ☐ a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).
2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43*bis*.1(a)).
3. ☒ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of a sequence listing:
   - a. ☒ forming part of the international application as filed:
     - ☒ in the form of an Annex C/ST.25 text file.
     - ☐ on paper or in the form of an image file.
   - b. ☐ furnished together with the international application under PCT Rule 13*ter*.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file.
   - c. ☐ furnished subsequent to the international filing date for the purposes of international search only:
     - ☐ in the form of an Annex C/ST.25 text file (Rule 13*ter*.1(a)).
     - ☐ on paper or in the form of an image file (Rule 13*ter*.1(b) and Administrative Instructions, Section 713).
4. ☐ In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

Form PCT/ISA/237

Box No. I

- Basis of this opinion
  - Application as filed
    - Translated
    - Rectified
  - No amendments
    - In contrast to Chapter II



WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No. PCT/US 11/40256

Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	4-5, 11-12, 15-16, 18-19	YES
	Claims	1-3, 6-10, 13-14, 17, 20	NO
Inventive step (IS)	Claims	None	YES
	Claims	1-20	NO
Industrial applicability (IA)	Claims	1-20	YES
	Claims	None	NO

2. Citations and explanations:

Claims 1-3, 6-10, 13-14, 17, and 20 lack novelty under PCT Article 33(2) as being anticipated by US 2003/0004859 A1 to Shaw et al. (hereinafter 'Shaw').

Regarding claims 1 and 14, Shaw teaches a method, and computer readable medium, for smart matching electronic orders for a tradeable object, comprising: comparing a new working order to at least one pending order prior to submitting the new working order to an electronic exchange for trading, where the new working order is for a first quantity for a tradeable object and the pending order is for a second quantity for the tradeable object, the new working order and the at least one pending order derived from at least one common trading strategy of one or more traders (a system automatically pairs users who have similarly entered counter-side transactional interest indications in the same item, where a secure station stores user data and transaction data in the form of multiple prospective transaction entries received from the user terminals, each entry including a fungible item indication and a transaction side indication identifying one of two opposing transaction sides, and where a search component is operatively coupled to the memory and adapted to perform a comparison of the stored entries with respect to the fungible item indications and the transaction side indications, and, based on that comparison, the search component selects sets of two or more stored entries as matching entries having the same fungible item indication and together including transaction side indications identifying the opposing transaction sides, para [0018], [0027], [0029], [0143]); in response to comparing, determining that the new working order and the at least one pending order are contra orders and have a common price (counter, or contra, side transactions are identified, para [0018], [0027], [0029]); matching at least a portion of the first quantity of the new working order and at least a portion of the second quantity of the pending order (the contra-side orders are matched, para [0018], [0027], [0029]); and reporting a match of the working order and the pending order (the transaction is reported, para [0174]).

Regarding claim 2, Shaw teaches where matching comprises matching the first quantity of the new working order and at least a portion of the second quantity of the pending order via the computing device (a set of matching entries is realized if the members of the potential set include at least one entry on each side of the transaction, para [0027], [0029]).

Regarding claim 3, Shaw teaches reporting a match of the first quantity of the new working order (a particular transaction is reported, para [0174]).

Regarding claims 6 and 17, Shaw teaches submitting a message to the electronic exchange to delete the at least a portion of the second quantity (personalized user page allows users to enter, modify, monitor, and delete indications of transaction interest, para [0082], [0091], [0097], [0101]).

Regarding claim 7, Shaw teaches sending a cancel/replace message to the electronic exchange to cancel and replace the pending order with a new pending order (personalized user page allows users to enter, modify, monitor, and delete indications of transaction interest, para [0082], [0091], [0097], [0101]).

Regarding claim 8, Shaw teaches where the new pending order comprises a remainder of the second quantity not matched with the new working order (the remainder of shares not within a single transaction are apportioned among several parties, para [0161]).

Regarding claim 9, Shaw teaches where matching comprises matching at least a portion the first quantity of the new working order and the second quantity of the pending order (the proposed buy and sell orders are matched, para [0027], [0029], [0079], [0161], [0190]).

Regarding claim 10, Shaw teaches reporting a match of the second quantity of the pending order (the transaction is reported, para [0174]).

Regarding claim 13, Shaw teaches where the new working order comprises an outright order (buy and sell orders, para [0079], [0190]).

--CONTINUED IN SUPPLEMENTAL BOX--

Form PCT/ISA/237 (Box No. V) (July 2011)

WOISA Reasoned Statement

Form PCT/ISA/237

Box No. V

Citations and explanations of the claimed invention for

- ***Novelty,***
- ***Inventive step, and***
- ***Industrial applicability (similar to utility)***

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.

uspto

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

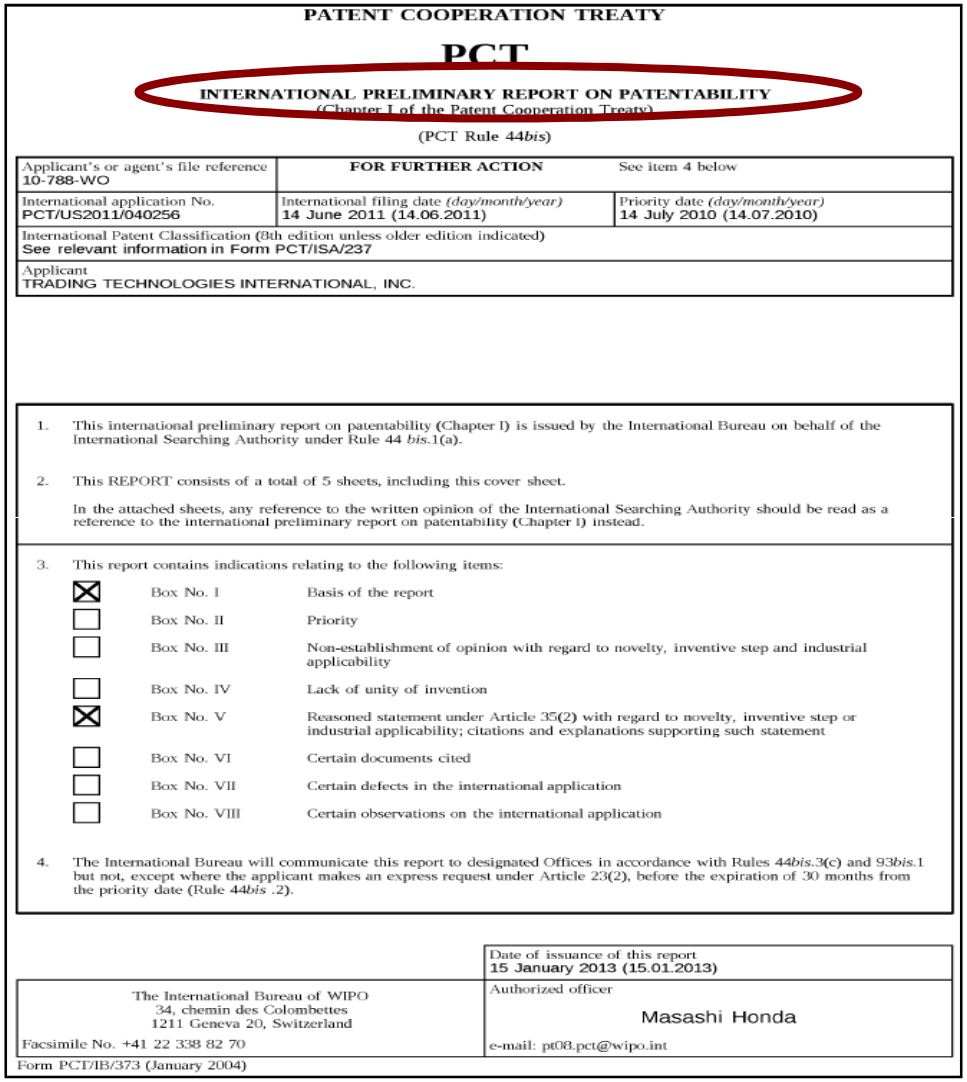
- International search report (or declaration under Article 17(2)(a)) plus written opinion of ISA is issued for every international application
- International preliminary report on patentability (IPRP) is issued for every international application
  - IPRP (Chapter I) = repackaged written opinion of 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

IPRP Chapter I

Form PCT/IB/373
(cover letter for the WOISA)



PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44*bis*)

Applicant's or agent's file reference 10-788-WO	FOR FURTHER ACTION	See item 4 below
International application No. PCT/US2011/040256	International filing date *(day/month/year)* 14 June 2011 (14.06.2011)	Priority date *(day/month/year)* 14 July 2010 (14.07.2010)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant TRADING TECHNOLOGIES INTERNATIONAL, INC.		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

   In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

☒	Box No. I	Basis of the report
☐	Box No. II	Priority
☐	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
☐	Box No. IV	Lack of unity of invention
☒	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
☐	Box No. VI	Certain documents cited
☐	Box No. VII	Certain defects in the international application
☐	Box No. VIII	Certain observations on the international application

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44*bis*.3(c) and 93*bis*.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44*bis* .2).

	Date of issuance of this report 15 January 2013 (15.01.2013)
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Authorized officer Masashi Honda e-mail: pt08.pct@wipo.int

Form PCT/IB/373 (January 2004)

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, ISA/IL, ISA/SG 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/US

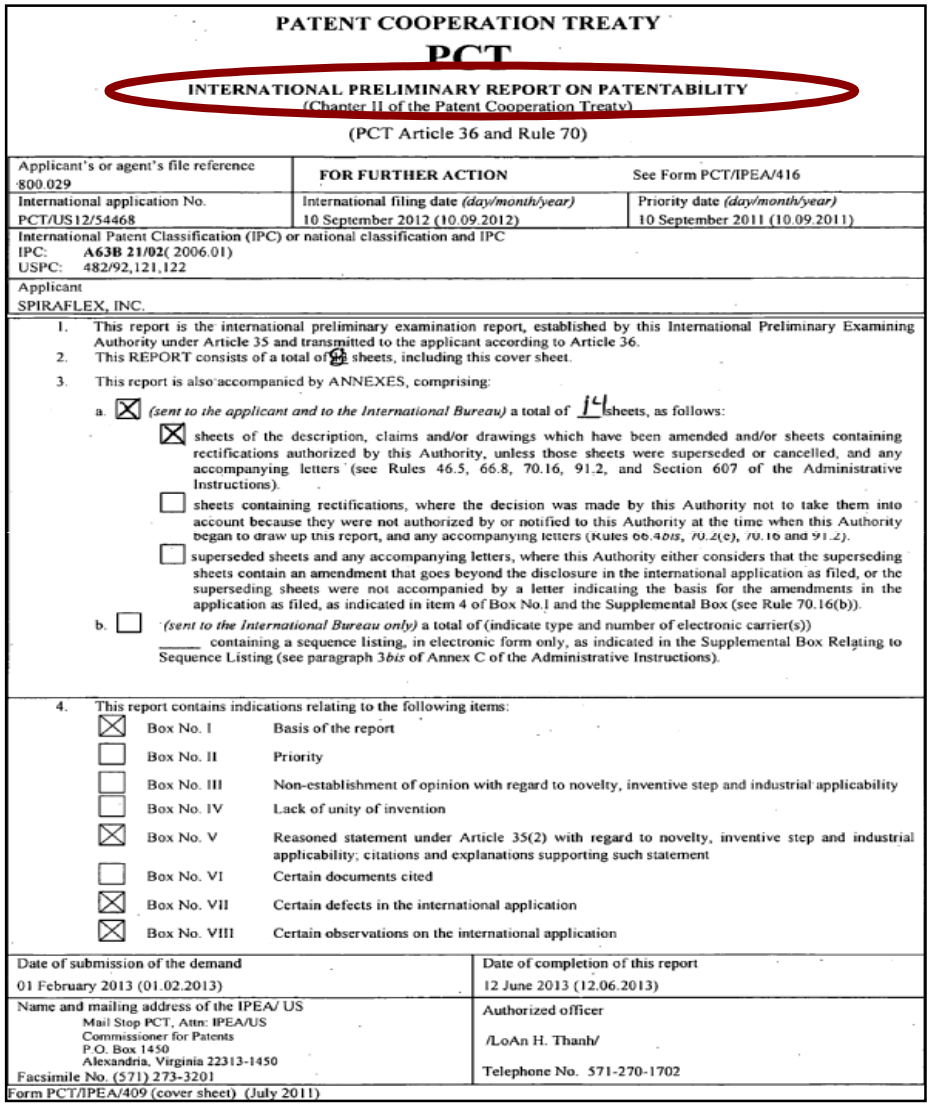
IPRP (Chapter II)

- 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.

IPRP (Chapter II) Cover Sheet

Form PCT/IPEA/409



PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 800.029	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/US12/54468	International filing date *(day/month/year)* 10 September 2012 (10.09.2012)	Priority date *(day/month/year)* 10 September 2011 (10.09.2011)

International Patent Classification (IPC) or national classification and IPC
IPC: **A63B 21/02**(2006.01)
USPC: 482/92,121,122

Applicant
SPIRAFLEX, INC.

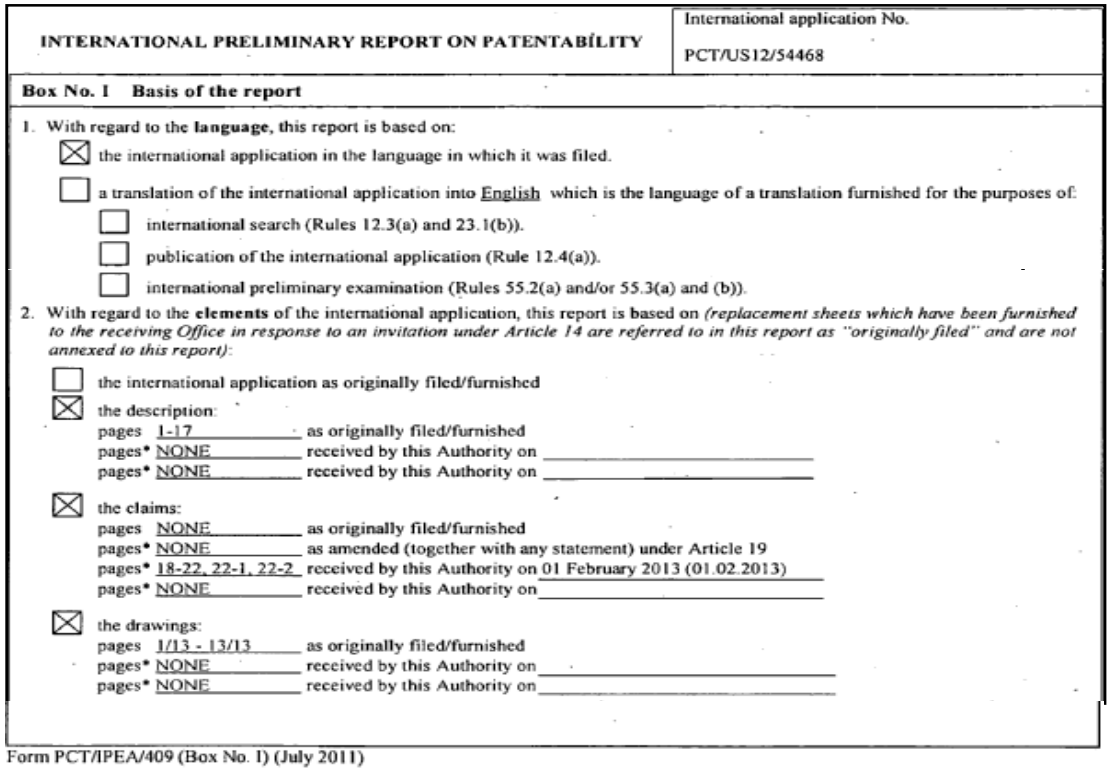
1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 18 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
   a. ☒ *(sent to the applicant and to the International Bureau)* a total of 14 sheets, as follows:
      ☒ sheets of the description, claims and/or drawings which have been amended and/or sheets containing rectifications authorized by this Authority, unless those sheets were superseded or cancelled, and any accompanying letters (see Rules 46.5, 66.8, 70.16, 91.2, and Section 607 of the Administrative Instructions).
      ☐ sheets containing rectifications, where the decision was made by this Authority not to take them into account because they were not authorized by or notified to this Authority at the time when this Authority began to draw up this report, and any accompanying letters (Rules 66.4*bis*, 70.2(e), 70.16 and 91.2).
      ☐ superseded sheets and any accompanying letters, where this Authority either considers that the superseding sheets contain an amendment that goes beyond the disclosure in the international application as filed, or the superseding sheets were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in item 4 of Box No.I and the Supplemental Box (see Rule 70.16(b)).
   b. ☐ *(sent to the International Bureau only)* a total of (indicate type and number of electronic carrier(s))
      _____ containing a sequence listing, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see paragraph 3*bis* of Annex C of the Administrative Instructions).
4. This report contains indications relating to the following items:
   - ☒ Box No. I Basis of the report
   - ☐ Box No. II Priority
   - ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
   - ☐ Box No. IV Lack of unity of invention
   - ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
   - ☐ Box No. VI Certain documents cited
   - ☒ Box No. VII Certain defects in the international application
   - ☒ Box No. VIII Certain observations on the international application

Date of submission of the demand	Date of completion of this report
01 February 2013 (01.02.2013)	12 June 2013 (12.06.2013)
Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (571) 273-3201	Authorized officer /LoAn H. Thanh/ Telephone No. 571-270-1702

Form PCT/IPEA/409 (cover sheet) (July 2011)

Contents of the IPRP (Chapter II)

IPRP (Chapter II)
Basis of the Report



INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US12/54468

Box No. I Basis of the report

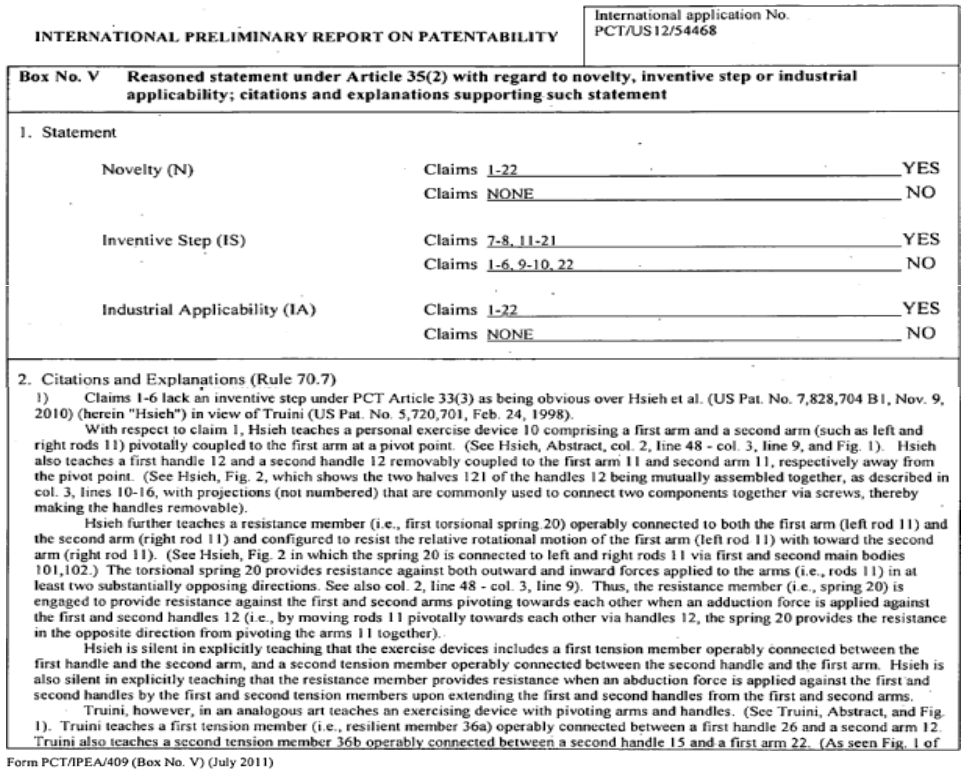
1. With regard to the **language**, this report is based on:
   - ☒ the international application in the language in which it was filed.
   - ☐ a translation of the international application into English which is the language of a translation furnished for the purposes of:
     - ☐ international search (Rules 12.3(a) and 23.1(b)).
     - ☐ publication of the international application (Rule 12.4(a)).
     - ☐ international preliminary examination (Rules 55.2(a) and/or 55.3(a) and (b)).
2. With regard to the **elements** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
   - ☐ the international application as originally filed/furnished
   - ☒ the description:
     - pages 1-17 as originally filed/furnished
     - pages* NONE received by this Authority on
     - pages* NONE received by this Authority on
   - ☒ the claims:
     - pages NONE as originally filed/furnished
     - pages* NONE as amended (together with any statement) under Article 19
     - pages* 18-22, 22-1, 22-2 received by this Authority on 01 February 2013 (01.02.2013)
     - pages* NONE received by this Authority on
   - ☒ the drawings:
     - pages 1/13 - 13/13 as originally filed/furnished
     - pages* NONE received by this Authority on
     - pages* NONE received by this Authority on

Form PCT/IPEA/409 (Box No. I) (July 2011)

Form PCT/IPEA/409
Box No. I

Basis of the report
- Application as amended
- In contrast to WOISA

IPRP (Chapter II)
Reasoned Statement



INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US12/54468

Box No. V **Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Claims 1-22	YES
	Claims NONE	NO
Inventive Step (IS)	Claims 7-8, 11-21	YES
	Claims 1-6, 9-10, 22	NO
Industrial Applicability (IA)	Claims 1-22	YES
	Claims NONE	NO

2. Citations and Explanations (Rule 70.7)

1) Claims 1-6 lack an inventive step under PCT Article 33(3) as being obvious over Hsieh et al. (US Pat. No. 7,828,704 B1, Nov. 9, 2010) (herein "Hsieh") in view of Truini (US Pat. No. 5,720,701, Feb. 24, 1998).

With respect to claim 1, Hsieh teaches a personal exercise device 10 comprising a first arm and a second arm (such as left and right rods 11) pivotally coupled to the first arm at a pivot point. (See Hsieh, Abstract, col. 2, line 48 - col. 3, line 9, and Fig. 1). Hsieh also teaches a first handle 12 and a second handle 12 removably coupled to the first arm 11 and second arm 11, respectively away from the pivot point. (See Hsieh, Fig. 2, which shows the two halves 121 of the handles 12 being mutually assembled together, as described in col. 3, lines 10-16, with projections (not numbered) that are commonly used to connect two components together via screws, thereby making the handles removable).

Hsieh further teaches a resistance member (i.e., first torsional spring 20) operably connected to both the first arm (left rod 11) and the second arm (right rod 11) and configured to resist the relative rotational motion of the first arm (left rod 11) with toward the second arm (right rod 11). (See Hsieh, Fig. 2 in which the spring 20 is connected to left and right rods 11 via first and second main bodies 101,102.) The torsional spring 20 provides resistance against both outward and inward forces applied to the arms (i.e., rods 11) in at least two substantially opposing directions. See also col. 2, line 48 - col. 3, line 9). Thus, the resistance member (i.e., spring 20) is engaged to provide resistance against the first and second arms pivoting towards each other when an adduction force is applied against the first and second handles 12 (i.e., by moving rods 11 pivotally towards each other via handles 12, the spring 20 provides the resistance in the opposite direction from pivoting the arms 11 together).

Hsieh is silent in explicitly teaching that the exercise devices includes a first tension member operably connected between the first handle and the second arm, and a second tension member operably connected between the second handle and the first arm. Hsieh is also silent in explicitly teaching that the resistance member provides resistance when an abduction force is applied against the first and second handles by the first and second tension members upon extending the first and second handles from the first and second arms.

Truini, however, in an analogous art teaches an exercising device with pivoting arms and handles. (See Truini, Abstract, and Fig. 1). Truini teaches a first tension member (i.e., resilient member 36a) operably connected between a first handle 26 and a second arm 12. Truini also teaches a second tension member 36b operably connected between a second handle 15 and a first arm 22. (As seen Fig. 1 of

Form PCT/IPEA/409 (Box No. V) (July 2011)

Form PCT/IPEA/409
Box No. V

Citations and explanations on

- ***Novelty,***
- ***Inventive step, and***
- ***Industrial applicability***

of the claimed invention

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
- ISA/SG
  - IPEA/SG,KR,RU,US

COMPETENT IPEA

CHOSEN ISA	US	AU	EP	KR	RU	IL	JP	SG
US	✓	☒	☒	✓	✓	☒	☒	☒
AU	✓	✓	☒	✓	✓	☒	☒	☒
EP	✓	☒	✓	✓	✓	☒	☒	☒
KR	✓	☒	☒	✓	✓	☒	☒	☒
RU	✓	☒	☒	✓	✓	☒	☒	☒
IL**	✓	☒	☒	✓	✓	✓	☒	☒
JP	✓	☒	☒	✓	✓	☒	✓	☒
SG	✓	☒	☒	✓	✓	☒	☒	✓

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

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

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
uspto


UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

Picking an International Searching Authority

Picking an International Searching Authority

- You are getting ready to file a PCT application
- You (the client) must pick an International Searching Authority (ISA)
- If your habit is always to pick the same ISA, because “we've always done it that way,” then this is an opportunity to provide better service to your client

Which ISA can you choose?

- The Receiving Office (RO) at which you file determines the available ISAs
  - To be a competent RO, at least one applicant must be a national/resident of the country/region of that RO
  - Any applicant can file at the RO/IB
- If you file at the RO/IB, the available ISAs are any that you could have selected if you had filed your application at the competent national/regional RO
- If there are joint applicants from different countries, you can file at any competent RO, but the RO you choose will determine the available ISAs
  - Therefore, best to consider available ISAs when selecting the RO
  - If you choose the RO/IB, you get to choose from the combined available ISAs

Which ISA can you choose?

- You can include an applicant of another nationality for the purpose of enabling filing at another RO (applicant of convenience)
  - The extra applicant can be made an applicant only for one obscure country
- You can use PCT-SAFE File Manager (for RO/US) or ePCT (for RO/IB) to prepare your Request. The software will look at the applicants and will tell you if you picked a competent RO, and will tell you which ISAs you can pick

You picked RO/US?

- There are 21 ISAs in total
- Available ISAs if you filed at the RO/US:
  - AU (Australia)
  - EP (EPO)
  - RU (Russia)
  - SG (Singapore)
  - 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, SG, and 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, DE, DK, EE, ES, FI, GB. HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, 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, this may influence your choice of ISA

EPO and PPH

- Note that EPO has the PACE program, which offers the opportunity to accelerate search or examination without having to qualify for PPH
- PPH is generally ineffective with EPO as the Office of Later Examination, but can be effective elsewhere with EPO as the Office of Earlier Examination.

Search Fees as of September 1, 2017

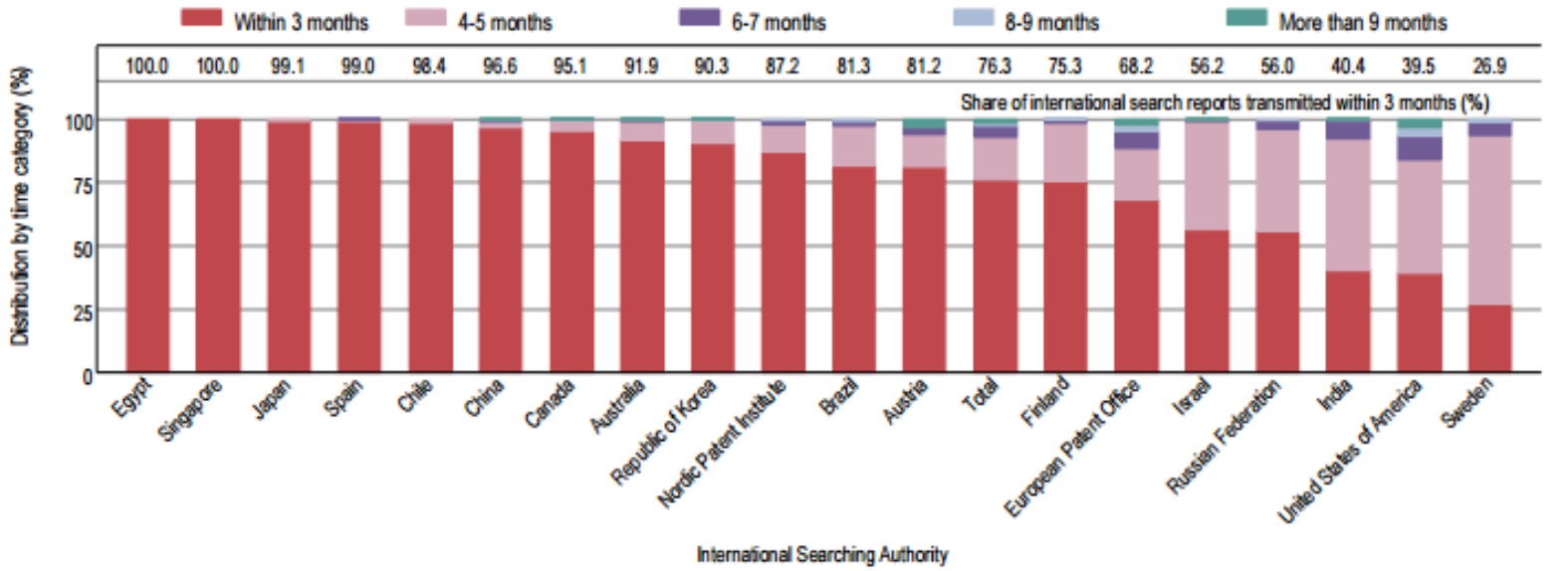
- EP – $2099
- US – $2080
- AU – $1688
- SG – $1552
- JP – $1372
- KR – $1114
- US – $1040 (small entity)
- IL – $963
- US – $520 (micro entity)
- RU – $482

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
  - If you think you are likely to have multiple inventions, consider ISA/KR

Timeliness in 2015

Figure C.3.2.2: Timeliness in transmitting ISRs to the IB, measured from date of receipt of the search copy by time category and by ISA, 2015



Note: Timeliness is calculated as the time between the date when the ISA receives a copy of the PCT application and the date when the ISA transmits the ISR to the IB (or, if applicable, the date of receipt of the declaration under Article 17(2)(a)). The figure shows timeliness in establishing the ISR, where the applicable time limit for establishing the ISR under Rule 42 is three months from receipt of the search copy.

Source: WIPO Statistics Database, May 2016.

Timeliness

- Ranking among ISAs available to RO/US filers:

ISA	Share transmitted within 3 months
SG	100%
JP	99.1%
AU	91.9%
KR	90.3%
EP	68.2%
IL	56.2%
RU	56.0%
US	39.5%

- Offices below the overall average: EP, IL, RU, US
- But in overwhelming majority of cases, the ISR is transmitted within 4-5 months of receipt of the search copy

Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional phase, 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 you 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 a reduced examination fee in EO/AU

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
- ISA/SG searchers read English and Mandarin and some also read additioal languages

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
  - Subject matter not required to be searched includes (Rule 39.1)
    - Scientific and mathematical theories
    - Plant or animal varieties or essentially biological processes for the production of plants or animals (except microbiological)
    - Schemes, rules or methods of doing business
    - Methods for the treatment or diagnosis of the human or animal body
    - Mere presentations of information
    - Computer programs

Subject Matter Not Searched

- For example:
  - 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))

ISA Competency Considerations – ISA/AU

Not competent to act as ISA for international applications filed by US applicants in RO/US or RO/IB if:

More than 250 IAs have been received in the relevant fiscal quarter

ISA Competency Considerations – ISA/EP

ISA/EP

ISA/EP will not search claims directed to mere business methods

For details, see:

http://documents.epo.org/projects/babylon/eponet.nsf/0/fe9b7f7048bf6529c1257d7

No_more_limitations_to_PCT_work_en.pdf

ISA Competency Considerations – ISA/IL

- Not competent to act as ISA for IAs filed by US applicants in RO/IB
- As for IAs filed by US applicants in RO/US, there is a numerical limitation of no more than 100 IAs per fiscal quarter

ISA Competency Considerations – ISA/JP

- 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

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 or method) that are in unity of invention:
  - ISA/EP may issue an informal communication telling the 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
  - The applicant may need to choose which independent claim should be searched
  - Unlike a unity of invention requirement, the 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

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

- Upon payment or free of charge
  - ISA/AU: upon payment of AUD 50 (about $37) per document
  - ISA/EP: provides copies of cited references
  - ISA/IL: upon payment of ILS 43 (about $11) per document
  - ISA/JP: upon payment of JPY 1400 (about $14) per document
  - ISA/KR: provides a temporary link (lasts three months) to a web page containing electronic copies of cited references
  - ISA/RU: provides copies of cited documents
  - ISA/SG: upon payment of SGD 30 (about $ 22) per document
  - ISA/US: provides copies of cited non-US patent documents and non-patent literature

Recent choices of ISA for International Applications filed in RO/US

ISA/US	ISA/EP	ISA/KR	ISA/AU	ISA/RU	ISA/IL	ISA/JP	ISA/SG
37%	37%	22%	<1%	3%	1%	<1%	0%

Supplementary International Search

- The applicant can ask another ISA to do its own search in addition to the standard ISA search, if the other ISA allows it
  - Most ISAs do not allow SIS, but:
    - EP, RU, SG, AT, FI, SE, UK, XN, XV offer it
  - Deadline to request SIS is 19 months from priority
  - Supplementary search fee to be paid to IB
  - SIS Report is produced by the SISA
  - Benefits
    - Reduces risk of new prior art being cited in the national phase
    - Can expand the linguistic and technical scope of the search
- Result of using EPO as SISA is that when entering European regional phase, the application will be treated in same manner as if EPO had been the ISA

International Preliminary Examining Authority

- Your choice of ISA affects your later choice of an IPEA
  - AU/EP/IL/JP/SG 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 an ISA

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The International Patent System

Amending the International Application and Filing Informal Comments

Matthias Reischle-Park
WIPO – AIPLA 21st Annual PCT Seminar, July 2017

Comparison of amendments filed under Article 19 and Article 34

Chapter I (Article 19)

- claims only
- one opportunity only
- for provisional protection and to overcome prior art applied by ISA
- have effect in all DOs
- filed within the later of 2 mos. of transmittal of the ISR (and WOSA) or 16 mos. from the priority date
- filed directly with IB (not ISA)
- formality examination by IB
- published as part of the international application by IB
- serve as basis for examination by IPEA unless reversed

Chapter II (Article 34)

- description, claims, drawings
- multiple opportunities possible*
- to overcome prior art applied by the ISA and IPEA
- have effect in all EOs
- filed best together with the demand, or during examination by IPEA
- filed directly with IPEA
- formality and substantive examination by IPEA
- are confidential between IPEA and the applicant, are not published during the international phase
- serve as basis for examination by IPEA unless superseded

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* Amendments need not be considered if received after the examiner has begun to prepare 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 have to be presented in the form of replacement sheets containing a (fresh) 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(s) or the agent, must accompany the amendments that
  - identifies claims that differ because of the amendments from the original claims
  - draws attention to the differences between the original claims and the amended claims
  - identifies claims that are canceled
  - indicates the basis for the amendments in the application as filed

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How to make amendments to the descriptions 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 sheets previously filed
- A letter, signed by the applicant(s) or the agent, must accompany the amendments that
  - draws attention to the differences between the replaced sheets and the replacement sheets
  - indicates the basis for the amendments in the application as filed
  - preferably explains the underlying reasons for the amendments

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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 (fully) reviewed by the IB for (substantive) compliance
  - If Article 34 amendments go beyond the disclosure of the international application, the IPRP (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 of the international application as filed
    - will include the amended sheets as annexes
- If the letter indicating the basis for the amendments in the international application as filed is missing, the IPRP (Chapter II) by the IPEA may be established as if the amendments had not been made

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

- ALL parts of the international application my be amended
- 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

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The International Patent System

TM

Article 19 and Article 34 Amendments

Article 19 & Article 34

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

Article 19 – Amendment of the Claims before the International Bureau

- “(1) The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. He may, at the same time, file a brief statement, as provided in the Regulations, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.
- (2) The amendments shall not go beyond the disclosure in the international application as filed.”

Docketing Article 19 Amendment Deadline

- An Art. 19 amendment is allowed between receipt of the ISR and the latest of:
  - **Two months** from the date of mailing of the ISR
  - **Sixteen months** from the 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 an Article 19 Amendment?

- You file with the International Bureau
- You can e-file as an “action” in ePCT
  - Amendments should be submitted in text format (DOCX or text-based PDF files)
    - Facilitates processing by the IB in preparation for international publication
  - Article 19 amendments not in text format can be submitted using the document upload function

What Does Article 19 Allow?

- One opportunity to amend
  - **Claims** only
    - must file complete set
  - Must file an accompanying **letter**
    - Identifying the amendments and/or cancelled claims
    - Indicating the basis for the amendments

What Does Article 19 Allow?

- May also file a **brief statement**
  - "Explaining the amendments"
    - No disparaging comments on the ISR or the relevance of the citations in the ISR is allowed
    - You can say that a claim is amended with reference to a particular citation
    - Cannot be 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

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

Should You File an Article 19 Amendment?

- Article 19 Amendments are useful:
  - For provisional protection
    - It's particularly useful if you plan to broaden the scope of independent claims from the scope as filed
    - To take advantage of provisional protection
      - In Europe, both the published and the granted claims have to be infringed
      - In the US, the claims that publish need to be substantially identical to the claims that ultimately issue
  - If you don't want to use International Preliminary Examination (Article 34), but would like to centrally amend the IA to avoid having to file amended claims in each Designated Office
    - If planning to use Article 34, then no need to amend under Article 19, unless for provisional protection benefit

Should You File an Article 19 Amendment?

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

Article 34 – Procedure before the International Preliminary Examining Authority

- “(2)(a) The applicant shall have a right to communicate orally and in writing with the International Preliminary Examining Authority.
- (2)(b) The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed.”

Docketing the Demand and Article 34 Amendment Deadline

- Must file the Demand by the latter of:
  - **Three months** from date of mailing of the ISR and WO, or
  - **22 months** from the priority date
- Can use the ePCT Time Line
- Can calculate using PCT Time Limit Calculator:

  www.wipo.int/pct/en/calculator/pct-calculator.html
- The handling fee and preliminary examination fee are paid to the IPEA by the latter of:
  - **One month** after the Demand was filed, or
  - **22 months** from the priority date
    - Can pay late but with a surcharge

Where to File?

- File with the IPEA
  - Payment is made to the IPEA
- You can e-file as an “action” in ePCT
  - A best practice

What Does Article 34 Allow?

- You may amend the claims, description and drawings
  - If Art. 19 claims were filed, may amend claims again or use Art. 19 claims
  - If amending claims, you need to file a complete set of claims with a letter indicating the basis for the amendment
    - If a letter is not provided, the amendment may be ignored
- You may file a response to objections in the WOISA
- The IPEA will conduct substantive examination on the basis of the (amended) claims
  - You may be allowed further amendment after examination
- The IPRP will be based on the situation at end of IPEA

What Does Article 34 Allow?

- The amendments should be filed with the demand
  - If filed later, it will be ok if the IPEA has not yet started to draw up the IPER, but this date is not known

- “Trick” to get more time to file amendments (in emergency):
  - When filing the demand, state that amendments under Article 34 are submitted with the demand, but don’t actually include any amendments (R. 53.9)
  - You will then be invited to file the amendments within a time limit (R. 60.1(g))
  - IPE won’t begin until the amendments are filed (provided filed within time limit) (R. 69.1(e))

Effect of Filing a Demand and Article 34 Amendments

- You may be able to turn a negative WOISA into a positive IPRP
  - This can lead to quick grant, particularly at the elected office that carried out the IPE and at other offices that give deference to the IPRP
- You may qualify for PPH
- You are guaranteed quick action from the IPEA
- You get 30 months to enter national phase in Luxembourg, Uganda, and Tanzania (otherwise deadline to enter national phase is 20/21 months)
  - Keep in mind that Luxembourg is a member of the EPO and Uganda and Tanzania are members of ARIPO
  - You must file the demand within 19 months of the priority date
- IPE is confidential, but the IPER is sent to elected offices and made publicly available as the IPRP Chapter II

Should You File a Demand and Article 34 Amendments?

- Reasons to file a demand:
  - If you are seeking early grant, as grant may be quicker at an elected office (particularly where the elected office = IPEA) following a positive IPRP
  - You get a better view of your prospect for success before you have to pay for national phase entry
  - If you would like to centrally amend your IA to avoid having to file amended claims in each national/regional phase office
    - Some elected offices do not examine in depth, so the patent will likely grant in this form
    - Particularly beneficial if filing in a large number of countries
  - If you believe a “clean” IPRP will help in licensing or other exploitation of the invention
  - There may be fee reductions at the elected office=IPEA
  - Use of PPH to get accelerated prosecution in PPH member countries

Should You File a Demand and Article 34 Amendments? – The US Case

- If you are going to enter the national stage in US and think you can get a "clean" IPRP prepared by the IPEA/US:
  - Your application will be "taken out of order" under the provisions of 37 CFR 1.496
  - Search and examination fees will be $0
    - If only some claims get a "clean" IPRP, you can cancel the other claims in a preliminary amendment
      - Note that this also applies to a "clean" written opinion issued by the ISA/'US

Should You File a Demand and Article 34 Amendments? – The EP Case

- If the ISA was ISA/EP, and you plans later to enter the EP regional phase
  - It may be smart to file a Demand and Article 34 amendments with IPEA/EP, with the goal of getting patentable claims
  - EP regional phase should then proceed smoothly with a quick grant
  - PPH can be used in other countries, many of which give deference to the EPO's positive opinion

Should You File a Demand and Article 34 Amendments?

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

Submitting Informal Comments – An Alternative

- You can submit informal comments to the International Bureau in response to the WOISA
  - An alternative if you want to rebut the WOISA in the international phase but don't want to request IPEA
  - There is no maximum word count
  - They must be clearly identified as informal comments
  - They are made publicly available on PATENTSCOPE as from the date of international publication
  - They should be submitted before the expiration of 28 months from the priority date so that they will be available to designated offices upon entry into national phase
    - Informal comments submitted after 30 months will not be transmitted to designated offices but only kept in the file at the IB
  - They can be filed in any language

Strategies for PCT Filing

DIFFERENT LAWS IN DIFFERENT COUNTRIES

- 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. Divulgation

    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

CAVEATS FOR FILING

- 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

STRATEGIES FOR PCT FILING

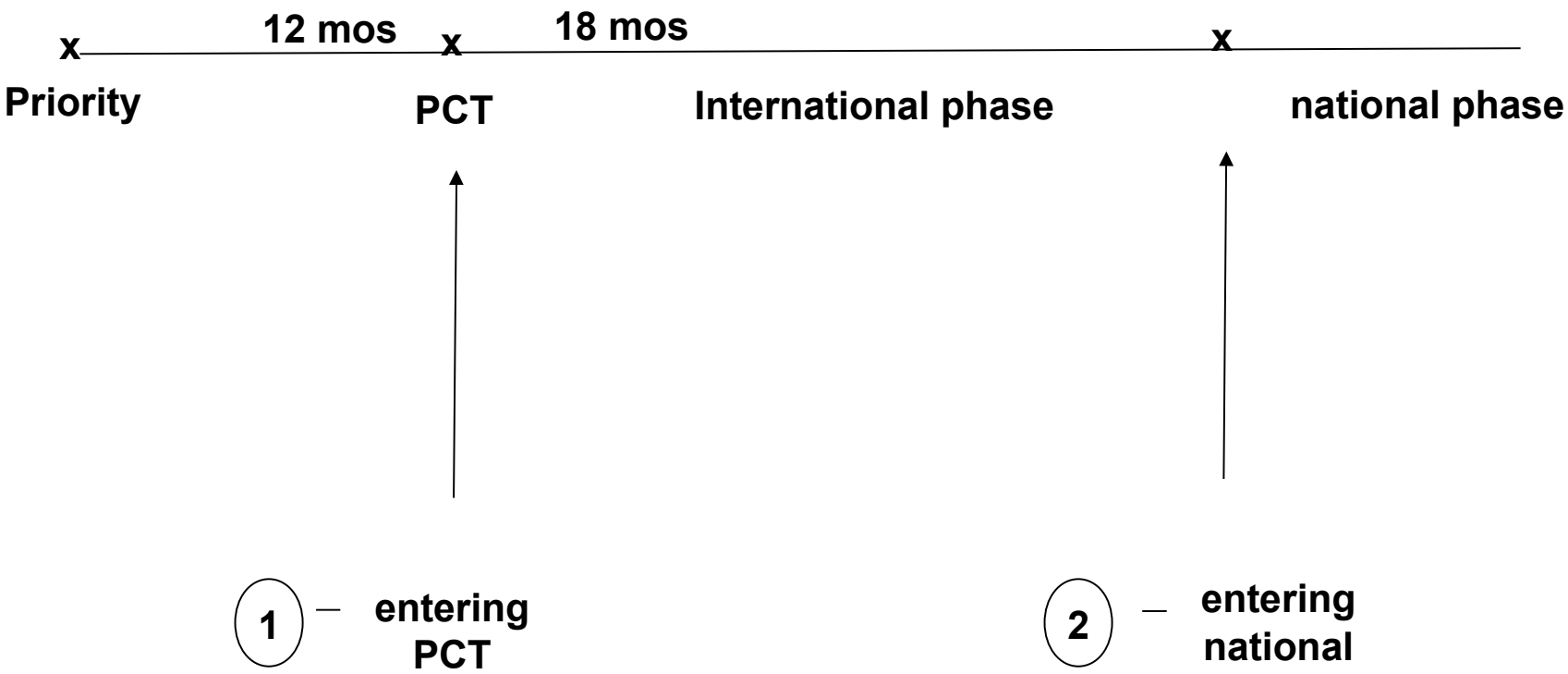
- There are different available routes for foreign filing, even using the PCT

- We must be able to combine available “tools”
  - Provisional Application
  - PCT
  - EPC
  - Paris Convention
  - Bilateral Treaties, e.g. Taiwan

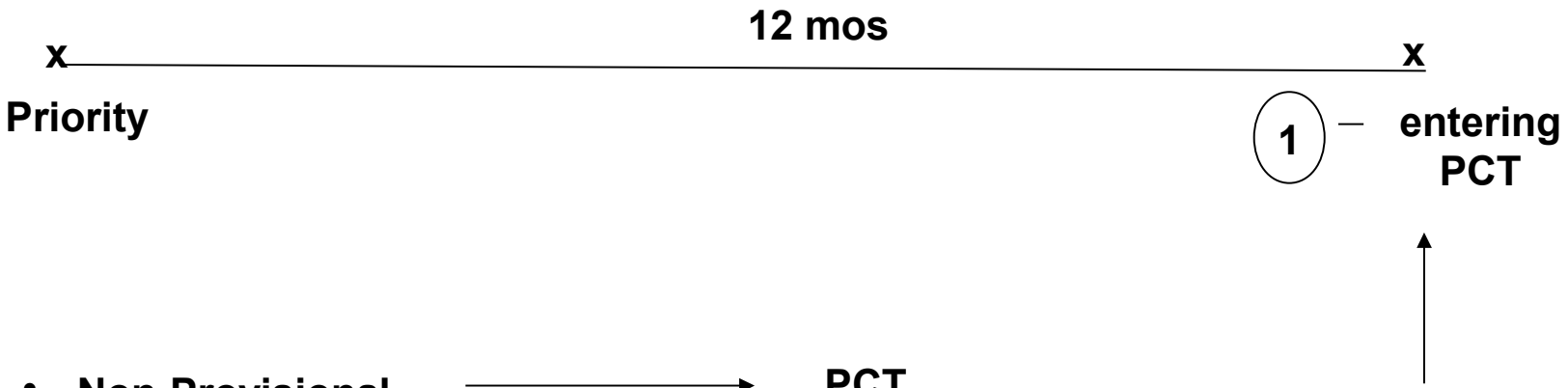
- Each case should be analyzed to determine best strategy for filing

FILING PCT

- Two “access” points:



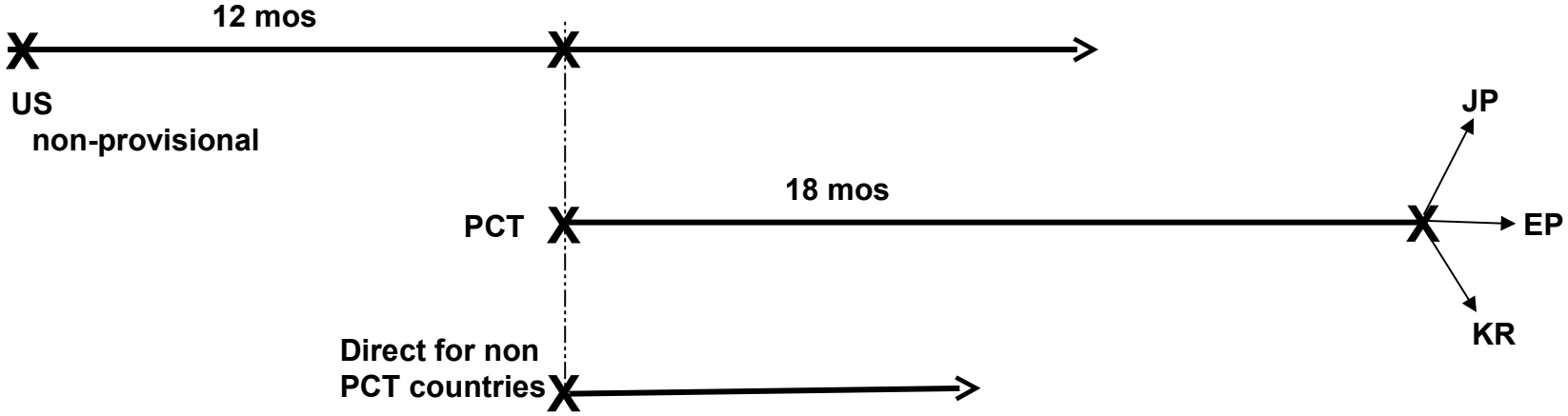
ENTERING PCT



- Non-Provisional → PCT
- Provisional → PCT
- PCT Direct →

CLASSICAL ROUTE

- 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

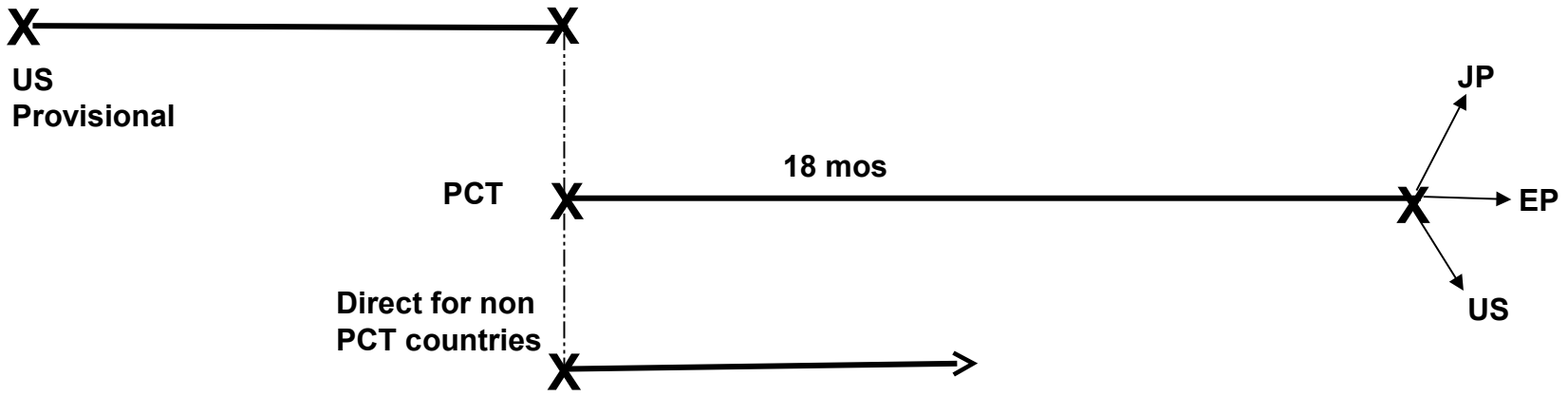
- PCT search may get earlier search results than US case
- Can get PCT search from another Patent Office
- Can still use PCT into US for a second US case

Concerns

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

PROVISIONAL AND PCT

- 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

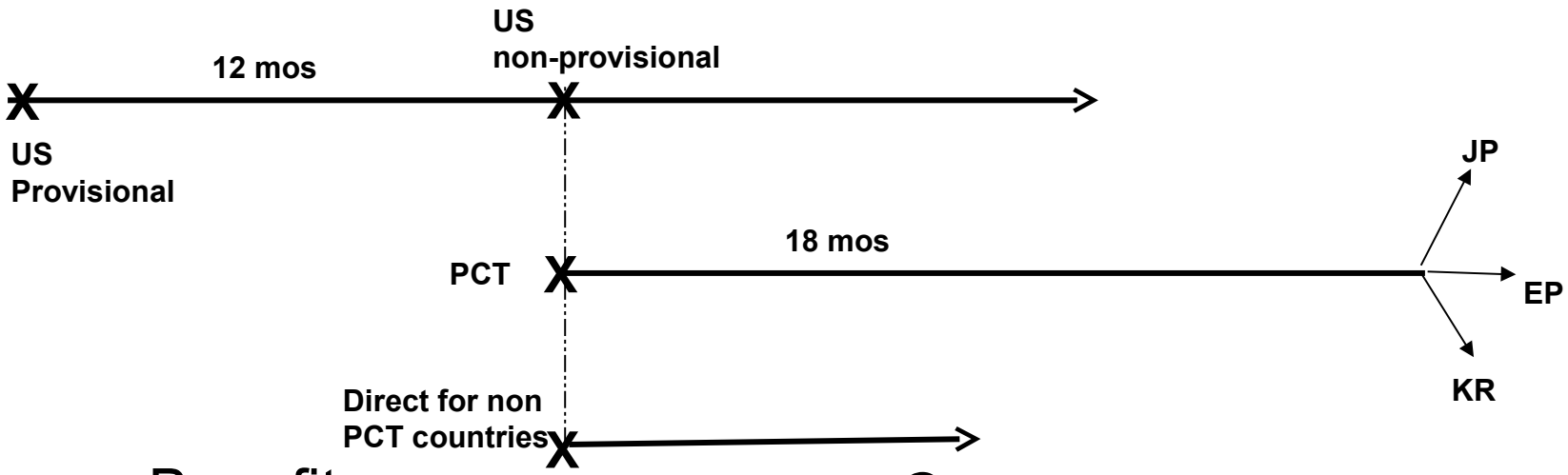
- Lower up front costs
- Can choose when to prosecute in US
- May get search results before big investment
- Get benefit of extra year of term of US Patent. All patents will expire at same time

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

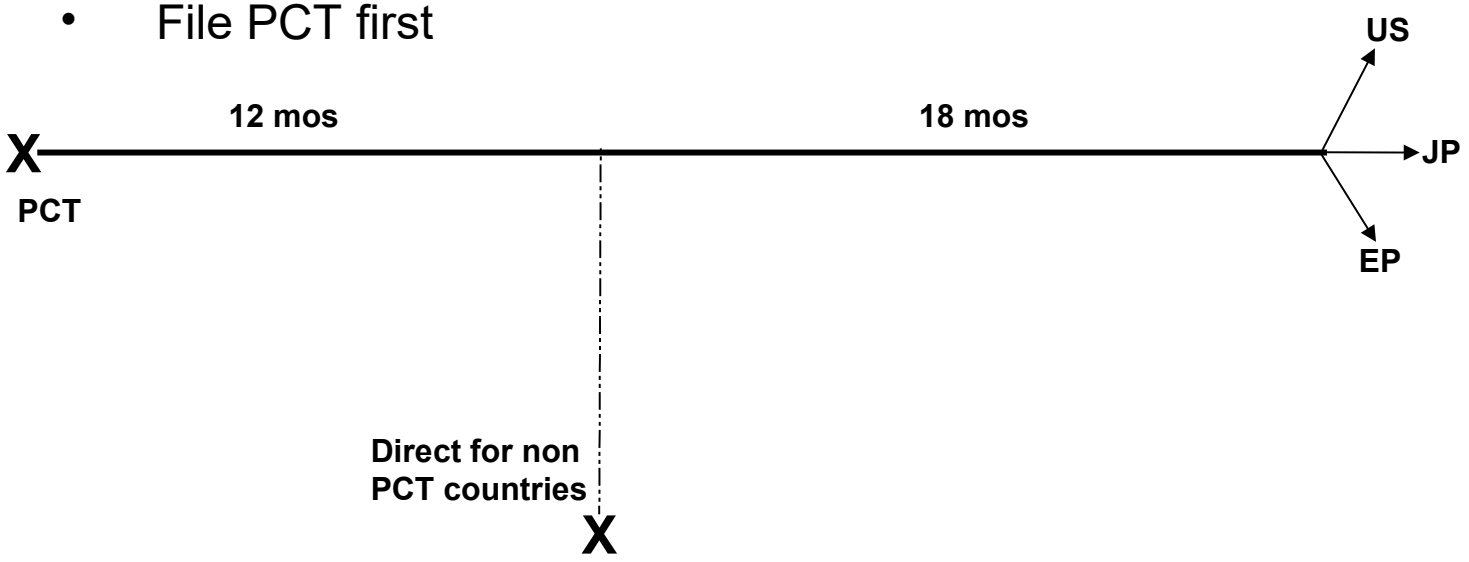
- Limited front end costs
- PCT search may get earlier result than US case
- If use EPO for PCT search can get US & EPO search before foreign filing
- Can still get a second US case from the PCT
- All patents will expire at the same time

Concerns

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

PCT FIRST

- 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

FILING PCT

- 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

FILING PCT

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)):*

. . . . . .

FILING PCT

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:

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		national application: country or Member of WTO	regional application:* regional Office	international application: receiving Office
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item (2)				
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

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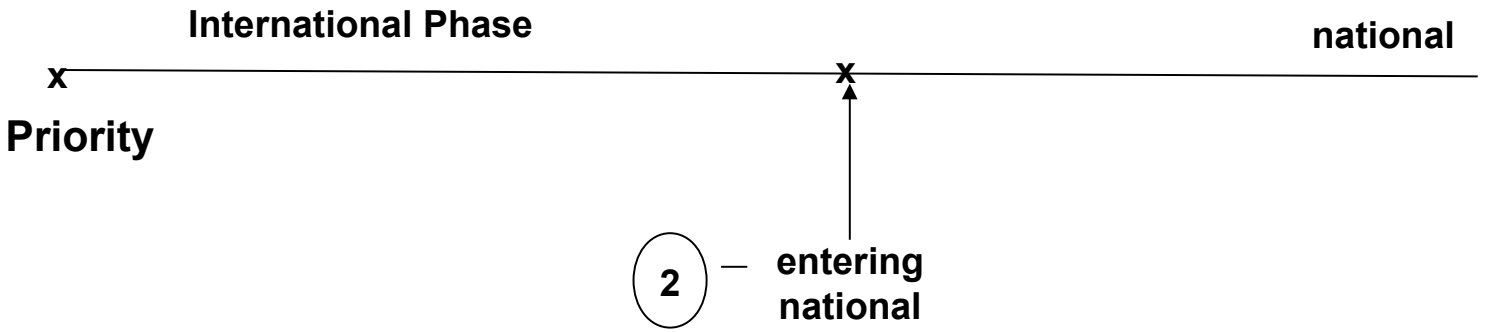
☐ all items ☒ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* *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 “designations” section of ePCT, where the PCT is to be treated as a continuation or a continuation-in-part of an earlier US non-provisional application.

- 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.

ENTERING US



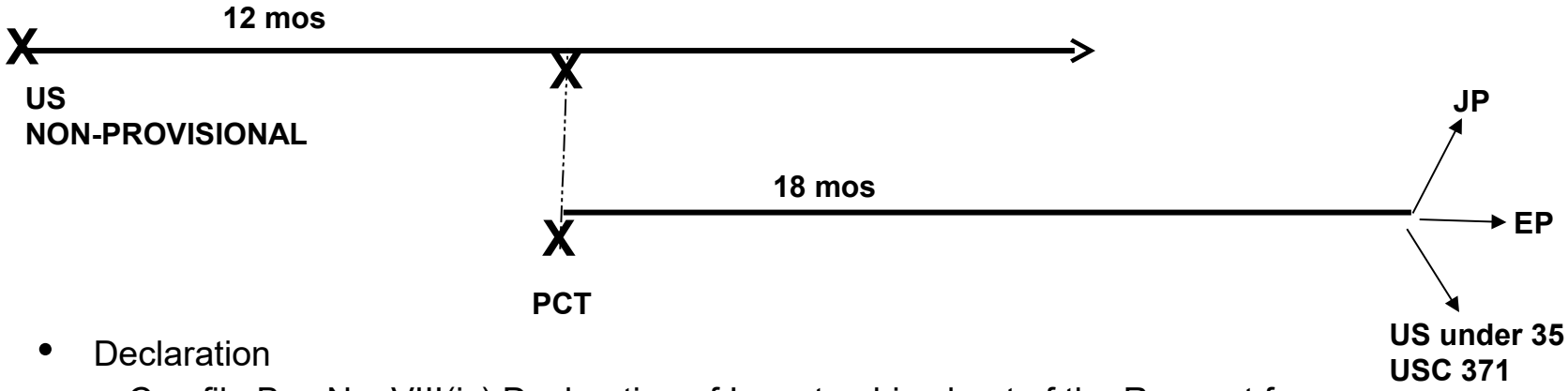
- Can enter USPTO in 2 ways:
  - National Phase Entry: (35 USC 371) – i.e. same case
  - By-Pass Route: (35 USC 111) – i.e. – new case (cont or cip)
- Upon Entry into USPTO, must provide:
  - Declaration
  - Fees

ENTERING US

US Non-Provisional-PCT-371 US National Phase Application

When entering into the US from PCT Non-Provisional Priority

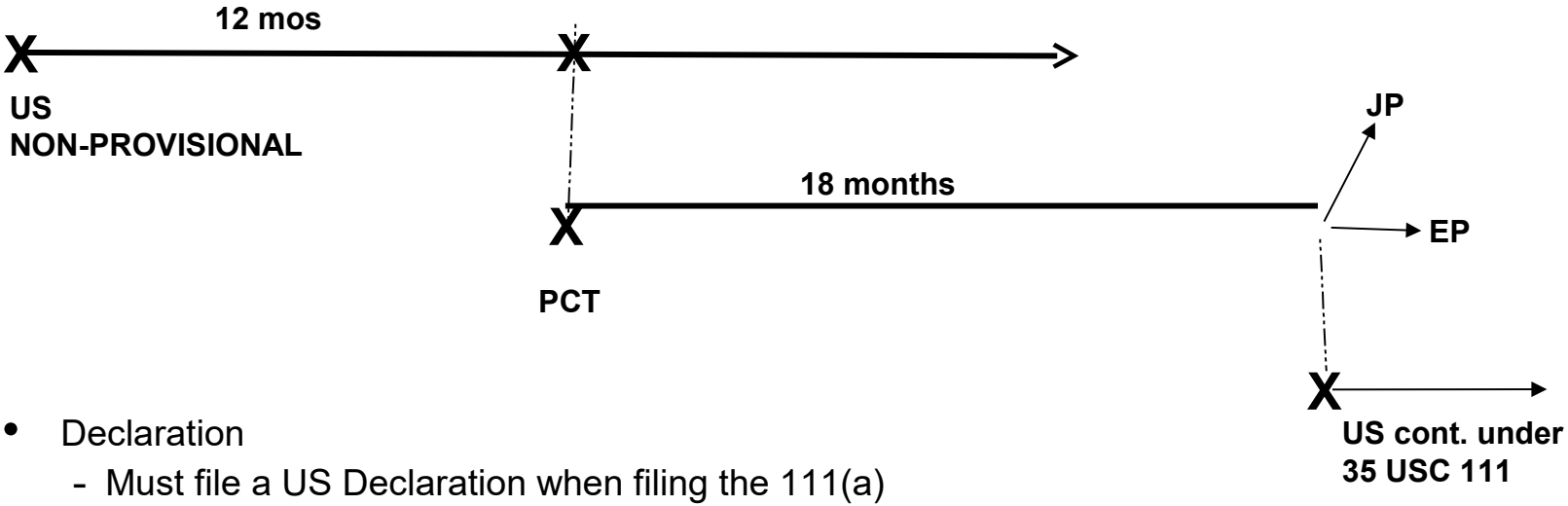
- **National Phase Entry**



- 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
- 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)
- 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 added information in “designations” when filing in ePCT
- Fees
  - Can be delayed

300

US Provisional-PCT-371 US National Phase Application

When entering into the US from the PCT-Provisional Priority

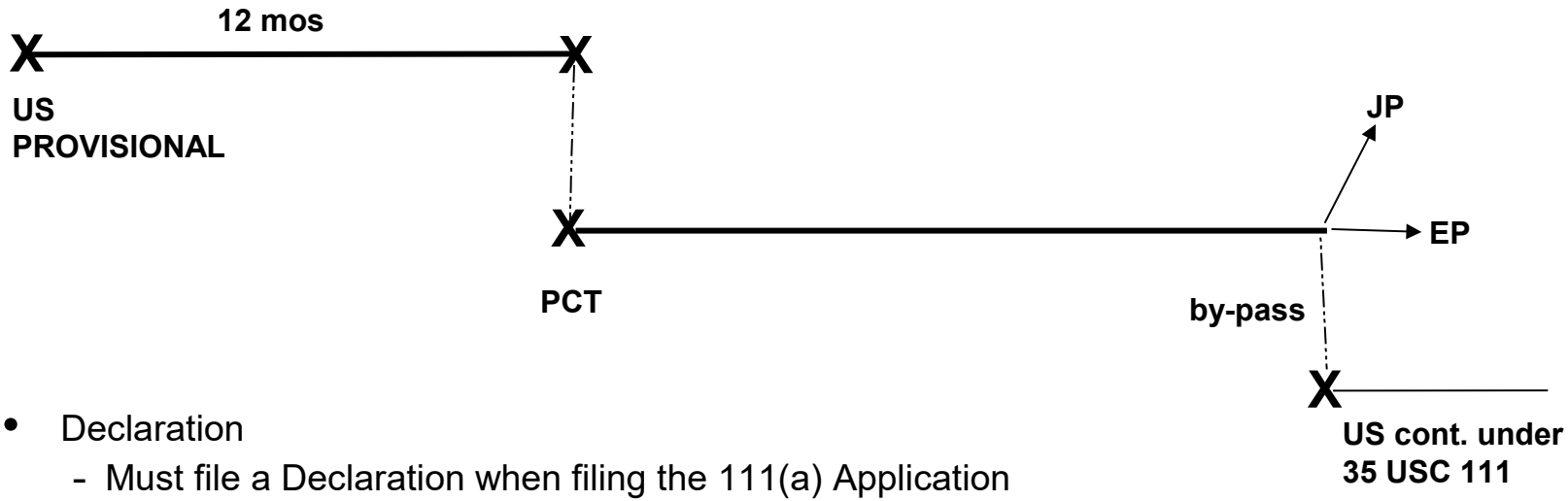
- **National Phase Entry**



- 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)
- Must refer to earlier application in Application Data Sheet, as this claims benefit of earlier US application
- Fees
  - Can be delayed

US Provisional-PCT-US Continuation (bypass) Application

- **By-Pass**



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

PCT FILING BY FOREIGN ENTITY

- 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:

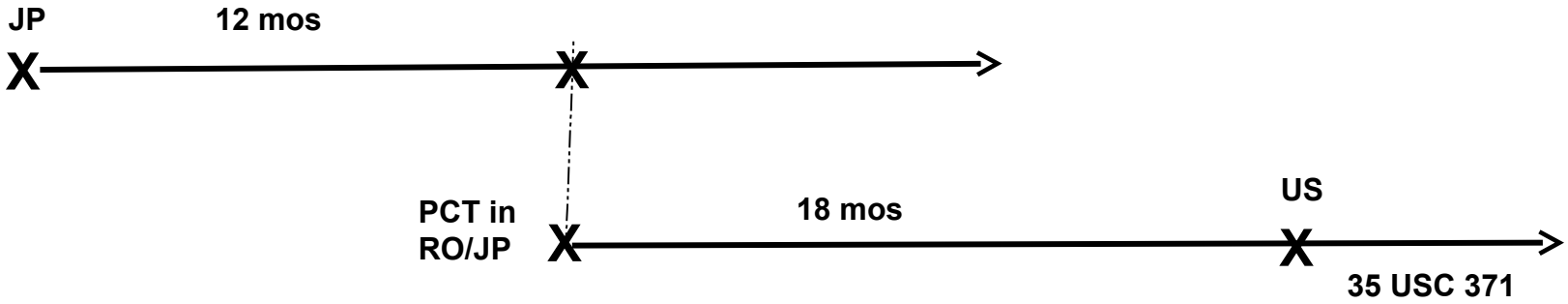
☐ all items ☐ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* *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))*:

. . . . . .

FILING IN US – FOREIGN PRIORITY AND PCT

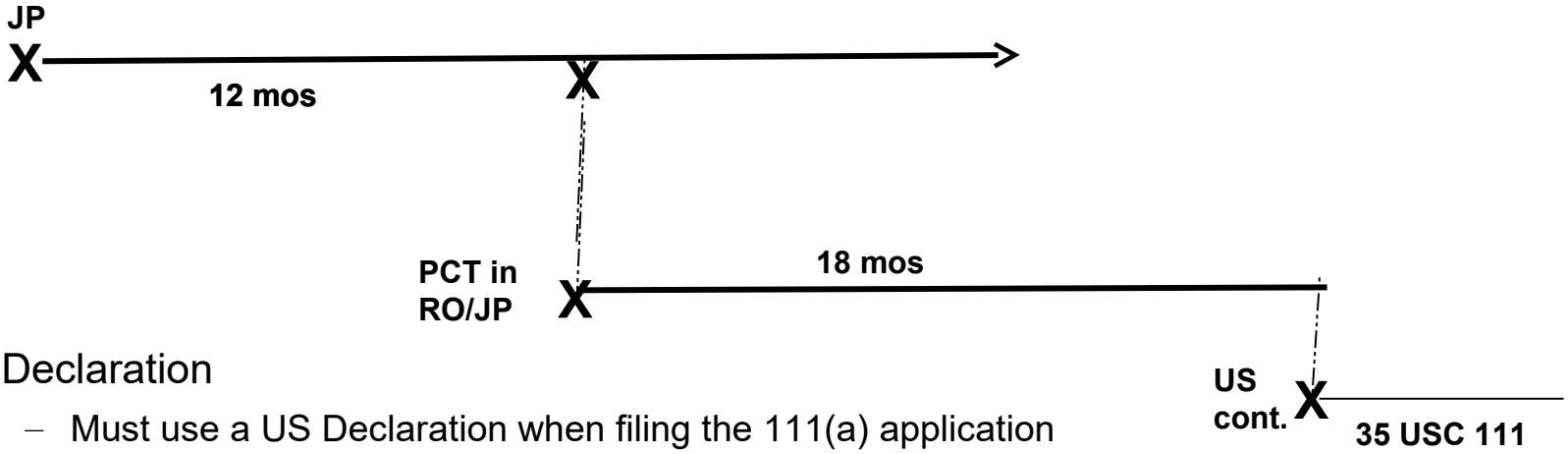
National Phase Entry



- 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
- Must claim Foreign Priority under 35 USC. 119(a)-(d) and indicate continuaton 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)

SUMMARY

- 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 CIPs) under 35 USC 120 and 365(c).

CONCLUSION

- 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

FOR MORE INFORMATION

- 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

UTILITY MODELS

- 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

ALTERNATIVE IP RIGHTS

- Design Patents
- Utility Models
- Trade Secrets
- Inventor’s Certificates

WIPO | PCT
The International Patent System

An Overview of ePCT

Matthias Reischle-Park
WIPO – AIPLA 21st Annual PCT Seminar, July 2017

ePCT Overview

- Getting started http://pct.wipo.int/ePCT
- Access to ePCT with and without strong authentication
- ePCT-Filing
- eOwnership of PCT applications
- eHandshakes, sharing/removal of access rights
- Features and functions
- Future developments

WIPO | PCT
The International Patent System

What is ePCT? (1)

- Online portal that provides PCT services for both applicants and Offices (pct.wipo.int)
- User interface available in all PCT publication languages
- Provides secure and direct interaction with PCT applications maintained by the International Bureau
- Applicants can conduct most PCT transactions electronically with the International Bureau
- ePCT-Filing - Web-based filing of PCT applications

WIPO | PCT
The International Patent System

What is ePCT? (2)

- Receiving Offices, International Searching Authorities, and International Preliminary Examining Authorities have access to PCT applications via secure ePCT Office accounts

WIPO | PCT
The International Patent System

ePCT modes

- Single WIPO User Account (username and password) required to access ePCT
  - https://pct.wipo.int/wipoaccounts/ePCT/
- ePCT **without** strong authentication
  - Limited functionality, document upload
  - Practical alternative to paper and fax
- ePCT **with** strong authentication
  - Additional identity verification
  - Access to full range of services and functions including the creation and filing of PCT applications
  - Access to PCT applications filed as of January 1, 2009, including before publication

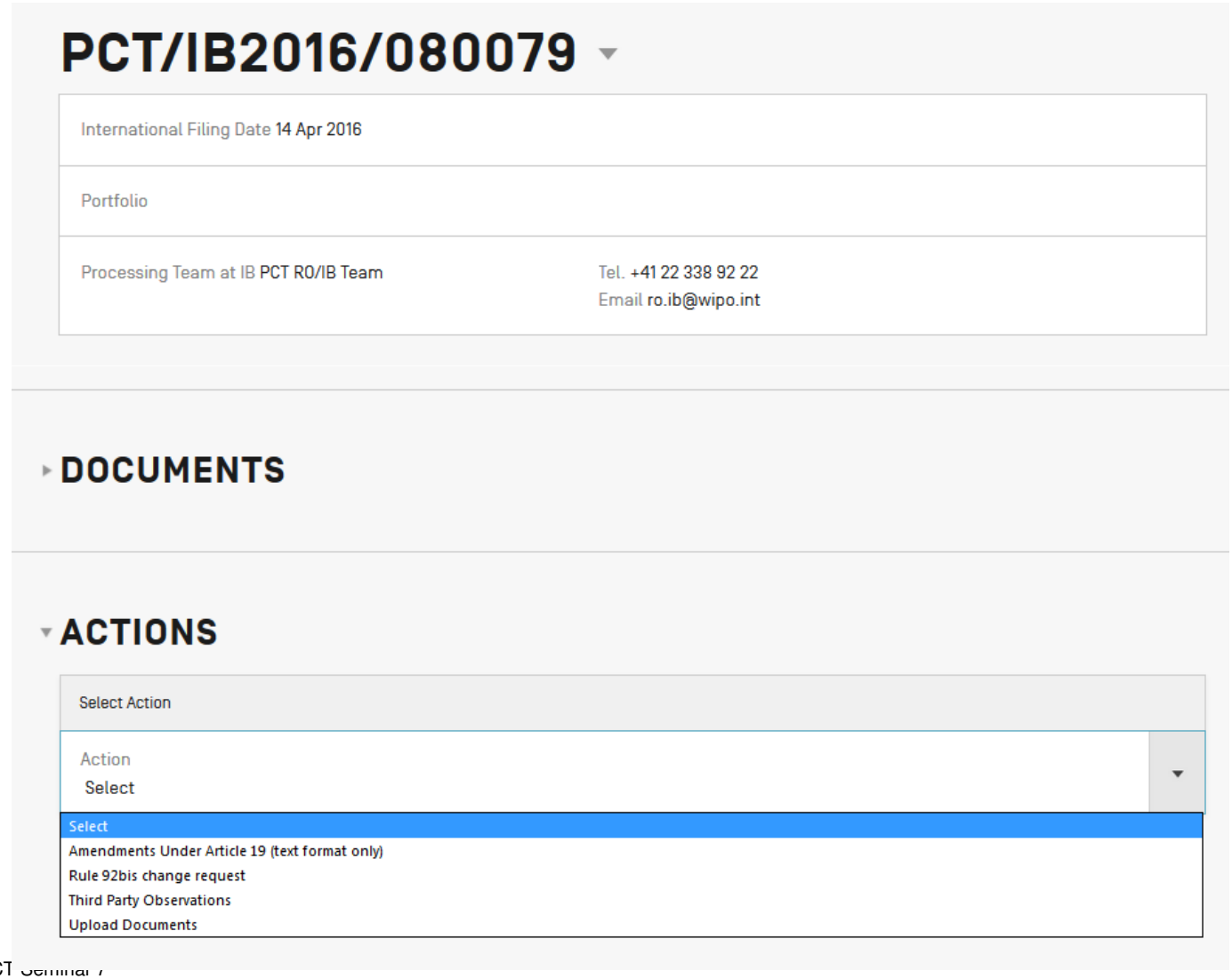
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ePCT without strong authentication

- Upload documents to the International Bureau only
  - PDF format
  - E-mail cannot be used to submit documents
- Submit Actions
  - Rule 92*bis* action for published PCT applications
  - Article 19 amendments
  - Third party observations

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ePCT without strong authentication - Actions



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ePCT with strong authentication

- Additional identity verification
  - Authenticator app with one-time password
  - SMS text with one-time password
  - Obtain/upload a “supported” digital certificate

WIPO | PCT
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Digital Certificates

- Choice of “supported” certificates
  - WIPO digital certificate
  - EPO digital certificate (smart card)
  - JP SECOM digital certificate
- Note: USPTO digital certificates are NOT supported

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The International Patent System

WIPO Digital Certificate (1)

- A small electronic file with data that identifies the user (must be installed in your browser in order to authenticate access under strong authentication)
- Supported browsers are Mozilla Firefox (recommended) and Internet Explorer
- Available free-of-charge from WIPO, valid 2 years, renewable
- One-time opportunity to pick up the requested digital certificate (must be done within a week)

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The International Patent System

WIPO Digital Certificate (2)

- Back-up the digital certificate
  - Export and password protect the digital certificate (for details see the ePCT Applicant User Guide) http://www.wipo.int/export/sites/www/pct/en/epct/pdf/pct_wipo_accounts_user_guide.pdf
  - E-mail the digital certificate to yourself and/or save it on a USB stick (keep password safe)
  - Back-up may be required after a browser upgrade or to access ePCT with strong authentication from a different PC or browser

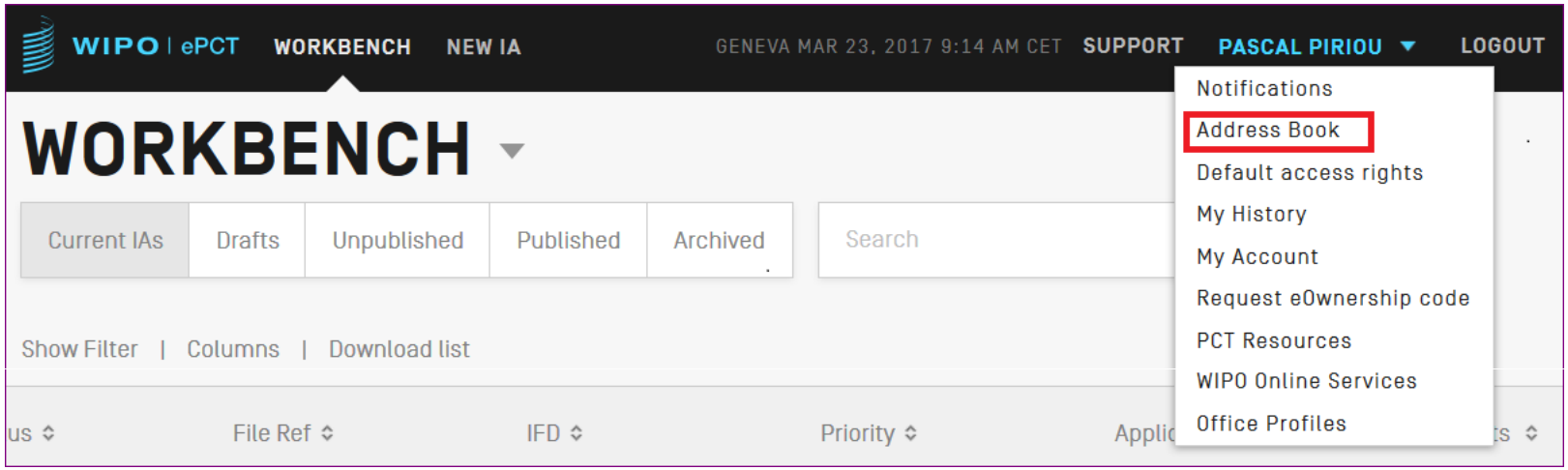
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The International Patent System

Multilingual Address Book (1)

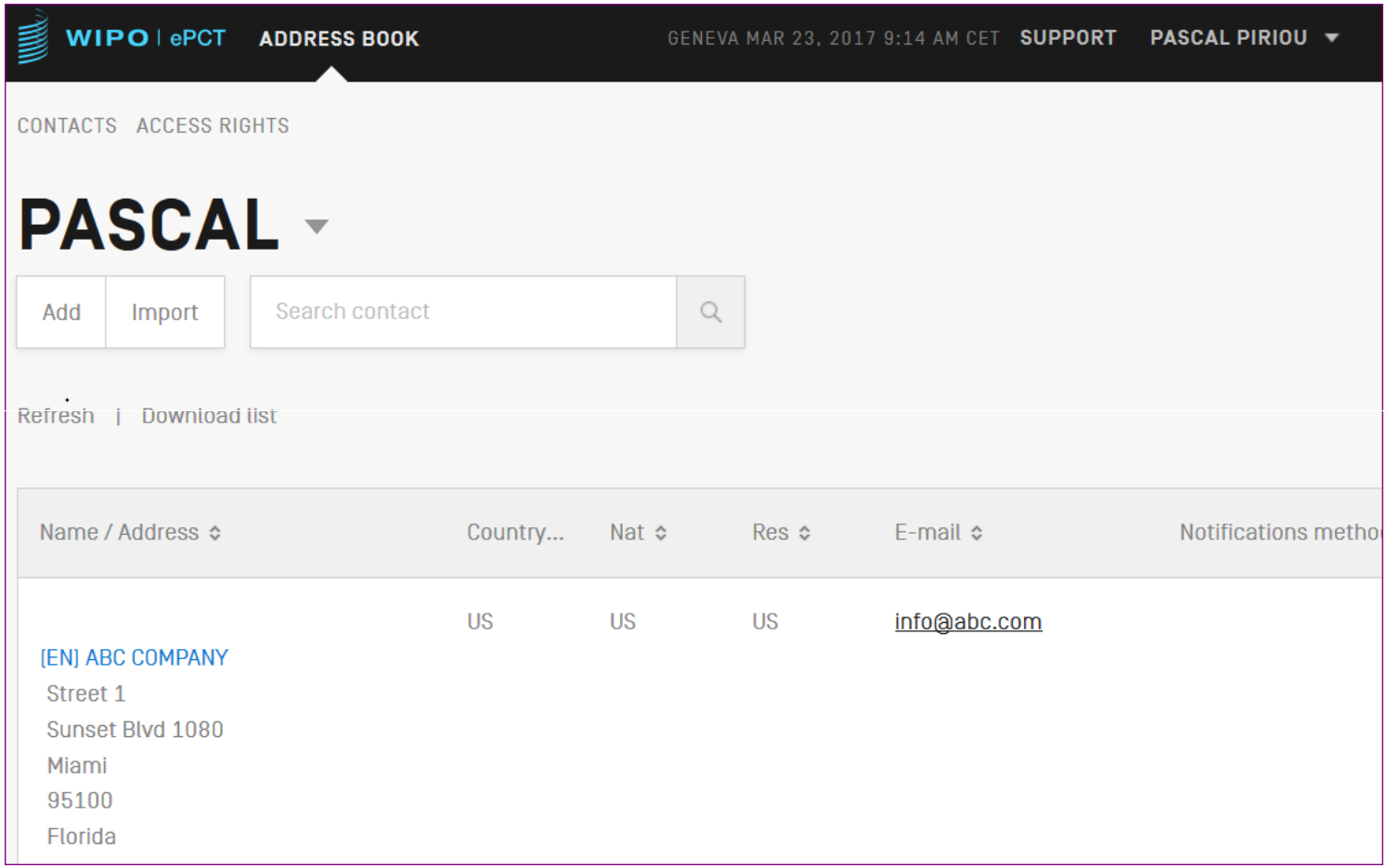
- Record and store contact details of applicants, inventors, and agents
- Possibility to include English transliteration for entries in Arabic, Chinese, Japanese, Korean, Russian
- Import of existing address book (.csv extension) from PCT-SAFE or EPO-OLF software
- Address book sharing based on access rights
  - eOwner (can edit, view and share)
  - eEditor (can edit and view)
  - eViewer (can view only)

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The International Patent System

Multilingual Address Book (2)

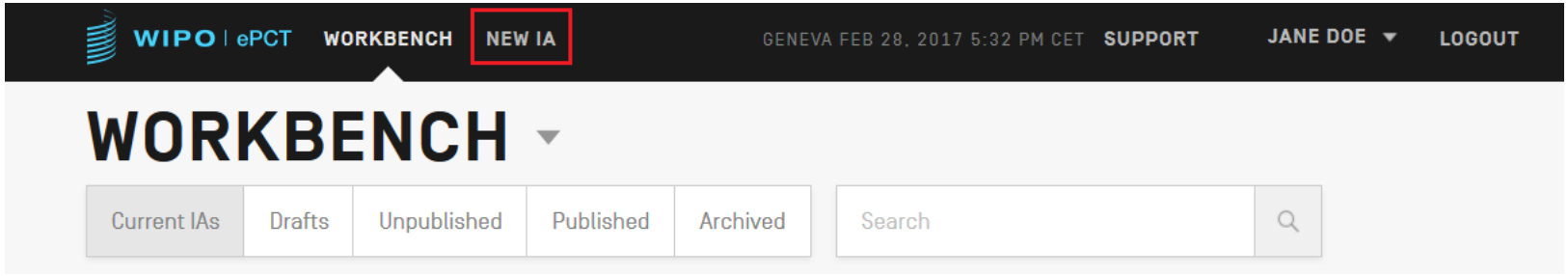


Multilingual Address Book (3)



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ePCT-Filing (1)



- Web-based filing of PCT applications available to all PCT applicants
- Real-time validation of data against the electronic processing system of the International Bureau
- Request form can be prepared in all PCT publication languages

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ePCT-Filing (2)

- Specification in PDF, DOCX or XML formats
  - For PDF format, option for single specification with or without drawings
  - For XML format, single file only
- Application body in DOCX format for conversion to XML using online converter
  - Templates and sample files are available in all PCT publication languages. User guide available in English

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ePCT-Filing (3)

- "Cloning" of PCT applications
  - The bibliographic data of a previous filing under ePCT-New IA (whether already filed or not yet filed) is used as an application template
  - Option to include all data and documents
- Real-time online payment to the International Bureau of filing fees by credit card or by debiting a WIPO Current Account (only for filings with RO/IB)
  - Visa, MasterCard/Eurocard, American Express, Discover, Diners Club
  - Payment can be made at or after the time of filing

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ePCT-Filing (4)

- Accompanying items (not part of the PCT application), for example
  - General correspondence
  - Documents in pre-conversion format
  - Translations for international publication and/or international search
  - Sequence listing for search purposes
- Possibility to make same day corrections
- Download copy of new PCT application before filing (ZIP (multiple PDF) or single PDF)

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eOwnership of PCT applications

- Right to access and manage a PCT application in ePCT
- Process is automatic when using ePCT-Filing
  - Access rights can be assigned prior to filing
  - Users with access rights can access the draft PCT application
- If ePCT-Filing is not used, additional steps are required to take eOwnership
- Default access rights can be set up and automatically applied each time you are confirmed as ‘original eOwner’

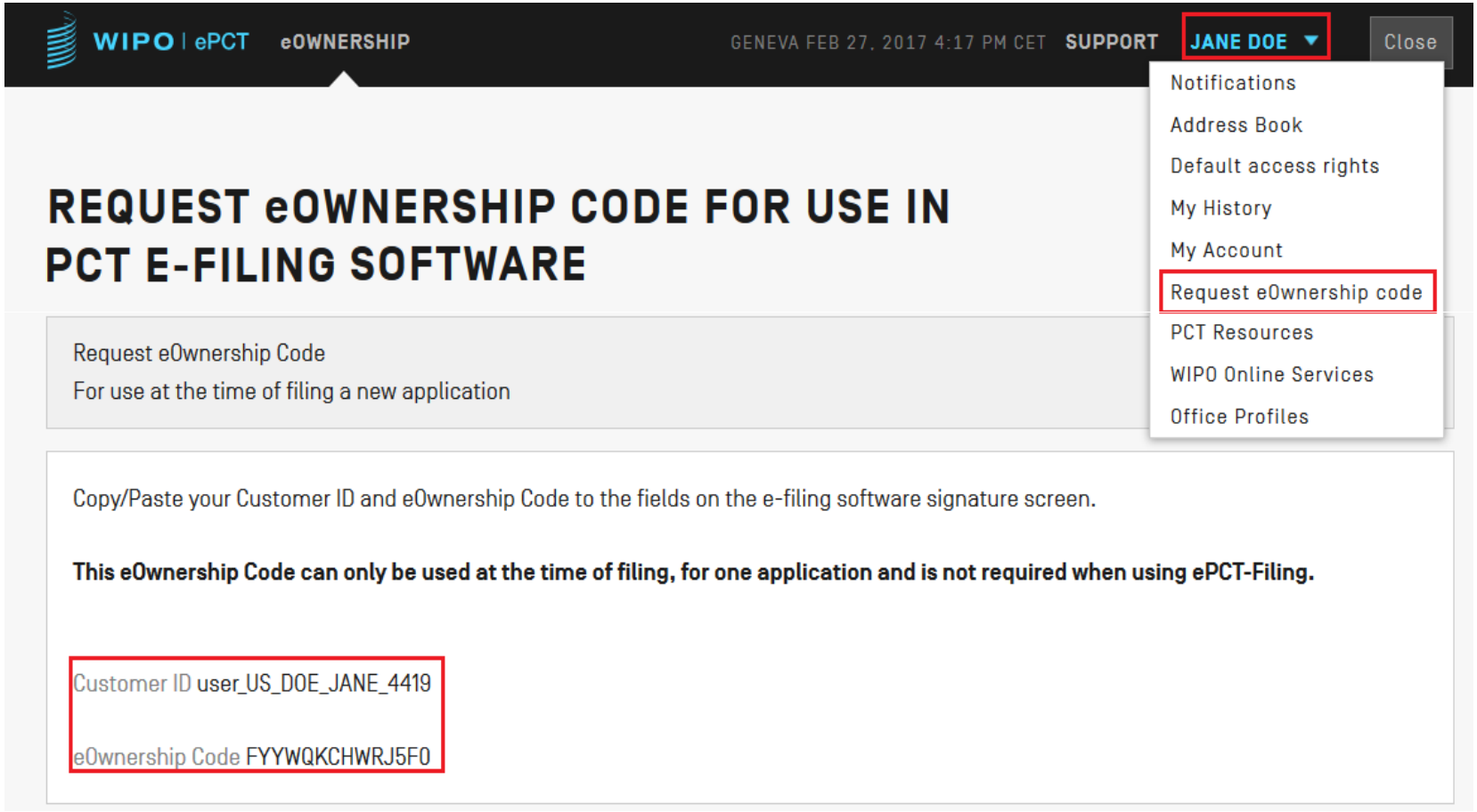
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Taking eOwnership

- Automatic assignment of access rights when using ePCT-Filing
- At the time of electronic filing using PCT-SAFE or the EPO's eOLF/CMS
- Subsequent to electronic filing using a supported digital certificate
- Paper-filed applications or electronically-filed applications with non-supported digital certificate
- Multiple applications

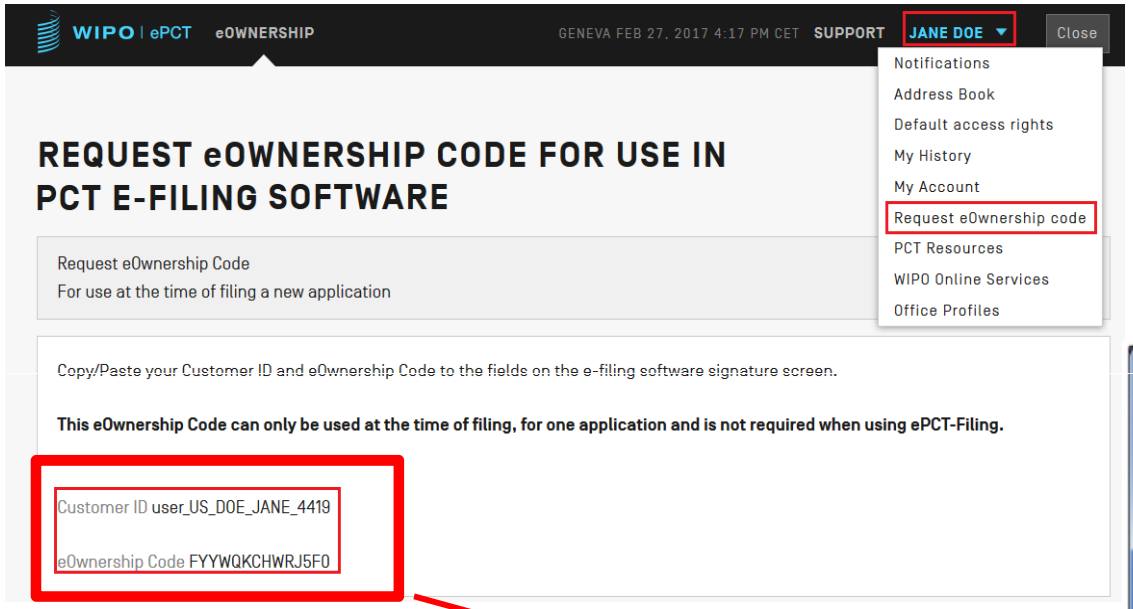
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The International Patent System

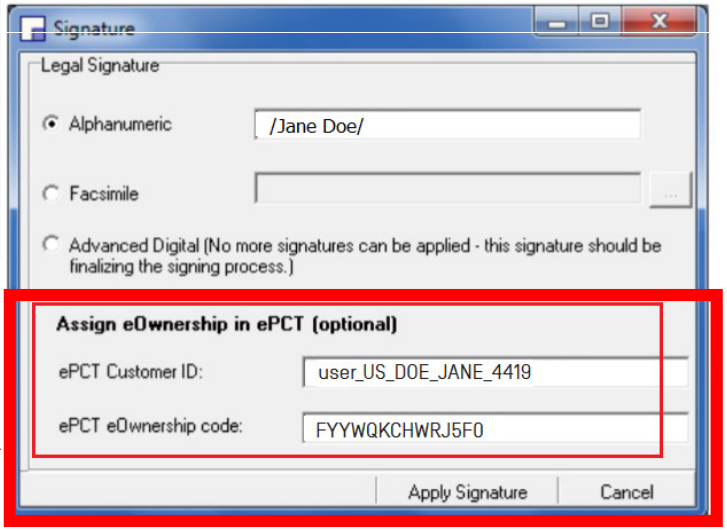
Taking eOwnership
PCT-SAFE or eOLF/CMS electronic filing



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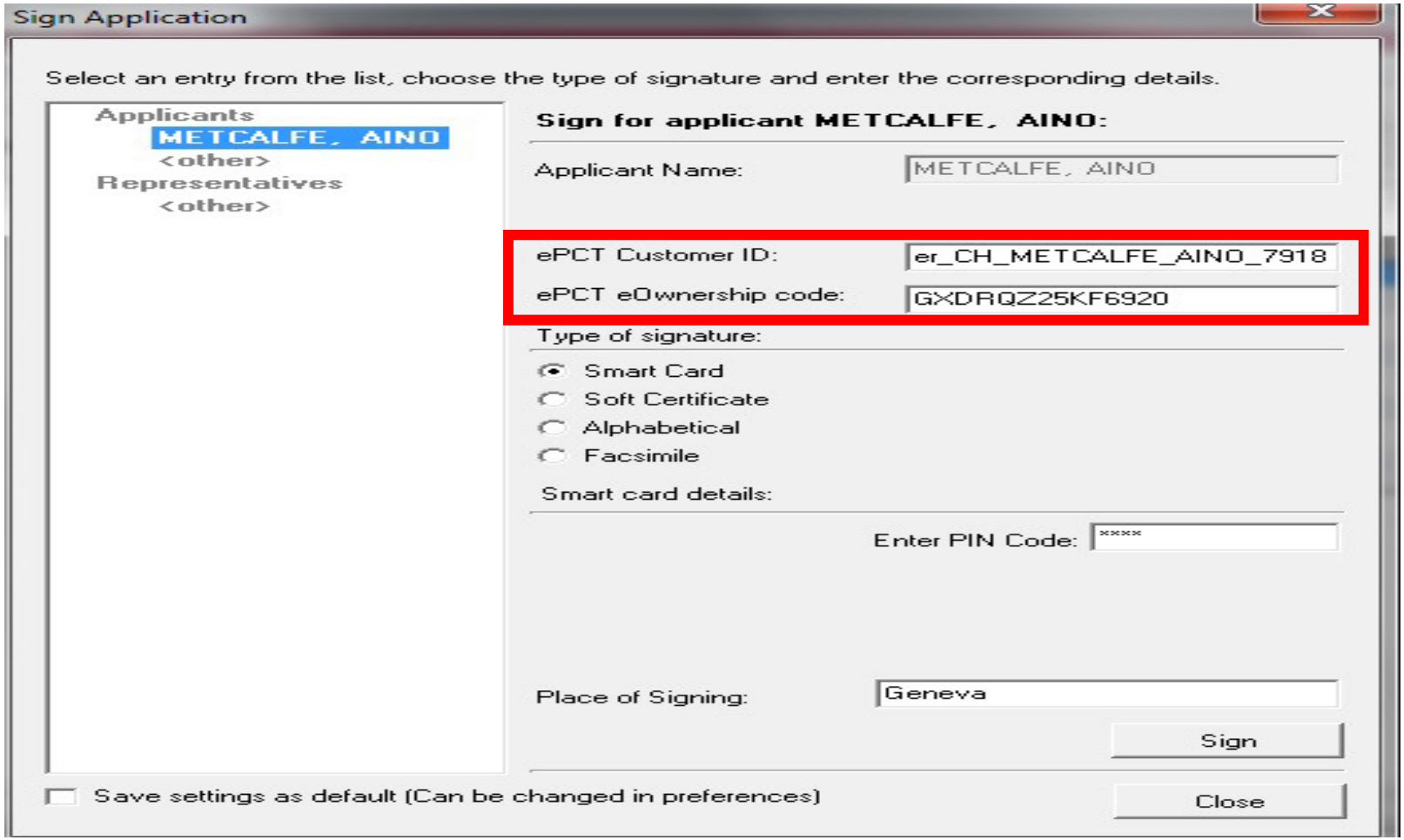
Taking eOwnership
PCT-SAFE electronic filing





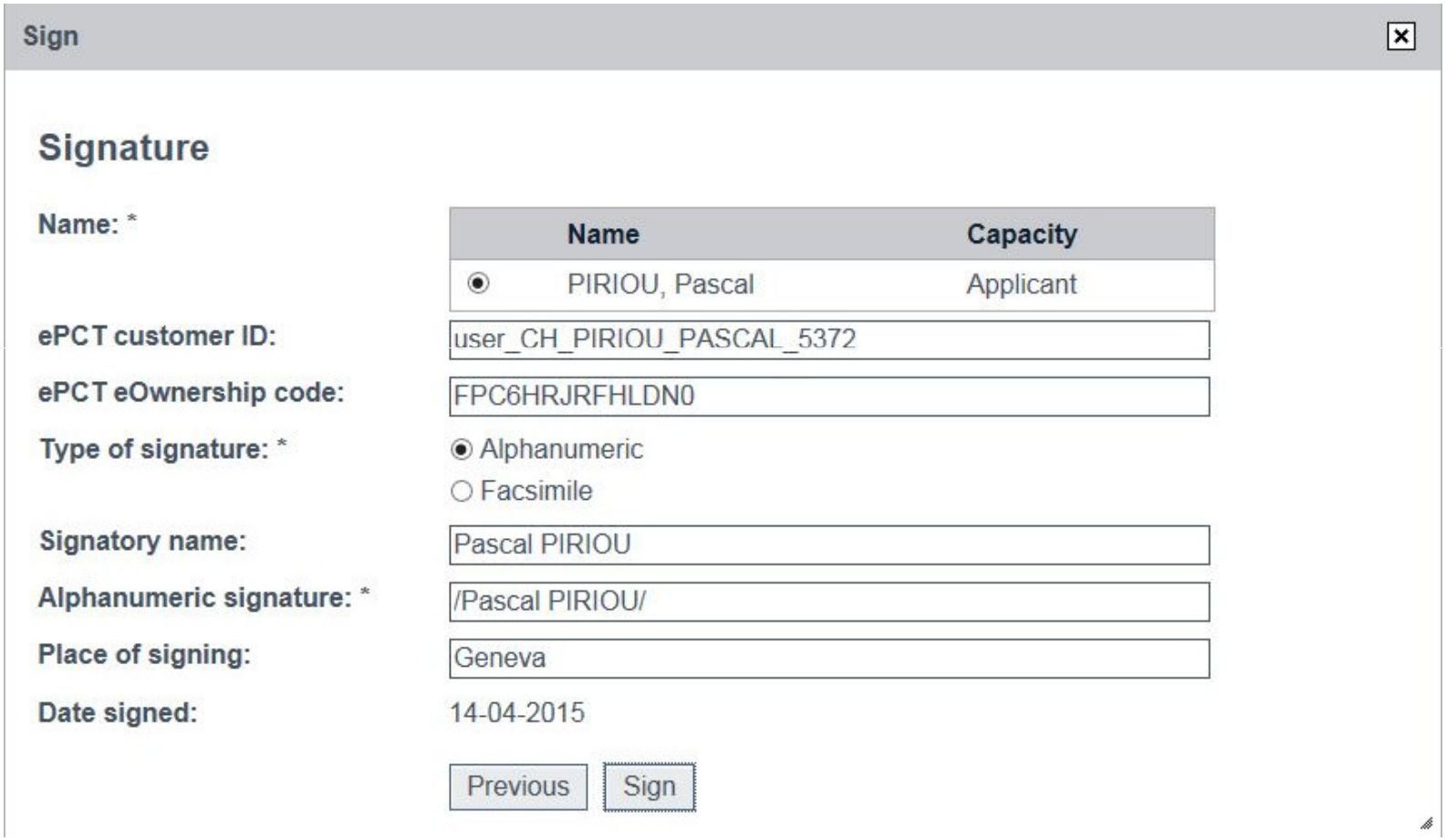
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eOLF electronic filing (EPO)



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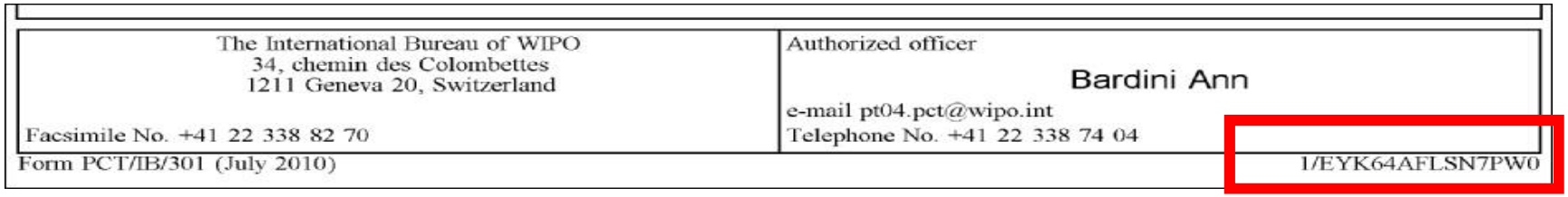
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CMS electronic filing (EPO)



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Taking eOwnership - Subsequent to electronic filing using a supported digital certificate

- Unpublished e-filed applications using a supported digital certificate
  - Both the e-filing and ePCT digital certificates must match
  - Enter the confirmation code in the bottom right-hand corner of Form PCT/IB/301
  - eOwnership automatically assigned



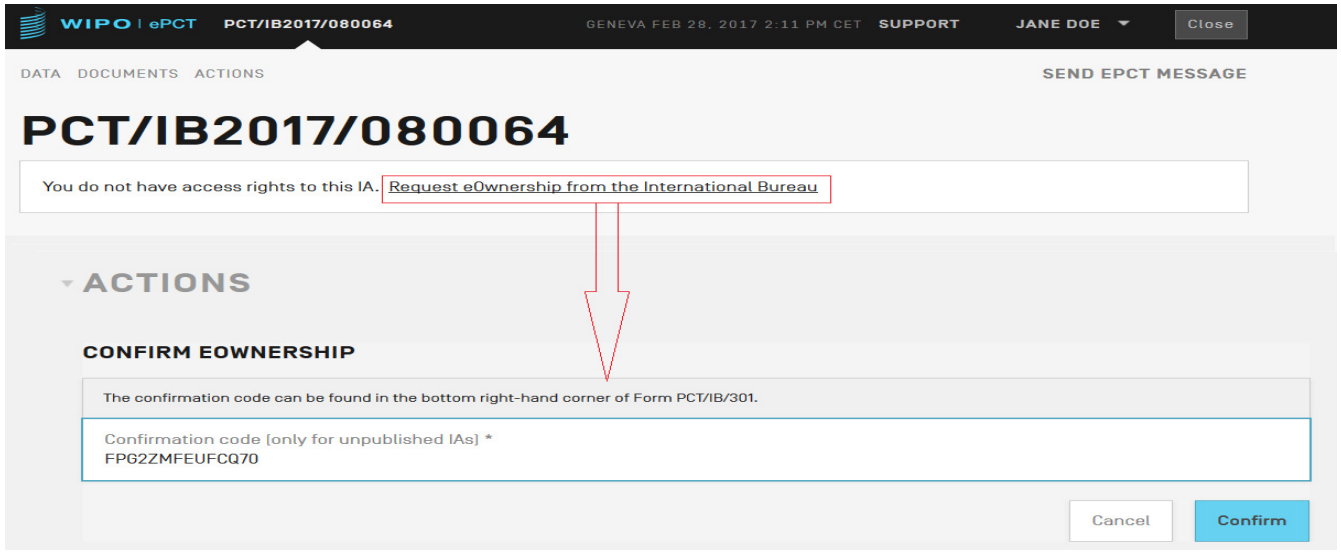
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70	Authorized officer Bardini Ann e-mail pt04.pct@wipo.int Telephone No. +41 22 338 74 04

Form PCT/IB/301 (July 2010) I/EYK64AFLSN7PW0

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Taking eOwnership
Paper or non-supported digital certificate

- Applications filed on paper or with non-supported digital certificate
- Enter Form PCT/IB/301 confirmation code (unpublished applications only)
- Will trigger an on-line form for the International Bureau to approve or reject the request



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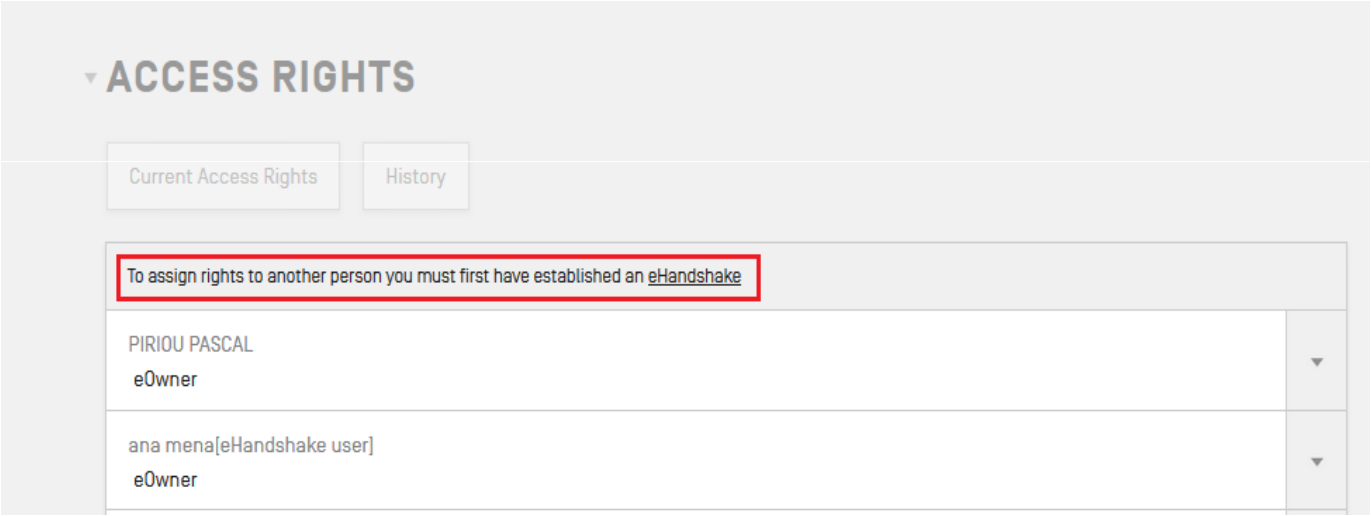
Sharing of Access Rights – eHandshake (1)

- First step in providing access to PCT applications
- Consists in the association and trusted recognition between different WIPO User Accounts with strong authentication
- eHandshakes do not directly result in shared access rights which have to be specifically assigned (default access rights options can be pre-defined)
- eHandshake screen are managed within your WIPO account (select “My Account” from the drop-down menu that appears when you select your name at the top of the screen)

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The International Patent System

Sharing of Access Rights – eHandshake (2)

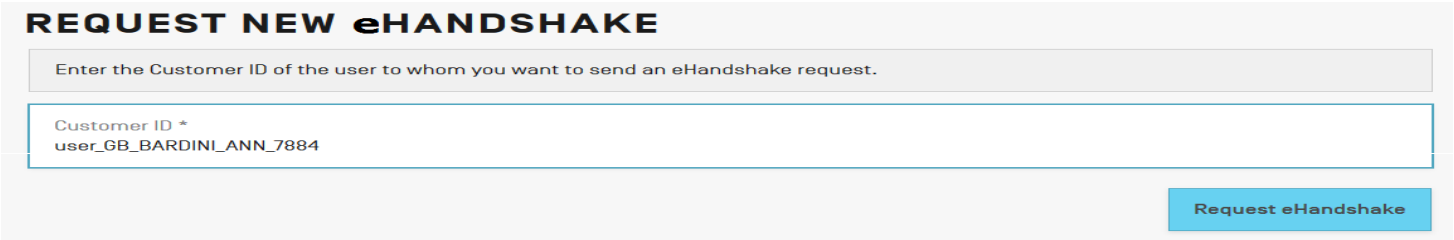
- eHandshake also available in the Access Rights screen of an application, in edit mode



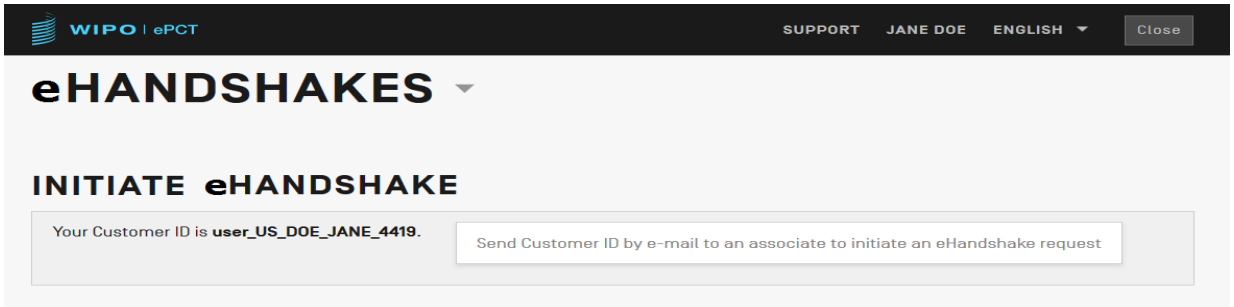
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Sharing of Access Rights – eHandshake (3)

- Request new eHandshake
  - If you know the associate's customer ID, enter it in the corresponding field



  - If you do not know the associate's customer ID, send yours by e-mail so that the associate can initiate the process



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The International Patent System

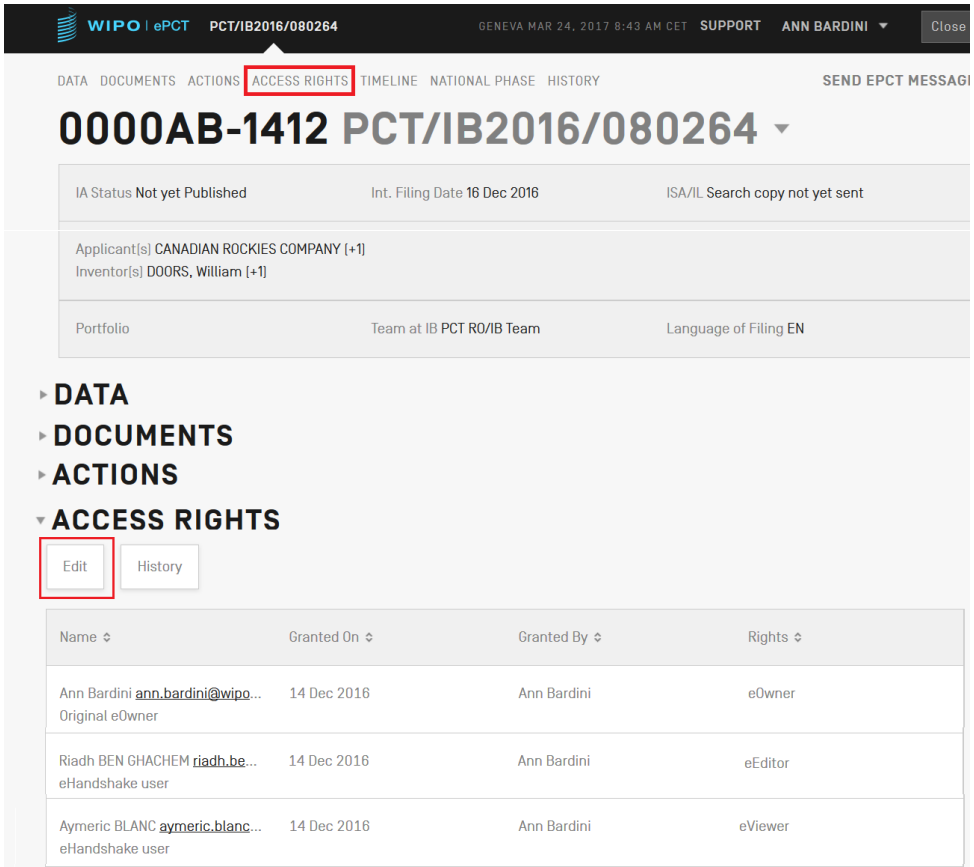
Types of Access Rights

- eOwner
  - Complete control over all aspects of the PCT application in ePCT
  - May be the applicant, agent or other individual (e.g., paralegal, assistant, secretary) who actually filed the PCT application, or another individual to whom access rights were granted by an existing eOwner
- eEditor
  - Can do everything except assign access rights
- eViewer
  - “Look” but don’t “Touch”

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The International Patent System

Assigning + Managing Access Rights (1)

- An eOwner can assign/modify/remove access rights of others via the Workbench (e.g. for multiple applications) or via the header “Access Rights” of each application



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The International Patent System

Assigning + Managing Access Rights (2)

- Access rights can be managed for multiple applications at the same time, including removal of all ePCT access rights for an eHandshake user in one step
- Access rights can be automatically assigned to default list of eHandshake users
- PCT applications should have more than one eOwner to facilitate access rights management and to ensure that at least one user has access to a PCT application
- Access rights should be removed for ePCT users no longer requiring access (e.g., change of applicant, change of agent, departure, etc.)
- Full history of all access rights modifications is available

WIPO | PCT
The International Patent System

Signatures

- ePCT access rights holders (eOwner or eEditor) are different from authorized signatories (applicant or agent)
- Applicant or agent may not necessarily be an eOwner or eEditor
- Applicant or agent signatures are required for ePCT-Filing and other PCT transactions, e.g., Rule 92*bis* changes, filing of Chapter II demand, Article 19 amendments, withdrawals
- Signature fields for the applicant or agent are indicated in ePCT

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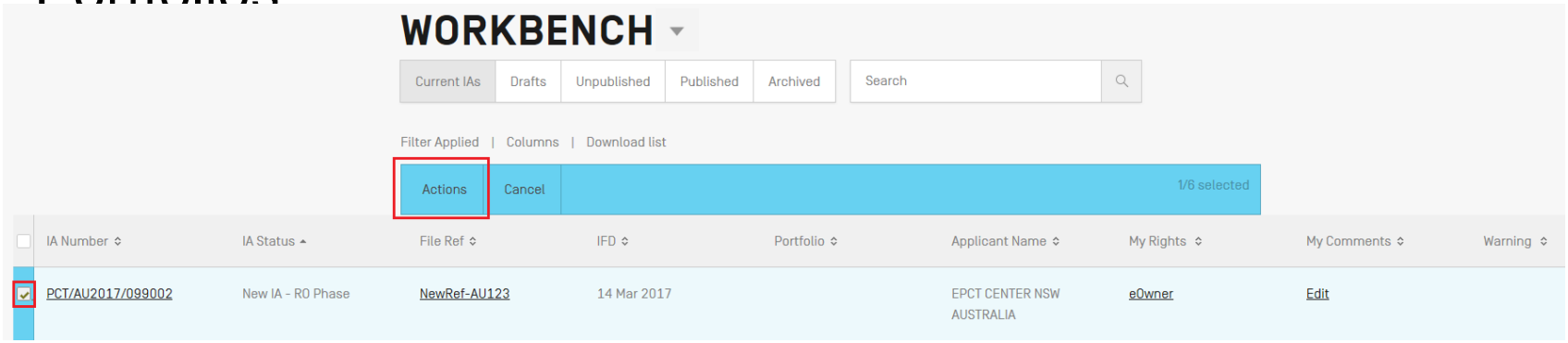
Workbench (1)

- List of all PCT applications to which you have access (eOwner, eEditor, eViewer)
- Many combinations of filters can be applied to the Workbench
- The Workbench contains 5 pre-defined shortcut filter buttons to display applications filtered as per
  - Current IAs
  - Drafts
  - Unpublished
  - Published
  - Archived

WIPO | PCT
The International Patent System

Workbench (2)

- The Workbench columns can be re-arranged by dragging/dropping; customize columns to show/hide
- Workbench list can be downloaded to a spreadsheet
- Select one or more applications to reveal a bar that gives access to functions such as manage access rights, archiving and organizing applications into Portfolios

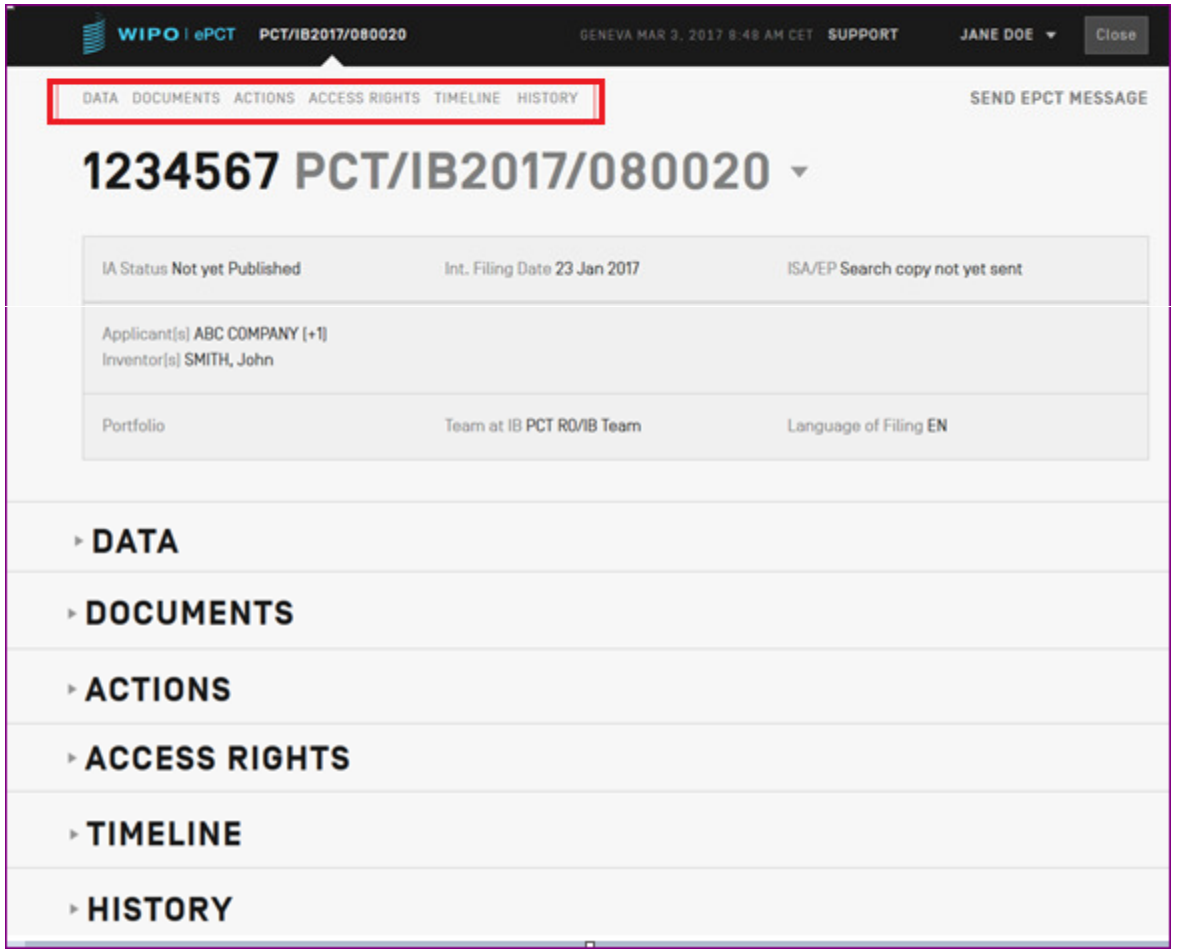


- Clicking on the IA number or file reference will open up a detailed file view

WIPO | PCT
The International Patent System

Viewing a PCT application

- Shortcut links for navigating to each section



WIPO | PCT
The International Patent System

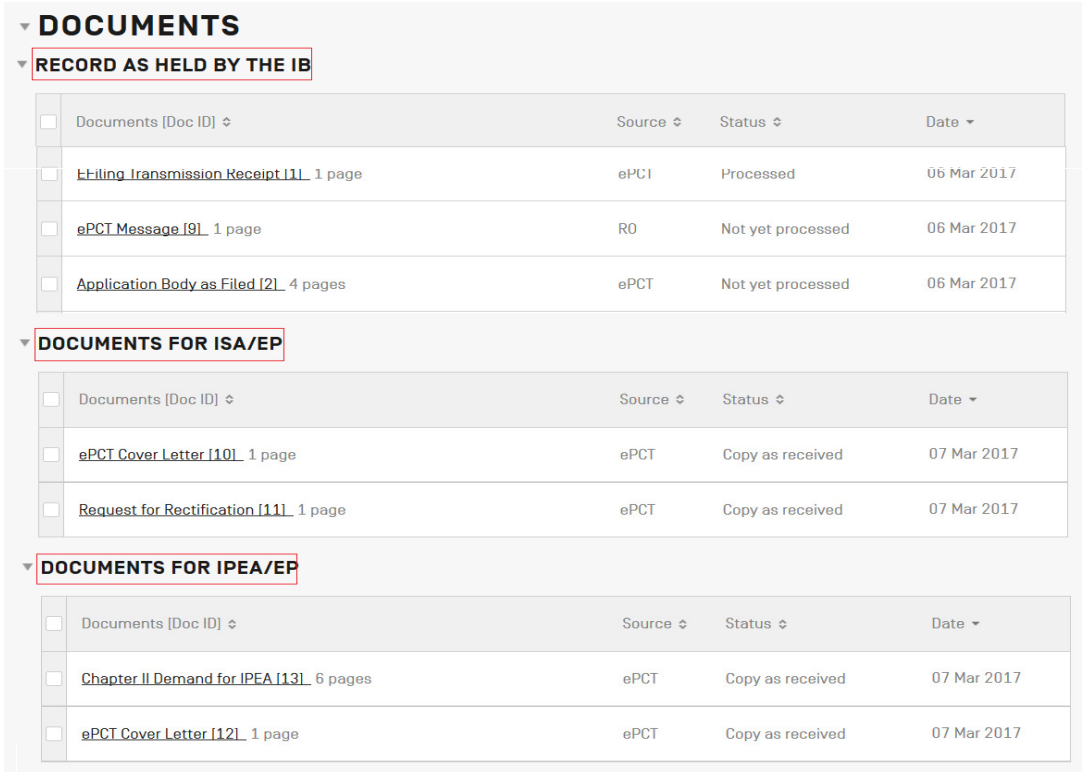
Data

- Up-to-date bibliographic data for the PCT application being viewed and preview in publication front page layout
- Information about the target date for international publication/republication
- Obtain current “IA Status Report” (IASR) in PDF or XML format
- Where the language of filing of a PCT application is in Arabic, Chinese, Japanese, Korean or Russian, bibliographic data is available in those languages in addition to the English transliteration

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Documents (1)

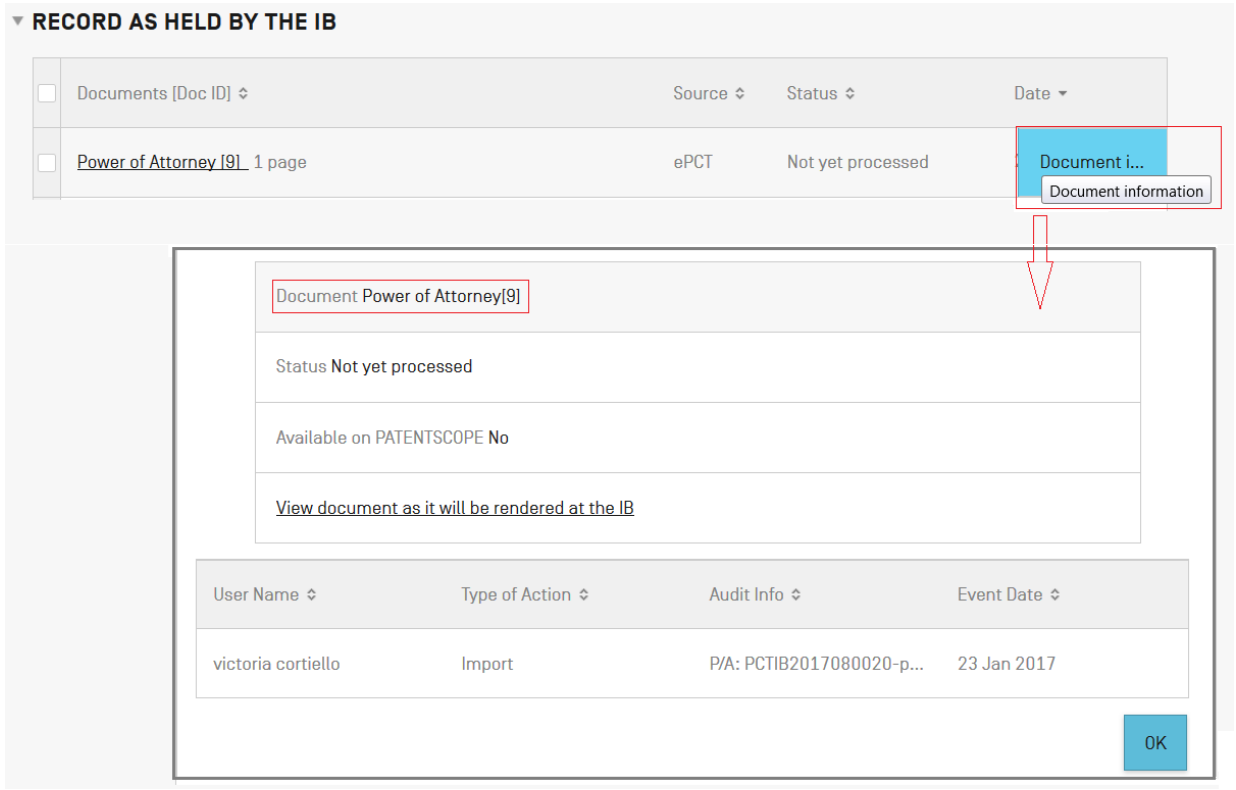
- Access to documents on Record as held by the IB, but also documents submitted to ePCT participating Offices in their capacity as RO, ISA, IPEA



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Documents (2)

- Indications about the status and public availability of each document type, plus audit trail, if available



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Documents (3)

- ‘Upload’ shorcut button to ePCT Action to ‘Upload documents’ (mostly PDF format) to the IB and also to participating Offices in capacity as RO, ISA, IPEA
  - Types of document selectable for upload depend on the recipient selected
- Simple, secure alternative to sending documents by mail or fax
- Current date and time at the *recipient* Office is displayed in the interface and is set as the date of receipt of uploaded documents
- After upload, documents are visible under Documents and the recipient Office is notified by the system

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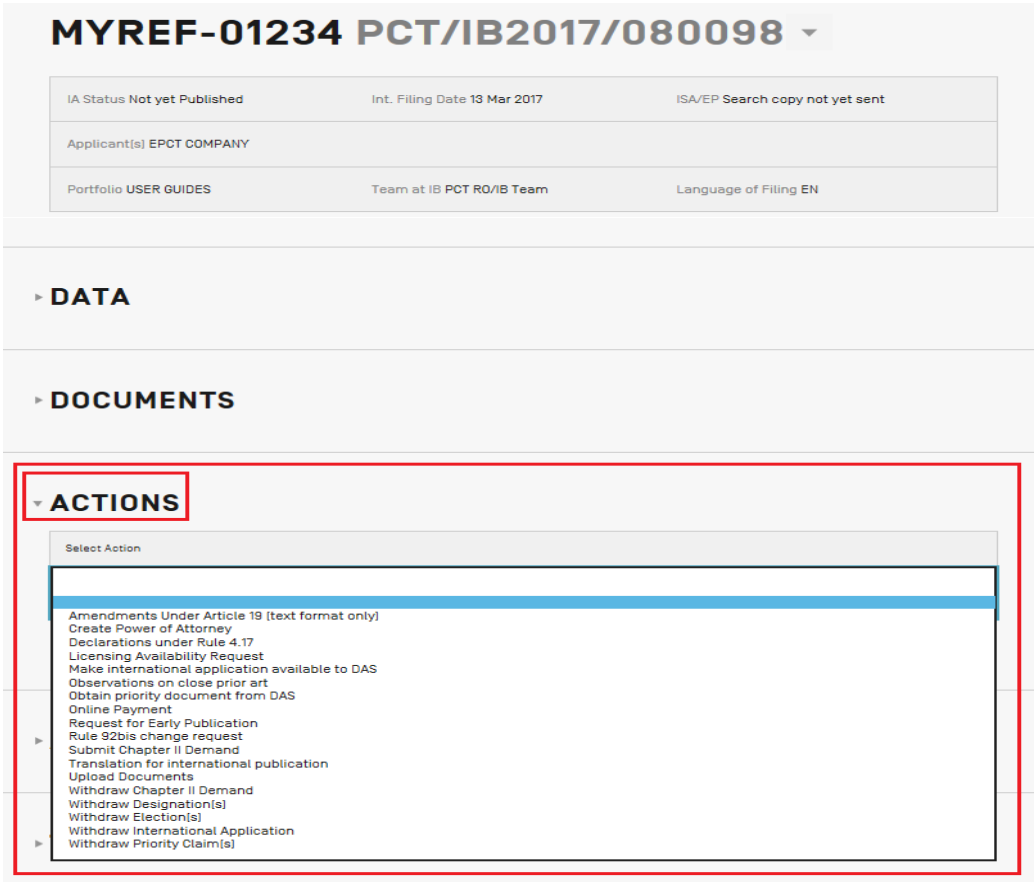
Upload Documents – Priority Document

- Upload of digitally signed priority documents
  - Available only for priority documents issued in electronic format by BR, PT and US

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Actions (1)

- Full suite of Actions only available if signed in to ePCT with strong authentication and with eOwner/eEditor access rights to an application



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Actions (2)

- The user benefits from pre-filled bibliographic data and automated validations to avoid errors; time limit checks
- Data and documents submitted through “Actions” are directly imported for processing with no need for retyping (reduces potential transcription errors)
- “Actions” are subject to review by the recipient (the IB or any participating Offices in capacity as RO, ISA, IPEA)
- “Actions” should be used instead of the equivalent document upload
- Option to save “Actions” as a draft only with strong authentication

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Actions (3)

- "Action" for Article 19 amendments
  - Option always appears but can only be used if the ISR has been received by the IB and time limit has not expired
  - Can only be uploaded in DOCX or text-based PDF format
  - DOCX files converted to XML using online converter (templates and samples are provided)
  - Accompanying letter can be prepared online
- Output of Actions is always rendered in language of publication of the application (regardless of language of interface)

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Time Line

- Date and time in Geneva, Switzerland, is displayed at the top of the screen to facilitate awareness of deadlines
- Graphical representation of PCT time limits
- Summary of key dates
- E-mail alerts for most of these time limits can be set up in Notification Preferences

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History

- List of actions taken by all ePCT users for the PCT application
  - Filter option
- Default view is for the last one week period
- Similar ‘My History’ function is available via the dropdown menu next to your name in the ePCT header which lists only your actions taken in ePCT in repect of any international application

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Notifications

- Preferences
  - Specify the events in the lifecycle of a PCT application for which you want to receive notifications
  - Method (e-mail, Notifications list, or both) and type of notifications
- Filters
  - Received date, read date, unread, date range
- Clearing of notifications from the list
- Only most recent 1000 notifications are saved

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Portfolios

- User-defined, personal ‘virtual folders’ for grouping PCT applications
- Portfolios are basically filters for viewing PCT applications in groups that are meaningful for the user who defines them
- Deletion of PCT applications from a Portfolio or deletion of the Portfolio itself only deletes the virtual grouping, not the applications themselves
- Switch between the Workbench view and Portfolio-based view of your applications

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Future Developments

- Further refinement of the redesigned user interface based on feedback from users of the system
- Extension of ePCT-Filing to other receiving Offices
- Machine-to-machine functionality
- Extend the online payment function to other types of fees for the IB (post-filing)
- User documentation/online help in other languages

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ePCT in DEMO mode

- pct**demo**.wipo.int
- Demo environment in which you can practice and familiarize yourself with ePCT
- Do not use confidential or sensitive data in the ePCT demo environment

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Need help with ePCT – SUPPORT (1)

- Use the “SUPPORT” link in the ePCT header
- PCT eServices
  - Tel: +41-22-338-9523
  - E-mail: pct.services@wipo.int
  - Monday to Friday, 9am-6pm Geneva time

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Need help with ePCT – SUPPORT (2)

- FAQs and user documentation
  - Database of help info
  - On-line Chat (during working hours) available via the FAQ answers
- Webinars on ePCT
  - http://www.wipo.int/pct/en/seminar/webinars/index.html

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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
- the “action” minimizes the duration of suspended access

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 ***not*** a Best Practice
- e-filing to WIPO as an “action” is 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



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




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PATENT AND TRADEMARK OFFICE
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Fixing Mistakes and Best Practices: International and U.S. National Phase Applications

Michael A. Neas
Deputy Director
International Patent Legal Administration

UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

No Request form

- An international application was filed with the RO/US via EFS-Web without a Request form
- Can this mistake be fixed?
  - Where there is no indication as to the nationality or residency of the applicants
    - The USPTO will treat the submission as an international application, but will transmit it to RO/IB under Rule 19.4(a)(i)
  - The EFS-Web software now provides a reminder to attach a Request form when filing a new international application
    - WARNING: New PCT applications filed in the US Receiving office should include an RO/101 request form. If the submission is meant to be a filing for entry into the US National Stage under 35 USC 371, you have incorrectly selected the type of application you are intending to file. Please go back and select the radio button corresponding to US National Stage under 35 USC 371 under the heading Utility

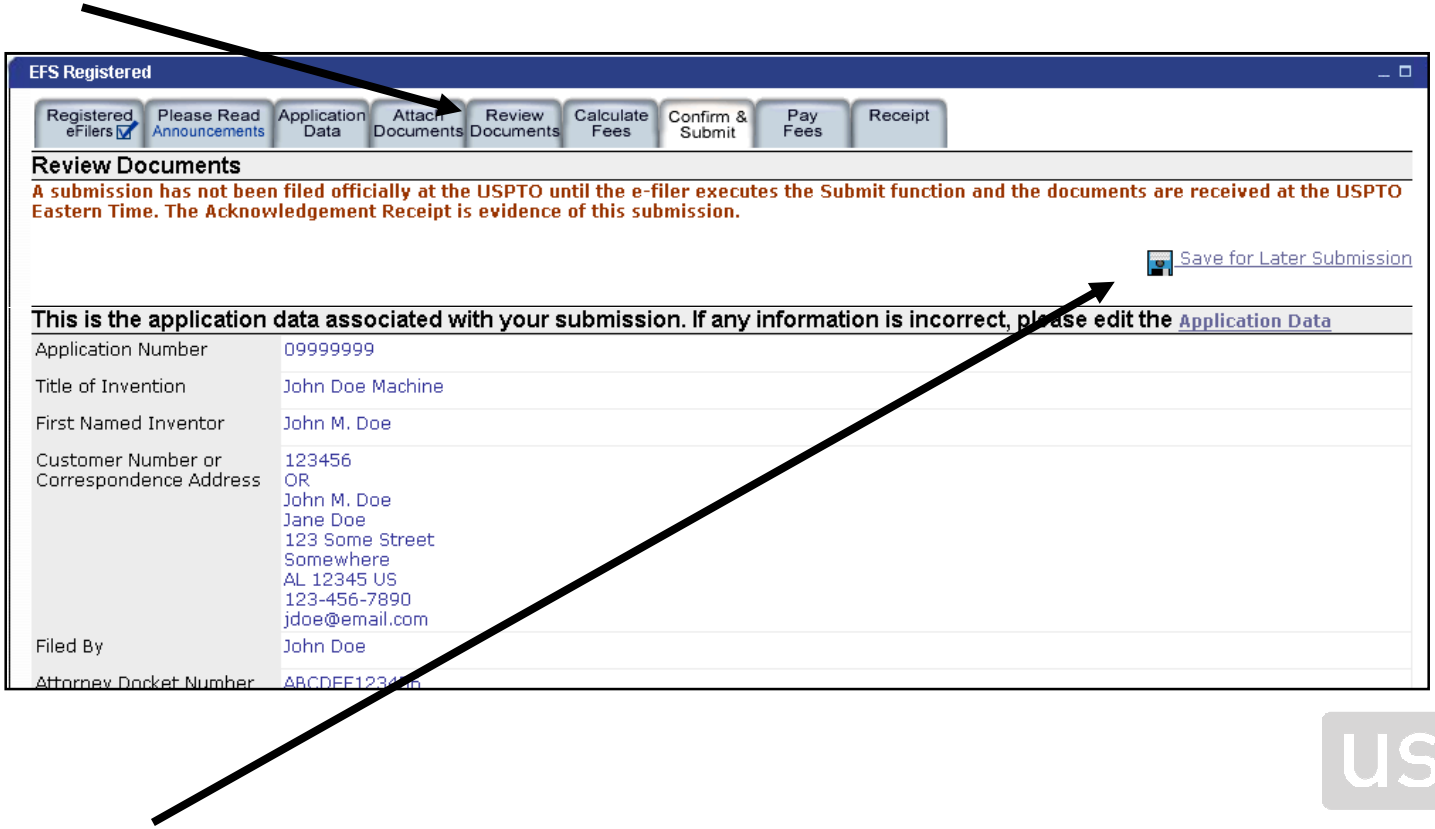
Multiple Request forms

- If filing PCT Safe or ePCT .zip file in EFS-Web
  - Do NOT upload a .pdf Request form
  - .pdf version will be automatically extracted from the .zip file
- Signature missing on the Request in the .zip file
  - Upload the page containing a signature in Box X of the Request as substitute sheet of the Request
    - Post initial submission use document description - Substitute Sheets of Request (Form PCT/RO/101)
- Multiple Requests that are not identical
  - RO/US will generally treat as cumulative
  - Changes will require correction under relevant regulations, Rules 26bis, 92bis, etc.

Missing parts/elements tips (1)

- Avoid omission of documents
  - Review documents prior to submission
    - Recent increase in applications filed with missing elements/parts
      - Use the “Review Documents” and “Save for Later Submission” functions in EFS-Web

Missing parts/elements tips (2)



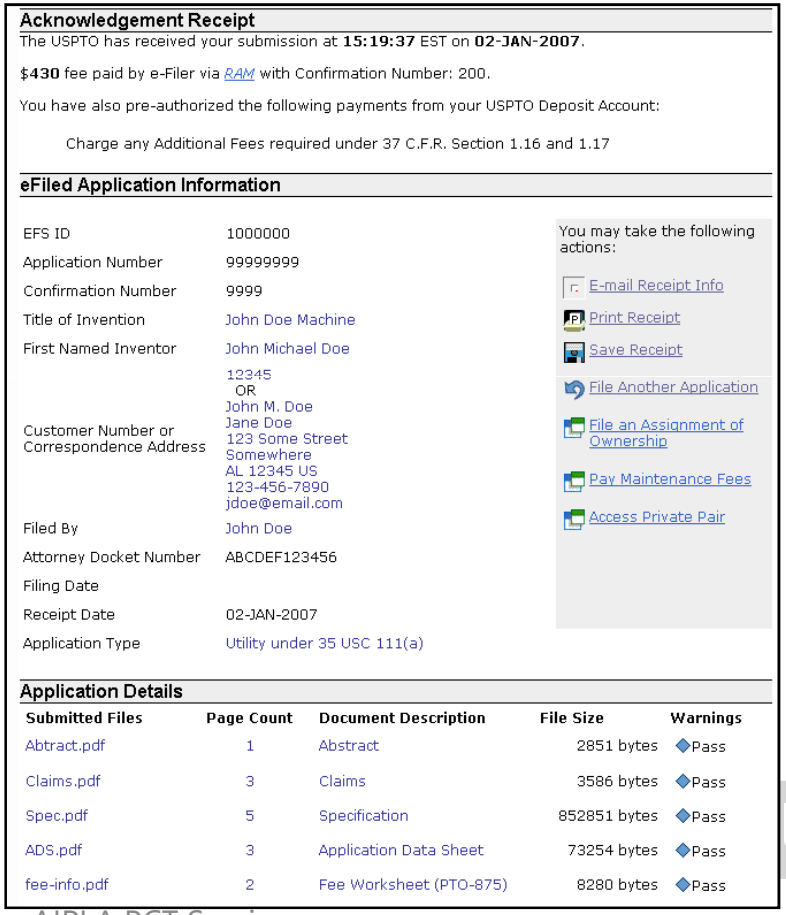
Missing parts/elements tips (3)

- Check for completeness/accuracy promptly after filing
  - Via Electronic Acknowledgement Receipt and Private PAIR
  - Application can be supplemented on the day of filing without adjustment to the IFD
- Only have two months from filing to confirm an incorporation by reference of a missing part/element where the RO does not issue an invitation
  - PCT Rule 20.6
- Respond to Form PCT/RO/107 by confirmation of incorporation by reference
  - Simply providing missing part will change the IFD

Missing parts/elements tips (4)

Check files and page count

Also check PAIR to verify the correct document was submitted



Acknowledgement Receipt

The USPTO has received your submission at **15:19:37** EST on **02-JAN-2007**.

$430 fee paid by e-Filer via *RAM* with Confirmation Number: 200.

You have also pre-authorized the following payments from your USPTO Deposit Account:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 and 1.17

eFiled Application Information

EFS ID	1000000
Application Number	99999999
Confirmation Number	9999
Title of Invention	John Doe Machine
First Named Inventor	John Michael Doe
Customer Number or Correspondence Address	12345 OR John M. Doe Jane Doe 123 Some Street Somewhere AL 12345 US 123-456-7890 jdoe@email.com
Filed By	John Doe
Attorney Docket Number	ABCDEF123456
Filing Date	
Receipt Date	02-JAN-2007
Application Type	Utility under 35 USC 111(a)

You may take the following actions:

- E-mail Receipt Info
- Print Receipt
- Save Receipt
- File Another Application
- File an Assignment of Ownership
- Pay Maintenance Fees
- Access Private Pair

Application Details

Submitted Files	Page Count	Document Description	File Size	Warnings
Abtract.pdf	1	Abstract	2851 bytes	Pass
Claims.pdf	3	Claims	3586 bytes	Pass
Spec.pdf	5	Specification	852851 bytes	Pass
ADS.pdf	3	Application Data Sheet	73254 bytes	Pass
fee-info.pdf	2	Fee Worksheet (PTO-875)	8280 bytes	Pass

Missing parts/elements tips (5)

- Confirmation of incorporation by reference
  - Don’t supply sheets embodying parts not contained in the earlier application
    - Replacement of informal drawings with formal drawings may be a problem
      - Not a “new matter” standard

Filed wrong parts of the IA

- Wrong description and/or claims was attached to an international application filed with the RO/US via EFS-Web
- Can this mistake be fixed?
  - Use of the current version of the PCT Request form
    - Allows confirmation of the incorporation by reference of the missing parts, provided those parts are contained in an application to which priority is claimed
      - Not all designated Offices will recognize incorporation of a description and claims where an erroneous set was originally filed
    - However, there is no simple means for removing the incorrect description and/or claims

Appendices

- There is no provision for appendices in international applications
  - A computer program listing or table must be submitted and paid for as part of the description
  - Unlike the provisions of 37 CFR 1.52(e) for U.S. national applications
  - RO will request clarification from applicant if unclear whether appendix is to be treated as part of the description
    - If part of the description, it will need to be renumbered
    - If not part of the description, will not form part of the IA

uspto

Formal drawings

- Providing drawings compliant with Rule 11 on filing avoids hassles later
  - Invitation from RO to correct (Form PCT/RO/106)
    - Correction may require approval from ISA under Rule 91
    - No amendment to drawings in Chapter I
    - May need to wait for Chapter II or national phase in order to amend
  - Prevents national/regional Offices from requiring new drawings based on form
    - PCT Art. 27 – *No national law shall require compliance with requirements relating to the form or contents of the international application different or in addition to those which are provided for in this Treaty and the Regulations.*

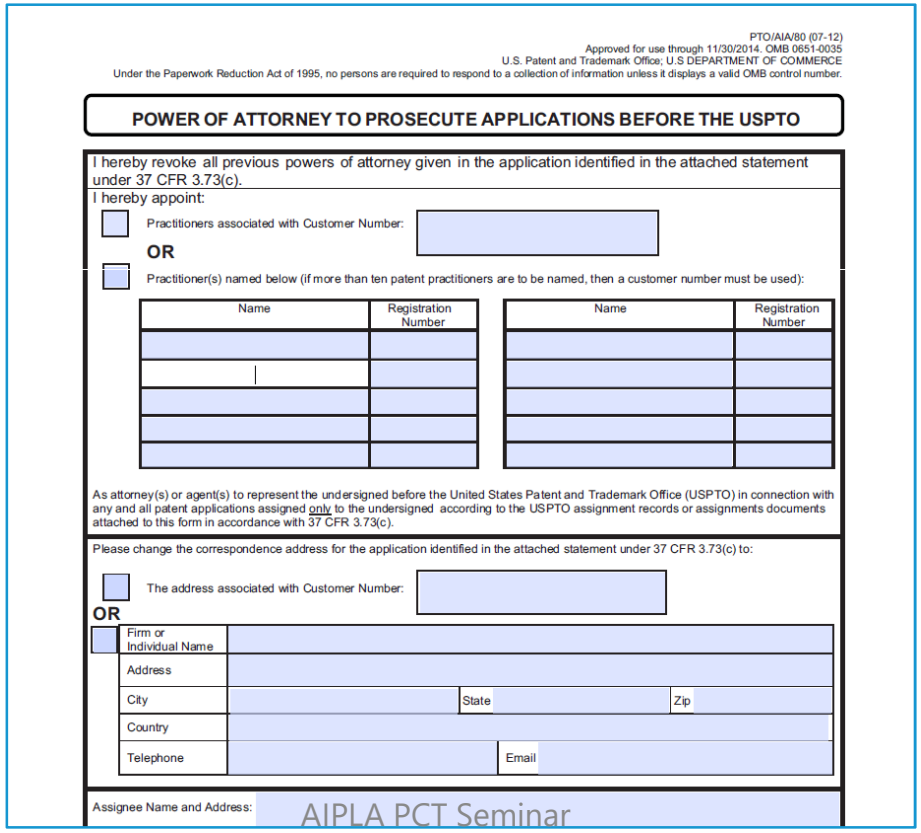
Unintended duplicate filing of an international application in EFS-Web

- Withdrawal of the international application must be signed by all applicants
  - Where withdrawal is signed by an agent, POA is required from every applicant
    - Which includes those designated as “applicant and inventor”

Use of customer numbers in international applications

- Customer number cannot be used in an international application to
  - appoint/withdraw agents
  - establish/change correspondence address
- Customer number associated with an international application
  - is only for access in Private PAIR
  - can be changed with Form PTO-2248

Do NOT Use This Form in International Applications



PTO/AIA/80 (07-12)
Approved for use through 11/30/2014. OMB 0651-0035
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.

POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(c).

I hereby appoint:

☐ Practitioners associated with Customer Number:

OR

☐ Practitioner(s) named below (if more than ten patent practitioners are to be named, then a customer number must be used):

Name	Registration Number	Name	Registration Number

As attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignments documents attached to this form in accordance with 37 CFR 3.73(c).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(c) to:

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name	
Address	
City	State Zip
Country	
Telephone	Email

Assignee Name and Address:

Do Not Use EFS-Web as a Testing Ground

- Use the “sandbox”
- Please do not file test cases
  - Someone has to review these
  - Someone on this panel has done it!



XXXXXXXX XXXXXXX XXXXXXX XXXXXXXXXXX XXXXXXXXXX XXX XXXX XXXXXXX

XXXXX XXXXXXXXX XX XXXXXXX XXXXXXXXXXX

[0001] XXXX XXXXXXXXXXX XXXXXX XXX XXXXXXX XX XXXXXXXX XX X.X. XXXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXX XX, XXXX, XXX X.X. XXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXXXX XX, XXXX, XXXXX XXXXXXXXXXX XXX XXXXXXXXXXX XXXXXX XX XXXXXXXXX XX XXXXX XXXXXXXX XXX XXX XXXXXXXX.

[0002] XXXX XXXXXXXXXX XX XXXXXXX XX XXX/XXXXXX/XXXXXX, XXXXX XXXXXXXX XX, XXXX, X.X. XXXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXXXXXXX XX, XXXX, X.X. XXXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXXXXXXX X, XXXX, X.X. XXXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXX X, XXXX, XXX X.X. XXXXXXXXXX XXXXXXXXXX XX. XX/XXX,XXX, XXXXX XXXXXX XX, XXXX, XXX XXXXXX XXXXXXXXX XX XXXX XX XXXXX XX XXXXXX XXXXXXXXXX XX XXXXXXXXX XX XXX XXXXXXXX XXX XXX XXXXXXXX.

XXXXXXXX XXXXXXX

[0003] XXX XXXXXXX XXXXXXXXXX XXXXXXXX X XXXXXXXX XXXXXXX XXXXX XXX XXXX XXXXXXXX XXXXXXXXXXXX XX XXXXX XXXXXX XXX XX XXXXXX XXXXXXXXXX XX XXXXXXXXX XX XXX XXXXXXXX.

Request MUST Indicate a Sequence Listing (SL) Forms Part of an International Application (IA)

- Failure to identify the SL as part of the IA in the Request
  - May result in a fatally-defective National Stage application
    - Where sequences are not otherwise sufficiently disclosed in the IA
    - Even if the SL was provided on the international filing date (IFD)
- Incorporation by reference (as in a regular U.S. application) is NOT sufficient
  - If present, some national/regional Offices may require removal
- Request – Box IX
  - Check List indicates items that form part of the IA
  - Accompanying Items do NOT form part of the IA

Request – Box IX – PCT SAFE

Parts of the IA

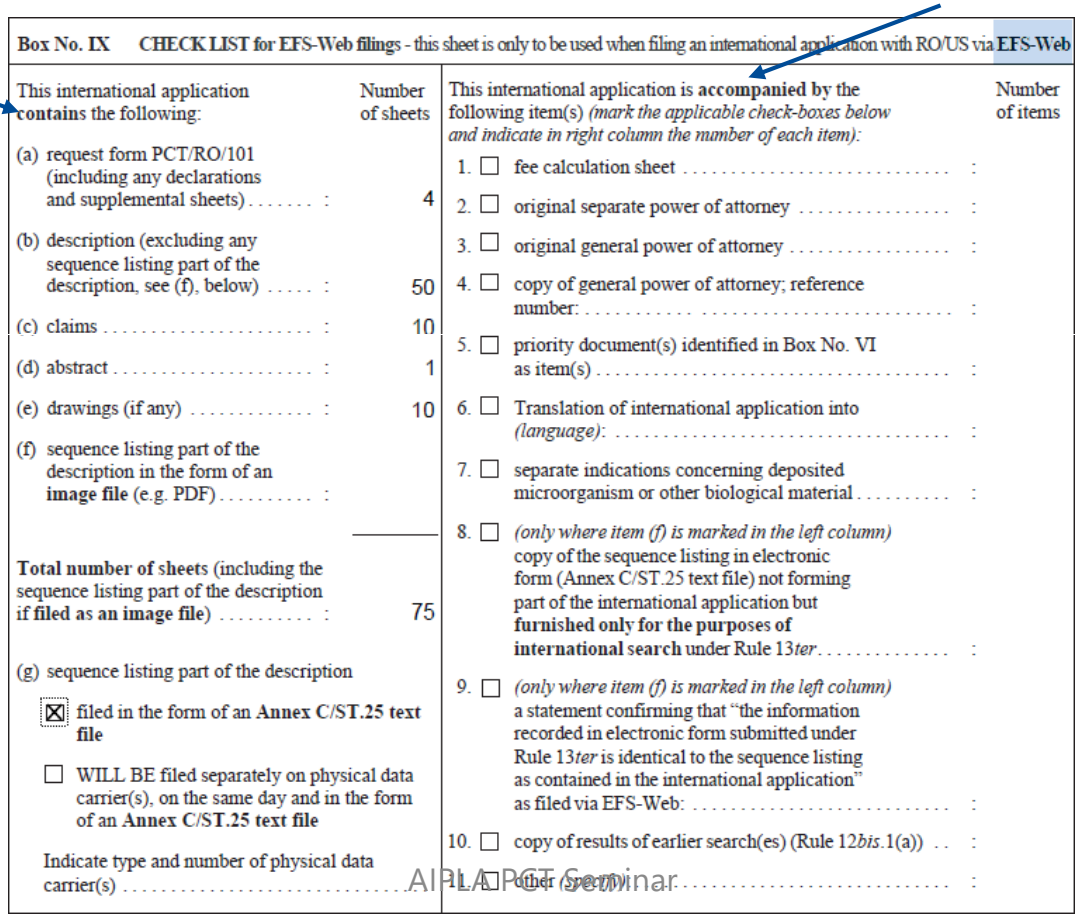
Accompanying items NOT part of the IA

IX	Check list	Number of sheets	Electronic file(s) attached
IX-1	Request (including declaration sheets)	5	✓
IX-2	Description (excluding sequence listing part)	67	-
IX-3	Claims	11	-
IX-4	Abstract	1	✓
IX-5	Drawings	20	-
IX-7a	Sub-total number of sheets	104	
IX-6	Sequence listing part of the description	6	-
IX-7	TOTAL	110	
	Accompanying Items	Paper document(s) attached	Electronic file(s) attached
IX-8	Fee calculation sheet	✓	-
IX-18	PCT-SAFE physical media	-	✓
IX-19	A statement confirming that "the information in Annex C/ST.25 text format submitted under Rule 13ter is identical to the sequence listing as contained in the international application"	✓	-
IX-19	Other	Transmittal	
IX-19	Other	Sequence Listing (TXT)	

Request – BOX IX – PCT/RO/101

Parts of the IA

Accompanying items NOT part of the IA



Box No. IX CHECK LIST for EFS-Web filings - this sheet is only to be used when filing an international application with RO/US via **EFS-Web**

This international application **contains** the following:	Number of sheets
(a) request form PCT/RO/101 (including any declarations and supplemental sheets)	4
(b) description (excluding any sequence listing part of the description, see (f), below)	50
(c) claims	10
(d) abstract	1
(e) drawings (if any)	10
(f) sequence listing part of the description in the form of an **image file** (e.g. PDF)	
Total number of sheets (including the sequence listing part of the description if **filed as an image file**)	75

(g) sequence listing part of the description

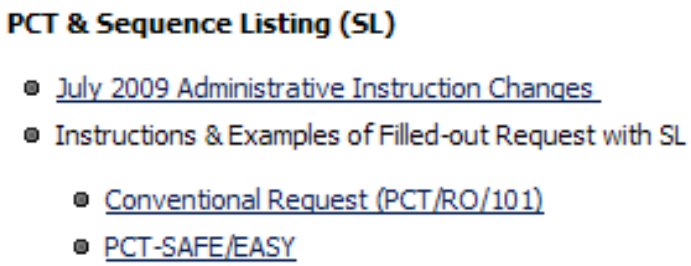
- ☒ filed in the form of an **Annex C/ST.25 text file**
- ☐ WILL BE filed separately on physical data carrier(s), on the same day and in the form of an **Annex C/ST.25 text file**

Indicate type and number of physical data carrier(s)

This international application is **accompanied** by the following item(s) *(mark the applicable check-boxes below and indicate in right column the number of each item)*:	Number of items
1. ☐ fee calculation sheet	
2. ☐ original separate power of attorney	
3. ☐ original general power of attorney	
4. ☐ copy of general power of attorney; reference number:	
5. ☐ priority document(s) identified in Box No. VI as item(s)	
6. ☐ Translation of international application into *(language)*:	
7. ☐ separate indications concerning deposited microorganism or other biological material	
8. ☐ *(only where item (f) is marked in the left column)* copy of the sequence listing in electronic form (Annex C/ST.25 text file) not forming part of the international application but **furnished only for the purposes of international search** under Rule 13*ter*	
9. ☐ *(only where item (f) is marked in the left column)* a statement confirming that "the information recorded in electronic form submitted under Rule 13*ter* is identical to the sequence listing as contained in the international application" as filed via EFS-Web:	
10. ☐ copy of results of earlier search(es) (Rule 12*bis*.1(a))	
11. ☐ other (specify):	

Instructions for Completion of the Request To Indicate That SL Forms Part of IA

- Available on the International Patent Legal Administration home page at: www.uspto.gov/go/pct



National Stage Application Contents

- A U.S. national stage application ("371") continues the prosecution of the IA
  - Contents of the IA determines contents of the 371
- Simply filing a SL on the date of first submission of the 371 DOES NOT make it part of the application
  - Unless the SL was already part of the IA
    - If filed, should be accompanied by a letter explaining its status, e.g., "The sequence listing submitted herewith is identical to the sequence listing forming part of the international application."
  - A SL that was not part of the IA MUST be accompanied by a preliminary amendment to enter it into the 371
    - E.g., SL in text format submitted to the ISA/US in response to PCT/ISA/225
    - See next slide

Preliminary Amendment to Enter a Text Format SL into a 371 Application

- SL in text format only, filed via EFS-Web upon 371 entry
  - Can serve both as part of the application and as the CRF
    - Is excluded when determining the application size fee
- If not part of the IA, MUST file a preliminary amendment, including
  - A statement that SL in text format does not introduce new matter to the IA as of its IFD
  - An indication of support for the amendment in the 371 application
  - An incorporation by reference
    - A separate paragraph added the SPEC that identifies the
      - Name of the file
      - Date of creation
      - Size of the file in bytes
    - As specified in MPEP 502.05 and the Legal Framework for EFS-Web

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

National stage entry error

- A typographical error in the international application number was made on the national stage entry papers or EFS-Web screen
- Can this mistake be corrected?
  - If the correct number appears somewhere in the original submission, applicant may correct this error by filing a petition under 37 CFR 1.182
  - If the correct number does not appear anywhere, applicant may have to file a petition to revive the international application

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
uspto


UNITED STATES PATENT AND TRADEMARK OFFICE
DEPARTMENT OF COMMERCE

WIPO | PCT
The International Patent System

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

Matthias Reischle-Park
WIPO – AIPLA 21st Annual PCT Seminar, July 2017

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

- Objective: Enable inclusion of accidentally omitted elements or parts that are contained in a priority application without affecting the international filing date
  - element = the whole description or the entire set of claims
  - parts = part of the description, part of the claims or part or all of pages of drawings
- Conditions:
  - priority must have been claimed on the original filing date (Rule 4.18)
  - priority application contains the missing 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

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Confirmation of incorporation by reference (Rules 20.6 and 20.7) (1)

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

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

- 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)) (only applicable to missing parts)

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The International Patent System

Invitation by RO to correct defect under Article 11(1) (Rule 20.3) – missing element(s)

Where the entire description or all claims are missing, the RO invites the applicant (PCT/RO/103) to either:

- furnish a correction under Article 11(2):
  - the international application is accorded a later filing date,

or,

- confirm under Rule 20.6(a) that the (missing) element is incorporated by reference under Rule 4.18
  - the date of receipt of the purported international application is maintained as the international filing date

WIPO | PCT
The International Patent System

Invitation by RO to correct defect under Article 11(1) (Rule 20.5) – missing part(s)

Where the receiving Office finds that a part appears to be missing it invites the applicant (PCT/RO/107) to either:

- complete the international application by furnishing the missing part;
  - the IFD changes into the date of receipt of the missing part(s)

or

- confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18
  - the international filing date is maintained

WIPO | PCT
The International Patent System

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

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

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The International Patent System

Declarations of incompatibility with the 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, MX, TR

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The International Patent System

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)

  - Chart of the restoration of the right of priority by ROs and DOs is available on WIPO website at http://www.wipo.int/pct/en/texts/restoration.html

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The International Patent System

Restoration of the right of priority
Applicable criteria

- Two possible criteria for restoration:
  - failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
  - 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 applies the unintentional criterion only
  - RO/IB applies both criteria

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The International Patent System

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 $ 1,700*
    - RO/IB does not charge any fee

* Fee reductions apply to “small entity” and “micro entity”

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The International Patent System

Effects if priority right **is not** restored by RO (Rule 26*bis*.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 (Rule 26*bis*.2(c)(iii))
  - 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

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The International Patent System

Effects of restoration by RO in the national phase (Rule 49*ter*.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
- For declarations of incompatibility with the national law (reservations), see the WIPO website at: www.wipo.int/pct/en/texts/reservations/res_incomp.html

WIPO | PCT
The International Patent System

Reservations made by Offices

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, 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, KR, LT, MX, NO, PH, TR

- Incompatibility as DO (Rule 49*ter*.2(h)):
  BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, NO, PH, TR

See the Table of "PCT Reservations, Declarations, Notifications and Incompatibilities"
www.wipo.int/pct/en/texts/reservations/res_incomp.html

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The International Patent System

Reinstatement of rights by DO/EOs (Rule 49.6)

- 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

WIPO | PCT
The International Patent System

Reinstatement of rights by DO/EOs (Rule 49.6) (3)

- 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

WIPO | PCT
The International Patent System

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

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

WIPO | PCT
The International Patent System

Selecting Countries for National Filing and Global Dossier

WHAT AND WHERE TO FOREIGN FILE

- Evaluate the invention
- Evaluate Countries for foreign filing

- General Evaluation

- Patent Evaluation

- Many companies prepare matrix of product/country for foreign filing

EVALUATING THE INVENTION

- Provide an analysis of the invention:

  - Problem to be solved

  - Previously suggested solutions

  - How the invention works

  - Distinguishing features of the invention

- Identify the type of invention that is being evaluated

  - Is it a basic invention?

  - Is it an improvement invention?

  - Is it an alternate embodiment to an existing invention?

- Determine the relationship between the invention and the client's business
  - Is it directly, peripherally or unrelated to a core business?
  - Is the invention more significant to a competitor's business?
  - What is the amount of time and money to be invested into the invention?
  - What is the anticipated life span of the invention?

- What is the purpose of obtaining the patent?
  - To protect technology from being used by keeping competitors away?
  - To improve marketing positions?
  - To protect customer use of the product or the technology?
  - Is it being filed for defensive purposes to block others from obtaining patents in certain areas?

- Is it for recognition to establish a reputation or credentials?
- Is it for potential use in other business relationships such as:

  joint venture with other companies?

  Licensing (one way or cross licensing?)
- Is it being used to support existing licensing activities?

•Bottom line question; If we don’t get a patent, so what?

EVALUATING POTENTIAL COUNTRIES FOR FILING

- General evaluation of countries
  - Population
  - Market potential
  - Emerging or industrialized country
  - Industry size and growth rate
  - Client's activity within country
- Patent Evaluation of country
  - The standards of patentability in the country
  - The type of patents available in the country
  - The patenting costs
  - Enforceability of patents in the country
  - Strength of the legal system
  - Any bias against foreign plaintiffs?

COUNTRY/INVENTION SELECTION

- Guidance Tools

- Formulas, charts, guidelines

- Must be updated regularly

- Must be tailored for each product

PRIORITIZING COUNTRIES

1. Protect local manufacture
2. Cover competitor's home countries or major investment manufacturing countries
3. Cover major markets
4. Cover export sales

A SUGGESTED SET OF RECOMMENDATIONS

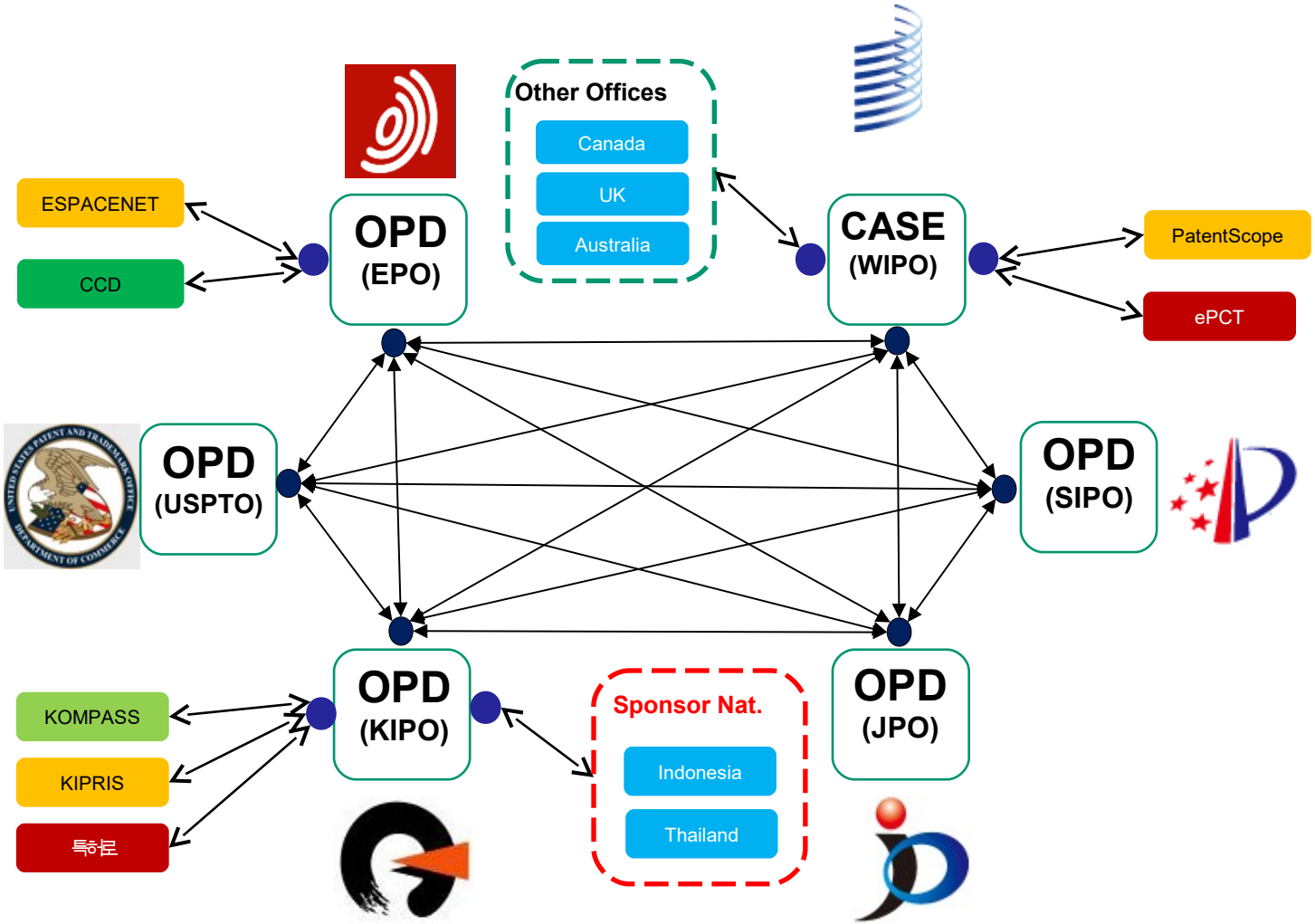
Type of Invention/Product	Recommendation
System, assembly, complex machine	Limited filing in industrialized countries
Components and materials	Broad filing in all major countries
High technology product	Limited filing in industrialized countries and sourcing countries
World-wide consumer product	Broad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

GLOBAL DOSSIER

- Joint project of IP5 Patent Offices and IP5 Industry through a Global Dossier Task Force
- An integrated on-line web portal/user interface between users and all participating offices
- It will allow users to access all available information about all applications and patents in the participating offices, and to utilize the electronic services of the offices
- Each country will have a portal in that country through which users will gain access into the patent data bases of the other participating offices and permit 2-way communication with that participating office
- All information of each Patent office remains on their own server. No single owner of data base. Only access from each portal
- Will included IP5, plus access to WIPO-CASE, and other countries wanting to participate

- Working to make all Country Portals to be able to access same information. No difference which portal you enter
- At each country portal the information will be translated into the language of that country. In US, entering the GD, all information will be available from all patent offices in English
- Will ultimately be available for Examiners, Applicants and third parties. Currently only post publication information will be available. Working on pre-publication information for use by Examiners and Applicants, and only post-publication information available for third parties

Concept Diagram of Global Dossier



USAGE OF PUBLIC PART

- Enter number
- Get family of patents/applications (of participating offices)
- Select one country (if part of GD)
- Get Table of Contents of documents in filewrapper of that country
- Select document(s) and get actual contents of filewrapper e.g. Office Action
  - Provides classification information, and all citations
  - All translated into portal country language

POTENTIAL ADVANTAGES

- To Examiners
  - Facilitated Worksharing
  - Improve Quality
  - Increased uniformity and potential harmonization
- To Applicants
  - Monitor portfolio
  - More uniformity in patent coverage
  - Reduce litigation risk of inconsistent arguments
  - Reduce ID5 burdens
  - Reduce costs
- To Third Parties
  - Facilitate searching
  - Reduce litigation costs
  - Ease due diligence opinions
  - Reduce translation burdens


UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

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)

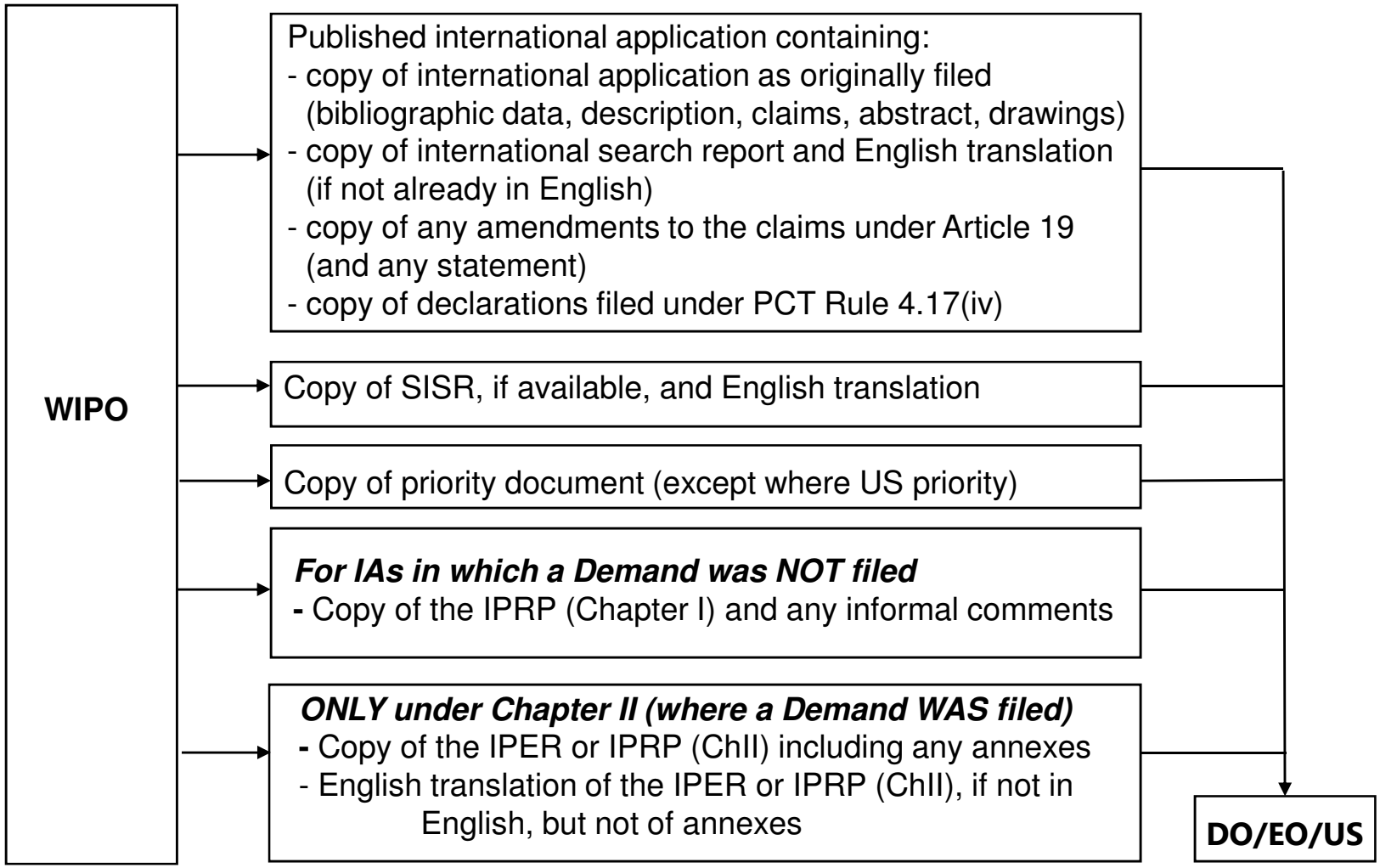
* not required if the IA was filed in RO/US or published by the IB

** amendments that formed the basis of the Report

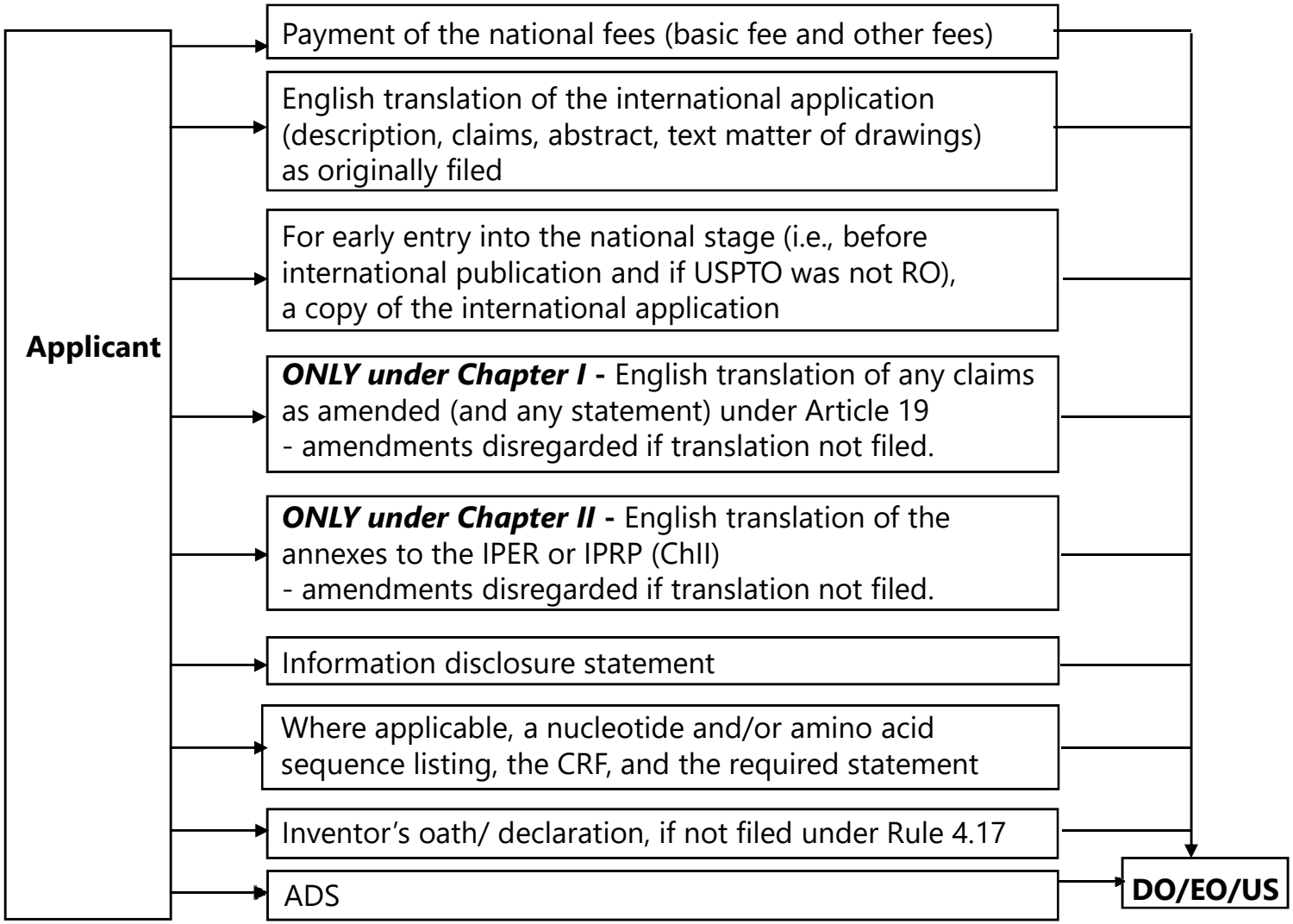
Commencement of U.S. National Stage

- 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

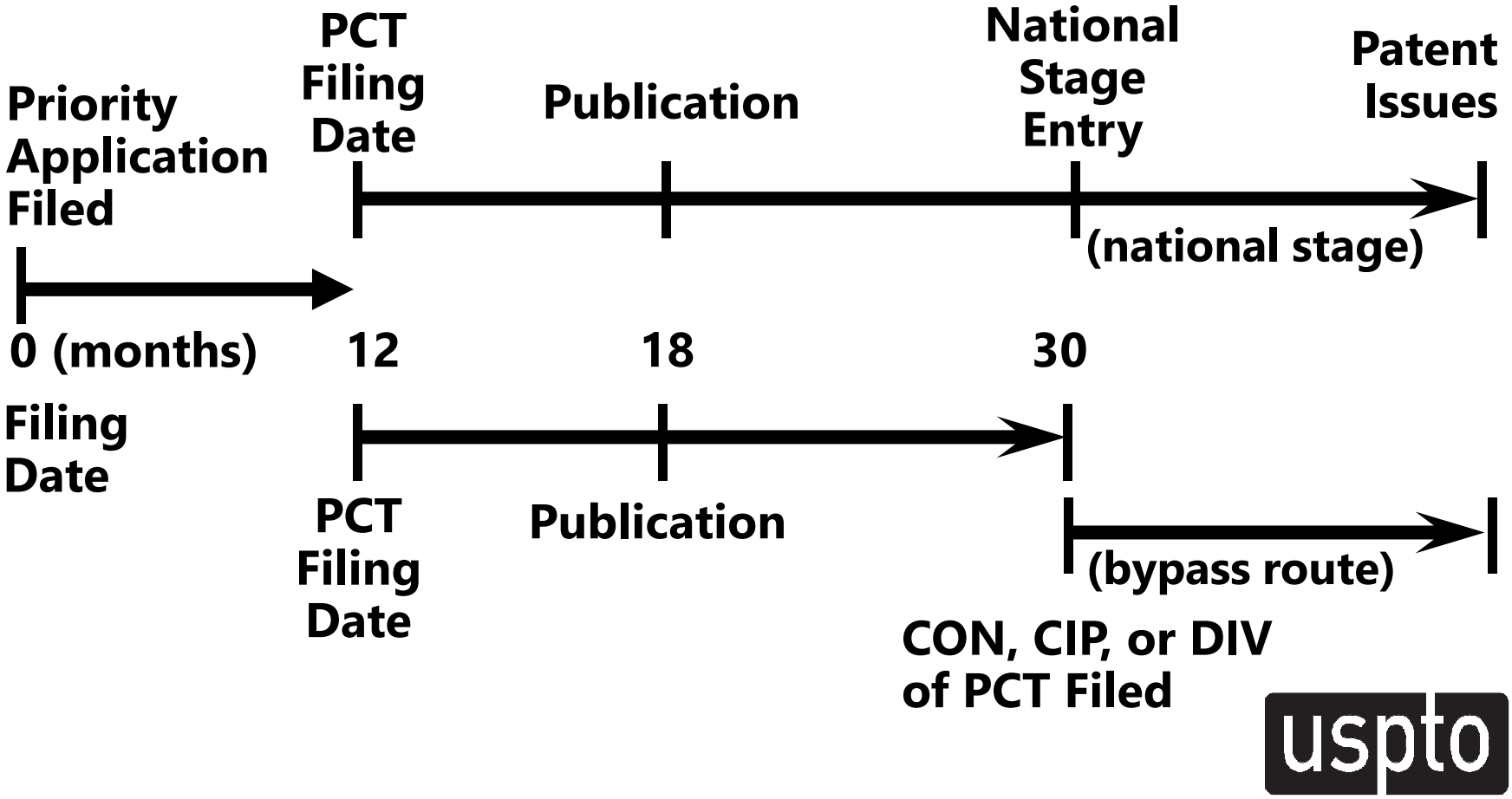
- The unity of invention standard is applied for restriction in a national stage application
- More claims may be kept together if multiple inventions present

"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, BR, DK, EE, ES, FI, GB, MA, NZ, 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) – ADS

- For a 371 application, applicability of the AIA and AIA-FITF is determined by the international filing date
  - **NOT** the date of initial submission under 35 U.S.C. 371
- Include a signed ADS with the initial §371 submission
  - If inventorship has changed
  - To indicate the relationship (continuation or CIP) to any non-provisional US application to which benefit was claimed in the international application
    - See the next 5 slides for screen shots

Helpful Hints (2) - ADS

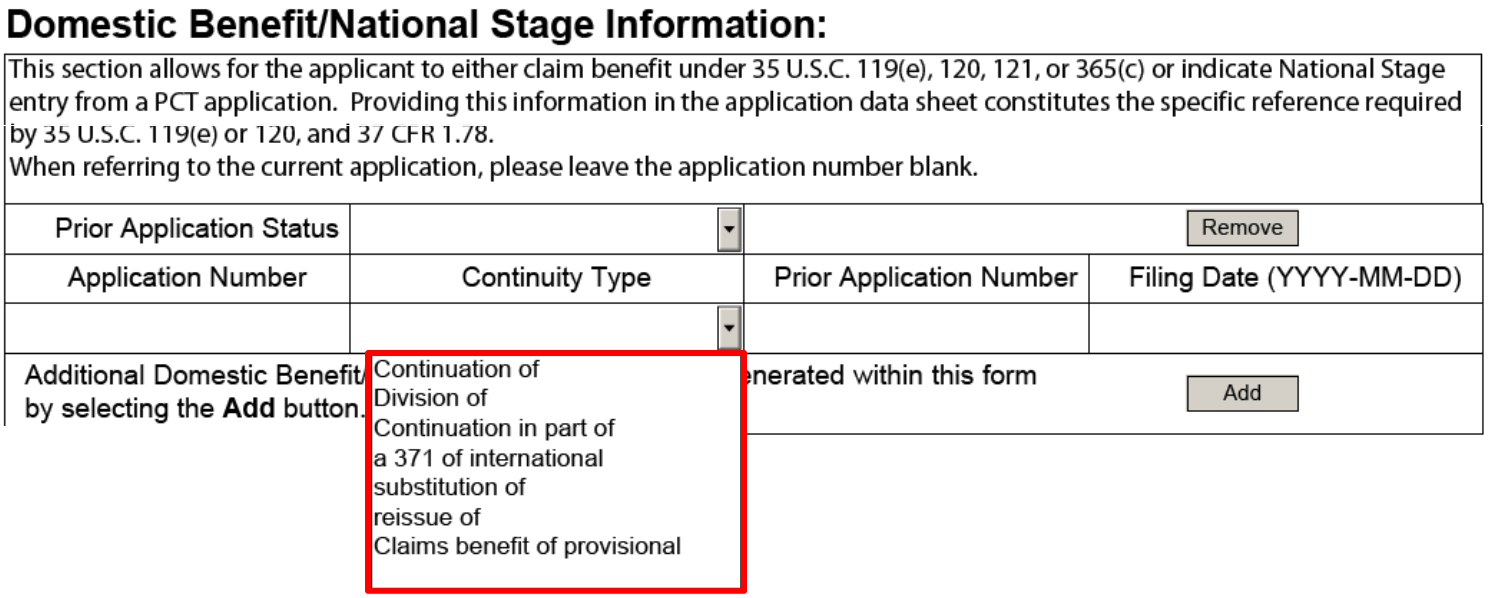
- Instructions on ADS form PTO/AIA/14:

Domestic Benefit/National Stage Information:

Application Number	If this field is left blank, it will signify "This Application is a" to refer to the application being submitted. You may also enter any application number that is already referred to in the Prior Application Number fields on the current form.
Continuity Type	Select the relationship between patent applications by selecting one of seven available relationship buttons. The relationships are continuation, division, continuation-in-part, 371 of international, substitution, reissue and non-provisional.
Prior Application Number	Provide the application serial number for the related application.
Filing Date	Select the filing date of the prior related application from the drop-down menu, which converts into a calendar. The date should be in the format YYYY-MM-DD.
Application Status	Select the status of the related application from Issued, Pending, Abandoned, or Expired.
Add Domestic Priority Data	Add the information to the continuity information list by selecting the Add button.
Remove Domestic Priority Data	Delete the information to the continuity information list by selecting the Remove button.

Helpful Hints (3) – ADS

- Select the relationship between patent applications by selecting one of seven available relationship buttons



Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)

Additional Domestic Benefit/ ...enerated within this form by selecting the **Add** button. Add

Continuation of
Division of
Continuation in part of
a 371 of international
substitution of
reissue of
Claims benefit of provisional

Helpful Hints (4) - ADS

- Benefit to US provisional

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	a 371 of international	PCT/IB2012/049050	2012-10-15
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/IB2012/049050	Claims benefit of provisional	61997050	2011-11-23

Helpful Hints (5) - ADS

- Benefit to US nonprovisional

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	a 371 of international	PCT/US13/14567	2013-01-15
Prior Application Status			Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
PCT/US13/14567	Continuation of	13925740	2012-05-21

Helpful Hints (6) – ADS

- Foreign Priority

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	a 371 of international	PCT/CN2012/099067	2012-11-14

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Foreign Priority Information:

This section allows for the applicant to claim priority to a foreign application. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(d). When priority is claimed to a foreign application that is eligible for retrieval under the priority document exchange program (PDX)[i] the information will be used by the Office to automatically attempt retrieval pursuant to 37 CFR 1.55(h)(1) and (2). Under the PDX program, applicant bears the ultimate responsibility for ensuring that a copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign priority application is filed, within the time period specified in 37 CFR 1.55(g)(1).

Remove

Application Number	Country[i]	Filing Date (YYYY-MM-DD)	Access Code[i] (if applicable)
201150384731.7	CN	2011-11-28	

Helpful Hints (7) – ADS

- "Bypass" application filed under 35 USC 111(a)

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation in part of	PCT/US14/20123	2014-03-04

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	PCT/US14/65432	2014-09-29

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Helpful Hints (8) – ADS

- Continuation of a 371 application

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.
When referring to the current application, please leave the application number blank.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
	Continuation of	14/385198	
Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
14/385198	a 371 of international	PCT/US14/55291	2014-08-30

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Helpful Hints (9)

- Use the national stage transmittal letter (PTO-1390)
- Do not pay all fees at time of filing if a preliminary amendment will be filed
  - Reduction of claim fees
    - No refund for claim fees paid
- 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
    - Declaration is not required at filing, if ADS is present

Helpful Hints (10)

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

Helpful Hints (11) - IDS

- List the references on an IDS; and
- Provide copies of any non-U.S. patent documents, *e.g.*
  - Foreign patent documents
  - Non-patent Literature (NPL)

  to ensure:
  - Consideration of references cited on the ISR/SISR, and
  - Reference citation on any resulting patent

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

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DEPARTMENT OF COMMERCE

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, EP, ES, FI, IL, JP, KR, 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/efsweb

PCT list serve:

www.oppedahl.com/pct

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The International Patent System

Priority Claiming under Paris Convention for the Protection of Industrial Property and the PCT

Matthias Reischle-Park

WIPO – AIPLA 21st Annual PCT Seminar, July 2017

The right of priority (1) (Article 4 of the Paris Convention)

- Any filing of an application for a patent by an applicant in one member country, entitles that applicant (or his successor in title) to have certain rights when applying for patent protection in all other member countries within 12 months
- For prior art purposes, the later applications will be regarded as having been filed on the same date as the first application
- The right of priority can be based only on the first filed application on the subject matter (see Paris Convention Art.4C(4) for exception)

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The right of priority (2) (Article 4 of the Paris Convention)

- Multiple and partial priorities may be claimed
- The later application must concern the same subject as the first application the priority of which is claimed
- Withdrawal, abandonment or rejection of the first application does not destroy its capacity to serve as a basis for priority

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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.

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Paris Convention (2)

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.

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Paris Convention (3)

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.

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Paris Convention (4)

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.

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Paris Convention (5)

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.

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Paris Convention (6)

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.

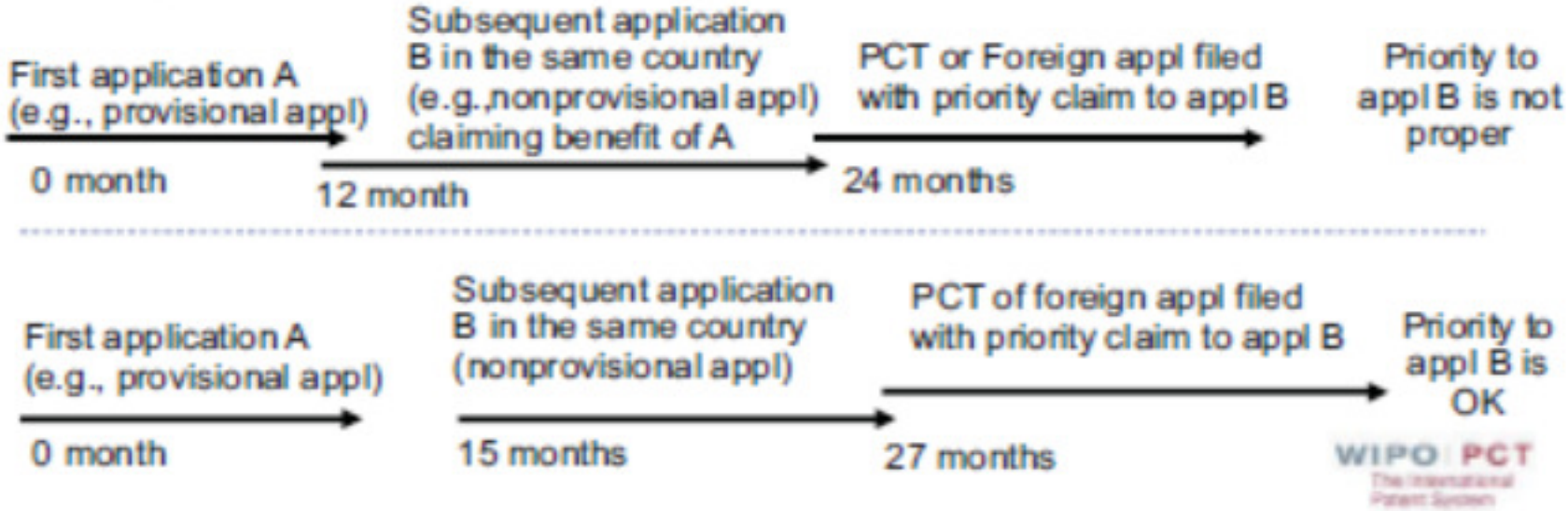
(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under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

H. — Priority my 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.

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

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. Statues 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

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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

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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

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Priority date and priority period (PCT 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

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Furnishing of priority documents (Rule 17.1)

- Where the priority of an earlier national, regional or international application is claimed, the applicant must provide a priority document for each corresponding earlier application (that is, a certified copy of the earlier application)
  - by furnishing such document directly to the receiving Office or the International Bureau (Rule 17.1(a)), or
  - by requesting the receiving Office to prepare such document and transmit it to the IB (Rule 17.1(b)), if the earlier application was filed with that Office, or
  - by requesting the IB to obtain the priority document from a digital library (Rule 17.1(b-*bis*)) (only for Offices participating in the Digital Access Service (DAS)

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Time limit for the furnishing of priority documents (Rule 17.1)

- Direct submission by the applicant to the RO:
  - within 16 months from the priority date
- Direct submission by the applicant to the IB:
  - before international publication
- Request to the RO to prepare and transmit the priority document to the IB:
  - within 16 months from the priority date
- Submission via DAS to IB:
  - The priority document must be made available to the IB via DAS and the request to the IB to retrieve the priority document must be made before international publication

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Retrieval of priority documents via DAS

- Possibility to request the IB to retrieve a copy of the priority document of an earlier application, in electronic form, via DAS
- The service is available for earlier national applications filed with AU, CN, DK, ES, FI, GB, JP, KR, NZ, SE and US and for earlier international applications filed with AU, CN, DK, ES, FI, SE and RO/IB
- The Office with which the earlier national application was filed is known as the Office of First Filing (OFF) or the Depositing Office
- The Office that retrieves the document is known as the Office of Second Filing (OSF) or Accessing Office

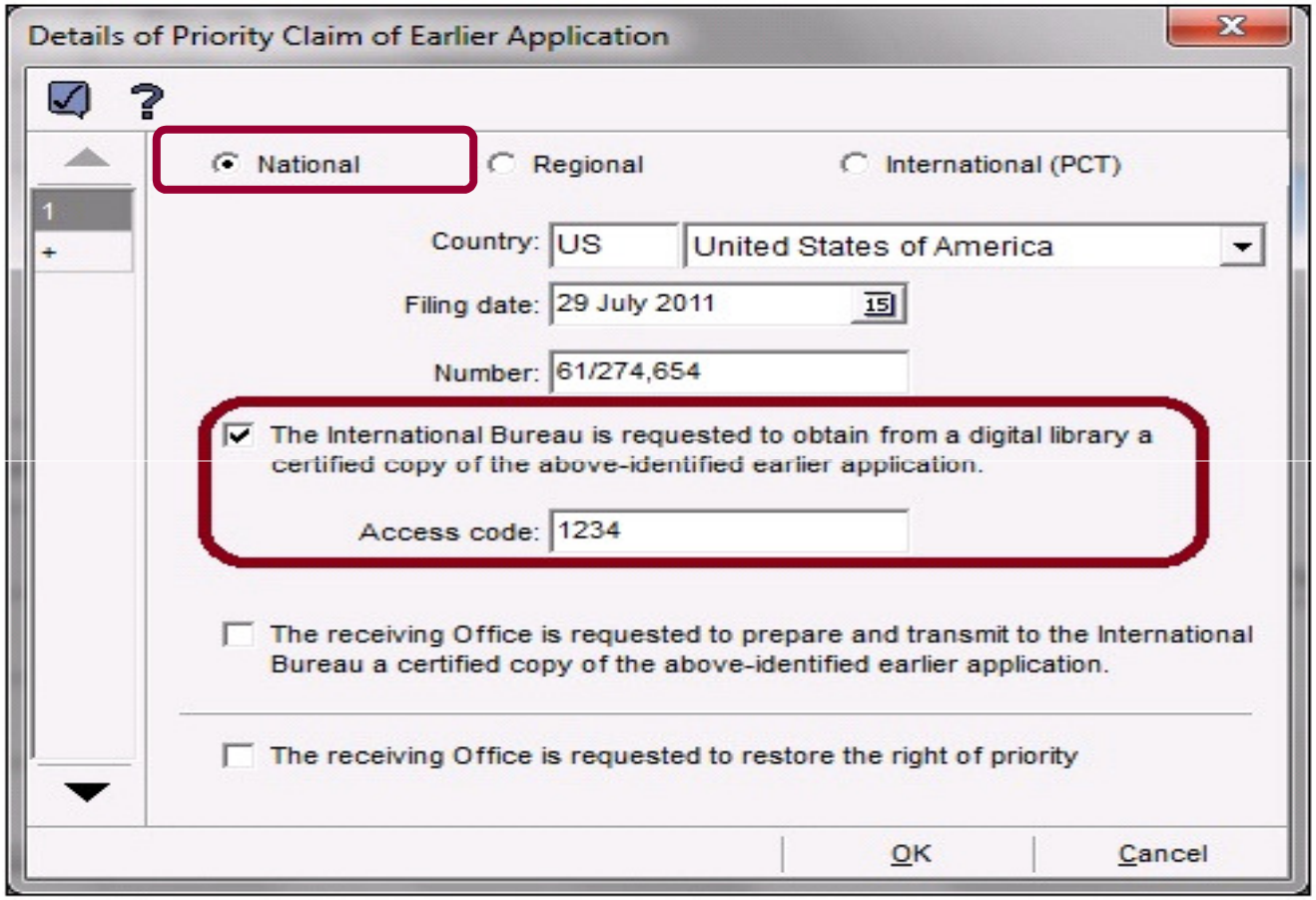
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Main steps for the use of DAS

- Request the OFF to make the earlier application available via DAS
- The OFF (or, in some cases, the IB on behalf of the OFF) provides the applicant with an access code
- File the PCT international application and request the IB to retrieve the priority document via DAS by checking the appropriate box on the request form and include the access code
- The IB retrieves the priority document via DAS and sends a confirmation of retrieval to the applicant by means of the Form PCT/IB/304

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Requesting DAS p-doc retrieval



- Select the checkbox on the Priority details page for the corresponding priority claim and indicate the access code.

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The International Patent System

Entering the European Regional Phase, European Prosecution Strategy, Unitary Patent

Jeremy Smith
July 2017

Kilburn & Strode

The European Patent Convention

Kilburn & Strode

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

Member states (38)

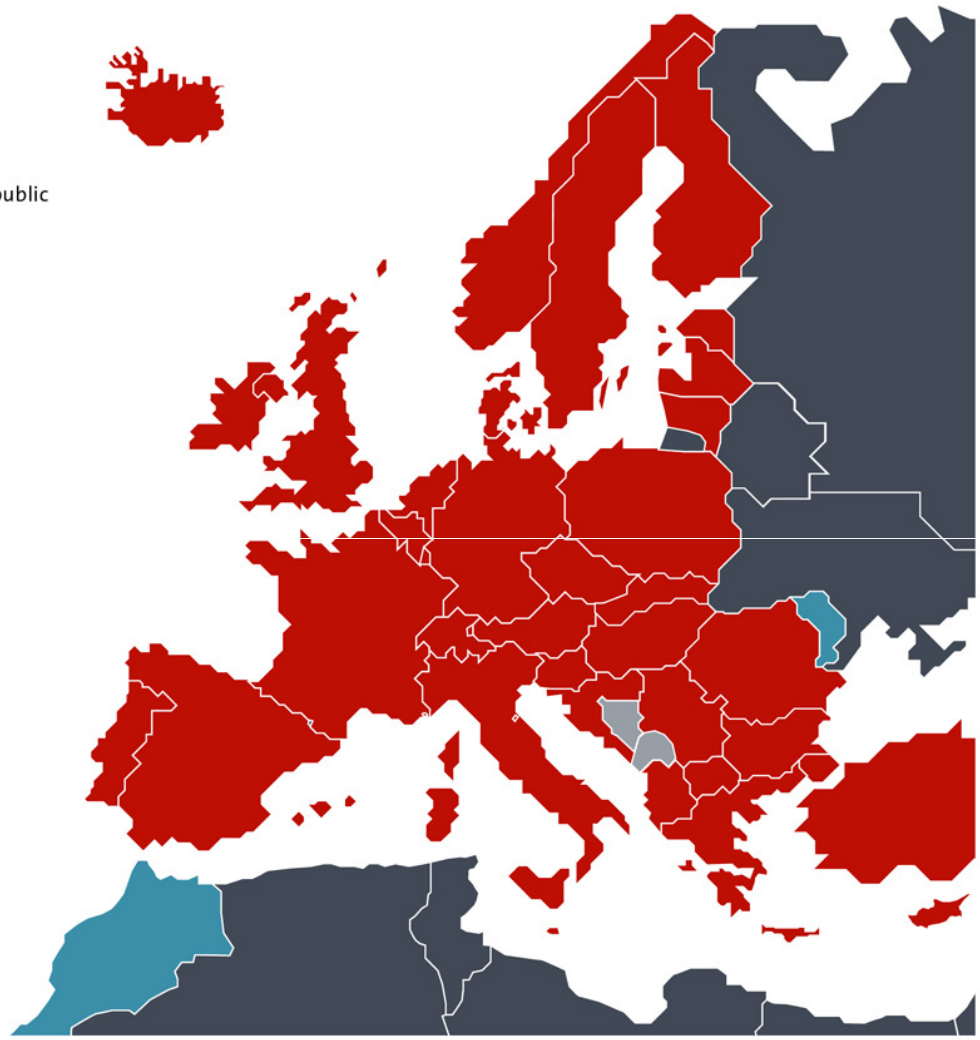
Albania
Austria
Belgium
Bulgaria
Croatia
Cyprus
Czech Republic
Denmark
Estonia
Finland
France
Germany
Greece
Hungary
Iceland
Ireland
Italy
Latvia
Liechtenstein
Lithuania
Luxembourg
Malta
Monaco
Former Yugoslav Republic of Macedonia
Netherlands
Norway
Poland
Portugal
Romania
San Marino
Serbia
Slovakia
Slovenia
Spain
Sweden
Switzerland
Turkey
United Kingdom

Extension states (2)

Bosnia-Herzegovina
Montenegro

Validation states (2)

Morocco
Republic of Moldova

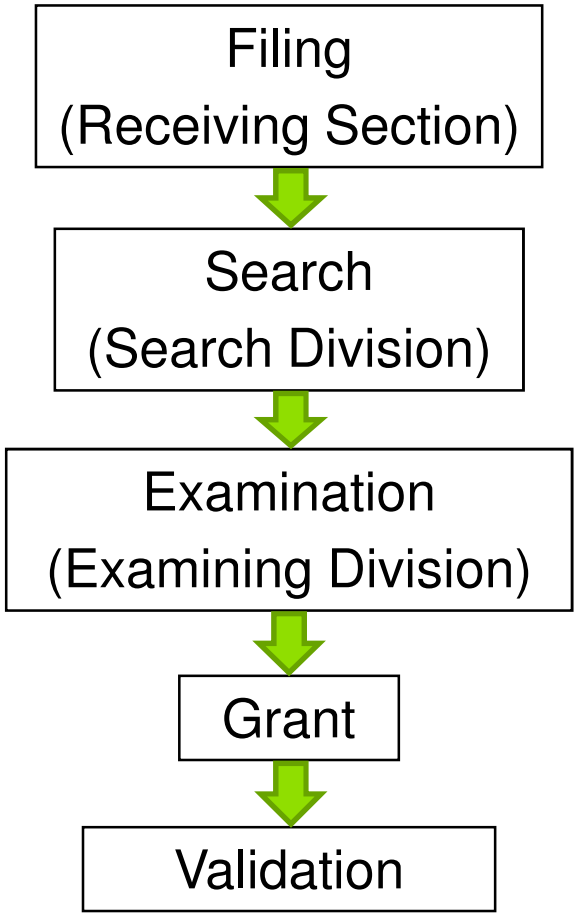


http://www.epo.org/about-us/foundation/member-states.html

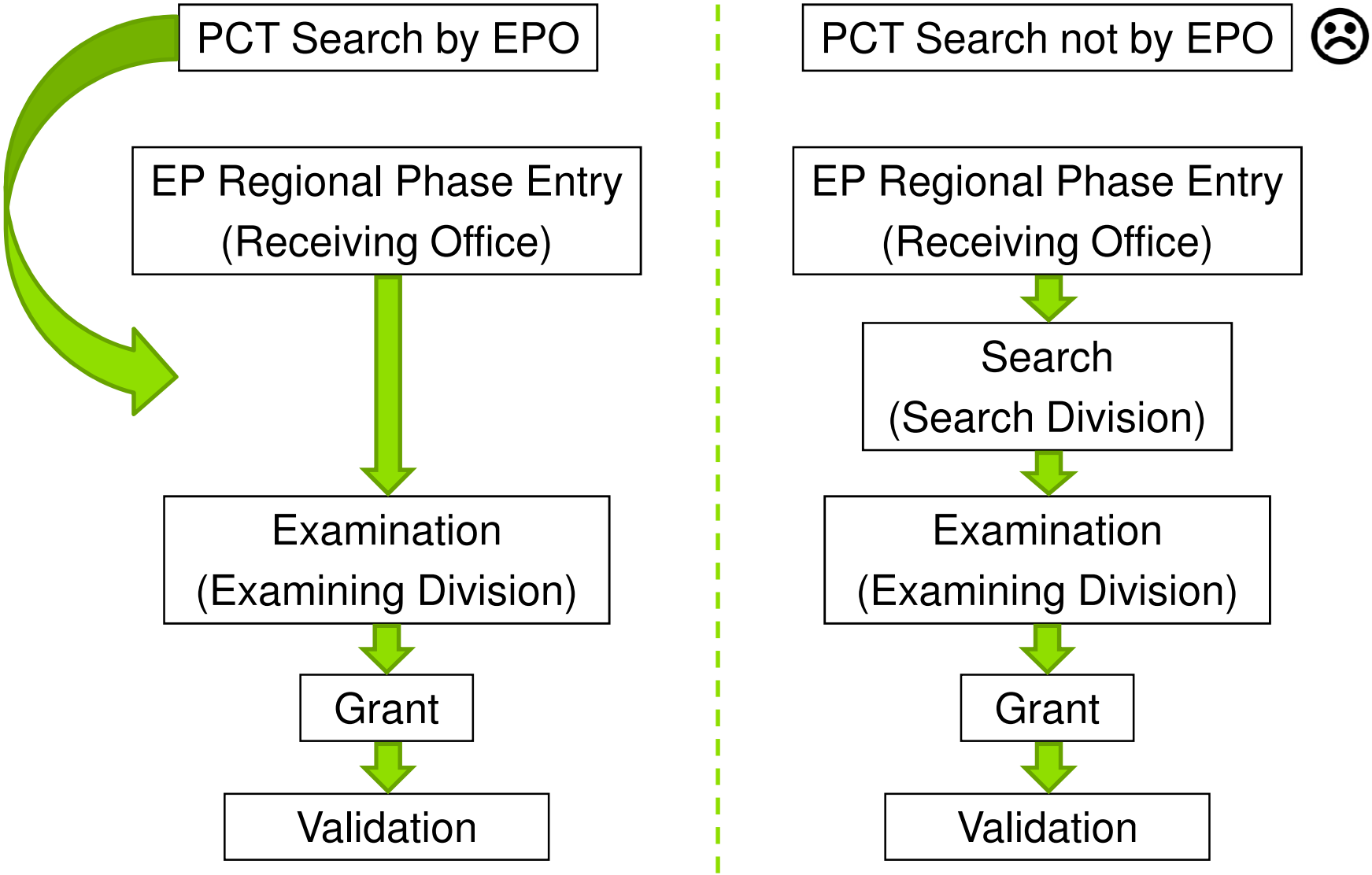
EP Regional Phase - The Basics

Kilburn & Strode

Normal EPO Procedure



Regional Phase Procedure at EPO



Basic Procedure

- Deadline for regional phase entry: 31 months from priority of PCT
- What has to be filed?
  - Simple form only
  - EP associate needs just the PCT application/publication number (unless before PCT publication)
  - 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)
  - 3rd year renewal fee (due on entry if more than two years from PCT filing date)
- 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.

Fee amounts

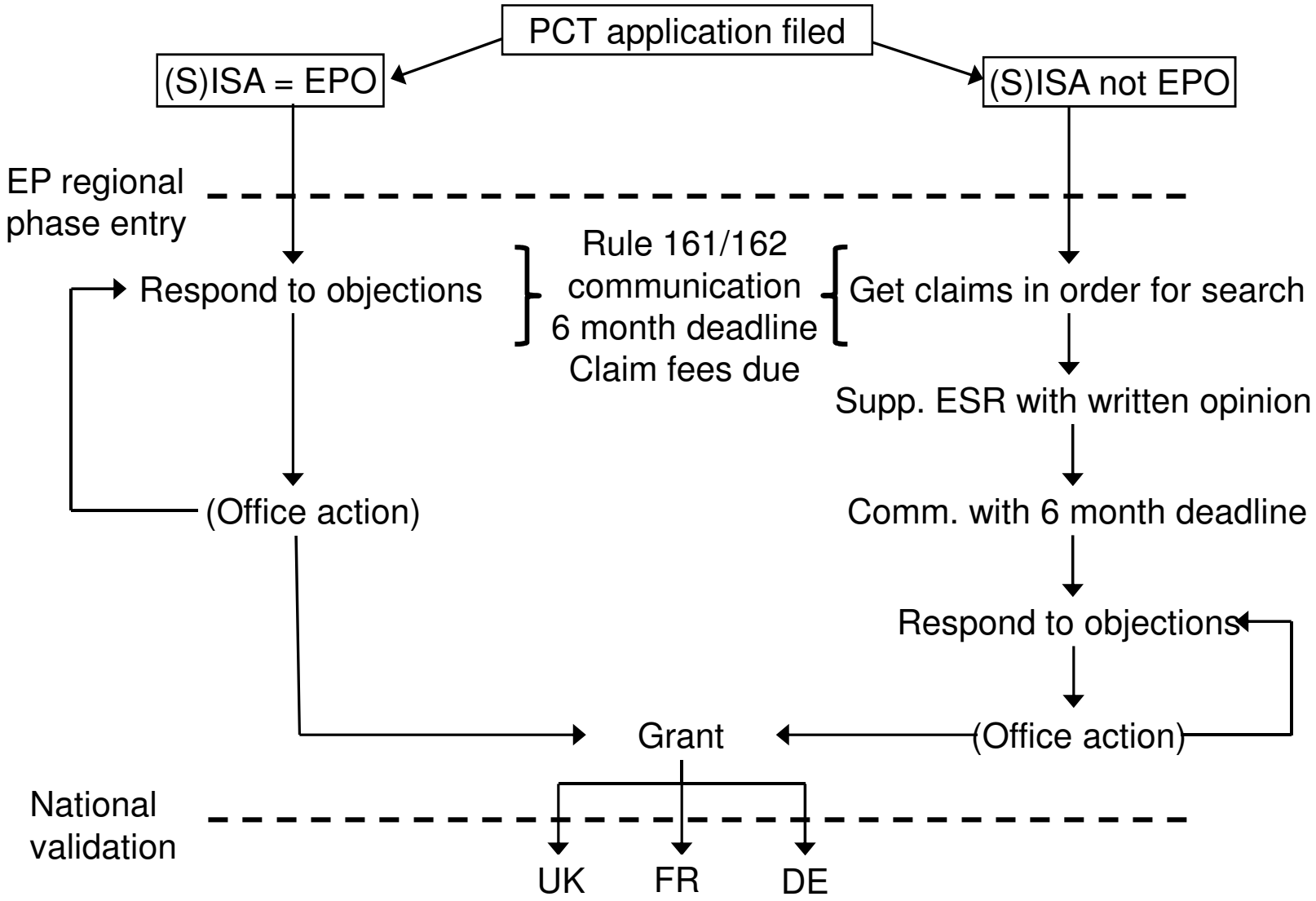
- Filing fee - €120 (+ €15 for each page over 35)
- Search Fee - €1300
  - No search fee due if EPO was ISA or SISA
  - €190 reduction if ISA or SISA was:
    - US, JP, KR, CN, RU, AU
  - €1100 reduction if ISA or SISA was European, i.e.:
    - AT, FI, ES, SE, XN
- Examination Fee
  - €1825 if EPO was ISA or SISA
  - €1635 if EPO was not ISA or SISA
  - 50% reduction if EPO was IPEA
- Excess Claims Fees
  - €235 for claims 16 to 49, €585 for claims 50+

EPO as ISA for PCT

- Not cheapest ISA, but don't have to pay search fee on European regional phase entry
- Get earlier first office action from EPO (the WOISA)

EP Regional Phase - Advanced

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PCT application filed
(S)ISA = EPO
(S)ISA not EPO
EP regional phase entry
Respond to objections
Rule 161/162 communication
6 month deadline
Claim fees due
Get claims in order for search
Supp. ESR with written opinion
(Office action)
Comm. with 6 month deadline
Respond to objections
Grant
(Office action)
National validation
UK
FR
DE

EPO = (S)ISA: After Entry

- 6-month period set by Rule 161/162 EPC Communication Issued shortly after regional phase entry:
  - Response to Written Opinion of ISA/IPEA [Rule 161 EPC]
    - Amendments and/or comments. This is compulsory if no amendments were filed on entry, and optional if amendments were filed on entry.
  - Payment of excess claim fees based on claims at end of 6-month period [Rule 162 EPC]
  - Last opportunity for voluntary amendments
    - Further amendments at discretion of Examining Division
  - If no amendments/comments filed on entry, failure to respond = application deemed withdrawn (but can recover with “further processing”)

EPO = (S)ISA: Further search

- If claims at end of six-month period include one or more inventions that were not searched by the EPO as (S)ISA, have to pay search fee(s) 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. Divisional application(s) can be filed to seek protection for other inventions.

EPO not (S)ISA: After Entry

- 6-month period set by Rule 161/162 EPC Communication Issued shortly after regional phase entry:
  - No response to WOISA/IPRP required
  - Payment of excess claim fees based on claims at end of 6-month period
  - Last opportunity for voluntary amendments
- Supplementary European search carried out after this

EPO not (S)ISA: must get claims in order for search

– 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 (can file divisional).

Saving $$$ on Entry

- Avoid excess claims fees
  - Reduce to have no more than one independent claim in each category (product/method)
  - Combine dependent claims as alternatives within a claim (may get objection of lack of conciseness)
- Incorporate original claim wording into description to ensure covered by EPO search
- File reduced number of description/claims/drawings pages on entry and amend at end of 6-month period to avoid excess page fees (bad faith?)

How to slow down the procedure

- Further processing can be used for entry and/or fees
  - If 31-month entry/fee deadline missed, letter noting “loss of rights” will issue (sent to applicant if not done entry yet)
  - Two-month deadline from date of letter to do omitted acts
  - 50% surcharge on late-paid fees
- Can make a minor claim amendment as a response to the WOISA to delay filing of a full response
  - Likely to lose a round of correspondence with EPO

How to speed up the procedure

- Can enter early (need to request early processing for EPO to act before 31m deadline)
- Can amend claims (or respond to WOISA if done by EPO) on entry
- Can waive right to receiving Rule 161/162 EPC communication (which gives 6m to amend claims before EPO search / respond to WOISA if done by EPO)
- Can respond to Rule 161/162 EPC communication early (need to request EPO to proceed before 6m deadline)

Acceleration at EPO

- Request PACE
  - No official fee
  - Separate requests for search and exam phases. Request must be filed after the respective phase has started.
  - PACE request for search on new cases has minimal effect – same 6m target from EPO, but useful to prompt EPO on old cases (filed before July 1 2014)
  - EPO has 3m target to issue each action after PACE request for exam
  - Application is removed from PACE if an extension is requested, if use further processing, or if miss renewal fee deadline. Can't re-enter PACE for that phase.
  - If PACE requested for all/most of an applicant's cases, EPO will likely require number to be limited
  - Anonymous – PACE request won't appear on register (provided filed on its own)

Acceleration at EPO

- Ask EPO when next office action expected
  - Get reply from a formalities officer, usually stating a number of months
  - Results in office action having a higher importance level in the examiner's docket
  - Not as effective as PACE, but no limit to number of uses per applicant
  - Not anonymous – will appear on register

Patent Prosecution Highway

- Not worth using at EPO based on earlier office action from another office
  - End result is same as PACE
  - Wastes attorney time=money in preparing the submission
  - Causes more work for the examiner

- The situation is different for using PPH at other offices based on positive office action from EPO
  - EPO report often respected and followed at other offices when using PPH

Prosecution Strategies

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International Preliminary Examination with EPO as IPEA

- Forces the EPO to examine within a time-frame
- File response/amendments with Demand for IPE
- Can appoint European attorney as agent for IPE
- Get IPER from EPO (2nd office action within PCT phase)
- Can file further response to this
- Can have phone call with EPO examiner
- Final result is IPRP
- Positive result from EPO usually carried through into EP regional phase
  - Quick grant in Europe
  - May also carry weight at other offices / use PCT-PPH

PCT Direct

- File direct EP application, searched within ~6m
- File PCT application claiming priority from EP including “amended” claims and letter responding to EP search opinion
- PCT search will include written opinion (effectively a second office action)
- May get full or partial refund of PCT search fee
- Positive EP search can be used for PPH in other countries

Gold standard – quick grant at the EPO

- File direct EP application (if not first filing for invention, file as soon as possible after first filing; add priority claim later to encourage quick search)
- ~6m after filing EP: receive EESR
- 12m after priority: file PCT with EPO as ISA, claiming priority from EP application (as well as any first filing), using PCT Direct with response to EESR.
- ~18m after priority: receive WOISA
- ~22m after priority: file Demand responding to WOISA
- ~25m after priority: receive WOIPEA
- ~26m after priority: file response to WOIPEA
- ~27m after priority: have telephone consultation with Examiner
- ~27.5m after priority: file response (if allowed in telephone consultation)
- ~28m after priority: receive IPER=IPRP
- ~31m after priority: enter EP regional phase with response to IPRP

Divisionals

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Divisionals

- Can file divisional while parent application is “pending”
  - Includes period between approval for grant and actual grant
  - Includes period after refusal of application during which appeal can be filed (even if appeal not filed)
- Token increase in filing fee for 2nd and subsequent generation divisionals
  - Negligible compared to back renewal fees payable for the divisional

EP grant – London Agreement

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London Agreement

– No post-grant translation:

France	Liechtenstein	Switzerland
Germany	Luxembourg	United Kingdom
Ireland	Monaco	

– Translation of claims only:

Albania	Hungary	Norway
Croatia	Iceland	Sweden
Denmark	Latvia	Slovenia
Finland	Lithuania	
Macedonia	Netherlands	

European National Filings

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EPO is not the only option

- Can file nationally instead of (or as well as) at EPO
  - Can do national phase entry from PCT (not available for Belgium, Cyprus, France, Greece, Ireland, Italy, Lithuania, Latvia, Monaco, Malta, Netherlands, Slovenia)
  - Can do Paris Convention national filing (all EPO countries available)
- Worth considering if would only validate EP patent in about 3 countries
- Translation of specification needed in most countries, so can be high initial cost (but may have had to pay on EP grant anyway)
- Prosecution costs usually significantly lower than EPO (including renewal fees)
- Easier and quicker to reach grant in most national offices compared with EPO
- If file both EP and nationally, get two chances for grant
- Double patenting restrictions in most EP countries – only relevant at grant stage if both EP and national patent grant

Quick grant via PPH at GB

- File GB early (e.g. at same time as PCT)
- Can get quick grant and use this for PPH in various countries
- Low official fees

Brexit

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Brexit

- UK referendum – voted to leave EU on June 23 2016
- Leaving process formally began on March 29 2017. Will leave EU on March 29 2019 unless all parties agree to extend (unclear whether process could be reversed with UK staying in EU). Likely to be a transitional period after this date.
- UK national and EP patents unchanged after Brexit
- UK patent attorneys' rights before EPO unchanged after Brexit
- PCT unchanged after Brexit
- Unitary patent may be delayed due to Brexit…

The Unitary Patent and Unified Patent Court

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Unitary Patent and Unified Patent Court

- Unitary Patent
  - Existing national + EP bundle patent systems remain in place
  - Additional validation option for European applications
  - Does not cover all EPC countries (or even all of EU, at least to begin with)
  - Single renewal fee for whole region
- Unified Patent Court System
  - Applicants can opt out of UPC for EP bundle patents during transitional period of 7-14 years
  - All unitary patents subject to UPC (not national courts)
  - National patents remain with national courts

UNITARY PATENT
(Must be an EU member state)

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

CURRENTLY NOT PART OF UP and/or UPC

Poland *
Spain
Croatia

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

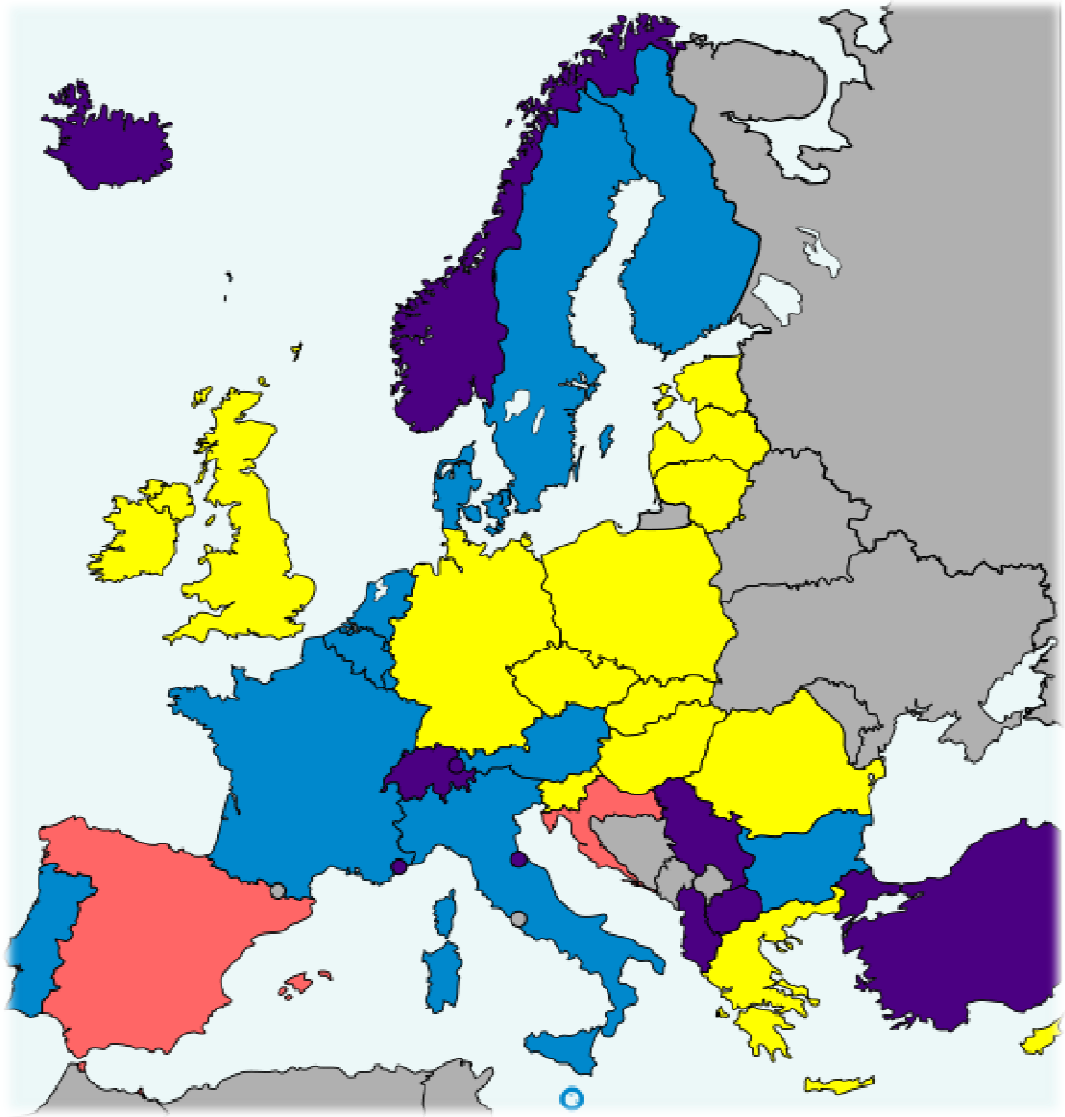
EPC MEMBERS BUT NOT EU MEMBERS

Iceland †
Serbia †
Macedonia †
Turkey †
Albania
Norway
Switzerland
Liechtenstein
Monaco
San Marino

† EU candidate country

AWAITING RATIFICATION		RATIFIED
Cyprus	Latvia	Austria
Czech Rep.	Lithuania	Belgium
Estonia	Romania	Bulgaria
Germany	Slovakia	Denmark
Greece	Slovenia	France
Hungary	United Kingdom	Italy
Ireland		Luxembourg
		Malta
		Netherlands
		Portugal
		Sweden
		Finland

Must have 13 countries to ratify, including France, Germany, UK
Currently have 12 countries, so waiting for UK and Germany



EU members participating in the unitary patent regulation which have also ratified the UPC Agreement
(unitary patents will only apply for these states)

EU members participating in the unitary patent regulation which have not ratified the UPC Agreement
(unitary patents will not apply for these states)

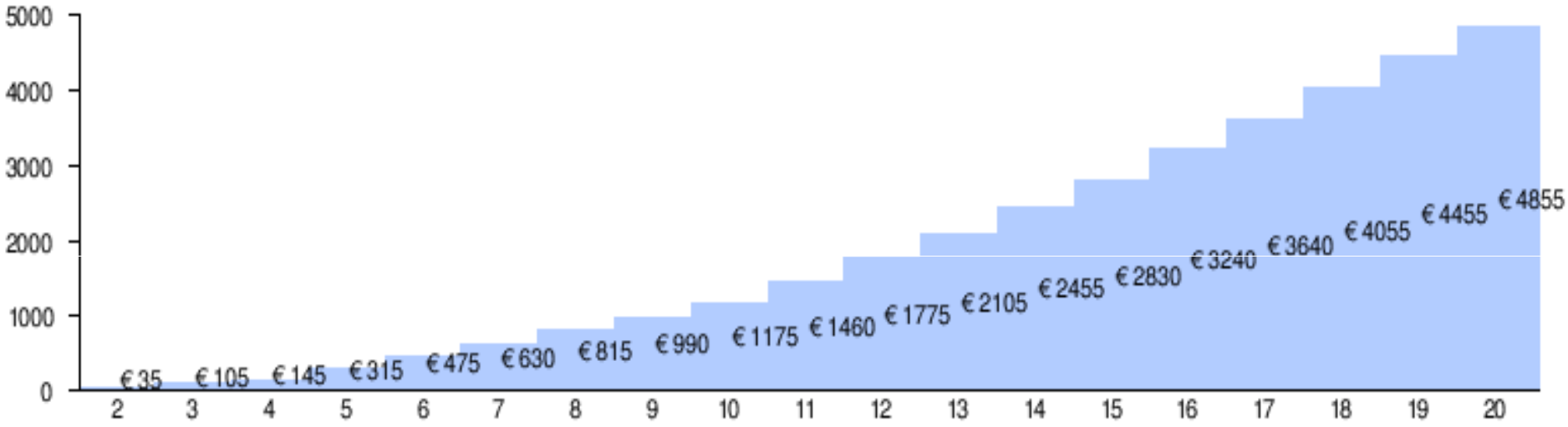
EU members neither participating in the unitary patent regulation nor in the UPC Agreement
(eligible for participation in the future)

Other European Patent Convention parties
(no participation possible)

https://en.wikipedia.org/wiki/File:Unitary_patent_participants.svg

https://en.wikipedia.org/wiki/Unitary_patent

Unitary Patent – renewal fees



https://en.wikipedia.org/wiki/Unitary_patent#Costs

Brexit considerations

- Current consensus is that UK can't be member of UP system if not an EU member, but this could be changed by agreement
- UK ratification required while UK remains in EU
  - Apparently going ahead – UK could ratify later this year
  - If UK leaves the EU before UP comes into force, only Germany would need to ratify
  - German ratification being held back until court is ready, but has been paused due to recent constitutional court case
- Agreement has part of court in London – may need to be changed if UK leaves EU – may form part of Brexit negotiations
- UK patent attorneys still able to practice before UPC after Brexit
- Will UP happen at all?

Thank you

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Patent and Trade Mark Attorneys

Kilburn & Strode

Entering the Chinese National Phase

AIPLA PCT Seminar
July, 2017

Prepared by Chenyan Wu

Presented by Jia LI

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 addressing enforcement issues:
  1) difficult burden of proof for appropriate damages;
  2) long cycle;
  3) low compensation;
  4) high cost and poor result;

Draft fourth amendment

- reduce the difficulty of providing evidence for calculating damages
- resume litigation proceedings once the Patent Reexamination Board makes a decision in the invalidation procedure and the decision is announced
- add willful infringement (double or triple the calculated damages or statutory damage) Currently, the upper limit of statutory damage is about US$160,000. In the case of willful infringement, this may be as high as about US$480,000;
- if the local IP offices find infringement, they may confiscate or destroy the infringing products and equipment used for making such products. They could also impose a fine up to five times the illegal amount of sales.
- add a duty to an internet service provider to take measures to curb infringement such as deleting, blocking or breaking the links of the infringing products

Basic procedure – time limit

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

Basic procedure – short list

- 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

Basic procedure – Invention or Utility Model

- 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 2010	2011	2012	2013	2014
From domestic applicants	407,328	581,303	734,437	885,226	861,053
From foreign applicants	2,598	4,164	5,853	7,136	7,458

Numbers of utility model applications filed

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;
- one of largest damages 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

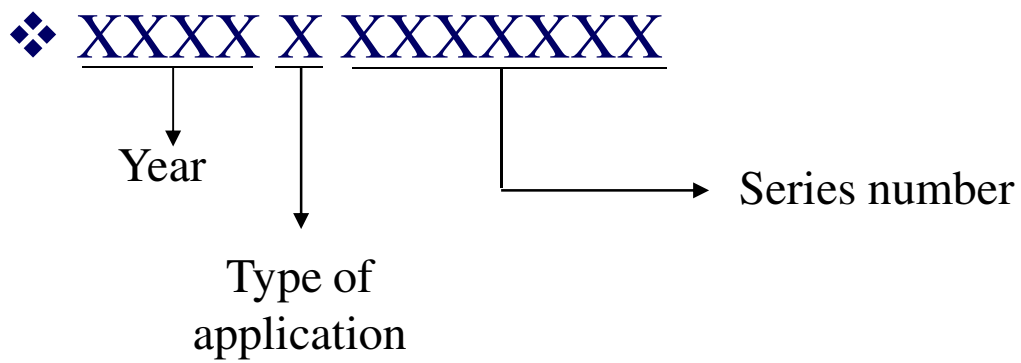
v. Invention Patents

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

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

Patent application number



- 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

Basic procedure – full list (Cont.)

- 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

Basic procedure – full list (Cont.)

- 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)
- Time limits:
  - 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 months 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

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

- Timelimits:

  - 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)

Discrepancy caused by Chinese translation

- 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

Extending to Hong Kong

- 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.

Extending to Hong Kong (Cont.)

- 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)

Extending to Macau

- 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;

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

- Prioritized Examination:

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

(1) patent applications relating to important technical fields covering energy saving and environmental protection, new generation information technology, biology, high-end equipment manufacturing, new energy, new materials, and new energy vehicles;

(2) patent applications relating to important technical fields encouraged by provincial and city governments;

(3) patent applications relating to internet, big data, cloud computing etc.;

(4) applicant is ready to implement or has implemented the technology, or has evidence to show others is implementing the technology;

(5) Patent applications that are first filed in China and subsequently in other countries or regions with respect to the same subject matter;

(6) Patent applications of great significance to national or public interests.

It applies to all three types of patent applications, including reexamination proceedings.

Time frame: The Chinese Patent Office must issue an Office Action within 45 days from the date the petition of prioritized examination is granted.

Applicant must respond to an Office Action within two months for an invention application and 15 days for a utility model application .

For an invention application, final disposition must be issued within twelve months from the date the petition of prioritized examination is granted.

For a utility model application, final disposition must be issued within two months from the date the petition of prioritized examination is granted.

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 – **disclose most limitations**; 2. Ascertaining the differences between the claimed invention and identify **object** 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.

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

Drafting a Global Application – US perspective

604

THE NEED FOR A "GLOBAL" PATENT APPLICATION

- REVISION OF APPLICATION FOR EACH FOREIGN COUNTRY IS NOT AN ADEQUATE SOLUTION
  - Time required for revision
  - Different attorneys for revision requires relearning
  - Hesitancy to make changes, especially in claims
  - Many countries still require translation of priority documents
  - Need priority application for "reference filing" under PLT
  - For PCT need translation of original application
- PCT is already a "Global" application

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THE NEED FOR A "GLOBAL" PATENT APPLICATION (cont.)

- US APPLICATIONS ARE VERY LENGTHY
  - Satisfying 35 USC. 112
  - Enablement, best mode, and written description
  - Satisfying CAFC Requirements
  - Standing up in litigation
  - Claim invention many ways
  - Length to impress client
  - Try to do a "selling job" of obviousness in view of KSR
  - Translation of such lengthy application is costly

THE NEED FOR A "GLOBAL" PATENT APPLICATION (cont.)

- FOREIGN COUNTRIES HAVE DIFFERENT REQUIREMENTS
  - Citing prior art
  - Format of specification
  - Type and number of claims
  - Objects, advantages, benefits
  - Different formalities, different headings
  - Different style and approach of describing inventions
- DIFFERENT WRITTEN DESCRIPTION REQUIREMENTS
  - US – invention support
  - EPO – photographic support
  - JPO – technical support

GENERAL RECOMMENDATIONS FOR A "GLOBAL" APPLICATION

- DESCRIBE THE INVENTION ONLY ONCE
  - Summary of Invention
  - Brief Description of Drawings
  - General Description of Invention
  - Best Mode of Invention
  - Concluding Summary

- DON'T TEACH THE TECHNOLOGY
  - Application addressed to one skilled in art
  - Prior art should be in IDS not applications
  - Don't discuss prior history of technology or prior reference

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GENERAL RECOMMENDATIONS FOR A "GLOBAL" APPLICATION (cont.)

- AVOID RECITATION OF NUMEROUS BENEFITS
- LIMIT NUMBER OF PAGES IN SPECIFICATION
  - Be Concise
  - Insist on Limits
- USE "GLOBAL" LANGUAGE
  - Short non-confusing sentences
  - Don't use ambiguous words
  - Avoid indefinite language
  - Avoid generalizations unless part of invention
  - Avoid critical language unless part of invention
  - Use metric units

GENERAL RECOMMENDATIONS FOR A "GLOBAL" APPLICATION (cont.)

- No cross-referencing
- No incorporation by reference
- Use standardized PCT format
- Keep parts list

PREPARING A "GLOBAL" APPLICATION

- ABSTRACT
  - Use reference numerals
  - Can be removed for US if desired
  - Keep short
- BACKGROUND OF INVENTION
  - Use only one (1) reference at most - closest reference
  - Describe reference only briefly
  - Enclose copy of closest reference in all countries for agent's use
    - Use problem/solution approach
    - Problem
    - Prior art solution from reference

PREPARING A "GLOBAL" APPLICATION (cont.)

- SUMMARY OF INVENTION
  - Problem with prior art - try not to make it a simple problem in view of KSR
  - Solution provided by invention
  - Unobvious nature of invention - in view of KSR
  - Advantage of invention - general
  - Consistory statement - copy claim 1
  - No objects
- BRIEF DESCRIPTION OF DRAWINGS
  - Just itemize - don't describe
  - Keep Concise
- DESCRIPTION OF THE INVENTION
  - Describe only once
  - Describe as part of best mode

PREPARING A "GLOBAL" APPLICATION (cont.)

- Each time you mention an item, give alternatives at that time
- Limit description of peripheral environment
- Be consistent in describing elements
- Use of examples is important, never too many
- Use generic type of examples and then list specifics covered by generic type
- Where range is recited, use example at low end, high end and mid-range
- Where values are critical, must show comparisons of in range and out of range
- For software patents include enough structure (even block diagrams)

• CLAIMS

- Must limit foreign claims, preferably 10 claims
- Write US claims so first 10 useful for foreign filing

PREPARING A "GLOBAL" APPLICATION (cont.)

- Foreign countries have broader unity of invention than US, thus more than one type of claim is permitted
- One independent claim for each type
- Limit dependent claims to novel features
- Use multiple dependencies when possible
- Foreign countries like functional language, but not all like
  "means", therefore use descriptive terms plus function
- Insert reference numerals when preparing claims, can eliminate for US

• DRAWINGS
  - Use A-4 paper and PCT margins
  - Prepare one set without English words
  - Use computerized drawings to facilitate drawing changes

CONCLUSION

- Applications can be prepared for “global” filing
- Can reduce initial cost as well as foreign filing cost
- Can produce a better application even for US filing
- Your PCT application should be prepared as a global application

Drafting an International Application as a Global Application – EP View

Jeremy Smith
July 2017

Kilburn & Strode

“…separated by a common language”

- Different patent offices want and allow different things
- EPO stricter in some areas, USPTO stricter in others
- Some issues can’t be fixed properly later if not anticipated early enough
- Best to account for different audiences when drafting

Added Matter

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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)
- Usually not allowed to add wording based on what is shown in a Figure

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 could form 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
- To amend to a generalized 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 generalized 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…”
- To broaden an independent claim by removing a feature, there must be 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. A car comprising a radio.
2. The car of claim 1, comprising an anti-theft device.
3. The car of claim 2, wherein the car is powered by a rocket.
4. The car of claim 1, wherein the car is black and has a retractable roof.

– Can I add the feature of claim 3 into claim 1?
– Can I add the feature of a black car into claim 1?
– Can I delete the radio?

Added Matter: Example

– More options for amendment if I originally had:

1. A car.
2. The car of claim 1, wherein the car comprises a radio.
3. The car of claim 1 or 2, wherein the car comprises an anti-theft device.
4. The car of any preceding claim, wherein the car is powered by a rocket.
5. The car of any preceding claim, wherein the car is black.
6. The car of any preceding claim, wherein the car 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 maneuver
  - This can be done in the claims or the description
- Include:
  - Lots of intermediate statements between broad generalizations 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

Priority

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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 generalization or intermediate position not appearing in priority document will not be entitled to priority
- Risk: if claim not entitled to priority, effective date will be filing date
  - Fatal if disclosure between priority and filing dates

Priority: What does it mean for the draft?

- Consider priority application when drafting claims
- In Europe, a priority document cannot be used to provide basis for an amendment, so include full content of priority application in later-filed application (e.g. PCT)
- 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), with multiple dependencies

Unity and Independent Claims

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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
- 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. if alternatives within claim)
- Ensure your most important subject matter appears first in the claims
  - Can correct this on EP regional phase entry
- Prepare 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)

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

– Identify your most important independent claim and make sure it is listed first as claim 1

Clarity

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Clarity

- EPO strict on what it sees as “clear”
  - Claims should be clear in isolation
  - Examiner not usually native English speaker
- Concerned with whether the skilled person can 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
  - Avoid referring to “the invention” (unless referring to independent claims) and avoid words like “must”, “need”, “necessary” throughout specification
  - Avoid “preferably” – “optionally” is better
  - “May” – EPO doesn’t like – does it mean some embodiments have the feature and others don’t, or that an embodiment has the ability/permission both to do and not to do the feature?
  - “In some embodiments…” is good wording
- Claim defines result to be achieved
  - Must claim how problem is solved, not that it is solved

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
- Avoid using terms of art that the examiner might not understand

Claim drafting

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Claim drafting – differences in EP/US practice

- USPTO stricter on functional claim language
  - Functional claims / “means plus function” usually accepted at EPO, and interpreted broadly
  - Broader scope than US-style structural claims
  - Have EP-style functional claim language in US provisional application and PCT application

Inventive Step

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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?

- Explain disadvantage(s) of prior art
  - Best to present this as something identified by the inventor(s) – identification of disadvantage(s) might be part of the invention
- Explain effect(s) achieved by features
  - Explain how this overcomes the identified disadvantage(s)
- Explain technical nature of features
  - Explain technical nature of optional features
- Consider scope of claims
  - Is problem solved over whole scope?

Excluded Subject Matter

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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
  - Set up a technical problem in Background
  - Explain technical nature of solution in Summary

Summary

- Background
  - Excluded matter: set up a technical problem
  - Inventive step: telling a story; set up problem to be solved
- Summary section
  - 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
  - Inventive step: telling a story; explain technical solution

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
  - 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, but potential extra scope for infringement due to doctrine of equivalents
- Grounds for revocation:
  - Excluded subject matter, novelty, inventive step, industrial applicability
  - Added matter
  - Extended scope of protection
  - Insufficiency
  - Entitlement

Thank you

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Drafting an International Application as a Global Application – CN View

AIPLA PCT Seminar
July, 2017

Prepared by Chenyan Wu

Presented by Jia LI

Language

- 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

Claims

- 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

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 allowed (newly accepted);
- Machine or transformation also works in China;

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

Specification

- 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

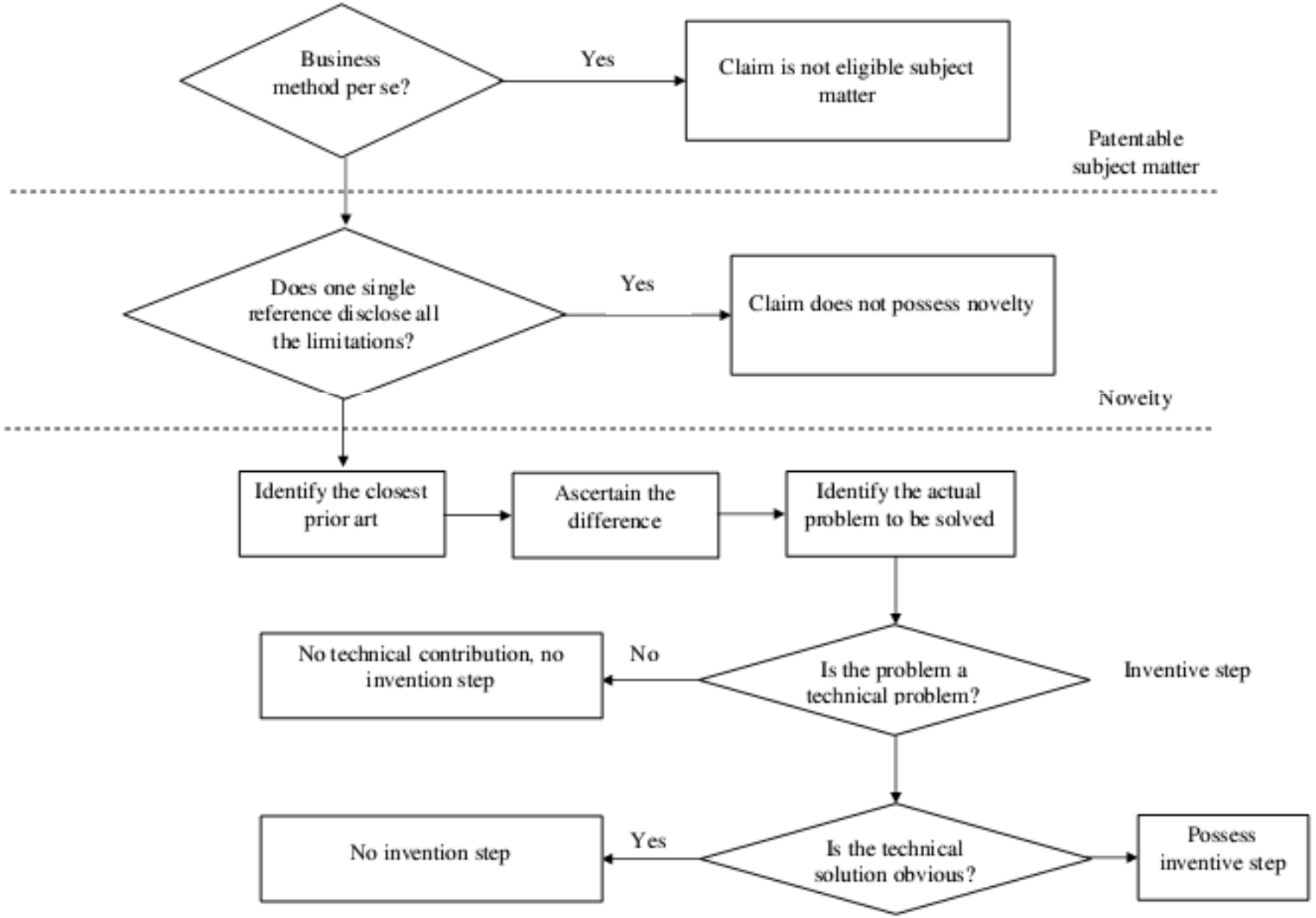
  - cannot be added into the specification later

- Avoid using trademark to identify a product

Drawings

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

Current examination practice for invention related to business methods



Business method per se

- If a claim does not have any technical features, it is business method per se.

  Example:

  A method for selling insurance on a network, characterized in that, using ***an insurance business terminal equipment*** which has ***an inputting keyboard, an identity card reader, a network connection device and a printing device***, and ***a system server*** connected to the network to perform insurance sales, the method comprises:

  S1, ***specifying*** a type of insurance and detailed content of the insurance through the inputting keyboard;

  S2, ***reading***, by the card reader, identity information of a policyholder, ***processing and saving*** it;

  S3, ***sending***, by insurance business terminal equipment, the type of insurance, detailed content of the insurance and identity information of the policyholder to the system server over the network;

  S4, printing insurance policy.

- It is ***not*** business method per se
- The difference between this example and its reference is that the example uses an inputting device to enter the type of insurance and detailed content of the insurance. In contrast, the reference uses a handwriting input device or a touch screen as an inputting device.
- The real problem to be solved is how to input information. It is a technical problem.
- Is the difference obvious? Yes. No inventive step.

Impacts on patent applications

- Number of rejections on patentable subject matter will be reduced due to this more objective approach.

- In the specification, describe technical problem and technical effect of important features of claims. (it is not only helpful for patentable subject matter determination but also helpful for inventive step argument).

- In claims, use technical limitation, such as hardware, “read”, “process”, “save” and “send”, other than just “calculate”.

Thank You

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