

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Cooperation Treaty Updates from the USPTO

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# The Patent Cooperation Treaty

- A United Nations Treaty
  - signed June 1970
  - became operational June 1978
  - administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland
  - Currently 148 Contracting States
    - Excludes countries not recognized by the United Nations, e.g., Taiwan



# International Patent?

- An international application is filed under the PCT but...
  - there is no “international patent”
  - the PCT functions as a patent application filing system
  - the international application must still be prosecuted in each national or regional office where patent protection is desired

# Purposes of the PCT

- To simplify the process of filing foreign patent applications
- To give every regional and national patent Office and the applicant the benefit of
  - a search and opinion on patentability by a major patent Office
  - an optional further examination by a major patent Office

# PCT World Map

*(148 Contracting States on 04 July 2013)*

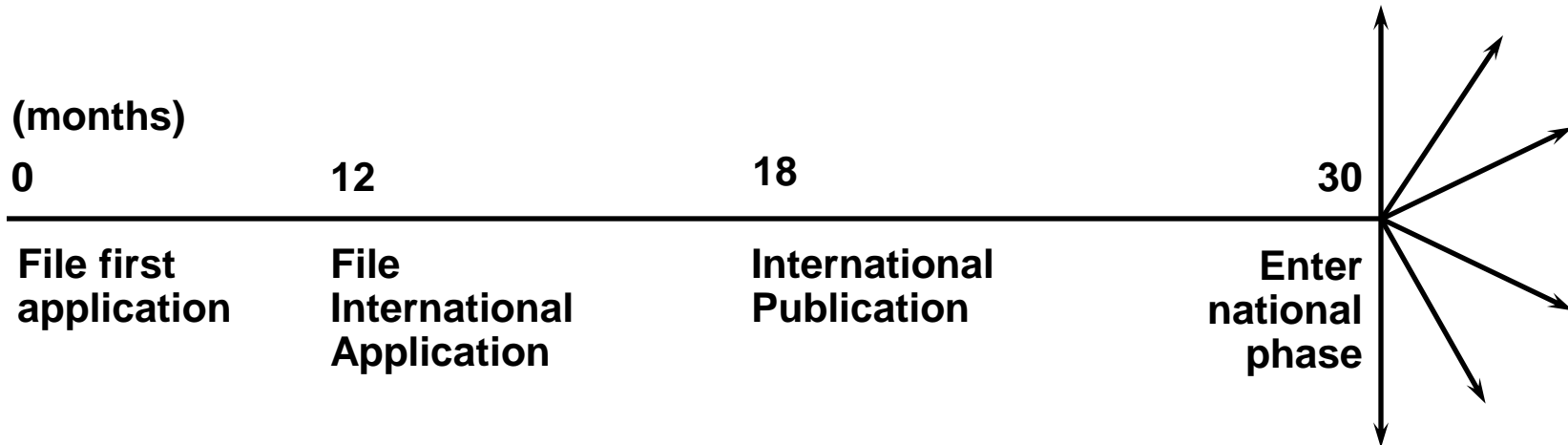


# The International Application

- A single application
  - filed together with a Request
    - by a resident/national of a PCT Contracting State
  - filed in one language
  - filed in one patent Office
    - the receiving Office (RO)
    - usually the applicant's home patent Office
  - treated as a national application
    - in each designated State as of the international filing date
- Formalities in compliance with the PCT
  - must be accepted during national phase



# PCT Filing Timeline



- Local patent application filed first
  - single international application filed at 12 months, claiming priority under the Paris Convention
    - one set of formalities requirements
    - one international phase prosecution
    - translations and national/regional fees and prosecution not required until 30 months



# Chapter I - Filing and Searching

- International application is
  - filed in a receiving Office (RO)
  - searched by an International Searching Authority (ISA)
- Documents issued
  - International Search Report
    - rarely, Declaration of Non-Establishment of ISR
  - Written Opinion of the ISA
    - reissued as IPRP (Chapter I) at 30 months
  - *optional* - Supplementary International Search Report

# Chapter I - Amendment and Publication

- *Optional* amendment to claims only, by applicant
  - filed directly with the IB under PCT Article 19
    - complete set of claims
    - within 2 months of ISR mailing date
- Publication of international application by the IB
  - with ISR and Article 19 amendments, if any
  - available on IB web site - PATENTSCOPE

# Chapter II (optional)

## Preliminary Examination by the IPEA

- A Demand is filed with an IPEA
  - usually accompanied by a response to the WOISA
    - arguments, and/or
    - Article 34 amendment to the description, claims, drawings
- Documents issued
  - International Preliminary Report on Patentability (Chapter II)
    - usually the only office action issued by the IPEA
    - no appeal or further prosecution during international stage once issued
  - Written Opinion of the IPEA
    - issued only in extraordinary circumstances



# National Stage Requirements

- PCT Articles 22 and 39 require furnishing of the following for national/regional stage entry
  - a copy of the international application
    - unless already provided by the International Bureau
  - a translation of the international application
    - where appropriate
  - the national fee
- National/Regional Offices may have additional requirements
  - PCT Applicant's Guide provides details

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

- (1) Basic national fee
- (2) Copy of the IA as filed and an English translation, if applicable
- (3) Article 19 amendments, if any, and an English translation, if applicable
- (4) Oath/declaration complying with 35 U.S.C. 115 and 37 CFR 1.497
- (5) English translation of any annexes to the IPER/IPRP (amendments), if applicable

# PCT Benefits for Applicants

- Simplifies the process of filing foreign applications
  - one set of formality requirements
  - establishes a filing date in all PCT Contracting States
- Postpones costs
  - translation fees, filing fees, attorney fees
- Provides
  - an early indication of prior art and
  - a written opinion as to the novelty, inventive step and industrial applicability of the claimed invention
- Gives extra time for assessment of commercial viability in designated States



# PCT Benefits for Offices

- Provides every regional and national patent Office, where protection is sought, the benefit of
  - an International Search Report (ISR) and
  - Written Opinion of the International Searching Authority (WOISA)
  - *optionally*, a Supplementary International Search Report (SISR)
    - by a Supplementary International Searching Authority
  - *optionally*, an International Preliminary Report on Patentability (Chapter II) – IPRP (CH II)
    - by an International Preliminary Examining Authority (IPEA)

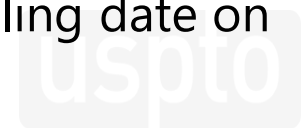


# **AIA Effects on the International Stage**



# Applicants for U.S. Patent Applications

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



# Applicants for PCT Applications - International Stage (1)

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

# Applicants for PCT Applications - International Stage (2)

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

<b>Box No. I</b> <b>TITLE OF INVENTION</b>	
PROCESS FOR FOLDING WRAPPING PAPER FOR CHOCOLATES	
<b>Box No. II</b> <b>APPLICANT</b> <input type="checkbox"/> This person is also inventor	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i> CANDY WRAP UNLIMITED, INC. 300 Colorado Street Baltimore, Maryland 21201-4307 United States of America	Telephone No. (+1-301) 876-5432
	Facsimile No. (+1-301) 876-5555
	Applicant's registration No. with the Office
<b>E-mail authorization:</b> 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. <input type="checkbox"/> as advance copies followed by paper notifications; or <input checked="" type="checkbox"/> exclusively in electronic form (no paper notifications will be sent). E-mail address: candy@anumma.com	
State <i>(that is, country)</i> of nationality: US	State <i>(that is, country)</i> of residence: US
This person is applicant for the purposes of: <input checked="" type="checkbox"/> all designated States <input type="checkbox"/> the States indicated in the Supplemental Box	

# Applicants for PCT Applications - International Stage (3)

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



# Important Practice Tips

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

# **AIA and PLT Effects on U. S. National Stage Applications Under 35 U.S.C. 371**



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

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

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

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



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

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

# Inventorship in 35 U.S.C. 371

## National Stage Applications (2)

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

# Inventor's Oath or Declaration (1)

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

# Inventor's Oath or Declaration (2)

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

# Substitute Statements

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



# Assignment-Statement (1)

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



# Assignment-Statement (2)

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



# 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
    - Under 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, [...]”
      - See 37 CFR 1.114(e)(3) as amended in Hague Final Rule Package
    - 35 U.S.C. 371(**c**) requires the filing of an oath/dec of the inventor



# Important Practice Tips

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



# 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 U.S. 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 the Right of Priority in the U.S. National Stage (2)

- Where priority was not restored in the international stage, 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

# Questions?

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PCT Help Desk

(571) 272-4300

Monday – Friday 8:30am – 5:00pm ET

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