

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Patent Cooperation Treaty Updates from the USPTO

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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 151 Contracting States
 - Excludes countries not recognized by the United Nations
 - *E.g.*, Taiwan



WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION



uspto

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 IA must still be prosecuted in each national or regional office where patent protection is desired

PCT World Map



November 2016

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 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
 - For filing in the national/regional Offices
 - 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 (Chapter II)
 - By an International Preliminary Examining Authority (IPEA)

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 (Form PCT/ISA/210)
 - Rarely, declaration of non-establishment of ISR (Form PCT/ISA/203)
 - Written Opinion of the ISA (Form PCT/ISA/237)
 - Reissued as the International Preliminary Report on Patentability (Chapter I) at 30 months (Form PCT/IB/373)
 - *Optional* - Supplementary International Search Report (Form PCT/SISA/501)

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
 - Occurs at 18 months from the priority date
 - Includes the 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
- IPEA will issue
 - International Preliminary Report on Patentability (Chapter II) (Form PCT/IPEA/409)
 - Usually the only office action issued by the IPEA
 - No appeal or further prosecution during the international stage once issued
 - Written Opinion of the IPEA (Form PCT/IPEA/408)
 - Issued only in extraordinary circumstances by the IPEA/US

National Stage Requirements

- PCT Articles 22 & 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
 - Due at 30 months from the priority date
- (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

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 national stage applications originating 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 Sep 2012
 - An applicant for the purposes of the United States may be a/an
 - 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 No. II) as an applicant for “**all designated States**” and Inventor X indicated (in Box No. III) as “**inventor only**”

Applicants for PCT Applications - International Stage (2)

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

| | |
|---|---|
| Box No. I TITLE OF INVENTION | |
| PROCESS FOR FOLDING WRAPPING PAPER FOR CHOCOLATES | |
| Box No. II APPLICANT <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> | Telephone No. (+1-301) 876-5432 |
| CANDY WRAP UNLIMITED, INC. 300 Colorado Street Baltimore, Maryland 21201-4307 United States of America | 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. <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 . . . | |
| Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S) | |
| <i>If none of the following sub-boxes is used, this sheet should not be included in the request.</i> | |
| <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>JONES, Mary 1600 South Eads Street Arlington, Virginia 22202-2913 United States of America</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> | |
| <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> | |

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 having an **international filing date** on or after 16 Sep 2012
 - Will be those applicants identified in the international stage for the United States
 - Unless changed in the national stage (37 CFR 1.46(c))
 - For a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including
 - The fee set forth in 37 CFR 1.17(g),
 - A showing that such person has sufficient proprietary interest, and
 - A statement that making the application is appropriate to preserve the rights of the parties (37 CFR 1.46(b)(2))

Applicants for 35 U.S.C. 371

National Stage Applications (2)

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

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

- Inventorship in a §371 application of IA having an **international filing date** 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(s) 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 on the same day, via the Electronic Patent Assignment System (EPAS), for the application number received in EFS-Web

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 AIA Oath/Declaration

- May postpone submission until application is in the 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 resident, if the inventor lives at the location different than the mailing address
 - Surcharge of \$140 required (37 CFR 1.492(h))
 - Reducible by 50% for small entity and 75% for micro entity
 - 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
 - To indicate the relationship (*i.e.*, continuation, divisional, or continuation-in-part) to any nonprovisional U.S. application to which benefit was claimed in the international application
 - If relationship was not indicated in the Request or captured on the 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 by applicant to request restoration, or
 - Refusal of a request for restoration by the receiving Office

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, indicates 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



PCT & PPH

- PCT-PPH (Patent Prosecution Highway)
 - National, or regional, stage applications
 - Leverages positive opinion of claims by the ISA or IPEA to
 - Expedite prosecution of claims towards patentability
 - Provide quicker patentability determinations
 - List of PCT-PPH agreements
 - <http://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

ePCT for Filing in RO/US

- As of 01 June 2016, 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>

Collaborative Search Pilots

- Pilots with JPO and KIPO
- Parallel Pilots testing prosecution efficiencies taking different approaches to initial search and examination
 - JPO – Serial search on substantially similar claims prior to Pre Interview Communication
 - KIPO – Parallel search on substantially similar claims
 - Both offices' searches sent to applicant for consideration in response to Pre Interview Communication



Global Dossier

- Participating Offices
 - USPTO, EPO, JPO, KIPO, and SIPO
- **First Release (November 2015)**
 - Access to all available information about applications and patents in the participating offices with the first service – Dossier access
 - Applicants can efficiently track and manage related applications across jurisdictions
 - Easier and less costly to perform functions associated with due diligence, technology transfer, and litigation and appeal processes
- Example of Future Services
 - Document exchange functionality, alerts, and XML functionality
- <http://globaldossier.uspto.gov/>



Questions?

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