

PCT PRACTICE

International Applications Filed Prior to January 1, 2004

Abraham J. Rosner

I. Introduction

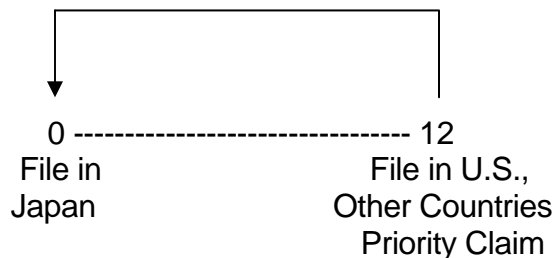
The PCT (Patent Cooperation Treaty) is an international agreement for the purpose of unifying and simplifying the procedures for filing patent applications by a national or resident of one member country in other member countries.

The PCT has two parts including Chapter I and Chapter II. Chapter I includes the filing of an international application, an international search, publication and national phase entry into designated countries. Chapter II is optional and includes international preliminary examination and national phase entry into elected countries.

II. Foreign Filing of Patent Applications

A. Paris Convention

Under Article 4 of the Paris Union Convention, a resident or national of a member country may first file a patent application in any member country and then file a patent application for the same invention in any other member country within 12 months of the first filing date. The subsequently filed application is treated as if it was filed in the other member country on the earlier filing date. This is called the “right of priority”.



B. Effective Filing Date and the Right of Priority under the PCT

Under the PCT, the filing of an international application has the effect of filing a regular national application in each designated state. That is, the PCT filing date is considered to be the actual filing date in each designated country. The corresponding U.S. statute is as follows.

§363 International application designating the United States: Effect

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent Office except as otherwise provided in section 102(e) of this title.

Furthermore, under the PCT, the right of priority may be claimed based on one or more earlier applications filed in any member country of the Paris Convention. The statutory basis in the U.S. for obtaining the right of priority to the foreign application is as follows.

35 U.S.C. §365(b)

(b) In accordance with the conditions and requirement of section 119(a) of this title and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

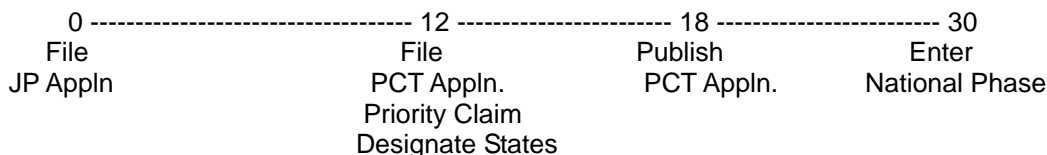
Namely, §365(b) provides that an international application designating the United States shall be entitled to the right of priority based on a prior foreign application.

The foreign priority claim is proper if (1) a claim for foreign priority was made in the international application, and (2) the foreign application was filed within 12 months prior to the international filing date.

C. Entering the U.S. National Stage

A typical PCT route for filing a patent application in the United States (or other countries) includes filing an international (PCT) application which designates the United States (and perhaps other countries), and which further claims priority from a foreign (home)

application. To preserve the right of priority, the PCT application must be filed within 12 months of the filing date of the foreign priority application. The PCT application is published 18 months after the priority date. To avoid abandonment of the PCT application as to the United States, the applicant must enter the U.S. national phase not later than 30 months from the priority date (37 C.F.R. § 1.495).



D. Paris Convention vs. PCT

An important motivation for filing via PCT as opposed to Paris Convention is that a decision as to whether or not to enter the national phase can be deferred for a time of up to 30 months from the priority date. Accordingly, the concomitant costs of preparing a translation and filing a national phase application can likewise be deferred.

III. PCT Chapter I Process

A. Overview

Chapter I of the PCT allows for centralized filing and searching of a single international application. One or more member countries are designated for national phase entry when filing a PCT application in the Receiving Office of a member country. The PCT application may also claim priority to an application for the same invention filed within 12 months of the PCT filing date. After the International Searching Authority conducts an international search, the International Bureau distributes copies of the PCT application and search report to each designated national patent office. The applicant may one time amend the claims of the international application (Article 19 amendment). The application and search report are published 18 months after the priority date. The applicant must complete the requirements for entering the national stage by the expiration of 30 months from the priority date. Substantive examination is then carried out by each of the designated national patent offices in accordance with their respective national laws.

0	-----	12	-----	18	-----	30
File JP Appln.	File PCT Designate States Priority Claim	International Search	Article 19 Amd.	Publish PCT Appln. Search Report	Enter National Phase	

B. Receiving Offices

A Receiving Office is the national patent office of the state of which the applicant or at least one of joint applicants is a resident or national.

C. International Searching Authority

The international search is carried out by an International Searching Authority (ISA) which is a national patent office appointed by the International Bureau.

The international search is based on the claims of the international application. Only material that was made public prior to the PCT filing date is considered prior art.

The ISA issues a search report in which relevant documents are identified with a letter code which explains why the document was cited.

D. Designated Office

A designated office is the patent office of a PCT member state which has been designated for national phase entry. The international bureau (IB) transmits a copy of the international application and search report to each designated office for examination according to the national law of the designated state. This is called the “national phase”.

IV. PCT Chapter II Process

A. Overview

Under Chapter II, an applicant may file a “demand” to have its application examined by an International Preliminary Examining Authority (IPEA). The examining authority prepares an International Preliminary Examination Report (IPER), including a

non-binding Written Opinion as to novelty, inventive step (unobviousness) and industrial applicability (utility) of the invention.

A Chapter II Demand for international preliminary examination must be made within 19 months of the claimed priority date.

One benefit of Chapter II is that it allows the applicant an opportunity to consider the International Preliminary Examination Report (IPER) before making a decision about entering the national phase in each elected country.

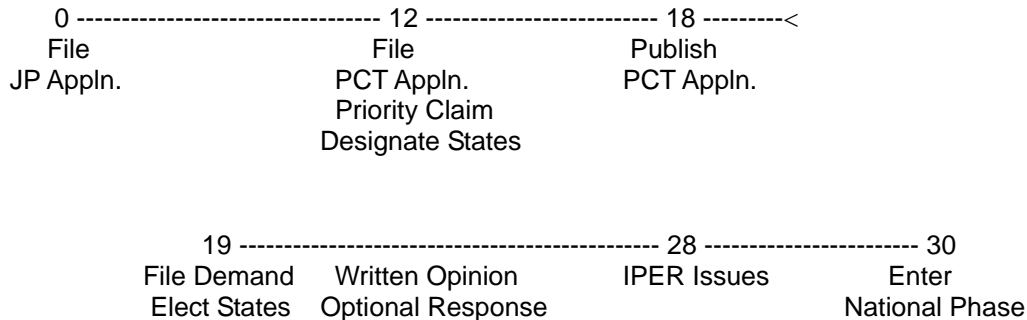
Under Chapter I member states are “designated” for national phase entry. Under Chapter II, member states are “elected” to receive the International Preliminary Examination Report (IPER).

In the Demand, the applicant may elect some or all of those states which were designated under Chapter I. The Demand (for international preliminary examination) is filed with an International Preliminary Examining Authority (IPEA) along with the requisite fee.

The applicant may amend the claims, the description and the drawings (Article 34 Amendment), which amendment cannot go beyond the disclosure in the international application as filed. That is, examination enables the applicant to attempt to obtain a positive IPER, which in some elected Offices is used as a basis for the issuance of a patent.

The IPEA examiner examines the application and issues a Written Opinion. The applicant can respond to the Written Opinion. An International Preliminary Examination Report (IPER) is then issued, and the applicant must then enter the national phase of each elected state within 30 months of the priority date.

B. PCT Chapter II Time Line



C. The Demand

The Demand is a form used to elect some or all of those states which were previously designated under Chapter I along with a fee calculation sheet. However, states that were not designated at the time the PCT application was filed cannot be elected in the Demand.

D. International Preliminary Examination

The claims of the international application are examined with respect to novelty, inventive step and industrial applicability. For purposes of examination, prior art constitutes written disclosures, drawings or other illustrations available to the public prior to the international filing date or the priority date. Oral disclosures, public uses and other non-written disclosures are not prior art for purposes of Chapter II examination. Prior art for purposes of International Preliminary Examination may be different from the definition of prior art in the respective elected states.

E. The Written Opinion

The Written Opinion is a non-binding opinion as to novelty, inventive step and industrial applicability. No “rejections” are made, and the examiner may suggest amendments.

F. The Reply

If the applicant disagrees with the Written Opinion, the applicant has a short time to reply by amending the application and/or making arguments (generally 2 months). If time permits, the examiner may issue a second Written Opinion, taking into consideration the applicant's response.

G. The International Preliminary Examination Report

The IPER must issue within 28 months of the priority date, and is provided to each elected office. The Report summarizes the conclusions of the examiner in the Written Opinion. Article 34 Amendments are annexed to the IPER and communicated to the elected offices.

Even if the Report is unfavorable, the applicant may still proceed with national stage entry where patentability will be determined based on the national laws of the elected state. Because the Report is issued within 28 months of the priority date, the applicant has two months in which to decide whether or not to enter the national stage.

V. Entry Into the U.S. National Stage as a Designated Office or as an Elected Office

The requirements for entry into the U.S. national phase as a designated or elected office are set forth in 35 U.S.C. §371 and 37 C.F.R. §1.495 as follows.

- (1) Pay the national fee.
- (2) File a copy of the international application (unless already received from the International Bureau), and an English translation if the international application was filed in another language.
- (3) File any amendments to the claims of the international application made under Article 19 unless previously communicated to the PTO by the

International Bureau, and an English translation if such amendments were made in another language.

- (4) File an oath or declaration of the inventor. For entry into the U.S. national phase, the applicant must be the inventor.
- (5) File an English translation of any annexes to the international preliminary examination report, if made in another language.

To avoid abandonment where the U.S. has not been “elected” (where no Chapter II Demand has been filed), or where the U.S. has been “elected” by the expiration of 19 months from the priority date, the applicant must submit to the PTO within 30 months from the priority date:

- (1) a copy of the international application (unless previously forwarded by the International Bureau or unless originally filed in the U.S. Receiving Office);
and
- (2) the basic national fee.

If the oath or declaration and English translation (if needed) are not timely filed, then the applicant will be given an extendible time period within which to file the translation and/or oath or declaration in order to prevent abandonment of the application. Article 19 amendments not received by the end of the 30 month period are canceled. The applicant may also request entry of Article 34 Amendments. Payment of the national fee cannot be extended and there is no grace period. The International Bureau ordinarily will automatically forward a copy of the international application to the designated or elected office.

The designated or elected office will not begin national processing before expiration of the respective 20 and 30 month periods. However, the applicant may request the national stage to begin earlier.

PCT PRACTICE
Highlights of Changes
International Applications Filed on or After January 1, 2004
(from WIPO Newsletter - November 2003)

I. EISPE system: Enhanced International Search and Preliminary Examination

- Convergence of Chapter I and II procedures
 - Chapters I and II remain legally distinct
- Request
 - All PCT member states and types of protection are automatically designated
 - Fee reduction for electronic filing
 - Signature of only one applicant required to file
- Search
 - The international searching authority (ISA) establishes a written opinion based on the claims as filed *at the same time it establishes an International Search Report.*
- International Preliminary Report on Patentability (IPRP) for every application
 - Chapter I: IPRP = written opinion by ISA
 - Chapter II: IPRP = IPER
- Amendments
 - The claims may still be amended pursuant to PCT Article 19. The applicant normally has 2 months from the date of transmittal of the international search report to amend the claims.
- Main difference
 - Chapter I: no applicant/examiner dialogue or amendments before IPRP issues
 - Chapter II: dialogue with examiner and amendments possible before IPRP issues

II. Written Opinion by ISA Examiner:

- ISA examiner prepares ISR *plus* detailed written opinion (IPRP) for *every* application
- Written opinion by ISA has similar scope and content as current written opinion by IPEA (International Preliminary Examining Authority)
- Written opinion by ISA sent to applicant with ISR
- ISR is published with application; written opinion by ISA is *not* published
- Applicant may informally submit comments to IB on written opinion prepared by ISA

III. EISPE System: Chapter I:

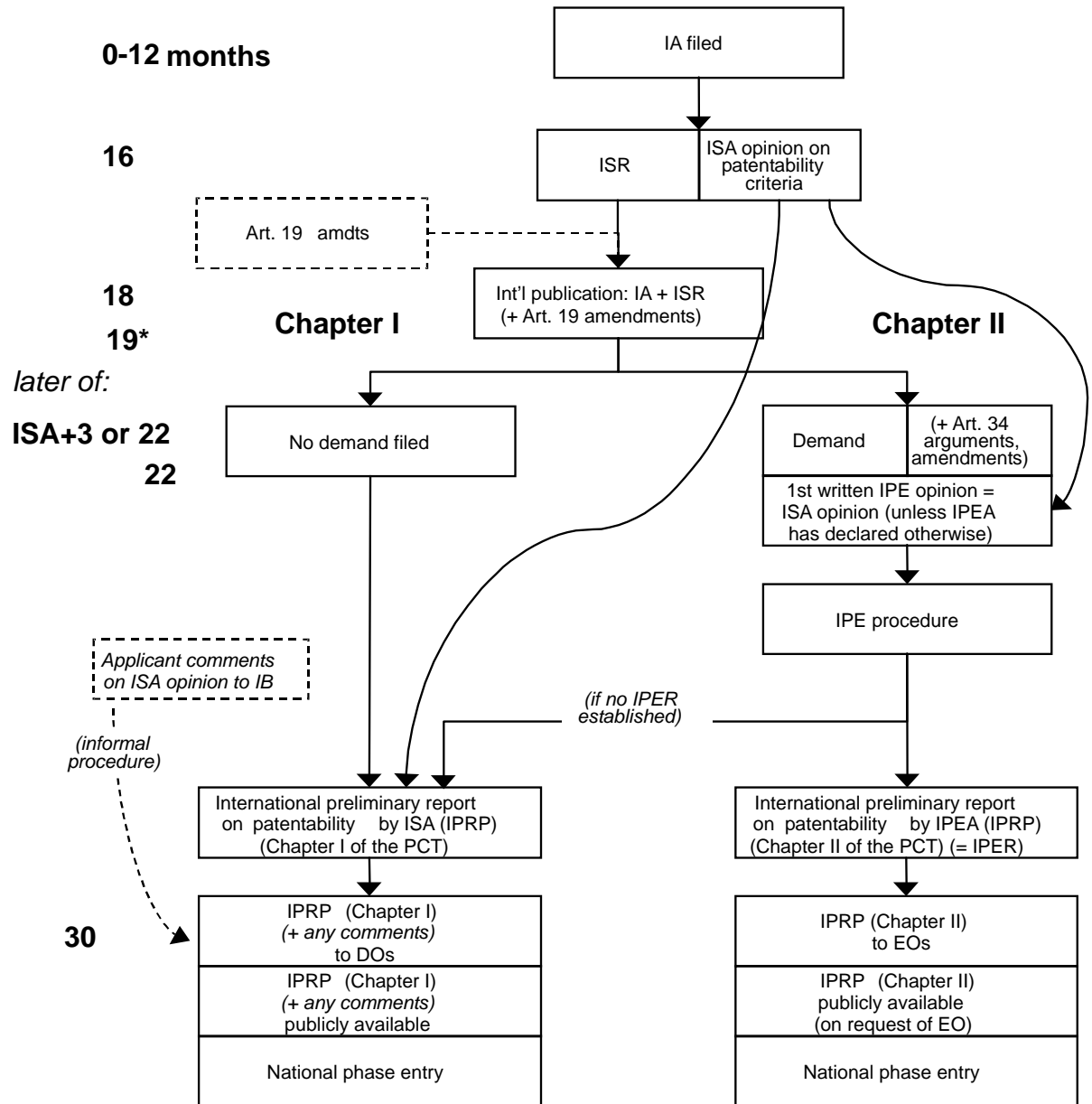
- If applicant does not request IPE (does not request International Preliminary Examination):
 - IB establishes “International Preliminary Report on Patentability” IPRP (Chapter I) based on written opinion by ISA
 - IPRP (Chapter I) and any comments by the applicant
 - are sent to designated Offices
 - are made publicly available (but not “published” like application and ISR)
 - but not before the expiration of 30 months from the priority date
 - The applicant must complete the requirements for entering the national stage by the expiration of 30 months from the priority date

IV. EISPE System Chapter II:

- All designated states are always elected
 - In response to the written opinion of the ISA, the applicant may file a demand (and amendments and/or arguments) for International Preliminary Examination (IPE) by the International Preliminary Examining Authority (IPEA) within 3 months of the ISR or 22 months from the priority date, whichever is later.
- When applicant requests IPE (by filing a demand):
 - written opinion by ISA becomes written opinion by IPEA (exception: IPEA decides not to accept written opinions by certain ISAs)

- amendments under Article 34 and/or arguments should be submitted together with the demand
- comments by applicant on written opinion by ISA not sent to IPEA (Article 34 amendments/arguments only)
- “normal” IPE procedure
- IPEA establishes IPRP (Chapter II) (= current IPER)
- The applicant must complete the requirements for entering the national stage by the expiration of 30 months from the priority date
- IPRP (Chapter II) is sent to elected Offices and made publicly available by IB on behalf of any elected Office which so requests, but not before the expiration of 30 months from the priority date

EISPE system



* must in practice file demand by 19 months for Article 22 transitional reservation countries

PCT PRACTICE

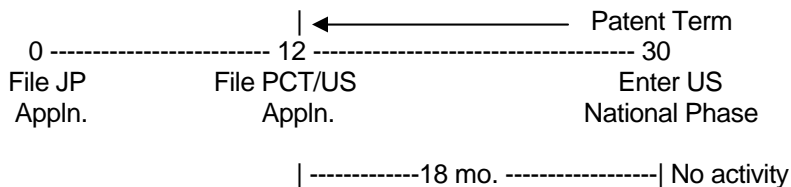
Additional Considerations Relating to U.S. National Stage Entry

I. Patent Term

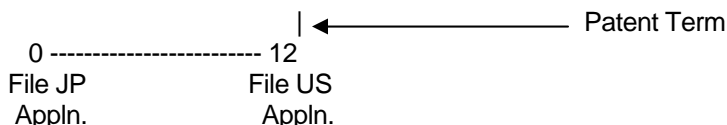
A U.S. patent which issues based on a PCT application designating the U.S. and filed on or after June 8, 1995 has a term of 20 years from the PCT filing date.

Assuming that a PCT application is filed 12 months from the priority date, use of the PCT filing route delays national stage entry until 30 months from the priority date. This potentially reduces patent term by up to 18 months (period of no activity) as compared to the Paris Convention route.

PCT



Paris Convention



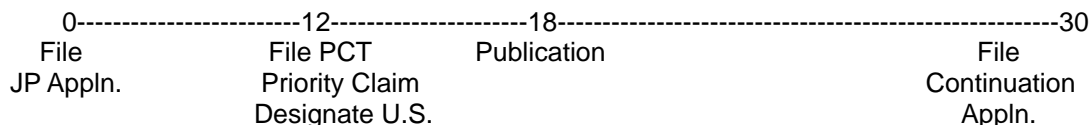
II. Filing a Continuation Application as an Alternative to National Stage Entry in The United States

A. Introduction

Instead of completing the requirements for entry into the national stage under 35 U.S.C. §371(c), it is possible to instead file a continuation or continuation-in-part (CIP) of a

PCT application designating the United States. The MPEP discusses this alternative filing route at §§1895 and 1896.

B. Continuation Procedure



The PCT application is filed within 12 months of the Japanese application, and designates the U.S. (and perhaps other countries). The continuation application is filed while the PCT application remains pending with respect to the United States (*i.e.*, within 30 months from the priority date), includes a specific reference to the PCT application and has at least one inventor in common with the PCT application. Priority is claimed from the Japanese application.

C. Restriction Practice

The unity of invention criteria (37 C.F.R. §1.475) are more liberal for a PCT application and a national phase application as compared to the restriction criteria (37 C.F.R. §§1.141 and 1.142) that are applied to a regularly filed U.S. application such as a continuation application. For example, the examiner can require restriction between a product and a process of use of that product in a continuation application if, *e.g.*, the process for using as claimed can be practiced with another materially different product (MPEP §806.05(h)). However, the examiner cannot require such an election in a national phase application (further providing that the two groups of claims are directed to a “single general inventive concept”). This difference should be taken into consideration when selecting between national stage entry and filing of a continuation application. That is, one would want to avoid the extra expense of filing a divisional application where the PCT application contains restrictable claims.

D. Continuation-in-Part and Revising the PCT Application

An exact, literal translation of the international application is to be filed upon entering the national stage. PCT Article 46, MPEP §1893.01(d) and 35 U.S.C. §375(b).

On the other hand, a benefit of the continuation route is that the applicant can revise the specification of the PCT application and then file the revised case as a continuation application. In order to obtain the benefit of the filing date of the PCT application, the claims of the continuation application must find support in the PCT application.

The continuation may also be filed as a continuation-in-part of the PCT application in case of changes and/or additions that are not supported by the PCT application. This is discussed in MPEP §§1895 and 1896.

III. PRIOR ART STATUS OF U.S. PATENTS AND PUBLISHED U.S. PATENT APPLICATIONS BASED ON A PCT APPLICATION

A. Offensive Prior Art Date under 35 U.S.C. §102(e)(1) and (2)

Foreign patents and technical literature references are prior art as of their publication date. 35 U.S.C. §102(a). On the other hand, U.S. patents and published U.S. patent applications are available as prior art as of their effective U.S. filing date.

It is often desirable to secure an early §102(e) offensive prior art date because this is the date that the issued patent or published U.S. patent application is prior art against other U.S. applicants. §102(e)(1) is specific to published U.S. patent applications. §102(e)(2) addresses the prior art status of U.S. patents. The development of this area of U.S. patent law as it relates to U.S. patents and published U.S. applications based on a PCT application, is summarized below.

35 U.S.C. §102(e)(1):

Type of Published U.S. Patent Application	Prior Art Status
(i) U.S. patent application published by the USPTO, based on a regularly filed U.S. national application	Available as prior art as of its U.S. filing date
(ii) U.S. patent application published by the USPTO, based on the U.S. national stage of a PCT application filed on or after November 29, 2000, where the PCT application was published by WIPO in English	Available as prior art as of its PCT filing date
(iii) U.S. patent application published by the USPTO, based on the U.S. national stage of a PCT application filed on or after November 29, 2000, where the PCT application was published by WIPO in a language other than English	No prior art date under §102(e), although the published PCT application is available as prior art under §102(a) or (b) as of the publication date of the PCT application
(iv) U.S. patent application published by the USPTO, based on the U.S. national stage of a PCT application filed before November 29, 2000	No prior art date under §102(e), independent of whether or not the PCT application was published by WIPO in English. However, the published PCT application is available as prior art under §102(a) or (b) as of the publication date of the PCT application

35 U.S.C. §102(e)(2):

Type of U.S. Patent	Prior Art Status
(i) U.S. patent, by another, granted on a regularly filed U.S. national application	Available as prior art as of its U.S. filing date
(ii) U.S. patent, by another, granted on the U.S. national stage of a PCT application filed before November 29, 2000	Available as prior art as of the date that the requirements under 35 U.S.C. §371(c)(1), (2) and (4) have been met (filing fee, English translation and Declaration on file)
(iii) U.S. patent, by another, granted on the U.S. national stage of a PCT application filed on or after November 29, 2000, where PCT application was published by WIPO in English	Available as prior art as of its PCT filing date
(iv) U.S. patent, by another, granted on the U.S. national stage of a PCT application filed on or after November 29, 2000, where the PCT application was published by WIPO in a language other than English	No prior art date under §102(e), although the published PCT application is available as prior art under §102(a) or (b) as of the publication date of the PCT application

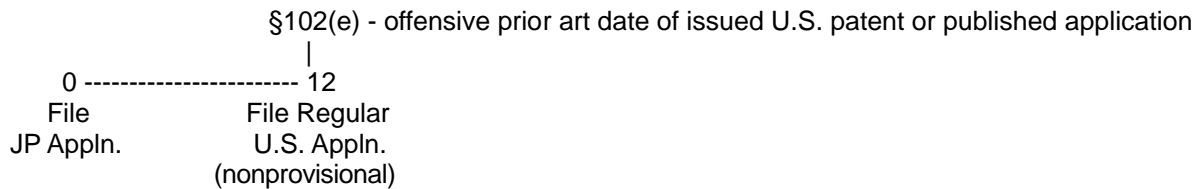
35 U.S.C. §102(e)(1) and (2)

A person shall be entitled to a patent unless -

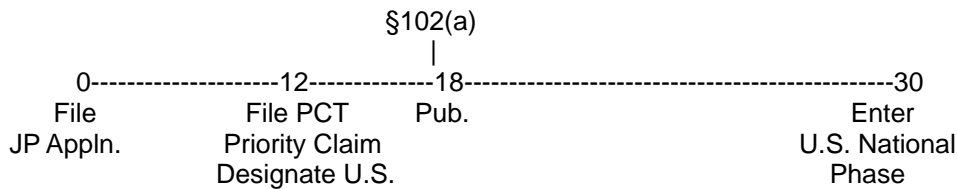
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty define in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Unless the PCT application is published by WIPO in English, a U.S. patent issuing from a PCT application or a published U.S. patent application based on a PCT application has NO §102(e) offensive prior art date (for PCT applications filed on or after November 29, 2000). However, the published PCT application will be available as prior art under §102(a) or (b) as of its publication date.

Paris Convention - a U.S. patent or published U.S. patent application based on a nonprovisional application is available as prior art under §102(e) as of its U.S. filing date:



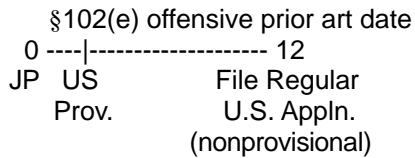
PCT Route - PCT application published by WIPO in a language other than English: No §102(e) offensive prior art date, but the published PCT application is available as prior art under §102(a):



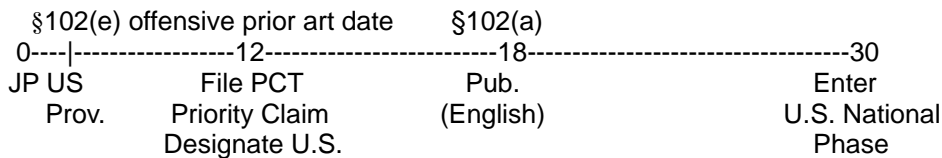
In other words, if obtaining an early §102(e) offensive prior art date is important, then either the regular convention route should be used or the PCT application should be filed in English (so that the PCT application is published by WIPO in English).

An even more effective way to move back the §102(e) offensive prior art date is to concurrently file a U.S. provisional application shortly after filing the basic Japanese application. A nonprovisional application may then be filed in the United States, claiming benefit from both the Japanese and U.S. provisional applications. A U.S. patent or published U.S. patent application based thereon has a §102(e) offensive prior art date as of the U.S. provisional filing date. The PCT route may also be used to enjoy an early §102(e) offensive prior art date, but the PCT application must be published by WIPO in English.

Paris Convention: Claim benefit of both the Japanese and US provisional applications



PCT Route: Claim benefit of both the Japanese and US provisional applications, PCT application filed and published by WIPO in English



GLOSSARY - PCT PRACTICE

1. Paris Convention

The Paris Convention is a multilateral treaty covering patents, industrial designs, trademarks and other intellectual property. A major purpose of the Paris Convention is to protect the intellectual property of foreign nationals to the same extent and under the same conditions as that nation protects the intellectual property of its own nationals (principle of national treatment). Another major purpose is to provide international priority periods within which foreign nationals may file applications for patents and for protection of industrial designs and trademarks. Under the Paris Convention, a filing in one signatory nation relates back to an earlier filing in another signatory nation, as long as the two filings are made within specified time periods.

2. Right of Priority

The right of priority under the Paris Convention allows a resident or national of a member country to first file a patent application in any member country and to then file a patent application for the same invention in any other member country within 12 months of the first filing date. The subsequently filed application is treated as if it was filed in the other member country on the earlier filing date. This is called the “right of priority”.

3. PCT

The PCT (Patent Cooperation Treaty) is an international agreement for the purpose of unifying and simplifying the procedures for filing patent applications by a

national or resident of one member country in other member countries. The PCT entered into force in 1978.

4. PCT Chapters I and II

The PCT has two parts including Chapter I and Chapter II. Chapter I includes the filing of an international application, an international search, publication and national phase entry into designated countries within 30 months of the priority date. Chapter II is optional and includes international preliminary examination and national phase entry into elected countries within 30 months of the priority date.

5. Receiving Office

A Receiving Office is the national patent office of the state of which the applicant or at least one of joint applicants is a resident or national.

6. International Bureau

The International bureau publishes the international application and search report 18 months after the claimed priority date, and provides copies to each of the designated offices specified in the application.

7. International Searching Authority

An International Searching Authority (ISA) is the patent office of a PCT member state which has been appointed by the International Bureau to conduct an international search.

8. Designated Office

A designated office is the patent office of a PCT member state which has been designated for national phase entry within 20 months of the priority date under PCT Chapter I.

9. Article 19 Amendment

A provision of the PCT which provides the applicant one opportunity to amend the claims of the international application by filing amendments with the International Bureau after receiving the international search report.

10. National Phase Entry

Transfer of an international application from international processing to examination in accordance with the national laws of the designated or elected member countries. To initiate national phase entry, the applicant submits to each of the designated or elected offices where national examination is desired a copy of the international application and translation, if needed, and the required national fee, within 20 or 30 months from the priority date, respectively.

11. Demand

The Demand is a form used to elect some or all of those states which were previously designated under Chapter I along with a fee calculation sheet.

12. Elected Office

An elected office is the patent office of a PCT member state which has been elected to receive the International Preliminary Examination Report under PCT Chapter II. The applicant must initiate national phase entry within 30 months of the priority date.

13. International Preliminary Examining Authority

An International Preliminary Examining Authority is the patent office of a PCT member state which has been appointed by the International Bureau to examine an international application under PCT Chapter II and to prepare an International Preliminary Examination Report. The Report must issue within 28 months of the priority date, and is provided to each elected office. The Report summarizes the conclusions of the examiner in the Written Opinion.

14. Written Opinion

The Written Opinion is a non-binding opinion as to novelty, inventive step and industrial applicability. No “rejections” are made, and the examiner may suggest amendments.

15. International Preliminary Examination Report

The International Preliminary Examination Report is issued by the International Preliminary Examining Authority within 28 months of the priority date, and is provided to each elected office. The Report summarizes the conclusions of the examiner in the Written Opinion.

For PCT Applications Filed on or After January 1, 2004

16. EISPE System

Enhanced International Search and Preliminary Examination. For PCT applications filed on or after January 1, 2004, the ISA establishes a written opinion based on the claims as filed at the same time it establishes an International Search Report.

17. IPRP

International Preliminary Report on Patentability. If applicant does not demand IPE (International Preliminary Examination), ISA issues IPRP based on the written opinion. If applicant requests IPE, IPEA issues IPRP, adopting written opinion of ISA, and further taking into considerations applicant's arguments and/or amendments (Article 34 Amendment) presented with the filing of the demand.

18. IPEA

International Preliminary Examining Authority. Establishes Chapter II IPRP.