

PART I

PCT Bypass US Applications

BENJAMIN J. HAUPTMAN

ADJUNCT PROFESSOR
University of New Hampshire School of Law
<http://law.unh.edu>

SENIOR PARTNER
Lowe Hauptman Ham & Berner LLP
Suite 300
1700 Diagonal St
Alexandria VA 22314
Tel. (703) 684-1111
Fax. (703) 518-5499
<http://www.ipfirm.com>

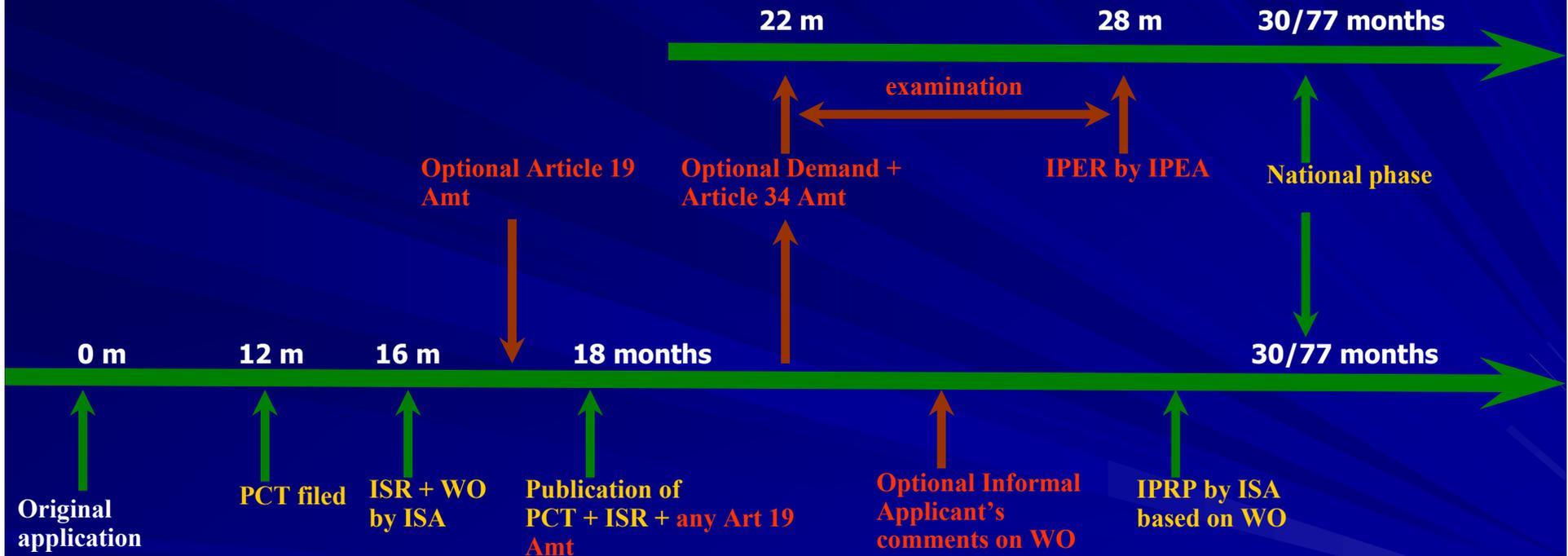
What is PCT

- PCT is a system for filing (not granting) patent applications
 - There is no international/PCT patent
- Applicant must prosecute PCT application in each national or regional office in order to obtain a patent
- Only for inventions (not for trademarks or industrial designs)
- As of 1 March 2007, PCT has 137 Contracting States
 - Single application in 137 countries
- Administered by WIPO (World Intellectual Property Organization)

How PCT works?

Typical timeline

- US = 30m
- EP = 31m
- JP = 30m + 2m for translation
- CN = 30 m + 2m (with fees)
- CA = 30 m + 12m (with fees) = 42m



ISR = International Search Report
 WO = Written Opinion
 IPRP = International Preliminary Report on Patentability
 ISA = International Search Authority examination
 IPER = International Preliminary Examination Report
 IPEA = International Preliminary Examining Authority

Art 19 Amt → in response to ISR and WO – claims only
 Art 34 Amt → amend Spec, claims, draws for
 Demand → to request additional patentability analysis

Requirements for PCT Filing Date

- PCT request form
- Description
- One or more claims
- Name of Applicant
- Applicant has residence or nationality of a contracting state
 - **Non-PCT member**
 - PCT can still be filed if at least one inventor or Applicant has residence or nationality of a PCT member
 - Filing fee can be submitted within 1 month from PCT filing date
 - All states are now automatically designated
 - **Filing date = last sheet received**
 - Began to fax application to WIPO at 11:55pm (Geneva) Dec 31, 2009
 - Last sheet received 00:05am Jan 1, 2010 → PCT filing date is 1/1/10

Advantages of PCT

- Simplify and reduce cost of patent filings
- Provide Patent Offices of small/developing countries with benefit of search and examination reports by major patent offices, ie, US PTO, EPO, JPO
- Provide early notice of relevant prior art and written opinion on patentability of claimed invention
- Provide extra time (up to 30/77 months) for evaluation of commercial viability of invention in designated countries
- Delay foreign-filing expenses associated with translations, foreign-filing fees, foreign agent's fees

Important information on whether and/or where to enter national phase

Cost effectiveness

Paris Convention vs. PCT

1. **Paris Convention** is recommended if
 - application is to be filed in only a few countries
 - No need to defer filing cost

2. **PCT** is recommended if
 - many countries or undecided
 - Applicant want to defer filing cost or buy time
 - Defer expensive translation cost for extra 18-19 months compared to Paris Convention

Paris Convention vs. PCT

1. Paris Convention:

Multiple patent applications, one in **each** country where protection is desired

2. Patent Cooperation Treaty (PCT)

Single international application designating all desired member states + **later nationalization**

- National phase application must be true translation of PCT. If PCT has errors, they are included in National phase application
- Non-US: may be difficult to fix PCT's errors in National phase
- **US: by-pass continuation (fixing errors) or by-pass CIP (introducing new subject matter)**

From PCT to US

- **US National Phase** application should be the exact translation of PCT application plus any amendments made in PCT phase
 - Reason: PCT and US National phase are one and the same application (in international and US phases, respectively) → no changes allowed.
- **US bypass application** permits deviation from PCT application
 - If US bypass application includes no subject matter unsupported by PCT application, it is a **continuation**
 - Otherwise, it is a **CIP** of PCT application

National phase v. Bypass

- Same priority benefit
- Same 20y patent term (counted from PCT filing)
- Same filing fees
 - National phase is cheaper if USPTO = ISA/IPEA
- Same PPH eligibility
- **Bypass requires slightly more complex procedure**
 - Certified copy of Priority Doc should be re-submitted
 - **Not a big deal**, because certified copies can be e-retrieved
 - ISR references should be filed in IDSs
 - **Not a big deal**, because in a National phase, if PTO fails to consider ISR references, IDSs will be needed anyway

Bypass advantages

- Easy correction of translational/minor errors in JP priority application or PCT application
- Incorporation by reference of JP priority application (if not made in PCT) is permitted
 - Not permitted in national phase
 - Easy fix for missing page issues that may occur when PCT is filed
- Correction of defective disclosure (enablement/support) → bypass CIP
- Disclosure/claiming post-PCT developments → bypass CIP

Bypass advantages

– US attorney's revision/disclosure enhancement

- Not necessarily requires CIP status
- Improves language, clarity
- Addresses US-specific issues:
 - Hardware description needed in computer related inventions → avoid 101 issues
 - Removal of harmful wordings → maximize US claim scope
 - Claim revision/addition →
 - shorten and facilitate effective prosecution,
 - avoid extra/multi-dependent claim fees
- Identifies and corrects any fatal defects (e.g., enablement) before US examination begins

Bypass: Continuation v. CIP

- Bypass continuation:
 - No new matter compared to PCT
 - Deviation from PCT language is permitted

- Bypass CIP:
 - New matter added to PCT
 - To correct major issues: enablement, support
 - To incorporate improvements developed after PCT filing
 - Claims are treated differently
 - claims supported by JP/PCT application is entitled to the JP date
 - claims not supported by JP/PCT is given the CIP bypass date

PCT Bypass Filing Path 1

- JP priority → PCT in JPO → US bypass
- Similar to traditional path, except for US bypass instead of national phase
- Minimal changes to preexisting filing procedure
- All advantages of PCT bypass (see previous slides)

PCT Bypass Filing Path 2

- JP priority → PCT in USPTO → US bypass
- PCT in English can be reviewed and enhanced by US attorney and used in other countries
- If PCT has already been enhanced, US bypass may be replaced with national phase for slightly simpler procedure

PCT Bypass Filing Path 3

- **Direct PCT** (no JP priority) → **US bypass**
- US attorneys can directly draft PCT in English, working with with JP inventors and in-houses
- If PCT is US-drafted, US bypass may be replaced with national phase for slightly simpler procedure