

Paris and PCT exercises

(revised 24 February 2008)

1. Inventor files a French patent application on April 9, 2000, disclosing invention A. Inventor files a second French patent application on April 12, 2000, disclosing inventions A and B. What is the last date on which the inventor can file a US patent application directed to invention A?
2. Same facts as 1, except the inventor wishes to be able claim priority from both French patent applications.
3. Same facts as 1, except the inventor only wishes to be able to claim priority from the April 12, 2000 French patent application.
4. Same facts as 1, except that invention A was disclosed in a printed publication on April 10, 1999. What is the last date on which the inventor can file a US patent application directed to invention A?
5. Same facts as 1, except that the April 9, 2000 and April 12, 2000 filings were US provisional applications rather than French patent applications. What is the last date on which the inventor can file a US patent application directed to invention A? (Assume that the inventor wishes to be able claim priority from both provisional patent applications.)
6. Same facts as 5, except that the inventor only wishes to be able to claim priority from the April 12, 2000 provisional patent application.
7. Same facts as 4, except that the April 9, 2000 and April 12, 2000 filings were US provisional applications rather than French patent applications. What is the last date on which the inventor can file a US patent application directed to invention A?
8. Same facts as 1, except the French patent applications are design patent applications. What is the last date on which the inventor can file a US design patent application directed to invention A? (Assume that the inventor wishes to be able claim priority from both French patent applications.)
9. Inventor files a French patent application on April 9, 2000, disclosing invention A. Inventor files a second French patent application on April 12, 2000, disclosing inventions A and B. What is the last date on which the inventor can file a US patent application directed to invention B?
10. Inventor files a French patent application on April 9, 2000, disclosing invention A. Inventor files a second French patent application on April 12, 2000, disclosing inventions A and B. What is the last date on which the inventor can file a US patent application directed to both inventions

A and B?

11. Inventor files a French patent application on April 9, 2000, disclosing invention A. Inventor files a second French patent application on April 12, 2000, disclosing inventions A and B. Invention A was disclosed in a printed publication on April 1, 2000. It is now April 11, 2001. Is the inventor going to be able to file a US patent application directed to invention A, and if so, how?
12. Today is Saturday, March 31, 2001. A French patent application was filed a year ago, March 31, 2000. Is it too late to file a US patent application claiming priority from the French application?
13. Same as question 12 except the previous application was a US provisional application, not a French application.
14. Same as question 12 except the French application was a design application.
15. May a US application claim priority from more than one foreign application?
16. You filed a US full patent application for a client five months ago. What should you be telling the client about foreign filing?
17. Same question as 16 except the application was a provisional application.
18. Same question as 16 except the application was a design patent application.
19. You filed a provisional application for the client eleven months ago, and a full US application five months ago. What should you be telling the client about foreign filing?
20. Your client wants to file a patent application on today's date in Japan. It is, however, 4 PM where you are (in Colorado) and it is already tomorrow in Japan. Under what circumstances, if any, may you fulfill the client's wishes?
21. May a PCT application claim priority from more than one previous patent application?
22. May a PCT application claim priority from a previous PCT patent application?
23. Is it possible to file a PCT application that does not claim priority from any previous patent application?
24. You filed a provisional patent application on August 11, 2005. You filed a PCT on August 11, 2006, which claims priority from the provisional. What is the due date for entering the US national stage?
25. How does your answer to 24 change if the subject matter of the provisional has nothing in common with the subject matter of the PCT?
26. Same question as 24 except the PCT was filed two months earlier.
27. You filed a provisional on August 11, 2005. You filed a PCT on August 11, 2006, which

- claims priority from the provisional. When was (or will) the PCT application published?
28. Same question as 27 except the PCT was filed two months earlier.
 29. Same question as 27 except the PCT was filed two months later.
 30. You filed a provisional on August 10, 2005. You filed a PCT on August 10, 2006, which claims priority from the provisional. It is now March 11, 2008. Is there any way you can now enter the US national stage?
 31. Same question as 30 except what you would like to do is enter the regional stage in the European Patent Office?
 32. Same question as 30 except the priority document was a French patent application.
 33. Same question as 31 except the priority document was a French patent application.
 34. You filed a PCT application, have today received an International Search Report, and would like to amend the claims so that the amended claims will be published by the International Bureau of WIPO. By what date must you do so?
 35. You filed a provisional on April 11, 2000, disclosing invention A. On April 10, 2001, you have invented related invention A'. Today, may you file a PCT application directed to both A and A'?
 36. How does the answer to question 35 change if the April 11, 2000 application was a French patent application?
 37. How does the answer to 35 change if the application you wish to file today is a regular US patent application?
 38. Try to identify some major countries that do *not* belong to the Paris Convention or to the Patent Cooperation Treaty.
 39. You filed a US provisional patent application on January 11, 2007. Today is February 11, 2008, and you realize to your horror that you meant to file a PCT application claiming priority from the US provisional. It is, of course, a month past the due date for such a PCT filing. You exercised due care and yet you still missed the due date. Is there any way to overcome this problem?
 40. Same as question 39 except that you are unable to establish that you exercised due care. Nonetheless you are able to establish that you did not intend to miss the due date.
 41. Considering the “office timeliness” information, what can you suggest as to the pros and cons of selecting US, EP, or KR as your International Searching Authority?