

2022 Virtual PCT Training Seminar

Session 13

Choosing Between U.S. National-Phase Entry and Bypass Continuation

Monday, March 14, 2022



Before We Get Started...



Recording

A recording of this session will be posted to the Attendee Hub after the live session ends.



Questions

Please enter questions in the Q&A feature in the Zoom menu.



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A Word about Your Presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner



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How Can You Ask Questions?

- Ask your questions in the “questions” box, not the chat box
- I might try to post some answers in the Attendee Hub later
- Consider posting some questions in the PCT Listserv (email discussion group sponsored by my firm)
- I might post some answers in my blog (Ant-Like Persistence blog)

Helpful PCT Resources

- WIPO’s PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
- WIPO’s PCT Applicant’s Guide
- The PCT listserv (email discussion group)
- PCT section of the *Ant-Like Persistence* blog

Helpful PCT Resources

- WIPO's PCT Help Desk
 - +41 22 338 83 38
- USPTO's PCT Help Desk
 - +1 571 272 4300
- Make sure you are subscribed to WIPO's *PCT Newsletter*



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Upcoming ePCT Webinars That I Will Be Presenting

- Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA
- Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts
- Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work
- Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel
- Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions
- Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications
- Filing a new US PCT application in RO/US using ePCT
- Filing a new US PCT application in RO/IB using ePCT
- ePCT actions and communications with the IB
- External signatures and PCT declarations
- Sequence listings and ePCT
- Using ePCT to e-file in ISAs and IPEAs, filing Demands
- Doing 92bis changes
- Docketing of PCT applications and making use of ePCT notifications
- Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents

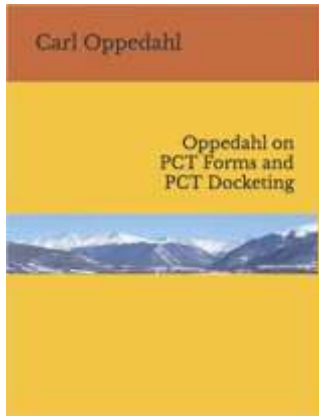
Don't want to miss them? Subscribe to the PCT listserv or subscribe to my blog (or both).



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Helpful PCT Resources



- The fifty PCT forms that you are most likely to encounter
- Which dockets to set or clear when these forms arrive
- What dates and check boxes to check on the forms
- Warning signs that you can detect from the forms
- Order through your local bookstore
- Also available at shop.oppedahl.com
- Also available on Amazon
- ISBN-13 : 979-8766914655
- Paperback : 218 pages
- A bargain at USD 89

Specific Goals

Review some background that will help us to keep in mind the various advantages and disadvantages of the two approaches:

- National phase entry and
- Bypass continuation

Discuss in detail the advantages and disadvantages of the two approaches

Identify Best Practices and traps for the unwary for each of the two approaches

Pursuing U.S. Patent Protection from a PCT Application

There are two ways to pursue U.S. patent protection from a PCT application:

- US national phase
- Bypass continuation

Be alert to the possibility of making use of the Patent Prosecution Highway

U.S. Legal Basis for the Two Approaches

- National phase gets its legal basis from 35 USC § 371
- Bypass continuation gets its legal basis from 35 USC § 111a and 35 USC § 120

Comparing National Phase with Bypass Continuation

Examiner's ability to impose restriction requirement

- With national phase, the restriction standard is “unity of invention”
- With bypass, the restriction standard is the regular domestic “distinct invention” standard
- Many applicants prefer the “unity of invention” standard

National Phase and Unity of Invention

Is the USPTO as a designated office bound by the unity of invention determination made by the International Searching Authority?

Sorry, no.

The US Examiner might restrict more ways than the ISA did.

You will get nowhere saying, “the ISA only said there were this many inventions!”

National Phase and Unity of Invention

The US Examiner in a national-phase case might get it wrong.

In such a case, the US Examiner might mail out a Restriction Requirement that uses ordinary domestic “distinct invention” language instead of the correct and applicable “unity of invention” language.

If this happens you can ask that it be withdrawn and you will absolutely win.

What will the Examiner do then?

Maybe the Examiner will give up and actually examine both of the independent claims rather than going to the trouble of digging through old Patent Academy notes to see how to do the restriction correctly.

Note that in such a case what you do not want to do is “traverse” – no no no no no no no!

You are asking that the RR be withdrawn.

National Phase and Unity of Invention

The US Examiner in a national-phase case might get it right.

In such a case, the US Examiner might mail out a Restriction Requirement that uses the correct and applicable “unity of invention” language.

Many practitioners feel that under this “unity of invention” restriction standard, an Examiner cannot get away with restricting as narrowly as Examiners often seem to do when they use the ordinary domestic “distinct invention” standard.

The practitioners who feel this way will often tell you that this is their chief reason for avoiding use of bypass continuations and instead making almost exclusive use of national-phase entry.

National Phase and Unity of Invention

When the US Examiner mails out a Restriction Requirement that uses the correct and applicable “unity of invention” language...

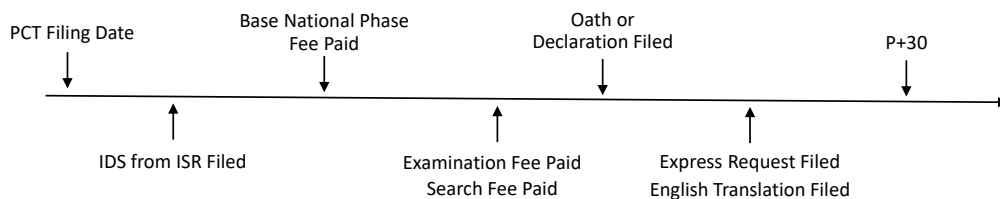
is the Examiner also permitted to layer a “species-type” restriction requirement on top of the “unity of invention” restriction?

Sorry, yes.

We had one case in our office where the number of divisional applications that would have been required, to get every species examined, would have been in excess of two thousand.

The client did not have enough money to pay for all of the divisional applications.

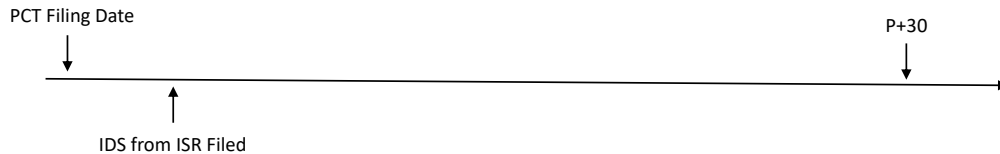
Dribs and Drabs



The important thing here is that there is absolutely no penalty for failing to file these things on different days if the path you pick is US national phase!

I greatly prefer US national phase for this reason.

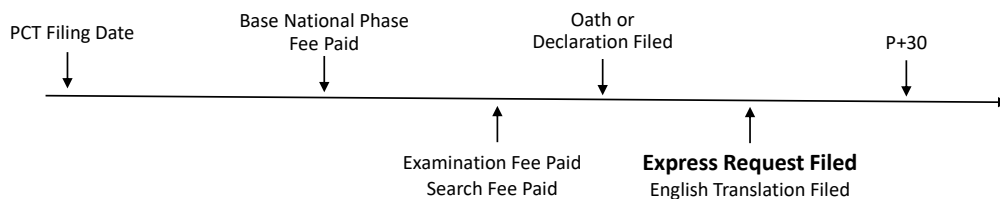
Avoiding Malpractice— Guaranteeing That You Will Never Forget to File That IDS from the ISR



This means you can get that IDS filed from the ISR, and you never need to worry what if I were to forget to file that IDS?

This is a very nice malpractice-avoidance Best Practice.

Malpractice Avoidance— Filing That Express Request



When you are using US national phase, and the 30 months has not yet passed, and you have indeed handed in everything that you need to hand in, it is malpractice not to hand in your Express Request. Failing to hand it in can lose PTA. Failing to hand it in can lose your place in the queue for examination.

National Phase? National Stage?

There is no such thing as “national stage”.

- Nowhere in the Patent Cooperation Treaty
- Nowhere in the PCT Rules
- Nowhere in the PCT Administrative Instructions
- Nowhere in the PCT Applicant’s Guide

The correct terminology is “national phase”.

The US joined the PCT in 1978.

Somebody at the USPTO made a mistake and referred to it in the earliest USPTO documents as “national stage”.

It stuck and has propagated throughout the USPTO’s rules and the MPEP.

Decades have passed and by now the mistake will never get fixed.

The correct terminology is “national phase”.



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Comparing National Phase with Bypass Continuation

Certified Copies of Priority Applications

- With national phase, nearly always the certified copies are taken care of automatically as part of the PCT process.
- With bypass, it is the applicant's responsibility to attend to the certified copies.
- The priority Office may belong to PDX.
- The priority Office may be a Depositing Office to DAS



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Certified Copies

The main point here is that if you for some reason are sitting on a particular PCT application for which it would be supremely difficult to obtain certified copies in any ordinary way (paper copies, PDX, DAS)...

But if the certified copies are all right there in Patentscope already...

Then this is a factor that strongly favors using US national phase rather than a bypass continuation.

Comparing National Phase with Bypass Continuation

Getting Help from the USPTO

- With national phase, you get to use the PCT Help Desk
 - (+1 571 272 4300)
- With bypass, your source of help is the Application Assistance Unit
 - (+1 571 272 4000)

Polling Question

Comparing National Phase with Bypass Continuation

Occasionally an applicant will have a PCT application in which a would-be priority claim was not timely presented

- In a US national phase case from the PCT, the priority claim problem can be corrected only by filing an expensive petition
- In a bypass continuation from the PCT, the priority claim problem can be corrected at no charge

Comparing National Phase with Bypass Continuation

Suppose the 30-month date has arrived and client has not given clear instructions whether to proceed

- With a bypass continuation, the filing fee could be handed in late so long as you do not mind paying a late fee
- With a US national phase entry, you must pay the base national phase filing fee within the 30 months
- This permits you to avoid getting stiffed on the bill for the government fee if the client later says they never actually wanted to spend any money
- If you pick the bypass continuation path and have the self-control to hold back from paying any government fees
- Keep in mind that you could use the “file by reference” check box in an ADS and the whole filing could be just one or two mouse clicks

What If You Missed the 30 Months?

Yes what if you missed the 30 months?

Recall that when the PCT application got filed, it was a bundle of 126 patent applications

One of them was a US patent application.

See 35 USC § 363 – “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 and Trademark Office except as otherwise provided in section 102(e).”

So when you missed the 30 months, that US patent application went abandoned.

You can revive it!

Well, so long as the abandonment was unintentional, you can revive it.

You pay a fee, you file a petition, you say the entire period of delay was unintentional (of course this needs to be true), and next thing you know, the USPTO will grant the petition.

Anytime You Petition to Revive...

Any time that you petition to revive, you must include with the petition whatever it is that you wish you had done back when you needed to do it. In this case, the payment of the base national phase fee and the identification of the PCT application.

There is a dedicated USPTO form for this purpose.

The Dedicated USPTO Form Is Extremely Poorly Designed

The dedicated USPTO form jams together two bundles of words:

- A first word bundle in the dedicated USPTO form is the petition to revive.
- A second word bundle in the dedicated USPTO form is the statement under penalty of perjury that the entire period of delay was unintentional.
- Of course under USPTO rules, where the applicant is anyone other than a natural person, we understand that the first word bundle (the petition) is required to be signed by a registered practitioner.
- So you or I will have to sign that word bundle.
- Then we get to the second word bundle, the part where somebody is going to have to stick their neck out and state under penalty of perjury that they know exactly how and why the 30-month date got missed.

The Dedicated USPTO Form Is Extremely Poorly Designed

The dedicated USPTO form tries to force it that a single signer will serve two roles:

- The signer will be the registered practitioner who is representing the (legal entity) applicant, and
- The signer will be the person who is personally stating that he or she is the person who has personal knowledge that the entire period of delay was unintentional.
- Of course in many real-life situations, the person with personal knowledge as to the circumstances of the delay is someone other than the practitioner.
- You will probably have to push and push to get the USPTO petitions person to understand this.

If I am not the one who is responsible for having missed the 30-month date, there ain't no way I am signing the part that says I have personal knowledge about how and why the 30-month date got missed, when that's not true. Just sayin'.

Still Other Factors That Might Influence the Choice of National Phase Versus Bypass Continuation

Suppose the PCT application itself is a mess?

Suppose lots of inventing has happened since the PCT application got filed?

Suppose the client sort of does not want to draw attention to the fact that what we are filing now has lots of stuff in it that is not exactly the same as what was in the PCT application when it got filed?

National Phase Versus Bypass

You have a PCT in which “small entity” status was established.

And the applicant ceased to be small.

Now if you enter national phase you get to keep paying “small entity” fees.

If you file a bypass, you have to start paying large entity fees.

Suppose the PCT Application Itself Is a Mess?

Suppose it is a very poor quality translation into English from some other language?

If you use national phase, and then try to clean it up, you will have to use strikethroughs and underscores.

Probably also a substitute spec.

Probably you will have to make a representation that no new matter has been added.

TYFNIL this representation will guarantee you seven hours of a hot seat in a deposition.

Maybe a bypass continuation is the better path.

Suppose Lots of Inventing Has Happened Since the PCT Application Got Filed?

Yeah, if so, then maybe you don't just want to enter the US national phase.

Maybe enter the US national phase and also, on the side, file a CIP.

Or maybe just file a CIP.

In that CIP, some claims might be entitled to different effective filing dates than other claims.

It could be a mess.

Suppose the Client Sort of Does Not Want to Draw Attention to the Fact That What We Are Filing Now Has Lots of Stuff in it That Is Not Exactly the Same as What Was in the PCT Application When It Got Filed?

Surely we all realize that if there really is new matter, then TYFNIL the adversary is not going to get fooled by filing a continuation and holding back from calling it a CIP. If it really was a CIP all along, the adversary will be all over this.

Still, there are many practitioners who will file a bypass continuation specifically because the client has a goal of not drawing unnecessary attention to the things that are non-identical to what was in the PCT application as filed. Much of this is in the nature of a business decision.

Patent Prosecution Highway

A favorable ISR/WO can be used to get a US national phase case put onto the Highway

But it can just as well be used to get a bypass continuation case put onto the Highway

This is not a factor that should prompt picking one path or the other

37 CFR § 1.496

Most US practitioners know nothing of this rule.

Most US Examiners know nothing of this rule.

This rule entitles you to have your US national-phase application “advanced out of turn for examination” if your claims (as presented in the US case) are claims that were found patentable by the ISA/US.

For this to work, of course you had to have selected ISA/US.

I never pick ISA/US.

But some applicants often pick ISA/US.

(ISA/US can be really inexpensive if you are a micro filer.)

37 CFR § 1.496

If your claims (as presented in the US case) are claims that were found patentable by the ISA/US,

Then your US national phase search fee drops to zero

And your US national phase examination fee drops to zero.

But this Rule 496 is only available for US national phase. It is not available for bypass continuations.

37 CFR § 1.496

If you do choose to make use of Rule 496, then it will be up to you to badger the Examiner to actually give you the “advanced out of turn for examination” service to which you are entitled.

Nothing in the USPTO systems will signal the Examiner in any way about this obligation to take the case “out of turn”.

You will probably have to make multiple phone calls.

Polling Question

PCT Declaration #4

The foreign patent practitioners who are trendy, modern, and up-to-date will make use of PCT Declaration Number 4.

At 29 months or so you are entrusted to attend to entry into the US national phase.

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes.

PCT Declaration #4

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes

Suppose you fail to notice that they did this (For example, you don't think to even look in Patentscope to see that they did this.).

And then you prepare Forms AIA/01, asking the foreign patent practitioner to round up the inventor signatures on the declarations of inventorship.

This is going to make you look really stupid in the eyes of the foreign patent practitioner.

I bet they will send their next case to some other smarter US patent practitioner.

Maybe it would be better to go to the trouble to look in Patentscope to see whether they did this.

PCT Declaration #4

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes

If so, then surely you realize this means the foreign patent practitioner is probably trendy, modern and up-to-date.

Probably in the future you should send your outbound work to this foreign patent practitioner!

The Notice of Acceptance into the U.S. National Stage

This is a form prepared by a USPTO person.

The person lists the various “dribs and drabs” documents that you filed.

The person lists the dates upon which you supposedly filed the “dribs and drabs” things.

It is routine for the person to get dates wrong.

It is routine for the person to miss that you filed an Express Request.

This can harm your PTA.

You may need to ask that the Notice of Acceptance be corrected.

How Long It Takes to Get a Filing Receipt

Over the years, there have been widely varying differences in the delays in receiving Filing Receipts depending on whether you pick “national phase” or “bypass continuation”.

Usually “bypass continuation” is much faster.

These days “national phase” sometimes takes half a year.

Sometimes “bypass continuation” takes only a few days.

The main situations where this could be really vexing is if you were counting on prompt examination because of PPH.

Recording Assignments

If you record an assignment in EPAS against the PCT, will this “count” against the US application number when later you enter the US national phase?

Yes.

Yes in terms of the legal conclusion (35 USC § 363).

But yes also in the practical sense that later it will actually turn up in all of the databases when people look it up using the US application number.

Same thing if you go in the other sequence, recording against the US application number first.

Getting Assignments Signed and Recorded

By the way if you get a PCT application filed, what you do not want to do is wait until US national phase time to get signatures on assignments.

Do it as soon as you learn your PCT application number.

Get the assignments signed.

Get them recorded within 3 months of signing day. See 35 USC § 261. It is a professional liability risk to allow more than three months to pass.

Getting Assignments Signed and Recorded

So you decided to file a bypass continuation that is not text-identical to the PCT? And you cannot rule out the possibility that there is conceivably some new matter somewhere lurking in the new application?

Then of course you are going to need to round up signatures on fresh assignments, and get them recorded within three months. 35 USC § 261.

What Lies Ahead?

- Session 14 | Wednesday, March 16 – Best Practices and Procedure for US National-Phase Entry
- Session 15 | Friday, March 18 – Making Use of PCT-PPH, and Comparison with Track I and AE

Now maybe a few questions?

Thank you!

See you at the next session!