

2022 Virtual PCT Training Seminar

# Session 14

Best Practices and Procedure for U.S. National-Phase Entry

Wednesday, March 16, 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.

 **Social**

Follow us on LinkedIn or go to SLW Institute on slwip.com to see upcoming and on demand webinars.

## Disclaimer

This is not legal advice. Reading these slides or attending this webinar or viewing a recording does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.



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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



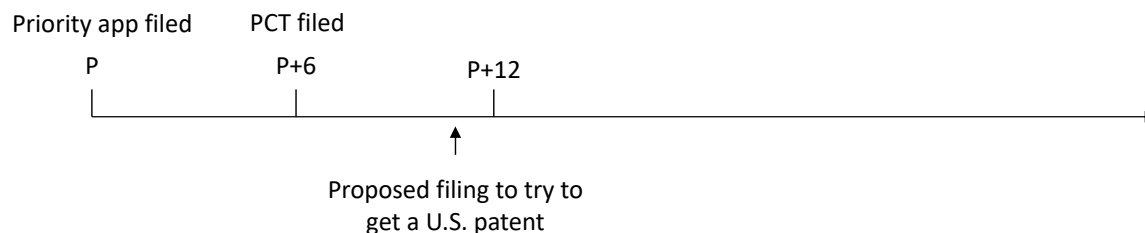
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## How Can You Ask Questions?

- 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)

## Trap for the Unwary: 20-Year Patent Term

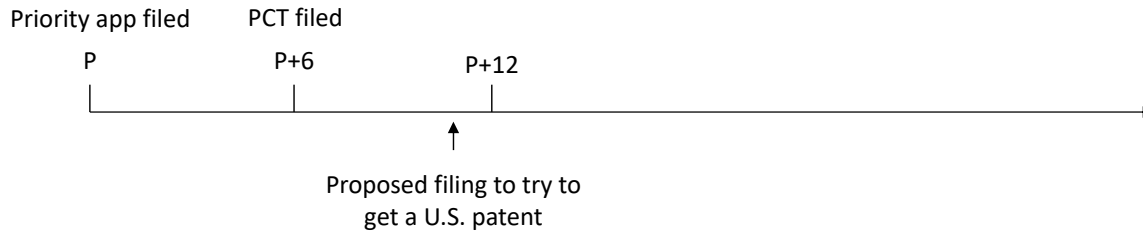


***We have not yet reached P+12.***

***Priority app might be non-U.S. filing or might be a U.S. provisional.***

***Should we use U.S. national phase? Should we use a bypass continuation?***

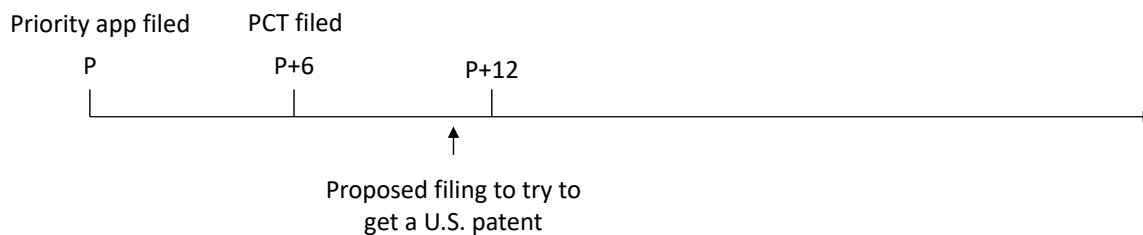
## Trap for the Unwary: 20-Year Patent Term



***Most filers would use U.S. national phase.***

***On this path, the 20-year U.S. patent term runs from the PCT filing date.***

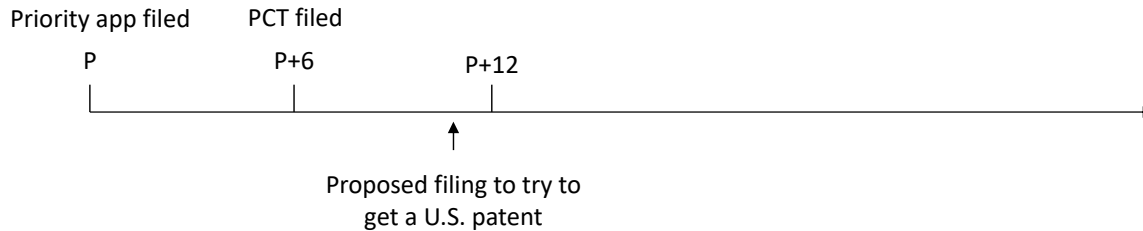
## Trap for the Unwary: 20-Year Patent Term



***If a bypass continuation is filed (meaning a 35 USC § 120 domestic benefit claim from the PCT) then the 20-year U.S. patent term runs from the PCT filing date.***

***This works out the same as the U.S. national-phase path.***

## Trap for the Unwary: 20-Year Patent Term



***Smart filer files a US 111a application that does not make any 35 USC § 120 domestic benefit claim.***

***Instead it merely makes two foreign priority claims (35 USC § 119 a-d).***

***The 20-year U.S. patent term runs from the 111a filing date.***

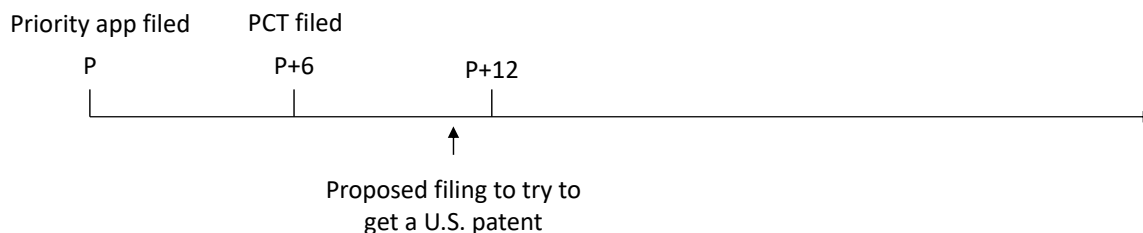
***You get an extra 5 months of patent term.***



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## Trap for the Unwary: 20-Year Patent Term



***What makes this trap are two things:***

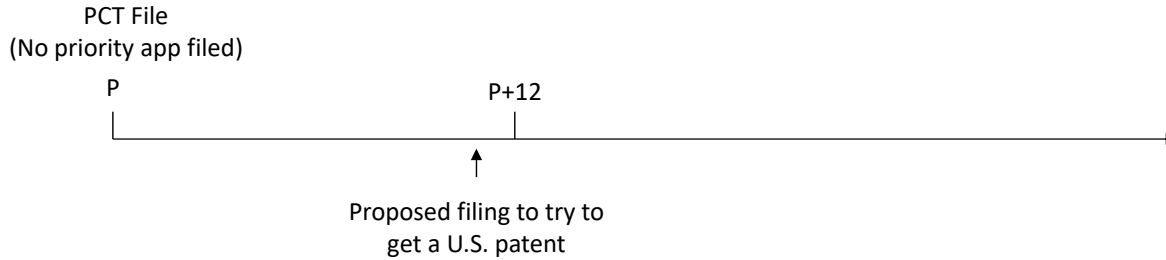
- ***The PCT got filed well in advance of the P+12 date, and***
- ***The proposed U.S. activity was also in advance of the P+12 date***



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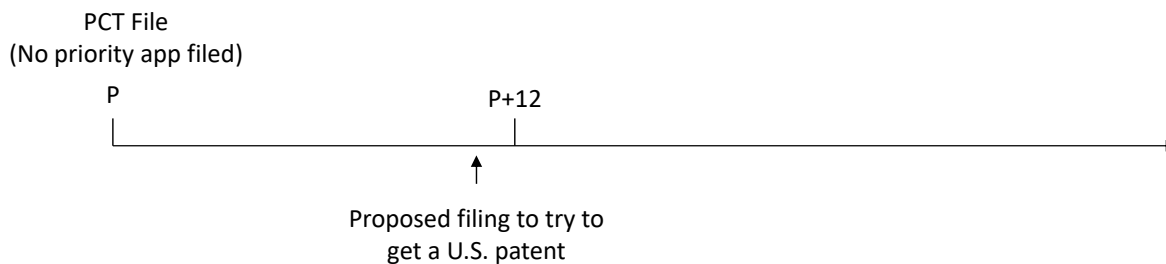
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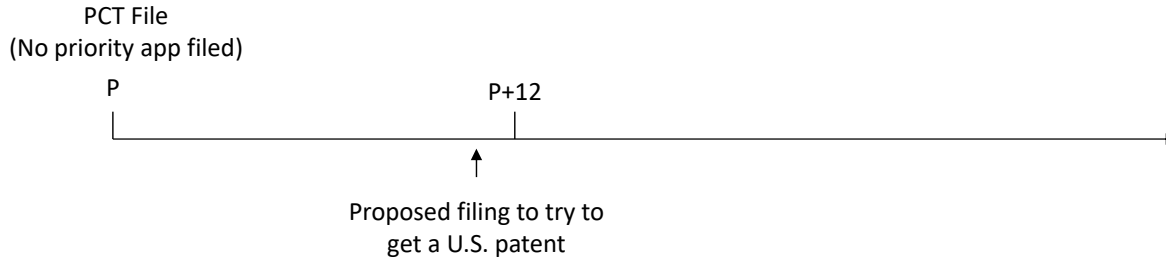
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***Most filers would use U.S. national phase.***

***On this path, the 20-year US patent term runs from the PCT filing date.***

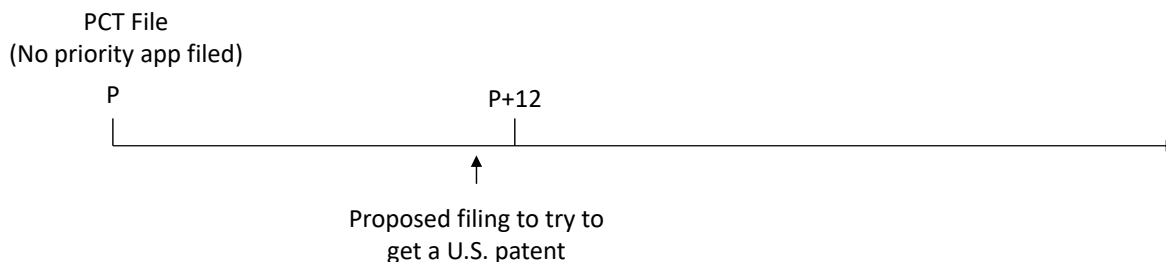
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## Trap for the Unwary: 20-Year Patent Term



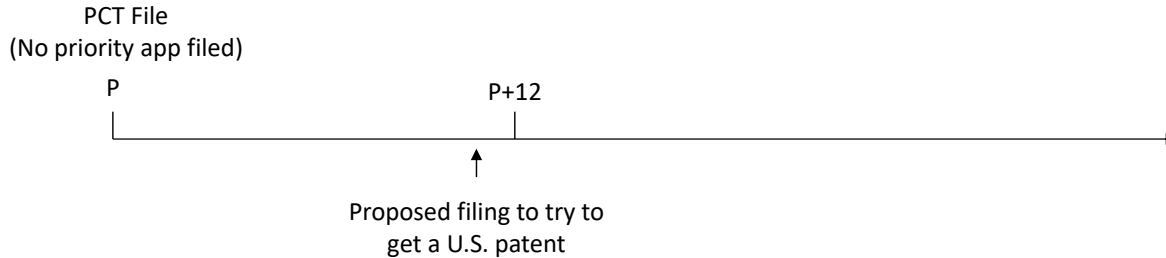
***Smart filer files a US 111a application that does not make any 35 USC § 120 domestic benefit claim.***

***Instead it merely makes one foreign priority claim (35 USC § 119 a-d).***

***The 20-year U.S. patent term runs from the 111a filing date.***

***You get an extra 11 months of patent term.***

## Trap for the Unwary: 20-Year Patent Term



***What makes this trap is that the proposed U.S. activity is in advance of the P+12 date.***

## U.S. National Phase

- Best Practice is to secure the inventor's signature on an Assignment and U.S. inventor declaration as soon as possible
- Suppose you have obtained these signatures a few days after filing the PCT application (the documents bearing the PCT application number)
- And suppose you are not planning to enter the U.S. national phase until the 29th month
- Best Practice is to file an ADS to start the national phase application process and then e-file the inventor declaration
- Best Practice is to file the Assignment in EPAS
- This provides an offsite backup for the declaration and Assignment



## U.S. National Phase

Consider that the PCT application may have been filed with a U.S. inventor declaration (PCT Declaration Number 4)

- Check ePCT or Patentscope to see if a U.S. inventor declaration is already in the application file
- If so, then download it from ePCT or Patentscope and upload it to EFS-Web
- This will save having to prepare an inventor declaration and getting it signed

## U.S. National Phase— The “Short List”

- What must be filed at USPTO to avoid abandonment at 30 months from priority?
  - Identify the PCT application
  - Pay the base national phase fee
  - If the PCT application has not been published (very unlikely), provide a copy of the PCT application
    - This includes a copy of the PCT Request!
- Best Practice is to do this via Patentscope (or EFS-Web)

## U.S. National Phase— The “Long List”

- What must be filed in addition to the “short list” to avoid not only abandonment but also a notice of missing requirements?
  - Pay the rest of the needed fees besides the base national phase fee (search fee, exam fee, excess pages fee, multiple dependent claim fee, excess claims fee)
  - English translation of the PCT application (if not in English)
  - Inventor's declaration
  - Translation of the annexes to the IPRP-II (if there is one, and if the annexes are not in English)
    - That's if you want them included as part of the processing!

## Other Papers to File

- Power of Attorney
- Information Disclosure Statement
- Assignment

## U.S. National Phase— Express Request

- Suppose the “long list” is satisfied prior to the end of the 30 months, what will DO/EO/US do?
  - Nothing
  - If the applicant wants USPTO to commence the national phase process before the end of the 30 months, the applicant must make an “express request” for immediate national stage processing
  - This can be done by means of Form PTO-1390
- It is a Best Practice to do so
  - Case will get examined sooner
  - Applicant might get more Patent Term Adjustment

## U.S. National Phase— Trap for the Unwary

- Some filers include a blanket authorization to charge any and all fees due to the filer's USPTO deposit account
- PCT application might have excess claims
- Filer might be assuming that the excess claims can be canceled later by preliminary amendment
- DO/EO/US will charge the deposit account for all of the excess claims
- In the past this has sometimes amounted to tens of thousands of dollars
- ***Filer should avoid such a blanket authorization***

## U.S. National Phase— Docketing

Docket the 30-month date

- The 30-month date should be cleared **only** when the “long list” has been fulfilled
- When the “long list” is fulfilled, docket to check for receiving the Filing Receipt and Form PCT/DO/EO/903 Notice of Acceptance into the National Phase

## What is the Filing Date?

- What is the Filing Date for an entry into the U.S. national phase?
  - It is the PCT filing date (see 35 USC § 363)
    - The Filing Receipt will not list this date as the “filing date”
    - Patentcenter (and PAIR) will not list this date as the “filing date”

## When the Filing Receipt Arrives

- Closely review the Filing Receipt
- Make sure it states that the application is a 371 of the PCT application
- Make sure the foreign priority is listed and is accurate
- Applicant name listed correctly (e.g. non-inventor applicant)
- Correspondence address correct
- If a Power of Attorney was filed, check that the power of attorney is listed correctly

## When the Form PCT/DO/EO/903 Arrives

- Closely review the Form
- Check accuracy of dates that filing tasks were carried out
- USPTO might have overlooked the Express Request
- Check the 371 date (which is a function of when the “long list” was satisfied and when an Express Request was filed)

## Handing in the Inventor Declaration

- The rules permit postponing the inventor declaration until the Notice of Allowance, but this is not a Best Practice
- The inventor declaration should be handed in as early as possible
- To avoid a late fee, the inventor declaration should be handed in before the 30-month date
- Note that to file an RCE, you need to have handed in the inventor declaration
  - Walking corpse problem

## U.S. National Phase— If the 30-Month Date Was Missed

- If the 30-month date was missed, but the failure to file timely was unintentional, then a Petition to Revive may be filed along with the “short list”
- Late fees will still have to be paid for the items that are on the “long list” but are not on the “short list”

## Signatures for the Petition to Revive

- A Petition to Revive requires two distinct signatures
  - A signature from someone with personal knowledge of the facts to state that “the entire period of delay was unintentional”
  - A signature from an authorized person on the Petition itself
- These are not the same thing, and you will probably be unable to use Form PTO/SB/64PCT as is

## Signatures for the Petition to Revive

- Who is “an authorized person” for the signature on the Petition itself?
  - If a non-inventor applicant has been identified on an ADS, then the authorized practitioner may sign the Petition
  - This person may not have personal knowledge of the facts as to the delay being unintentional

## If a Restriction Requirement Arrives

- If you receive a Restriction Requirement in a US national phase application...
  - Check to see whether it is a “unity of invention” RR or a “distinct invention” RR under 35 USC § 121
  - If it is a “distinct invention” RR then the applicant may wish to request that it be withdrawn

## Walking Corpse Problem

If you file an RCE in a US national phase case, and if you had not yet gotten your oath or declaration into the case, then the RCE is defective.

The USPTO might not notice the defect.

You may end up with a thing that looks like a patent but is not a patent.

Maybe you can fix it, even many years later, with a petition to revive.



# What Lies Ahead?

- 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!

