

Dependence of Claim Format on Choice of ISA for A PCT Application

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My prior article ["Which RO And ISA Should You Select When Filing PCT" Rick Neifeld, November 24, 2016](#) provides some insight into which RO and which ISA a PCT applicant is entitled to select, and which one to select, depending upon certain factors.

A topic that article did not address is choice of claim format of the PCT application, with respect to the choice of ISA.

US applicants (residents and nationals), in particular, have a choice of more than one ISA, which include in particular ISA/EP and ISA/US. (The ISAs for US applicants are identified by the USPTO in MPEP 1840.)

At a recent patent attorney professional meeting, it was suggested that claims in PCT applications should all be written in multiply dependent form, each claim depending upon all of the prior claims. This was to provide express support for those claims in the EPO.

That suggestion should be qualified to apply only to those PCT applications that select an ISA that provides for search of multiply dependent claims upon earlier multiply dependent claims. ISA/EP provides for that. However, ISA/US, does not.

PCT regulation 6.4 states "Multiple dependent claims shall not serve as a basis for any other multiple dependent claim" unless the regional or national law of the ISA provides otherwise. PCT regulation 6.4 continues that "failure to use that manner of claiming may result in an indication under Article 17(2)(b) in the international search report." And what PCT Article 17(2)(b) indicates at that the ISA will not search claims that violate Regulation 6.4.

US law and regulations do not provide otherwise. That is, US law and regulations do not allow multiply dependent claims to depend from other multiply dependent claims. Consequently, ISA/US does not effect a search or examination of any multiple dependent claim that depends from an earlier multiply dependent claim. Therefore, a PCT applicant that selects ISA/US and includes multiply dependent claims that depend from other multiply dependent claims will not obtain a search in the international phase of those claims from ISA/US.

In contrast, ISA/EP is one of those jurisdictions that overrides PCT regulation 6.4 by allowing for multiply dependent claims to depend from earlier multiply dependent claims. So claims in a PCT application that are multiply dependent upon an earlier multiply dependent claim will be searched in the international phase by ISA/EP.

A PCT applicant very much wants to have all claims in their application searched in the international phase, so they can obtain the international search report. The report evaluates relevance to patentability of prior art references identified in the report. Obtaining that report is one of the main goals of filing a PCT application. This is because the report allows the applicant to evaluate the likelihood of getting national and regional patents issued from the PCT application, and thereby helps the applicant determine whether to go forward with the huge expenses of entering the national and regional stages for the PCT application.

Therefore, the choice of ISA is a factor in the form (multiply dependent or not) one should use for claims in the international application.

Accordingly, claim format is important, from the get-go, and claim format may depend

upon which ISA the PCT applicant selects.

I should also point out that, even when selecting ISA/US, the PCT applicant needs to be cognizant of the requirement for support for multiply dependent claims that depend upon another multiply dependent claim, because the claims may be amended to that format, for example, when entering the EPO regional phase, to improve patent protection for the disclosed subject matter. However, if ISA/US is selected (for whatever reason), an appropriate way provide that support is to include that support in the specification and not by making the claims all multiply dependent.

And given the desirability of the Paris right of priority, the same holds true for the first filing for the same subject matter, when that file is a nonprovisional or a provisional. Include support for the multiply dependent format preferred in the EPO.