

PCT Substance, Procedure, and Upcoming Changes

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PCT Substance and Procedure OUTLINE

- I. PCT Substance
- II. PCT Procedure
- III. Upcoming Changes in PCT
- IV. Conclusion

I - PCT Substance

- Basics
- Paris Convention
- Reservations
- US Law

PCT Substance - Basics

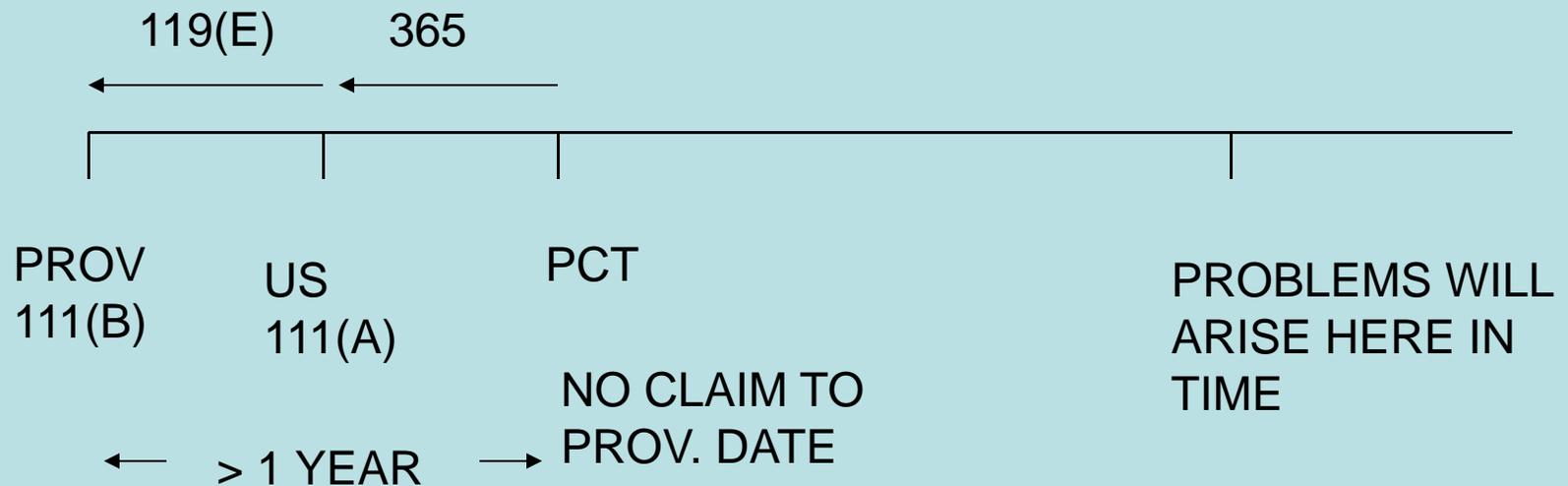
- PCT – Patent Cooperation Treaty
- Treaty drafted in the 1970's
- Implementation began in the late 1970's
- Purpose – Simplify and reduce cost of patent filings around the world. Art. 1
- Mechanism – Provide single filing in one country to get benefit of filing date in all contracting countries. Art. 3

PCT Substance – Paris Conv.

- PCT Incorporates Paris Convention right. Art. 8.
- Paris Convention provides right to filing date of an application in one country for an application for “the same subject” later filed in a second country.
- See Paris Convention article 4 for Priority Right details and limitations. **IMPORTANT!**

PCT Substance – Paris Conv.

- PROV → US → PCT WITH PROV “OUT OF PARIS CONVENTION YEAR” IS A BAD IDEA! (INVENTION A, B ISSUE)



THE PCT APP. MAY LOOSE RIGHT OF PRIORITY TO THE US APP.!

PCT Substance – Paris Conv.

- PARIS CONVENTION REQUIREMENTS FOR ENTITLEMENT TO PRIORITY
- WITHIN 1 YEAR – UTILITY (6 MONTHS FOR DESIGNS)
- OR PRIOR APPLICATION ABANDONED WITH NO RIGHTS OUTSTANDING
- FOR “THE SAME SUBJECT” AS THE EARLIER APPLICATION

PCT Substance – Paris Conv.

- “THE SAME SUBJECT” IS ILL DEFINED
- EP – TREATS RIGHT OF PRIORITY AS A SUPPORT ISSUE (BUT EPC HAS A PRIORITY RIGHT DISTINCT FROM PARIS, AND MEMBER STATES FOLLOW EPO RULINGS)
- JAPAN, KOREA, US UNCLEAR
- CA – INVENTIONS NOT DISCLOSED IN THE EARLIER APPLICATION

PCT Substance – Paris Conv.

- **BOTTOM LINE** – BE VERY CAREFUL WITH PROVISIONAL APPLICATIONS OR ANY OTHER LONG SITUATION INVOLVING CHAINS OF PRIORITIES; IDENTIFY TO THE CLIENT POTENTIAL DOWNSIDE OF RELYING ONLY UPON NEWLY DISCLOSED MATTER AS A BASIS FOR FILING PCT APPLICATIONS!
- PARIS INTERPRETATION IS AN ISSUE OF NATIONAL LAW; WE ARE NOT EXPERTS IN OTHER COUNTRIES' NATIONAL LAWS.

PCT Substance – Reservations

- Art. 64 Reservations
- Some contracting countries have certain reservations as allowed by article 64
- Article 64(4)(a) – US reservation for 35 USC 102(e); US does not necessarily equate filing date of PCT application as date PCT application is prior art. See old 102(e) (nationalization date) and Newest 102(e)(English publication date).

PCT Substance – US Law

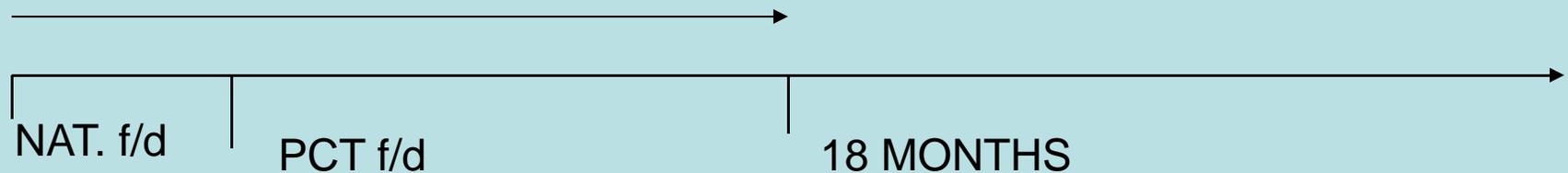
- Newest 102(e) imports English language PCT published applications into 102(e); they are prior art from their PCT filing date.
- Newest 135(b)(2) imports PCT publications in any language to 135(b)(2) bar.
- File History construction and estoppel issues – Part of the same transaction as US patent?
- No PCT patent exists – patenting requires subsequent national stage proceeding.

II. PCT Procedure

- Dates
- Application Format
- Disclosure Format
- Amendments

PCT Procedure - Dates

- PCT dates determined based primarily upon earliest claimed Paris Convention priority date.
- 18 months to publication.
- 19 months to payment of Demand.
- 20 months to Chapter 1 national stage filings. *
- 30 months – Chapter 2 filings. *



PCT Procedure - Dates

- PCT dates determined based primarily upon actual PCT filing date.
- ISR – generated in about 5 months
- Notices as to form, content, and completion of application – 1-2 months.
- Important – PCT application must be executed by all applicants or an attorney with power from all applicants.



PCT Proc. – Application Format

- Request
- Fee Calc
- Decs – PCT form or US form or Both
- Assignments of invention

PCT Proc. – Request

- **REQUEST FORM**
- **DOWNLOAD ADOBE EDITABLE VERSION FROM THE USPTO WEB SITE**
- **USE ADOBE ACROBAT 5.0 OR HIGHER TO COMPLETE.**
- **(OTHERWISE YOU CAN'T SAVE DRAFTS!)**

PCT Proc. – Request

- **Box 1 - TITLE** – Same as in spec.
- **Box II APPLICANT** – List assignee, if there is one, in this box, as applicant.
- For assignee, check the box “Applicant [for] ... all designated states *except* ... [the U.S.]” In the U.S., only “true inventors” can apply for a patent.

PCT Proc. – Request

- **Box III - FURTHER APPLICANTS**
- List inventors in these boxes. Check BOTH boxes “applicant and inventor” and “applicant for the purpose of... the United States of America only.” (Assuming this inventor is not an assignee.) See Request instructions page 2 second paragraph, last 6 lines.

PCT Proc. – Request

- **Box IV – AGENT OR COMMON REP.**
- Check “agent,” not “common representative” if you are not an inventor.
- Name and address - I use my name and firm address, not my firm’s name.

PCT Proc. – Request

- **BOX V – DESIGNATIONS**
- I ALWAYS DESIGNATE ALL STATES.
- YOU ONLY PAY FOR THE FIRST 5 DESIGNATIONS, AND IT MAKES NO SENSE TO EVEN QUERY THE CLIENT ON THE ISSUE OF DESIGNATION FEES.
- I PAY AT TIME OF FILING FOR ADMIN CONVENIENCE.

PCT Proc. – Request

- Applicant's or agent's reference number –
Note that there is a character limit of 12 characters that the PCT will record. Docket accordingly!
- I use longer docket numbers, but the first 12 characters are sufficient for my firm to identify a PCT correspondence. (PTO notices an objection but takes no adverse action.)

PCT Proc. – Request

- **Box VI - PRIORITY CLAIM**
- **MAKE SURE TO CHECK “THE RECEIVING OFFICE IS REQUESTED TO PREPARE AND TRANSMIT [THE PRIORITY DOCUMENTS...” TO AVOID PROBLEMS!**
- **COST**
- **NATIONAL TIME LIMITS**

PCT Proc. – Request

- **BOX VII – ISA**
- WE IN THE U.S. CAN ONLY CHOOSE USPTO OR EPO FOR ISA
- EPO WILL NOT SEARCH CERTAIN ISC'S RELATING THE BUSINESS METHOD PATENTS AND BIOTECH.
- EPO IS AN UNCERTAIN CHOICE EVEN FOR OTHER TECHNOLOGY FIELDS – THEY MAY WITHOUT NOTICE DECIDE NOT TO SEARCH ANY TECHNOLOGY FIELD.

PCT Proc. – Request

- **BOX VIII – DECLARATIONS**
- PCT APPROVED FORM DECLARATIONS THAT CONTRACTING STATES HAVE AGREED TO ACCEPT.
- PCT FORM DECLARATION OF INVENTORSHIP – IF FILED WITH PCT APPLICATION, WILL BE ACCEPTED BY USPTO
- STALE DEC DOCTRINE INAPPLICABLE.

PCT Proc. – Request

- **BOX VIII – DECLARATIONS**
- PCT FORM FOR U.S. DECLARATION OF INVENTORSHIP – *PROBLEMS*
- DOES NOT INCLUDE FIRM POWER OF ATTORNEY.
- DOES NOT INCLUDE FORM “DOCUMENT CONTROL” INDICIA (DOCKET NUMBER, DRAFT PRINT DATE, PATH/FILENAME, AUDIT TRAIL INITIALS, ECT.)

PCT Proc. – Request

- **BOX VIII – DECLARATIONS**
- PCT LEGAL OFFICE/PCT CLERKS INFORMED ME THAT FIRM'S FORM COMBINED U.S. DEC AND POWER OF ATTORNEY FILED IN THE U.S. RECEIVING OFFICE WILL REMAIN WITH THE FILE AND BE PASSED TO THE U.S. NATIONAL STAGE AT APPROPRIATE TIME, THEREBY AVOIDING BOTH STALE DEC. DOCTRINE AND NEED FOR SIGNATURES AT MULTIPLE POINTS IN TIME.
- RELY UPON THIS INFO AT YOUR OWN RISK!

PCT Proc. – Request

- **BOX IX – CHECK LIST**
- **FEES BASED UPON COUNT OF FORMAL PAGES IDENTIFIED IN (a) – DOES NOT INCLUDE ANY U.S. ATTORNEY’S FORM DEC AND POA OR ASSIGNMENT PAPERS.**

PCT Proc. – Request

- NOTE – PCT ALLOWS INSERTION OF ADDITIONAL PAGES IN ARTICLE 19 AMENDMENT (CLAIMS) AFTER RECEIVING ISR WITH *NO FEE*. LOOPHOLE IN CASE YOU WANT TO REDUCE FILING COSTS BASED UPON INCLUSION OF LARGE NUMBER OF CLAIMS.

PCT Proc. – Request

- BOX X – SIGNATURE
- The PCT request must be signed.
- I list date, name, and affiliation as listed in BOX IV, for consistency.

PCT Proc. – Request

- Box X - Items 2 and 3 are **IMPORTANT!** A PCT must include either power of attorney or signature of each applicant, or appointment of common rep. who then appoints an attorney of record. Failure to include signatures of inventors or their power of attorney will generally result in a non-extendable 2 month deadline to comply by submitting missing signatures.

PCT Proc. – FEE CALC.

- ITEMS 1-5 – FEES IDENTIFIED IN PTO WEB SITE.
- **IMPORTANT** – PCT MAY NOT GET A FILING DATE IF YOU FAIL TO PAY ENOUGH \$.
THEREFORE, *ALWAYS CHECK THE BOX TO CHARGE EXTRA FEES TO YOUR DEPOSIT ACCOUNT* - - “AUTHORIZATION TO CHARGE ANY DEFICIENCIES....”
- CHECK “AUTHORIZATION TO CHARGE THE FEE FOR THE PRORITY DOCUMENT, IF THERE IS A PRIORITY DOCUMENT.

PCT Proc. - Disclosure Format

- Generally the same as US, except for:
- All paper must be A4
- Minimum 2.5 cm margins
- Font size - 12 pitch or larger
- Line spacing – at least 1.5
- Line numbering - every fifth line (optional)
- Page numbering - Centered in the bottom portion of upper margin
- Figures labeled 1/_ in lower part of top margin

PCT Proc. – Amendments

- Article 19 amendment – Allows amendment of claims in response to ISR.
- Article 34 amendment – Allows amendment to spec and claims in response to WO or IPER.
- No amendment to spec or claims allowed prior to receipt of ISR/WO/IPER.

PCT Procedure – Amendments

- Letter format.
- Short remarks specifying the amendment
- Replacement pages.
- Submit to RO or IB (fax to IB on time sensitive matters).

PCT – Upcoming Changes

- General
- Chapter I
- Chapter II
- Administrative Changes
- Miscellaneous

PCT – General Changes

- Changes Effective 1/1/2004
- 68 FR 32441 details PCT changes and related proposed USPTO rule makings
- (Note recent PCT change mooted Chapter II Demand, except for certain “holdout countries”)
- Changes to Chapter I, Chapter II, and administrative items.

PCT – Chapter I Changes

- PCT CHAPTER I CHANGES
- Combine ISR and WO in PCT chapter 1
- Still within 6 months?
- Revised fee structure
- Simplified procedures

PCT – Chapter I Changes

- ISA will both search and provide WO in Chapter I.
- Chapter I WO opining on Inventive step, Novelty, Industrial Applicability
- Chapter 1 WO will become the Chapter II final opinion (now called an IPRP – International Preliminary Report on Patentability), unless applicant amends claims in Chapter 1.

PCT – Chapter II Changes

- CHAPTER II CHANGES
- Chapter II entry time limit (i.e., Demand filing) now depends upon date of issuance of ISR!
- Demand filing time limit is:
 - 3 months from ISR/WO (or Art. 17(2)(a) declaration, - - but not more than
 - 22 months from Paris Convention priority date
 - still 19 months for Art. 22(1) “holdout countries”

PCT – Chapter II Changes

- IPEA will still establish a final report, now call an IPRP Chapter II report, within 28 months of priority date
- Changes do not affect Chapter II deadlines for national stage entry
- US 30, EPO 31, Canada 42, JP 30/32, etc.
- Note – National stage late filing permitted under various national laws – check with local agent, NOT WIPO!

PCT – Administrative Changes

- Designation of all contracting states *automatic*
- Designation of all types of protection *automatic*
- Election of all designated states *automatic* upon filing Demand
- Filing fee simplified to sheet count (30+)

PCT – Administrative Changes

- PCT application need be signed by *only 1* applicant!
- PCT application need only provide address, residence, and nationality of *only 1* applicant!
- For US/RO, identified applicant must be a citizen or resident of the United States
- National stage offices may still require applicant signatures (or powers of attorney).

PCT – Upcoming Changes

- PCT rule 90.4 has been revised to permit the RO, ISA, or IPEA to *waive the requirement for a power of attorney* (except in instances of applicant initiated withdrawals under PCT rule 90bis).

PCT – Miscellaneous Changes

- USPTO proposed rules relate to and generally intend to implement changes to PCT just noted. Comments period on proposed rules closed June 30, 2003. Final rules should be out very soon.

PCT Substance, Procedure, and Upcoming Changes

THANK YOU
THE END

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