

Expediting US national stage entry of a PCT International Application

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There are patent attorney email list services where patent attorneys and other patent law professionals share knowledge and ideas. I often contribute to those list services.

Copied in below is a post I made providing some particularly useful information on 7/21/2020, to those involved in nationalizing PCT applications into the United States.

The basic point of this exchange is to explain practice details not specified in any rule of practice or statute provide procedural advantages to a patent applicant. This is just one example on one issue. There are many such issues that arise during the acquisition of patent rights.

The subject line of this email post was "Early Processing under 371(f), update from PCT Help desk."

The body of this email (with minor revisions) post read:

Allen asked the insightful question "I wonder whether early publication [sic; by the IB of a PCT application] can be used to expedite examination by filing national phase application along with a request for Early Processing" in response to Carl's blog post ... (Beginning "The normal timetable for publication of a PCT application is about 18 months after the priority date. But you can request that it be published early," at a cost of 200 Swiss Francs.)

So can it? Can early publication by the IB expedite a 371 containing an "Early Processing" request? So I called the PCT Help Desk yesterday to get some insight and spoke with Shane. He looked into the issue and we spoke again at some length today.

The answer is, it depends. According to Shane, my inquiry has prompted the USPTO PCT supervisor (Mike N) to raise this question with the OPAP supervisor in their biweekly meeting (about 371 entry formalities review procedures).

One point is that IB publication of a PCT application should not affect an entitlement to commence early processing pursuant to 371(f). But there are some hidden issues.

Like the presence of a backlog of un-reviewed 371 filings, and the preconditions for 371(f) action. By "un-reviewed" I mean a 371 filing that OPAP personnel have not yet picked up for review for compliance with national stage entry.

Like de facto compliance with 371(c) requirements.

And, like whether the USPTO has sufficient formalities information to reliably complete formalities review of a 371(c) filing.

As of a few months back, there was a backlog of un-reviewed 371 filings amounting to many months of delay before review of each 371 filing. It paid to call the PTO to ask them to ding the review group, to get going in any particular 371 filing having a proper 371(f) request, so that such a case would be reviewed out of turn by OPAP.

A precondition for 371(f) early processing is that the USPTO (DO/EO/US) has the required 371(c) elements of the PCT application, and that may depend upon the RO in which the PCT was filed. For any RO other than RO/US, the USPTO generally does not have access to a copy of the PCT application prior to the IB publishing the application. So if documents uploaded by the 371 filer lack any required 371(c) element, then you have not complied with national stage entry and there will be no 371(f) processing.

If an OPAP person reviews a 371 filing lacking the 371(c) elements in the USPTO's official file, they may try to obtain the 371(c) elements from the IB electronically. But that attempt only works if the IB has published the PCT application. What that means is that, in situations where the PCT application has not been published and you file a 371(f) request, and you have not complied with the 371(c) requirements by actually uploading the 371(c) elements to the USPTO's server, 371(f) processing will not occur. You will not get an early 371(c) entry date, and that failure may negatively affect patent term adjustment of a patent issuing from the 371 filing.

Shane also suggested that uploading the RO/105 (providing the IA number and filing date) were helpful in review of 371 filings for PCT applications not filed in RO/US and not yet published by the IB. And the reasons for this makes sense, if the USPTO cannot access information about the PCT application from the IB to reliably determine accuracy of that information. Like, if the USPTO cannot determine the IA number and filing date, to verify that information is accurate. I can envision in that situation that the OPAP person might delay signing off on a 371 review until they could confirm with the IB that the application number and filing date provided by the 371 filer was correct.

So back to the big picture, can IB publication be used to expedite examination of a 371 filing? If you file a proper 371(f) request, which means that you complied with 371(c), then, presumably and rightfully no. But practically, maybe. And that may depend upon whether you filed for example copies of the RO/101 and RO/105. The PTO deems the RO/101 as part of the 371(c) requirements, but not so the RO/105. But the USPTO PCT supervisor is going to confer with the OPAP supervisor to make sure that OPAP's business rules do not delay early processing under 371(f) merely because a PCT application has not been published by the IB.

On the flip side, however, a 371 filing is not entitled to early processing under 371(f) unless (1) a 371(f) express request is present and (2) the 371(c) requirements were satisfied. And the 371(c) requirements require that the USPTO, and in particular OPAP, have the required 371(c) elements of the PCT application, for review. One way to ensure that OPAP will have access to those elements is by having the IB publish the PCT application. But another way is to actually provide those elements and the RO/101 in the 371 national stage entry filings you upload to the USPTO servers.

And given the previously known delay in OPAP in getting to reviewing 371 filings and the possibility that such a delay continues or may come into existence in the future, if you have a 371 filing having a 371(f) express request, and you actually want prompt action on that request (as opposed to merely the benefit of protection of inchoate patent term adjustment), then you may still need to call the USPTO's PCT help desk and plead for grace.

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