

Syllabus

Session 25: International Patent Prosecution

June 11, 2019

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Session Overview

Consider this session as a practitioner's perspective on prosecuting patent applications internationally.

We will discuss practical challenges and strategies that affect how practitioners approach questions of when and where to file internationally, and how to prosecute patent applications with an eye toward developing a family of patents in multiple jurisdictions.

We will also discuss practical and procedural aspects: timelines in the application life cycle, costs (government and practitioner), making decisions as to where to file, and navigating the seemingly different worlds of WIPO/PCT, EPO, USPTO, etc., and collaborative efforts of patent offices in different jurisdictions.

Finally, we will reserve some time for discussion of your questions and possibly a working example.

Background Reading Materials

Consider the following materials only for the purposes of familiarizing yourself with various terminology and for reference to topics we will discuss.

- Excerpts from M.P.E.P. §1801 (Basic PCT Principles), §1805 (Where to File), §1810 (Filing Date Requirements), §1812 (Elements of the International Application), and §1842 (Basic Flow under the PCT). Full chapter available at: <https://www.uspto.gov/web/offices/pac/mpep/mpep-1800.html>
- Excerpts from "Considerations and Options for Foreign Filing Including the PCT" by L. Lauchman, USPTO (July 2018). Full set available at: <https://www.uspto.gov/sites/default/files/documents/July%20Inventor%20Info%20Chat%20%20-%20Foreign%20Filing%202018.pdf>
- Also, see <https://www.wipo.int/pct/en/faqs/faqs.html>

1801 Basic Patent Cooperation Treaty (PCT) Principles [R-08.2017]

I. MAJOR CONCEPTS OF THE PCT

The Patent Cooperation Treaty (PCT) enables the U.S. applicant to file one application, "an international application," in a standardized format in English in the U.S. Receiving Office (the U.S. Patent and Trademark Office), and have that application acknowledged as a regular national or regional filing in as many Contracting States to the PCT as the applicant "designates," that is, names, as countries or regions in which patent protection is desired. The filing of an international application will automatically constitute the designation of all contracting countries to the PCT on that filing date. In the same manner, the PCT enables foreign applicants to file a PCT international application, designating the United States of America, in their home language in their home patent office and have the application acknowledged as a regular U.S. national filing. The PCT also provides for the establishment of an international search report and written opinion at 16 months from the priority date and publication of the international application after 18 months from the priority date. Upon payment of national fees and the furnishing of any required translation, usually 30 months after the filing of any priority application for the invention, or the international filing date if no priority is claimed, the application will be subjected to national procedures for granting of patents in each of the designated countries. For any countries remaining whose national laws are not compatible with the 30 month period set forth in [PCT Article 22\(1\)](#) ([mpep-9025-appx-t.html#d0e363673](#)), the filing of a demand for an international preliminary examination electing such countries within 19 months from the priority date will result in an extension of the period for entering the national stage to 30 months from the priority date. An up-to-date list of such countries may be found on WIPO's website ([www.wipo.int/pct/en/texts/reservations/res_incomp.html](#) ([http://www.wipo.int/pct/en/texts/reservations/res_incomp.html](#))). See also subsection V. below. A brief description of the basic flow under the PCT is provided in [MPEP § 1842](#) ([s1842.html#d0e171994](#)).

The PCT offers an alternative route to filing patent applications directly in the patent offices of those countries which are Contracting States of the PCT. It does not preclude taking advantage of the priority rights and other advantages provided under the Paris Convention and the WTO administered Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Agreement). The PCT provides an additional and optional foreign filing route to patent applicants.

The filing, search and publication procedures are provided for in Chapter I of the PCT. Additional procedures for a preliminary examination of PCT international applications are provided for in optional PCT Chapter II.

In most instances a national U.S. application is filed first. An international application for the same subject matter will then be filed subsequently within the priority year provided by the Paris Convention and the priority benefit of the U.S. national application filing date will be claimed.

II. RECEIVING OFFICE (RO)

The international application (IA) must be filed in the prescribed receiving Office (RO) ([PCT Article 10](#) ([mpep-9025-appx-t.html#d0e363227](#))). The United States Patent and Trademark Office will act as a receiving Office for United States residents and nationals ([35 U.S.C. 361\(a\)](#) ([mpep-9015-appx-l.html#d0e306949](#))). Under [PCT Rule 19.1\(a\)\(iii\)](#) ([mpep-9025-appx-t.html#d0e368505](#)), the International Bureau of the World Intellectual Property Organization will also act as a Receiving Office for U.S. residents and nationals. The receiving Office functions as the filing and formalities review organization for international applications. International applications must contain upon filing the designation of at least one Contracting State in which patent protection is desired and must meet certain standards for completeness and formality ([PCT Articles 11\(1\)](#) ([mpep-9025-appx-t.html#d0e363237](#)) and [14\(1\)](#) ([mpep-9025-appx-t.html#d0e363352](#))).

Where a priority claim is made, the date of the earliest-filed application whose priority is claimed is used as the date for determining the timing of international processing, including the various transmittals, the payment of certain international and national fees, and publication of the application. Where no priority claim is made, the international filing date will be considered to be the "priority date" for timing purposes ([PCT Article 2\(xi\)](#) ([mpep-9025-appx-t.html#d0e362923](#))).

The international application is subject to the payment of certain fees within 1 month from the date of receipt. See [PCT Rules 14.1\(c\)](#) ([mpep-9025-appx-t.html#d0e368002](#)), [15.3](#) ([mpep-9025-appx-t.html#d0e368057](#)), and [16.1\(f\)](#) ([mpep-9025-appx-t.html#d0e368138](#)). The receiving Office will grant an international filing date to the application, collect fees, handle informalities by direct communication with the applicant, and monitor all corrections ([35 U.S.C. 361\(d\)](#) ([mpep-9015-appx-l.html#d0e306949](#))). By 13 months from the priority date, the receiving Office should prepare and transmit a copy of the international application, called the search copy (SC), to the International Searching Authority (ISA); and forward the original, called the record copy (RC), to the International Bureau (IB) ([PCT Rules 22.1](#) ([mpep-9025-appx-t.html#d0e369213](#)) and [23](#) ([mpep-9025-appx-t.html#d0e369309](#))). A second copy of the international application, the home copy (HC), remains in the receiving Office ([PCT Article 12\(1\)](#) ([mpep-9025-appx-t.html#d0e363301](#))). Once the receiving Office has transmitted copies of the application, the International Searching Authority becomes the focus of international processing.

III. INTERNATIONAL SEARCHING AUTHORITY (ISA)

The basic functions of the International Searching Authority (ISA) are to conduct a prior art search of inventions claimed in international applications (it does this by searching in at least the minimum documentation defined by the Treaty ([PCT Articles 15](#) ([mpep-9025-appx-t.html#d0e363418](#)) and [16](#) ([mpep-9025-appx-t.html#d0e363461](#))) and [PCT Rule 34](#) ([mpep-9025-appx-t.html#d0e370400](#))) and to issue a written opinion ([PCT Rule 43bis](#) ([mpep-9025-appx-t.html#d0e370901](#))) which will normally be considered to be the first written opinion of the International Preliminary Examining Authority where international preliminary examination is demanded. See [PCT Rule 66.1bis](#) ([mpep-9025-appx-t.html#d0e374660](#)).

For most applications filed with the United States Receiving Office, the applicant may choose (in the Request form) the U.S. Patent and Trademark Office, the European Patent Office, the Korean Intellectual Property Office, the Australian Patent Office (IP Australia), the Federal Service for Intellectual Property (Rospatent) (Russian Federation), the Israel Patent Office (ILPO), the Japan Patent Office (JPO), or the Intellectual Property Office of Singapore (IPOS) to act as the International Searching Authority. However, IP Australia and JPO may not be competent to act as an International Searching Authority for certain applications filed by nationals or residents of the United States. See [MPEP §§ 1840.01 \(s1840.html#d0e171588\) - 1840.07 \(s1840.html#ch1800_d298ed_29d3d_331\)](#). The International Searching Authority is also responsible for checking the content of the title and abstract ([PCT Rules 37.2 \(mpep-9025-appx-t.html#d0e370644\)](#) and [38.2 \(mpep-9025-appx-t.html#d0e370677\)](#)).

An international search report (ISR) and written opinion will normally be issued by the International Searching Authority within 3 months from the receipt of the search copy (usually about 16 months after the priority date) ([PCT Rule 42 \(mpep-9025-appx-t.html#d0e370881\)](#)). Copies of the international search report and prior art cited will be made available to the applicant by the ISA ([PCT Rules 43 \(mpep-9025-appx-t.html#d0e370901\)](#) and [44.1 \(mpep-9025-appx-t.html#d0e371259\)](#)). The international search report will contain a listing of documents found to be relevant and will identify the claims in the application to which they are pertinent. The written opinion indicates whether each claim appears to satisfy the [PCT Article 33 \(mpep-9025-appx-t.html#d0e364085\)](#) criteria of "novelty," "inventive step," and "industrial applicability." The written opinion may also indicate defects in the form or content of the international application under the PCT articles and regulations, as well as any observations the ISA wishes to make on the clarity of the claims, the description, and the drawings, or on the question of whether the claims are fully supported by the description.

Once the international search report and written opinion are established, the ISA transmits one copy of each to the applicant and the International Bureau, and international processing continues before the International Bureau. If a Demand for Chapter II examination is not timely filed, the International Bureau communicates a copy of the written opinion established by the ISA (retitled International Preliminary Report on Patentability (Chapter I of the PCT)) to each designated Office after the expiration of 30 months from the priority date.

IV. INTERNATIONAL BUREAU (IB)

The basic functions of the International Bureau (IB) are to maintain the master file of all international applications and to act as the publisher and central coordinating body under the Treaty. The World Intellectual Property Organization (WIPO) in Geneva, Switzerland performs the duties of the International Bureau.

If the applicant has not filed a certified copy of the priority document in the receiving Office with the international application, requested upon filing that the receiving Office prepare and transmit to the International Bureau a copy of the prior U.S. national application, the priority of which is claimed, or requested the International Bureau to obtain a copy of the earlier application from a digital library, the applicant must submit such a document directly to the International Bureau or the receiving Office not later than 16 months after the priority date ([PCT Rule 17 \(mpep-9025-appx-t.html#d0e368311\)](#)). The request (Form PCT/RO/101) contains a box which can be checked requesting the receiving Office to prepare and transmit a copy of a prior application. This is only possible, of course, if the receiving Office is a part of the same national Office where the priority application was filed. The request (Form PCT/RO/101) also contains a box which can be checked requesting the International Bureau to obtain a copy of the earlier application from a digital library. This is only possible if the application is registered in a digital library, made available to the International Bureau within the prescribed time limit, as set forth in PCT Rule 17.1(b-bis), and the access code is furnished to the International Bureau.

The applicant has normally 2 months from the date of transmittal of the international search report to amend the claims by filing an amendment and may file a brief statement explaining the amendment directly with the International Bureau ([PCT Article 19 \(mpep-9025-appx-t.html#d0e363565\)](#) and [PCT Rule 46 \(mpep-9025-appx-t.html#d0e371568\)](#)). The International Bureau will then normally publish the international application along with the search report and any amended claims at the expiration of 18 months from the priority date ([PCT Article 21 \(mpep-9025-appx-t.html#d0e363622\)](#)). For applications filed before July 1, 2014, former PCT Rule 44ter provided that the written opinion of the ISA would not be made publicly available until the expiration of 30 months from the priority date. For applications filed on or after July 1, 2014, the written opinion of the ISA and any informal comments submitted by the applicant are made available to the public in their original language as of the publication date. The international publication includes a front page containing bibliographical data, the abstract, and a figure of the drawing ([PCT Rule 48 \(mpep-9025-appx-t.html#d0e371853\)](#)). The publication also contains the search report and any amendments to the claims submitted by the applicant. If the application is published in a language other than English, the search report and abstract are also published in English. The International Bureau publishes a *PCT Gazette* in the French and English languages which contains information similar to that on the front pages of published international applications, as well as various indexes and announcements ([PCT Rule 86 \(mpep-9025-appx-t.html#d0e376690\)](#)). The International Bureau also communicates copies of the publication of the international application to all designated Offices that have requested to receive the publication ([PCT Article 20 \(mpep-9025-appx-t.html#d0e363585\)](#), [PCT Rule 47 \(mpep-9025-appx-t.html#d0e371652\)](#), and [PCT Rule 93bis.1 \(mpep-9025-appx-t.html#d0e378072\)](#)).

V. DESIGNATED OFFICE (DO) and ELECTED OFFICE (EO)

The designated Office is the national Office (for example, the USPTO) acting for the state or region designated under Chapter I. Similarly, the elected Office is the national Office acting for the state or region elected under Chapter II.

[PCT Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#) was amended, effective April 1, 2002, to specify that a copy of the international application, a translation thereof (as prescribed), and the national fee are due to the designated Office not later than at the expiration of 30 months from the priority date. Accordingly, the time period for filing the copy of the international application, the translation, and the fee under [PCT Article 22 \(mpep-9025-appx-t.html#d0e363665\)](#) is the same as the 30 month time period set forth in [PCT Article 39 \(mpep-9025-appx-t.html#d0e364336\)](#). The USPTO has adopted the 30 month time limit set forth in [PCT Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#). Most Contracting States have changed their national laws for consistency with [PCT Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#) as amended. An up-to-date listing of Contracting States that have adopted [Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#) as amended is maintained at WIPO's website at www.wipo.int/pct/en/texts/time_limits.html (http://www.wipo.int/pct/en/texts/time_limits.html). At the time of publication of this Chapter, only three countries have not adopted [Article 22\(1\) \(mpep-9025-appx-t.html#d0e363673\)](#) as amended: Luxembourg (LU), United Republic of Tanzania (TZ) and Uganda (UG). It is noted that Luxembourg is included in the regional designation "EPO" and that the United Republic of Tanzania and Uganda are included in the regional designation "ARIPO." For those few remaining Contracting States that have not adopted [Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#) as amended, if no "Demand" for

international preliminary examination has been filed within 19 months of the priority date, the applicant may be required to complete the requirements for entering the national stage within 20 months from the priority date of the international application in the national offices of those states. When entering the national stage following Chapter I, the applicant has the right to amend the application within the time limit set forth in [PCT Rule 52.1 \(mpep-9025-appx-t.html#d0e373266\)](#). After this time limit has expired ([PCT Article 28 \(mpep-9025-appx-t.html#d0e363856\)](#) and [PCT Rule 52 \(mpep-9025-appx-t.html#d0e373259\)](#)), each designated Office will make its own determination as to the patentability of the application based upon its own specific national or regional laws ([PCT Article 27\(5\) \(mpep-9025-appx-t.html#d0e363805\)](#)).

If the applicant desires to obtain the benefit of delaying the entry into the national stage until 30 months from the priority date in one or more countries where the 30 month time limit set forth in [PCT Article 22\(1\) \(mpep-9025-appx-t.html#d0e363665\)](#) as amended does not apply, a Demand for international preliminary examination must be filed with an appropriate International Preliminary Examining Authority (IPEA) within 19 months of the priority date.

Those states in which the Chapter II procedure is desired must be "elected" in the Demand.

[PCT Rule 54bis.1 \(mpep-9025-appx-t.html#d0e373603\)](#) requires the Demand to be made prior to the expiration of whichever of the following periods expires later:

- (A) three months from the date of transmittal to the applicant of the international search report or of the declaration referred to in [PCT Article 17\(2\)\(a\) \(mpep-9025-appx-t.html#d0e363514\)](#), and of the written opinion under [PCT Rule 43bis.1 \(mpep-9025-appx-t.html#d0e370901\)](#); or
- (B) 22 months from the priority date.

However, applicant may desire to file the Demand by 19 months from the priority date to extend the national stage entry deadline in Luxembourg, the United Republic of Tanzania, and Uganda.

The original Demand is forwarded to the International Bureau by the IPEA. The International Bureau then notifies the various elected Offices that the applicant has entered Chapter II and sends a copy of any amendments filed under [PCT Article 19 \(mpep-9025-appx-t.html#d0e363565\)](#) and any statement explaining the amendments and the basis for the amendments to the IPEA. See [PCT Rule 62 \(mpep-9025-appx-t.html#d0e374402\)](#). The International Bureau also sends the IPEA a copy of the written opinion established by the International Searching Authority (ISA) unless the ISA is also acting as the IPEA. See [PCT Rule 62.1\(i\) \(mpep-9025-appx-t.html#d0e374412\)](#).

VI. INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY (IPEA)

The International Preliminary Examining Authority (IPEA) normally starts the examination process when it is in possession of:

- (A) the Demand;
- (B) the amount due;
- (C) a translation, if the applicant is required to furnish a translation under [PCT Rule 55.2 \(mpep-9025-appx-t.html#d0e373660\)](#);
- (D) either the international search report or a notice of the declaration by the International Searching Authority (ISA) that no international search report will be established; and
- (E) the written opinion established under [PCT Rule 43bis.1 \(mpep-9025-appx-t.html#d0e371129\)](#).

However, the IPEA shall not start the international preliminary examination before the expiration of the later of three months from the transmittal of the international search report (or declaration that no international search report will be established) and written opinion; or the expiration of 22 months from the priority date unless the applicant expressly requests an earlier start, with the exception of the situations provided for in [PCT Rule 69.1\(b\) - \(e\) \(mpep-9025-appx-t.html#d0e375172\)](#).

The written opinion of the ISA is usually considered the first written opinion of the IPEA unless the IPEA has notified the International Bureau that written opinions established by specified International Searching Authorities shall not be considered a written opinion for this purpose. See [PCT Rule 66.1bis \(mpep-9025-appx-t.html#d0e374660\)](#). Also, the IPEA may, at its discretion, issue further written opinions provided sufficient time is available. See [PCT Rule 66.4 \(mpep-9025-appx-t.html#d0e374874\)](#).

The IPEA establishes the international preliminary examination report (entitled "international preliminary report on patentability"), which presents the examiner's final position as to whether each claim is "novel," involves "inventive step," and is "industrially applicable" by 28 months from the priority date. A copy of the international preliminary examination report is sent to the applicant and to the International Bureau. The International Bureau then communicates a copy of the international preliminary examination report to each elected Office.

The applicant must complete the requirements for entering the national stage by the expiration of 30 months from the priority date to avoid any question of withdrawal of the application as to that elected Office; however, some elected Offices provide a longer period to complete the requirements.

A listing of all national and regional offices, and the corresponding time limits for entering the national stage after PCT Chapter I and PCT Chapter II, may be found on WIPO's website at: www.wipo.int/pct/en/texts/time_limits.html (http://www.wipo.int/pct/en/texts/time_limits.html).

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1805 Where To File an International Application [R-07.2015]

35 U.S.C. 361 *Receiving Office.*

(a) The Patent and Trademark Office shall act as a Receiving Office for international applications filed by nationals or residents of the United States. In accordance with any agreement made between the United States and another country, the Patent and Trademark Office may also act as a Receiving Office for international applications filed by residents or nationals of such country who are entitled to file international applications.

See [MPEP § 1806 \(s1806.html#ch1800_d1ffcb_1d71d_75\)](#), as to who can file an international application.

Only if at least one of the applicants is a resident or national of the United States of America may an international application be filed in the United States Receiving Office. See [PCT Article 9\(1\) and \(3\) \(mpep-9025-appx-t.html#d0e363201\)](#), [PCT Rules 19.1 \(mpep-9025-appx-t.html#d0e368505\)](#) and [19.2 \(mpep-9025-appx-t.html#d0e368543\)](#), [35 U.S.C. 361\(a\) \(mpep-9015-appx-l.html#d0e306949\)](#) and [37 CFR 1.412\(a\) \(mpep-9020-appx-r.html#d0e327307\)](#) and [1.421 \(mpep-9020-appx-r.html#d0e327684\)](#). The concepts of residence and nationality are defined in [PCT Rule 18.1 \(mpep-9025-appx-t.html#d0e368432\)](#).

International applications may be filed electronically through the Office's electronic filing system (EFS-Web). International applications and related papers may also be deposited with the United States Receiving Office by addressing the papers to "Mail Stop PCT" and delivering them to the Customer Service Window at the USPTO's Alexandria headquarters. The street address is: U.S. Patent and Trademark Office, Customer Service Window, Mail Stop PCT, Randolph Building, 401 Dulany Street, Alexandria, VA 22314. The mailing address for delivery by the U.S. Postal Service is: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. It should be noted that the Priority Mail Express® provisions of [37 CFR 1.10 \(mpep-9020-appx-r.html#d0e313951\)](#) apply to the filing of all applications and papers filed in the U.S. Patent and Trademark Office, including PCT international applications and related papers and fees. It should be further noted, however, that PCT international applications and papers relating to international applications are specifically excluded from the Certificate of Mailing or Transmission procedures under [37 CFR 1.8 \(mpep-9020-appx-r.html#d0e313726\)](#). See [MPEP § 1834 \(s1834.html#d0e170737\)](#). If [37 CFR 1.8 \(mpep-9020-appx-r.html#d0e313726\)](#) is improperly used, the date to be accorded the paper will be the date of actual receipt in the Office unless the receipt date falls on a Saturday, Sunday, or federal holiday in which case the date of receipt will be the next succeeding day which is not a Saturday, Sunday, or federal holiday ([37 CFR 1.6 \(mpep-9020-appx-r.html#d0e313447\)](#)).

Irrespective of the Certification practice under [37 CFR 1.8\(a\) \(mpep-9020-appx-r.html#d0e313726\)](#), facsimile transmission (without the benefit of the certificate under [37 CFR 1.8\(a\) \(mpep-9020-appx-r.html#d0e313726\)](#)) may be used to submit certain papers in international applications. However, facsimile transmission may not be used for the filing of an international application, the filing of color drawings under [37 CFR 1.437 \(mpep-9020-appx-r.html#d0e328126\)](#), or the filing of a copy of the international application and the basic national fee to enter the U.S. national stage under [35 U.S.C. 371 \(mpep-9015-appx-l.html#d0e307164\)](#). See [37 CFR 1.6\(d\)\(3\) \(mpep-9020-appx-r.html#d0e313447\)](#) and [\(4\) \(mpep-9020-appx-r.html#d0e313529\)](#), [1.8\(a\)\(2\)\(i\)\(D\) \(mpep-9020-appx-r.html#d0e313726\)](#), and [1.8\(a\)\(2\)\(i\)\(E\) \(mpep-9020-appx-r.html#d0e313726\)](#). The Demand for international preliminary examination may be filed by facsimile transmission. See [MPEP § 1834.01 \(s1834.html#d0e170909\)](#).

The United States Receiving Office and PCT Help Desk are available to offer guidance on PCT requirements and procedures. See [MPEP § 1730 \(s1730.html#d0e163385\)](#) for information on contacting the staff and other available means for obtaining information.

WARNING - although the United States patent law at [35 U.S.C. 21\(a\) \(mpep-9015-appx-l.html#d0e301434\)](#) authorizes the Director to prescribe by rule that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service, [PCT Rule 20.1\(a\) \(mpep-9025-appx-t.html#d0e368656\)](#) provides for marking the "date of actual receipt on the request." Although the Priority Mail Express® provisions under [37 CFR 1.10 \(mpep-9020-appx-r.html#d0e313951\)](#) have not been contested to date regarding PCT applications, applicants should be aware of a possible different interpretation by foreign authorities.

[PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#) provides for transmittal of an international application to the International Bureau as Receiving Office in certain instances. For example, when the international application is filed with the United States Receiving Office and the language in which the international application is filed is not accepted by the United States Receiving Office, or if the applicant does not have the requisite residence or nationality, the application may be forwarded to the International Bureau for processing in its capacity as a Receiving Office. See [37 CFR 1.412\(c\)\(6\) \(mpep-9020-appx-r.html#d0e327307\)](#). The Receiving Office of the International Bureau will consider the international application to be received as of the date accorded by the United States Receiving Office. This practice will avoid the loss of a filing date in those instances where the United States Receiving Office is not competent to act, but where the international application indicates an applicant to be a national or resident of a PCT Contracting state or is in a language accepted under [PCT Rule 12.1\(a\) \(mpep-9025-appx-t.html#d0e367234\)](#) by the International Bureau as a Receiving Office. Where questions arise regarding residence or nationality, i.e., the U.S. is not clearly competent, the application will be forwarded to the International Bureau as Receiving Office. Note, where no residence or nationality is indicated, the U.S. is not competent, and the application will be forwarded to the International Bureau as Receiving Office so long as the necessary fee is paid. The fee is an amount equal to the transmittal fee.

If all of the applicants are indicated to be residents and nationals of non-PCT Contracting States, [PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#) does not apply, and the application is denied an international filing date.

Any applicant who is a resident or national of a PCT Contracting State may also file their application directly with the International Bureau as receiving Office. An applicant may wish to consider filing directly with the International Bureau as receiving Office instead of the United States Receiving Office in the situation where applicant is filing their international application after the expiration of the 12 month priority period but within two months of the expiration of the priority period, and where applicant desires to request restoration of the right of priority under the in spite of due care standard. See [MPEP § 1828.01 \(s1828.html#d0e170589\)](#). An applicant may also request that an application be forwarded to the International Bureau for processing in its capacity as receiving Office in accordance with [PCT Rule 19.4\(a\)\(iii\) \(mpep-9025-appx-t.html#d0e368616\)](#) in situations where the international application was filed with the United States Receiving Office after the expiration of the 12 month priority period but within two months of the expiration of the priority period, and where applicant desires to request restoration of the right of priority under the in spite of due care standard. However, any transfer request received after substantial processing of the international application by the United States Receiving Office has occurred may be declined.

Applications filed with, or forwarded to, the International Bureau must have a foreign filing license.

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1810 Filing Date Requirements [R-08.2017]

PCT Article 11

Filing Date and Effects of the International Application

- (1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:
 - (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,
 - (ii) the international application is in the prescribed language,
 - (iii) the international application contains at least the following elements:
 - (a) an indication that it is intended as an international application,
 - (b) the designation of at least one Contracting State,
 - (c) the name of the applicant, as prescribed,
 - (d) a part which on the face of it appears to be a description
 - (e) a part which on the face of it appears to be a claim or claims.

35 U.S.C. 363 International application designating the United States: Effect.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the America Invents Act (AIA). See [35 U.S.C. 100 \(note\)](#) ([mpep-9015-appx-l.html#al_d1d917_1bef1_2b](#)).]

An international application designating the United States shall have the effect, from its international filing date under [article 11](#) ([mpep-9025-appx-t.html#d0e363237](#)) of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office.

35 U.S.C. 363 (pre-AIA) International application designating the United States: Effect.

[Editor Note: Applicable to applications not subject to the first inventor to file provisions of the AIA (see [35 U.S.C. 100 \(note\)](#) ([mpep-9015-appx-l.html#al_d1d917_1bef1_2b](#))). See [35 U.S.C. 363](#) ([mpep-9015-appx-l.html#d0e306994313](#)) immediately above for the law otherwise applicable.]

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\(e\)](#) ([mpep-9015-appx-l.html#d0e302407](#)).

37 CFR 1.431 International application requirements.

[Editor Note: See [pre-AIA 37 CFR 1.431](#) ([mpep-9020-appx-r.html#d0e327806](#)) in Appendix R for para. (b)(3)(iii) applicable to applications filed before September 16, 2012]

- (a) An international application shall contain, as specified in the Treaty and the Regulations, a Request, a description, one or more claims, an abstract, and one or more drawings (where required). ([PCT Art. 3\(2\)](#) ([mpep-9025-appx-t.html#d0e363046](#)) and Section [207](#) ([mpep-9030-appx-ai.html#d0e279393](#)) of the Administrative Instructions.)
- (b) An international filing date will be accorded by the United States Receiving Office, at the time of receipt of the international application, provided that:
 - (1) At least one applicant (§ [1.421](#) ([mpep-9020-appx-r.html#aia_d0e327684](#))) is a United States resident or national and the papers filed at the time of receipt of the international application so indicate ([35 U.S.C. 361\(a\)](#) ([mpep-9015-appx-l.html#d0e306949](#)), [PCT Art. 11\(1\)\(i\)](#) ([mpep-9025-appx-t.html#d0e363237](#))).
 - (2) The international application is in the English language ([35 U.S.C. 361\(c\)](#) ([mpep-9015-appx-l.html#d0e306949](#)), [PCT Art. 11\(1\)\(ii\)](#) ([mpep-9025-appx-t.html#d0e363237](#))).
 - (3) The international application contains at least the following elements ([PCT Art. 11\(1\)\(iii\)](#) ([mpep-9025-appx-t.html#d0e363237](#))):
 - (i) An indication that it is intended as an international application ([PCT Rule 4.2](#) ([mpep-9025-appx-t.html#d0e365969](#)));
 - (ii) The designation of at least one Contracting State of the International Patent Cooperation Union (§ [1.432](#) ([mpep-9020-appx-r.html#d0e327937](#)));
 - (iii) The name of the applicant, as prescribed (note §§ [1.421](#) ([mpep-9020-appx-r.html#aia_d0e327684](#)), [1.422](#) ([mpep-9020-appx-r.html#aia_d0e327758](#)), and [1.424](#) ([mpep-9020-appx-r.html#aia_d0e327782](#)));
 - (iv) A part which on the face of it appears to be a description; and
 - (v) A part which on the face of it appears to be a claim.
- (c) Payment of the international filing fee ([PCT Rule 15.2](#) ([mpep-9025-appx-t.html#d0e368023](#))) and the transmittal and search fees (§ [1.445](#) ([mpep-9020-appx-r.html#d0e328174](#))) may be made in full at the time the international application

papers required by paragraph (b) of this section are deposited or within one month thereafter. The international filing, transmittal, and search fee payable is the international filing, transmittal, and search fee in effect on the receipt date of the international application.

- (1) If the international filing, transmittal and search fees are not paid within one month from the date of receipt of the international application and prior to the sending of a notice of deficiency which imposes a late payment fee, applicant will be notified and given one month within which to pay the deficient fees plus the late payment fee. Subject to paragraph (c)(2) of this section, the late payment fee will be equal to the greater of:
 - (i) Fifty percent of the amount of the deficient fees; or
 - (ii) An amount equal to the transmittal fee;[.]
- (2) The late payment fee shall not exceed an amount equal to fifty percent of the international filing fee not taking into account any fee for each sheet of the international application in excess of thirty sheets ([PCT Rule 16bis \(mpep-9025-appx-t.html#d0e368190\)](#)).
- (3) The one-month time limit set pursuant to paragraph (c) of this section to pay deficient fees may not be extended.
- (d) If the payment needed to cover the transmittal fee, the international filing fee, the search fee, and the late payment fee pursuant to paragraph (c) of this section is not timely made in accordance with [PCT Rule 16bis.1\(e\) \(mpep-9025-appx-t.html#d0e368199\)](#), the Receiving Office will declare the international application withdrawn under [PCT Article 14\(3\)\(a\) \(mpep-9025-appx-t.html#d0e363352\)](#).

THE "INTERNATIONAL FILING DATE"

An international filing date is accorded to the earliest date on which the requirements under [PCT Article 11\(1\) \(mpep-9025-appx-t.html#d0e363237\)](#) were satisfied. If the requirements under [PCT Article 11\(1\) \(mpep-9025-appx-t.html#d0e363237\)](#) are not satisfied as of the date of initial receipt of the international application papers, the receiving Office will invite applicant to correct the deficiency within a set time limit. See [PCT Article 11\(2\) \(mpep-9025-appx-t.html#d0e363237\)](#) and [PCT Rule 20.3 \(mpep-9025-appx-t.html#d0e368720\)](#). In such case, the international filing date will be the date on which a timely filed correction is received by the receiving Office. If the defect under [PCT Article 11\(1\) \(mpep-9025-appx-t.html#d0e363237\)](#) is that the purported international application fails to contain a portion which on its face appears to be a description or claims, and if the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the initial receipt date may be retained as the international filing date if the submitted correction was completely contained in the earlier application. See [PCT Rules 4.18 \(mpep-9025-appx-t.html#d0e366394\)](#) and [20.6 \(mpep-9025-appx-t.html#d0e368933\)](#). If the defect under [PCT Article 11\(1\) \(mpep-9025-appx-t.html#d0e363237\)](#) is not timely corrected, the receiving Office will promptly notify the applicant that the application is not and will not be treated as an international application. See [PCT Rule 20.4 \(mpep-9025-appx-t.html#d0e368804\)](#). Where all the sheets pertaining to the same international application are not received on the same day by the receiving Office, in most instances, the date of receipt of the application will be amended to reflect the date on which the last missing sheets were received. As an amended date of receipt may cause the priority claim to be forfeited, applicants should assure that all sheets of the application are deposited with the receiving Office on the same day. If the application, on its initial receipt date, contained a priority claim and a proper incorporation by reference statement, the initial receipt date may be retained as the international filing date if the submitted correction was completely contained in the earlier application. Again see [PCT Rules 4.18 \(mpep-9025-appx-t.html#d0e366394\)](#) and [20.6 \(mpep-9025-appx-t.html#d0e368933\)](#).

An all too common occurrence is that applicants will file an international application in the U.S. Receiving Office and no applicant has a U.S. residence or nationality. Applicants are cautioned to be sure that at least one applicant is a resident or national of the U.S. before filing in the U.S. Receiving Office. Where no applicant indicated on the request papers is a resident or national of the United States, the USPTO is not a competent receiving Office for the international application under [PCT Rule 19.1\(a\) \(mpep-9025-appx-t.html#d0e368505\)](#). Nonetheless, the date the international application was filed in the USPTO will not be lost as a filing date for the international application if at least one applicant is a resident or national of any PCT Contracting State. Under [PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#), the USPTO will receive the application on behalf of the International Bureau as receiving Office ([PCT Rule 19.4\(a\) \(mpep-9025-appx-t.html#d0e368587\)](#)) and, upon payment of a fee equal to the transmittal fee, the USPTO will promptly transmit the international application to the International Bureau under [PCT Rule 19.4\(b\) \(mpep-9025-appx-t.html#d0e368587\)](#). However, if all of the applicants are indicated to be both residents and nationals of non-PCT Contracting States, [PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#) does not apply, and the application is denied an international filing date.

The USPTO is also not competent to receive international applications that are not in the English language and, upon payment of a fee equal to the transmittal fee, the USPTO will forward such applications to the International Bureau under [PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#) provided they are in a language accepted by the International Bureau as receiving Office.

A discussion of [PCT Rule 19.4 \(mpep-9025-appx-t.html#d0e368587\)](#) is also included in [MPEP § 1805 \(s1805.html#d0e164352\)](#).

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1812 Elements of the International Application [R-08.2017]

PCT Article 3 The International Application

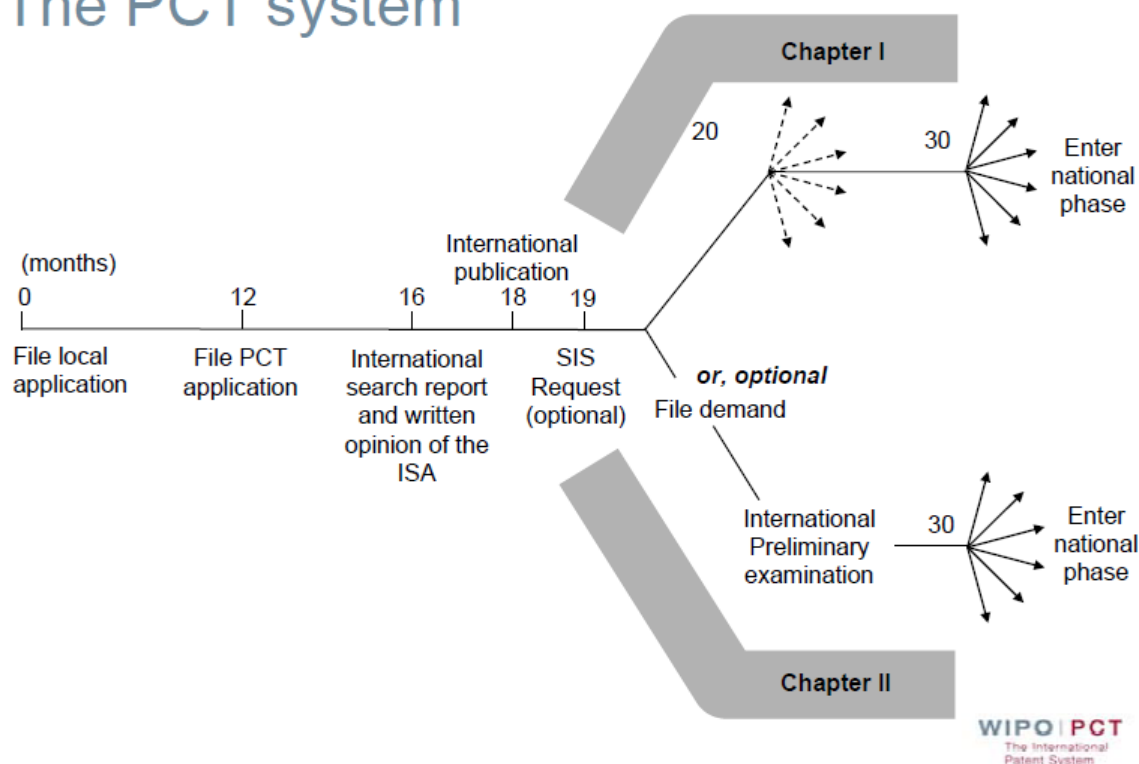
- (1) Applications for the protection of inventions in any of the Contracting States may be filed as international applications under this Treaty.
- (2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.
- (3) The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought.
- (4) The international application shall:
 - (i) be in a prescribed language;
 - (ii) comply with the prescribed physical requirements;
 - (iii) comply with the prescribed requirement of unity of invention;
 - (iv) be subject to the payment of the prescribed fees.

Any international application must contain the following elements: request, description, claim or claims, abstract and one or more drawings (where drawings are necessary for the understanding of the invention ([PCT Article 3\(2\)](#) ([mpep-9025-appx-t.html#d0e363046](#)) and [PCT Article 7\(2\)](#) ([mpep-9025-appx-t.html#d0e363156](#))). The elements of the international application are to be arranged in the following order: the request, the description (other than any sequence listing part thereof), the claims, the abstract, the drawings, and the sequence listing part of the description (where applicable) (Administrative Instructions Section [207\(a\)](#) ([mpep-9030-appx-ai.html#d0e279393](#))). All the sheets contained in the international application must be numbered in consecutive Arabic numerals by using the following separate series of numbers: a first series applying to the request; a second series to the description, claims and abstract; a third series to the drawings (where applicable); and a further series to the sequence listing part of the description (where applicable) ([PCT Rule 11.7](#) ([mpep-9025-appx-t.html#d0e367031](#))) and Administrative Instructions Section [207\(b\)](#) ([mpep-9030-appx-ai.html#d0e279393](#))). Only one copy of the international application need be filed in the United States Receiving Office ([37 CFR 1.433\(a\)](#) ([mpep-9020-appx-r.html#d0e327975](#))). The request is made on a standardized form (Form PCT/RO/101), copies of which can be obtained from the USPTO or online from WIPO's website ([www.wipo.int/pct/en/forms/](#) ([http://www.uspto.gov/patents/init_events/pct/Chapter1.jsp](#))). The "Request" form can also be presented as a computer printout prepared using the PCT-SAFE software or WIPO's ePCT system. See [MPEP § 1821](#) ([s1821.html#d0e168204](#))).

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1842 Basic Flow Under the PCT [R-08.2017]

The PCT system

**I. MEASURING TIME LIMITS UNDER THE PCT**

Time limits under the PCT are measured from the "priority date" of the application. The priority date for the purposes of computing time limits is defined in [PCT Article 2\(xi\)](#) ([mpep-9025-appx-t.html#d0e362923](#)). Where an international application does not contain any priority claim under [PCT Article 8](#) ([mpep-9025-appx-t.html#d0e363180](#)), the international filing date is considered to be the priority date.

II. INTERNATIONAL FILING DATE

An international application under the Patent Cooperation Treaty is generally filed within 12 months after the filing of the first application directed to the same subject matter, so that priority may be claimed under [PCT Article 8](#) ([mpep-9025-appx-t.html#d0e363180](#)) and [Article 4](#) ([mpep-9025-appx-t.html#d0e363086](#)) of the Stockholm Act of the Paris Convention for the Protection of Industrial Property. [PCT Article 11](#) ([mpep-9025-appx-t.html#d0e363237](#)) specifies the elements required for an international application to be accorded an international filing date.

III. ESTABLISHMENT OF THE INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

As provided in [PCT Rule 42](#) ([mpep-9025-appx-t.html#d0e370881](#)) and [PCT Rule 43bis](#) ([mpep-9025-appx-t.html#d0e371120](#)), the time limit for establishing the international search report (or a declaration that no international search report will be established) and written opinion is three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

IV. INTERNATIONAL PUBLICATION

Under [PCT Article 21](#) ([mpep-9025-appx-t.html#d0e363622](#)), the international publication of the international application by the International Bureau shall be effected promptly after the expiration of 18 months from the priority date of that application.

V. SUPPLEMENTARY INTERNATIONAL SEARCH (SIS)

As provided in [PCT Rule 45bis](#) ([mpep-9025-appx-t.html#Rule45bis](#)), at any time prior to the expiration of 22 months from the priority date, the applicant can request one or more supplementary international searches each to be carried out by an International Searching Authority other than the International Searching Authority which carries out the main international search.

VI. DEADLINE FOR FILING THE DEMAND

International preliminary examination is optional. A demand for international preliminary examination must be filed prior to the expiration of whichever of the following periods expires later: (A) three months from the date of transmittal to the applicant of the international search report and the written opinion; or (B) 22 months from the priority date. Otherwise the demand shall be considered as if it had not been submitted and the International Preliminary Examining Authority shall so declare. See [PCT Rule 54 \(mpep-9025-appx-t.html#d0e373512\)](#). In order to take advantage of a national phase entry time limit of at least 30 months from the priority date in relation to all States designated in the international application, it may be necessary to file a demand before the expiration of 19 months from the priority date. See subsection VII.A., below.

VII.DEADLINE FOR FILING COPY, TRANSLATION, AND FEE IN NATIONAL STAGE OFFICES

A listing of all national and regional offices, and the corresponding time limits for entering the national stage following PCT Chapter I and PCT Chapter II, may be found on WIPO's website at: www.wipo.int/pct/en/texts/time_limits.html (http://www.wipo.int/pct/en/texts/time_limits.html).

A.National Stage Entry Following PCT Chapter I

[PCT Article 22\(1\)\(mpep-9025-appx-t.html#d0e363673\)](#) was amended, effective April 1, 2002, to specify that the national stage requirements are due not later than at the expiration of 30 months from the priority date if no demand has been filed. Prior to April 1, 2002, [PCT Article 22\(1\)\(mpep-9025-appx-t.html#d0e363673\)](#) specified that these requirements were due not later than at the expiration of 20 months from the priority date. See www.wipo.int/pct/en/texts/time_limits.html (http://www.wipo.int/pct/en/texts/time_limits.html) for a list of the Contracting States that have not yet changed their national laws to adopt the 30 month period now set forth in [PCT Article 22\(1\)\(mpep-9025-appx-t.html#d0e363673\)](#). (At the time of publication of this Chapter, only three countries have not adopted [Article 22\(1\)\(mpep-9025-appx-t.html#d0e363673\)](#) as amended: Luxembourg (LU), United Republic of Tanzania (TZ) and Uganda (UG). It is noted that Luxembourg is included in the regional designation "EPO" and that the United Republic of Tanzania and Uganda are included in the regional designation "ARIPO.")

B.National Stage Entry Following PCT Chapter II

If the election of a Contracting State has been effected by filing a demand prior to the expiration of the 19th month from the priority date, the provisions of Article 39 apply rather than the provisions of [Article 22 \(mpep-9025-appx-t.html#d0e363665\)](#). The deadline for filing the national stage requirements under PCT Article 39(a) is 30 months from the priority date, but any national law may fix time limits which expire later than the time limit provided in PCT Article 39(a). See PCT Article 39(b) and the list of time limits found on WIPO's website at www.wipo.int/pct/en/texts/time_limits.html (http://www.wipo.int/pct/en/texts/time_limits.html).

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Considerations and Options for Foreign Filing Including the PCT

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International Patent Legal Administration
United States Patent & Trademark Office



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Overview

- Information about foreign patents
- General considerations in deciding whether to pursue patent protection outside of the United States
- Options available for pursuing foreign patent protection
- Review the structure and function of the Patent Cooperation Treaty (PCT)
- Avoiding common mistakes

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Foreign Patent Protection

- Patent protection can be an important part of overall business strategy in today's global marketplace
- In general, patent rights are territorial in nature
 - Protect against infringing activities occurring within the country or region in which the patent was granted
- To obtain patent rights in foreign countries, U.S. applicants must apply for a patent in each country or region of interest
 - A world-wide patent does not exist



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Who Grants Patents?

- National patent offices
 - *E.g.*, USPTO, JPO, KIPO, *etc.*
- Regional patent offices
 - Grants patents with effect in some or all member countries
 - European Patent Office (EPO)
 - African Regional Intellectual Property Organization (ARIPO)
 - Eurasian Patent Convention (EA)
 - African Intellectual Property Organization (OAPI)
 - Patent Office of the Gulf Cooperation Council (GCC)



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General Considerations in Filing Foreign Patent Applications (1)

- Market size and potential of country/region
- Manufacturing potential
- Industry size and growth
- Competition activity
- Patent procurement costs



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General Considerations in Filing Foreign Patent Applications (2)

- Patent law considerations
 - Standards of patentability in country/region
 - Patentable subject matter differences
 - Prior art differences
 - Grace periods
 - Geographical restrictions
 - First-to-file
 - Enforceability of patents
 - Does the country/region have effective laws and procedures for enforcing the patent?



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Options for Foreign Filing

- File a patent application directly in a national or regional patent office (Paris Convention)
 - A foreign filing license from the USPTO may be required
- File an international patent application under the Patent Cooperation Treaty (PCT)
 - A foreign filing license from the USPTO may be required, if filing in a foreign receiving Office



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International Agreements and Treaties Governing Priority (1)

- Paris Convention
 - Provides applicant with a 12-month right of priority, triggered by the first filing of a patent application, in which to file a subsequent application in another Paris Convention member country for the same invention
 - The subsequent application must claim the priority of the first application in order to make use of the right of priority
 - Most countries are party to the Paris Convention
 - Currently 177 Contracting Parties
 - Excludes countries not recognized by the United Nations, e.g., Taiwan

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International Agreements and Treaties Governing Priority (2)

- Patent Cooperation Treaty (PCT)
 - Effectively permits the filing of a single international application to be treated as “a regular national application in each designated State as of the international filing date” (PCT Article 11)
 - Currently 152 Contracting States are party to the PCT

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Direct Filing in a Foreign National or Regional Patent Office

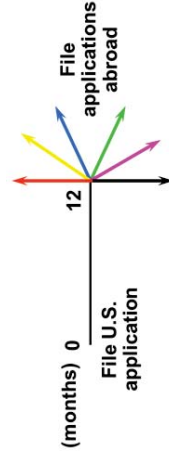
- May be cost effective if filing in only a few countries
- Applicant is certain as to which countries applications are to be filed
- Applicant is prepared to pay the filing costs early
 - *E.g.*, filing fees, translation costs, attorney fees
- Necessary for countries not party to the PCT

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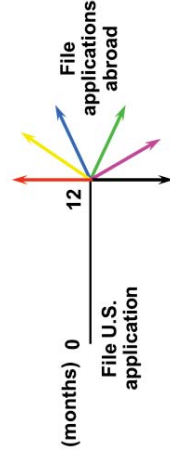
Example: Direct Foreign Filing under the Paris Convention (1)



- U.S. patent application followed within 12 months by one or more foreign applications filed in Paris Convention or WTO member countries
- The foreign application(s) may claim priority to the earlier U.S. application
- If the invention in the foreign application(s) is entitled to the priority, the filing date of the U.S. application will be used for prior art purposes

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Example: Direct Foreign Filing under the Paris Convention (2)



- Some additional considerations when multiple foreign applications at 12 months and claiming priority under the Paris Convention
 - Multiple formality requirements
 - Multiple prosecutions of applications
 - Translations and national/regional fees required at 12 months

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The Patent Cooperation Treaty

- A United Nations Treaty
 - Signed June 1970
 - Became operational June 1978
 - Administered by the International Bureau (IB)
 - Of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland



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International Patent?

- An international application is filed under the PCT but...
 - There is no “international patent”
 - The PCT functions as a patent application filing system
 - The international application must still be prosecuted
 - In each national or regional office where patent protection is desired

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Purposes of the PCT

- To simplify the process of filing foreign patent applications
- To give every regional and national patent Office and the applicant the benefit of
 - A search and written opinion on patentability by an International Searching Authority (ISA)
 - An optional further examination by an International Preliminary Examining Authority (IPEA)

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PCT Contracting State

- A country which is a signatory to the PCT
- Eighteen (18) Contracting States in 1978
- Currently 152 Contracting States
 - Jordan became bound by the PCT on 09 June 2017

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The International Application

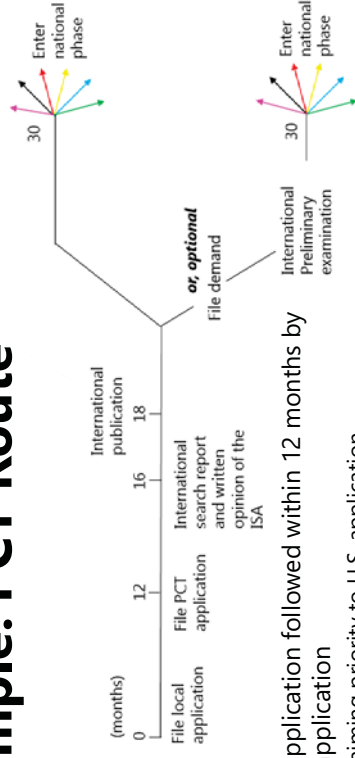
- A single application
 - Filed together with a request
 - By a resident/national of a PCT contracting state
 - Filed in one language
 - Filed in one patent office
 - The receiving office (RO)
 - Usually the applicant's home patent office
 - Treated as a national application
 - In each designated state as of the international filing date (IFD)
- Formalities in compliance with the PCT
 - Must be accepted during national phase

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Example: PCT Route



- U.S. application followed within 12 months by PCT application
 - Claiming priority to U.S. application
 - One set of formalities requirements
 - Translations and national/regional fees and prosecution not required until 30 months

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Two Phases of the PCT

- International phase
 - Chapter I (mandatory)
 - Chapter II (optional)
- National phase (stage)

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Chapter I

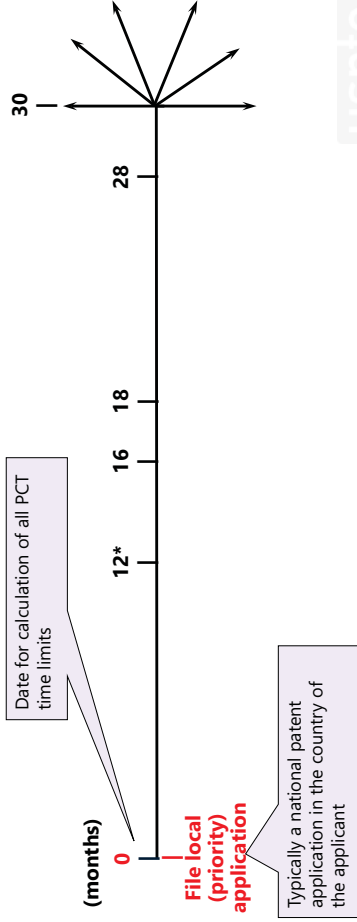
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PCT System

Priority Application Filed



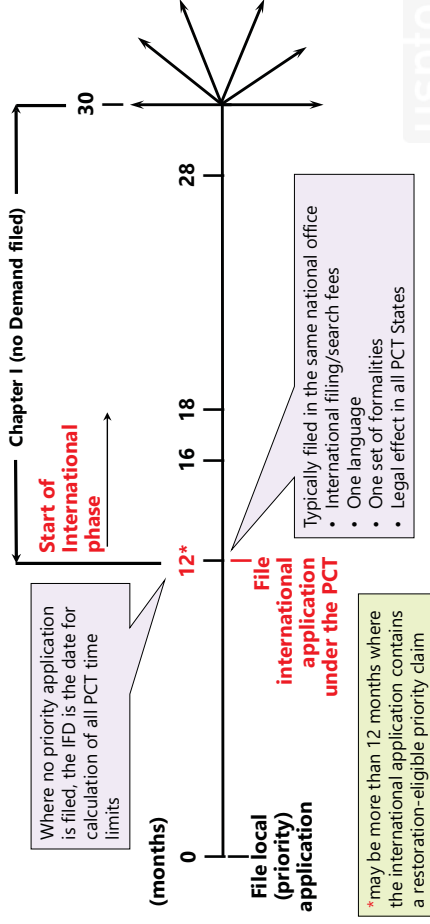
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PCT System – Chapter I

International Application Filed



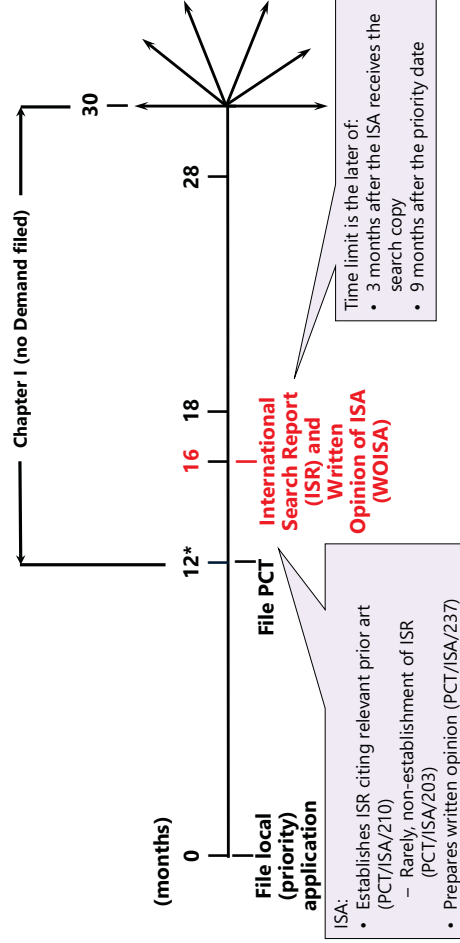
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PCT System – Chapter I

ISR and WOISA Issued



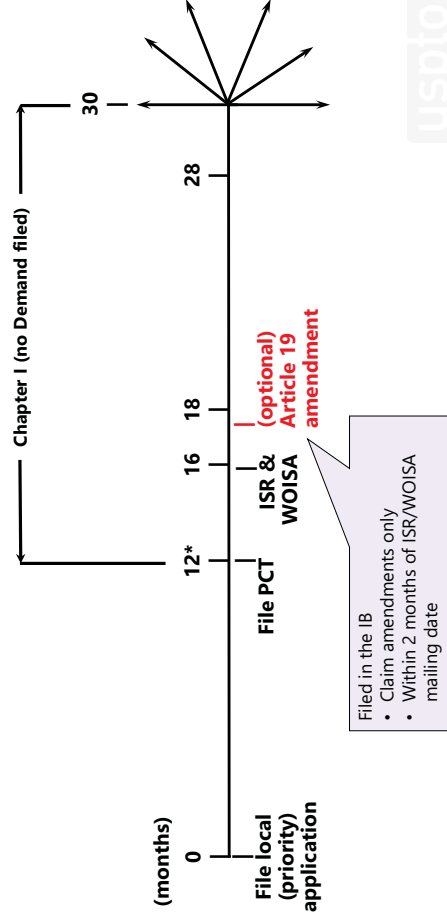
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PCT System – Chapter I

Article 19 Amendment Filed



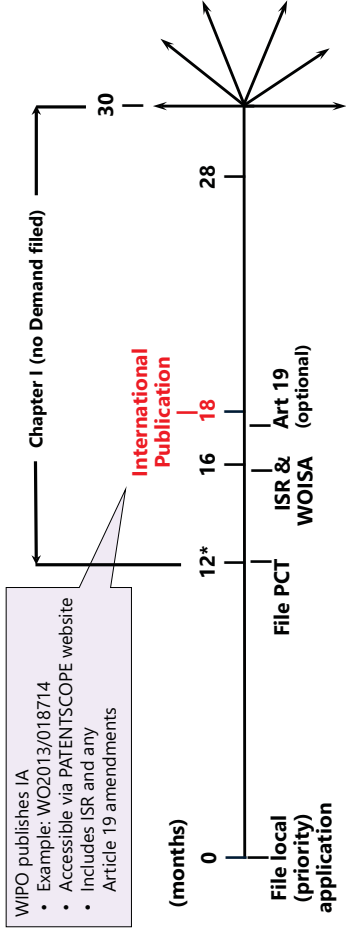
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PCT System – Chapter I

International Application Publication



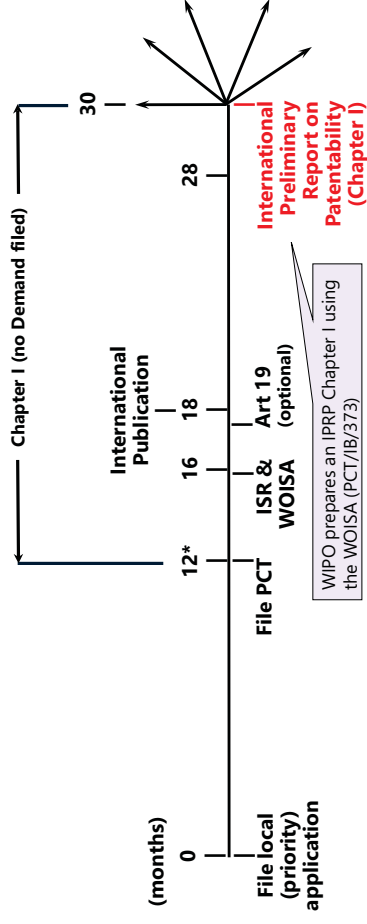
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PCT System – Chapter I

International Preliminary Report on Patentability (IPRP) (Chapter I)



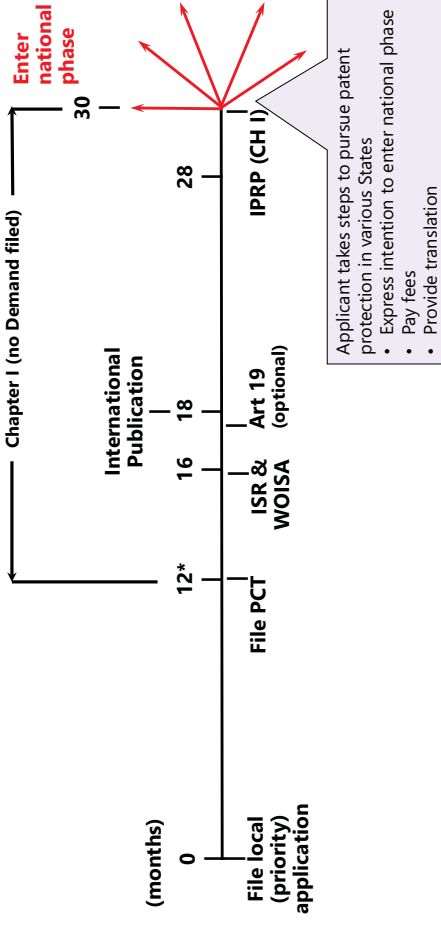
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PCT System – Chapter I

National Phase Entry from Chapter I



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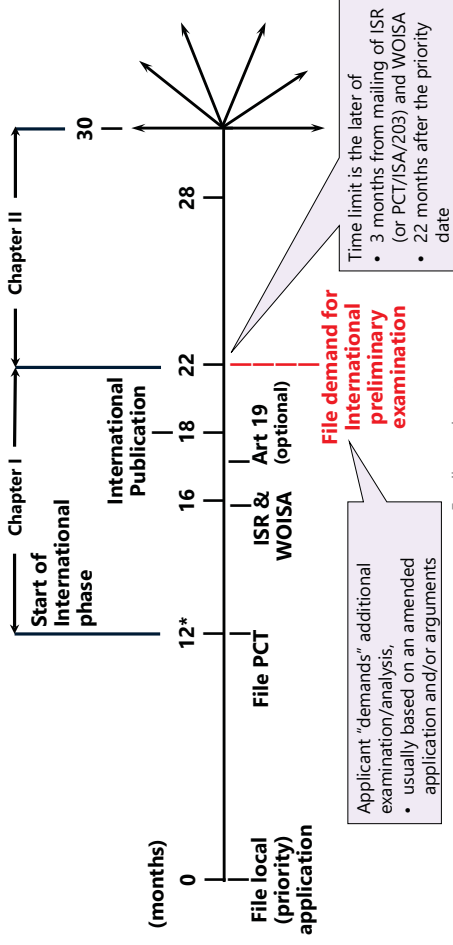
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Chapter II

PCT System – Chapter II

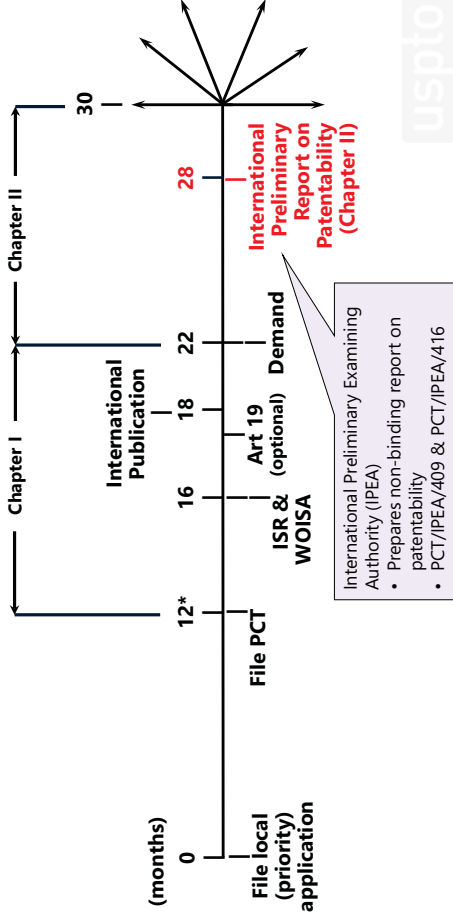
Filing of Demand for Chapter II Entry



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PCT System – Chapter II

IPRP (Chapter II)

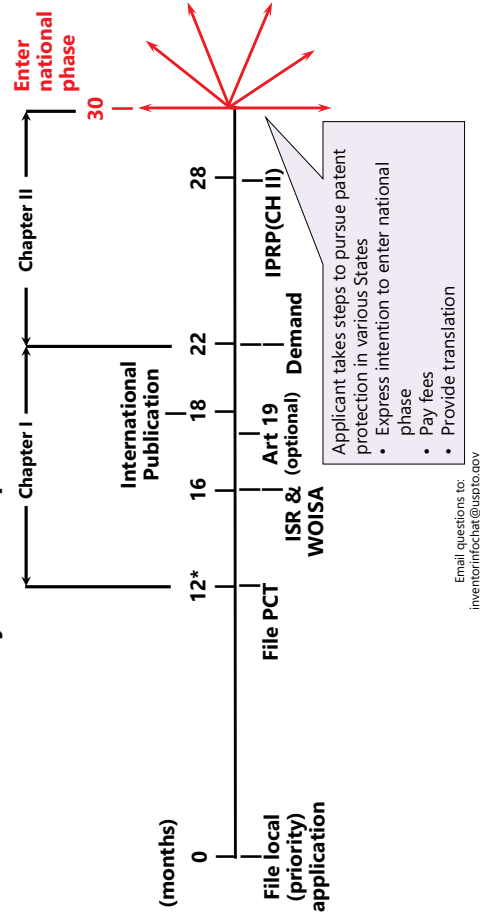


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PCT System – Chapter II

National Phase Entry from Chapter II



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The National Stage

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National Stage Requirements

- PCT Articles 22 & 39 require furnishing of the following for national/regional stage entry
 - A copy of the international application (unless already provided by the International Bureau)
 - A translation of the international application (where appropriate)
 - The national fee
- National/Regional Offices may have additional requirements
 - PCT Applicant's Guide provides details
 - <http://www.wipo.int/pct/en/appguide/>

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PCT Route Filing Strategies

- Some options for foreign filing using the PCT*
 - Option 1: Nonprovisional followed by PCT
 - Option 2: Provisional followed by PCT
 - Option 3: Provisional followed by Nonprovisional **and** PCT
 - Option 4: PCT filed first
- * List is not exhaustive

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Avoiding Common Mistakes

- Confidentiality
 - Avoid making the invention public prior to filing a patent application
 - Many countries have an absolute novelty requirement
- Be familiar with key dates and deadlines
 - Under U.S., foreign, and international laws
 - *E.g.*, one year deadline from first filing in U.S. to file directly in foreign countries to preserve priority
- Recommend securing services of a registered patent attorney or agent
 - If unfamiliar with the complexities in obtaining foreign patent rights
 - To avoid potentially losing patent rights

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