

The Fireworks of PCT Practice – Chapter I

By Kirk A. Wilson*

Note: This is the second of a four-article series on PCT practice. Today we discuss PCT Chapter I activities with subsequent articles covering PCT Chapter II and the National Phase. For more information on PCT practice, see http://www.wipo.int/pct/en/seminar/basic_1.

Now that the big picture of PCT practice has been learned from the timelines presented in the preceding issue, prepare yourself for some Chapter I prosecution that tends to smoke up the skies as the fireworks begin. The 20- and 30-month mortar rounds are very similar during this phase, and the ignition sequence begins with formatting the application in accordance with PCT regulations and preparation of the PCT Request.

A few peculiarities about the international application include the requirement of A4 size paper with one-inch margins on all sides, removal of any text matter from drawings, addition of an “industrial applicability” section in the specification, and addition of drawing reference characters to the Abstract. Page numbering, date format (Day-Month-Year), and the order in the application are also very specific.

A PCT Request, or the electronic counterpart PCT-EASY, must accompany the application. The applicant(s) may be legal entities (e.g. a corporation) or inventor(s), and the applicant’s(s’) relationship with the application must be disclosed in the Request. Typically, if all patent rights are assigned to a single legal entity, the PCT applicant is that legal entity. However, if the U.S. is designated as one of the PCT contracting states (typical for PCT-First applications), the inventor(s) must be indicated as both inventor(s) and applicant(s). Also, an Interna-

tional Searching Authority (ISA) must be designated in the Request, remembering that if the US is the designated ISA, the application can only be examined by the USPTO. If the EP is the designated ISA, either the USPTO or the EPO can examine the application. The author’s experience is that the additional first cost for designating the EP as the ISA is money well spent. When completed, the Request and accompanying international application papers must be filed with the appropriate PCT Receiving Office (RO), depending on the residence or nationality of the applicant(s). In addition, all applicants can file with the International Bureau (IB) as RO. Also remember that the Express Mail “date of deposit” is only effective if the international application is filed at the US receiving office, and that a filing date cannot be established via faxed papers.

When choosing the designated PCT contracting states (hereinafter referred to as countries), the applicant can designate specific countries of economic interest, or as many as all 116 PCT contracting countries (as of November 15, 2001). The designation cost is currently \$82 per designated country with a maximum cost of \$492 for all 116 countries. In January 2002, the maximum cost will be reduced to \$410. Unless the applicant is fully confident about specific country designations, the author recommends designating all countries at this stage.

After all PCT filing requirements are met, a myriad of international invitations/notifications are mailed from the PCT receiving office and/or the IB informing the agent of matters such as corrections, filing date, 18-month publication, and finally the search report. The International Search Report (ISR) provides significant information on the international patentability of the invention including classification of subject matter, fields searched, and documents considered to be relevant. If a companion case is pending in the US, any new prior art found by the ISA must be submitted to the US examiner in a supplemental IDS. An Article 19 amendment can be submitted up to two months after the date of the ISR (or prior to the 16th month, whichever expires later) to distinguish patentable subject matter in the invention from prior art cited in the ISR.

Chapter I terminates with either filing a Demand for international preliminary examination at the 19th month, thereby progressing into Chapter II, or national phase filing(s) in designated countries at the 20th month. (Time limits to enter the national phase will be changed in 2002, see the accompanying article on PCT Practice Tips.) Regarding national phase filings, it is highly recommended that a country- or region-specific agent (foreign associate) be appointed for the performance of the

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acts for entry into the national phase. Most designated offices require non-resident applicants to be represented by an agent; others require non-resident applicants to have an address for service in the country for which the office acts. The applicant must be prepared to pay these exploding national phase costs in a timely manner and it is the agent's responsibility to monitor the applicable time limit(s) in order for the application not to lose its effect before the designated Offices. This decision process is best started at the 16th month to allow time for interaction with foreign associates. Without timely decisions, the only remaining option is to file the Demand, thereby postponing national phase filings until the 30th month.

The smoke generated by these Chapter I fireworks is merely an indication of the national phase explosion and "Grant" Finale to follow. Reliable docketing and timely communication are keys to making this show a success.

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**The Officers
and Directors of
the NAPP wish
you and your
family a very
healthy and happy
New Year 2002.**

PCT Practice Tips - Chapter I

This commentary provides details for several of the items mentioned in Kirk Wilson's overview of Chapter I activity. These expanded topics are intended to acquaint the reader with some less familiar approaches of PCT practice in order to promote strategies for filing, amending and monitoring the international application in its initial stage.

Payment of Official Filing Fees

Although it is advisable to submit the required fees with the application, the filing fees will be accepted, without penalty, up to one month from the date of receipt of the application by the Receiving Office (RO). If the fees are not filed within that month, the RO issues an Invitation to pay the fees within one month of the Invitation, and includes a surcharge of typically 50% of the original fees. The application will be considered withdrawn if all filing fees (transmittal, search, basic, and designation fees) for at least one country designation are not filed by the expiration of the extended deadline. Assuming the application is filed with the RO/US via Express Mail, the due date derives from the date of the express mailing, and not from the actual date of receipt by the RO.

For international applications which do **not** claim priority (PCT as a first filing), the designation fee portion only of the filing fees can be paid up to one year from the date of receipt of the international application by the RO. Because the International Search Report (ISR) issues prior to the due date for payment of the designation fees for a PCT first filing application, the applicant has the advantage of reviewing the cited art and evaluating the probability of obtaining valid protection of the invention prior to paying these fees. This strategy could save payment of the entire designation fee if the ISR is particularly unfavorable, and the applicant decides to abandon the application.

Declarations in the Request to Streamline National Phase Entry

Since March 1, 2001, the Request can optionally contain one or more of the following declarations: Identity of the Inventor; Entitlement to Apply For and Be Granted a Patent; Entitlement to Claim Priority; Inventorship; and Non-prejudicial Disclosures or Exceptions to Lack of Novelty

Such declarations can be included in the Request with the intention to simplify the national phase processing of the PCT application. Each declaration must conform to standardized wording, with the effect that the designated Offices (with only a few exceptions) may not require additional documents or evidence relative to the intent of the declaration (unless the veracity of the declaration is in doubt). Each declaration can be filed up to the 16th month if not included in the Request, and can be corrected if necessary by filing a replacement sheet. The only declaration that requires signature is the Declaration of Inventorship, which is applicable when the US is a designated state, and which must be signed by each inventor.

The declarations appear in Box No. VIII of the Request, and the associated Notes to the Request Form, dated March 2001, provide valuable assistance in completing the forms. For details, see PCT Rules 4.1(c)(iii) and 4.17.

Continued on next page