



Ant-like Persistence®

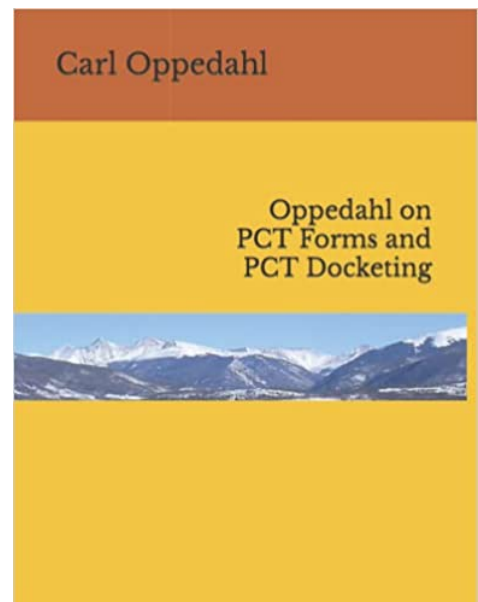
(<https://blog.oppedahl.com>)



A new PCT book: PCT Forms and PCT Docketing (<https://blog.oppedahl.com/?p=7181>)

14th November, 2021 (<https://blog.oppedahl.com/?p=7181>) (<https://blog.oppedahl.com/?author=1>)

([https://blog.oppedahl.com/wp-](https://blog.oppedahl.com/wp-content/uploads/2021/11/31s7k35V84L._SX384_BO1204203200_.jpg)



content/uploads/2021/11/31s7k35V84L._SX384_BO1204203200_.jpg)Here is a book that I think you should add to your bookshelf: *Oppedahl on PCT Forms and PCT Docketing*.

You can see it on Amazon here (<https://www.amazon.com/dp/B09LGLN5XK/>).

For each of fifty forms, we discuss what docket should be set or cleared when the form arrives. We discuss what to look for in the form that might indicate that some further action is required or some particular docket needs to be set. We identify combinations of events which require “calling a meeting” because some docket failure has occurred or there is reason to worry that other files in the office might require review to see if a similar failure has occurred. The forms discussed include:

- two Power of Attorney forms

PCT Seminar Calendar

(https://www.wipo.int/pct/en/seminar/seminar.pdf)
(situation on 12 November 2021)

Dates and location	Language of seminar	Nature of seminar; WIPO speakers (and others where known)	Organizer and contact numbers
22 November 2021 Online seminar	Arabic/ French	WIPO "PCT Prime" Webinar on the Patent Cooperation Treaty (PCT) and Related IP Services for the National Institute for Food, Nutrition and Agro-Food Technologies (INATAA), the University of Guelma, the University of Oran, and the University of Batna, Algeria WIPO Speakers: Ms. Bonvallet, Mr. Abdelnasser, Mr. Jazairy	Algerian National Institute of Industrial Property (INAPI) (Mr. Youcef Ziane) E-mail: y.ziane@inapi.org
24 - 26 November 2021 Bad Nauheim (DE)	German	PCT presentation on the latest developments in the PCT within the framework of the 11th PAFA-Tagung conference WIPO speaker: Mr. Reischle-Park Other WIPO speakers on other IP topics: Ms. Weiss and other speaker to be announced	Intellectual Property for Intellectual People (IP for IP) GmbH (Ms. Monika Huppertz) Tel: (49-0) 6201 844 37 30 Fax: (49-0) 6201 98 62 10 E-mail: info@ipforip.de Internet: https://www.ipforip.com
30 November 2021 Online seminar	French	PCT seminar within the framework of the basic CEIPI course WIPO speaker: to be announced	Centre d'études internationales de la propriété industrielle (CEIPI), International Section (Mr. Thierry Debled) E-mail: thierry-debled@ceipi.edu
15 December 2021 Online seminar	Arabic/ French	WIPO "PCT Prime" Webinar on the Patent Cooperation Treaty (PCT) and Related IP Services for the University of Sidi Bel Abbas, and the Center for the Development of Renewable Energies (CDER), Algeria WIPO Speakers: Ms. Bonvallet, Mr. Abdelnasser, Mr. Jazairy	Algerian National Institute of Industrial Property (INAPI) (Mr. Youcef Ziane) E-mail: y.ziane@inapi.org

PCT Webinars

(https://www.wipo.int/pct/en/seminar/webinars/index.html)

Date and time	Language of webinar	Nature of webinar; WIPO speakers	Registration
15 November 2021 09:00 – 10:45 (CET)	Russian	Roving Webinar on WIPO Services and Initiatives WIPO speakers: Mr. Spitsyn, Mr. Gribkov, Mr. Azimov, Mr. Dimitrov, Ms. Ghetu, Ms. Gobechia, and Ms. Krysanova. Other speakers: Mr. Zhuravlev (Rospatent) and Mr. Gulyaeva (Hogan Lovells), Moscow	https://www.wipo.int/meetings/en/details.jsp?meeting_id=65469
17 November 2021 12:00 – 13:40 (US Mountain Time)	English	"Picking a PCT Receiving Office" Speaker on behalf of WIPO: Mr. Oppedahl (Oppedahl Patent Law Firm LLC)	https://blog.oppedahl.com/?page_id=7157

[continued on next page]

PCT Webinars [continued]			
Date and time	Language of webinar	Nature of webinar; WIPO speakers	Registration
19 November 2021 12:00 – 13:40 (US Mountain Time)	English	“National phase or bypass continuation” Speaker on behalf of WIPO: Mr. Oppedahl (Oppedahl Patent Law Firm LLC)	https://blog.oppedahl.com/?page_id=7106
24 November 2021 14:30 – 15:30 (CET)	German	Exploring the PCT webinar series: Mastering priority claims in PCT applications WIPO speakers: Mr. Henninger and Ms. Schumm	Further information: https://register.gotowebinar.com/register/3382579771973631503 Registration: https://register.gotowebinar.com/register/3382579771973631503
8 December 2021 12:00 – 13:40 (US Mountain Time)	English	“Picking a PCT International Searching Authority” Speaker on behalf of WIPO: Mr. Oppedahl (Oppedahl Patent Law Firm LLC)	https://blog.oppedahl.com/?page_id=7150

PATENTSCOPE Webinars (www.wipo.int/patentscope/en/webinar/)			
Date and time	Language of webinar	Nature of webinar; WIPO speakers	Registration
16 November 2021 17:30 - 18:30 (CET)	English	Building complex queries in PATENTSCOPE WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_wsquvLbFTEONGERXFUv7Pg
18 November 2021 08:30 - 09:30 (CET)	English	Building complex queries in PATENTSCOPE WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_SQ0IAcomTgCjwV2z2n_FQ
14 December 2021 17:30 - 18:30 (CET)	English	PATENTSCOPE: retrospective of 2021 and plans for 2022 WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_UXelZHK7SLmcxBscGtHejw
16 December 2021 08:30 - 09:30 (CET)	English	PATENTSCOPE: retrospective of 2021 and plans for 2022 WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_1IDQAFuoRVGH1OxJHh4YTw



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National phase or bypass continuation?

Click Here to
Register

(<https://attendee.gotowebinar.com/register/8178473570439354125>) There are two ways to pursue US patent coverage from a PCT patent application. One way is entry into the US national phase. The other way is the filing of a so-called “bypass continuation” patent application.

What are the advantages and disadvantages of these two filing paths? Are there traps for the unwary lurking in one path or the other? (The answer of course is “yes” and we will discuss some of these traps for the unwary.) Are there particular fact patterns which, if present in a particular case, make one path or the other a particularly advantageous path to follow? (The answer of course is “yes” and we will discuss some of these fact patterns.)

When and where?

Friday, November 19, 2021. Noon to 1:40 PM Mountain Time

Format: Live webinar

Cost? \$59. This registration fee covers one login link. The link is usable on one computer or one projection screen or one tablet or one smart phone. If two or three or more people watch the webinar on that computer or screen or tablet or smart phone, and if each of them learns the material, and if each of them fills in whatever forms they need to fill in to get CLE credit in their state, then each of them has the prospect of earning CLE credit in their state.

The faculty. Your professor is Carl Oppedahl, the author of the *Ant-Like Persistence* blog. Carl is a partner in Oppedahl Patent Law Firm LLC. He has served as an adjunct professor at University of Denver law school, teaching Patent Prosecution. Carl has been a Fellow of the American Intellectual Property Law Association. He has spent more than twenty-five years serving intellectual property clients.

Here's what some attendees had to say about a recent webinar taught by Professor Oppedahl:

"Great. Concise, to the point and practical." — M.Z., Suffern, NY

"Attorney Oppedahl does an excellent job of explaining procedures before various patent authorities and does so in an effective webinar format." — R.K., Manchester, NH

"This webinar was extremely helpful, very current, and professionally presented. Carl is an excellent presenter, answers as many questions as possible, and speaks with perfect pacing."
— S.B., Boston, MA

"Oppedahl Webinars are the best for patent practitioners!" — P.M., Portland, ME

"Very interesting, well presented and topical." — S.M., Ottawa, Canada

In our evaluation questionnaires we usually ask "is there any topic that you would like to see Carl Oppedahl to cover in some future webinar?" Almost always at least one attendee will respond with something along the lines of "any topic that Mr. Oppedahl feels like talking about."

CLE accreditation? CLE accreditation is being requested in Colorado for two CLE units.

What about CLE credit in states other than Colorado? In some states the paperwork for CLE accreditation is extremely burdensome. In some states the required fees are unreasonably high. Many states nowadays try to shift the burden of recordkeeping regarding attendance away from the CLE agency and onto the CLE provider, and require that the CLE provider forward attendance information electronically and in bulk to the CLE agency. For such a state, it is pointless to even think about trying to be a CLE provider unless there is some reason to think that one will regularly get dozens or hundreds of registrations from attendees in that state. We have an impression that in some states, the CLE paperwork and recordkeeping and reporting requirements are set up to favor one or two in-state CLE providers and to tolerate half a dozen big nationwide CLE providers, and to exclude everyone else including small local independent CLE providers such as our firm.

If we were to set a goal of doing the paperwork and recordkeeping and reporting for all of the states that have CLE accreditation procedures, we would have to charge registration fees of hundreds of dollars per program and even then I suspect we would lose money on some programs. Instead, by leaving it to you to try to navigate the paperwork burden in your state, we are able to keep our registration fees much lower.

What we have heard is that some attendees from some states other than Colorado have successfully gotten credit in their own state by handing in the Uniform Certificate of Attendance that we provide. Some attendees have kindly reported back to us about their successes as you can see here (https://blog.oppedahl.com/?page_id=7135).

CLE assistance? Please note that to keep our prices as low as possible, the registration fee *does not include* assistance from our office in attempting to obtain CLE credit from your state CLE agency. We will provide a Uniform Certificate of Attendance and related material, and it is up to you to attempt to obtain the CLE credit from your state CLE agency. If you wish assistance from our office in attempting to obtain CLE credit from your state CLE agency, please understand that (a) there will be an extra charge for such assistance; (b) our assistance will be limited to answering questions and filling out forms for you, but it will be up to you to communicate with your state CLE agency directly, and (c) we cannot make any assurances of successful CLE credit in any state in which we have not promised to provide CLE accreditation.

More than one location? This registration is *per login computer or smart phone or tablet location*. If your firm or corporation wishes to make it possible for people to attend at two or more locations or at two or more computers or smart phones or tablets, you should make a registration for each location or computer or smart phone or tablet so that each location or computer or smart phone or tablet can have its own login credentials to the webinar system.

In the past, we have heard of some attendees attempting unsuccessfully to use Citrix or other desktop sharing applications to share the audio and video from one location to a second location. We have heard that this does not work well. We urge you to avoid problems by registering individually for each intended login computer location.

In case we did not make this clear, you need to understand that the login link that you will receive is good for only one login. If you try to use it for logging in at two or more locations, it is extremely likely that at least one of the login attempts will fail and it would not be surprising if the second login attempt would make some sort of problem for the first login attempt.

Will the webinar be recorded? Many people ask this question. The answer is that maybe we will successfully record the webinar, and maybe we will fail to successfully record it. Either way, the money that you pay to attend the live webinar will not entitle you to view the recording, if we do successfully record the webinar. If you want to get the benefit of paying your registration fee, you need to attend the live webinar. If you miss the live webinar, your consolation is that you will have received the presentation materials and you might get some benefit from reading and studying the presentation materials. If you have paid the registration fee and if you realize you are not going to be able to log in to attend the live webinar, then probably the most productive thing you could do so that your money does not go to waste is to find some deserving colleague and give them the login link as a gift so that they can attend the live webinar.

Keep in mind that even if there were an opportunity to view a recording at a later time, this would not include the ability to ask questions. A live webinar offers the opportunity to ask questions through a chat function.

How to sign up? To register for this program, click on the big button above. After you have paid, you should receive a confirming email message. *If you do not receive the confirming email message, consider the possibility that you might have mistyped your own email address when paying the money.* Another possibility is that you may have asked the GotoWebinar company (also

known as LogMeIn) not to send you any emails at all, by clicking “unsubscribe” links in the past when receiving past emails from the GotoWebinar company. If you did that, then you have no one but yourself to blame if the GotoWebinar company is not sending you any emails at all.

How may I receive the webinar materials? On the day of the webinar, you will receive at least two email messages with a link for downloading the materials for the webinar. One such email message should arrive about an hour before the starting time of the webinar, and another such email message should arrive about three hours before the starting time of the webinar. If you do not see such email messages, ask yourself whether you received a confirming email message back when you registered for the program. If you did not, then maybe you mistyped your own email address when you paid the money to register. If so, then this would explain why you are not receiving the expected email messages on the day of the webinar.

The webinar materials will include a set of the presentation slides as well as a copy of the program brochure and a Uniform Certificate of Attendance for use in seeking CLE credit.

Keep in mind too that if you register for the webinar with less than an hour to go before the starting time of the webinar, then you will not receive the email message about downloading the materials that is supposed to reach you an hour before the starting time.

Format. This program is a webinar, meaning a seminar offered over the Web. It is anticipated that at some law firm and corporate locations, the presentation-slide content of the webinar will be projected upon a screen in a conference room. The projection-screen approach can provide a nice way for several people to attend.

Other attendees will view the presentation by themselves, on their own computers or smart phones or tablets.

Participants will be able to submit typed questions through the webinar system.

After the webinar has finished, participants will be requested to complete an online evaluation form.

For users who attend by means of a computer, audio will be provided through the attendee’s choice of either computer speakers or a dial-in telephone number. A user with a computer headset can use the headset to listen to the audio. Many attendees will find it convenient to receive the audio through their computer speakers, which is free of any per-minute charge. It will also be possible to dial in to a telephone conference bridge to receive the audio; this will be a toll call with regular per-minute long-distance telephone charges.

You may find it convenient to use a USB speakerphone to broadcast the audio in your conference room.

Are you a smart phone or tablet user? If so, you may wish to try attending using a Gotowebinar app. Before the date of the webinar, please do at least one test webinar as mentioned on the technical support page (https://shop.oppedahl.com/?page_id=392). On the date of the webinar, please log in at least ten minutes early so that you will have time to try to solve any problems. Plan ahead so that if you cannot get the app to work, you will be able to switch to an ordinary computer connection to attend the webinar.

Group viewing. We hear from our attendees that one of the most pleasant and productive ways to attend one of our webinars is by means of group viewing. Pick a conference room or some other comfortable setting. *Make sure, of course, to have a writing surface available for each attendee, since this is required by most state CLE accreditation rules.* Set up a large-screen monitor with an HDMI cable to display the program, or use a computer data projector to show the program on a big screen. Use a USB speakerphone to broadcast the audio. Keep a keyboard handy so that when attendees have questions, somebody can type in the questions in the “ask questions” box in the webinar system.

Beverages during the group viewing? The plain fact is that most of the topics upon which we provide presentations have the potential to be very dry. You do not know the full meaning of “very dry” until you have suffered through the first thirty minutes or so of a discussion of some of the finer points of the Patent Cooperation Treaty or the Paris Convention for the Protection of Industrial Property, and then you glance at a clock and you realize that there are another seventy minutes to go before we are done. You may thus find it helpful to plan ahead and to arrange to be well rested for the webinar. One approach for a beverage is to consume some caffeinated beverages ahead of time and to have refills available during the program. Another approach for a beverage during the group viewing would be to provide half a glass of wine to all attendees at about the half-way point. This is very much a matter of personal choice.

Technical support on the day of the program. Sometimes when we host a webinar, we receive frantic telephone calls on the day of the webinar from people who have problems. Usually the cause of the problem is something that we cannot help with in any way. Please see our technical support page (https://shop.oppedahl.com/?page_id=392) for technical support.

Cutoff time for registrations. Please plan ahead and register with at least one hour to spare before the webinar. We can offer no assurances that an attempted webinar registration will succeed if you try to do it with less than one one hour remaining before the starting time of the webinar.

Other educational programs? You can see other upcoming educational programs (https://blog.oppedahl.com/?page_id=7066) from Oppedahl Patent Law Firm LLC.

Edit (<https://blog.oppedahl.com/wp-admin/post.php?post=7106&action=edit>)

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CATEGORIES

National phase or bypass continuation?

Webinar
November 19, 2021
Noon to 1:40 PM, Mountain Time
Carl Oppedahl
Oppedahl Patent Law Firm LLC
blog.oppedahl.com

Presented with generous support of
the World Intellectual Property Organization

Disclaimer

This is not legal advice. Reading these slides or attending this webinar or viewing a recording does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.

How we will proceed

Feel free to ask questions in the questions box in the webinar system. No need to save up questions until the end.

Please please please complete the evaluation questionnaire.

Please note that if you have not already downloaded your presentation materials, you can download them now from a link in the webinar system.

A word about your presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner

Polling question

Helpful PCT resources

WIPO's PCT Distance Learning Course

The Schwegman lectures (Youtube, yours truly speaking)

WIPO video series (Matthias Reischle)

WIPO's PCT Applicant's Guide

The PCT listserv (email discussion group)

PCT section of the *Ant-Like Persistence* blog

Polling question

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Helpful PCT resources

WIPO's PCT Help Desk

+41 22 338 83 38

USPTO's PCT Help Desk

+1 571 272 4300

Make sure you are subscribed to WIPO's *PCT Newsletter*

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Helpful PCT resources

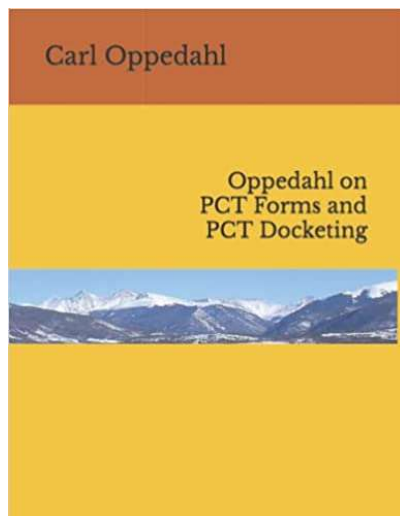
Upcoming webinars:

- Picking a PCT International Searching Authority (Wednesday, December 8, 2021)
- Docketing of PCT
- Making use of PCT Declarations

To hear about such webinars, subscribe to the *Ant-Like Persistence* blog

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Helpful PCT resources



Published November 14, 2021!

The fifty PCT forms that you are most likely to encounter

Which dockets to set or clear when these forms arrive

What dates and check boxes to check on the forms

Warning signs that you can detect from the forms

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General goals

Making best possible use of the Patent Cooperation Treaty from tactical and strategic points of view

Learning and following Best Practices to minimize embarrassment and malpractice

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Specific goals

Review some background that will help us to keep in mind the various advantages and disadvantages of the two approaches:

- National phase entry and
- Bypass continuation

Discuss in detail the advantages and disadvantages of the two approaches

Identify Best Practices and traps for the unwary for each of the two approaches

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Pursuing US patent protection from a PCT application

- There are two ways to pursue US patent protection from a PCT application:
 - US national phase
 - Bypass continuation
- Be alert to the possibility of making use of the Patent Prosecution Highway

US legal basis for the two approaches

National phase gets its legal basis from 35 USC § 371

Bypass continuation gets its legal basis from 35 USC § 111a and
35 USC § 120

What is the PCT?

The PCT is two treaties – Chapter I and Chapter II

Now in 2021 every State that belongs to Chapter I also belongs to Chapter II

When you file a Demand, you make use of Chapter II

Not just anybody can make use of the PCT (as an Applicant) – the would-be applicant may only do so if the applicant is a citizen or domiciliary of a member State of the PCT

In 2021, the PCT has 154 contracting States

There are States that belong to the Paris Convention but that have not (yet) joined the Patent Cooperation Treaty

The example that I think of often is Argentina

Afghanistan	Iraq
Andorra	Jamaica
Argentina	Lebanon
Bahamas	Mauritius
Bangladesh	Nepal
Bhutan	Pakistan
Bolivia	Paraguay
Burundi	Suriname
Congo	Tonga
Guyana	Uruguay
Haiti	Venezuela
Holy See	Yemen

(States that belong to the Paris Convention but do not (yet) belong to the PCT)

One way to think of a PCT application is that it is a bundle of 126 patent applications

When you file a single PCT application, you are actually simultaneously filing 126 patent applications, one for each of the Designated/Elected Offices where you might later enter the national/regional phase

Each designation is legally a patent application in that patent office, with a filing date that is the PCT filing date

Each such patent application is pending for some period of time (maybe 20 months, maybe 30 months, maybe 31 months, longer if the applicant enters the national/regional phase)

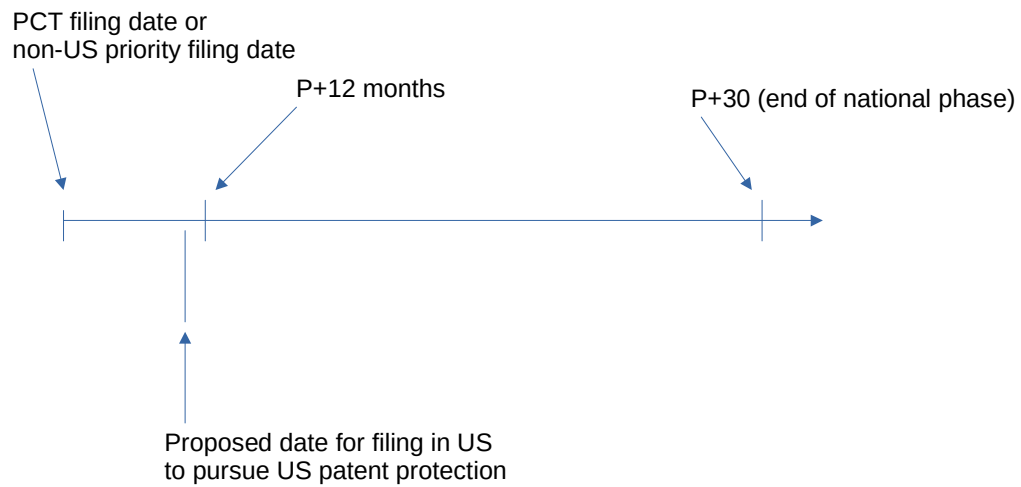
126 is smaller than 154!

Subtract 126 from 165 and you get 28

What is going on here?

There are twenty-eight States where you cannot enter the national phase directly, but instead can only obtain patent protection by means of regional protection

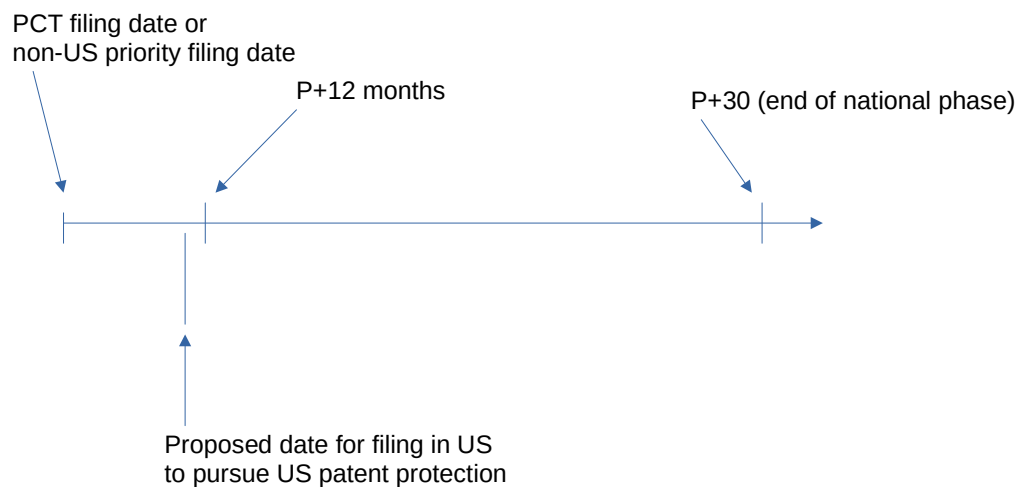
First trap for the unwary: US patent term



From point of view of US patent term, does it matter whether the US applicant selects national phase or bypass continuation?

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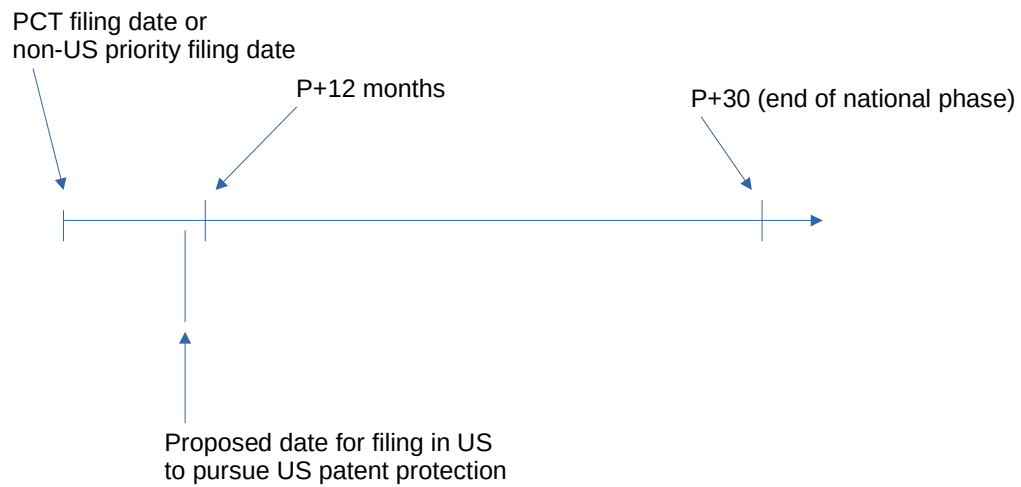
First trap for the unwary: US patent term



If the US applicant selects national phase, when will the US patent term end? Answer: 20 years from the PCT filing date

20

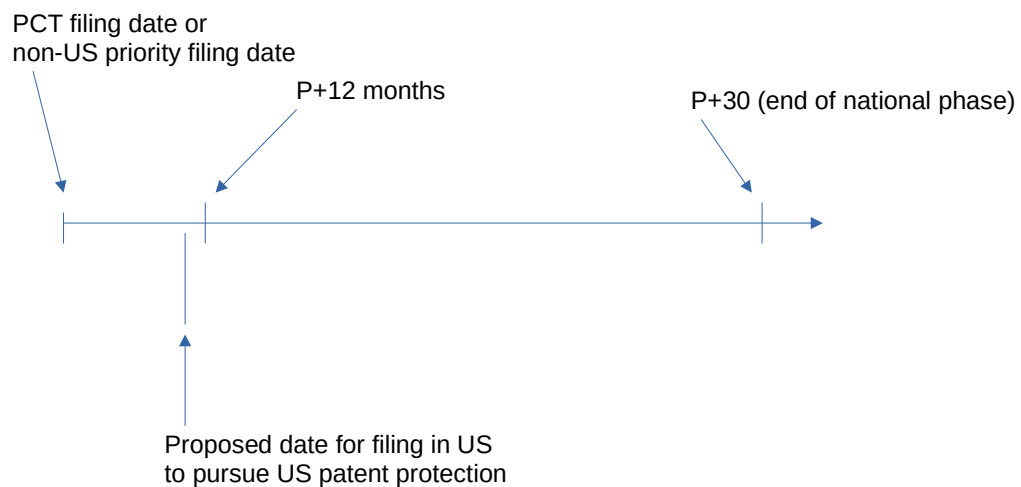
First trap for the unwary: US patent term



If the US applicant selects bypass continuation, when will the US patent term end? Answer: 20 years from the PCT filing date

21

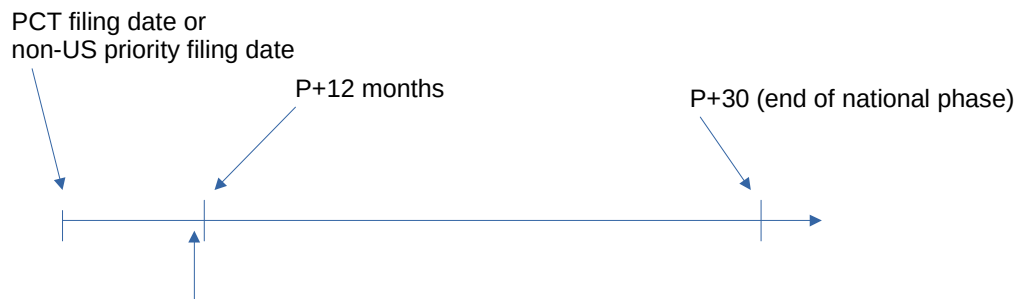
First trap for the unwary: US patent term



If the US applicant selects bypass and **does not call it a continuation**,
When will the US patent term end?
Answer: 20 years from the **bypass filing date**

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First trap for the unwary: US patent term



Three possible filing paths:

- 1) Enter national phase from PCT – US patent gets a term that ends 20 years after the PCT application was filed
- 2) File a bypass continuation – US patent gets a term that ends 20 years after the PCT application was filed
- 3) File a bypass that claims foreign priority from the PCT application and from the non-US priority application (if any) – US patent gets a term that ends 20 years after the bypass application was filed

If you select path 1 or 2, you are flushing as much as a year of US patent term down the drain!

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First trap for the unwary: US patent term

Three possible filing paths:

- 1) Enter **national phase** from PCT – US patent gets a term that ends 20 years after the PCT application was filed – this means you are using 35 US Code § 371
- 2) File a **bypass continuation** – US patent gets a term that ends 20 years after the PCT application was filed – this means you are using 35 US Code § 111a and 35 US Code § 120
- 3) File a **bypass** that claims foreign priority from the PCT application and from the non-US priority application (if any) – US patent gets a term that ends 20 years after the bypass application was filed – this means you are using 35 US Code § 111a and 35 US Code § 119a-d

If you select path 1 or 2, you are flushing as much as a year of US patent term down the drain!

Path 3 is a bypass that is not a “bypass continuation”

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Mechanical steps of path 3 (the bypass that is not a continuation)

The ADS lists *no domestic benefit*

The ADS lists *no continuity data*

The ADS lists **a foreign-priority claim to the PCT application**

(If there is a foreign priority claim in the PCT application, then the ADS lists a foreign-priority claim to that foreign application)

When we say “a foreign-priority claim to the PCT application” we mean **a claim to one of the 125 designations that is not the US designation**

It is fascinating that the USPTO does not actually require you to stick your neck out and say **which** of the 125 non-US designations you are actually claiming priority from

The result is avoidance of flushing up to 12 months of US patent term down the drain, simply by filling out a form correctly instead of filling it out wrong!

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How many US patent owners actually pay their 11½-year maintenance fee?

Yes, I thought so

Very few US patent owners actually pay their 11½-year maintenance fee

The only US patent owners that will ever care about the previous six slides are the ones that pay their 11½-year maintenance fee

But then again what about some pharma and biotech patents?

The last day of the term of the Tagamet patent was worth about one million dollars!

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Comparing national phase with bypass continuation

Examiner's ability to impose restriction requirement

- With national phase, the restriction standard is “unity of invention”
- With bypass, the restriction standard is the regular domestic “distinct invention” standard
- Many applicants prefer the “unity of invention” standard

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National phase and unity of invention

Is the USPTO as a designated office bound by the unity of invention determination made by the International Searching Authority?

Sorry, no

The US Examiner might restrict more ways than the ISA did
You will get nowhere saying “the ISA only said there were this many inventions!”

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National phase and unity of invention

The US Examiner in a national-phase case might get it wrong

In such a case, the US Examiner might mail out a Restriction Requirement that uses ordinary domestic “distinct invention” language instead of the correct and applicable “unity of invention” language

If this happens you can ask that it be withdrawn and you will absolutely win

What will the Examiner do then?

Maybe the Examiner will give up and actually examine both of the independent claims rather than going to the trouble of digging through old Patent Academy notes to see how to do the restriction correctly

Note that in such a case what you do not want to do is “traverse” – no no no no no no no

You are asking that the RR be withdrawn

National phase and unity of invention

The US Examiner in a national-phase case might get it right

In such a case, the US Examiner might mail out a Restriction Requirement that uses the correct and applicable “unity of invention” language

Many practitioners feel that under this “unity of invention” restriction standard, an Examiner cannot get away with restricting as narrowly as Examiners often seem to do when they use the ordinary domestic “distinct invention” standard

The practitioners who feel this way will often tell you that this is their chief reason for avoiding use of bypass continuations and instead making almost exclusive use of national-phase entry

National phase and unity of invention

When the US Examiner mails out a Restriction Requirement that uses the correct and applicable “unity of invention” language ...

is the Examiner also permitted to layer a “species-type” restriction requirement on top of the “unity of invention” restriction?

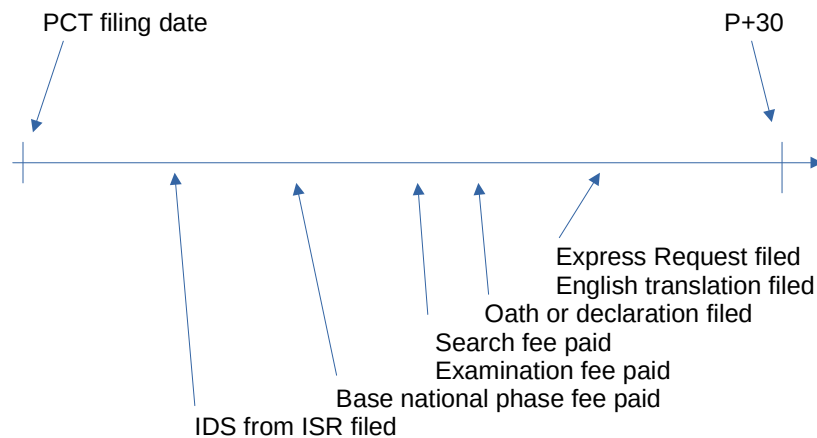
Sorry, yes.

We had one case in our office where the number of divisional applications that would have been required, to get every species examined, would have been in excess of two thousand

The client did not have enough money to pay for all of the divisional applications

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Dribs and drabs



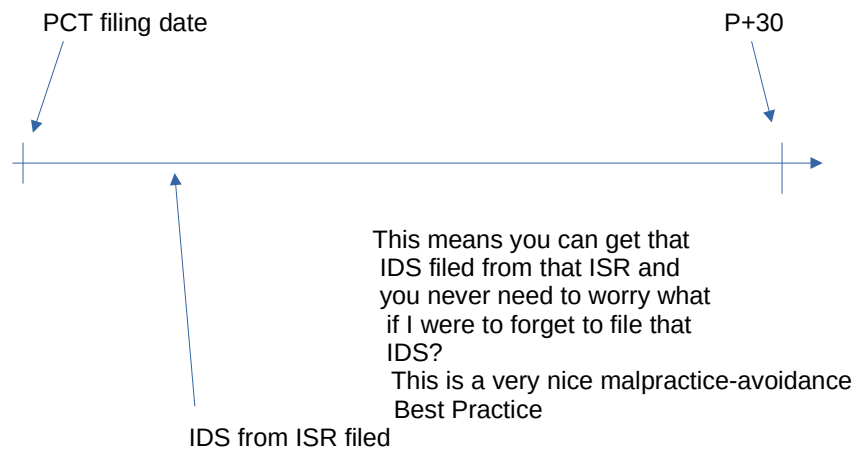
The important thing here is that there is absolutely no penalty for failing to file these things on different days

If the path you pick is US national phase!

I greatly prefer US national phase for this reason

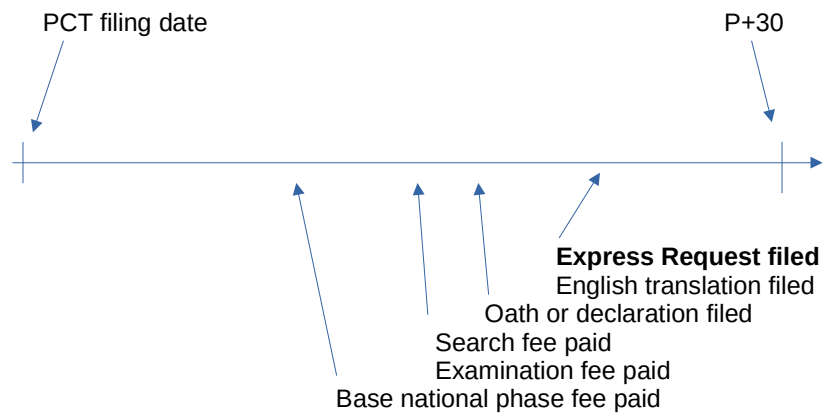
32

Avoiding malpractice – guaranteeing that you will never forget to file that IDS from the ISR



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Malpractice avoidance – filing that Express Request



When you are using US national phase, and the 30 months has not yet passed, and you have indeed handed in everything that you need to hand in, it is malpractice not to hand in your Express Request. Failing to hand it in can lose PTA. Failing to hand it in can lose your place in the queue for examination.

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National phase? National stage?

There is no such thing as “national stage”.

- Nowhere in the Patent Cooperation Treaty
- Nowhere in the PCT Rules
- Nowhere in the PCT Administrative Instructions
- Nowhere in the PCT Applicant's Guide

The correct terminology is “national phase”.

The US joined the PCT in 1978.

Somebody at the USPTO made a mistake and referred to it in the earliest USPTO documents as “national stage”.

It stuck and has propagated throughout the USPTO's rules and the MPEP.

Decades have passed and by now the mistake will never get fixed.
The correct terminology is “national phase”.

Comparing national phase with bypass continuation

Certified copies of priority applications

- With national phase, nearly always the certified copies are taken care of automatically as part of the PCT process
- With bypass, it is the applicant's responsibility to attend to the certified copies
 - The priority Office may belong to PDX
 - The priority Office may be a Depositing Office to DAS

Certified copies

The main point here is that if you for some reason are sitting on a particular PCT application for which it would be supremely difficult to obtain certified copies in any ordinary way (paper copies, PDX, DAS) ...

But if the certified copies are all right there in Patentscope already ...

Then this is a factor that strongly favors using US national phase rather than a bypass continuation

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Comparing national phase with bypass continuation

Getting help from the USPTO

- With national phase, you get to use the PCT Help Desk (+1 571 272 4300)
- With bypass, your source of help is the Application Assistance Unit (+1 571 272 4000)

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Polling question

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Comparing national phase with bypass continuation

Occasionally an applicant will have a PCT application in which a would-be priority claim was not timely presented

- In a US national phase case from the PCT, the priority claim problem can be corrected only by filing an expensive petition
- In a bypass continuation from the PCT, the priority claim problem can be corrected at no charge

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Comparing national phase with bypass continuation

Suppose the 30-month date has arrived and client has not given clear instructions whether to proceed

- ❑ With a bypass continuation, the filing fee could be handed in late so long as you do not mind paying a late fee
- ❑ With a US national phase entry, you must pay the base national phase filing fee within the 30 months

This permits you to avoid getting stiffed on the bill for the government fee if the client later says they never actually wanted to spend any money

If you pick the bypass continuation path and have the self-control to hold back from paying any government fees

Keep in mind that you could use the “file by reference” check box in an ADS and the whole filing could be just one or two mouse clicks

What if you missed the 30 months?

Yes what if you missed the 30 months?

Recall that when the PCT application got filed, it was a bundle of 126 patent applications

One of them was a US patent application.

See 35 USC § 363 – “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).”

So when you missed the 30 months, that US patent application went abandoned.

You can revive it!

Well, so long as the abandonment was unintentional, you can revive it.

You pay a fee, you file a petition, you say the entire period of delay was unintentional (of course this needs to be true), and next thing you know, the USPTO will grant the petition.

Any time you petition to revive ...

Any time that you petition to revive, you must include with the petition whatever it is that you wish you had done back when you needed to do it. In this case, the payment of the base national phase fee and the identification of the PCT application.

There is a dedicated USPTO form for this purpose.

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The dedicated USPTO form is extremely poorly designed

The dedicated USPTO form jams together two bundles of words:

- A first word bundle in the dedicated USPTO form is the petition to revive.
- A second word bundle in the dedicated USPTO form is the statement under penalty of perjury that the entire period of delay was unintentional.

Of course under USPTO rules, where the applicant is anyone other than a natural person, we understand that the first word bundle (the petition) is required to be signed by a registered practitioner.

So you or I will have to sign that word bundle.

Then we get to the second word bundle, the part where somebody is going to have to stick their neck out and state under penalty of perjury that they know exactly how and why the 30-month date got missed.

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The dedicated USPTO form is extremely poorly designed

The dedicated USPTO form tries to force it that a single signer will serve two roles:

- the signer will be the registered practitioner who is representing the (legal entity) applicant, and
- the signer will be the person who is personally stating that he or she is the person who has personal knowledge that the entire period of delay was unintentional

Of course in many real-life situations, the person with personal knowledge as to the circumstances of the delay is someone other than the practitioner

You will probably have to push and push to get the USPTO petitions person to understand this.

If I am not the one who is responsible for having missed the 30-month date, there ain't no way I am signing the part that says I have personal knowledge about how and why the 30-month date got missed, when that's not true. Just sayin'.

Still other factors that might influence the choice of national phase versus bypass continuation

Suppose the PCT application itself is a mess?

Suppose lots of inventing has happened since the PCT application got filed?

Suppose the client sort of does not want to draw attention to the fact that what we are filing now has lots of stuff in it that is not exactly the same as what was in the PCT application when it got filed?

Suppose the PCT application itself is a mess?

Suppose it is a very poor quality translation into English from some other language?

If you use national phase, and then try to clean it up, you will have to use strikethroughs and underscores.

Probably also a substitute spec.

Probably you will have to make a representation that no new matter has been added.

TYFNIL this representation will guarantee you seven hours of a hot seat in a deposition.

Maybe a bypass continuation is the better path.

Suppose lots of inventing has happened since the PCT application got filed?

Yeah, if so, then maybe you don't just want to enter the US national phase.

Maybe enter the US national phase and also, on the side, file a CIP.

Or maybe just file a CIP.

In that CIP, some claims might be entitled to different effective filing dates than other claims.

It could be a mess.

Suppose the client sort of does not want to draw attention to the fact that what we are filing now has lots of stuff in it that is not exactly the same as what was in the PCT application when it got filed?

Surely we all realize that if there really is new matter, then TYFNIL the adversary is not going to get fooled by filing a continuation and holding back from calling it a CIP. If it really was a CIP all along, the adversary will be all over this.

Still, there are many practitioners who will file a bypass continuation specifically because the client has a goal of not drawing unnecessary attention to the things that are non-identical to what was in the PCT application as filed. Much of this is in the nature of a business decision.

Patent Prosecution Highway

A favorable ISR/WO can be used to get a US national phase case put onto the Highway

But it can just as well be used to get a bypass continuation case put onto the Highway

This is not a factor that should prompt picking one path or the other

37 CFR § 1.496

Most US practitioners know nothing of this rule

Most US Examiners know nothing of this rule

This rule entitles you to have your US national-phase application “advanced out of turn for examination” if your claims (as presented in the US case) are claims that were found patentable by the ISA/US

For this to work, of course you had to have selected ISA/US

I never pick ISA/US

But some applicants often pick ISA/US

(ISA/US can be really inexpensive if you are a micro filer.)

37 CFR § 1.496

If your claims (as presented in the US case) are claims that were found patentable by the ISA/US

Then your US national phase search fee drops to zero

And your US national phase examination fee drops to zero

But this Rule 496 is only available for US national phase. It is not available for bypass continuations.

37 CFR § 1.496

If you do choose to make use of Rule 496, then it will be up to you to badger the Examiner to actually give you the “advanced out of turn for examination” service to which you are entitled.

Nothing in the USPTO systems will signal the Examiner in any way about this obligation to take the case “out of turn”.

You will probably have to make multiple phone calls.

Polling question

PCT Declaration Number 4

The foreign patent practitioners who are trendy, modern, and up-to-date will make use of PCT Declaration Number 4.

At 29 months or so you are entrusted to attend to entry into the US national phase.

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes

PCT Declaration Number 4

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes

Suppose you fail to notice that they did this. (For example you don't think to even look in Patentscope to see that they did this.)

And then you prepare Forms AIA/01, asking the foreign patent practitioner to round up the inventor signatures on the declarations of inventorship.

This is going to make you look really stupid in the eyes of the foreign patent practitioner.

I bet they will send their next case to some other smarter US patent practitioner.

Maybe it would be better to go to the trouble to look in Patentscope to see whether they did this.

PCT Declaration Number 4

Maybe two years ago, the foreign patent practitioner already obtained the signature of each of the inventors on PCT Declaration Number 4, which is the declaration of inventorship for US purposes

If so, then surely you realize this means the foreign patent practitioner is probably trendy, modern and up-to-date.

Probably in the future you should send your outbound work to this foreign patent practitioner!

The Notice of Acceptance into the US national stage

This is a form prepared by a USPTO person

The person lists the various “dribs and drabs” documents that you filed

The person lists the dates upon which you supposedly filed the “dribs and drabs” things

It is routine for the person to get dates wrong

It is routine for the person to miss that you filed an Express Request

This can harm your PTA

You may need to ask that the Notice of Acceptance be corrected

How long it takes to get a Filing Receipt

Over the years there have been widely varying differences in the delays in receiving Filing Receipts depending on whether you pick “national phase” or “bypass continuation”

Usually “bypass continuation” is much faster

These days “national phase” sometimes takes half a year

Sometimes “bypass continuation” takes only a few days

The main situations where this could be really vexing is if you were counting on prompt examination because of PPH

Recording assignments

If you record an assignment in EPAS against the PCT, will this “count” against the US application number when later you enter the US national phase?

Yes.

Yes in terms of the legal conclusion (35 USC § 363)

But yes also in the practical sense that later it will actually turn up in all of the databases when people look it up using the US application number.

Same thing if you go in the other sequence, recording against the US application number first.

Getting assignments signed and recorded

By the way if you get a PCT application filed, what you do not want to do is wait until US national phase time to get signatures on assignments.

Do it as soon as you learn your PCT application number.

Get the assignments signed.

Get them recorded within 3 months of signing day. See 35 USC § 261. It is a professional liability risk to allow more than three months to pass.

Getting assignments signed and recorded

So you decided to file a bypass continuation that is not text-identical to the PCT? And you cannot rule out the possibility that there is conceivably some new matter somewhere lurking in the new application?

Then of course you are going to need to round up signatures on fresh assignments, and get them recorded within three months. 35 USC § 261.

Should you put the ISR itself into the IDS?
Should you put the WO itself into the IDS?

Is it a gold case? If it is, then of course you should put everything into the IDS. No judgment call should be made in the direction of “oh I guess this does not need to go into the IDS.”

If the ISR/WO is favorable, why would you ever pass up a chance to rub the Examiner’s nose in it?

Of course if you are using the ISR/WO as your reason why you deserve to be on the Highway, then you are *required* to put the ISR/WO into the IDS.

Note that WIPO translates the ISR and the WO into English (if they are not already in English) at no charge.

Using ePCT

When foreign instructing counsel entrust to you the entry into the US national phase from a PCT, they may communicate this to you by giving you access to the PCT application in ePCT.

If so, this tells you that they are trendy, modern and up-to-date.

Helpful PCT resources

WIPO's PCT Distance Learning Course

The Schwegman lectures (Youtube, yours truly speaking)

WIPO video series (Matthias Reischle)

WIPO's PCT Applicant's Guide

The PCT listserv (email discussion group)

PCT section of the *Ant-Like Persistence* blog

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Helpful PCT resources

WIPO's PCT Help Desk

+41 22 338 83 38

USPTO's PCT Help Desk

+1 571 272 4300

Make sure you are subscribed to WIPO's *PCT Newsletter*

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Helpful PCT resources

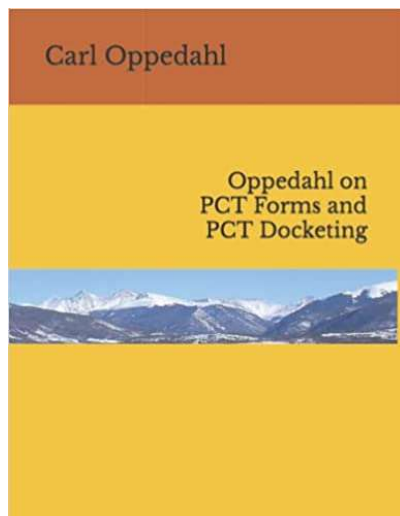
Upcoming webinars:

- Picking a PCT International Searching Authority (Wednesday, December 8, 2021)
- Docketing of PCT
- Making use of PCT Declarations

To hear about such webinars, subscribe to the *Ant-Like Persistence* blog

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Helpful PCT resources



Published November 14, 2021!

The fifty PCT forms that you are most likely to encounter

Which dockets to set or clear when these forms arrive

What dates and check boxes to check on the forms

Warning signs that you can detect from the forms

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Again a reminder ...

Be sure to fill out the evaluation
questionnaire.

Thank you!