

The Limited Monopoly™

Obtaining a United States Patent via the Patent Cooperation Treaty

by Luis Ormaechea, Esq., Robert Gunderman PE and John Hammond PE

This article discusses entry into the “national phase” in the United States for Patent Cooperation Treaty (PCT) international patent applications.

The Patent Cooperation Treaty as a Portal for Pursuing Patent Protection in Multiple Countries

The PCT is a very useful way to file international patent applications.¹ This is because the PCT makes it possible to seek patent protection for an invention simultaneously in many countries² by filing a single application instead of several separate national or regional patent applications. In essence, the PCT application extends the time an applicant has to file for patent protection in countries that are members of the PCT. After the PCT application is filed, an applicant will still need to apply for patents in the individual countries in which patent protection is desired, but prosecution of the application is greatly simplified by using the PCT process.³

A PCT application may claim priority to an earlier-filed provisional, utility or foreign patent application, provided that it is filed within 12 months from the filing date of that application (the “priority date”).⁴ A PCT application can also be the first-filed application, in which case the priority date will be the filing date of the PCT application itself. In most cases, an applicant has 30 months from the filing date of the initial patent application to which priority is claimed before the applicant must file with individual national patent offices, in a process known as the “national phase.” Generally, an applicant using the PCT normally has at least 18 additional months before it is necessary to fulfill national requirements, compared to an applicant who does not use the PCT.⁵

A PCT filing fee must be paid with a PCT filing, but other expenses, such as translation and foreign associate handling fees will not be due until after the initial period of processing under the PCT (known as the “international phase”) is completed. During the international

The Patent Cooperation Treaty makes it possible to seek patent protection for an invention simultaneously in many countries by initially filing a single application internationally.

phase, a patentability search is performed and a patentability report (known as a Written Opinion) is issued. The search and Written Opinion should be considered by the applicant in deciding whether to proceed with filing in individual countries. Thus, applicants can avoid the cost of filing and translation fees for those countries in which patent protection will ultimately not be pursued. At the end of the international phase, the applicant can choose to proceed with the application in the U.S. and other PCT member countries by entering the national phase.⁶

of claims of the international application, and an English translation of any annexes to the international preliminary examination report.⁷

The U.S. national phase of an international application will commence once the 30 month period has elapsed and all of the required items have been deposited with the USPTO.⁸ In addition, once the applicant has met all of the requirements, the U.S. national phase application will receive the benefit of the filing date of the international application and

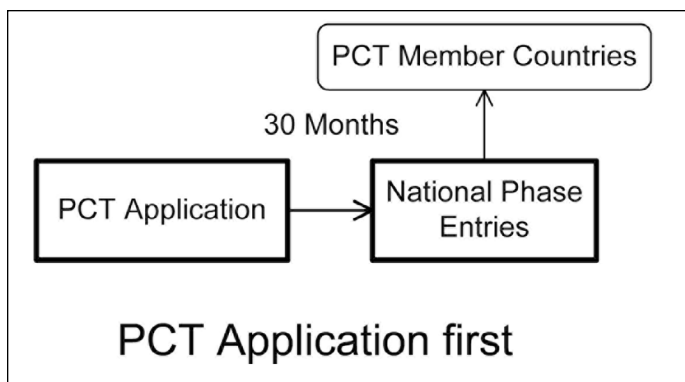
may constitute a prior art reference in the U.S. against another patent application.⁹

It is important to note that the applicant must clearly identify the application to the USPTO as a submission to enter the U.S. national phase under 35 U.S.C. §371. Applicants seeking to enter the national phase are urged to use transmittal Form PTO-1390 in order to meet this requirement.¹⁰

Once an international application enters the U.S. national phase, the USPTO will assign the submission a U.S. application number, consisting of a two-digit series code followed by a six-digit serial number. That number should then be used whenever papers or other communications are directed to the USPTO regarding the national phase application.¹¹

The PCT Application as the First-Filed Application

As mentioned above, a PCT international application may be filed after an applicant has filed a national or regional application. Alternatively, a PCT international application may be filed before any regional or national patent application has been submitted. If an applicant does not claim priority to an earlier



application, the priority date for the purposes of the PCT procedure will be the filing date of the international application.¹²

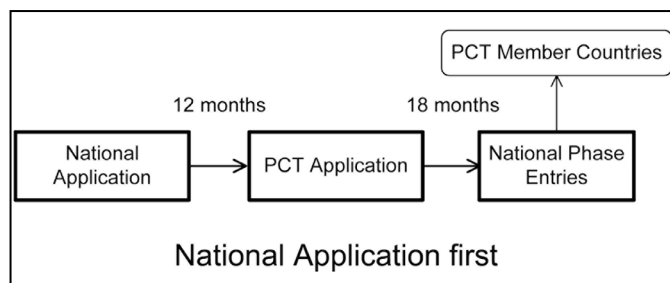
One reason for filing a PCT application before filing a regional or national application is to take advantage of the time that will elapse before the applicant is required to fulfill national application requirements. The applicant can use this time to evaluate the chances of obtaining patents and the possibility of exploiting the invention commercially in the countries in which patent protection is desired. For example, an applicant may file a PCT application designating the United States and several other countries, and wait up to 30 months before deciding whether entry into the national phase in the United States remains a worthwhile option. Market conditions and other factors that may change during the extended time period could be taken into account in making the decision of whether to proceed with the national phase application.

In order to file a PCT application, the applicant (or at least one applicant, if there are multiple applicants) must be a national or resident of one of the PCT contracting states, must pay one set of fees, and must prepare the international patent application in accordance with certain formal requirements set out in the PCT and associated regulations. In addition, an applicant (from the U.S. or other member country) who files a PCT application with the intent of later entering the U.S. national phase should designate the United States in the application. In most cases, the application can be filed with the applicant's national patent office. Alternatively, the application can be filed directly with the World Intellectual Property Organization (WIPO), as long as this is permitted by applicable national security statutes. PCT applications can be filed electronically with receiving offices which accept such filings, such as the PCT receiving office at WIPO and at the USPTO.¹³

As discussed above, when an applicant has filed a PCT application for an invention and does not claim priority to another patent application, the priority date will be the filing date of the PCT international application. An applicant then has 30 months from this priority date before the applicant must commence the national phase with individual national patent offices.

Provisional Applications and National Phase Entries

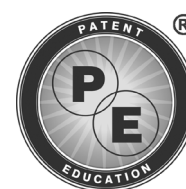
It is important to note that the date of a United States provisional patent application may be used as a priority date for PCT purposes. However, an applicant will not gain an additional year to file a PCT application if a provisional is filed first. In this situation, the priority date for PCT purposes is the filing date of the U.S. provisional, and a PCT application must be filed within a year of the priority date of the first filed application, in this case the U.S. provisional.



Entering the National Phase

In summary, a United States patent application can be a first-filed application, or it can be filed on the basis of a PCT application. Oftentimes in the case of a non-U.S. applicant, a United States patent application is filed on the basis of a PCT application. There are advantages and disadvantages associated with each approach that should be considered in view of one's business objectives.

The Limited Monopoly welcomes Luis Ormaechea, Esq., a registered patent agent and attorney, who contributed to this article. Robert D. Gunderman P.E. (Patent Technologies, LLC www.patenttechnologies.com) and John M. Hammond P.E. (Patent Innovations, LLC www.patent-innovations.com) are both registered patent agents and licensed professional engineers. They offer several courses that qualify for PDH credits. More information can be found at www.patenteducation.com. Copyright 2010 John Hammond and Robert Gunderman, Jr.



Note: This short article is intended only to provide cursory background information, and is not intended to be legal advice. No client relationship with the authors is in any way established by this article.

(Endnotes)

¹ A brief summary of the PCT is available in our Limited Monopoly column of November 2007. Reprints may be obtained at www.patenteducation.com/patentarticles.html under the topic "International Patent Applications."

² There are 142 countries as of January, 2010. WIPO, *PCT Applicant's Guide – International Phase – Annex A*, http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexa/ax_a.pdf.

³ WIPO, *FAQs About the PCT*, http://www.wipo.int/pct/en/basic_facts/faqs_about_the_pct.pdf

⁴ The Limited Monopoly, *International Patent Law: PCT Applications-Amendments and Demands*, September, 2009.

⁵ WIPO, *FAQs About the PCT*, http://www.wipo.int/pct/en/basic_facts/faqs_about_the_pct.pdf

⁶ The Limited Monopoly, *International Patent Law: PCT Applications-Amendments and Demands*, September, 2009.

⁷ 35 U.S.C. § 371. See MPEP 1893.01—1893.01(e) (8th ed. Aug. 2001).

⁸ 35 U.S.C. § 371(c); 37 C.F.R. § 1.495 (2002). Note: earlier entry into the national phase is available upon request.

⁹ See 35 U.S.C. §102(e).

¹⁰ MPEP 1893.03(a) (8th ed. Aug. 2001).

¹¹ MPEP 1893 (8th ed. Aug. 2001).

¹² WIPO, *FAQs About the PCT*, http://www.wipo.int/pct/en/basic_facts/faqs_about_the_pct.pdf

¹³ WIPO, *FAQs About the PCT*, http://www.wipo.int/pct/en/basic_facts/faqs_about_the_pct.pdf