

Track 1: PCT Practice Tips and Update

Carol E. Bidwell
United States Patent and Trademark Office
Alexandria, VA

Exhibit
Exhibit A PowerPoint Presentation 3-3

**Exhibit A
PowerPoint Presentation**



**PCT Practice:
Tips and Update**

**Carol Bidwell
Supervisor, Office of PCT Legal
Administration
USPTO**

March 14, 2005

ICLE is a 501c(3) non-profit organization

Modification of Article 22

- **The time limit for performing the acts necessary for national phase entry under Article 22(1) has been changed from 20 months to 30 months from the priority date**
 - change went into effect on April 1, 2002
 - applicable to international applications where
 - the 20 month time limit expired on or after April 1, 2002 and
 - the acts for national phase entry have not yet been performed
 - changes to US rules concerning national phase entry went into effect on April 1, 2002
 - see 67 Fed. Reg. 520, published January 4, 2002

Transition to new time limit

- **The 30 month time limit under Chapter I will not be immediately applicable for all designated Offices**
 - necessary to modify national laws in designated Offices
 - national phase entry from Chapter I will remain 20 months in those designated Offices until the modifications are made

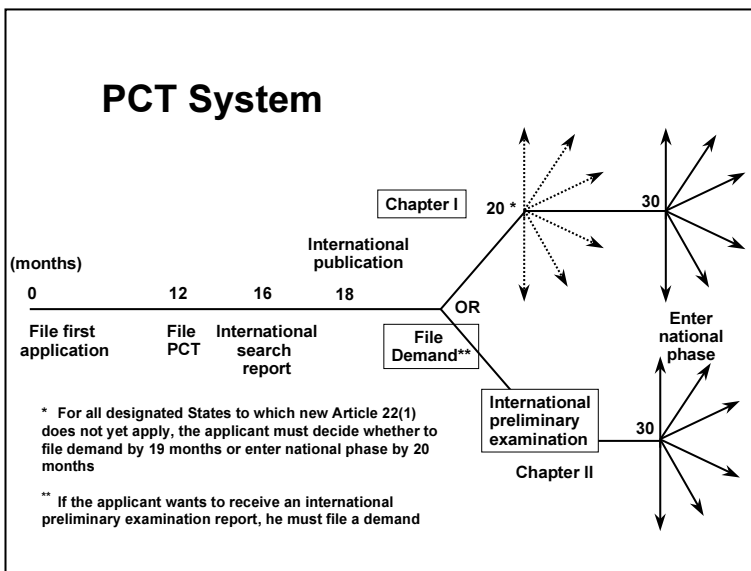
Effects and consequences of change to Article 22

- **The time limit for national phase entry under PCT Article 22(1) is the same as under PCT Article 39(1)(a)**
- **A demand electing at least one eligible State will need to be filed**
 - where international preliminary examination is desired
 - before 19 months from the priority date in order to delay time limit for national phase entry to 30 months in any of the designated Offices where national laws have yet to be modified

Designated Offices where national phase entry remains 20 months

CH Switzerland *	TZ United Republic of Tanzania **
LU Luxembourg *	UG Uganda **
SE Sweden *	ZM Zambia **

* Member of EPO
** Member of ARIPO



January 2004 changes

- **Enhanced international search and preliminary examination (EISPE) system**
- **Change to time limit for filing a demand for international preliminary examination**
- **Automatic designation and election of Contracting States**
- **Simplified fee system**
- **Relaxation of signature and other filing requirements**

Effective dates

- **Changes apply only to international applications with international filing date on or after January 1, 2004**
 - **exception: all-inclusive elections apply if demand is filed on or after January 1, 2004, regardless of when application was filed**
 - **exception: IPER available via IB if demand is filed on or after January 1, 2004, regardless of when application was filed**

EISPE system – main features

- **Convergence of Chapter I and II procedures**
 - Chapters I and II remain legally distinct
- **International search report (or declaration under Article 17(2)(a)) plus written opinion of ISA issued for every international application**
- **International preliminary report on patentability (IPRP) issued for every international application**
 - IPRP (Chapter I) = repackaged written opinion of the ISA
 - IPRP (Chapter II) = IPER
- **Main distinction:**
 - Chapter I (no demand for IPE filed): no dialogue with ISA examiner before establishment of IPRP
 - Chapter II (demand for IPE is filed): dialogue with IPEA examiner before establishment of IPRP (IPER)

Expanded Chapter I proceedings

- **The written opinion of the ISA will have similar scope and content as the written opinion of IPEA**
- **Written opinion of the ISA sent to applicant together with ISR**
- **ISR will be published with application but written opinion of the ISA will not be published**
- **Applicant may “informally” submit comments on the written opinion of the ISA to IB**
 - IB will transmit comments to designated Offices

IPRP (Chapter I)

- **If applicant does not file demand**
 - IB will establish “International Preliminary Report on Patentability” IPRP (Chapter I) – same content as ISA written opinion
- **IPRP (Chapter I) and any comments on the written opinion filed by applicant**
 - are sent to designated Offices by the IB
 - are made publicly available by the IB (but not “published” like application and ISR)
 - but not before the expiration of 30 months from the priority date

Chapter II

- **Written opinion of the ISA will be considered as the written opinion by IPEA**
 - IPEA may decide not to accept written opinions by certain ISAs
 - US will accept written opinions issued by ISA/EP
- **Comments by applicant on written opinion of the ISA not sent to IPEA**
 - may be submitted by the applicant to IPEA as arguments or amendments under Article 34
- **“New” written opinion of IPEA issued only in rare circumstances**

IPRP (Chapter II)

- **IPEA establishes “International Preliminary Report on Patentability (Chapter II)” = IPER**
- **IPRP (Chapter II) is sent to elected Offices**
 - made publicly available by IB on behalf of any elected Office which so requests,
 - but not before the expiration of 30 months from the priority date (≈100% availability from IB is expected)

New time limit for making a Demand

- **For international applications filed on or after January 1, 2004,**
 - three months from the date of transmittal of the international search report (or declaration referred to under Article 17(2)(a)) and written opinion of the ISA or
 - 22 months from the priority datewhichever expires later
- **A demand made after expiration of this time limit will be considered as not having been submitted**
 - see Rule 54*bis*.1
- **A demand should be filed before 19 months from the priority date in order to delay the time limit for national phase entry to 30 months in all PCT Contracting States**

Amendments to be considered in Chapter II

- **The time limit for filing amendments under Article 34 is the same as the time limit for filing a demand, that is, the later of**
 - 22 months from the priority date or
 - 3 months from the date of mailing of the search report and written opinion of the ISA

Concept and operation of designation system

- **Automatic and all-inclusive**
 - all possible designations are made by default
 - can exclude Germany, Republic of Korea, Russian Federation under transitional reservations for countries with “self-designation” provisions
- **Choice of other types of protection in lieu of “national patent” postponed until national phase**

Elections and fee changes

- **Filing a demand provides automatic and all-inclusive elections under Chapter II**
- **Flat “international filing fee”**
 - eliminate separate basic fee and designation fees

Relaxation of signature and other filing requirements

- **Signature – sufficient that request be signed by one applicant – BUT:**
 - signature of all applicants needed for withdrawals under Rule 90bis
 - designated/elected Offices may require absent signatures and indications in national phase
- **Indications concerning applicants – needed only for one applicant entitled to file with the RO concerned**
- **Powers of attorney – RO, ISA, IPEA, IB may waive requirement for separate power of attorney**
 - US has waived the requirement
 - See January 2004 *PCT Newsletter*

Search fee – where US is ISA (1)

- **If a corresponding prior U.S. national application under 35 U.S.C. 111(a) has been filed**
 - on or after December 8, 2004, the basic filing fee under §1.16(a), the search fee under §1.16(k) and examination fee under §1.16(o) have been paid...
- OR**
 - before December 8, 2004, the basic filing fee under §1.16(a) has been paid ...
- **AND...**

Search fee – where US is ISA (2)

- **And the corresponding prior U.S. national application is identified by application number, if known, or if the application number is not known, by the filing date, title, and name of applicant (and preferably the application docket number) in the international application or accompanying papers at the time of filing of the international application, the search fee is \$300**
- **For all other situations, the search fee is \$1000**

Changes to national stage fees

- **The Consolidated Appropriations Act provides for the following separate fees for national stage applications:**
 - **Basic national fee (35 U.S.C. 41(a)(1)(F))**
 - **\$300 (non-small entity)**
 - **Examination fee (35 U.S.C. 41(a)(3)(D))**
 - **\$200 (non-small entity)**
 - **Search fee (35 U.S.C. 41(d)(1))**
 - **\$500 (non-small entity)**
 - **Application size fee (35 U.S.C. 41(a)(1)(G))**
 - **If the specification and drawings exceed 100 sheets of paper, \$250 (non-small entity) for each additional 50 sheets of paper or fraction thereof**
- **These fees went into effect on December 8, 2004**

Excess claims fees

- **The revised excess claims fees (35 U.S.C. 41(a)(2):**
 - **\$200 (non-small entity) for each claim in independent form in excess of 3**
 - **\$50 (non-small entity) for each claim (whether dependent or independent) in excess of 20;**
 - **\$360 (non-small entity) for each application containing a multiple dependent claim**

Revision of national stage search and examination fees

- **The Office reduced certain patent fees set forth in 37 CFR 1.492 pursuant to its authority under 35 U.S.C. 376(b)**
 - The amended rules were published in the Federal Register on February 1, 2005 (Vol. 70, No. 20, 5055)

National stage search fee

- **For an international application entering the national stage under 35 U.S.C. 371 where the basic national fee was not paid before December 8, 2004**
 - Search fee (37 CFR 1.492(b))
 - \$100 (non-small entity) if the search fee set forth in 37 CFR 1.445(a)(2) has been paid to the USPTO as ISA
 - \$400 (non-small entity) if an international search report has been prepared and is provided to the Office no later than the time the search fee is paid
 - \$500 (non-small entity) in all other situations
 - Examination fee (37 CFR 1.492(c))
 - \$100 (non-small entity) if the international preliminary examination fee prepared by the IPEA/US satisfied PCT Article 33(1)-(4)
 - \$200 (non-small entity) in all other situations

Examination in the national stage

- **The lower examination fee applies if the national stage application contains, or is amended to contain, at the time of entry into the national stage, only claims which have been indicated in an IPER issued by the IPEA/US as satisfying PCT Article 33(1)-(4)**

March 1, 2005 fee changes

- **WIPO is adjusting certain international fees due to currency fluctuation**
 - International filing fee will increase to \$1211
 - Fee per sheet in excess of 30 will increase to \$13
 - Reduction for PCT-EASY will increase to \$87
 - Handling fee will increase to \$173

March 15, 2005 fee changes

- **EP is adjusting the search fee where they act as ISA, due to currency fluctuation**
 - Search fee will increase to \$2075

April 2005 changes

- **Rule 13ter has been amended to permit an ISA to charge a fee for the late submission of sequence listing in electronic form**
- **Time limit for responding to a lack of unity requirement will be one month**

Two new Contracting States

- **The Comoros will become the 125th PCT Contracting State on 3 April 2005**
- **Nigeria will become the 126th PCT Contracting State on 8 May 2005**

Any questions?

