Considerations and Options for Foreign Filing Including the PCT

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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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### Regional Patent Offices

**AP (ARIPO)**
- BW Botswana
- GH Ghana
- GM Gambia
- KE Kenya
- LR Liberia
- LS Lesotho
- MW Malawi
- MZ Mozambique
- NA Namibia
- RW Rwanda
- SD Sudan
- SL Sierra Leone
- SZ Swaziland
- TZ United Republic of Tanzania
- UG Uganda
- ZM Zambia
- ZW Zimbabwe

**EP (EPO)**
- AL Albania
- AT Austria
- BE Belgium
- BG Bulgaria
- CH Switzerland
- CY Cyprus
- CZ Czech Republic
- DE Germany
- DK Denmark
- EE Estonia
- ES Spain
- FI Finland
- FR France
- GB United Kingdom
- GR Greece
- HR Croatia
- HU Hungary
- IE Ireland
- IS Iceland
- IT Italy
- LI Liechtenstein
- LT Lithuania
- LU Luxembourg
- LV Latvia
- MC Monaco
- MD Republic of Moldova
- MK Macedonia
- MT Malta
- NL Netherlands
- NO Norway
- PL Poland
- PT Portugal
- RO Romania
- RS Serbia
- SE Sweden
- SI Slovenia
- SK Slovakia
- SM San Marino
- TR Turkey

**OA (OAPI)**
- BF Burkina Faso
- BJ Benin
- CG Congo
- CI Côte d'Ivoire
- CM Cameroon
- GA Gabon
- GN Guinea
- GQ Equatorial Guinea
- GW Guinea-Bissau
- ML Mali
- MR Mauritania
- NE Niger
- SN Senegal
- TD Chad
- TG Togo

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**EA (EA)**
- AM Armenia
- AZ Azerbaijan
- BY Belarus
- KG Kyrgyzstan
- KZ Kazakhstan
- RU Russian Fed.
- TJ Tajikistan
- TM Turkmenistan

**EP (EPO) Extension Countries**
- BA Bosnia and Herzegovina
- ME Montenegro
- MA Morocco
- MD Republic of Moldova

**GC (GCC)**
- BL Bahrain
- KW Kuwait
- OM Oman
- QA Qatar
- SA Saudi Arabia
- AE United Arab Emirates

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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
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
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)
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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# Current List of PCT Contracting States

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</table>

¹ Extension of European patent possible.
² May only be designated for a regional patent (the “national route” via the PCT has been closed).
³ Validation of European patent possible for international applications filed on or after 1 March 2015.
⁴ Validation of European patent possible for international applications filed on or after 1 November 2015.

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PCT World Map

Email questions to:
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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)
Chapter I
PCT System

Priority Application Filed

Date for calculation of all PCT time limits

Typically a national patent application in the country of the applicant

File local (priority) application

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PCT System – Chapter I
International Application Filed

Where no priority application is filed, the IFD is the date for calculation of all PCT time limits.

Start of International phase

Typically filed in the same national office
- International filing/search fees
- One language
- One set of formalities
- Legal effect in all PCT States

*may be more than 12 months where the international application contains a restoration-eligible priority claim

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PCT System – Chapter I
ISR and WOISA Issued

File local (priority) application

File PCT

International Search Report (ISR) and Written Opinion of ISA (WOISA)

Chapter I (no Demand filed)

Time limit is the later of:
- 3 months after the ISA receives the search copy
- 9 months after the priority date

ISA:
- Establishes ISR citing relevant prior art (PCT/ISA/210)
  - Rarely, non-establishment of ISR (PCT/ISA/203)
- Prepares written opinion (PCT/ISA/237)

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Indications concerning:

- Basis of the report
- Unsearchable claims
- Unity of Invention
- Title and abstract
- Figure to be published

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International Search Report

Form PCT/ISA/210
(second sheet)

Documents Considered to be Relevant

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### International Search Report Cited Documents (References)

#### Document Categories

**X**
- US 2007/0125844 A1 (LiBIN et al.) 07 June 2007 (07.06.2007), entire document, especially para [0002]-[0003], [0005], [0015]-[0017], [0021]-[0025], [0030], [0036] and abstract
- Relevant to claim No. 1-2, 4-5, 7-15, 17-18, 20-22

**Y**
- US 2005/0222873 A1 (NEPHIN et al.) 06 October 2005 (06.10.2005), entire document, especially para [0102], [0223]-[0227]
- Relevant to claim No. 3, 6, 16, 19

**A**
- Relevant to claim No. 1-22

**A**
- Relevant to claim No. 1-22

**A**
- Relevant to claim No. 1-22

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Email questions to: inventorinfochat@uspto.gov
Three Main Categories of Prior Art in an International Search Report

• “X” document
  – Claimed invention lacks
    • Novelty, or
    • Inventive step when considered alone (lacks inventive step = obvious)
  – “Stand alone” reference

• “Y” documents
  – Claimed invention lacks inventive step
    • When two or more documents are used in combination

• “A” document
  – General state of the art reference
Written Opinion of the ISA
(Cover Sheet)

Form PCT/ISA/237
(cover sheet)

Contents of the Written Opinion of the ISA

Email questions to:
inventorinfochat@uspto.gov
# Written Opinion of the ISA

## Basis of this Opinion

**Form PCT/ISA/237**

<table>
<thead>
<tr>
<th>Box No. 1</th>
<th>Basis of this opinion</th>
</tr>
</thead>
<tbody>
<tr>
<td>1. With regard to the language, this opinion has been established on the basis of:</td>
<td></td>
</tr>
<tr>
<td>✔ the international application in the language in which it was filed.</td>
<td></td>
</tr>
<tr>
<td>☐ a translation of the international application into _________ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).</td>
<td></td>
</tr>
<tr>
<td>2. ☐ This opinion has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a)).</td>
<td></td>
</tr>
<tr>
<td>3. ✔ With regard to any nucleotide and/or amino acid sequence disclosed in the international application, this opinion has been established on the basis of a sequence listing:</td>
<td></td>
</tr>
<tr>
<td>a. ✔ forming part of the international application as filed:</td>
<td></td>
</tr>
<tr>
<td></td>
<td>✔ in the form of an Annex C/ST.25 text file.</td>
</tr>
<tr>
<td></td>
<td>☐ on paper or in the form of an image file.</td>
</tr>
<tr>
<td>b. ☐ furnished together with the international application under PCT Rule 13ter.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file.</td>
<td></td>
</tr>
<tr>
<td>c. ☐ furnished subsequent to the international filing date for the purposes of international search only:</td>
<td></td>
</tr>
<tr>
<td></td>
<td>☐ in the form of an Annex C/ST.25 text file (Rule 13ter.1(a)).</td>
</tr>
<tr>
<td></td>
<td>☐ on paper or in the form of an image file (Rule 13ter.1(b) and Administrative Instructions, Section 713).</td>
</tr>
<tr>
<td>4. ☐ In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.</td>
<td></td>
</tr>
<tr>
<td>5. Additional comments:</td>
<td></td>
</tr>
</tbody>
</table>

Email questions to: inventorinfochat@uspto.gov
Citations and explanations on:
- novelty
- inventive step, and
- industrial applicability of the claimed invention
File local (priority) application

File PCT

ISR & WOISA

Chapter I (no Demand filed)

File PCT in the IB
- Claim amendments only
- Within 2 months of ISR/WOISA mailing date

Email questions to: inventorinfochat@uspto.gov
**PCT System – Chapter I**

**International Application Publication**

WIPO publishes IA
- Example: WO2013/018714
- Accessible via PATENTSCOPE website
- Includes ISR and any Article 19 amendments

Email questions to: inventorinfochat@uspto.gov
International Application Published under the PCT

Email questions to: inventorinfochat@uspto.gov

FIG. 3

Title: ARTICULATED SCREEN COVER FOR ACCOMMODATING OBJECTS

Abstract: A cover for a mobile computing device is described. The cover comprises two or more hinges so constructed that the hinges are substantially rigid when in place and flexible when out of place. The cover includes segments made of a rigid material disposed between the hinges. The cover, when adhered to the back side of the computing device, forms a contour around an object such as a stylus to secure the object to the back side of the computing device when the cover is present. The cover becomes substantially flat and parallel to the back side of the computing device when the object is absent.
PCT System – Chapter I
Supplementary International Search

File local (priority) application

File PCT

ISR & WOISA

Art 19 (optional)

International Publication

Supplementary International Search Report(s) (SISR) established

SISA:
- Establishes SISR citing relevant prior art (PCT/SISA/501)
  - Originally-filed claims searched
  - No written opinion produced

Filed in the IB
- Prior to 19 months from priority date
- Indicates a Supplementary ISA (SISA)

Email questions to:
inventorinfochat@uspto.gov
PATENT COOPERATION TREATY

PCT
SUPPLEMENTARY INTERNATIONAL SEARCH REPORT
(PCT Rule 458/o)

Applicant's or agent's file reference 11506-GB
International application No. PCT/US2009/065691
International filing date (day/month/year) 24-11-2009
(Earliest) Priority Date (day/month/year) 25-11-2008
Applicant The Procter & Gamble Company et al

This supplementary international search report has been prepared by this Authority specified for supplementary search and it is transmitted to the applicant in accordance with Rule 458(o). A copy is being transmitted to the International Bureau.

This report is a corrected version of a previously issued international search report.

This supplementary international search report consists of a total of 4 sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the language, the supplementary international search was carried out on the basis of:

- the international application in the language in which it was filed
- a translation of the international application into [language], which is the language of a translation furnished for the purposes of:
- the international search (Rules 12.2(a) and 23.1(b));
- the international publication (Rule 12.4);
- the supplementary international search (Rule 458(o)(c)(i)).

b. This supplementary international search report has been established taking into account the rectification of an obvious mistake notified to this Authority under Rule 91 (Rules 45.6h(a) and 45.6h(c)).

c. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, see Box No. 1.

d. This supplementary international search report has been established taking due account of the international search report, or the declaration under Article 17(3)(b) that no international search report will be established, and the written opinion established under Rule 43(b).2.

 Certain claims were found unsearchable (see Box No. II).

3. Unity of invention is lacking (see Box No. III).

Form PCT/SISA/501 (first sheet) (January 2009)
Form PCT/SISA/501 (second sheet)

Documents Considered to be Relevant
PCT System – Chapter I
International Preliminary Report on Patentability (IPRP) (Chapter I)

- File local (priority) application
- File PCT
- ISR & WOISA
- Art 19 (optional)

Chapter I (no Demand filed)

International Publication

12* 16 18 28

30

WIPO prepares an IPRP Chapter I using the WOISA (PCT/IB/373)

Email questions to: inventorinfochat@uspto.gov
PCT System – Chapter I
National Phase Entry from Chapter I

- File local (priority) application
- File PCT
- ISR & WOISA
- Art 19 (optional)
- International Publication
- IPRP (CH I)

 Applicant takes steps to pursue patent protection in various States
- Express intention to enter national phase
- Pay fees
- Provide translation

Chapter I (no Demand filed)

Enter national phase

Email questions to:
inventorinfochat@uspto.gov
Chapter II
PCT System – Chapter II
Filing of Demand for Chapter II Entry

File local (priority) application

File PCT

Start of International phase

Chapter I

International Publication

Chapter II

File demand for International preliminary examination

Applicant “demands” additional examination/analysis,
• usually based on an amended application and/or arguments

Time limit is the later of
• 3 months from mailing of ISR (or PCT/ISA/203) and WOISA
• 22 months after the priority date

Email questions to: inventorinfochat@uspto.gov
PCT System – Chapter II
IPRP (Chapter II)

International Preliminary Examining Authority (IPEA)
• Prepares non-binding report on patentability
• PCT/IPEA/409 & PCT/IPEA/416

International Preliminary Report on Patentability (Chapter II)

Email questions to: inventorinfochat@uspto.gov
IPRP Chapter II
Cover Sheet

Form PCT/IPEA/409

Contents of the IPRP (CH II)

Email questions to:
inventorinfochat@uspto.gov
IPRP (Chapter II)
Basis of the Report

Basis of the report
– Application as amended
Form PCT/IPEA/409
Box No. V

Citations and explanations on
- Novelty,
- Inventive step, and
- Industrial applicability of the claimed invention

Email questions to: inventorinfochat@uspto.gov
PCT System – Chapter II
National Phase Entry from Chapter II

- File local (priority) application
- File PCT
- International Publication
- ISR & WOISA
- Art 19 (optional)
- Demand
- IPRP(CH II)

Applicant takes steps to pursue patent protection in various States
- Express intention to enter national phase
- Pay fees
- Provide translation

Email questions to:
inventorinfochat@uspto.gov
The National Stage
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/

Email questions to:
inventorinfochat@uspto.gov
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

Email questions to: inventorinfochat@uspto.gov
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

Email questions to: inventorinfochat@uspto.gov
PCT Resources

  - International Patent Legal Administration web page on USPTO Internet site
    - Forms, fees, rules, etc.

- [http://www.wipo.int](http://www.wipo.int)
  - World Intellectual Property Organization
    - ePCT, PATENTSCOPE, etc.

Email questions to: inventorinfochat@uspto.gov
Upcoming OID Events

• August 16, 2018– Inventor Info Chat: Global Dossier
• August 17-18, 2018 – Invention Con-Alexandria, VA
  – “Concept to Commercialization”
• For more information or to register for any of the above events contact us at oidevents@uspto.gov

https://www.uspto.gov/patents-application-process/inventor-info-chat
Questions?