

UNITED STATES
PATENT AND TRADEMARK OFFICE



Best Practices and Common Mistakes for Patent Cooperation Treaty and U.S. National Stage Applications

Michael Neas
Deputy Director
International Patent Legal Administration



Validated Patent Cooperation Treaty (PCT) request form

- Validation software
 - PCT-SAFE
 - ePCT-Filing
 - Export issues: Federal Register Notice May 6, 2016
 - www.govinfo.gov/content/pkg/FR-2016-05-06/pdf/2016-10733.pdf
 - Optional provision of abstract
 - Optional provision of title
 - NEW! 37 CFR part 5 amended to expand the scope of a foreign filing license from the USPTO
 - Federal Register Notice September 30, 2020
 - » <https://www.govinfo.gov/content/pkg/FR-2020-09-30/pdf/2020-18743.pdf>



Optional provision of title in ePCT

0-4	Form PCT/RO/101 PCT Request	
0-4-1	Prepared Using	ePCT-Filing for data package download Version 4.5.001 MT/FOP 20190404/1.1
0-5	Petition	The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty
0-6	Receiving Office (specified by the applicant)	United States Patent and Trademark Office (USPTO) (RO/US)
0-7	Applicant's or agent's file reference	
I	Title of Invention	[The title is as provided on page 1 of the description]



Missing parts or elements – best practices

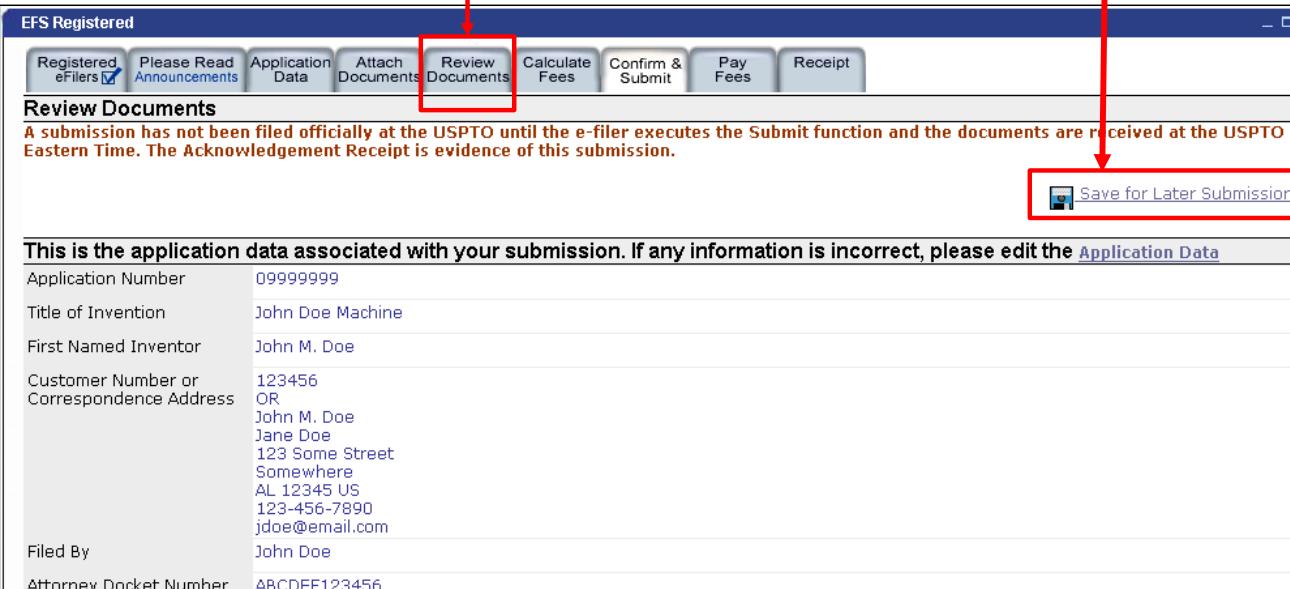
- Avoid omission of documents
 - Review documents prior to submission
 - Recent increase in applications filed with missing elements or parts
 - Use the “Review Documents” and “Save for Later Submission” functions in EFS-Web



Missing parts or elements – best practices (cont)

Review Documents

Save for Later Submission



The screenshot shows the EFS Registered software interface. At the top, there is a navigation bar with several buttons: 'Registered e-filers' (with a checked checkbox), 'Please Read Announcements', 'Application Data', 'Attach Documents', 'Review Documents' (highlighted with a red box and an arrow), 'Calculate Fees', 'Confirm & Submit', 'Pay Fees', and 'Receipt'. Below the navigation bar, there is a section titled 'Review Documents' with a note: 'A submission has not been filed officially at the USPTO until the e-filer executes the Submit function and the documents are received at the USPTO Eastern Time. The Acknowledgement Receipt is evidence of this submission.' At the bottom of the interface, there is a table showing application data, and a 'Save for Later Submission' button (highlighted with a red box and an arrow).

This is the application data associated with your submission. If any information is incorrect, please edit the Application Data	
Application Number	09999999
Title of Invention	John Doe Machine
First Named Inventor	John M. Doe
Customer Number or Correspondence Address	123456 OR John M. Doe Jane Doe 123 Some Street Somewhere AL 12345 US 123-456-7890 jdoe@email.com
Filed By	John Doe
Attorney Docket Number	ABCDEF123456

Save for Later Submission

Missing parts or elements – best practices (cont)

- Check for completeness and accuracy promptly after filing
 - Via Electronic Acknowledgement Receipt and Private PAIR
 - Application can be supplemented on the day of filing without adjustment to the international filing date (IFD)
- You only have two months from filing to confirm an incorporation by reference of a missing part or element where the receiving Office (RO) does not issue an invitation
 - See PCT Rule 20.6
- Respond to Form PCT/RO/107 by confirmation of incorporation by reference
 - Simply providing a missing part will change the IFD



Missing parts or elements – best practices (cont)

- Check files and page count
- Check PAIR to verify the correct document was submitted

Acknowledgement Receipt
The USPTO has received your submission at 15:19:37 EST on 02-JAN-2007.
\$430 fee paid by e-Filer via RAM with Confirmation Number: 200.
You have also pre-authorized the following payments from your USPTO Deposit Account:
Charge any Additional Fees required under 37 C.F.R. Section 1.16 and 1.17

eFiled Application Information

EFS ID	1000000	You may take the following actions:
Application Number	99999999	E-mail Receipt Info
Confirmation Number	9999	Print Receipt
Title of Invention	John Doe Machine	Save Receipt
First Named Inventor	John Michael Doe 12345 OR John M. Doe Jane Doe 123 Some Street Somewhere AL 12345 US 123-456-7890 jdoe@email.com	File Another Application
Customer Number or Correspondence Address		File an Assignment of Ownership
Filed By	John Doe	Pay Maintenance Fees
Attorney Docket Number	ABCDEF123456	Access Private Pair
Filing Date		
Receipt Date	02-JAN-2007	
Application Type	Utility under 35 USC 111(a)	

Application Details

Submitted Files	Page Count	Document Description	File Size	Warnings
Abstract.pdf	1	Abstract	2851 bytes	◆ Pass
Claims.pdf	3	Claims	3586 bytes	◆ Pass
Spec.pdf	5	Specification	852851 bytes	◆ Pass
ADS.pdf	3	Application Data Sheet	73254 bytes	◆ Pass
fee-info.pdf	2	Fee Worksheet (PTO-875)	8280 bytes	◆ Pass

Missing parts or elements – best practices (cont)

- Confirmation of incorporation by reference
 - Do not supply sheets embodying parts not contained in the earlier application
 - Replacement of informal drawings with formal drawings may be a problem
 - Not a “new matter” standard



Filed wrong parts of the international application (IA)

- Wrong description or claims were attached to an international application filed with the RO/US via EFS-Web
- Can this mistake be fixed?
 - Use of the current version of the PCT Request form
 - Allows confirmation of the incorporation by reference of the missing parts, provided those parts are contained in an application to which priority is claimed
 - Not all designated Offices will recognize incorporation of a description and claims where an erroneous set was originally filed
 - PCT Rule 20.5bis allows for removal of the erroneously-filed part or element under certain conditions



Appendices and annexes

- There is no provision for appendices nor annexes in international applications
 - A computer program listing or table must be submitted and paid for as part of the description
 - Unlike the provisions of 37 CFR 1.52(e) for U.S. national applications
 - The receiving Office (RO) will request clarification from applicant if unclear whether appendix/annex is to be treated as part of the description
 - If part of the description, it will need to be numbered accordingly
 - If not part of the description, will not form part of the IA



Formal drawings

- Providing drawings compliant with Rule 11 on filing avoids hassles later
 - Invitation from RO to correct (Form PCT/RO/106)
 - Correction may require approval from International Searching Authorities (ISA) under Rule 91
 - No amendment to drawings in Chapter I
 - May need to wait for Chapter II or national phase in order to amend
 - Prevents national and regional Offices from requiring new drawings based on form
 - PCT Art. 27 – “No national law shall require compliance with requirements relating to the form or contents of the international application different or in addition to those which are provided for in this Treaty and the Regulations.”



Use of Customer Numbers in international applications

- Customer Numbers cannot be used in an international application to
 - Appoint or withdraw agents
 - Establish or change correspondence address
- A Customer number associated with an international application
 - Is only for access in Private PAIR
 - Can be changed with Form PTO-2248
- Refer to MPEP 1807



Avoid using USPTO power of attorney forms in IAs

PTO/AIA/80

PTO/AIA/80 (07-12)
Approved for use through 11/08/2014. OMB 0651-0005
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(c).
I hereby appoint:

Practitioners associated with Customer Number:

OR

Practitioner(s) named below (if more than ten patent practitioners are to be named, then a customer number must be used):

Name	Registration Number
<input type="text"/>	<input type="text"/>

As attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignments documents attached to this form in accordance with 37 CFR 3.73(c).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(c) to:

The address associated with Customer Number:

OR

Firm or Individual Name:	<input type="text"/>
Address:	<input type="text"/>
City:	<input type="text"/>
State:	<input type="text"/>
Country:	<input type="text"/>
Telephone:	<input type="text"/>
Email: <input type="text"/>	

Assignee Name and Address:



Request MUST indicate a sequence listing (SL) forms part of an IA

- Failure to identify the SL as part of the IA in the request
 - May result in a fatally-defective National Stage application
 - Where sequences are not otherwise sufficiently disclosed in the IA
 - Even if the SL was provided on the international filing date (IFD)
- Incorporation by reference (as in a regular U.S. application) is NOT sufficient.
 - If present, some national/regional Offices may require removal.
- Request – Box No. IX
 - Check list indicates items that form part of the IA.
 - Accompanying Items do NOT form part of the IA.



Request Box No. IX - PCT-SAFE

Parts of the IA

IX	Check list	Number of sheets	Electronic file(s) attached
IX-1	Request (including declaration sheets)	5	✓
IX-2	Description (excluding sequence listing part)	67	-
IX-3	Claims	11	-
IX-4	Abstract	1	✓
IX-5	Drawings	20	-
IX-7a	Sub-total number of sheets	104	
IX-6	Sequence listing part of the description	6	-
IX-7	TOTAL	110	
IX	Accompanying Items	Paper document(s) attached	Electronic file(s) attached
IX-8	Fee calculation sheet	✓	-
IX-18	PCT-SAFE physical media	-	✓
IX-19	A statement confirming that "the information in Annex C/ST.25 text format submitted under Rule 13ter is identical to the sequence listing as contained in the international application"	✓	-
IX-19	Other	Transmittal	
IX-19	Other	Sequence Listing (TXT)	

Accompanying items NOT part of the IA

Request – Box No. IX – PCT/RO/101

Parts of the IA

Box No. IX CHECK LIST for EFS-Web filings - this sheet is only to be used when filing an international application with RO/US via EFS-Web		
This international application contains the following:		Number of sheets
(a) request form PCT/RO/101 (including any declarations and supplemental sheets)	:	4
(b) description (excluding any sequence listing part of the description, see (f), below)	:	50
(c) claims	:	10
(d) abstract	:	1
(e) drawings (if any)	:	10
(f) sequence listing part of the description in the form of an image file (e.g. PDF)	:	
Total number of sheets (including the sequence listing part of the description if filed as an image file)	:	75
(g) sequence listing part of the description		
<input checked="" type="checkbox"/> filed in the form of an Annex C/ST.25 text file		
<input type="checkbox"/> WILL BE filed separately on physical data carrier(s), on the same day and in the form of an Annex C/ST.25 text file		
Indicate type and number of physical data carrier(s)		
This international application is accompanied by the following item(s) (mark the applicable check-boxes below and indicate in right column the number of each item):		
1. <input type="checkbox"/> fee calculation sheet		
2. <input type="checkbox"/> original separate power of attorney		
3. <input type="checkbox"/> original general power of attorney		
4. <input type="checkbox"/> copy of general power of attorney; reference number:		
5. <input type="checkbox"/> priority document(s) identified in Box No. VI as item(s)		
6. <input type="checkbox"/> Translation of international application into (language):		
7. <input type="checkbox"/> separate indications concerning deposited microorganism or other biological material		
8. <input type="checkbox"/> (only where item (f) is marked in the left column) copy of the sequence listing in electronic form (Annex C/ST.25 text file) not forming part of the international application but furnished only for the purposes of international search under Rule 13ter		
9. <input type="checkbox"/> (only where item (f) is marked in the left column) a statement confirming that “the information recorded in electronic form submitted under Rule 13ter is identical to the sequence listing as contained in the international application” as filed via EFS-Web:		
10. <input type="checkbox"/> copy of results of earlier search(es) (Rule 12bis.1(a))		
11. <input type="checkbox"/> other (specify):		

Accompanying items NOT part of the IA

Instructions for completion of the request to indicate that SL forms part of IA

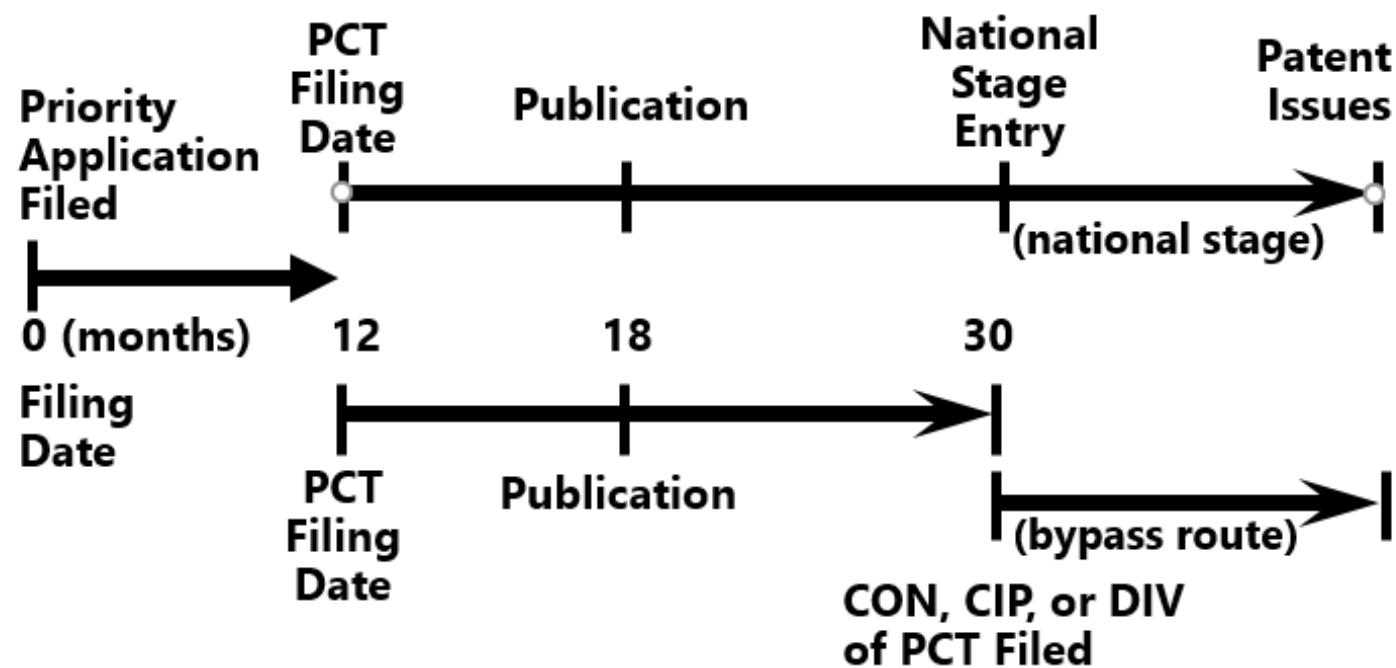
- Available on the International Patent Legal Administration homepage at www.uspto.gov/patentcooperationtreaty
 - Located under the heading "Helpful resources to assist applicants navigating the PCT process"

PCT & Sequence Listing (SL)

- [July 2009 Administrative Instruction Changes](#)
- [Instructions & Examples of Filled-out Request with SL](#)
 - [Conventional Request \(PCT/RO/101\)](#)
 - [PCT-SAFE/EASY](#)



National stage vs. bypass route



uspto

National stage application contents

- A U.S. national stage application ("371") continues the prosecution of the IA
 - Contents of the IA determines contents of the national phase application
- Simply filing a SL on the date of first submission of the 371 **does not** make it part of the application
 - Unless the SL was already part of the IA
 - If filed, should be accompanied by a letter explaining its status, e.g., "The sequence listing submitted herewith is identical to the sequence listing forming part of the international application."
 - A SL that was not part of the IA **must** be accompanied by a preliminary amendment to enter it into the national phase application
 - E.g., SL in text format submitted to the ISA/US in response to PCT/ISA/225
 - See next slide



Preliminary amendment to enter a text format SL into a 35 U.S.C. 371 application

- SL in text format only, filed via EFS-Web upon national phase entry
 - Can serve both as part of the application and as the computer readable form (CRF)
 - Is excluded when determining the application size fee
- If not part of the IA, MUST file a preliminary amendment, including
 - A statement that SL in text format does not introduce new matter to the IA as of its IFD
 - An indication of support for the amendment in the 371 application
 - An incorporation by reference
 - A separate paragraph added to the SPEC, by Substitute SPEC practice, that identifies the
 - Name of the file
 - Date of creation
 - Size of the file in bytes
 - As specified in MPEP 502.05 and the Legal Framework for EFS-Web



Time for Filing of oath/declaration- (Pre-AIA (Oath/Dec))

- By 30 months from the priority date
- In response to Notice of Missing Requirements
 - Time limit set in Notice may be extended
 - 37 CFR 1.136(a)
- After 30 months from the priority date
 - With a surcharge of \$140 (37 CFR 1.492(h))
 - Reducible by 50% for small entity and 75% for micro entity



Time for Filing of oath/declaration- AIA (Oath/Dec) (1)

- May postpone submission until application is in condition for allowance (37 CFR 1.492(c))
 - If an ADS is filed identifying
 - Each inventor by his or her legal name
 - For each inventor, a mailing address where the inventor customarily receives mail
 - And residence, if the inventor lives at a location different than the mailing address
 - If postponed, must be filed no later than the time period set in the "Notice of Allowability" to avoid abandonment



Time for Filing of oath/declaration - AIA (Oath/Dec) (2)

- Exceptions to postponement of oath/dec until allowance
 - Early commencement under 35 U.S.C. 371(f)
 - Request for Continued Examination (RCE)
 - PUBLIC LAW 106-113-APPENDIX I 113 STAT. 1501A-560 (SEC. 4403) adds section (b) to 35 U.S.C. 132
 - Which grants the Director [of the USPTO] the ability to prescribe regulations for continued examination of patent applications
 - However, PUBLIC LAW 106-113-APPENDIX I 113 STAT. 1501A-561 sets forth the applicability of 35 U.S.C. 132(b) to
 - "[...] all applications complying with section 371 of title 35, United States Code, [...]"
 - 35 U.S.C. 371(c) requires the filing of an oath/dec of the inventor



Form PTO-1390 – express request to begin national phase examination

PTO-1390 (01-18) Approved for use through 8/31/2019. OMB 0651-0021 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE		
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.		
TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371		Attorney Docket No.
International Application No.	International Filing Date	Priority Date Claimed
Title of Invention		
First Named Inventor		
Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information.		
<ol style="list-style-type: none">1. <input type="checkbox"/> This is an express request to begin national examination procedures (35 U.S.C. 371(f)). NOTE: The express request under 35 U.S.C. 371(f) will not be effective unless the requirements under 35 U.S.C. 371(c)(1), (2), and (4) for payment of the basic national fee, copy of the International Application and English translation thereof (if required), and the oath or declaration of the inventor(s) have been received.2. <input type="checkbox"/> A copy of the International Application (35 U.S.C. 371(c)(2)) is attached hereto (not required if the International Application was previously communicated by the International Bureau or was filed in the United States Receiving Office (RO/US)).3. An English language translation of the International Application (35 U.S.C. 371(c)(2))<ol style="list-style-type: none">a. <input type="checkbox"/> is attached hereto.b. <input type="checkbox"/> has been previously submitted under 35 U.S.C. 154(d)(4).4. An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4))<ol style="list-style-type: none">a. <input type="checkbox"/> is attached.b. <input type="checkbox"/> was previously filed in the international phase under PCT Rule 4.17(iv).		
Items 5 to 8 below concern amendments made in the international phase.		
<small>PCT Article 19 and 24 amendments</small>		

Form PTO-1390 – sequence listings

<p>The following items 9 to 17 concern a document(s) or information included.</p> <p>9. <input type="checkbox"/> An Information Disclosure Statement under 37 CFR 1.97 and 1.98.</p> <p>10. <input type="checkbox"/> A preliminary amendment.</p> <p>11. <input type="checkbox"/> An Application Data Sheet under 37 CFR 1.76.</p> <p>12. <input type="checkbox"/> A substitute specification. NOTE: A substitute specification cannot include claim(s). See 37 CFR 1.125(b).</p> <p>13. <input type="checkbox"/> A power of attorney and/or change of address letter.</p> <p>14. <input type="checkbox"/> A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.3 and 37 CFR 1.821-1.825 (not required if sequence listing in text format was indicated on the PCT Request as part of the International Application and the sequence listing was published as part of the international application).</p> <p>15. <input type="checkbox"/> Assignment papers (<i>cover sheet and document(s)</i>). Name of Assignee: _____</p> <p>16. <input type="checkbox"/> 37 CFR 3.73(c) Statement (<i>when there is an Assignee</i>).</p>
<p>This collection of information is required by 37 CFR 1.414 and 1.491-1.492. The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 15 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p>



Form PTO-1390 – deposit account authorization for excess claim fees

PTO-1390 (01-18)
Approved for use through 8/31/2019. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

a. A check in the amount of \$ _____ to cover the above fees is enclosed.

b. Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees.

c. The Director is hereby authorized to charge additional fees which may be required, or credit any overpayment, to Deposit Account No. _____ as follows:

i. any required fee.

ii. any required fee except for excess claims fees required under 37 CFR 1.492(d) and (e) and multiple dependent claim fee required under 37 CFR 1.492(f).

d. Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. The PTO-2038 should only be mailed or faxed to the USPTO. However, when paying the basic national fee, the PTO-2038 may NOT be faxed to the USPTO.

ADVISORY: If filing by EFS-Web, do NOT attach the PTO-2038 form as a PDF along with your EFS-Web submission. Please be advised that this is **not** recommended and by doing so your **credit card information may be displayed via PAIR**. To protect your information, it is recommended to pay fees online by using the electronic payment method.

NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

National stage entry error

- A typographical error in the international application number was made on the national stage entry papers or EFS-Web screen
- Can this mistake be corrected?
 - If the correct number appears somewhere in the original submission, applicant may correct this error by filing a petition under 37 CFR 1.182
 - If the correct number does not appear anywhere, applicant may have to file a petition to revive the international application



Miscellaneous items

- Verify the mailing address in the Box No. IV of the request is complete
 - Ensure firm name is included to avoid USPTO correspondence being returned as undeliverable
- Upload the sequence listing text file part of description with the initial submission
 - Uploading the sequence listing text file to avoid processing delays
- Clarify the purpose of a subsequently filed sequence listing text file
 - Subsequently filed sequence listing (image or text format) may change the international filing date if not received on or before the international filing date
 - Amendment is not possible before the RO/US or the ISA/US
 - Amendment is possible during Chapter II with filing of a demand for international preliminary examination or at national phase (new matter cannot be added)



Miscellaneous items (cont)

- Chapter II processing
 - Use of correct document descriptions is critical
- Exact fee not available in EFS-Web
 - Use alternative payment method



Questions?





Thank you.

Michael Neas

Deputy Director, International Patent
Legal Administration

Michael.Neas@uspto.gov

PCT Help Desk
571-272-4300
Monday-Friday 8:30 a.m. to 5 p.m. ET

www.uspto.gov