

# Training Module for Chapter 18 of the MPEP

(Revised August 16, 2018)

## Summary

### Chapter 18: Patent Cooperation Treaty

**NOTE:** The provisions of Chapter 18 have not been changed by the AIA.

#### Section 1801 – Basic Patent Cooperation Treaty (PCT) Principles

- The PCT is an international treaty administered by the World Intellectual Property Organization (WIPO) located in Geneva, Switzerland. The treaty is between 146 countries known as the Paris Convention countries and it includes the U.S.
- RECALL: A U.S. citizen who desires to file a patent application in a foreign country must obtain a license from the USPTO prior to making such a filing. Normally it takes 6 months for the USPTO to review a new patent application for possible national security implications and to issue a license for foreign filing if there are no security issues.
- Once such a license has been obtained, the applicant can file internationally under the PCT and receive priority to the U.S. filing date if the international filing is done within 12 months of that date.
- NOTE: Although use of the PCT for foreign filing is not the only way, it generally thought to be the simpler, easier and most cost effective than filing in individual foreign countries one-by-one.

[The main benefits are that a single search can be conducted for all countries and only a single publication is required.]

- However, after the applicant has satisfied all of the PCT requirements, he must deal directly with the foreign countries in which patent coverage is

required. This step is called the “national stage”.

- Generally, a U.S. applicant can file a single application (called a “international application”) with the USPTO (called the “Receiving Office”) and have that application acknowledged as a regular national or regional filing in as many Contracting States (countries) to the PCT as the applicant “designates” or “elects”.
- In a similar manner, foreign applicants can file international applications designating the U.S. in their home language and in their home “Receiving Office” and have the application acknowledged as a regular U.S. national filing.
- The filing, search, and publication procedures are provided for in Chapter I of the PCT.

[An optional preliminary examination covered in Chapter II of the PCT may also be requested.]

- Typically, an applicant will choose Chapter I for filing, search, and publication and then go directly to the “national stage” leaving examination up to the patent office in each elected country.
- International applications must contain the designation of at least one Contracting State in which patent protection is desired and must meet certain standards for completeness and formality.
- If no priority claim is made at the time an international filing is made, the priority date is the international filing date.
- Within 13 months after international filing, the Receiving Office prepares and transmits a copy of the international application (called the “search copy”) to the International Searching Authority (ISA) and forwards the original application to the International Bureau (IB).
- Once the ISA receives the search copy of the application, it becomes the focus of international processing. The ISA issues an international search report (ISR) and written opinion in about 3 months from receipt of the search copy (about 16 months after the filing date).

- Once the ISA transmits a copy of the search report and written opinion to the IB, the focus of international processing shifts to the IB.
- The IB maintains master files for all international applications and acts as the publisher and central coordinating body under the PCT.
- The IB normally publishes the international application along with the ISR and any amended claims at the expiration of 18 months from the priority date. [So that the timing for international publishing aligns with the USPTO's timing.]
- After the above PCT procedures, the applicant may pursue protection directly before the national (or regional) patent offices of the countries that were designated. That is, the applicant enters the “national stage”.
- In most countries, the applicant must complete all requirements for entering the national stage within 30 months from the priority date to avoid any question of withdrawal of the application. (Some countries provide latitude beyond 30 months.)

## 1810 Filing Date Requirements

- An all too common occurrence is that applicants will file an international application in the U.S. Receiving Office and no applicant has a U.S. residence or nationality. Applicants are cautioned to be sure that at least one applicant is a resident or national of the U.S. before filing in the U.S. Receiving Office. Where no applicant indicated on the request papers is a resident or national of the United States, the USPTO is not a competent receiving Office for the international application under PCT Rule 19.1(a). Nonetheless, the date the international application was filed in the USPTO will not be lost as a filing date for the international application if at least one applicant is a resident or national of any PCT Contracting State. The USPTO will receive the application on behalf of the International Bureau as receiving Office and, upon payment of a fee equal to the transmittal fee, the USPTO will promptly transmit the international application to the International Bureau.

## Selected Questions and Answers for Chapter 18

### Question 18-1 (Oct03pm-15a)

Applicant filed an international patent application under the Patent Cooperation Treaty (PCT) designating the United States. A copy of the international application has not been submitted to the USPTO by the International Bureau. The deadline for entering the national stage under 35 USC 371(c) was August 15, 2017. Applicant submitted all of the national stage items required by 35 USC 371(c) by facsimile transmission on August 15, 2017. The facsimile transmission was successfully received by the USPTO on August 15, 2017. The submission included an authorization to charge any required fees to the valid deposit account of the registered practitioner representing applicant. The account contained sufficient funds. Assuming that applicant has made no other national stage submissions under 35 USC 371(c), which of the following statements is most correctly describes why the national stage submission in accordance with the patent laws, rules and the procedures as related in the MPEP is proper or improper?

- (A) The national stage submission was proper because facsimile transmission is a valid method of correspondence in the USPTO.
- (B) The national stage submission was proper because a copy of an originally executed oath or declaration is acceptable, but the original oath or declaration should be retained as evidence of authenticity.
- (C) The national stage submission was improper because a copy of the international application and the basic national fee necessary to enter the national stage as required by 35 USC 371(c) may not be submitted by facsimile transmission.
- (D) The national stage submission was improper because the USPTO does not accept fee payments via facsimile transmission.
- (E) The national stage submission was improper because facsimile transmission may never be used for PCT applications.

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ANSWER: (C) is the most correct answer. 37 §§ CFR 1.6(d)(3); 1.8(a)(2)(i)(F); 1.495(b); MPEP § 1893.01(a)(1), 2nd paragraph. The filing of the copy of the international application and the basic national fee in order to avoid abandonment under 37 CFR § 1.495(b), as appropriate, may not be transmitted by facsimile. See 37 CFR § 1.6(d)(3) and 37 CFR § 1.8(a)(2)(i)(F). (A) is not the most correct answer because facsimile transmission is not permitted in the situations set forth in 37 CFR § 1.6(d). (B) is not the most correct answer because even though an oath or declaration may be submitted by facsimile transmission as set forth in MPEP § 602, the national stage submission was improper for the reasons discussed in (C). (D) is not the most correct answer because (C) is the most complete answer. Facsimile transmissions may not be used to file a copy of the international application necessary to enter the national stage.

(E) is not the most correct answer because facsimile transmission may be used to file certain correspondence in PCT applications. See MPEP § 1805.

### Question 18-2 (oct03pm-39a)

An international application is filed in the United States Receiving Office on September 18, 2017. In accordance with the PCT and USPTO rules and the procedures set forth in the MPEP, which of the following will result in the application not being accorded an international filing date of September 18, 2017?

- (A) The description and claims are in German.
- (B) The Request is signed by a registered attorney rather than the applicant.
- (C) The sole applicant is a Canadian resident and national.
- (D) The application does not contain a claim.
- (E) The application is not accompanied by any fees.

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ANSWER: The correct answer is (D). PCT Article 11(1)(iii)(e); 35 U.S.C. § 363; 37 CFR § 1.431(a); MPEP § 1810. Under PCT Article 11(1)(iii)(e) to be accorded an international filing date an application must have “a part which on the face of it appears to be a description or claims.” (A) and (C) are incorrect. Under PCT Rule 19.4 if an application is not filed in the prescribed language or is filed by an applicant for which the Office to which the application is submitted is not competent, such application will be forwarded to the International Bureau which will act as receiving Office and accord a filing date as of the date of receipt in the USPTO. (B) is not correct. The Request may be signed by an attorney or agent who is registered to practice before the USPTO. In such a situation the application will be accorded an international filing date of September 18, 2002, and under PCT Article 14 an invitation to correct the defect will be mailed. See MPEP § 1805, paragraph 7; MPEP 1810, under the heading “The ‘International Filing Date,’” second paragraph. (E) is also incorrect. Under PCT Rules 14.1(c), 15.4(a), 16.1(f), and 16bis.1 the fees may be paid at a date later than the original receipt date.

## In-Depth Review of Chapter 18

Chapter 18 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is

recommended that you quickly scan through most of the chapter - while reading only those sections that are **highlighted in yellow**.

## [Chapter 18, MPEP](#)