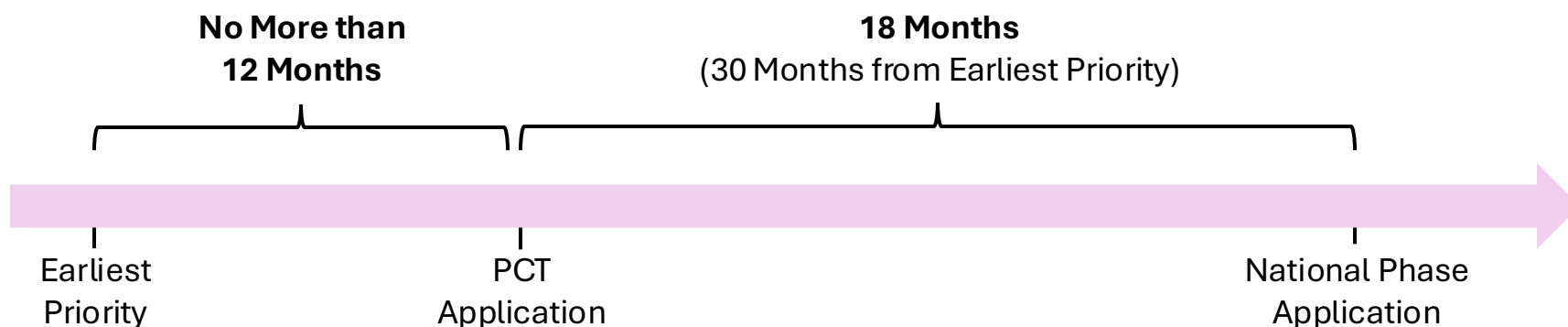


Patent Cooperation Treaty (PCT)



PCT Applications (MPEP 1800)

Basics: Application to maintain rights in member countries for 18 months (30 months from priority date)

(Can be thought of as a process rather than an application)

International Phase followed by **National Phase**

What: (1) A Request

(2) Designation of at least one contracting state

(3) Name of the applicant

(4) Specification, Claim and drawing

(5) Abstract

(6) Fee

When: (1)-(4) required at time of filing, (5) and (6) can be late

Steps: 1. Filing of the PCT app, processing by receiving office

2. International Search Report by ISA (Search Auth.)

3. Preliminary written opinion on patentability

4. Publication of application with ISR

5. *(Optional)* International Preliminary Examination

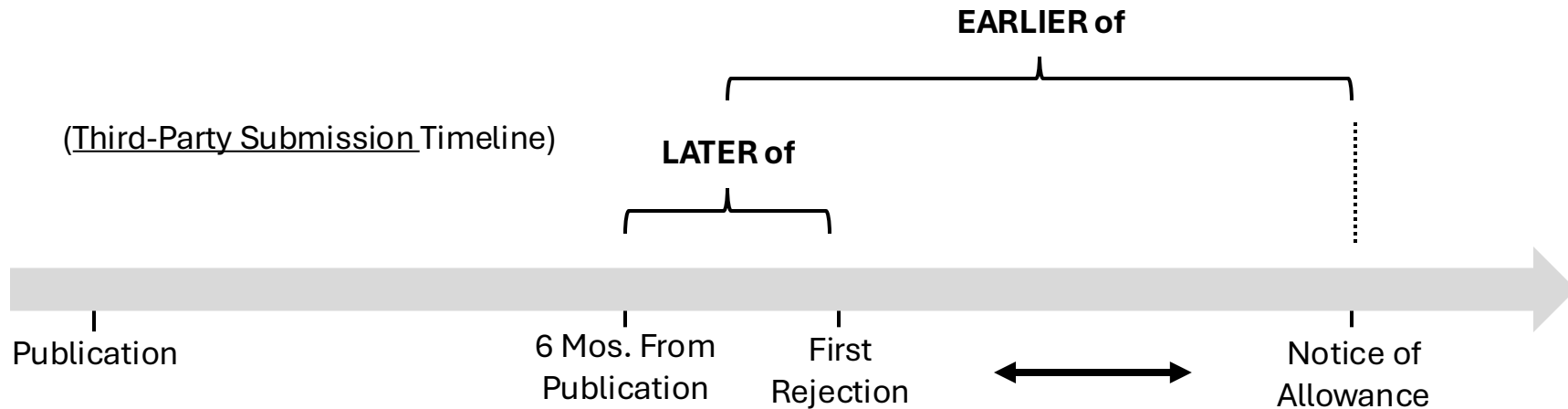
Timing: ISR at ~16 months from priority (4 Mos. From PCT),

Publication at ~18 months from priority (6 Mos. From PCT)

Brightline Points

- All time limits in PCT are calculated upon the priority date, so the priority claim is very important
 - A certified copy of the priority application must be submitted by 16 months from priority date (~4 months from PCT)
- Claim for priority to US application must be within 1 year of filing date of the US application
- Priority claim cannot be late!
- International applications are not subject to restriction procedures, and instead must adhere to 'Unity of Invention' requirement
 - More than one invention doesn't mean defective app, but may require more fees for searching if desired, etc.
- There is an optional chance to make amendments following the International Search Report under Article 19 or Article 34
- In order to enter the national phase in the US, need the following by the end of the 30th month from the priority date
 - 1. Copy of the international application
 - 2. National filing fee
 - These cannot be late (Oath and Translation can with a fee)
 - Other countries may have different deadlines (i.e. 31 months)

Protests and Third Party Submissions



Protests (MPEP 1900) and Third-Party Submissions (MPEP 1100)

Protests: Typically reserve for lookup (MPEP 1900 is short, and questions are rare)

Basics: Anyone can file a Protest, and attorney can file without naming client, but must be served on applicant

What: (1) copies of references, (2) a listing of the references, (3) Translations of non-English refs, and (4) a concise explanation of relevance

Amazingly, no fee is required unless the second protest!!

Third-Party Submissions: MPEP 1100

Summary: Method for interested parties to submit patents, published apps, or printed pubs of potential relevance

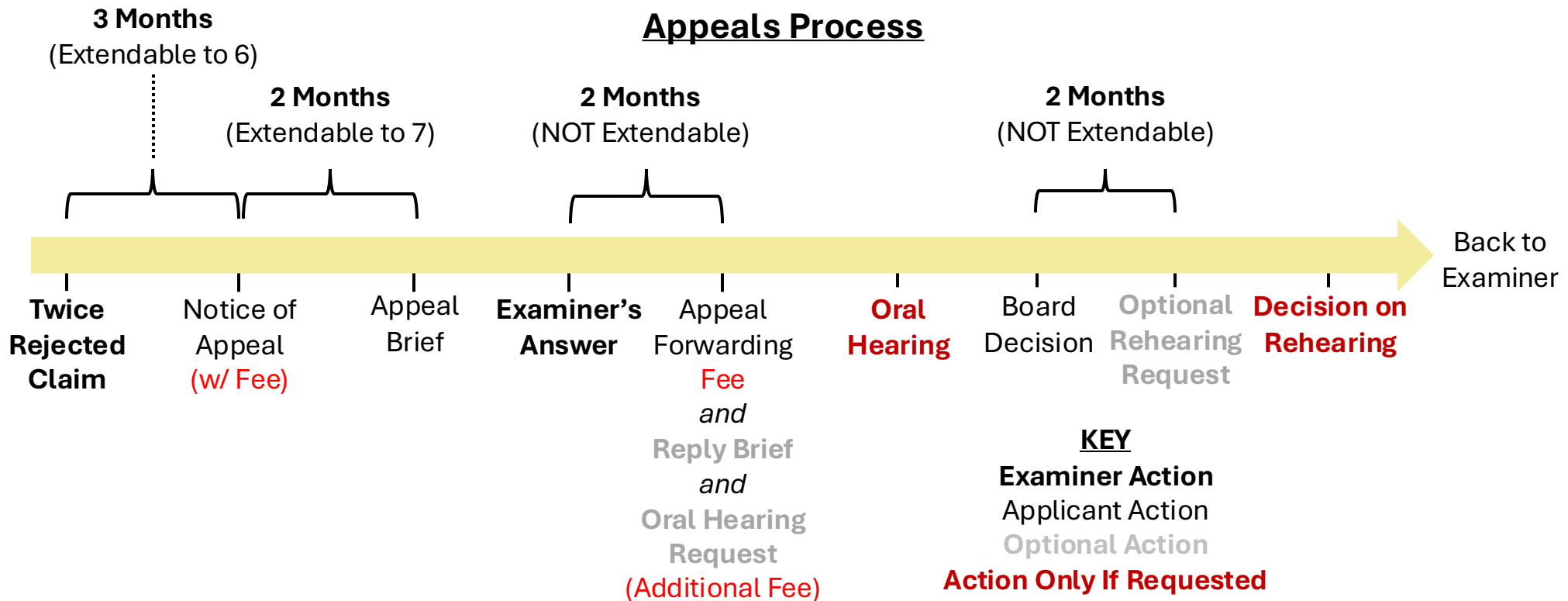
What: (1) Concise description of relevance of each ref
(2) Submitted within a statutory time period
(3) Statement submission complies with statute
(4) Fee

When: Must be filed prior to the EARLIER of:

- (1) Date of a Notice of Allowance or
- (2) The LATER of:
 - (i) Six months from publication
 - (ii) Date of first rejection

Brightline Points – Third-Party Submissions

- Third-party submissions can be made in any non-provisional utility, design, and plant app (*including continuing applications*)
- Timing is important, so study the deadline rules carefully
 - Complicated, but explicitly laid out
 - Must be **received** by the office by the day **before** critical date
- Cannot submit third-party submissions by Fax!
- Concise description is a statement of facts regarding the submitted evidence and will not, itself, be treated as evidence
 - Cannot contain opinions, proposed rejections, etc
- Non-compliant submissions will not necessarily be entered and may not be amended
 - Instead, submitter may submit a new one that is compliant
- Compliance depends on both 35 U.S.C. 122(e) and 1.290
 - Not compliant with 122(e) will not be entered, but compliant with that and not with 1.290 might be
- USPTO will not notify a third-party submitter whether their submission was entered into the record, but will tell you if it was received by the office
 - For paper filing, may include a self-addressed postcard to receive acknowledgement that it was received



Ex Parte Appeals (MPEP 1200)

Standard: Twice rejected claim (not necessarily final)

Who: Applicant/Patent Owner

What: (1) Notice of Appeal
(2) Required Fee

When: Anytime during lifetime of patent

Between: Patent Trials and Appeals Board (PTAB)

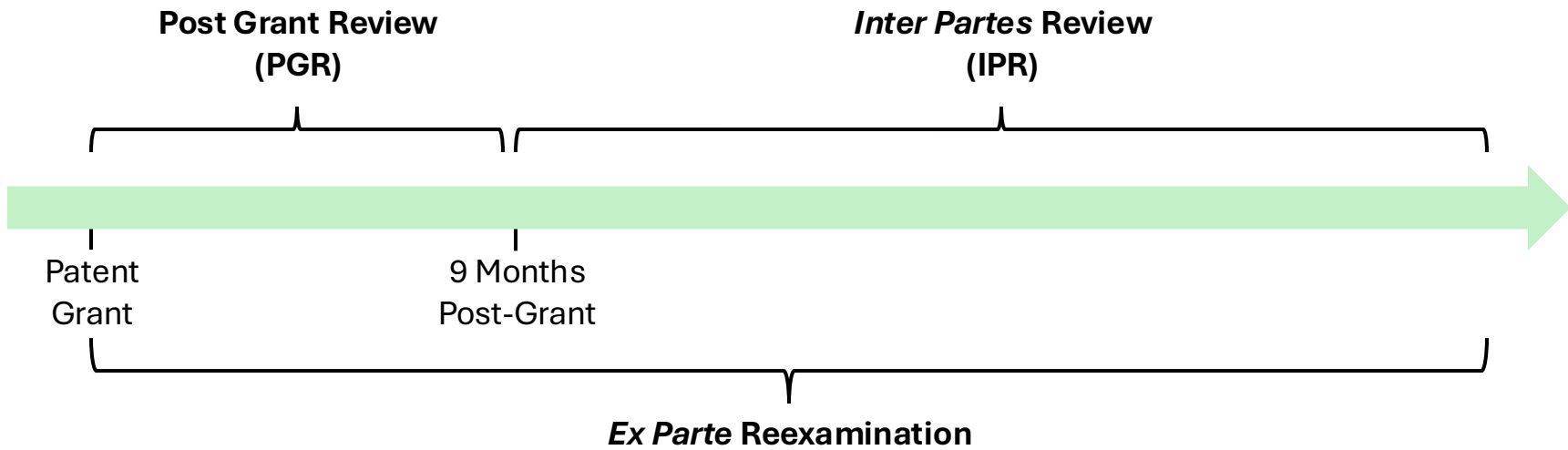
Scope: PTAB reviews claims as grouped by applicant in the Appeal Brief

Result: Decision on Appeal and return to Examiner for Allowance or Abandonment

Brightline Points

- After the Notice of Appeal, deadlines are 2 months
 - Deadlines after the Appeal Brief are NOT extendable
- PTAB only needs to consider claims on the merits that are argued in Appeal Brief
 - NOT the Examiner's response
- Oral Hearing and Rehearing Requests are optional
- Claims not in condition for allowance after Appeal will not be allowed
 - This includes claims that were only objected to
 - Also includes claims that would otherwise be allowable except being dependent on those that are not
- If PTAB finds new grounds of rejection, the applicant should either
 - Reopen prosecution, or
 - Request a rehearing, or
 - File an RCE (in which case the board decision is the law of the case)

Post Grant Proceedings



Ex Parte Reexamination

Standard: Substantial new question of patentability (Lowest)

Who: Anyone, even Patent Owner (PO)

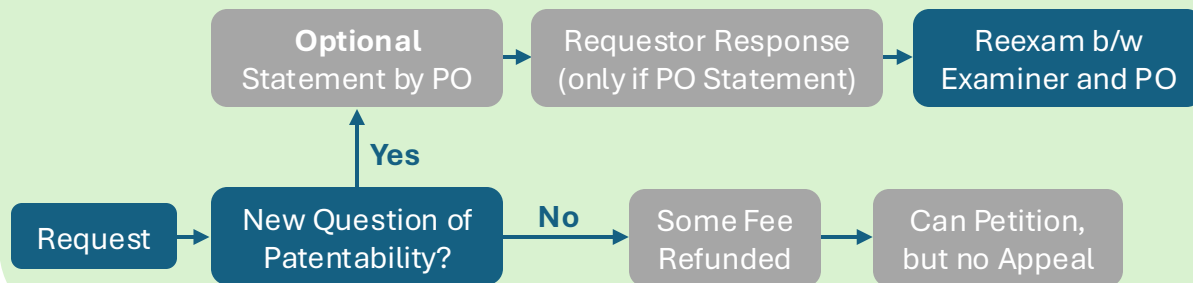
What: (1) Statement w/ each question of patentability,
 (2) Every claim where reexam is sought (+explanation),
 (3) Copy of every Patent/Publication relied on,
 (4) Copy of Specification and Claims (2 columns, 1-sided)
 (5) Certificate it's been served on PO (if not requested by PO)
**Fee can be late, but request date is when fee is received*

When: Anytime during lifetime of patent

Between: Examiner and Patent Owner (PO) – **Requestor cannot participate!**

Scope: Patents and printed publications, and cannot broaden claim scope

Result: Reexamination Certificate



Post Grant Review (PGR)

Standard: Success over one claim is “more likely than not” (Highest)

Who: Challenger, who has to identify themselves and any parties of interest

When: First 9 months

Between: PTAB
(Challenger participates)

Scope: All statutory challenges *(widest scope)*

Inter Partes Review (IPR)

Standard: “Reasonable likelihood” of success over one claim (Medium)

Who: Challenger, who has to identify themselves and any parties of interest

When: After 9 months (and within 12 months of a notice of infringement)

Between: PTAB
(Challenger participates)

Scope: Limited to patents or publications for 102/103 questions