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PCT National Stage vs. Paris Convention

Overview: For an international application under the Patent Cooperation Treaty (PCT), an applicant has 30 months from the international filing date to file a national stage application in the U.S. Alternatively, the applicant can directly file the application with the USPTO as a “bypass continuation” application. As will be discussed below, each option has its own unique set of advantages and disadvantages.

U.S. National Stage Application	Bypass Continuation Application
File the application with the PCT U.S. Designated Office/Elected Office (US DO/EO) at the USPTO under 35 U.S.C. 371.	File the application directly with the USPTO under 35 U.S.C. 111.
Standard large entity filing fee: \$1,580. Practice Point: The cost savings over a “bypass continuation” is often consumed by the cost of attorney fees for a preliminary claim amendment and/or a substitute specification.	Standard large entity filing fee: \$1,720.
Filing fee due at time of filing.	Filing fee not due at time of filing; must be paid two months after issuance of a Notice to File Missing Parts. Extensions of time are available beyond the two-month response period.
The national stage application is considered the same as the international application, so the U.S. filing date = the international filing date.	The application is considered as a continuation of the international application under U.S. rules.
Remedy for unintentionally missing 30-month priority deadline? YES (under PTLIA of 2012).	Remedy for unintentionally missing 30-month priority deadline? NO.
Processing and examination are subject to Patent Cooperation Treaty rules.	Processing and examination are subject to USPTO national rules.
Application must be a literal translation of the international application.	Application may be revised prior to filing; does not need to be a literal translation, although priority may be claimed only to the subject matter that is supported in the underlying international application.
Amendments to the claims and specification must be entered at either the international stage or through preliminary amendment prior to examination.	Amendments may be made to the claims and specification prior to filing. For example, applicant can incorporate any Article 19 or 34 amendments directly into the claims without the need for a preliminary amendment.

<i>U.S. National Stage Application</i>	<i>Bypass Continuation Application</i>
<p>Express examination must be requested; otherwise, processing of the application will not occur until after the 30-month deadline. Even if express examination is requested, an official filing receipt may not be generated for 3-6 months, or longer, from the filing date. Practice Point: Based on our communications with the PCT Legal Department at the USPTO, this is due largely to the high number of applications filed with the US DO/EO and understaffing at PCT Legal.</p>	<p>Processing occurs shortly after the application is filed; official filing receipt is generated usually within 2-3 weeks of filing.</p>
<p>Target time to issuance of a first Office Action: 14 months. According to PCT Legal, any delay due to initial processing should not affect this time frame. Practice Point: In our experience, the processing delay typically leads to a delay in issuance of the first Office Action.</p>	<p>Target time to issuance of a first Office Action: 14 months.</p>
<p>Claims subject to PCT unity of invention practice. In theory, this practice is more liberal than restriction practice and should provide an applicant with a better opportunity to have all claims examined together without the need to file one or more divisional applications. Practice Point: We have found that most examiners do not understand the difference between unity of invention practice and U.S. restriction practice. As U.S. examiners are provided with broad discretion with these matters, it is time-consuming and expensive to file a petition to rebut an examiner's improper decision regarding unity of invention.</p>	<p>Claims subject to U.S. restriction practice.</p>
<p>File inventor declaration before filing Request for Continued Examination? YES; all requirements under 35 U.S.C. 371 must be met, or application will go abandoned.</p>	<p>File inventor declaration before filing Request for Continued Examination? NO; file declaration before payment of issue fee.</p>

Takeaways

- A bypass continuation affords foreign applicants more flexibility with, and control over, claim and specification format and content. This in turn enables foreign applicants to reduce the initial filing costs associated with U.S. attorneys' time for preparing preliminary amendments and substitute specifications in national stage applications.
- Initial processing of a bypass continuation is more streamlined than for a national stage application; this typically results in a bypass continuation emerging from pre-examination processing earlier, and thus being added to an examiner's docket faster, than a national stage application.
- A bypass continuation provides an applicant with (1) the maximum time afforded by a PCT international application for foreign filing decisions, and (2) the new application pre-examination processing efficiency afforded by the USPTO versus PCT Legal.

For further details or questions, please contact David Posz at Posz Law Group (dposz@poszlaw.com)