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DIFFERENT MEANS FOR ENTERING THE USPTO FROM PCT

Practical Tip to non-US Applicants

When entering the USPTO from a PCT application, evaluate the condition of the application and any strategic amendments/additions that are anticipated. Consider the benefits of 371 national stage entry or 111(a) by-pass continuation application.

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27 July 2010

Many patent attorneys are unaware that the 35 USC 371 (“national-stage entry”) is not the only means for entering the USPTO from a PCT application. The 35 USC 111(a) (“by-pass route”) is also available with the same benefits of foreign priority and may provide advantages over the national-stage option.

For example, if the PCT application is not in English, the national-stage entry requires a literal translation while the by-pass route translation can be clarified for readability. Also, at the time of filing, the national-phase entry prohibits additional subject matter beyond the international application disclosure. The by-pass route, however, provides the opportunity to add disclosure through a Continuation-in-Part application.

Further, multiple dependent claims incur large fees in the USPTO and the national-stage application requires a separate preliminary amendment for their removal. The by-pass route, however, allows the applicant to file a single clean document with claims in amended form.

Additionally, while the national-stage entry requires application fees to be paid in full at the 30 month mark, the by-pass route allows the applicant to pay the filing fee with an extension of time.

And, if the inventive entity requires correction from the PCT application, the national-stage entry demands a processing fee and a statement from each person being added or deleted. When using the by-pass route, however, no such fee or statements are required.

Alternatively to the above by-pass benefits, national-stage entry applications simply require the applicant to provide an indication of national-stage entry, the requisite fees and any required English translation. The by-pass route, on the other hand, requires submission of a complete application with formal drawings as well as certified copies of all foreign priority documents. And, US restriction practice applies to by-pass applications while the broader unity-of-invention standard applies to national-stage entry applications.

Considering the above, consider the circumstances of the application’s entry into the USPTO and seek help from a foreign associate.

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