

# PATENT LAW

Tim Clise

CLASS 13

**International Prosecution;  
Post Grant Procedures**

## International Prosecution

- How are patents obtained in other countries?
- What treaties enable foreign counterpart patent applications?
- What parts of US Patent Laws affect?
- What issues exist relative to priority?
- How do we use treaty procedures?

2

## International Prosecution

### "Foreign Patents"

International Patent Procedures

International Patent Treaties

European Patent Procedures

International - Problem & Solution

Questions of Priority

Comparisons with US Law

3

## Why Seek Foreign Patents?

- US enterprises wish to sell or export or license in selected other countries or that do or wish to do business globally.
- Patents as business tools
- Entities in foreign countries seek US patents for the same reasons.
- We are all increasingly part of global economy - and so we file "foreign" applications to improve our position in global economy.

4

## What is meant by filing "foreigns?"

- What is meant by filing "foreigns" is initiating (filing) analogous patent applications in countries or treaty region
- Foreign to USA according to the patent laws and procedures in that country or countries or treaty region for purposes of obtaining patent protection there.

5

## In what countries or treaty regions do we seek patents?

- Business Justification:
  - Actual or prospective commercial activities
    - Distribution, Sale or Licensing by patent owner or licensee
    - Manufacturing location
    - Competitor location
- Where it is practical and affordable to do so.
- Can afford costs: foreign atty. services & govt. fees for filing, prosecution, annuities, grant fees, & translations to/from other languages.

6

## "Uncle Sam" may I?

- May you simply take your invention to a patent attorney in another country, and ask that a patent country be filed?
- Must not export w/o an export license. To do so, filing would run afoul of the export laws and export rules administered by US Commerce Department.

7

### If patent application filed w/o permission?

- Violation of such laws is federal offense. So . . .
- Before sending a patent application to another country you will need an EXPORT LICENSE, which takes the form of a FOREIGN FILING LICENSE.
- How is it obtained?

8

### If no U.S. patent application is on file

- If no corresponding national or international patent application has been filed, must petition USPTO Trademark Office for a foreign filing license. Difficult?
- Not difficult. Requires that . . .

9

### If no U.S. patent application is on file

- Patent lawyer submits petition together with legible copy of material upon which a license is desired; then:
- When export license is granted (weeks or months), copy of material submitted represents scope of the information which can be the subject of a foreign patent application.

10

### But If U.S. patent application already is on file

- US patent application is used as a basis for filing for corresponding patent rights in a foreign country, because:
- US patent application is treated as a petition for the granting of a foreign filing license, which is usually granted. And...
- International treaty application (PCT) filing in USRO of USPTO also possible.

11

### When U.S. patent application already is on file

US provisional or non-provisional (utility) patent application is used as a basis for filing for corresponding patent rights in a foreign country, priority can be obtained under the Paris Convention (dating from 1883) which accords to the US applicant priority of the US application for one year (6 mo. for design appls.)

12

### U.S. as Foreign Destination

- Other countries have Foreign Filing restrictions as well
  - China
  - India
  - Singapore

13

## U.S. as Foreign Destination

- 2015 : 301,075 (51.1%)
- 1990 : 73,915 (44.9%)



14

## Modern Treaties for International Filing

In addition to The Paris Convention over last few decades, international treaties have streamlined and made more economical procedures for seeking protection in many parts of the world. USA has signed, acceded to, or ratified many treaties

15

## Some International IP Treaties

- The Paris Convention
- European Patent Convention (EPC)
- Others treaties for regional patent rights
- Trade-Related Aspects of Intellectual Property (TRIPS) Rights
  - patent term 20 yrs. from filing everywhere
- WIPO
  - Patent Cooperation Treaty (PCT)
  - Madrid Protocol Trademarks
  - Hague Agreement – Industrial Design

16

## Paris Convention

- Effect is one of giving priority.
- Allows applicant(s) to file in U.S. or other home country signatory to treaty.
- Provides a priority effect of 12 months (6 mo. for designs) in which to file corresponding application elsewhere equivalent to national filing.
- Based on whole content of application.

17

## Paris Convention Article 4, Section A

1. Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

18

## Paris Convention Article 4, Section A

2. Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

19

### Paris Convention Article 4, Section B

. . . [A]ny subsequent filing in any of the other countries of the Union before the expiration of the [above] periods shall not be invalidated by reason of any action accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sales of copies . . .

20

### Paris Convention Article 4, Section C

- **C.-**
  - (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.
  - (2) . . . periods . . . start from the date of filing [the] first application; the day of filing [is] not included...

21

### Paris Convention Article 4, Section C

- C.-**
  - (3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

22

### Paris Convention Article 4, Section C

- C.-**
  - (4) A subsequent application concerning the same subject as a previous first application . . . filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority., [cont'd]

23

### Paris Convention Article 4, Section C

- C. (4)[cont'd]**

if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

24

## Modern Treaties

### Treaties signed by USA specifically related to patents:

- **Patent Cooperation Treaty (PCT)**
- **European Patent Convention (EPC)**
- **Other treaties relating to regional rights**
- **TRIPS** (WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights)
- **WIPO**
- Taiwan (1996), became member of WIPO in 2002

25

## Patent Cooperation Treaty

- Basics:
- One application for 151 countries
- Compliance with form in PCT is a valid filing in all 151 countries
- Own language – delay translation fee
- Optional Search Report – decide if and where to apply for patent

26

## PCT Countries



27

## PCT Countries

Added in 2016



28

## PCT Countries

• AE	United Arab Emirates	• GA	Gabon
• AG	Antigua and Barbuda	• GB	United Kingdom
• AL	Albania	• GD	Grenada
• AM	Armenia	• GE	Georgia
• AO	Angola	• GH	Ghana
• AT	Austria	• GM	Gambia
• AU	Australia	• GN	Guinea
• AZ	Azerbaijan	• GQ	Equatorial Guinea
• BA	Bosnia and Herzegovina	• GR	Greece
• BB	Barbados	• GT	Guatemala
• BE	Belgium	• GW	Guinea-Bissau
• BF	Burkina Faso	• HK	Hong Kong
• BG	Bulgaria	• HR	Croatia
• BH	Bahrain	• HU	Hungary
• BJ	Benin	• ID	Indonesia
• BN	Brunei Darussalam	• IE	Ireland
• BO	Bolivia	• IL	Israel
• BR	Brazil	• IN	India
• BS	Bahamas	• IR	Iran (Islamic Republic of)
• BT	Bhutan	• IS	Iceland
• CA	Canada	• IT	Italy
• CC	Cocos (Keeling) Islands	• JP	Japan
• CD	Congo	• KE	Kenya
• CF	Central African Republic	• KG	Kyrgyzstan
• CG	Congo	• KH	Korea
• CH	Switzerland	• KI	Kiribati
• CI	Cote d'Ivoire	• KM	Comoros
• CL	Chile	• KN	Saint Kitts and Nevis
• CM	Cameroon	• KP	Democratic People's Republic of Korea
• CN	China	• KR	Republic of Korea
• CO	Colombia	• KW	Kuwait
• CR	Costa Rica	• KZ	Kazakhstan
• CU	Cuba	• LA	Laos
• CY	Cyprus	• LB	Lebanon
• CZ	Czechia	• LC	Liechtenstein
• DE	Germany	• LI	Liechtenstein
• DG	Dominican Republic	• LK	Sri Lanka
• DK	Denmark	• LR	Liberia
• DM	Dominica	• LS	Lesotho
• DO	Dominican Republic	• LU	Luxembourg
• DZ	Algeria	• LV	Latvia
• EC	Ecuador	• LY	Libya
• EE	Estonia		
• EG	Egypt		
• ES	Spain		
• FI	Finland		
• FR	France		

29

## PCT Countries

• MA	Morocco	• TD	Chad
• MC	Monaco	• TG	Togo
• MD	Republic of Moldova	• TJ	Tajikistan
• ME	Montenegro	• TK	Turkmenistan
• MG	Madagascar	• TL	Turkey
• MK	The Former Yugoslav Republic of Macedonia	• TN	Tunisia
• ML	Mali	• TR	Turkey
• MN	Mongolia	• TT	Trinidad and Tobago
• MR	Mauritania	• TZ	Tanzania
• MT	Malta	• UA	Ukraine
• MU	Mauritius	• UG	Uganda
• MV	Maldives	• US	United States of America
• MW	Malawi	• UZ	Uzbekistan
• MY	Malaysia	• VC	Saint Vincent and the Grenadines
• MZ	Mozambique	• VE	Venezuela
• NA	Namibia	• VN	Viet Nam
• NE	Niger	• ZA	South Africa
• NG	Nigeria	• ZW	Zimbabwe
• NI	Nicaragua		
• NL	Netherlands		
• NO	Norway		
• NZ	New Zealand		
• OM	Oman		
• PA	Panama		
• PE	Peru		
• PG	Papua New Guinea		
• PH	Philippines		
• PL	Poland		
• PT	Portugal		
• QA	Qatar		
• RO	Romania		
• RS	Serbia		
• RU	Russian Federation		
• SC	Seychelles		
• SD	Saudi Arabia		
• SG	Singapore		
• SI	Slovenia		
• SK	Slovakia		
• SL	Sierra Leone		
• SM	San Marino		
• SN	Senegal		
• ST	Sao Tome and Principe		
• SV	El Salvador		
• SY	Syrian Arab Republic		
• SZ	Switzerland		

30

## Some Non-PCT Countries

- Afghanistan
- Argentina
- Bahamas
- Bangladesh
- Bhutan
- Bolivia
- Burma
- Cambodia (until December 2016)
- Ethiopia
- Eritrea
- Fiji
- Guyana
- Holy See
- Jamaica
- Pakistan
- Palestinian Territory
- Paraguay
- Samoa
- Suriname
- Somalia
- Taiwan (wants to join)
- Tonga
- Uruguay
- Yemen
- Venezuela

31

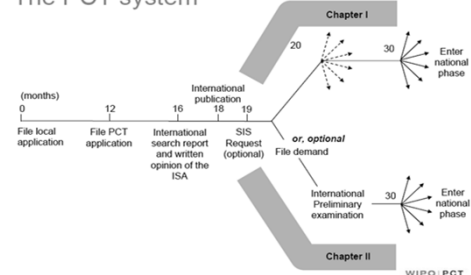
## PCT Costs

- If your client/company needs an estimate of costs, an estimate may be generated using the Global IP Estimator
  - Filing fees (est.): \$4K - \$7K
  - Prosecution costs (est.): \$2K - \$7K

32

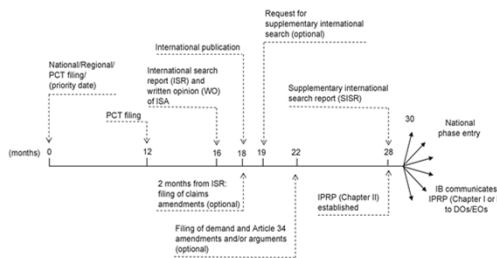
## PCT Flow

The PCT system



33

## PCT Flow Redux PCT TIMELINE



34

## PCT Flow Redux (bis)

- Paris Convention – Can file PCT within 12 months of national filing
- Article 19 claim amendments – change claims for publication, provisional rights
- Demand/Art. 34 Amendments – argue / amend against ISR/WO

35

## Priority under PCT

- Priority under the PCT is governed by the Paris Convention
- Same rights in that country if filed within 12 months of priority application
- [http://www.uspto.gov/web/offices/pac/mpep/documents/appxp\\_4.htm#parart4](http://www.uspto.gov/web/offices/pac/mpep/documents/appxp_4.htm#parart4)

36

## File PCT – Receiving Office

- - the national Office of any Contracting State willing to assume this responsibility
- - the regional Office acting for one or more Contracting States, with their consent
- the International Bureau (IB)
- For us = USPTO or IB
- Determined by anyone of the applicants' nationalities or residence (No US applicant/inventor, then can NOT file with USPTO as receiving office)

37

## Receiving Office Duties

- 1. Specifies the international authority competent to carry out search and examination
- 2. Checks:
  - - whether it is competent
  - - the filing papers and application
  - - whether fees are paid
  - - whether certain time limits are complied with
- -- receives and directs correspondence from the applicant to offices and authorities
- -- collects fees and transfers some of them to the ISA and the International Bureau (IB)

38

## Receiving Office

- App must include:
  1. Indication that app is international app
  2. Request of designation of countries
  3. Name of Applicant
  4. Description
  5. Claim
- App need not include:
  1. Fees
  2. Translation
  3. Applicant's signature
  4. Title
  5. Abstract
  6. Drawings

39

## Receiving Office

- Failure to comply with formal requirements will result in request by receiving office to correct, e.g., informal drawings. Any reply must be filed with receiving office (USPTO – Mail Stop PCT or IB – in Geneva)

40

## Receiving Office

- Filed with wrong RO?
- RO will forward to International Bureau (IB)
  - meet priority deadline?
  - timely paid fees?
    - wrong RO keeps transmittal fee
    - USPTO refunds the other fees
    - Must pay fees to IB within one month (Rule 16*bis*)

41

## International Search Authority

- USA applicants can choose:
  - USPTO \$2,800\* (\$300 if prior US search)
  - EPO \$2,097
  - Australian Patent Office \$1,674
  - Singapore IPO \$1,578
  - Japanese Patent Office \$1,530
  - Israel Patent Office \$912
  - Russia IP Office \$420
  - Korea Patent Office \$232

42

## Claims

- Added Subject Matter Problems
- Include multiple dependent claims
- Include a “means” claim
  - term “means” is broadest protection in Europe
- Two part form not required

43



## Specification

- Consider removing US boilerplate to reduce excess page fees and translation costs
- Incorporate by reference priority document or co-pending US application with boilerplate if you believe you may nationalize the PCT application back into the US
- OK to incorporate by reference if you are doing so for the US ONLY. No effect for other countries

44




## Article 19 Amendments

- What? Claim Amendment(s) Only; No Argument or Comment
- When? Within 16 months from priority date or 2 months after mailing of International Search Report/ Written Opinion\*
- How? File claim amendments with the International Bureau as substitute pages with statement describing the change to each claim
- Why? Publish with better claims for damages. Claims in better form for national stages.

45

## Demand

- Countries that still require demand:

-  Luxembourg,
-  Uganda,
-  United Republic of Tanzania

- However, can enter each country through regional patent application (EPO) and ARIPO)

46

## Demand/Article 34 Amendments

- What? Your Chance to respond to the International Search Report/Written Opinion
- When? Later of three months from the date of the international search report and the written opinion or 22 months from the priority date
- How? File directly with International Preliminary Examining Authority (IPEA) – USPTO or EPO (or other ISA)
- Why? Applicant's chance to refute the rejection of the claims by the International Search Authority

47

## PCT also allows designation of regional procedures

- European (EPC) Patent  
<http://www.european-patent-office.org/>
- Eurasian Patent  
<http://www.piperpat.co.nz/europe/ea.html>
- ARIPO Patent (African Regional Industrial Property Association)  
<http://www.aripo.wipo.net/>
- OAPI Patent (Organisation Africaine de la Propriété Intellectuelle)  
<http://www.qpa.co.za/english/africa/oapi.htm>

48

## PCT - national stage

- Ultimately, every PCT Application must proceed to "National Phase" prosecution in designated countries desired by procedures initiated by the end of 20 months (30 or 31 months in some countries)
- from filing date of priority application,
- such as U.S. provisional or non-provisional patent application.

49

## PCT - national stage

- National stage prosecution is necessary for perfection of patent rights in the respective designated state.
- Applicant must be careful in choosing countries for national stage.
- Highly variable in complexity and cost.
- Legal services and governmental fees and translations can be costly. These can exceed the costs in the US for each country

50

## Modern Treaties for International Filing

### Treaties signed by USA specifically related to patents:

- Patent Cooperation Treaty (PCT)
- European Patent Convention (EPC)
- Other treaties relating to regional rights
  - TRIPs
  - WIPO
  - Hague (industrial designs)

51

## EPC - European Patent Convention

- The European patent system was established by the European Patent Convention (EPC)
- European Patent Office (EPO) administers EPC procedures
- Not the European Union

52

## EPC - European Patent Convention

- Provides patent protection in 42 European countries on the basis of a single patent application and a single grant procedure. "All eggs in 1 basket."



53

## EPC States

- |  |   |
|--|---|
| <ul style="list-style-type: none"><li>• Belgium</li><li>• Germany</li><li>• France</li><li>• Luxembourg</li><li>• Netherlands</li><li>• Switzerland</li><li>• United Kingdom</li><li>• Sweden</li><li>• Italy</li><li>• Austria</li><li>• Liechtenstein</li><li>• Greece, Spain</li><li>• Denmark</li><li>• Monaco</li><li>• Portugal</li><li>• Ireland</li><li>• Finland</li><li>• Cyprus</li><li>• Turkey</li><li>• Bulgaria</li></ul> | <ul style="list-style-type: none"><li>• Czech Republic</li><li>• Estonia</li><li>• Slovakia</li><li>• Slovenia</li><li>• Hungary</li><li>• Romania</li><li>• Poland</li><li>• Iceland</li><li>• Lithuania</li><li>• Latvia</li><li>• Malta</li><li>• Norway</li><li>• Croatia</li><li>• Republic of Macedonia</li><li>• San Marino</li><li>• Albania</li><li>• Serbia</li></ul> |
|--|---|

54

## EPC - European Patent Convention

- Member States
  - All others
- Extension States
  - Bosnia and Herzegovina, & Montenegro
- Validation States
  - Morocco & Republic of Moldova

55

## EPC States



56

## EPC - European Patent Convention

- The European patent system established by European Patent Convention (EPC)  
<http://www.epo.org/>  
<http://www.epo.org/#organ>
- The European Patent Office (EPO) administers the EPC procedures

57

## EPC - European Patent Convention

- European patent gives its holder the same rights in the designated contracting states as a national patent
- Valid for 20 years
- Effective only in those countries in which EP proceeds to grant (translation & fees)

58

## EPC - European Patent Convention

What are the rights granted?

- European patent is a legal title granting its holder exclusive right to make use of an invention for a limited area and time by stopping others from making, using or selling it without authorization
- analogous to exclusion principles in US law

59

## EPC - European Patent Convention

- Patentability requirements under the EPC not substantially different from US
- (1) Industrial Applicability
- (2) Novelty (an invention considered new if it does not form part of the state of the art), and
- (3) Inventive Step (not obvious to a skilled person having regard to the state of the art; like non-obviousness in US)

60

## EPC - European Patent Convention

- European patent grant procedure takes on average just over four years for a patent to be granted.
- EPC patent grant procedure lays down time limits to facilitate communication between applicants and the Office.

61

## EPC - method of initiating

### *How?*

- PCT application can be used to designate EPC when filing PCT. Recommended to do so.
- EPC alternative is to file EPC as a regional filing based on pending US patent application under Paris Convention within 1 year from priority date.

62

## EPC – or National Filings?

### *What are trade-offs?*

- High costs of EPC procedure including translations and annuities.
- EPC from filing to grant: 4+ yr. average
- Where only protection desired in limited number of European states (e.g., Germany, UK, Netherlands), will be more cost-effective to file nationally. BUT: France and Italy have no national patent applications apart from EPC.

63

## EPC – Patentability Exceptions

BUSINESS METHODS & COMPUTER PROGRAMS (as such) NOT PATENTABLE

- EPC Article 52(2)(c): --schemes, rules and methods to perform mental acts, playing games or doing business, and programs for computers, are not regarded as inventions for which European Patents can be granted.
- *Even so, application can be filed in EPO*

64

## EPC – Patentability Exceptions

### *So, how are these exceptions handled?*

- EPO over last few years carries out limited processing of appls. for business methods, pending clarification of law
- Applications for bus. methods. (& computer programs) are not searched
- Law may be changed or interpreted more favorably to applicants
- some EPC applications in limbo, awaiting clarification of law

65

## EPC – Patentability Exceptions

### *Work-around for these exceptions?*

- If a business method uses a certain hardware or system, industrial nature of hardware/system overrides “business method” use if hardware/system itself novel
- *Example:* Computerized hand-held device uses software but device itself is specially configured in novel way

66

## EPC – Patentability Exceptions

### *Still more . . .*

- Methods for treatment of the human or animal body and
- Diagnostic methods on humans or animals
- Expressly excluded by EPC Art. 52(4) although Art. 52(1) enables protection to all inventions having industrial application (**81 countries exclude**)

67

## Other EPC Considerations

Extra fee for:

- Every page of the application over 35
  - 15€ (Euro)each
- Every claim over 15
  - Claims 16-50 cost 235€ each
  - Claims 51 and above cost 585€ each
  - But aggressive multiple dependent claims and signal claims are allowed
- <http://www.epo.org/applying/forms-fees/fees.html>

68

## Other EPC Considerations

- No doctrine of equivalents
- No explicit duty of disclosure
- No incorporation by reference
- Claims are interpreted fairly literally
- Limitations on the timing of filing divisional applications
- Claim amendments must have literal support in the specification
- Software claim must include feature that is technical and innovative

69

## EP - advantage in UK

European patents with validity in Great Britain (as designated state) may be extended to a number of UK countries:

Anguilla, Belize, Virgin Islands (British), Falkland Islands, Gibraltar, Cayman Islands, Jersey, St. Vincent, Turks and Caicos, Tuvalu, Bahrain, Bermuda, Botswana, Brunei, Fiji, Gambia, Ghana, Grenada, Yemen, Solomon Islands, St. Lucia, Singapore, Swaziland, Trinidad and Tobago, Vanuatu, Western Samoa, St. Christopher (St. Kitts) Nevis, Sierra Leone, Tanganyika, Tanzania, Zanzibar, Uganda, Cyprus (Nicosia), Guyana, Kiribati, Seychelles and Hong Kong

70

## Some International Priority Problems

- What happens if applicant loses original priority year? E.g., lack of money for foreign filing or lack appreciation of importance of invention at the time, may cause an applicant to miss the 12-month deadline.
- If the invention has been published, then this ordinarily creates a fatal bar to European and Japanese rights. ABSOLUTE NOVELTY?
- So is there any solution to this problem?

71

## Some International Work-Arounds?

- Failure to file under Paris Convention deadline is fatal only if a third party has filed a patent application in the interval, or if the invention has been published
- If only patent filing was in the United States, and the patent has not yet been issued or published (recall typical 18 month publication in USA), is it possible that there has so far been no publication of the invention anywhere in the world?

72

## Some International Solutions

Where patent not yet issued, patent application not yet published, and no publication or commercial sale of invention anywhere in the world, could

- File national patent application in country of interest if permitted; OR
- File PCT application designating all countries and regions (ultimately selecting national phase only in those designated countries of interest)

73

## Challenges in Foreign Filing

### Types:

- *Opposition proceedings possible*
- Proceeds in Patent Office of a country
- Depends upon patent laws of country
- EPC allows them also
- *Inter partes* (between parties) proceeding
- Parties may present evidence and expert testimony

74

## Challenges in Foreign Filing

### Types:

- *Nullity proceedings also possible*
- Seek to nullify patent
- Typically held before special Patent Court or other tribunal
- *Inter partes* proceeding
- Depend upon patent laws of country
- May occur at any time during patent life

75

## Challenges in Foreign Filing

- Fees
  - Translations
  - Excessive claim fees
- Timing for Filing
  - Divisional/Continuation Type Applications

76

## Further thoughts about PCT

### **Possible Benefits--**

- A PCT international application can put off the major expenses of dealing with individual countries' patent offices for up to 30 months from original US filing date.
- May allow time for the international business to develop or
- May allow time for licensing or mfg. conditions to improve

77

## Potential Benefits of EPC

- EPC "all eggs in one basket" approach makes economic and logical sense if enough EU countries of interest (or where EP desired in France or Italy)
- EP can open protection to all of Europe, and even the extension states mentioned
- EP in UK opens other UK counties

78

## Unified Patent

- 26 of 28 EU countries (all except Spain and Croatia)
- Patent rights at a lower cost
- Not yet in effect; will start functioning when EU reaches an agreement on a Unified Patent Court

79

## Unified Patent Court

- The Unified Patent Court (UPC) will (ultimately) enable enforcement of a unitary patent throughout the EU countries
- <http://www.unified-patent-court.org/>
- Ratification of 13 countries needed
  - Currently 11: Austria, Belgium, Bulgaria, Denmark, France, Luxembourg, Malta, Netherlands, Portugal, Sweden, and Finland

80

## National Patent Applications Not using PCT or EPC

### **Possible Benefits--**

- Paris Convention filing of national patent appls. in selected countries could be preferable or economical
- Examples: Canada, Japan, Germany, UK, Korea, Australia
- National filing especially where time is pressing & countries of interest are few
- Only way into "Non-PCT countries"

81

Some thoughts about selecting countries for foreign filing whether or not using PCT or EPC

### **Important Questions--**

- Country includes a market for technology of invention?
- Is there a manufacturing base to produce or export from country?
- Are patents effective in country?
- Can profits/license fees flow out?
- Is inventive subject matter barred?

82

## Some Other Country Thoughts

### **Weigh Against Possible Benefits--**

- Paris Convention national patent application or PCT filing in Germany and Japan also gives the advantage that examination of patent application may be deferred for years

83

## A Key Treaty Organization: WIPO

- WIPO - World Intellectual Property Organization ("WYE-Poe" or "WEE-Poe")
  - [www.wipo.int](http://www.wipo.int)
- WIPO administers 23 treaties, including the PCT

84

## More about WIPO "The International Bureau"

### **Principal international authority** <http://www.wipo.org/>

- **Administers** handling of international patent applications under PCT - the Patent Cooperation Treaty - for 179 member states
- **Provides** int'l clearing house, in effect
- **Handles** these through the INTERNATIONAL BUREAU of WIPO  
<http://www.wipo.org/about-wipo/en/members/index.html>

85

## Is There An International Patent?

- There are only international patent applications. They open the way to patents in individual countries, although a European patent under EPC comes close to being an "international patent."
- So no, there is no "international patent." BUT--

86

## Is There An "International Patent Application?"

- For convenience, we use the term "international patent application" to mean either a PCT application or else an EPC application.
- An international application typically uses the same specification and drawings and format of the U.S. application but claims appropriate to European and international procedures.

87

## And so, When Preparing U.S. Patent Application

### Recommendations:

- Plan for possibility of foreign filing
- Discuss that with patent counsel
- Budget for at least a PCT application
- Prepare application in international format so specification and drawings are acceptable for USPTO, for either PCT or EPC filing
- Claims in "US" or "European" format
- Problem – Solution Approach

88

## International Procedures in a Nutshell

Why not seek corresponding patents in every country--or most countries?

- Foreign patents are complicated
- Relatively expensive to file & prosecute
- Very expensive to maintain for life of a patent (annuities: sliding scale upward)
- Translations will be required (Japan, China and Korea are expensive)

89

## International Procedures - How Big a Nut to Crack?

- Like asking the question: "How deep a hole do you wish to dig?"
- You do not have enough money for patents in all the world's countries.
- A business interested in patents in other countries must choose carefully; must consider what, where and why.
- Contrast with successful pharmaceutical drug

90

## Petty Patents

- Utility Models
  - No Examination
  - Shorter Term, typically 7-10 years
  - Limited Subject Matter, mechanical, electrical
- Countries – (about 78), notables: Austria, China, Germany, Italy, Japan, Russia, Spain, Taiwan

91



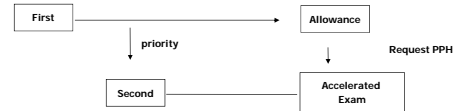
## Patent Prosecution Highway

- Leverage examination from another patent office to speed prosecution in other patent offices
- PPH leverages fast-track examination procedures already in place among participating patent offices to allow applicants to reach final disposition of a patent application more quickly and efficiently than standard examination processing

92

## Patent Prosecution Highway

- If at least one claim of an application has been found to be allowable by a 1<sup>st</sup> patent office, an accelerated examination can be requested at a 2<sup>nd</sup> patent office by submitting a request for PPH;
- The claims filed in the 2<sup>nd</sup> patent office must sufficiently correspond to the claims allowed in the 1<sup>st</sup> patent office.



93

## Patent Prosecution Highway

- Examination under the PPH does not result in automatic issuance
- If the requirements of the PPH are satisfied, application will be advanced out of turn for Examination purposes
- Examination still takes place before both patent offices
- Applicant must still comply with all the requirements of each jurisdiction (e.g. criteria for patentability, formalities, duty of disclosure, etc.)

94

## Patent Prosecution Highway

### General Requirements:

- Applicant submits request for PPH;
- Applicant submits supporting documents:
  - Copy of allowed claims
  - Copy of documents indicating allowable claims
  - Completed claim correspondence table showing the relationship between the claims allowed by 1<sup>st</sup> Office and the claims pending in the USPTO
  - Copies of examination reports from the 1<sup>st</sup> Office
- Applicant must pay fee
- Supporting documents required by the USPTO may vary depending on which Patent Office is involved with the PPH.

95

## Post Grant Procedures

- AIA significantly increased the opportunities for challenging or enhancing a patent via a PTO proceeding.
- The new Patent Trial and Appeal Board replaced the PTO Board of Patent Appeals and Interferences, and hears four types of contested cases.
- These contested proceedings became more like litigation, with opportunities for discovery, document requests, depositions and sanctions.
- Most proceedings allowed for settlements and/or arbitration by the parties.

96

## AIA Post-Grant Proceedings

- Post-Grant Review (PGR)
- Inter Partes Review (IPR)
- Transitional Program for Covered Business Methods (CBM)
- Supplemental Examination
- Derivation Proceedings

97

## Post Grant Review

- Available to third parties
- May be filed up to 9 months after issuance with the PTAB
- Burden of proof – petitioner must prove unpatentability by a preponderance of the evidence
- Appealable only to the Federal Circuit

98

## Post Grant Review

- “PGR permits evidence of on-sale activities, public uses, prior-filed but not-yet-issued patents, and other types of disclosures, as well as issues such as enablement.”
- “Any issue that was raised or that reasonably could have been raised in a PGR may not be further contested in another PTO proceeding (such as an Inter-Partes Review) or in a district court or International Trade Commission proceeding”

99

## Inter Partes Review

- Available to any third party who is not the patent owner
- **Burden of proof** – petitioner must prove unpatentability by a preponderance of the evidence
- **Threshold** – a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition
- Appealable only to the Federal Circuit

100

## Inter Partes Review

- Only patents and printed publications can be cited to initiate an IPR.
- Must wait until after the period for making a PGR has passed or until a PGR proceeding is complete before initiating

101

## Supplemental Examination

- Filed by the patent owner
- Can be used to correct or reconsider information relevant to patentability; correct errors in prosecution; offer for sale; public disclosure (no more than 12 items)
- Office issues supplemental examination certificate within 3 months

102

## Transitional Program for Covered Business Methods

- Like post grant reviews
- Can only involve a covered business method
- Petitioner must be charged with infringement

103

Major Differences between IPR, PGR, and CBM				
Inter Partes Review (IPR)	Petitioner	Estoppel	Standard	Basis
Post Grant Review (PGR)	<ul style="list-style-type: none"> <li>Person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent</li> <li>Must identify all real parties in interest</li> </ul>	<ul style="list-style-type: none"> <li>Raised or reasonably could have raised</li> <li>Applied to subsequent USPTO/district court/ITC action</li> </ul>	More likely than not OR Novel or unsettled legal question important to other patents/applications	101, 102, 103, 112; double patenting but not best mode
Inter Partes Review (IPR)	<ul style="list-style-type: none"> <li>Person who is not the patent owner; has not previously filed a civil action challenging the validity of a claim of the patent, and has not been served with a complaint alleging infringement of the patent more than 1 year prior (exception for parties)</li> <li>Must identify all real parties in interest</li> </ul>	<ul style="list-style-type: none"> <li>Raised or reasonably could have raised</li> <li>Applied to subsequent USPTO/district court/ITC action</li> </ul>	Reasonable likelihood	102 and 103 based on patents and printed publications
Covered Business Method (CBM)	<ul style="list-style-type: none"> <li>Must be used or charged with infringement</li> <li>Financial product or service</li> <li>Excludes technological inventions</li> <li>Must identify all real parties in interest</li> </ul>	<ul style="list-style-type: none"> <li>Office—raised or reasonably could have raised</li> <li>Court raised</li> </ul>	Same as PGR	Same as PGR (some 102 differences)

Major Differences between IPR, PGR, and CBM			
Proceeding	Available	Applicable	Timing
Post Grant Review (PGR)	From patent grant to 9 months after patent grant or reissue	Patent issued under first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible
Inter Partes Review (IPR)	For first-inventor-to-file, from the later of: (i) 9 months after patent grant or reissue; or (ii) the date of termination of any post-grant review of the patent. For first-to-invent, available after grant or reissue (technical amendment)	Patent issued under first-to-invent or first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible
Covered Business Method (CBM)	Available 9/16/12 (for first-inventor-to-file only after PGR not available or completed)	Patents issued under first-to-invent and first-inventor-to-file	Must be completed within 12 months from institution, with 6 months good cause exception possible

### Derivation Proceeding

- To resolve issues where someone claims that a claimed invention was derived from that person
- Must be brought within one year of publication

106

### What is a Covered Business Method (CBM)?

- Method or corresponding apparatus for performing data processing or other operations for a financial product or service
- Definition excludes patents for “technological inventions”

107

### Experian Marketing Solutions, Inc. v. RPost Communications Limited

- Case History
- Experian and Epsilon filed a petition to institute a CBM with the PTAB
- PTAB denies the petition

108

### Experian Marketing Solutions, Inc. v. RPost Communications Limited

- 1. A method of transmitting a message from a sender to a recipient through a server acting as a Mail Transport Agent, including the steps at the server of:
  - transmitting the message to the recipient's Mail Transport Agent in a protocol dialog selected from a group consisting of the selected one of the SMTP and ESMTP protocols; and
  - recording at the server some portion of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient through the server including those portions of the selected one of the SMTP and ESMTP protocol dialog between the server and the recipient in which the receiving Mail Transport Agent accepts or declines delivery of the transmitted message.

109

Experian Marketing Solutions, Inc. v.  
RPost Communications Limited

- “A ‘covered business method patent’ is a patent that ‘claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a **financial product or service**, except that the term does not include patents for **technological inventions**.”

110

Experian Marketing Solutions, Inc. v.  
RPost Communications Limited

- Focus is on the claims
- “A patent need have only one claim directed to a covered business method to be eligible for review.”

111

Experian Marketing Solutions, Inc. v.  
RPost Communications Limited

- “The ‘legislative history explains that the definition of covered business method patent was drafted to encompass patents “claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.” ... The legislative history indicates that ‘financial product or service’ should be interpreted broadly.”

112

Experian Marketing Solutions, Inc. v.  
RPost Communications Limited

- “To determine whether a patent is for a **technological invention**, we consider ‘whether the claimed subject matter as a whole recites a **technological feature** that is novel and unobvious over the prior art; and solves a **technical problem using a technical solution**.”

113

Experian Marketing Solutions, Inc. v.  
RPost Communications Limited

- “Lastly, merely because an invention’s claims recite a method, and such a method is applicable to a financial process, which does not obviate the need to determine whether the invention is directed to a technical invention.”

114

***Program  
Completed***

© 2002-16 Randy L. Canis and Tim Clise

115