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RE: NATIONALIZING A PCT FOREIGN FILED PATENT APPLICATION IN THE
UNITED STATES

OUR REF.: INTELLECTUAL PROPERTY NEWSLETTER 163

I. NORMAL "NATIONALIZING" PROCEDURE

The "nationalized" PCT application must be identical to what was originally filed in the International Receiving Office along with any Article 19 amendments (Chapter I) and/or Article 34 amendments (Chapter II). If the original documents were filed in a language other than English, they must be translated. Assuming you wish to amend the specification or claims of this foreign filed PCT application, this must be done by way of a Preliminary Amendment.

II. PCT CONTINUATION APPLICATION

Many of our clients are not aware that there is another way to "nationalize" foreign filed PCT applications in the United States. For years we have been using what we call the "PCT Continuing Application" route. Keeping in mind that when you file a PCT application in the International Receiving Office and designate the United States, that is a filing date in the United States. Therefore there exists a pending application in the United States and it will pend up to the 20th or 30th month, Chapter I or Chapter II respectively. If you file a PCT Continuing Application you do not have to "nationalize" the PCT application but you must file a PCT Continuing Application within the applicable 20th or 30th month term.

A PCT Continuing Application can be a Continuation, a CIP, or a Divisional of the PCT application and it is filed in the PTO in the same way as any other Continuation application. We can simply file the specification that you wish to be placed on file in the United States, which specification can be a combination of your originally filed PCT application with some or all of the Chapter I and/or II changes and amendments, and any other changes you wish to make, provided new matter is not added unless you are filing a CIP. We will need a Patent Declaration and a Small Entity Declaration if applicable, and such a PCT Continuing Application will maintain all of the priorities and filing dates of the parent PCT application. It will have ancestry to the PCT application filing date via 35 USC 120, and if there was a priority in the PCT application, you will maintain that priority via 35 USC 119.

1. ADVANTAGES OF THE PCT CONTINUATION ROUTE:

For any PCT international filing date before or after November 29, 2000, the effective prior art effect under 35 USC 102 (a) or (b) is the publication date of the PCT application.

- 1.1 Simpler procedures to edit an application for U.S. consumption as explained above.
- 1.2 Same cost, large entity filing fee, search fee, and examination fee is \$1000 which is the same fee when "nationalizing" a PCT application.
- 1.3 No need to supply translation of PCT application as filed plus translation of all Article 19 and 34 amendments. Need only supply English translation of what you now wish to file in the U.S.

2. DISADVANTAGES OF THE PCT CONTINUATION ROUTE:

- 2.1 For any PCT international filing date on or after November 29, 2000 and you nationalize rather than file a PCT Continuation and the PCT publication was in English, the effective prior art date under 35 USC 102(e) will be the international filing date. If published in other than English, the effective prior art date is the PCT publication date under 35 USC 102(a) or (b). For any PCT international filing date before November 29, 2000 and you nationalize, the 35 USC 102(e) effective prior art date will be when you complete all of the 35 USC 371 requirements. The effective prior art date under 35 USC 102(a) and (b) is the date of the PCT publication.
- 2.2 You will have to supply a certified copy of any priority document(s).
- 2.3 You will be subject to U.S. restriction practice as opposed to PCT unity of invention practice.

Depending on the application, consideration should be given to filing a PCT Continuation application.

If you wish further information about this PCT Continuing Application procedure, please write to John Clarke Holman.