Choosing Between a §371 National Stage Entry and a Bypass Continuation for Your U.S. Patent Application

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Posted By: Thomas A. Miller

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When international inventors and applicants seek U.S. patent protection on their invention first filed under the Patent Cooperation Treaty (PCT), they have a choice to make. They can file what is referred to as a U.S. national stage entry of the PCT application under 35 USC §371, or a bypass continuation under 35 USC §111 claiming priority to the PCT application. What are the differences, both pro and con, and when and where might you consider employing each? That is what this article will endeavor to explain.

First, it is important to note that the vast majority of patent applications encountering this phase are currently filed under Section 371 as an U.S. national stage entry of the PCT. More specifically, recent U.S. Patent & Trademark Office data indicates that roughly 80% of cases are filed in such a manner. Based on this fact alone, one might surmise it has to be the better option. In our opinion though, this is not always the case. Filings under Section 371 might be made largely out of habit, but given the facts involved a bypass continuation might be the better route.

Prior Art Concerns

For those of us old enough to have been practicing before the America Invents Act (AIA) of 2011, the decision used to be based entirely on prior art considerations. More specifically, the wording of 35 USC 102 (e) made the decision for the applicant, but as that law was changed by the AIA, the filing decision tree also changed. Prior art is still a consideration of course, just not the only one. For example, if a case enters the national stage under Section 371, the PCT application cannot be used as prior art against the national stage. This is in fact the point and thus it is a requirement that the national stage not add any new matter relative to the PCT. However, with a continuation, including a bypass continuation, U.S. law allows for what is known as a continuation-in-part (CIP) to be filed. With such a filing, new matter can in fact be added to the bypass continuation as long as it is reasonably related to the PCT, and with the understanding that the new matter will only be afforded the filing date of the CIP. As a result, claims in the bypass continuation, which are only supported by the new matter of the CIP, can be anticipated or rendered obvious by the PCT application itself as the PCT application is prior art against such new matter, depending on the timing of the filings. More specifically, if the PCT publishes more than a year prior to the bypass continuation filing, and the bypass continuation contains new matter, the PCT publication can be used as prior art against the new matter of the bypass continuation. Applicants should be careful in taking this approach; not completely avoid the approach, just be careful in weighing all such prior art considerations and timing their filing appropriately.

Restriction & Unity of Invention Requirements

Another consideration when choosing between the national stage and bypass continuation options is the effect each route will have on restriction and unity of invention requirements. By way of background, restriction and unity of invention requirements are largely two sides of the same coin as they serve as limits to the breadth of coverage a single patent application can have. As an overly exaggerated example, a single patent cannot be granted based on a patent application disclosing and claiming an airplane engine, a nucleic acid variant, a medical device, and microprocessor all in one. This would be an abuse of the system and overly burdensome on the Examiner. In fact, speaking more pragmatically, practitioners will no doubt agree even a case with nothing but airplane engine claims, or nothing but medical device claims, albeit of different scope, will often be met with a restriction requirement from the USPTO.

As it particularly pertains to this issue though, it is important to note that the filing route taken will dictate whether a restriction requirement or a unity of invention requirement may well be raised. This is because bypass continuation applications will be subject to a restriction requirement if the Examiner views the claims as being directed to more than one invention, and a unity of invention requirement will be raised if done so as a national stage. Since each type of requirement employs different standards for examination, applicants would be wise to factor this into their filing decision as well.

As a general rule, unity of invention requirements are easier to challenge. For example, the claims simply need to be linked to form a single general inventive concept, and the "unity" can be established by showing the various claims all involve one or more of the same "special technical features." The standard for a restriction requirement on the other hand is more vague in that it states the claims must be independent or distinct from one another, and not place an undue burden on the Examiner. The nebulous nature of this standard makes it harder to challenge, especially given the broad authority U.S. Examiners have in such situations.

Fee Implications

Cost is always a factor. Here again though, the answer is "it depends". If the USPTO was selected as the searching authority with the PCT application, the filing fees for a U.S. national stage entry will be reduced relative to a case where another searching authority (Europe, South Korea, etc.) was used. With a bypass continuation on the other hand, the filing fee will be the filing fee as no such discounts are available.

The timing of the fees is also in play. With a national stage entry, the filing fee must be paid at the time of filing or else a filing date will not be given. Depending on the timing of the filing, this can even result in abandonment of the application. However, with a bypass continuation, the application can be filed and be given a filing date even with no filing fees being paid at the time of filing.

RCE Practice

With a bypass continuation, a request for continued examination (RCE) can be filed as many times as needed/wanted to obtain an allowance. This is true even if signed inventor declarations have not yet been filed. Such is not the case with national stage filings. If a U.S. national stage filing is made under 35 USC 371, before an RCE can be filed, the signed inventor declarations must be on file with the USPTO. If not, and the RCE is filed, the case will be abandoned. While this may seem like a rare occurrence, those active in filing patent applications will no doubt agree getting all inventor declarations signed and on file is one of the more challenging aspects of patent prosecution. Depending on the facts of a given situation, a national stage may be filed by the 30 month deadline, but without all inventor declarations. Fast forward 18-24 months down the prosecution road, and after receipt of an Advisory Action, the client may want to file an RCE to continue prosecution. If the file history is not carefully monitored, the RCE may be filed in time only to receive a Notice of Abandonment from the USPTO as the signed inventor declarations were not yet on file.

Prioritized Examination

Track 1 Prioritized Examination is a tool applicants can employ to jump the line and have a given patent application reviewed ahead of schedule. The USPTO charges a significant fee for such a service, but depending on the importance of the invention or the activities of the competition, it may be desirable. However, Track 1 Prioritized Examination is only available with a bypass continuation, not a 371 national phase filing.

Conclusion

Many factors should be weighed when determining which option should be employed in obtaining U.S. patent protection on an invention filed under the PCT. Should you find yourself in such a situation and choosing between a national phase and bypass continuation, please do not hesitate to contact one of the patent attorneys of von Briesen. We are well experienced with U.S. and international patent practice and would be happy to help.

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