US National Phase Requirements

Additional Requirements for National Stage Entry in the US (continued)

- In addition to the basic national fee and any required copy of the international application, 35 U.S.C. § 371 also requires:
  - an oath or declaration signed by the inventors; and,
  - a translation* of any annexes to the International Preliminary Examination Report.

* Translations are NOT required if the documents were originally filed in the English language.

02.02.96

Article 19 Amendments

- Only amendment permitted in Chapter I.
- Amendment of the claims only.
- Only a single amendment permitted.
- Cannot be filed until receipt of international search report by applicant.
- Filed directly with the International Bureau.

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements

- The penalty for failure to file the Basic National Fee and any required copy of the international application by 20/30 months from the priority date is:

  the application will be considered abandoned as to the US.

  NO EXTENSIONS OF TIME ARE PERMITTED.
  However, if the application does become abandoned, a petition to revive under 37 CFR 1.137 may be filed.



02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- The penalty for failure to file a copy of any required English translation of the international application by 20/30 months from the priority date is:

  the imposition of a processing fee for the late submission of the English translation.



02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- If the required copy of the inventor(s) oath or declaration is not furnished by the end of 20/30 months:
  - The applicant will be invited to provide the oath or declaration and the surcharge generally within one month* of the notice making the invitation.

* This one month time period *IS EXTENDIBLE UNDER 37 CFR 1.136 .*

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- The penalty for failure to file the copy of any Article 19 amendments and any required translation of same by 20/30 months from the priority date is:

  the amendments to the claims under PCT Article 19 will be considered to have been canceled.

No extensions of time are permitted.

02.02.96

Special Rule for Translations of Annexes to the IPER

- Even though a required English translation of the IPER annexes is not submitted by 30 months, there remain two ways in which the amended material may be entered into the US National Stage application.
  - The translation may be provided within any period set for submission of a translation of the international application or oath or declaration.
  - The amended material may be presented as a preliminary amendment under 37 CFR 1.115.



02.02.96

Identification of Papers for National Stage Entry in the US

- Documents and fees submitted to enter the national stage in the US must be *clearly identified* as a submission to enter the national stage under 35 U.S.C. § 371, otherwise the submission will be considered to have been made under 35 U.S.C. § 111 (see 37 CFR 1.494(f) and 1.495(g)).



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Requirements of 37 CFR 1.63

- The oath or declaration must:
  - be executed in accordance with either 37 CFR 1.66 (oaths) or 37 CFR 1.68 (declarations);
  - identify the specification to which it is directed;
  - identify each inventor and the residence and country of citizenship of each inventor; and
  - state whether the inventor is a sole or joint inventor of the invention claimed.



02.02.96

Requirements of 37 CFR 1.63 (continued)

- The oath or declaration must state that the person making the oath or declaration:
  - has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration;
  - believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought; and
  - acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.



02.02.96

Execution of A Declaration*

- A written declaration
  - "may be used in lieu of the oath otherwise required, if, and only if, the declarant is, on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon."
  - "The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

* (See 37 CFR 1.68)

02.02.96

Identifying the Specification

- An oath or declaration must positively identify the specification to which it is directed (see 37 CFR 1.63(a)).
- MPEP 601.01 sets forth acceptable combinations of information for identifying a specification.

02.02.96

Other National Stage Fees

	Small Entity	Regular
• For each independent claim in excess of 3	39.00	78.00
• For each claim in excess of 20	11.00	22.00
• For each application containing a multiple dependent claim	125.00	250.00
• Surcharge for filing oath or declaration after the time limit applicable under PCT Article 22 or 39(1) (20 or 30 months from the priority date)	65.00	130.00
• Processing fee for filing English translation after the time limit applicable under PCT Article 22 or 39(1) (20 or 30 months from the priority date)	130.00	130.00

• Authorization to charge Additional Fees to your Deposit Account should always be given



02.02.96

The Transmittal Letter PTO form 1390



02.02.96

National Stage Helpful Hints

- If a translation of the international application is necessary, be sure to furnish a translation of the international application ***as it was filed with the receiving Office.***
- Separately translate any Article 19 amendments and annexes to the IPER. Explain where the translated amendments are to be entered in the international application as translated.



30.01.96

National Stage Helpful Hints

- Preliminary amendments are acceptable.
  - NOTE: If you don't want to bother with a translation of an Article 19 or an Article 34 amendment, you can make any desired changes by filing a regular preliminary amendment.
- Please ensure that all amendments are consistent with any earlier amendments.
- NOTE: A preliminary amendment must be made in accordance with 37 CFR 1.121.



30.01.96

National Stage Helpful Hints

- Use the US serial number on all papers once assigned.
- Use a current version of the USPTO Transmittal form 1390 .
- Please be sure that all information is accurate and complete.
- Check the current OG for proper fee amounts for entry into National Stage in the US.



30.01.96

Use Of The Transmittal Letter

- Applicants are encouraged to use the Transmittal Letter, form PTO 1390.
  - The form positively identifies the documents as a National Stage filing under 35 U.S.C. § 371.
  - The form has the necessary fee information imprinted on it.
  - Copies of the current version of the form may be obtained free of charge by contacting the PCT Help Desk at 703-305-3257.



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National Stage Helpful Hints



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National Stage Fees

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Transmittal Letter PTO-1390
Basic National Fee Information

Basic National Fee (37 CFR 1.492(a) (1) - (5):

Search Report has been prepared by the EPO or JPO	$880.00*
International Preliminary examination fee paid to USPTO (37 CFR 1.482)	$680.00*
No international preliminary examination fee paid to USPTO (37 CFR 1.482) but international search fee (37 CFR 1.445(a)(2)) paid to USPTO	$750.00*
Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO	$1010.00*
International preliminary examination fee paid to USPTO (37 CFR 1.482) and all claims satisfied provisions of PCT Article 33(2) - (4)	$ 94.00*

* Note that these fees may be reduced for a Small Entity

Requirements of 37 CFR 1.63 (continued)

- A separate duty of disclosure clause (37 CFR 1.56) must be included if the international application is:
  - a continuation-in-part (CIP) of a prior U.S. application, or
  - a CIP of a prior international application which designates the United States.

02.02.96

Execution of An Oath

- An oath must be signed by the inventor or inventors and made before a person authorized to administer oaths.*
- Special requirements apply to oaths made in a foreign country.*

* (See 37 CFR 1.66(a) and (b))

02.02.96

Oath or Declaration Requirements

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Oath Or Declaration Requirements

- **The oath or declaration must satisfy the requirements of 37 CFR 1.63.**

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- While no extensions of time are permitted for late filing of any Article 19 amendments or any required translations thereof, it should be noted that the substance of the canceled amendment may be entered into the national application by filing a preliminary amendment under 37 CFR 1.115.

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- The penalty for failure to file any required translation of the annexes to the International Preliminary Examination Report by 30 months from the priority date is:

the amendments to the international application under PCT Article 34 will be considered to have been canceled.

No extensions of time are permitted.

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- If the required translation of the international application is not furnished by the end of 20/30 months:
  - The applicant will be invited to provide the required translation and the processing fee generally within one month* of the notice making the invitation.

* This one month time period *IS EXTENDIBLE UNDER 37 CFR 1.136 .*

02.02.96

Penalties for Failure to Comply With 35 U.S.C. § 371 Requirements (continued)

- The penalty for failure to file the copy of the inventor(s) oath or declaration by 20/30 months from the priority date is:

  the imposition of a surcharge for the late submission of the inventor(s) oath or declaration.

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Annexes to the IPER

- Copies of amended sheets entered during international processing.
- Attached to the international preliminary examination report.



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National Stage Entry In The US

- Note that while all of the requirements of 35 U.S.C. 371 must be met, they do not have to be complied with ***at the same time.***
- The various time limits for fulfilling the requirements of 35 U.S.C. 371 are set forth in 37 CFR 1.494 and 1.495.
  - Certain of the 35 U.S.C. 371 requirements must be fulfilled at 20/30 months from the priority date.
  - Other requirements may be fulfilled at a later time.



02.02.96

National Stage Entry In the US

- In order to prevent abandonment of the international application as to the US, 35 U.S.C. § 371 requires that the applicant must furnish to the USPTO by 20/30 months from the priority date:*
  - the basic national fee; and,
  - a copy of the international application,
    - unless it has previously been communicated to the USPTO by the International Bureau, or
    - unless the international application was originally filed in the USPTO.

* ***No extensions of time are possible.***

02.02.96

Additional Requirements for National Stage Entry in the US

- In addition to the basic national fee and any required copy of the international application, 35 U.S.C. § 371 also requires:
  - an English translation* of the international application;
  - a copy of any Article 19 amendments and a translation* into English;

* Translations are NOT required if the documents were originally filed in the English language.

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