Practical Considerations for Entry into the U.S. National Stage from the PCT

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A PCT applicant that designated the U.S. and is considering the filing of a U.S. national application[2] is faced with two possible filing routes: (i) filing a national stage application under 35 U.S.C. §371 or (ii) filing a continuation or continuation-in-part application from the PCT application under 35 U.S.C. §111(a). Both routes must occur while the PCT application is pending[3] and/or before the 30-month national-stage filing deadline prescribed by 37 C.F.R. §1.495. The first option is generally referred to as a "national stage perfection route" and is governed by both PCT and U.S. procedure and rules that are conveniently summarized in Sections 1893-1896 of the Manual of Patent Examining Procedure (MPEP)[4]. The second option is generally referred to as the "bypass route" because all of the requirements of national stage filings under §371 are "bypassed" in favor of U.S. rules and regulations pertaining to §111(a) filings. A discussion and comparison of these two routes can be found in Sections 1893-1896 of the MPEP. This article summarizes and highlights some of the practical considerations involved in choosing between the two routes, and why/when one route may be preferred over the other.

PRELIMINARY CONSIDERATIONS

The initial decision about which route to choose is normally based on three factors. First and foremost is the U.S. (or foreign) representative's familiarity and comfort level with PCT rules and procedure. National stage perfection route applications are filed and examined according to a different set of rules than traditional non-provisional applications filed under §111(a). As will be discussed below in more detail, the differences are highlighted by the type of filing forms, the substantive filing requirements and the type of claims allowed in a single application. A general unfamiliarity with these items, and particularly the filing requirements, could have unexpected and unfortunate consequences resulting in unintentional abandonment or the like[5]. For a PCT-savvy[6] filer, a national stage perfection application may occur through the filing of a single transmittal form[7] and the payment of the filing fee[8]. However, the international application must meet certain requirements[9] if the filing of such form alone is to be successful. However, for the non-PCT savvy filer, the bypass route offers an uncomplicated way to transform a PCT application into a U.S. national application. As long as the bypass route application is filed while the PCT application is "pending," which usually occurs within thirty (30) months of the priority application filing (or if there is no priority filing, the filing date of the PCT Request), all that is required to obtain a U.S. filing date is the filing of a specification, drawings (if any) and at least one claim[10] as will be discussed below.

A second factor is more psychological in nature and concerns the representative's comfort level with the USPTO's ability to properly handle PCT-based applications. National stage perfection applications are initially reviewed and processed by administrative personnel from the PCT Branch. During the initial stages, a U.S. file wrapper is created and the international prosecution of the PCT application is imported into such file wrapper, thereby forming the foundation for the U.S. prosecution[11]. All of the documents generated during the International Stage (PCT Chapters I and II) and forwarded to the USPTO are supposed to find their way into the newly created U.S. file. However, it is not an infrequent occurrence that certain documents will be "missing" from the file and reported as "not received" by the USPTO, which goes against the efficient national processing of documents that is one of the hallmarks of the PCT system. Any patent practitioner can attest to the USPTO's notorious ability to lose or otherwise misplace documents in their possession.

In addition, if the PCT application is not published in English, but is amended during Chapter II under PCT Article 34, and the Applicant wishes the USPTO to effect entry of such PCT Article 34 amendments through the submission of English-language translations of the annexes to the International Preliminary Examination Report[12], the representative may fail to properly file translated substitute sheets, or the USPTO may fail to properly process such sheets to effect entry of such PCT Article 34 amendments prior to examination. If the PCT Article 34 amendments are not properly entered and made of record, the U.S. Examiner might examine the originally-filed claims and not the claims as amended under PCT Article 34, which results in the applicant losing the benefit of the international prosecution. Therefore, if there are many documents generated during Chapters I and II that could potentially be lost or misplaced by the USPTO, and if the PCT application is amended extensively under PCT Article 34 during Chapter II of the international phase, it may be more beneficial to choose the bypass route over the national stage perfection route. However, if the international application is filed and published in English, and no amendments were submitted under PCT Article 19 or 34, then a national stage perfection application should be fairly uncomplicated.

The third factor concerns the scope of the claims and the potential for a "distinctive invention" restriction if examined in accordance with U.S. restriction practice[13] under the bypass route. With national stage perfection applications, it is generally understood that separate independent claims directed to, for example, an apparatus and method for making and/or using the same apparatus can generally be retained in the same application under PCT Unity of Invention practice[14] if such apparatus and method are linked so as to form a single general inventive concept. However, with bypass route applications and non-provisional applications in general, it seems that U.S. examiners are erring on the side of issuing a restriction requirement with respect to, for example, any apparatus and method claims that are not so inherently linked such that they are not mutually substantively dependent on each other. Zealous use of restriction practice[15] by the USPTO has resulted in a financial windfall[16] for the USPTO in divisional and continuation application filings. Therefore, if the applicant does not want to be faced with the prospect of prosecuting multiple patents for

apparatus, product, method, process etc. claims that comprise the same "special technical features[17]," then it might be better to choose the national stage perfection route over the bypass route.

In addition to the above-mentioned preliminary considerations, some specific considerations may also affect the choice between a national stage perfection and the bypass route.

PRIORITY DOCUMENT

One of the major benefits of the national stage perfection route over the bypass route is that it is usually not necessary to file a certified copy of a priority document, from which priority was originally claimed in the PCT application, in order to perfect a priority claim made under 35 U.S.C. §119(a) or 35 U.S.C. §365(b)[18]. Such priority document is automatically transmitted from the International Bureau (WIPO) to all states designated in the PCT Request if properly instructed by the applicant at the time of filing the Request[19]. On the other hand, bypass route applicants must file a certified copy of the priority document at some point during the pendency of the U.S. national application to perfect the priority claim[20]. Regardless of the route chosen, if a national application priority claim extends back to a U.S. application, whether to a first-filed provisional application under 35 U.S.C. §119(e), or to a non-provisional application under 35 U.S.C. §120, or to an earlier international application designating the U.S. under 35 U.S.C. §365(c)[21], such priority must be properly identified either in an application data sheet[22] or at the beginning of the specification in accordance with 35 U.S.C. §§119 or §120[23].

Some bypass route applicants consider the filing of a certified copy of the priority document an inconvenience, particularly since the applicant may have already paid for the transmission a certified copy of the priority document at the time of filing the PCT Request. However, considering how obtaining a certified copy of filed application is relatively quick and inexpensive, and considering that a bypass route applicant has considerable time to file the certified copy after the priority claim is formally made, the inconvenience is usually overlooked or outweighed by the other bypass route benefits discussed in this article. For example, as long as the bypass route applicant makes a priority claim upon filing of the application or shortly thereafter[24], the certified copy of the priority document may be filed much later, and usually any time prior to allowance of the case[25].

OBTAINING A U.S. FILING DATE

The "filing date" printed on all USPTO application correspondence evidences the date on which all of the minimum requirements are filed with the USPTO to commence examination of a U.S. application. It is much easier and cheaper to obtain a filing date using the bypass route, since all that is generally required is the filing of specification, drawings (if any) and at least one claim[26]. As with any conventional non-provisional filing under 37 C.F.R. §1.53(b), the filing fee and oath or declaration are not essential to obtaining a filing date, since such items could be supplied later in response to a Notice to File Missing Parts[27]. In fact, such items could be supplied up to six (6) months from the mailing date of the Notice to File Missing Parts with the payment of extension fees, which provides the applicant with the option to defer both payment of the USPTO filing fee ***and*** the ultimate decision to financially commit to a U.S. national application. In other words, if the bypass route applicant does not pay the filing fee at the time the specification, drawings (if any) and at least one claim are submitted, and then decides six (6) months after the mailing date of the Notice to File Missing Parts that a U.S. national application is no longer desired, the bypass route applicant may abandon the application without paying any USPTO fees. The option to defer payment of the filing fee is one of the greatest benefits of the bypass route.

Since a bypass route application is considered a continuation application that takes priority from the PCT application under 35 U.S.C. §120, and since a PCT application that designates the U.S. is considered a U.S. filing[28], the bypass route application must be filed while the PCT application is pending to create copendency between the two applications. This must occur up to thirty (30) months from the earliest priority date as noted above. If a bypass route application is not filed during the pendency of the PCT application and the PCT application effectively goes "abandoned" as to the U.S., the applicant can file a petition to revive the abandoned PCT application under the unintentional[29] or unavoidable[30] standard within a certain period of time[31]. Recognizing that this is not an uncommon occurrence, the USPTO has made available on its website FORMS PTO/SB/64/PCT (unintentional) and PTO/SB/61/PCT (unavoidable), which applicants can use if they fail to enter the national stage while the PCT application is still pending.

For national stage perfection applications, the U.S. "filing date" printed on all USPTO correspondence is the date that all requirements under 35 U.S.C. §371(1), (2) and (4) are satisfied[32] while the PCT application is still "pending." However, such "filing date" is of no real legal consequence, since the patent term of a national stage perfection is based initially on the filing date of the international application and not the "filing date" printed on all future USPTO correspondence. The filing date of a national stage perfection application is absolutely dependent upon the submission of the national stage filing fees[33], which absolutely must be paid while the PCT application is pending in order to avoid abandonment of the national stage application[34]. Accordingly, a national stage perfection applicant must immediately commit financial resources in order to commence examination before the USPTO. Contrast this with the bypass route benefit of paying the filing fee either at the time of filing the national application or later in response to a Notice to File Missing Parts. In addition, the national phase perfection applicant must also file an oath or declaration[35] in order to establish the "filing date" which, again, is not mandatory for bypass route applicants.

This concept of establishing a "filing date" for national stage perfection applicants used to have greater meaning than it does today, because the "filing date" used to also be the "§102(e)" date for prior art purposes. However, with the recent amendments to 35 U.S.C. §102(e)[36], and for all PCT applications (a) filed on or after November 29, 2000 that (b) designate the U.S. and (c) that are published in English, the §102(e) date is the international filing date of the international application, or earlier if priority is claimed to an earlier U.S. filing under 35 U.S.C. §§119(e), 120 or 365(c). Otherwise, if the PCT application is not published in English, its effective date as a prior art reference is determined in accordance with 35 U.S.C. §§102(a) or §102(b)[37], which usually coincides with the 18-month PCT publication date[38]. The same general rules apply to a bypass route application, although if the PCT applica-

tion is not published in English, the bypass application is effective as a reference as of its U.S. filing date under 35 U.S.C. §102(e).

THE FILING FEE

The filing fee for bypass route applications is the same as the filing fee for a continuation application and is governed by 37 C.F.R. §1.16. Currently, such filing fee is $750 for a large entity with a 50% reduction for a small entity.

For a majority of the PCT applicants that do not actively prosecute the international application through Chapter II, or that designate an office other than the USPTO as the International Searching Authority (ISA) and/or the International Preliminary Examining Authority (IPEA), the filing fee[39] for a national stage perfection is usually greater than the filing fee[40] for a bypass route application. As illustrated in Table 1, which represents Box 21. of the national stage transmittal form[41], the filing fee depends on where the international prosecution took place, to which office the applicant paid search and/or examination fees, and the result of such international prosecution if an examination took place in the USPTO.

FIGURE 1: Box 21 from National Stage Transmittal (Large Entity Fees)

21. ☐ The following fees are submitted:

BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)):

Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO and International Search Report not prepared by the EPO or JPO	**$1060.00**
International preliminary examination fee (37 CFR 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO	**$900.00**
International preliminary examination fee (37 CFR 1.482) not paid to USPTO but international search fee (37 CFR 1.445(a)(2)) paid to USPTO	**$750.00**
International preliminary examination fee (37 CFR 1.482) paid to USPTO but all claims did not satisfy provisions of PCT Article 33(1)-(4)	**$720.00**
International preliminary examination fee (37 CFR 1.482) paid to USPTO and all claims satisfied provisions of PCT Article 33(1)-(4)	**$100.00**

ENTER APPROPRIATE BASIC FEE AMOUNT =

The more the USPTO is substantively involved in the international prosecution, the lower the filing fee. On the flip side, if the search and/or examination took place in a patent office other than the USPTO, EPO or JPO, then the national phase perfection filing fee is much greater than the filing fee under the bypass route. Thus, the USPTO offers a financial incentive to prosecute the international application completely through the USPTO through a reduced filing fee upon entry into the national stage through 35 U.S.C. §371.

The severely reduced filing fee for USPTO-based international prosecution that results in all claims being considered to meet the requirements of novelty, inventive step and industrial applicability under PCT Articles 33(1)-(4), provides an incentive for applicants desirous of obtaining both U.S. and foreign patent protection to prosecute the international application through at least Chapter II with the USPTO as the IPEA. If, for example, an applicant knows that U.S. and foreign applications will be filed, a PCT application (designating the US) could be filed first in the USPTO designating the USPTO as both the ISA and IPEA. The USPTO strives to prepare the International Search Report (ISR) by either 16 months from the priority date or 9 months from the filing date if no priority is claimed,[42] at which point the applicant will have one opportunity to file Article 19 amendments[43] in response to the ISR citations. Then, the Applicant can enter Chapter II and request an examination, submitting further amendments if necessary or desired under PCT Article 34[44]. In accordance with current Chapter II practice, the Examiner may then issue a Written Opinion[45] based on the claims as amended under PCT Articles 19 and 34, which is more of a comprehensive examination report than the ISR and is based on such further amendments and an additional search of the prior art. The applicant may then have a third opportunity to amend to place the claims in condition for acceptance under PCT Articles 33(1)-(4). Upon the issuance of an International Preliminary Examination Report (IPER) that concludes that all claims meet the requirements of PCT Articles 33(1)-(4), the applicant would immediately file a U.S. national application under the national phase perfection route, pay a severely reduced filing fee and ***hopefully*** proceed to allowance on the first action[46], particularly since the U.S. Examiner tends to be the same as the PCT Examiner if the PCT application is prosecuted in the USPTO. National phase perfection applications that qualify for a severely reduced filing fee also qualify for expedited examination[47]. An obvious benefit to prosecuting the international application through to acceptance under PCT Articles 33(1)-(4) is that subsequent national phase filings in other countries may become easier, particularly in those countries that tend to rubber-stamp a favorable IPER into a national patent. Of course, a favorable USPTO-generated IPER does not hold that much weight upon entry to the EP regional phase, or the JPO for example, because the EPO will usually perform their own search and will, more often than not, issue a substantive rejection and require the applicant to undergo further prosecution to achieve an EP grant. Prosecution in the EP regional phase is streamlined if the PCT prosecution takes place with the EPO as at least the IPEA. As far as the USPTO, EPO and JPO are concerned, there is an obvious prejudice or bias with respect to the substantive examination of national (or regional) phase filings depending on which office is designated as the ISA and/or IPEA. Thus, if the applicant is more concerned with the issuance of a U.S. patent, then the applicant should benefit from international prosecution through the USPTO and a highly reduced filing fee through the national phase perfection route. However, if an EP patent is more desirable and international prosecution occurs through the EPO, then this benefit of the severely reduced filing fee through the U.S. national phase perfection route will not be realized, and a bypass route application may be more desired.

THE FILED SPECIFICATION AND CLAIMS

Bypass route applicants should commence examination with a "clean" specification that must indicate at the beginning of the specification that such application is a continuation of at least the PCT application[48]. Any Article 19 and Article 34 amendments to the specification and claims made during the international phase

should be incorporated into the body of the application prior to filing, such that the bypass route application shows no signs of, or is "clean" of amendments. It is preferable that the bypass route application be filed without a preliminary amendment (to enter amendments made during the international phase or prior to entry into the national phase) because preliminary amendments are not published under 35 U.S.C. §122(b) unless they are filed in electronic form[49]. Assuming an electronic filing is not used, which occurs with the great majority of U.S. filings, only the filed "application" is published, which may have detrimental consequences if the applicant desires that the claims as amended under Article 34 or thereafter be subject to publication to place the public and potential infringers on notice[50]. Thus, if the application is filed in a "clean" form, the bypass route applicant benefits from publication of the entire application as filed and as amended (if applicable).

National stage perfection applicants must start with the original application as filed with the PCT Request and as amended under Article 19 as a foundation[51]. Upon entry into the U.S. national phase, any Article 34 amendments made during PCT Chapter II can be effected by a preliminary amendment ***or*** by submitting copies of annexes to the IPER[52]. Such annexes must be line-by-line substitute sheets of the originally-filed PCT application as amended under Article 19 (if applicable), which usually doesn't present a problem if everything was filed and published in English. If the PCT application was filed and published in a language other than English, and if PCT Article 19 and 34 amendments were made in a language other than English, then the ***translated*** PCT Article 19 and the ***translated*** annexes to the IPER must correspond, as line-by-line replacement sheets, to the original non-English PCT application[53].

Practically speaking, the ***translated*** PCT Article 19 amendments and IPER annexes, whether they are provided by overseas agents or an applicant's translation service, usually don't function as replacement sheets of the foreign-language original sheets. This results in the possibility that the amendments will not be entered during the initial processing of the national-stage application, and the applicant may not be aware of such non-entry until a first Office Action is received in the case. As a practical matter, reliance on the USPTO's entry of amendments embodied in translated documents, whether the PCT Article 19 amendments and annexes are submitted correctly or not by the applicant, can result in the applicant losing the benefit of any international prosecution. This further results in the applicant entering such amendments in response to a first substantive Office Action, which effectively wastes a first response by forcing the applicant to place the application in a condition that it should have been upon entry into the national phase.

An even further danger arises where the national phase perfection applicant submits PCT Article 19 and/or IPER annexes upon entry into the U.S. national phase and, assuming such items will be automatically entered during the initial processing of the application, submits a preliminary amendment to amend the claims as set forth in the PCT Article 19 amendments and/or IPER annexes. If, however, the amendments are not entered due to USPTO or applicant error, and the applicant is not notified of such non-entry by the USPTO Examiner, then the U.S. Examiner will consider the preliminary amendment with respect to the originally-filed PCT application.

This scenario presents two dangers. First, the originally-filed claims may not be drafted in accordance with U.S. practice and include improper claim dependencies and the like. If, however, the PCT Article 19 and 34 amendments addressed these claim deficiencies, and the applicant relies on entry of the amendments through submission of the PCT Article 19 amendments under 35 U.S.C. §371(c)(3) and the IPER annexes under 35 U.S.C. §371(c)(5), and such amendments and/or annexes are not entered through USPTO or applicant error, then the applicant loses the benefit of the international prosecution as discussed above. Second, if the applicant submits a preliminary amendment based on the assumption of automatic entry of the PCT Article 19 amendments and/or IPER annexes, and such items are not entered, then the Examiner will consider the preliminary amendment with respect to the originally-filed PCT claims and not the claims as amended under PCT Articles 19 and/or 34. As expected, this can have unintended and sometimes unusual consequences, particularly since the preliminary amendment would be drafted assuming entry of the content of the claims as amended under PCT Articles 19 and 34.

One simple example of this second danger is an Article 34 amendment that results in the addition of 10 claims to the international application, such that the total claims after the Article 34 amendment is 20 instead of 10 as originally filed, and then the applicant submits a preliminary amendment to claim 15 assuming automatic entry of the Article 34 amendments through submission of the IPER annexes. If the IPER annexes are ***not*** entered by the USPTO, then the Examiner will not consider or at least be perplexed with respect to such preliminary amendment because, as far as the Examiner is concerned, the application only has 10 claims (as originally filed) and claim 15 does not exist. The application presented to the U.S. Examiner is a version that has processed by the PCT Branch of the USPTO. Therefore, if the initial review by the PCT Branch results in the non-entry of the IPER annexes, the Examiner would have no knowledge that such annexes ever existed and the applicant must first introduce the substance of such annexes in response to a first Office Action during prosecution of the U.S. case. As noted above, and in anticipation of these types of procedural errors, it is recommended, particularly for all national phase perfection applicants having non-English PCT filings, to enter all PCT Articles 19 and 34 amendments and subsequent amendments made thereto via a preliminary amendment and not through submission of translated PCT Article 19 and/or IPER annexes upon entry into the national phase[54].

UNITY OF INVENTION

As noted above, bypass route applicants are subject to restriction practice in accordance with 37 CFR §§1.141-1.146, while national stage perfect applicants are subject to Unity of Invention practice in accordance with 37 CFR §§1.475 and 1.499. Accordingly, if a U.S. Examiner would likely consider the claims to comprise multiple "inventions" in accordance with restriction practice, yet such claims might comprise one "invention" under Unity of Invention practice, and the applicant prefers to minimize related patent application filings, then the applicant may opt for the national stage perfection route subject to Unity of Invention practice. However, if the applicant desires to increase the number of

patents in its portfolio, and would welcome a multi-invention restriction in order to generate increased patent filings through multiple divisional and continuing applications, then the applicant may opt for the bypass route subject to restriction practice.

In 68 FR 27536 (May 20, 2003), the USPTO requested comments on implementing a Unity of Invention style examination as part of the 21st Century Strategic Plan. Ten issues were presented for comment, mostly raising potential problems in financial, administrative and procedural considerations for the USPTO. It is fairly clear that a conversion from restriction practice to the Unity of Invention standard would require more than just an implementation of new rules.

For example, as noted in the FR Request for Comments, a Unity of Invention standard would normally require the following inventions to remain in a single application: (1) process and apparatus for carrying out the process; (2) product and process for making the product; (3) apparatus and product made by the apparatus; and (4) product and process of using the product. Unless such invention pairings are integrally linked, they would normally be subject to restriction under the current U.S. restriction practice prior to the Examiner carrying out a substantive examination. An obvious problem with a wholesale adherence to the Unity of Invention standard is how to apportion work between USPTO Examiners that specialize in only one of the types of related inventions being claimed. Such Examiners are already overburdened, and to expand the scope of their duties would likely result in greater prosecution delays. Having applicants pay for multiple "inventions" might solve a financial consideration of increased Examiner resources, but it doesn't appear to address the real problem of existing prosecution delays that are only getting longer even as the USPTO fees are increased. While the author of this article believes that the USPTO would "relax" its restriction practice to something between the current restriction and Unity of Invention practices before it adheres to a full-blown Unity of Invention type of examination, the USPTO's ultimate decision in this regard may effect the selection between the national phase perfection and bypass routes.

CONCLUSION

The choice between filing a national phase perfection under 35 U.S.C. §371, or a continuation application under 35 U.S.C. §111(a), usually comes down to a matter of control. With bypass route applications, the applicant has more control in what is presented to the USPTO for examination, particularly since a bypass route application is generated and filed directly by the applicant or its representative. With national stage perfection applications, extensive reliance is placed on communications between the USPTO, WIPO and the applicant or its representative to ensure that all international phase documents are received and properly processed prior to substantive examination. Of course, each route has its particular pros and cons that vary depending on the extent of international prosecution, the language of the international publication and the patent office designated as the ISA and/or IPEA.

ENDNOTES

1. Associate Attorney in the Intellectual Property Department of Katten Muchin Zavis Rosenman in New York. This article does not constitute any specific legal or business advice. Questions or comments may be directed to harris.wolin@kmzr.com.
2. 37 C.F.R. §1.9(a)(1)
3. A PCT application that designates the U.S. is effectively treated as a pending U.S. application. See 35 U.S.C. §363, which states that an international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.
4. See also 37 C.F.R. §§1.491-1.499
5. See MPEP §1893.02 and 37 C.F.R. §1.495(h)
6. Even though PCT practice is tested on the patent bar exam, some patent practitioners with local and regional clients limit their exposure to U.S. provisional and non-provisional filings, and become uneasy at the thought of PCT or other international prosecution.
7. FORM PTO-1390
8. See 37 C.F.R. §§1.495(b) and 1.492(a)
9. 37 C.F.R. §1.495(b)(1)
10. See 37 C.F.R. §1.53(b) and 35 U.S.C. §365(c)
11. MPEP §1893.03(c)
12. 35 U.S.C. §371(c)(5)
13. See 37 C.F.R. §§1.141-1.146 and 35 U.S.C. §121
14. See PCT Rule 13 and 37 C.F.R. §1.475
15. See Chapter 800 of the MPEP in general
16. Of course, some would argue that the pilfering of the USPTO's coffers by the U.S. Government (fee diversion) would tend to negate any realized windfall.
17. PCT Rule 13.2
18. MPEP §1893.03(c)
19. PCT Rule 17 and 37 C.F.R. §1.451(b,c)
20. 37 C.F.R. §1.55(a)(1,2)
21. 35 U.S.C. §363
22. 37 C.F.R. §1.76
23. See *Claiming the Benefit of a Prior-Filed Application under 35 U.S.C.§§ 119((e),120, 121,and 365(c)* dated February 24, 2003, by Stephen G. Kunin (posted on the USPTO website)
24. Id.
25. Id.
26. 37 C.F.R. §1.53(b)
27. 37 C.F.R. §1.53(f)
28. 35 U.S.C. §363
29. 37 C.F.R. §1.137(b)
30. 37 C.F.R. §1.137(a)
31. 37 C.F.R. §1.181(a,f) and MPEP §711.03(c)
32. Submission of the national fee, a copy of the international application and any translation and the oath or declaration
33. 37 C.F.R. §1.492
34. MPEP §1893.01(a)(1)
35. It is not critical that the oath or declaration is filed by the 30 month date as discussed in 35 U.S.C. §371(d) and 37 C.F.R. §1.495(c). See also MPEP §1893.01(a)(1).
36. 35 U.S.C. §102(e) as amended by H.R. 2215 states that a person shall be entitled to a patent unless the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. See also *Prior Art Under 35 U.S.C. §102(e) An Update, Effect of H.R. 2215* by Cheryl H. Agris, Ph.D, published in the February 2003 edition of Intellectual Property Today.
37. §102(a) and (b) state that a person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.
38. See in particular MPEP §§1857 and 1857.01. Note also 35 U.S.C. §374, which currently states that a publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122(b), except as provided in sections 102(e) and 154(d) of this title.
39. 37 C.F.R. §1.492
40. 37 C.F.R. §1.16

41. FORM PTO-1390
42. See MPEP §1844.01
43. See MPEP §1853
44. See also 37 C.F.R. §1.485
45. See in particular MPEP §1878
46. Unless new references unique to U.S. law, under 35 U.S.C. §102(e) for example, are asserted by the Examiner.
47. 37 C.F.R. §1.496(b)
48. 35 U.S.C. §120
49. 37 C.F.R. §1.215
50. 35 U.S.C. §154(d)
51. 35 U.S.C. §371(c)(2). Article 19 amendments are usually entered automatically by the International Bureau. But see MPEP §1893.01(a)(2) concerning non-English language amendments, which may be entered by preliminary amendment under 37 C.F.R. §1.121. Also note that failure to submit English-language translations of PCT Article 19 amendments results in such amendments being canceled pursuant to 35 U.S.C. §371(d).
52. 35 U.S.C. §371(c)(5)
53. See in particular MPEP §§1893.01(a)(2, 3)
54. See the last sentence of MPEP §1893.01(a)(3)