CHAPTER 19

THE NATIONAL/REGIONAL PHASE

The National phase must be entered into no later than 30 months (or 31 months in some countries/regions, such as Europe) from the earliest priority date of the application. The applicant may file a national patent application in any one or more of the countries/regions previously designated in the PCT Request (remember, under the new rules, all countries and states are automatically designated in the Request). The national application will claim priority to the International application, and perhaps back to an even earlier-filed application, such as a US provisional, if there is one. The National phase application may use the same specification and claims, as amended by any Article 19 and/or 34 amendments during the PCT phase.

Amendments under Article 41 may be made during entry to the National phase at this point, the amendments being in accordance with the relevant national law of the elected Office of that state (country) or region. In the USPTO, a preliminary amendment may be used to amend the claims/application upon national filing.

Early entry into National phase: You do not have to wait for the 30/31 month deadline to file a National phase application. Under PCT Articles 23(2) and 40(2), any designated Office may, at the express request of the applicant, process or examine the international application at any time. You are, therefore, entitled to enter the National phase earlier than the 30/31-month time limits; there is no requirement that an international application be published in order to enter the National phase.

The National phase is separate from the PCT. In the US, the National phase is very similar to filing a regular application, just taking priority from a previously filed PCT application. The National phase is generally different from country to country, although some groups of countries have banded together to provide a unified Regional patent procedure. A regional patent office is one that acts on behalf of several countries, bundling prosecution together and issuing a patent enforceable in all the countries in that region. For example, the European Patent Office (EPO) is a regional patent office that acts for all the countries in the European Union, issuing a European patent. The individual countries that are members of a region also have their own national patent offices, and an applicant may choose, instead, to apply for a patent in one or more individual countries rather than in a region. The National phase must be entered by 30 months from the priority date of the application (or 31 months in some countries/regions, such as the EPO - See Volume II of the PCT Applicant’s Guide).

The National phase is handled almost entirely by foreign counsel in the particular countries involved. The major exception is entering the National phase in the US, where the attorney at your firm/company will probably be prosecuting the national US application. Entering the National phase in non-US countries is generally a matter of telling the foreign associate to do it and sending the required information. The foreign counsel will be docketing the necessary due dates and will be primarily responsible for
the prosecution at this stage. Thus, for non-US applications, your main job will be to make sure that all correspondence is filed and forwarded appropriately, and that any due dates are entered in your internal docket, just to be safe.

NOTE: Many countries require that annuity fees be paid to keep the application alive. While your foreign counsel may keep track of these, be sure to docket these dates and make sure the fees are paid. Most countries will give you a six-month grace period in which to pay the fees plus a penalty fee. If you miss the six-month date, though, the application in that country will go abandoned, and it may be very difficult and expensive to get the application reinstated.

The countries in which the applicant chooses to file a national application will depend on the particular route of prosecution the applicant has chosen. Under some circumstances, the applicant may have already filed a separate US application and will not need to go national in the US.

Ch. 19/A: Routes of Prosecution
Let's look at four different routes of prosecution, all of which assume that the applicant wishes to eventually pursue patent rights in the US.

ROUTE 1: The applicant has filed a provisional US application (the priority application) and at 12 months simultaneously files both a nonprovisional US application and a separate PCT application. The US application enters prosecution, and the PCT application proceeds as usual towards the 30-month deadline, when non-US national applications will be filed. This strategy is often used to get the US case into prosecution quickly.

ROUTE 2: The applicant has filed a provisional US application, then, 12 months later, chooses to file a PCT designating, amongst other countries, the US. The US national application is not filed until the 30-month National phase deadline. This option is cost efficient, and it takes advantage of the US provisional's 12-month grace period that allows the applicant to further determine practicability/marketability of the invention before filing for real.
ROUTE 3: The applicant has filed a US nonprovisional application. The application begins prosecution in the US and continues as normal. Twelve months later, the applicant files a PCT application not designating the US. This option is efficient and is useful if the applicant wishes to prosecute the US case separately and does not need the one-year provisional grace period.

ROUTE 4: The applicant immediately files a PCT application designating the US. The US national application is filed (with any other desired national applications) at the 30-month National phase deadline. This is the simplest of all routes.

We will now discuss entry into the National phase in the US and then discuss entry into the National (regional) phase in Europe.

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