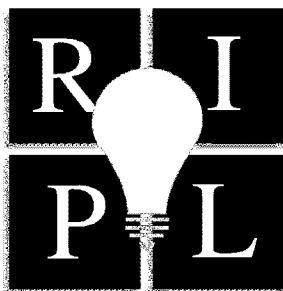


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



PATENT COOPERATION TREATY – IMPLEMENTATION V. U.S. LAW

RICHARD LAZARUS

ABSTRACT

What ways can an individual attack the enforceability of a patent that relies on the benefit of an earlier filed Patent Cooperation Treaty application (“PCT”)? This article highlights the top five PCT issues that an attorney should look for to successfully defend a client against infringement. The strategies discussed include: (1) searching for new matter; (2) searching for errors in inventorship; (3) examining an international filing date; (4) checking for withdrawal of an international application; and (5) examining estoppel arguments in international applications.

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PATENT COOPERATION TREATY – IMPLEMENTATION V. U.S. LAW

RICHARD LAZARUS*

Let us assume a client has just walked into your office and explained that they are being sued for infringement of a United States patent. The plaintiff is asking for many millions of dollars and the client desperately needs your help. Of course, the first thing to be done is to determine if there is actual infringement of the claims of this patent. You realize that the other side has done a pretty good job and that there appears to be infringement. You do not want to have to argue that there is no infringement.

So now what? The client is faced with substantial damages if you cannot help him. The next thing that comes to most attorneys' minds is the question of whether the patent is valid. Is there any prior art out there that could invalidate this patent? This is one avenue to pursue. Also, you should ask whether there is anything in the file that could invalidate or render the patent unenforceable. Maybe there was an abandonment of the application during the process that would render this invalid or unenforceable. The face of the patent shows there is benefit under the Patent Cooperation Treaty ("PCT") of an earlier PCT application. In order to determine if there are any validity or enforceability issues arising under the PCT or corresponding U.S. law you must order and review the PCT files.

What PCT files are there? There is a receiving office file, a searching authority file and an international bureau file. If a demand for examination has been filed there will also be an examination file. An international application is filed with a receiving office. The receiving office processes the original papers on which a filing date is granted. The receiving office sends those original papers on to the International Bureau. The International Bureau keeps the original papers for themselves and makes a copy to send to the International Searching Authority. Then, the examiner at the searching authority provides a search. The International Searching Authority has a file and, as already explained, the International Bureau and Receiving office have files. The International Bureau will get a copy of the search report and publish it with the application. If the applicant wishes examination and files a demand for an international preliminary examination there will, of course, be an examination file.

At the end of this article are three examples of the first page of a U.S. patent. Each first page demonstrates reliance on a PCT filing. These examples demonstrate how to quickly determine if the U.S. patent, of which your client is accused of infringing, is based on a prior PCT application. The first example shows a national stage filing. The front page of the patent shows that there was a prior PCT

* Richard B. Lazarus is of counsel in the Washington, D.C. office of Barnes & Thornburg LLC. This article is based on his presentation given on May 25, 2006, at The John Marshall Law School's 50th Annual Conference of Developments in Intellectual Property Law and the 65th Anniversary of the John Marshall Center for Intellectual Property Law, entitled "The Role of the United States in World Intellectual Property Law."

application and gives the Section 371(c) U.S. national stage entry date.¹ Section 371 is a portion of Title 35, of the Patent Statute, that dictates how one enters the national stage after a PCT filing.² This means that the U.S. Patent and Trademark Office takes the International Bureau's copy of the international application with the fee and other national stage papers provided by applicant, and forwards them to the examiner in the U.S. Patent Office for examination.

The second example occurs when applicants do not enter the national stage, but choose, instead, to file a continuation. This is an example of an applicant who has chosen to use 111(a) route provided by the statute. 111(a) is the only other way, besides Section 371, to get an application on file in the patent office.³ Under 111(a), one provides a copy of the disclosure and asks for a filing date. In this second situation, there is a claim for benefit of the prior PCT application that is apparent. The third example demonstrates the situation when an application is from a series of previous applications, one of which was either a national stage or a continuation of a PCT.

After observing that the patent relies on a PCT filing and obtaining the receiving office, international searching authority, the International Bureau, and in examination cases the international preliminary examining authority files, now what? There are many issues to look for in the PCT files. Some of these can be very helpful to one's client to perhaps avoid the very expensive costs of being an infringer. The following five issues are discussed: (1) searching for new matter; (2) searching for errors in claimed inventorship; (3) examining an international filing date; (4) checking for withdrawal of an international application; and (5) examining estoppel arguments in international applications.

A. *New Matter*

The first issue is new matter. As many are aware, U.S. law says that new matter may not be introduced into a patent application.⁴ The Patent Cooperation Treaty also forbids this. Can international application files have new matter? Speaking from my experience and the number of files that I have seen, the answer, surprisingly, is — yes, they can.

How does the new matter get in? Article 19 of the Patent Cooperation Treaty⁵ explains that when the applicant gets the search report, they have a limited time to amend the claims. That is, the search is completed and the applicant is given two months to look at that search report and make a decision as to whether there is any prior art that would cause their claims to be rendered unpatentable. If there is such prior art, the applicant has an opportunity to amend the claims in accordance with PCT Article 19. The applicant then sends the claim amendment to the International Bureau, which publishes those claims. There is an advantage to an applicant to have

¹ 35 U.S.C. § 371 (2000).

² *Id.*

³ *Id.* at § 111(a).

⁴ *Id.* at § 132 (forbidding the introduction of new matter into patent applications).

⁵ Patent Cooperation Treaty art. 19, June 19, 1970, 28 U.S.T. 7645, 116 U.N.T.S. 231, available at <http://www.wipo.int/pct/en/texts/articles/atoc.htm> [hereinafter PCT].

his claims published. For those published claims that survive to the patent, one can get protection all the way back to the publication of those claims. This is called provisional patent protection. After the applicant gets the search report, the applicant sends those Article 19 Amendments to the International Bureau so that they will be published with the international application. No one at the International Bureau looks at the amendments to check for new matter. There are no examiners at the International Bureau; there is no one qualified to look for new matter. If any new matter is included, it simply is published and included with the application. One should compare the Article 19 amendments with the original disclosure to discover if such amendment has introduced new matter.

Article 34 Amendments⁶ are a little different. Those amendments come during the examination phase. They go to an examiner at the international preliminary examining authority. An examiner will examine such amendments for new matter. If the examiner finds there is new matter, he will refuse the amendments. For example, if the European Patent Office (“EPO”) is the examining authority, an examiner in the EPO will examine the Article 34 amendments. The EPO has a slightly different new matter standard than the United States. So, you will want to look at these amendments and compare them with the original disclosures in the application to determine if new matter has been introduced.

Another way that new matter can get into these files is called *ex officio* changes. The guidelines and administrative instructions authorize various international authorities to make changes to the application. They are supposed to be harmless changes. These are changes made, in effect, by clerical staff, some of whom are well-trained, although some are not. Some of the clerical staff go beyond and make changes that perhaps should not be made. Some of the changes could be determined to be new matter.

Another potential source of new matter is through a request for rectification. When the international application is filed, the receiving office quickly notifies the applicant of formal errors, e.g., that some of the margins are off, that there are some lines in the drawings, or other similar defects indicating that the application is not sufficient for publication. The office gives the applicant a month to correct. The applicant then provides changes to the application. Perhaps the applicant sees some changes they would like to make on their own. There may have been some misspellings in the disclosure. Maybe the office felt the applicant left out some kind of chemical symbol, so the receiving office just puts it in. When those papers come in, the receiving office stamps those papers with two stamps. The stamp at the top includes the date that the office received the papers. The other stamp is at the bottom and indicates the type of change being approved. Or, if they choose to not enter the paper, there is no stamp at the bottom. If the office does enter the paper, the office can indicate that it is an amendment, or a substitute sheet. The stamp “substitute sheet” on the bottom means that the clerical person examined the amendment and certifies that the only changes are formalities; there are no substantive changes. This substitute sheet stamp is applied so that people who later see the sheet will not have to review it for possible substantive changes. In my view,

⁶ PCT, *supra* note 5, art. 34.

it is a good idea to look at the sheet to see if there are any substantive changes or if any new matter has crept into the application. For example, the applicant may have changed the range of an amount of cadmium or other element used in a pharmaceutical drug application. This change could be mere movement of a decimal point and could be introduction of new matter into the application.

Another way to review these files for new matter is by comparison of the publication with the original disclosure. The International Bureau is the one that puts together the eighteen month publication. The Bureau is supposed to do it from the original disclosure and make sure nothing is added. However, in each application there are potentially several submissions from various groups (receiving office, applicant, and International Bureau), and each of these presents a possibility for adding new matter. This is why the International Bureau's publication can end up containing new matter.

Additionally, new matter can be introduced when an application enters the national stage. If the international application was published in, Japanese, German, or another language other than English, then when the applicant comes to enter the national stage he must provide an English translation. Did that translator provide an accurate translation? Or again, were some of the terms used perhaps a little expansively so as to add new matter to that disclosure?

And the last potential source of new matter is continuation. I always scratch my head a little bit, maybe too much, asking myself, why people would file a continuation instead of entering the national stage. To initiate entry into the national stage all one really needs to do is pay the fee and identify the international (PCT) application. If it is published in English, a copy of the disclosure is not needed. However, some people come in with a new copy of the disclosure. Instead of proceeding under Section 371 of the statute,⁷ they proceed under Section 111 of the statute.⁸ They provide the U.S. Patent and Trademark office with a new disclosure. So, in the case of a 111(a) continuation application, one should always ask, "what is in that new disclosure that is not in the PCT case?" It is prudent to make sure you look at an original copy of the PCT application papers that were filed, and check those against the continuation papers for possible new matter.

B. Inventorship

The second issue is inventorship. We all know that the law of the U.S. requires the applicant for U.S. patents to be the inventor, or if there are multiple inventors, a joint inventor.⁹ Here, one should look outside of Chapter 11 at Section 373 of the United States Code, which is something that people do not ever seem to do.¹⁰ This section states that if an international application was filed by someone not qualified, e.g., not an inventor, under Chapter 11 of the Statute, it can not be accepted for the

⁷ 35 U.S.C. § 371 (2000).

⁸ *Id.* at § 111.

⁹ *Id.* See 37 C.F.R. § 1.41 (2006) ("A patent is applied for in the name or names of the actual inventor or inventors."), and 37 C.F.R. § 1.45 (2006) (requiring joint inventors to apply for a patent jointly and that each inventor make the required oath or declaration).

¹⁰ 35 U.S.C. § 373.

U.S. national stage. Thus, the U.S. Patent Office cannot accept an application for the national stage under Section 371 if the PCT was filed by someone not qualified under Chapter 11 of the United States Code. Furthermore, it states that under these circumstances (the wrong inventor in the PCT) one cannot file a continuation of that PCT application. I can not count the number of instances I have seen in which the inventorship has changed in an international application after the filing date. It is not an unusual occurrence. What is a proper change? Is it the type of change that runs afoul of Section 373 of the Statute? Unfortunately, there is not any case law that I am aware of that addresses this issue. You should examine all of the facts to see if the PCT application was filed by someone other than the correct inventor and, if so, whether there is compliance with all of the necessary statutory requirements, including Section 373.

C. Filing Date

The next issue is the filing date. I want to take you back just a little bit to give you some of my experience. In the 1970s, if there was an alleged infringement of a U.S. patent, the attorney would first order the patented file. The reason he would order the U.S. file was to review the U.S. filing date requirements. Back then, beyond the disclosure that one needs now, one also needed a filing fee and an oath or declaration by the inventor. Attorneys were surprisingly good at finding defects in those requirements. When defects were uncovered, there went the filing date; and there went the patent. The attorneys could also find troubling things that happened in the U.S. Patent Office, such as situations in which an applicant paid the fee using his deposit account and there was not enough money in that account. Or, on occasion, the check that the applicant used to pay the fee bounced. U.S. law changed, so we do not have to worry about those types of filing date requirements anymore.

Unfortunately, Article 11,¹¹ which is the filing date provision under the treaty, developed along some of the same lines as the old U.S. filing date requirements. There are a lot of requirements in Article 11, and it has never been changed. Some things in it are maybe a little bit onerous that we could do away with, but we have not. However, this is the law. When one files an international application in a receiving office, one must have it in the prescribed language. It has to be a language that is acceptable to that receiving office. If one files in the wrong language, one does not get that filing date. If one misses that filing date, one might go beyond the Paris Convention year and could lose his or her priority date. A lot of things could happen. Furthermore, the applicant must be qualified. An applicant who is a resident or national qualifies to file. These are all Article 11 provisions and one should examine the receiving office file to be sure the Article 11 requirements were met. That is, it is wise to order the files and look especially at the receiving office file to determine for yourself if the PCT application was entitled to the international filing date that it was given.

¹¹ PCT, *supra* note 5, art 11.

D. Withdrawal

The next issue is withdrawal. What is a withdrawal? There are basically three types of withdrawals. An applicant can withdraw the priority claim asserted in the international application, he can withdraw the demand for examination, or he can withdraw the whole application. But, why would anybody want to give up any of these rights in an international application?

First, maybe the applicant did not want to have the case published, or he wanted to delay publication. Or, maybe he wanted to keep the invention as a trade secret. Then, the applicant withdraws the priority claim before technical preparation of that publication is complete, and the Bureau does not publish it. The priority date is reset if there is another priority claim. Or, if there is none, then the international filing date is used to calculate the periods running from the priority date. This type of withdrawal can give an applicant more time to make economic or business decisions. In such instances they are losing a priority claim. Sometimes, however, applicants will later reassert a priority claim in the national stage. You should review the application papers for such change.

You should look at the international preliminary examination file. Unusual things can be uncovered in such files. For example, why would an applicant ever withdraw the demand for examination? Consider the situation where an applicant gets a written opinion or a report that says some of their claims are unpatentable. If he or she gets a written opinion to that effect, the applicant considers whether amendment is possible to avoid the rejection. If the applicant can not amend, he is stuck. And perhaps he already has received a patent in one country. Maybe other countries will give the applicant patents too, but not if they see this report. So, the applicant enters the national stage and then withdraws the demand. What that means is that nothing from the examination file gets sent to any of the designated countries. It is locked up, because after publication one can see all different parts of the international application, but not the international preliminary examination material. That is the only thing that is kept confidential unless the applicant permits the examination file to be copied or reviewed. That is one reason why an applicant might want to withdraw the demand.

Why would an applicant want to withdraw the international application? Why would there ever be something like that in the file? As someone who has looked at a lot of these applications, there are many different things that could have happened. A secretary may be instructed by the attorney to withdraw an application, because the client is not paying his bills. Alternatively, the applicant may say he wants to abandon the application. Clerical mistakes can occur. A secretary could type up a letter of withdrawal for international application number five, when the attorney requested withdrawal of application number six. The attorney signs, and they send it in. Then where are they? The attorney writes a quick letter stating, "We withdrew number five. We intended to withdraw number six." The international authority would perhaps respond, "Okay. You're back in business. We're going to rescind that." Under what authority can the international authority do this? I have always wondered, how this happens, but it has happened. Is that going to be of any value to you when you are looking at the patent in this case? Perhaps. I mention this because these withdrawals and the effects of these withdrawals are something you

should look for if you want to make a proper evaluation of the validity and enforceability of the patent in question.

The Statute says if an international application is withdrawn before an applicant has entered the national stage, or before he has filed a continuation, the international application is considered not to have been filed.¹² As many people know, if a U.S. application goes abandoned, it was pending from the time it was filed until the time it went abandoned. The penalty for withdrawal is much more severe. A withdrawn application is considered as though it had never been filed. So, withdrawals are very important. One does not know how a judge would look at a withdrawn PCT application followed by a subsequent U.S. application having benefit of the PCT application, but it is my belief that there have been many of these situations.

E. Estoppel Arguments

Finally, there are estoppel arguments. Throughout the prosecution of the international application one will find statements by applicants, attorneys, and the international authorities. Explanations may accompany the applicants request for rectification of some apparently minor change. One would be amazed at the comments that applicants and attorneys provide with those changes. Applicants often do not need to put in any comments. However, they often do provide comments, and the question arises: Could such comments be estoppel arguments? Absolutely. Look especially at the Article 19¹³ and Article 34¹⁴ Amendments. Article 34 Amendments are submitted to the examiner to overcome written opinions rejections. The entire Article 34 amendment does not get forwarded to the national offices. One will find the Article 34 claims in the national stage files. One will not find the comments that were provided to the international preliminary examining authority with the Article 34 Amendments, because they are not forwarded to the national offices for the national stage files. The only way one can see the arguments is if one gets a copy from the applicant or the International Preliminary Examining Authority.

In conclusion, these are five possible issues to explore when assisting a party accused of infringement. These five issues demonstrate the importance of examining the PCT files for possible validity and enforceability issues.

¹² 35 U.S.C. § 366.

¹³ PCT, *supra* note 5, art. 19.

¹⁴ PCT, *supra* note 5, art. 34.

EXAMPLE 1: U.S. NATIONAL STAGE PATENT



(12) **United States Patent**
Polato

(10) **Patent No.:** **US 6,701,638 B1**
(45) **Date of Patent:** **Mar. 9, 2004**

(54) **MACHINE FOR CONDITIONING LAMINAR FLEXIBLE PRODUCTS SUCH AS INDUSTRIAL HIDES AND SKINS**

5,970,754 A * 10/1999 Polato 69/54
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6,178,659 B1 * 1/2001 Corner et al. 34/92

(75) **Inventor:** Antonio Polato, Mussoicento (IT)

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(73) **Assignee:** Officine di Cartigliano SpA, Cartigliano (IT)

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WO WO 95/01540 1/1995

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

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Primary Examiner—Henry Bennett
Assistant Examiner—Camia Nguyen

(21) **Appl. No.:** **10/130,436**
(22) **PCT Filed:** **Apr. 20, 2000**
(86) **PCT No.:** **PCT/IB00/00495**
§ 371 (c)(1),
(2), (4) **Date:** **May 15, 2002**
(87) **PCT Pub. No.:** **WO01/44517**
PCT Pub. Date: **Jun. 21, 2001**

(74) **Attorney, Agent, or Firm**—R. Neil Sudol; Henry D. Coleman; William J. Sapone

(57) **ABSTRACT**

A machine for the conditioning of laminar flexible products such as industrial hides and skins, including at least one conditioning unit crossed by the products to be processed, blowers for blowing and extracting air directed toward products, and a series of air jets blowing simultaneously on both sides of the products under treatment in a transverse direction with respect to the advancement direction of the products. The products are caused to advance along a substantially horizontal plane by means of pairs of annular threads uniformly distributed across the useful width of the conditioning paths. The threads of each pair are placed on opposite sides and in contact with the products to support end transfer them along the path leaving their side surfaces substantially free. As an alternative, the advancement means are formed by pairs of endless belts in mutually facing relationship to firmly hold the products while permitting passage of blown air.

(30) **Foreign Application Priority Data**

Dec. 14, 1999 (KR) 1999/57429

(51) **Int. Cl. 7** **F26B 13/00**

(52) **U.S. Cl.** **34/618; 34/92; 34/619; 34/620**

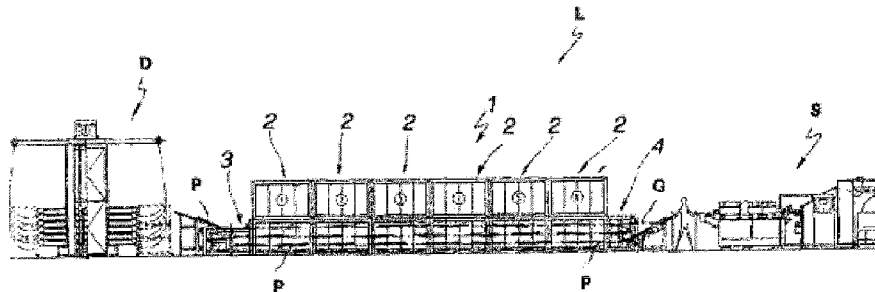
(58) **Field of Search** **34/618, 92, 77, 34/75, 619, 620, 611**

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11 Claims, 5 Drawing Sheets



EXAMPLE 2: U.S. PATENT — CONTINUATION OF PCT



US006701546B2

(12) **United States Patent**
Hodgetts

(10) **Patent No.:** US 6,701,546 B2
(45) **Date of Patent:** *Mar. 9, 2004

- (54) **PATIENT TRANSPORT SYSTEM**
- (75) Inventor: **Graham L. Hodgetts**, Baden, PA (US)
- (73) Assignee: **Barton Medical Corporation**, Austin, TX (US)
- (*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.
- This patent is subject to a terminal disclaimer.
- (21) Appl. No.: **09/945,157**
- (22) Filed: **Aug. 31, 2001**
- (65) **Prior Publication Data**
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Primary Examiner—Frederick L. Lagman
(74) *Attorney, Agent, or Firm*—Webb Ziesenheim Logsdon Orkin & Hanson, P.C.

Related U.S. Application Data

- (63) Continuation of application No. PCT/AUS00/05446, filed on Mar. 3, 2000, which is a continuation-in-part of application No. 08/440,065, filed on May 12, 1995, now Pat. No. 5,697,109, and a continuation-in-part of application No. 08/330,808, filed on Oct. 28, 1994, now Pat. No. 5,819,339.
- (60) Provisional application No. 60/122,946, filed on Mar. 5, 1999.

- (51) **Int. Cl.** A61G 7/08
- (52) **U.S. Cl.** 5/88.1; 5/81.1 R; 5/81.1 HS
- (58) **Field of Search** 5/86.1, 81.1 R, 5/88.1, 89.1, 84.1, 87.1 C, 87.1 HB

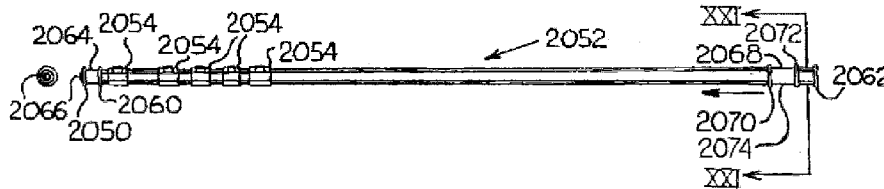
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(57) **ABSTRACT**

A wheelchair convertible into a gurney that includes a main frame, a rear frame and a supplemental rear frame pivotally secured to the rear frame. The main frame includes a back portion pivotally secured to a seat portion which is pivotally secured to a leg portion. The rear frame is pivotally secured to the back portion. A guide arrangement is provided that coacts with the supplemental rear frame and the main frame whereby the main frame is in a first position. The back portion, seat portion and leg portion are arranged so that they are in different planes and when the main frame is in a second position, the back portion, seat portion and leg portion are arranged so that they are in a gurney position.

4 Claims, 11 Drawing Sheets



EXAMPLE 3: U.S. PATENT DOMESTIC (35 U.S.C. § 120)
PRIORITY INCLUDING BENEFIT OF PCT



US006701612B2

(12) **United States Patent**
Khandros et al. (10) **Patent No.:** **US 6,701,612 B2**
(45) **Date of Patent:** **Mar. 9, 2004**

(54) **METHOD AND APPARATUS FOR SHAPING SPRING ELEMENTS**

(75) Inventors: **Igor Y. Khandros**, Livermore, CA (US); **Thomas H. Dozier**, Carrolton, CA (US); **Gary W. Grube**, Pleasanton, CA (US); **Gaetan L. Mathieu**, Dublin, CA (US)

(73) Assignee: **FormFactor, Inc.**, Livermore, CA (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 146 days.

(21) Appl. No.: **09/753,296**

(22) Filed: **Dec. 29, 2000**

(65) **Prior Publication Data**

US 2002/0145032 A1 Oct. 10, 2002

Related U.S. Application Data

- (60) Division of application No. 08/794,202, filed on Jan. 24, 1997, now Pat. No. 5,442,831, and a continuation-in-part of application No. 08/452,255, and a continuation-in-part of application No. PCT/US95/14909, filed on Nov. 13, 1995, each is a continuation-in-part of application No. 08/340,144, filed on Nov. 15, 1994, now Pat. No. 5,917,707, and a continuation-in-part of application No. PCT/US94/13373, filed on Nov. 16, 1994, each is a continuation-in-part of application No. 08/152,812, filed on Nov. 16, 1993, now Pat. No. 5,476,211, application No. 09/753,296, which is a continuation-in-part of application No. 08/602,179, filed on Feb. 15, 1996, now abandoned, and a continuation-in-part of application No. 08/584,981, filed on Jan. 11, 1996, now Pat. No. 5,820,014, and a continuation-in-part of application No. 08/573,945, filed on Dec. 18, 1995, now Pat. No. 5,601,740, and a continuation-in-part of application No. 08/558,332, filed on Nov. 15, 1995, now Pat. No. 5,829,128, and a continuation-in-part of application No. 08/554,902, filed on Nov. 9, 1995, now Pat. No. 5,974,662, and a continuation-in-part of application No. 08/533,584, filed on Oct. 18, 1995, now Pat. No. 5,772,451, and a continuation-in-part of application No. 08/526,246, filed on Sep. 21, 1995, now abandoned, each is a continuation-in-part of application No. 08/452,255.
- (60) Provisional application No. 60/005,189, filed on May 17, 1996, provisional application No. 60/013,247, filed on Mar.

11, 1996, provisional application No. 60/012,878, filed on Mar. 5, 1996, provisional application No. 60/012,040, filed on Feb. 22, 1996, and provisional application No. 60/012,027, filed on Feb. 21, 1996.

(51) **Int. Cl.**⁷ **H05K 3/00**
(52) **U.S. Cl.** **29/842; 29/843; 29/874; 324/756; 439/666; 439/591**
(58) **Field of Search** **29/842, 843, 874, 29/885; 439/81, 83**

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