

# Noli IP Newsletter

NOLI IP SOLUTIONS, PC

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## *PCT National Phase - Reinstatement or Reviving*

*By Sergio Chacon-Hoffman*

So you have now reached the end of the PCT international application and you must make a decision on where to file applications (called national and/or regional phase) and you are not ready. Can any of these entries be

3. Yes, with the payment of fee and within reasonable time.

PCT Rule 49.6 states that the request to reinstate the applicant's rights after the failure to perform the acts

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postponed?

You will find three options at the PCT member states national patent offices:

1. Not in your life will we extend the date.
2. We will petition with fee and see what the Examiner says.

referred in article 22 shall be submitted to the designated Office, and the acts referred to in Article 22 shall be performed, within whichever of the following periods expires first:

1. Two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22; or

## *"Beyond Making Drawings"*

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Lou Janesko has been producing quality patent drawings for attorneys for over fifteen years from his studio near Washington, DC. Many of the utility & design patents he has drawn are for companies who are leading in their respective industries. Those products have included tools, medical and dental devices, exercise equipment, sports apparel, bicycle parts, auto body design and parts, alternative energy devices, pet products, digital entertainment products and complex charts and graphs required in high-technology applications. Lou's background in fine art and graphic design adds robust value to his professional services offered to clients...

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2. 12 months from the date of the expiration of the applicable time limit under Article 22.

Even though all countries do abide by the 30/31 month rule, some allow for a grace period in which the PCT application can be reinstated or revived to thereby allow for the national stage application to be filed even later than 30 or 31 months. The following are examples of some such countries often of interest to US applicants:

### **AUSTRALIA**

AU.16 Excuse of Delay in Meeting Time Limits. Reference is made to paragraphs 6.022 to 6.027 of the National Phase.

If, due to an error or omission on the part of the applicant, his agent or attorney, or due to circumstances beyond the control of the person concerned, the applicant has failed to observe a time limit which is prejudicial to his rights, or the Commissioner is satisfied that the person took due care as required by the circumstances, to ensure the doing of the act within that time, he may request the Office to extend the time limit even though that time has

already expired. The request must be presented in writing, with Form P/00/013, and establish the facts on which the request is based in a declaration (see Annex AU.V), and also must be accompanied by a fee (for the amount of the fee, see Annex AU.I).

### **BRAZIL**

BR.13 Excuse of Delays in Meeting Time Limits. The Office does not excuse the failure to comply with a time limit, neither during the international phase nor during the national phase, unless otherwise specified in this Chapter, although, in specific cases considered as force majeure cases, the delay may be excused.

### **CANADA**

The deadline for filing a national stage application of a PCT with the Canadian Intellectual Property Office (CIPO) is thirty (30) months. After this deadline passes, the PCT will be deemed abandoned. However, Canada has a very forgiving grace period of twelve (12) months. Upon payment of a governmental surcharge, the applicant then has a total of forty two (42) months from

the priority date to supply all the papers necessary to complete the national stage application.

### **CHINA**

The deadline for filing a national stage application of a PCT is thirty (30) months from the priority date. Again, after this deadline, the PCT is deemed abandoned. A two (2) month grace period exists in China, however, which allows the Chinese national stage to be entered up to thirty two (32) months after the priority date. To take advantage of this grace period a surcharge must be paid and all application papers must be complete by the 32nd month.

### **EPO**

The deadline for filing a national stage application in the European Patent Office (EPO) is thirty one (31) months. However, assuming the PCT application was filed designating the EPO as a potential region in which to file a national stage, additional time may be afforded up to a total of forty (40) months from the priority date. After the 31st month has passed, the EPO will issue a "Notification of Loss of Rights" to the applicant.

Under Article 121 of the EPC, the applicant then has a period of two months from the date of the Notification in which to supply all the necessary application papers. A surcharge to the EPO is also necessary.

### **JAPAN**

The deadline for filing a national stage application in Japan is thirty (30) months. No grace period per se exists in Japan, but as Japanese translations are required with every application not provided in Japanese, the JPO allows an additional two (2) months from filing the national stage application in which to supply the necessary translation.

### **NEW ZEALAND**

In New Zealand, then the normal deadline by which to complete the filing requirements is 31 months. However, late entry is possible where it is 'unintentional' and there has been no undue delay in entering the national phase. It is necessary to file evidence in support and providing reasons and this must be

completed within 2 months of entering the national phase late.

### **SINGAPORE**

Offers a 3-month extension from the 30-month deadline. No reasons for the delay are required, but paying a fee of S\$200 (US\$158) for each month of delay is necessary. Beyond the available three months, any further extension granted will be at the discretion of the Registrar and must be accompanied by a statutory declaration or affidavit detailing the grounds for the longer extension of time. Singapore does apply PCT Rule 49.6 for reinstatement of rights. They will consider requests for reinstatement based on either the "unintentional" or the "in spite of due care" standard. Filing in English.

### **SOUTH AFRICA**

The deadline for filing national phase applications in terms of PCT Chapter I and Chapter II is 31 months from the earliest priority date. This deadline may be extended by 3 months to 34 months from the earliest priority date.

### **CONCLUSION**

The initial question was: "Late national phase entry: can it be done?" The answer is "Yes" in many cases. There are a few countries that have no provisions for late entry. Others routinely offer additional time or have provisions for paid extensions of time. Still others consider the international application withdrawn if entry is not timely made. In many of these countries, reinstatement of rights is available under PCT Rule 49.6 or similar national provisions. For reinstatement, a showing that the deadline was missed unintentionally or in spite of due care is generally required (along with any associated fees). The details of the procedures for each PCT contracting state can be found in the National Chapter annexed to the PCT Applicant's Guide coupled with the details according to local practice supplied by a local patent agent.

## Software Inventions: Can I get a Patent?

By Karim Lagobi and Mariana Noli

We have been asked this question many times before. From prospective to existing clients, from inventors to entrepreneurs. Everyone wants to know the answer to the question: "Can I get a patent on software?"

It calls for a yes or no reply but as simple as it sounds, this question is never as easy to answer. Some countries, such as the U.S., issue software patents. Other countries, such as Argentina, exclude computer programs as patentable inventions.

In the U.S., "whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof, may obtain a patent, subject to (certain) conditions and requirements..." Thus, you should be able to get a patent as long as the computer software complies with the general requirements of Section 101 of the U.S. Patent Act that is (1) to be statutory, (2) new, (3) useful, and (4) non-obvious.

In Argentina, regardless of the exclusion of computer

programs as patentable inventions, the debate on the patentability of software continues. The Argentine Patent Law excludes computer programs as such because they are considered intellectual creation without industrial character.

Software, as an intangible creation is protected by copyrights.

There are many reasons why the answer to this question could be crucial to your business' success. If you do not take the proper steps to timely protect your invention, you may lose your rights forever.

The typical steps we advise our clients to take toward preparing and filing patent applications start with a meeting between the patent attorney or agent and the inventors, during which the general concept of the invention (or inventions as may be the case) is disclosed. Questions such as how the invention is implemented and used according to the requirements for patent disclosure will be discussed as well as the prior art. Further,

it should be examined how the exiting technology fails to fulfill the specific need filled with the present invention, or how (and in which ways) the present invention improves upon the prior art.

Our patent team at NOLI IP Solutions PC requires the following information to file a software patent application: (1) A description of the problem to be solved; (2) A description of the prior art; (3) A description of how the software is implemented i.e. method steps, system network requirements, etc.; (4) drawing/s of the invention whether in the form of block diagrams, flowcharts, etc.; and (5) A clear indication as to what the inventor(s) regard as the invention, which will determine the claims.

Based on the disclosure alone in person with the inventors we can assess the amount of time that will be required to prepare a first draft. If you have further questions, or wish estimates for filing a new application, please do not hesitate to contact us at [mail@noli-ipsolutions.com](mailto:mail@noli-ipsolutions.com).

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*“My dedication to the IP profession goes beyond making drawings. One of the patent firms I’ve worked with had sent me directly to consult with an examiner at the Patent Office in Alexandria to insure that a difficult-to-illustrate product would be drawn exactly as required. The patent firm’s client was extremely pleased with the formal drawing and successful application.”*

*“Another company with an inventive dental device hired me to first produce patent drawings for their various applications. Eventually, their unique product required a full-blown color illustration for marketing purposes which I was also able to deliver to them.”*

Lou produces formal patent drawings on computer for easy modification and delivered as PDFs and he is able to work from emailed sketches, photos or

prototypes on fast-track turnaround.

Ms. Mariana Noli had the opportunity to work with Lou for the first time over a decade ago and it is our pleasure to announce that Lou will be strategically aligned with Noli IP Solutions PC to provide many of the services mentioned above for our clients.

## ASIPI turns 50 years old!

Ms. Noli recently had the privilege to represent Noli IP Solutions, PC. at the historical work sessions in the 50 years anniversary of ASIPI (Inter-American Association of Intellectual Property) which was held at the Hilton Hotel on November 31-December 3, 2014 in Mexico City.

For more information on the work of this organization, please visit:

<http://www.asipi.org/en/content/www/historical-work-sessions-50-years-asipi-mexico-city>

