

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Considerations and Options for Foreign Filing Including the PCT

Layla Lauchman
Special Programs Examiner
International Patent Legal Administration
United States Patent & Trademark Office

Email questions to:
inventorinfochat@uspto.gov

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PATENT AND TRADEMARK OFFICE



Office of Innovation Development

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Overview

- Information about foreign patents
- General considerations in deciding whether to pursue patent protection outside of the United States
- Options available for pursuing foreign patent protection
- Review the structure and function of the Patent Cooperation Treaty (PCT)
- Avoiding common mistakes

Foreign Patent Protection

- Patent protection can be an important part of overall business strategy in today's global marketplace
- In general, patent rights are territorial in nature
 - Protect against infringing activities occurring within the country or region in which the patent was granted
- To obtain patent rights in foreign countries, U.S. applicants must apply for a patent in each country or region of interest
 - A world-wide patent does not exist



Who Grants Patents?

- National patent offices
 - *E.g.*, USPTO, JPO, KIPO, *etc.*
- Regional patent offices
 - Grants patents with effect in some or all member countries
 - European Patent Office (EPO)
 - African Regional Intellectual Property Organization (ARIPO)
 - Eurasian Patent Convention (EA)
 - African Intellectual Property Organization (OAPI)
 - Patent Office of the Gulf Cooperation Council (GCC)



Regional Patent Offices

AP (ARIPO)

BW Botswana
GH Ghana
GM Gambia
KE Kenya
LR Liberia
LS Lesotho
MW Malawi
MZ Mozambique
NA Namibia
RW Rwanda
SD Sudan
SL Sierra Leone
SZ Swaziland
TZ United Republic of Tanzania
UG Uganda
ZM Zambia
ZW Zimbabwe

EP (EPO)

AL	Albania	IS	Iceland
AT	Austria	IT	Italy
BE	Belgium	LI	Liechtenstein
BG	Bulgaria	LT	Lithuania
CH	Switzerland	LU	Luxembourg
CY	Cyprus	LV	Latvia
CZ	Czech Republic	MC	Monaco
DE	Germany	MK	Macedonia
DK	Denmark	MT	Malta
EE	Estonia	NL	Netherlands
ES	Spain	NO	Norway
FI	Finland	PL	Poland
FR	France	PT	Portugal
GB	United Kingdom	RO	Romania
GR	Greece	RS	Serbia
HR	Croatia	SE	Sweden
HU	Hungary	SI	Slovenia
IE	Ireland	SK	Slovakia
		SM	San Marino
		TR	Turkey

OA (OAPI)

BF Burkina Faso
BJ Benin
CF Central African Rep.
CG Congo
CI Côte d'Ivoire
CM Cameroon
GA Gabon
GN Guinea
GQ Equatorial Guinea
GW Guinea-Bissau
ML Mali
MR Mauritania
NE Niger
SN Senegal
TD Chad
TG Togo

EA (EA)

AM Armenia
AZ Azerbaijan
BY Belarus
KG Kyrgyzstan
KZ Kazakhstan
RU Russian Fed.
TJ Tajikistan
TM Turkmenistan

EP (EPO) Extension Countries

BA Bosnia and Herzegovina
ME Montenegro
MA Morocco
MD Republic of Moldova

GC (GCC)

BL Bahrain
KW Kuwait
OM Oman
QA Qatar
SA Saudi Arabia
AE United Arab Emirates

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General Considerations in Filing Foreign Patent Applications (1)

- Market size and potential of country/region
- Manufacturing potential
- Industry size and growth
- Competition activity
- Patent procurement costs



General Considerations in Filing Foreign Patent Applications (2)

- Patent law considerations
 - Standards of patentability in country/region
 - Patentable subject matter differences
 - Prior art differences
 - Grace periods
 - Geographical restrictions
 - First-to-file
 - Enforceability of patents
 - Does the country/region have effective laws and procedures for enforcing the patent?



Options for Foreign Filing

- **File a patent application directly in a national or regional patent office (Paris Convention)**
 - A foreign filing license from the USPTO may be required
- **File an international patent application under the Patent Cooperation Treaty (PCT)**
 - A foreign filing license from the USPTO may be required, if filing in a foreign receiving Office



International Agreements and Treaties

Governing Priority (1)

- Paris Convention

- Provides applicant with a 12-month right of priority, triggered by the first filing of a patent application, in which to file a subsequent application in another Paris Convention member country for the same invention
 - The subsequent application must claim the priority of the first application in order to make use of the right of priority
- Most countries are party to the Paris Convention
 - Currently 177 Contracting Parties
- Excludes countries not recognized by the United Nations, *e.g.*, Taiwan

International Agreements and Treaties Governing Priority (2)

- Patent Cooperation Treaty (PCT)
 - Effectively permits the filing of a single international application to be treated as “a regular national application in each designated State as of the international filing date” (PCT Article 11)
 - Currently 152 Contracting States are party to the PCT

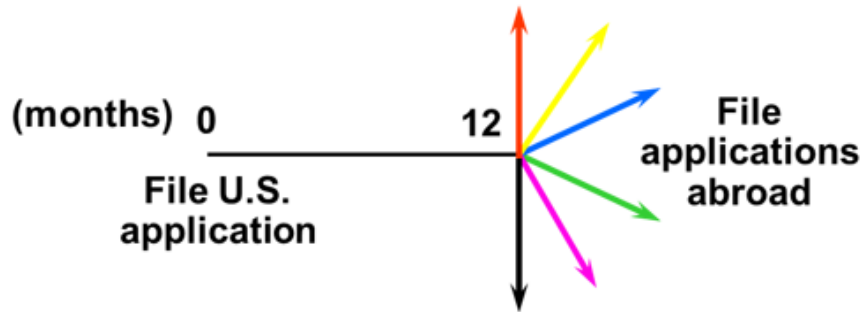


Direct Filing in a Foreign National or Regional Patent Office

- May be cost effective if filing in only a few countries
- Applicant is certain as to which countries applications are to be filed
- Applicant is prepared to pay the filing costs early
 - *E.g.*, filing fees, translation costs, attorney fees
- Necessary for countries not party to the PCT



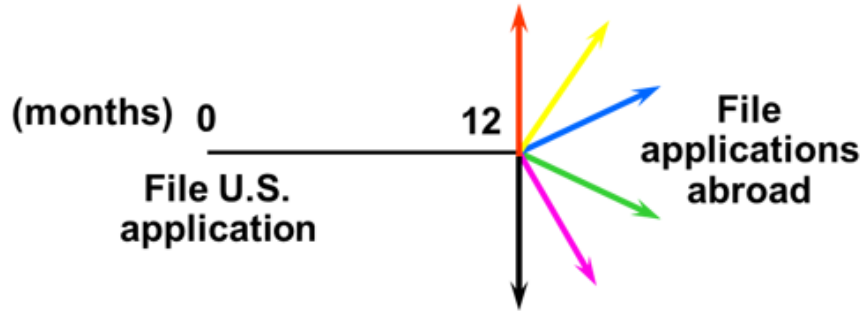
Example: Direct Foreign Filing under the Paris Convention (1)



- U.S. patent application followed within 12 months by one or more foreign applications filed in Paris Convention or WTO member countries
- The foreign application(s) may claim priority to the earlier U.S. application
- If the invention in the foreign application(s) is entitled to the priority, the filing date of the U.S. application will be used for prior art purposes

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Example: Direct Foreign Filing under the Paris Convention (2)



- Some additional considerations when multiple foreign applications at 12 months and claiming priority under the Paris Convention
 - Multiple formality requirements
 - Multiple prosecutions of applications
 - Translations and national/regional fees required at 12 months

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The Patent Cooperation Treaty

- A United Nations Treaty
 - Signed June 1970
 - Became operational June 1978
 - Administered by the International Bureau (IB)
 - Of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland



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International Patent?

- An international application is filed under the PCT but...
 - There is no “international patent”
 - The PCT functions as a patent application filing system
 - The international application must still be prosecuted
 - In each national or regional office where patent protection is desired



Purposes of the PCT

- To simplify the process of filing foreign patent applications
- To give every regional and national patent Office and the applicant the benefit of
 - A search and written opinion on patentability by an International Searching Authority (ISA)
 - An optional further examination by an International Preliminary Examining Authority (IPEA)

PCT Contracting State

- A country which is a signatory to the PCT
- Eighteen (18) Contracting States in 1978
- Currently 152 Contracting States
 - Jordan became bound by the PCT on 09 June 2017

Current List of PCT Contracting States

AE United Arab Emirates	CU Cuba	IR Iran (Islamic Republic of)	MG Madagascar	SD Sudan (AP)
AG Antigua and Barbuda	CY Cyprus (EP) ²	IS Iceland (EP)	MK The former Yugoslav Republic of Macedonia (EP)	SE Sweden (EP)
AL Albania (EP)	CZ Czechia (EP)	IT Italy (EP) ²	ML Mali (OA) ²	SG Singapore
AM Armenia (EA)	DE Germany (EP)	JO Jordan	MN Mongolia	SI Slovenia (EP) ²
AO Angola	DJ Djibouti	JP Japan	MR Mauritania (OA) ²	SK Slovakia (EP)
AT Austria (EP)	DK Denmark (EP)	KE Kenya (AP)	MT Malta (EP) ²	SL Sierra Leone (AP)
AU Australia	DM Dominica	KG Kyrgyzstan (EA)	MW Malawi (AP)	SM San Marino (EP)
AZ Azerbaijan (EA)	DO Dominican Republic	KH Cambodia	MX Mexico	SN Senegal (OA) ²
BA Bosnia and Herzegovina ¹	DZ Algeria	KM Comoros (OA) ²	MY Malaysia	ST Sao Tome and Principe (AP)
BB Barbados	EC Ecuador	KN Saint Kitts and Nevis	MZ Mozambique (AP)	SV El Salvador
BE Belgium (EP) ²	EE Estonia (EP)	KP Democratic People's Republic of Korea	NA Namibia (AP)	SY Syrian Arab Republic
BF Burkina Faso (OA) ²	EG Egypt	KR Republic of Korea	NE Niger (OA) ²	SZ Swaziland (AP) ²
BG Bulgaria (EP)	ES Spain (EP)	KW Kuwait	NG Nigeria	TD Chad (OA) ²
BH Bahrain	FI Finland (EP)	KZ Kazakhstan (EA)	NI Nicaragua	TG Togo (OA) ²
BJ Benin (OA) ²	FR France (EP) ²	LA Lao People's Democratic Republic	NL Netherlands (EP) ²	TH Thailand
BN Brunei Darussalam	GA Gabon (OA) ²	LC Saint Lucia	NO Norway (EP)	TJ Tajikistan (EA)
BR Brazil	GB United Kingdom (EP)	LI Liechtenstein (EP)	NZ New Zealand	TM Turkmenistan (EA)
BW Botswana (AP)	GD Grenada	LK Sri Lanka	OM Oman	TN Tunisia
BY Belarus (EA)	GE Georgia	LR Liberia (AP)	PA Panama	TR Turkey (EP)
BZ Belize	GH Ghana (AP)	LS Lesotho (AP)	PE Peru	TT Trinidad and Tobago
CA Canada	GM Gambia (AP)	LT Lithuania (EP) ²	PG Papua New Guinea	TZ United Republic of Tanzania (AP)
CF Central African Republic (OA) ²	GN Guinea (OA) ²	LU Luxembourg (EP)	PH Philippines	UA Ukraine
CG Congo (OA) ²	GQ Equatorial Guinea (OA) ²	LV Latvia (EP) ²	PL Poland (EP)	UG Uganda (AP)
CH Switzerland (EP)	GR Greece (EP) ²	LY Libya	PT Portugal (EP)	US United States of America
CI Côte d'Ivoire (OA) ²	GT Guatemala	MA Morocco ³	QA Qatar	UZ Uzbekistan
CL Chile	GW Guinea-Bissau (OA) ²	MC Monaco (EP) ²	RO Romania (EP)	VC Saint Vincent and the Grenadines
CM Cameroon (OA) ²	HN Honduras	MD Republic of Moldova ⁴	RS Serbia (EP)	VN Viet Nam
CN China	HR Croatia (EP)	ME Montenegro ¹	RU Russian Federation (EA)	ZA South Africa
CO Colombia	HU Hungary (EP)		RW Rwanda (AP)	ZM Zambia (AP)
CR Costa Rica	ID Indonesia		SA Saudi Arabia	ZW Zimbabwe (AP)
	IE Ireland (EP) ²		SC Seychelles	
	IL Israel			
	IN India			

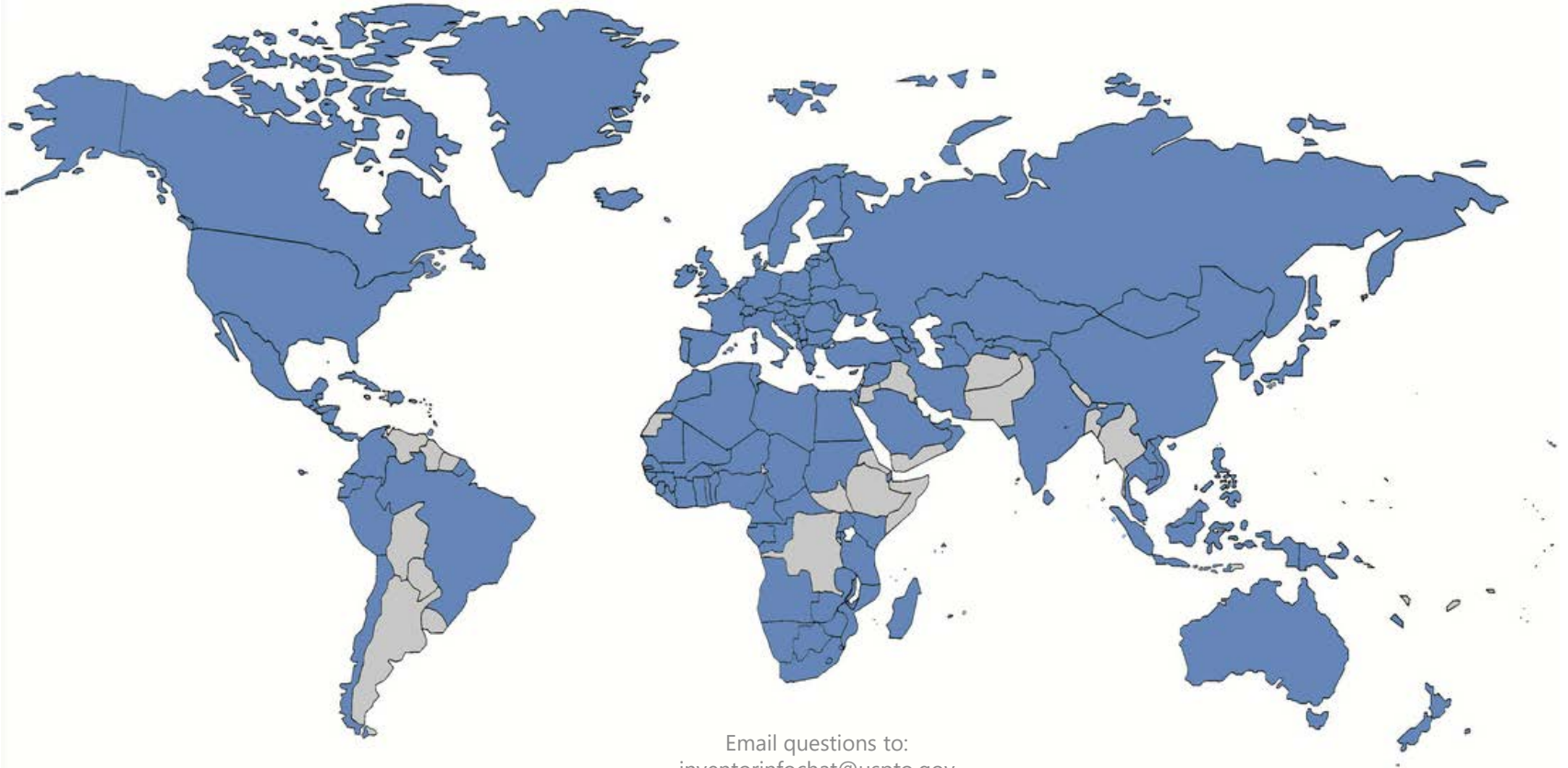
1 Extension of European patent possible.

2 May only be designated for a regional patent (the "national route" via the PCT has been closed).

3 Validation of European patent possible for international applications filed on or after 1 March 2015.

4 Validation of European patent possible for international applications filed on or after 1 November 2015.

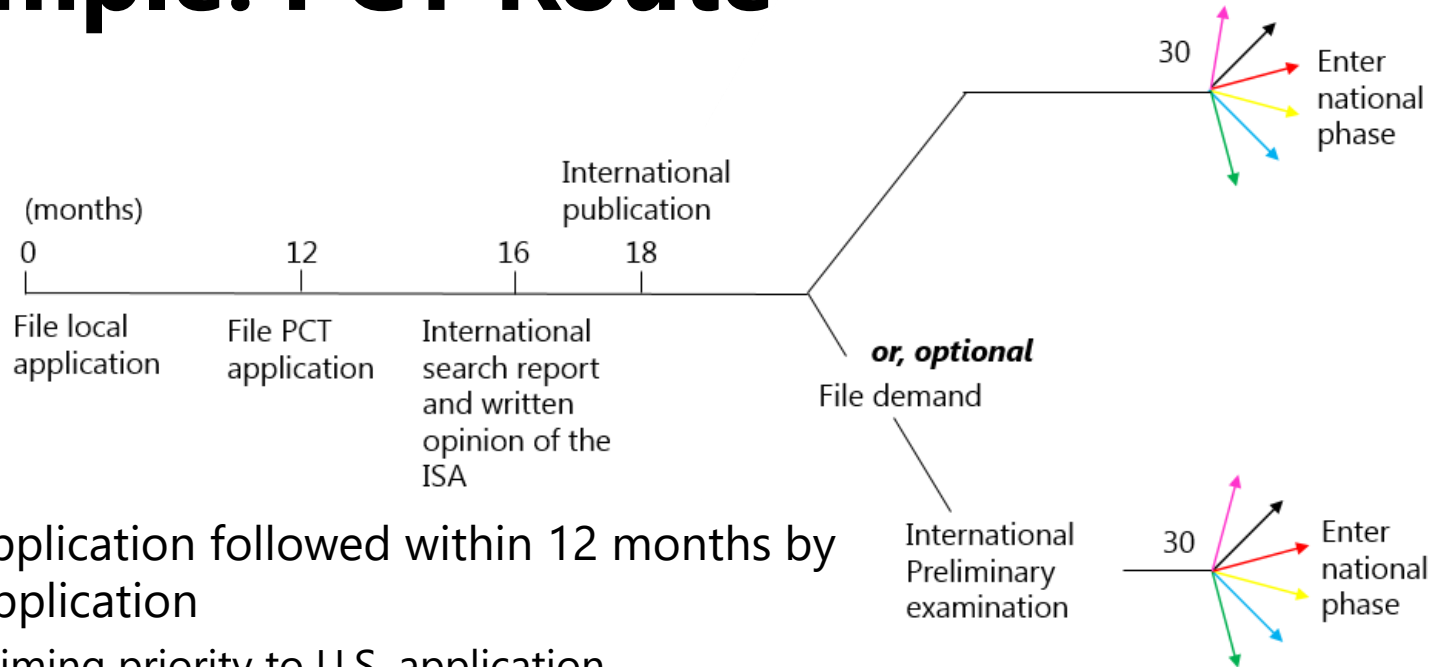
PCT World Map



The International Application

- A single application
 - Filed together with a request
 - By a resident/national of a PCT contracting state
 - Filed in one language
 - Filed in one patent office
 - The receiving office (RO)
 - Usually the applicant's home patent office
 - Treated as a national application
 - In each designated state as of the international filing date (IFD)
- Formalities in compliance with the PCT
 - Must be accepted during national phase

Example: PCT Route



- U.S. application followed within 12 months by PCT application
 - Claiming priority to U.S. application
 - One set of formalities requirements
 - Translations and national/regional fees and prosecution not required until 30 months

Two Phases of the PCT

- International phase
 - Chapter I (mandatory)
 - Chapter II (optional)
- National phase (stage)

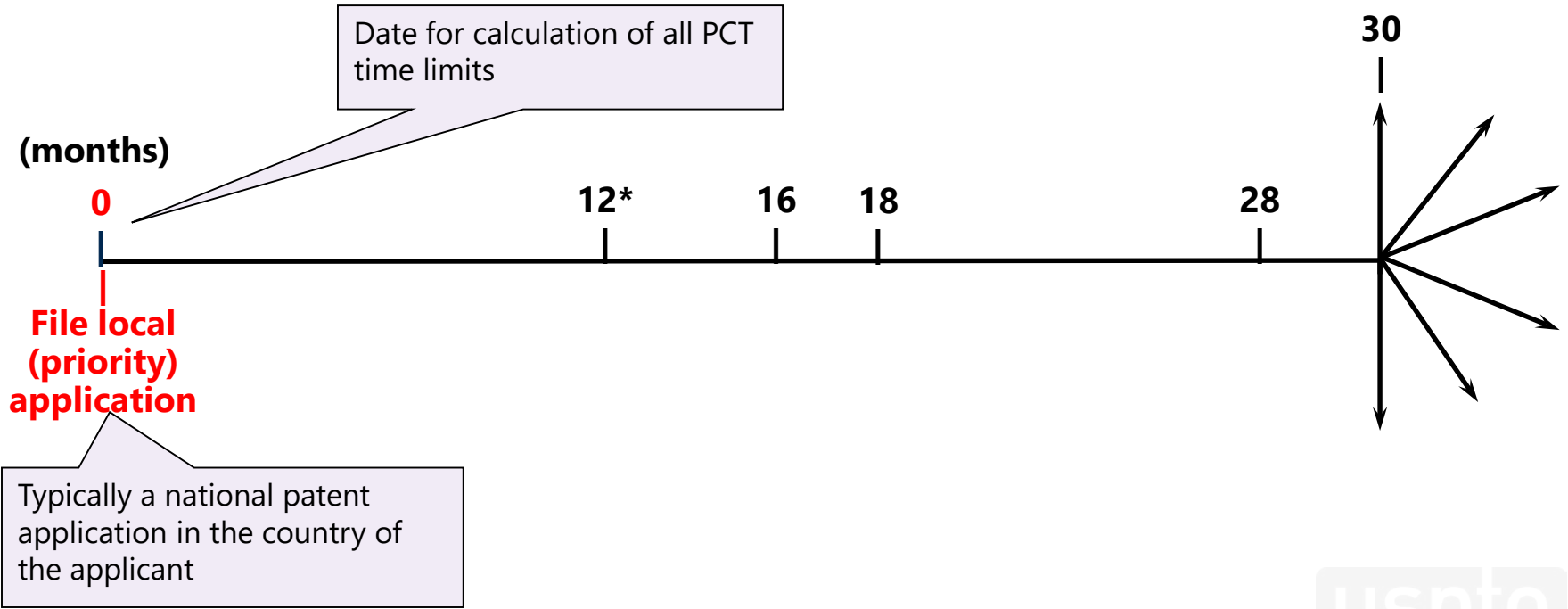
Chapter I

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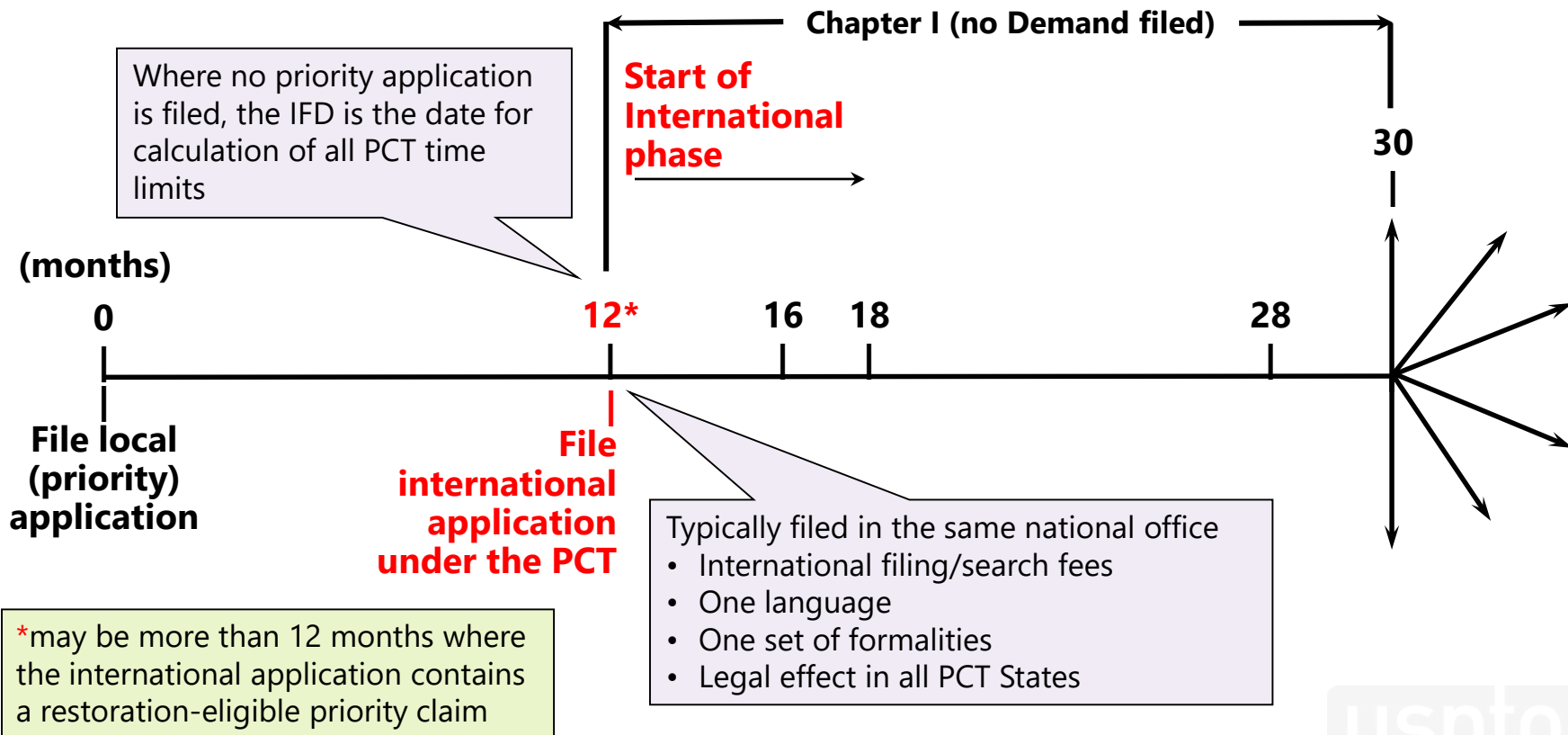
PCT System

Priority Application Filed



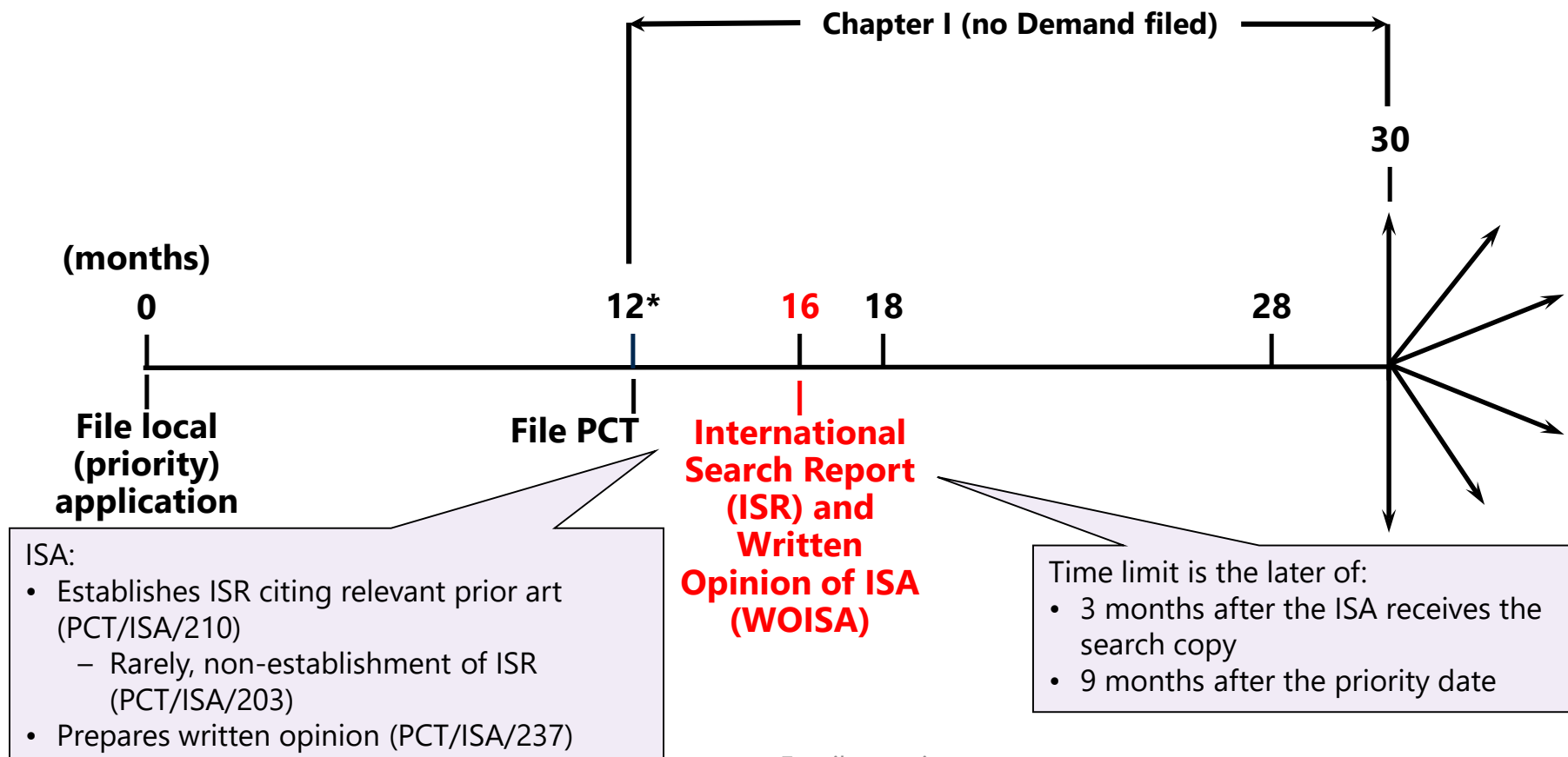
PCT System – Chapter I

International Application Filed



PCT System – Chapter I

ISR and WOISA Issued



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PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference BERK-239WO	FOR FURTHER ACTION	see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No. PCT/US15/25147	International filing date (day/month/year) 09 April 2015 (09.04.2015)	(Earliest) Priority Date (day/month/year) 10 April 2014 (10.04.2014)
Applicant THE REGENTS OF THE UNIVERSITY OF CALIFORNIA		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 4 sheets.
 It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the **language**, the international search was carried out on the basis of:

- the international application in the language in which it was filed.
- a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

b. This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.6bis(a)).

c. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. **Certain claims were found unsearchable** (see Box No. II).

3. **Unity of invention is lacking** (see Box No. III).

4. With regard to the **title**,

- the text is approved as submitted by the applicant.
- the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

- the text is approved as submitted by the applicant.
- the text has been established, according to Rule 38.2, by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. 1A

- as suggested by the applicant.
- as selected by this Authority, because the applicant failed to suggest a figure.
- as selected by this Authority, because this figure better characterizes the invention.

b. none of the figures is to be published with the abstract.

International Search Report

Form PCT/ISA/210
(first sheet)

Indications concerning:

- Basis of the report
- Unsearchable claims
- Unity of Invention
- Title and abstract
- Figure to be published



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INTERNATIONAL SEARCH REPORT		International application No. PCT/US15/25147
A. CLASSIFICATION OF SUBJECT MATTER IPC(8) - C12N 15/63; C12P 19/34; C07K 14/195 (2015.01) CPC - C12N 15/63; C07H 21/02; C07K 14/195 According to International Patent Classification (IPC) or to both national classification and IPC		
B. FIELDS SEARCHED Minimum documentation searched (classification system followed by classification symbols) IPC(8): C12N 15/63, 15/00; C12P 19/34; C07H 21/02; C07K 14/195 (2015.01) CPC: C12N 15/63; C07H 21/02; C07K 14/195; USPC: 435/91.1, 440, 455, 89, 85, 84, 72, 41; 536/23.1, 22.1, 18.7, 1.11 Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched Electronic data base consulted during the international search (name of data base and, where practicable, search terms used) Patseer (US, EP, WO, JP, DE, GB, CN, FR, KR, ES, AU, IN, CA, INPADOC); TheLens.org PatSeq; PubMed/NCBI Blast; EBSCO; Google; Google Scholar; target, 'nucleic acid', 'RNA', nucleotide, Argonaute, Ago, protein, 'Marinitoga piezophila', mpago, 'Guide RNA', 'gRNA', 'Targeting nucleotide sequence', 'binding, complementary, homologous, 'expression vector', 'modified cell', 'kit		
C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 2006/0141600 A1 (JOSHUA-TOR, L et al.) June 29, 2006; paragraphs [0015], [0134]-[0138]	1-4, 47-49, 51-53, 55-58
A	US 2013/0217592 A1 (THE WASHINGTON UNIVERSITY) August 22, 2013; paragraph [0022]	1-4, 47-49, 51-53, 55-58
A	LUCAS, S et al. Complete Genome Sequence Of The Thermophilic, Piezophilic, Heterotrophic Bacterium Marinitoga piezophila KA3. J Bacteriol. November 2012, Vol. 194, No. 21; pages 5974-5975; Genbank Supplement, pages 1, 2; DOI: 10.1128/JB.01430-12.	1-4, 47-49, 51-53, 55-58
A	WO 2007/092181 A2 (UNIVERSITY OF MASSACHUSETTS) August 16, 2007; abstract	1-4, 47-49, 51-53, 55-58
A	WO 2007/048629 A2 (MAX-PLANCK-GESELLSCHAFT ZUR FORDERUNG DER WISSENSCHAFTEN E.V.) May 3, 2007; abstract	1-4, 47-49, 51-53, 55-58
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.		
* Special categories of cited documents: "A" document defining the general state of the art which is not considered to be of particular relevance "E" earlier application or patent but published on or after the international filing date "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but later than the priority date claimed "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art "G" document member of the same patent family		
Date of the actual completion of the international search 10 July 2015 (10.07.2015)	Date of mailing of the international search report 28 JUL 2015	
Name and mailing address of the ISA/ Mail Stop PCT, Attn: ISA/US, Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 Facsimile No. 571-273-8300	Authorized officer Shane Thomas PCT Helpdesk: 571-272-4300 PCT OSP: 571-272-7774	

International Search Report

Form PCT/ISA/210
(second sheet)

Documents
Considered to be
Relevant



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International Search Report Cited Documents (References)

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X ---- Y	US 2007/0125844 A1 (LIBIN et al.) 07 June 2007 (07.06.2007), entire document, especially para [0002]-[0003], [0005], [0015]-[0017], [0021]-[0025], [0030], [0036] and abstract	1-2, 4-5, 7-15, 17-18, 20-22 ----- 3, 6, 16, 19
Y	US 2005/0222873 A1 (NEPHIN et al.) 06 October 2005 (06.10.2005), entire document, especially para [0102], [0223]-[0227]	3, 6, 16, 19
A	US 2009/0043611 A1 (NADAS et al.) 12 February 2009 (12.02.2009)	1-22
A	US 2005/0086071 A1 (FOX et al.) 21 April 2005 (21.04.2005)	1-22
A	US 2008/0149701 A1 (LANE) 26 June 2008 (26.06.2008)	1-22

Document Categories

Document Citations & Relevant Passages



Three Main Categories of Prior Art in an International Search Report

- “X” document
 - Claimed invention lacks
 - Novelty, or
 - Inventive step when considered alone (lacks inventive step = obvious)
 - “Stand alone” reference
- “Y” documents
 - Claimed invention lacks inventive step
 - When two or more documents are used in combination
- “A” document
 - General state of the art reference

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To: Paula A. Borden
1900 University Circle, Suite 200
East Palo Alto, California 94303
United States of America

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY
(PCT Rule 43bis.1)

Date of mailing
(day/month/year) **2 8 JUL 2015**

Applicant's or agent's file reference
BERK-239WO

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/US15/25147

International filing date (day/month/year)
09 April 2015 (09.04.2015)

Priority date (day/month/year)
10 April 2014 (10.04.2014)

International Patent Classification (IPC) or both national classification and IPC
IPC(8) - C12N 15/63; C12P 19/34; C07K 14/195 (2015.01)
CPC - C12N 15/63; C07H 21/02; C07K 14/195

Applicant **THE REGENTS OF THE UNIVERSITY OF CALIFORNIA**

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

Name and mailing address of the ISA/
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450, Alexandria, Virginia 22313-1450
Facsimile No. 571-273-8300

Date of completion of this opinion
10 July 2015 (10.07.2015)

Authorized officer:
Shane Thomas
PCT Helpdesk: 571-272-4300
PCT OSP: 571-272-7774

Written Opinion of the ISA (Cover Sheet)

Form PCT/ISA/237
(cover sheet)



Contents of the Written
Opinion of the ISA



Written Opinion of the ISA

Basis of this Opinion

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY		International application No. PCT/US15/25147
Box No. I	Basis of this opinion	
1.	With regard to the language , this opinion has been established on the basis of: <input checked="" type="checkbox"/> the international application in the language in which it was filed. <input type="checkbox"/> a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).	
2.	<input type="checkbox"/> This opinion has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a)).	
3.	<input checked="" type="checkbox"/> With regard to any nucleotide and/or amino acid sequence disclosed in the international application, this opinion has been established on the basis of a sequence listing: a. <input checked="" type="checkbox"/> forming part of the international application as filed: <input checked="" type="checkbox"/> in the form of an Annex C/ST.25 text file. <input type="checkbox"/> on paper or in the form of an image file. b. <input type="checkbox"/> furnished together with the international application under PCT Rule 13ter.1(a) for the purposes of international search only in the form of an Annex C/ST.25 text file. c. <input type="checkbox"/> furnished subsequent to the international filing date for the purposes of international search only: <input type="checkbox"/> in the form of an Annex C/ST.25 text file (Rule 13ter.1(a)). <input type="checkbox"/> on paper or in the form of an image file (Rule 13ter.1(b) and Administrative Instructions, Section 713).	
4.	<input type="checkbox"/> In addition, in the case that more than one version or copy of a sequence listing has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that forming part of the application as filed or does not go beyond the application as filed, as appropriate, were furnished.	
5.	Additional comments:	

Form PCT/ISA/237
Box No. I

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	4-5, 11-12, 15-16, 18-19	YES
	Claims	1-3, 6-10, 13-14, 17, 20	NO
Inventive step (IS)	Claims	None	YES
	Claims	1-20	NO
Industrial applicability (IA)	Claims	1-20	YES
	Claims	None	NO

2. Citations and explanations:

Claims 1-3, 6-10, 13-14, 17, and 20 lack novelty under PCT Article 33(2) as being anticipated by US 2003/0004859 A1 to Shaw et al. (hereinafter "Shaw").

Regarding claims 1 and 14, Shaw teaches a method, and computer readable medium, for smart matching electronic orders for a tradeable object, comprising: comparing a new working order to at least one pending order prior to submitting the new working order to an electronic exchange for trading, where the new working order is for a first quantity for a tradeable object and the pending order is for a second quantity for the tradeable object, the new working order and the at least one pending order derived from at least one common trading strategy of one or more traders (a system automatically pairs users who have similarly entered counter-side transactional interest indications in the same item, where a secure station stores user data and transaction data in the form of multiple prospective transaction entries received from the user terminals, each entry including a fungible item indication and a transaction side indication identifying one of two opposing transaction sides, and where a search component is operatively coupled to the memory and adapted to perform a comparison of the stored entries with respect to the fungible item indications and the transaction side indications, and, based on that comparison, the search component selects sets of two or more stored entries as matching entries having the same fungible item indication and together including transaction side indications identifying the opposing transaction sides, para [0018], [0027], [0029], [0143]); in response to comparing, determining that the new working order and the at least one pending order are contra orders and have a common price (counter, or contra, side transactions are identified, para [0018], [0027], [0029]); matching at least a portion of the first quantity of the new working order and at least a portion of the second quantity of the pending order (the contra-side orders are matched, para [0018], [0027], [0029]); and reporting a match of the working order and the pending order (the transaction is reported, para [0174]).

Regarding claim 2, Shaw teaches where matching comprises matching the first quantity of the new working order and at least a portion of the second quantity of the pending order via the computing device (a set of matching entries is realized if the members of the potential set include at least one entry on each side of the transaction, para [0027], [0029]).

Regarding claim 3, Shaw teaches reporting a match of the first quantity of the new working order (a particular transaction is reported, para [0174]).

Regarding claims 6 and 17, Shaw teaches submitting a message to the electronic exchange to delete the at least a portion of the second quantity (personalized user page allows users to enter, modify, monitor, and delete indications of transaction interest, para [0082], [0091], [0097], [0101]).

Regarding claim 7, Shaw teaches sending a cancel/replace message to the electronic exchange to cancel and replace the pending order with a new pending order (personalized user page allows users to enter, modify, monitor, and delete indications of transaction interest, para [0082], [0091], [0097], [0101]).

Regarding claim 8, Shaw teaches where the new pending order comprises a remainder of the second quantity not matched with the new working order (the remainder of shares not within a single transaction are apportioned among several parties, para [0161]).

Regarding claim 9, Shaw teaches where matching comprises matching at least a portion the first quantity of the new working order and the second quantity of the pending order (the proposed buy and sell orders are matched, para [0027], [0029], [0079], [0161], [0190]).

Regarding claim 10, Shaw teaches reporting a match of the second quantity of the pending order (the transaction is reported, para [0174]).

Regarding claim 13, Shaw teaches where the new working order comprises an outright order (buy and sell orders, para [0079], [0190]).

--CONTINUED IN SUPPLEMENTAL BOX--

Written Opinion of the ISA - Reasoned Statement

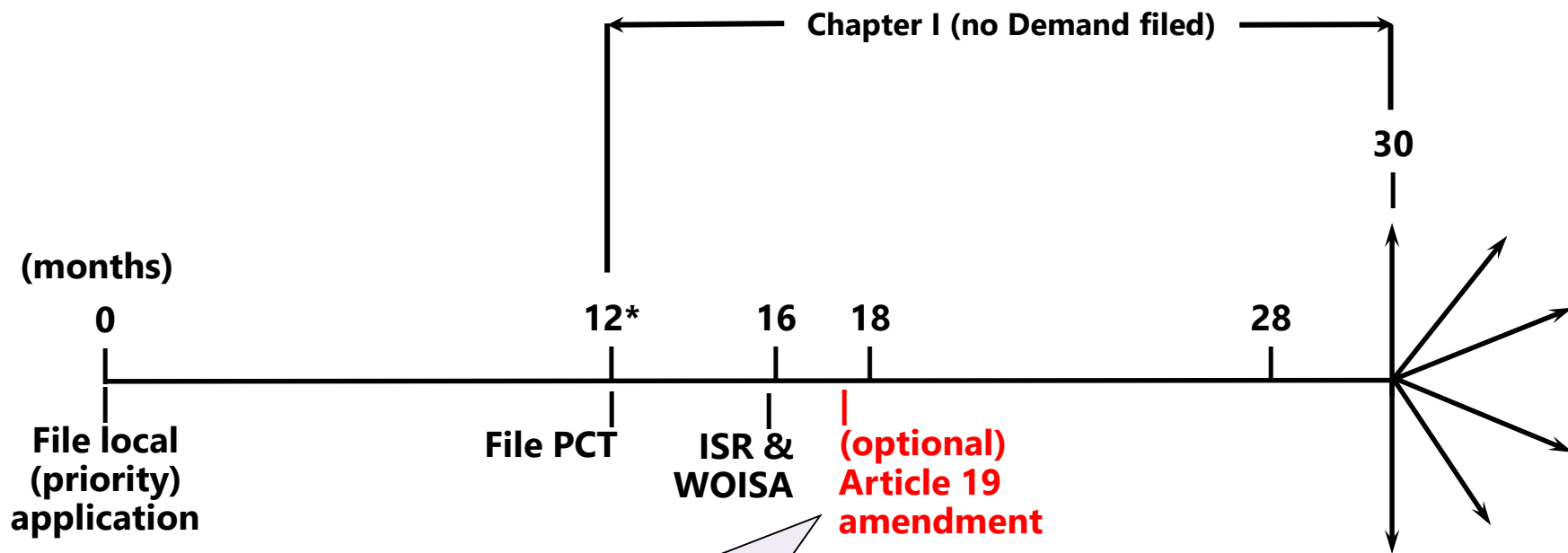
Form PCT/ISA/237
Box No. V

- Citations and explanations on
 - novelty
 - inventive step, and
 - industrial applicability
 of the claimed invention



PCT System – Chapter I

Article 19 Amendment Filed



Filed in the IB

- Claim amendments only
- Within 2 months of ISR/WOISA mailing date

Email questions to:
inventorinfochat@uspto.gov

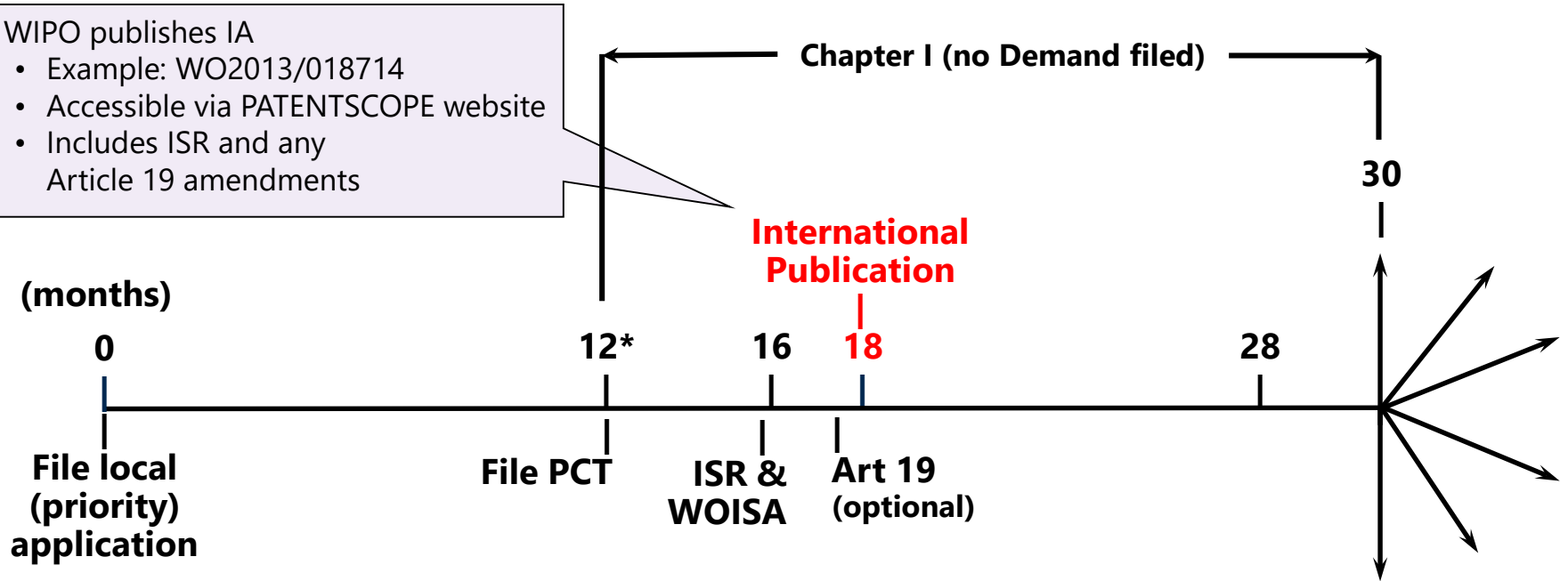


PCT System – Chapter I

International Application Publication

WIPO publishes IA

- Example: WO2013/018714
- Accessible via PATENTSCOPE website
- Includes ISR and any Article 19 amendments





(51) International Patent Classification:
G06F 1/16 (2006.01)
(21) International Application Number:
PCT/US2015/025497
(22) International Filing Date:
13 April 2015 (13.04.2015)
(25) Filing Language:
English
(26) Publication Language:
English
(30) Priority Data:
14/260,137 23 April 2014 (23.04.2014) US

(71) Applicant: MICROSOFT TECHNOLOGY LICENSING, LLC [US/US]; One Microsoft Way, Redmond, Washington 98052-6399 (US).

(72) Inventors: MCCracken, Ivan Andrew; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US). WANG, Hua; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US). AAGAARD, Karsten; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US). WHITT, David Otto, III; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US). BINGHAM, Robert James, Jr.; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US). GROENE, Ralf; c/o Microsoft Technology Licensing, LLC, LCA - International Patents (8/1172), One Microsoft Way, Redmond, Washington 98052-6399 (US).

(81) Designated States (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BN, BR, BW, BY, BZ, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DK, DM, DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IR, IS, JP, KE, KG, KN, KP, KR, KZ, LA, LC, LK, LR, LS, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PA, PE, PG, PH, PL, PT, QA, RO, RS, RU, RW, SA, SC, SD, SE, SG, SK, SL, SM, ST, SV, SY, TH, TJ, TM, TN, TR, TT, TZ, UA, UG, US, VZ, VC, VN, ZA, ZM, ZW.

(84) Designated States (unless otherwise indicated, for every kind of regional protection available): ARIPO (BW, GH, GM, KE, LR, LS, MW, MZ, NA, RW, SD, SL, ST, SZ, TZ, UG, ZM, ZW), Eurasian (AM, AZ, BY, KG, KZ, RU, TJ, TM), European (AL, AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV, MC, MK, MT, NL, NO, PL, PT, RO, RS, SE, SI, SK, SM, TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, KM, ML, MR, NE, SN, TD, TG).

Declarations under Rule 4.17:

- as to applicant's entitlement to apply for and be granted a patent (Rule 4.17(ii))
- as to the applicant's entitlement to claim the priority of the earlier application (Rule 4.17(iii))

Published:

- without international search report and to be republished upon receipt of that report (Rule 48.2(g))

(54) Title: ARTICULATED SCREEN COVER FOR ACCOMMODATING OBJECTS

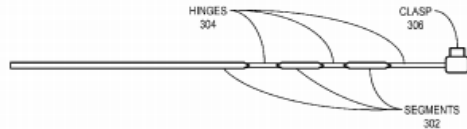


FIG. 3

(57) Abstract: A cover for a mobile computing device is described. The cover comprises two or more hinges so constructed that the hinges are substantially rigid when in-plane and flexible when out-of-plane. The cover includes segments made of a rigid material disposed between the hinges. The cover, when swiveled to the back side of the computing device, forms a contour around an object such as a stylus to secure the object to the back side of the computing device when the object is present. The cover becomes substantially flat and parallel to the back side of the computing device when the object is absent.

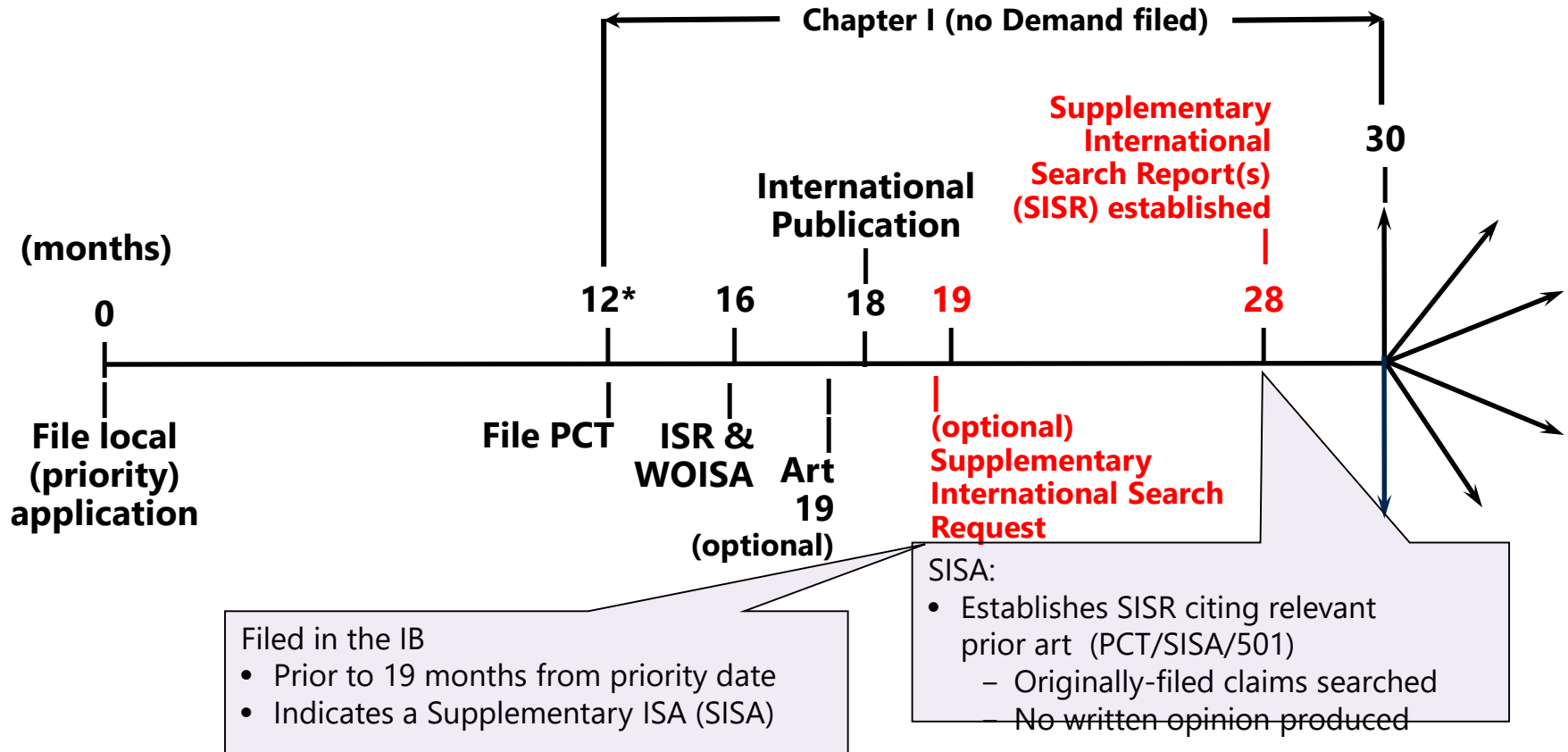
International Application Published under the PCT

Front/Bibliographic Page



PCT System – Chapter I

Supplementary International Search



PATENT COOPERATION TREATY

PCT

SUPPLEMENTARY INTERNATIONAL SEARCH REPORT

(PCT Rule 45bis)

Applicant's or agent's file reference 11506-CB	International application No. PCT/US2009/065691
International filing date (day/month/year) 24-11-2009	(Earliest) Priority Date (day/month/year) 25-11-2008

Applicant
The Procter & Gamble Company et al

This supplementary international search report has been prepared by this Authority specified for supplementary search and it is transmitted to the applicant in accordance with Rule 45bis.8(a). A copy is being transmitted to the International Bureau.

This report is a corrected version of a previously issued supplementary international search report

This supplementary international search report consists of a total of 4 sheets.

It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the **language**, the supplementary international search was carried out on the basis of:

- the international application in the language in which it was filed
- a translation of the international application into _____ which is the language of a translation furnished for the purposes of:
 - the international search (Rules 12.3(a) and 23.1(b)).
 - the international publication (Rule 12.4)
 - the supplementary international search (Rule 45bis.1(c)(i))

b. This supplementary international search report has been established taking into account the **rectification of an obvious mistake** notified to this Authority under Rule 91 (Rules 43.6bis(a) and 45bis7(c)).

c. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

d. This supplementary international search report has been established taking due account of the international search report, or the declaration under Article 17(2)(a) that no international search report will be established, and the written opinion established under Rule 43bis.1.

2. **Certain claims were found unsearchable** (see Box No. II).

3. **Unity of invention is lacking** (see Box No. III).

Supplementary International Search Report

Form PCT/SISA/501
(first sheet)



1 SUPPLEMENTARY INTERNATIONAL SEARCH REPORT		
		International application No. PCT/US2009/065691
A. FIELDS SEARCHED		
Minimum documentation searched (classification system followed by classification symbols)		
IPC: A61K		
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched		
SE,DK,FI,NO classes as above		
Electronic database consulted during the supplementary international search (name of database and, where practicable, search terms used)		
EPO-INTERNAL, WPI DATA, PAJ, MEDLINE, EMBASE, CADATA		
B. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	STN International, File CAPLUS, CAPLUS accession number 1988:101076, document number 108:101076, Feng L.: "Amorphous silicone dioxide and transparent toothpaste", & Riyong Huaxue Gongye, 1987, 3, 133-6, Indexed for CAS reg.no. 60676-86-0	1-15
	--	
X,P	US 20090130030 A1 (RIBI H.O.), 21 May 2009 (21.05.2009), paragraph (0022) Fused silicates listed as polishing agents	1-15
	--	
A	US 2268589 A (HEANY J.A.), 6 January 1942 (06.01.1942), page 2, column 1, line 25, claim 1, Vitreous, non-porous silica as tooth paste ingredient	1-15
	--	
<input checked="" type="checkbox"/> Further documents are listed on the continuation of second sheet B. <input checked="" type="checkbox"/> See patent family Annex. <input type="checkbox"/> See Scope Annex for details of the scope of the supplementary international search.		
* Special categories of cited documents: "A" document defining the general state of the art which is not considered to be of particular relevance "E" earlier application or patent but published on or after the international filing date "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but later than the priority date claimed "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art "&" document member of the same patent family		
Date of the actual completion of the supplementary international search	Date of mailing of the supplementary international search report	
25 October 2010	28-10-2010	
Name and mailing address of the SISA/ Swedish Patent Office Box 5055, S-102 42 STOCKHOLM Facsimile No. +46 8 666 02 86	Authorized officer Ingrid Eklund/ELY Telephone No. +46 8 782 25 00	

Supplementary International Search Report

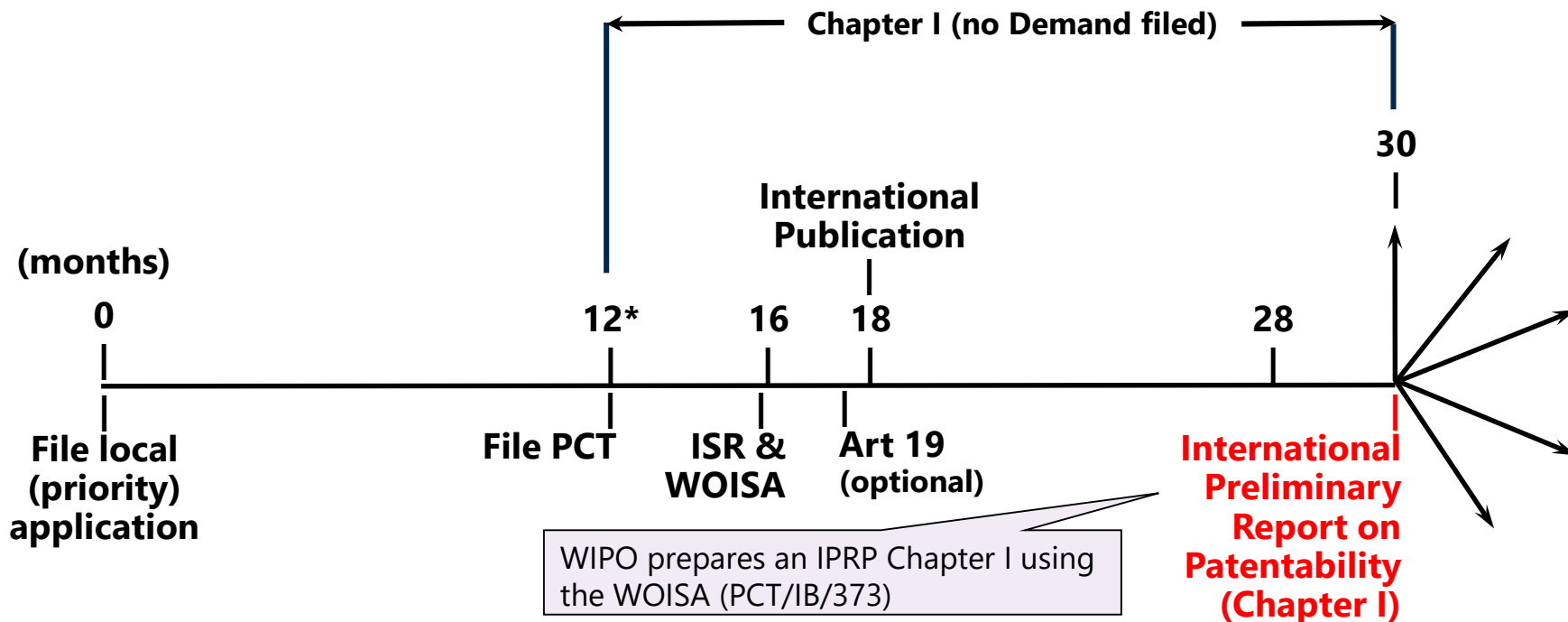
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Documents Considered to be Relevant



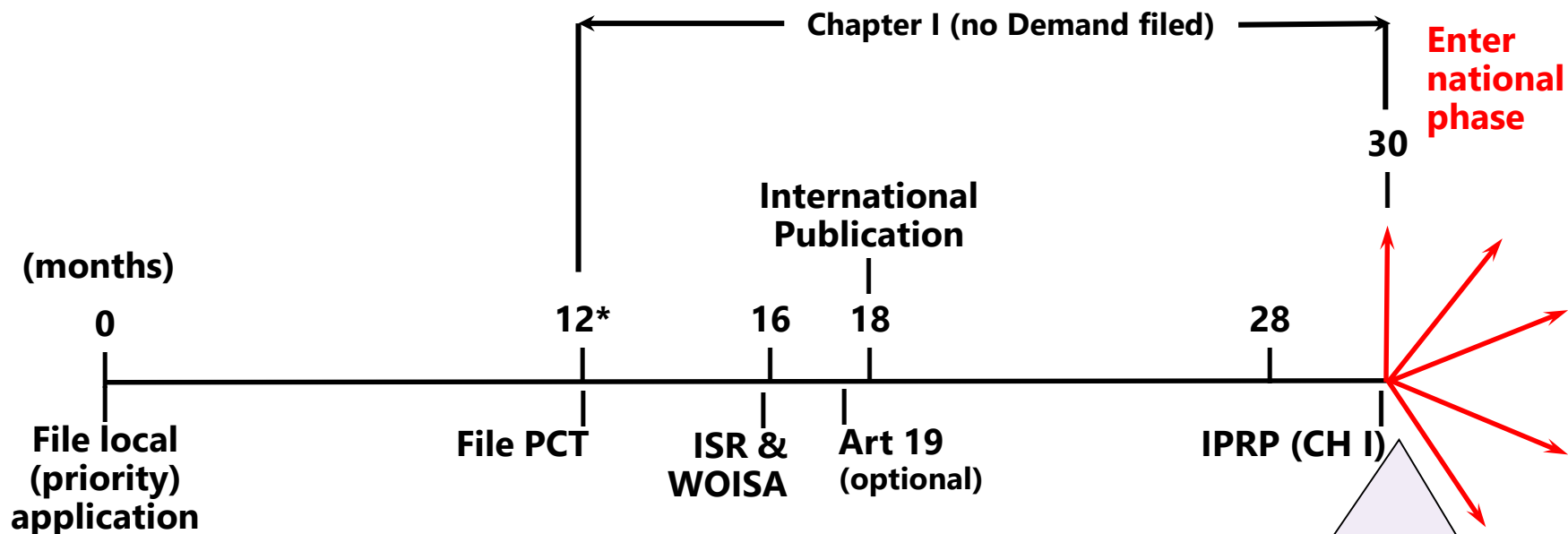
PCT System – Chapter I

International Preliminary Report on Patentability (IPRP) (Chapter I)



PCT System – Chapter I

National Phase Entry from Chapter I



- Applicant takes steps to pursue patent protection in various States
- Express intention to enter national phase
 - Pay fees
 - Provide translation

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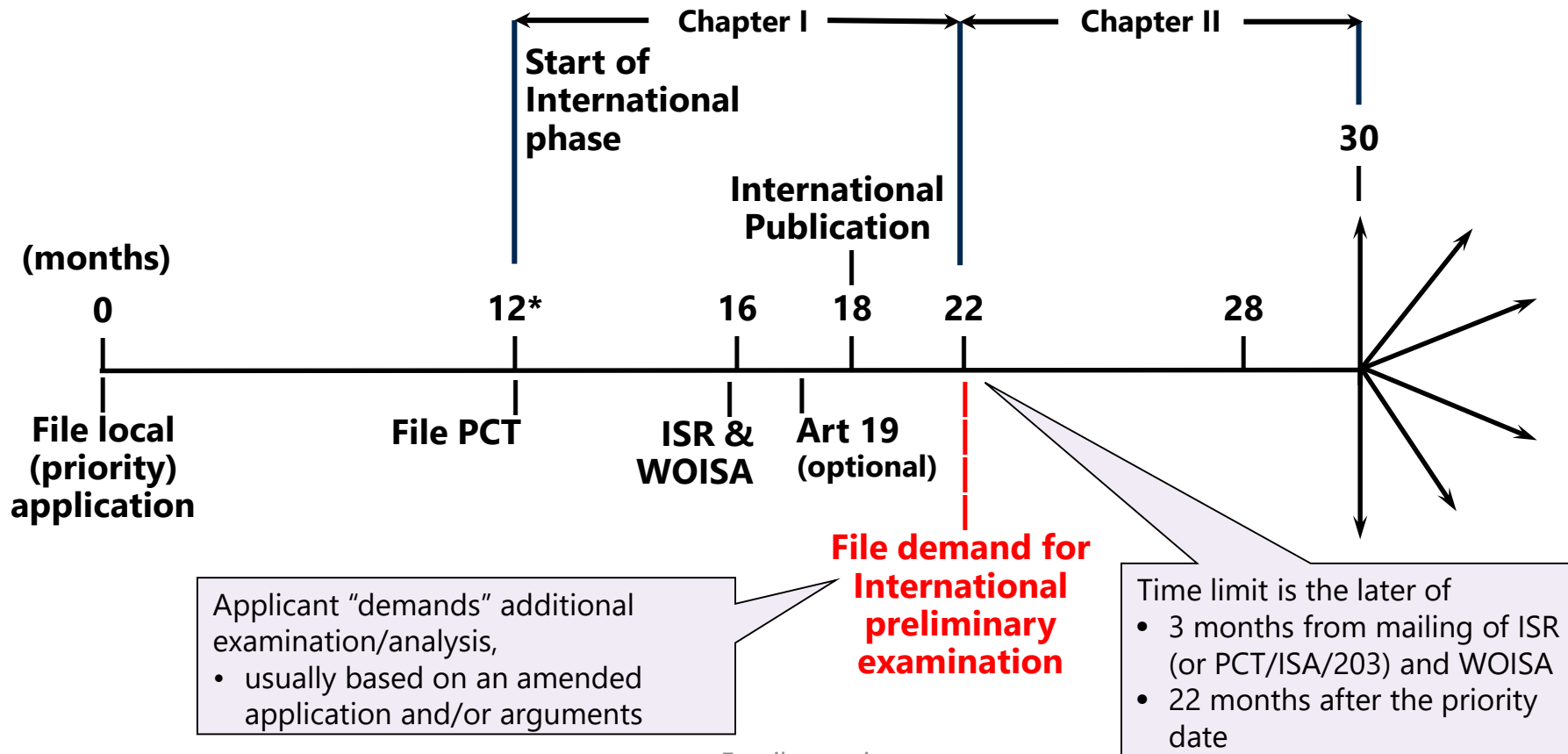
Chapter II

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PCT System – Chapter II

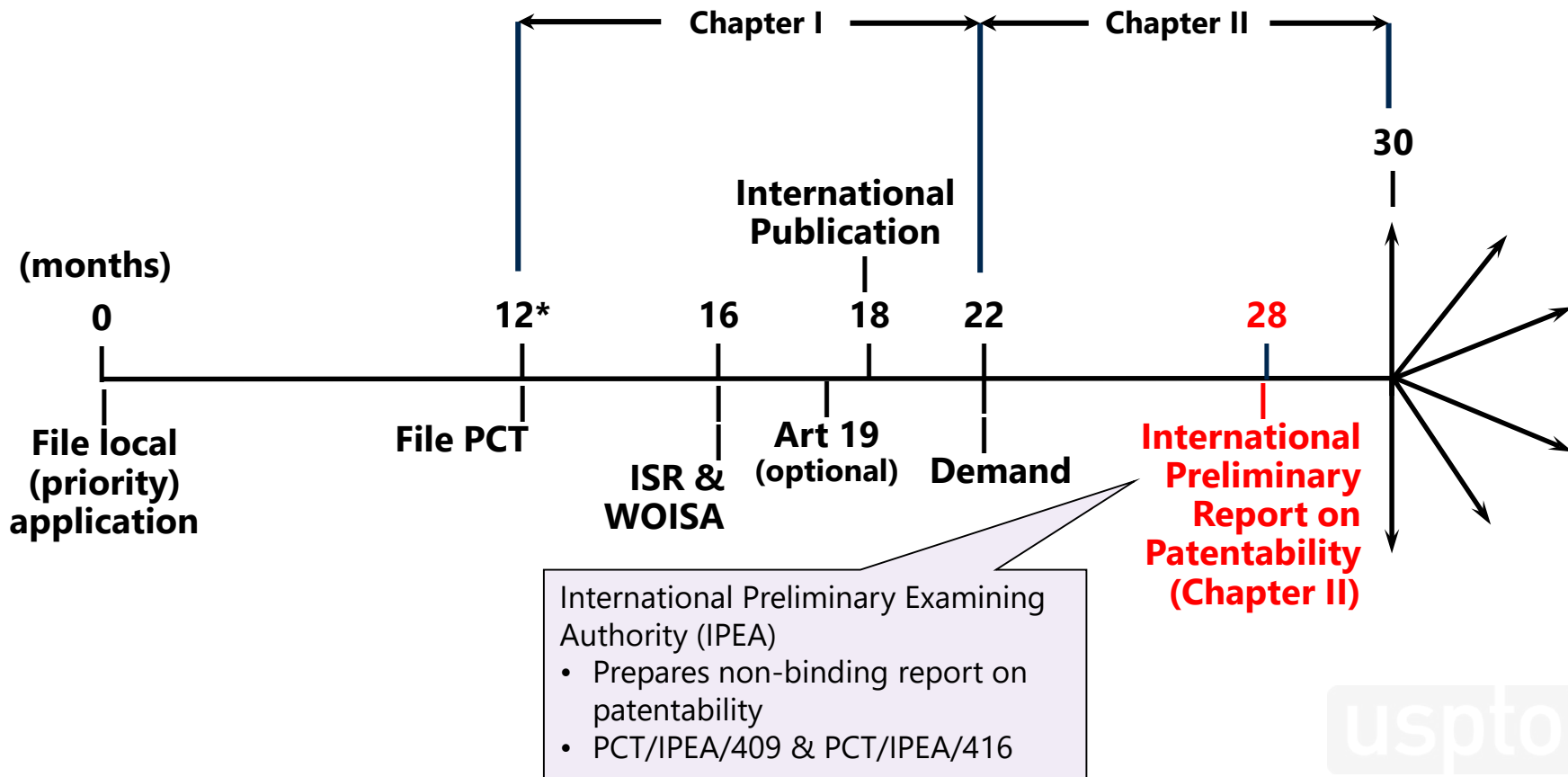
Filing of Demand for Chapter II Entry



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PCT System – Chapter II

I PRP (Chapter II)



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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's reference number 800 029			Applicant's name SPIRAFLEX, INC.			See Form PCT/IPEA/416		
International application No. PCT/US12/54468		International filing date (day/month/year) 10 September 2012 (10.09.2012)		Priority date (day/month/year) 10 September 2011 (10.09.2011)				
International Patent Classification (IPC) or national classification and IPC IPC: A63B 21/02 (2006.01) USPC: 482/92,121,122								
Applicant SPIRAFLEX, INC.								
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>92</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u>14</u> sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and/or sheets containing rectifications authorized by this Authority, unless those sheets were superseded or cancelled, and any accompanying letters (see Rules 46.5, 66.8, 70.16, 91.2, and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets containing rectifications, where the decision was made by this Authority not to take them into account because they were not authorized by or notified to this Authority at the time when this Authority began to draw up this report, and any accompanying letters (Rules 66.4bis, 70.2(c), 70.16 and 91.2).</p> <p><input type="checkbox"/> superseded sheets and any accompanying letters, where this Authority either considers that the superseding sheets contain an amendment that goes beyond the disclosure in the international application as filed, or the superseding sheets were not accompanied by a letter indicating the basis for the amendments in the application as filed, as indicated in item 4 of Box No. I and the Supplemental Box (see Rule 70.16(b)).</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____ containing a sequence listing, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see paragraph 3bis of Annex C of the Administrative Instructions).</p> <p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application</p>								
Date of submission of the demand 01 February 2013 (01.02.2013)			Date of completion of this report 12 June 2013 (12.06.2013)					
Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (571) 273-3201			Authorized officer /LoAn H. Thanh/ Telephone No. 571-270-1702					
Form PCT/IPEA/409 (cover sheet) (July 2011)								

I PRP Chapter II Cover Sheet

Form PCT/IPEA/409



Contents of the IPRP (CH II)



IPRP (Chapter II)

Basis of the Report

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No. PCT/US12/54468
Box No. 1 Basis of the report	
1. With regard to the language , this report is based on:	
<input checked="" type="checkbox"/> the international application in the language in which it was filed.	
<input type="checkbox"/> a translation of the international application into <u>English</u> which is the language of a translation furnished for the purposes of:	
<input type="checkbox"/> international search (Rules 12.3(a) and 23.1(b)).	
<input type="checkbox"/> publication of the international application (Rule 12.4(a)).	
<input type="checkbox"/> international preliminary examination (Rules 55.2(a) and/or 55.3(a) and (b)).	
2. With regard to the elements of the international application, this report is based on (<i>replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report</i>):	
<input type="checkbox"/> the international application as originally filed/furnished	
<input checked="" type="checkbox"/> the description:	
pages <u>1-17</u> as originally filed/furnished	
pages* <u>NONE</u> received by this Authority on _____	
pages* <u>NONE</u> received by this Authority on _____	
<input checked="" type="checkbox"/> the claims:	
pages <u>NONE</u> as originally filed/furnished	
pages* <u>NONE</u> as amended (together with any statement) under Article 19	
pages* <u>18-22, 22-1, 22-2</u> received by this Authority on <u>01 February 2013 (01.02.2013)</u>	
pages* <u>NONE</u> received by this Authority on _____	
<input checked="" type="checkbox"/> the drawings:	
pages <u>1/13 - 13/13</u> as originally filed/furnished	
pages* <u>NONE</u> received by this Authority on _____	

Form PCT/IPEA/409 (Box No. 1) (July 2011)

Form PCT/IPEA/409
Box No. I

- Basis of the report
 - Application as amended



I PRP (Chapter II)

Reasoned Statement

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/US12/54468
Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement		
Novelty (N)	Claims <u>1-22</u>	YES
	Claims <u>NONE</u>	NO
Inventive Step (IS)	Claims <u>7-8, 11-21</u>	YES
	Claims <u>1-6, 9-10, 22</u>	NO
Industrial Applicability (IA)	Claims <u>1-22</u>	YES
	Claims <u>NONE</u>	NO
2. Citations and Explanations (Rule 70.7)		
<p>1) Claims 1-6 lack an inventive step under PCT Article 33(3) as being obvious over Hsieh et al. (US Pat. No. 7,828,704 B1, Nov. 9, 2010) (herein "Hsieh") in view of Truini (US Pat. No. 5,720,701, Feb. 24, 1998).</p> <p>With respect to claim 1, Hsieh teaches a personal exercise device 10 comprising a first arm and a second arm (such as left and right rods 11) pivotally coupled to the first arm at a pivot point. (See Hsieh, Abstract, col. 2, line 48 - col. 3, line 9, and Fig. 1). Hsieh also teaches a first handle 12 and a second handle 12 removably coupled to the first arm 11 and second arm 11, respectively away from the pivot point. (See Hsieh, Fig. 2, which shows the two halves 121 of the handles 12 being mutually assembled together, as described in col. 3, lines 10-16, with projections (not numbered) that are commonly used to connect two components together via screws, thereby making the handles removable).</p> <p>Hsieh further teaches a resistance member (i.e., first torsional spring 20) operably connected to both the first arm (left rod 11) and the second arm (right rod 11) and configured to resist the relative rotational motion of the first arm (left rod 11) with toward the second arm (right rod 11). (See Hsieh, Fig. 2 in which the spring 20 is connected to left and right rods 11 via first and second main bodies 101,102). The torsional spring 20 provides resistance against both outward and inward forces applied to the arms (i.e., rods 11) in at least two substantially opposing directions. See also col. 2, line 48 - col. 3, line 9). Thus, the resistance member (i.e., spring 20) is engaged to provide resistance against the first and second arms pivoting towards each other when an adduction force is applied against the first and second handles 12 (i.e., by moving rods 11 pivotally towards each other via handles 12, the spring 20 provides the resistance in the opposite direction from pivoting the arms 11 together).</p> <p>Hsieh is silent in explicitly teaching that the exercise devices includes a first tension member operably connected between the first handle and the second arm, and a second tension member operably connected between the second handle and the first arm. Hsieh is also silent in explicitly teaching that the resistance member provides resistance when an abduction force is applied against the first and second handles by the first and second tension members upon extending the first and second handles from the first and second arms.</p> <p>Truini, however, in an analogous art teaches an exercising device with pivoting arms and handles. (See Truini, Abstract, and Fig. 1). Truini teaches a first tension member (i.e., resilient member 36a) operably connected between a first handle 26 and a second arm 12. Truini also teaches a second tension member 36b operably connected between a second handle 15 and a first arm 22. (As seen Fig. 1 of</p>		

Form PCT/IPEA/409 (Box No. V) (July 2011)

Form PCT/IPEA/409
Box No. V

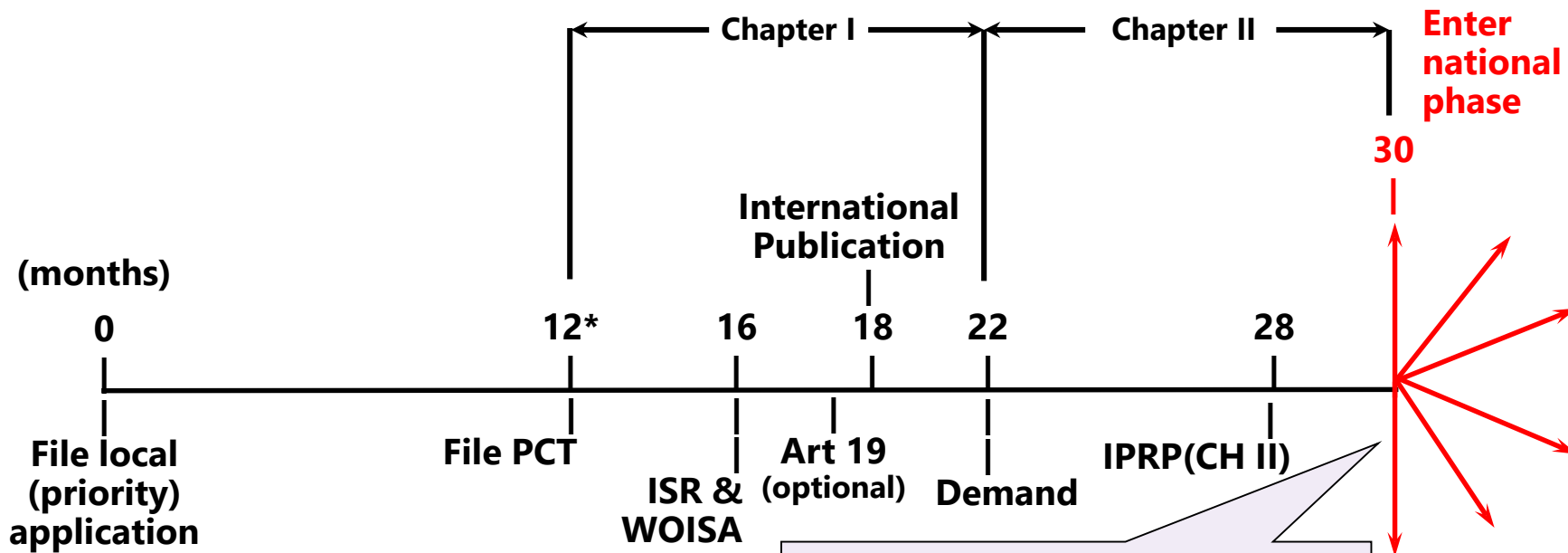
Citations and explanations on

- Novelty,
- Inventive step, and
- Industrial applicability of the claimed invention

Email questions to:
inventorinfochat@uspto.gov

PCT System – Chapter II

National Phase Entry from Chapter II



Applicant takes steps to pursue patent protection in various States

- Express intention to enter national phase
- Pay fees
- Provide translation

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inventorinfochat@uspto.gov

The National Stage

Email questions to:
inventorinfochat@uspto.gov



National Stage Requirements

- PCT Articles 22 & 39 require furnishing of the following for national/regional stage entry
 - A copy of the international application (unless already provided by the International Bureau)
 - A translation of the international application (where appropriate)
 - The national fee
- National/Regional Offices may have additional requirements
 - PCT Applicant's Guide provides details
 - <http://www.wipo.int/pct/en/appguide/>

PCT Route Filing Strategies

- Some options for foreign filing using the PCT*
 - Option 1: Nonprovisional followed by PCT
 - Option 2: Provisional followed by PCT
 - Option 3: Provisional followed by Nonprovisional **and** PCT
 - Option 4: PCT filed first
- * List is not exhaustive

Avoiding Common Mistakes

- Confidentiality
 - Avoid making the invention public prior to filing a patent application
 - Many countries have an absolute novelty requirement
- Be familiar with key dates and deadlines
 - Under U.S., foreign, and international laws
 - *E.g.*, one year deadline from first filing in U.S. to file directly in foreign countries to preserve priority
- Recommend securing services of a registered patent attorney or agent
 - If unfamiliar with the complexities in obtaining foreign patent rights
 - To avoid potentially losing patent rights

PCT Resources

- <http://www.uspto.gov/patents-getting-started/international-protection/international-patent-legal-administration-formerly>
 - International Patent Legal Administration web page on USPTO Internet site
 - Forms, fees, rules, etc.
- <http://www.wipo.int>
 - World Intellectual Property Organization
 - PCT Newsletter, PCT Applicant's Guide, Hague Guide for Users
 - ePCT, PATENTSCOPE, etc.

Upcoming OI Events

- August 16, 2018– Inventor Info Chat: Global Dossier
- August 17-18, 2018 – Invention Con-Alexandria, VA
– *“Concept to Commercialization”*
- For more information or to register for any of the above events contact us at oidevents@uspto.gov

<https://www.uspto.gov/patents-application-process/inventor-info-chat>



Questions?



