



Timing considerations for concurrent Track One and PCT applications

By Angelo Christopher and Matthew Kitces

U.S. Track One and PCT Applications

Filing concurrent U.S. Track One and Patent Cooperation Treaty (PCT) applications is an attractive strategy for many applicants. Under “Track One” prioritized examination, one can expect a first office action within 3–4 months and a final disposition within a year (for an additional undiscounted filing fee, which is presently \$4,200). At the same time, the applicant can maintain its rights to file in foreign countries for 30 months from the priority date with the PCT application. The PCT application is also advantageous in that the chosen searching authority provides a search report and non-binding written opinion on patentability.

To illustrate this strategy, suppose an applicant files U.S. Track One and PCT applications on December 1, 2020, claiming priority to a December 1, 2019, provisional application. Using Track One, the U.S. Patent Office should issue a final disposition by December 1, 2021 (or sooner), while the 30-month national state deadline for foreign application expires on June 1, 2022. This allows the applicant to obtain a U.S. patent well before needing to file in foreign countries. Many foreign patent office’s offer Patent Highway Prosecution (“PPH”) programs that can leverage the U.S. patent to expedite prosecution and reduce costs.

Track One might be too fast

While the objective for most patent applications is to obtain a valid and enforceable patent quickly and efficiently, the U.S. Track One procedure, in some cases, might be too fast when there is a co-pending PCT application. Patent Office statistics show that the average time between the Track One petition grant and the first office action is currently 2.1 months, while the average time for a notice of allowance is 5.5 months from the petition grant. The PCT search report should be received within the later of three months from the receipt of the search copy or nine months from the application’s priority date.

There is a very real possibility that the applicant will receive a notice of allowance in the U.S. Track One before receiving the PCT search report. This order of events presents a problem if the PCT search report identifies material references that were not considered by the U.S. examiner and previously unknown to the applicant, thereby requiring the filing of an information disclosure

statement (“IDS”). An applicant always has the ability to file an IDS within three months of the application’s filing date. However, if the IDS is needed more than three months after the filing date, the applicant’s options are limited.

One option would be to file the IDS with a request for continued examination (“RCE”). This option is generally disfavored as it will delay issuance of the patent and raise costs (the present undiscounted RCE fee is \$1,360). The only other option to file the IDS after allowance is to make a certification under 37 C.F.R. § 1.97(e)(1) or § 1.97(e)(2). At first brush one might think that the PCT counterpart is a foreign counterpart under § 1.97(e)(1), which covers references cited for the first time in a foreign counterpart within the last three months. However, the Patent Office updated MPEP in June 2020 to clarify that a PCT application that designates the U.S. is not a counterpart foreign application. The remaining option, § 1.97(e)(2), requires the following certification:

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

If one is not able to make that certification, an RCE is needed.

Strategies to consider

Given the potential that the timing of the PCT search report may negatively affect the benefits of Track One, one might consider alternative filing strategies.

1. **Bypass continuation with Track One request**—In this approach, the applicant first files only the PCT application. After receiving the PCT search report, the applicant can file a “bypass continuation” application in the U.S. based on the PCT application. While the Patent Office rules provide that a normal national stage application cannot obtain Track One status, the applicant can submit a Track One request with the bypass continuation. In addition to avoiding the timing issues described above, this approach is advantageous in that the applicant can review PCT references before filing in the U.S. (e.g., and can adjust the claims if necessary). Further, a positive search report may allow the applicant to take advantage of expedited processing under the PPH program instead of paying Track One fees. However, the tradeoff is an approximate 4–9 month delay compared to the concurrent U.S. and PCT approach.
2. **File concurrent applications, but fail to designate the U.S. in the PCT application**—In this approach, the PCT and U.S. applications are filed concurrently, but the U.S. is not identified as the designated country in the PCT application. As a result, the PCT application would be considered a “foreign counterpart,” meaning that if faced with a notice of allowance before receiving the PCT search report, the applicant could submit an IDS using the 37 C.F.R. § 1.97(e)(1) certification. However, the tradeoff in this approach is that the PCT application cannot be used to enter the U.S. national stage.

For more information on the content of this alert, please contact your Nixon Peabody attorney or:

- Angelo J. Christopher at achristopher@nixonpeabody.com or 312-977-4391
 - Matthew T. Kitces at mkitces@nixonpeabody.com or 202-585-8026
-