

NATH, GOLDBERG & MEYER

Attorneys at Law

T:703.548.6284 ||703.486.1000

F:703.683.8396 ||703.486.7000

112 S. West Street
Alexandria, VA 22314

EMAIL: ip@nathlaw.com

HTTP://www.nathlaw.com

RECOMMEDED STEPS IN THE PATENT PROCESS

1. Avoid public disclosure (such as publication of a research paper) until an application is filed. Public disclosure before filing an application can result in loss of rights in most countries.
2. Patent Search based on inventor's details of the invention to determine patentability and scope of the invention.
3. US Utility Patent Application prepared and reviewed by inventor (s); revisions made; declarations signed and Power of Attorney signed
4. File in the USPTO with request for prioritized examination (USPTO Track One). It is possible to get an application allowed within 6-9 months of filing. This permits decisions about filings in other countries to be made before the 1 year Paris Convention deadline. This is the first step in building a **worldwide patent family**.

Filing this application will establish an international priority date for all subsequent applications. This starts a period of 1 year in which corresponding applications can be filed in 177 Paris Convention Member Patent Offices claiming priority to the original filing date.

5. Prioritized Examination also allows for discussion between NGM and the Examiner at the USPTO to review patentability and resolve issues before filing an amendment
6. Allowance of Patent in the United States; once allowed the scope of the invention is established and **patent families** can be established by further filings such as PCT, GCC and other national applications as well as continuing US prosecution with continuation, divisional or continuation in part applications.
 - a. Note that the scope of an invention may vary from country to country, primarily due to variations in the patent laws and examination processes of different countries.
7. If a PCT application is filed as the first filing, this will allow for up to 30-31 months in about 152 patent offices to file corresponding patent applications and claim the priority of the original filing date. (The GCC Patent Office, Argentina, Bolivia, Venezuela, Paraguay, Suriname, and Taiwan are not PCT members.)

A PCT application can also be filed within one year of the US filing. This will allow 18-19 months to file in member countries and claim the priority of the original filing date.

8. The Gulf Cooperation Council (GCC) is a regional organization currently comprising six countries: Kingdom of Saudi Arabia, Qatar, Kuwait, United Arab Emirates, Sultanate of Oman, and Bahrain. The GCC is not a member of the PCT. GCC applications must be filed within one year of the first filed application.
9. The Patent Prosecution Highway can be used for accelerated review of family member applications in other countries. Many patent offices have agreements with other patent offices which provide that a first application which is examined and has an allowable claim can be used to accelerate review in other countries.