International Inventor Assistance Program
OUS Counsel US National Phase Checklist

☐ Confirm that the Client continues to qualify for pro bono patent representation in the country of origin.

☐ Shortly after publication of the PCT application, and no later than three months before the US national stage entry deadline, contact the Federal Circuit Bar Association (FCBA) for assistance with national stage filing. This communication with the FCBA should at least identify the OUS Counsel, the Client, the assistance requested, and the publication number of the PCT application. In response, FCBA will contact potential US Counsel.

☐ Upon receipt of an introductory communication from the assigned US Counsel, contact the Client and inform them of the assignment of US Counsel to their national stage filing. Additionally, assist the US Counsel in procuring execution of an engagement letter/rules of representation with the Client.

☐ Upon receipt of an executed engagement letter/rules of representation, forward the executed engagement letter/rules of representation to US Counsel and obtain from US Counsel an estimate of any initial fees that need to be procured from the Client prior to performance of the representation (e.g., USPTO filing fees).

☐ Obtain any initial fees from the Client pertaining to performance of the representation by US Counsel, and forward the fees to US Counsel.

☐ Forward instruction letter to US Counsel for National Stage Application. In the instance of a new national stage filing the instructions should include the following:

  Confirmation of entity status: ☐ Large ☐ Small ☐ Micro

  Application, as filed, in Word format. The US Counsel is not obligated to file more than three independent claims and more than twenty total claims.

  ☐ Drawings, as filed (or replacement drawings submitted), in PDF, Visio, or Word format.

  ☐ Translation of the National Stage Application in Word format (if not in English).

  ☐ Copies of any demand or amendments (e.g., Article 19 or 34 amendments) made during international phase in Word format.

  ☐ Translation of any demand or amendments (e.g., Article 19 or 34 amendments), and any annexes (if not in English).

  ☐ All priority documents and assignments thereof, if applicable.

  ☐ Executed Oath/Declaration.

  ☐ Executed Power of Attorney (optional).
Executed Assignment (if applicable).

☐ A list of all references cited in the International Search Report, specification of application, any foreign priority application search or examination reports, and any other references material to patentability known to anyone involved with the application.

☐ Any information concerning assignment of the PCT application to another entity as well as information on whether that entity qualifies for pro bono representation?

☐ Any information concerning any third party that may have rights to the invention disclosed in the PCT application (does that party qualify for pro bono representation)?

☐ Any other relevant information concerning changes since filing the PCT application.

☐ Any information concerning any prior art, publications, or other information that may be material to patentability and needs to be disclosed to the USPTO.

☐ Provide copies of all prior art, publications, or other information. To be disclosed to the USPTO including the International Search Report and any foreign search or examination reports.

☐ Provide copies in English of any favorable report for consideration of the Patent Prosecution Highway (PPH) at the USPTO.

☐ Upon receipt of a copy of the application as filed, along with the electronic receipt evidencing the filing from the US Counsel, report the filing to the Client.

☐ Patent applicants and their attorneys have a continuing duty to disclose to the USPTO any information known to them that is material to patentability in a pending application. Please continually advise US Counsel through-out prosecution of the nation stage filing of any such information you have not yet called to their attention, so that US Counsel can consider a disclosure to the USPTO.

☐ Confirm that the Client continues to qualify for pro bono patent representation in the country of origin through-out prosecution of the nation stage filing.