

5 KEY TAKEAWAYS

Taking Advantage of Bypass Continuations based on Recent USPTO Practice Trends for US National Phase Entry

[Kilpatrick Townsend](#) partner [Karam J. Saab](#), in cooperation with [GreyB](#), offers his key takeaways for “Taking Advantage of Bypass Continuations based on Recent USPTO Practice Trends for US National Phase Entry.”

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The United States (US) is unique in that a Patent Cooperation Treaty (PCT) application can enter US national phase examination via two distinct routes: as a 371 national phase application or as a bypass continuation application. The applicable regulations vary for each of these routes. Kilpatrick Townsend and GreyB analyzed over 600,000 national phase filings filed between 2015 and 2020 to identify trends worth considering when choosing a route.

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The most common method of entering the US from a PCT application is to file a national stage application under 35 USC §371. While the filing of bypass continuations over the past five years has become significantly more common, applicants still heavily favor 371 applications for US national phase entry. Bypass continuations accounted for roughly 12.5% of national phase entry in 2015 and was up to about 19% in 2020 within our analyzed dataset.

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The relative prevalence of US national phase entry using bypass applications compared to 371 applications does vary by Technology Center (TC). TCs that examine computer architecture and security, computer networks and cryptography, and communications tend to favor bypass continuations compared to other TCs. TCs that examine biotechnology, organics, chemicals, and materials more heavily favor 371 national phase applications.

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A key difference between 371 applications and bypass continuations is the standard used for restriction practice. When 371 applications are examined, the USPTO will apply the PCT unity of invention standard. In contrast, a bypass continuation is examined under the US “independent and distinct” standard. Does this result in any practical difference? Based on our analyzed data set, US examiners have historically issued a slightly greater number of restriction requirements on 371 national phase applications under the “unity of invention” standard as compared to the “independent and distinct” standard for bypass continuations. Therefore, a small advantage in avoiding restriction may be realized by using the bypass route.

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Another key difference is relevant to PCT applications filed in a language other than English. An exact English translation of the PCT application is required to be filed for a 371 national phase application. In contrast, a bypass continuation requires a certified translation of the PCT application to be filed. There is no requirement, however, that the English bypass continuation be an exact translation of the PCT application. Not only does this allow the English bypass continuation to introduce minor changes, but also a bypass continuation can function as a continuation-in-part (CIP) application, allowing new matter to be introduced to the application.

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