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Intellectual Property Update

Best Practices for Entering the U.S. with a non-U.S. Originated Patent Application

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On March 20, 2026, the U.S. Patent and Trademark Office (USPTO) published a new rule requiring that foreign patent applicants be represented by a patent practitioner registered with the USPTO[1]. This new rule may have limited practical relevance, because corporate filers have long been required to be represented by a registered U.S. practitioner.[2] Beginning on July 20, 2026 when this new rule takes effect, foreign pro se inventors can no longer represent themselves without a registered U.S. practitioner.

Although this new rule may not bring significant change to U.S. patent examination, it is a reminder that U.S. patent practice presents unique procedural and substantive requirements that can materially affect foreign-originated applications. Applicants entering the U.S. from a priority filing abroad should plan early for claim strategy, disclosure alignment, and compliance with U.S.-specific formalities. This article summarizes practical steps to preserve rights and position applications for efficient examination and enforceable claim scope.

I. Filing Options

Non-U.S. applicants typically use one of two routes to enter U.S. examination:

- Paris Convention route: File a U.S. nonprovisional (utility) application within 12 months of the earliest foreign filing date, or a U.S. design application within 6 months, claiming foreign priority.
- PCT route: File a PCT application designating the U.S., then enter the U.S. national phase within 30 months from the earliest priority date.

II. Early Stage Considerations

It is important to confirm inventorship and ownership. Each inventor must sign an inventor Oath or Declaration before any U.S. patent application can grant. Filing the application with these executed documents avoids a late fee. It is important to correct errors promptly to avoid downstream enforceability issues. While not required for patentability, it can be important to timely record any assignment document with the USPTO for standing and notice purposes.

If the priority application is not in English, the USPTO requires a signed translation verification statement by an individual fluent in both languages. If this statement is not filed at the time the application is filed, the USPTO will charge a late fee.

The USPTO can be particular that the figures of a patent application meet its standards. The figure label must be oriented with respect to each image, and the page margins must meet specific requirements.

[1] https://www.federalregister.gov/documents/2026/03/20/2026-05564/required-use-by-foreign-applicants-and-patent-owners-of-a-patent-practitioner
[2] MPEP § 401

The U.S. charges additional claim fees when the application includes more than 3 independent claims and more than 20 total claims. Multiple dependent claims are permitted in U.S. applications but incur additional claim fees.

It is beneficial to revise the priority application before filing, often through a preliminary amendment, to address the above and other jurisdiction-specific requirements and reduce USPTO fees.

III. Information Disclosure and Prior Art

Applicants and individuals associated with a U.S. non-provisional patent application must disclose known material prior art, including foreign search reports and office actions, to the USPTO. If material prior art is not disclosed timely, there can be drastic consequences related to the enforceability of any granted patent.

Monitoring non-U.S. applicants in the same family as the U.S. application can create a significant burden. It is important to have a procedure or software in place to reduce this burden and prevent oversight.

The USPTO recently created a scaled system to charge applicants when submissions of prior art pass certain number thresholds. Applicants are not required to submit cumulative prior art, which can help avoid excess costs.

It is important to disclose material prior art to the USPTO in a prompt manner. If material prior art is not made of record before issuance of a first action by an examiner or within 90 days of learning of the prior art, the applicant can lose patent term adjustment once the patent grants.

IV. Claim Strategy in View of U.S. Eligibility

The U.S. has stringent subject-matter eligibility requirements compared to some foreign jurisdictions. In particular, the U.S. applies a distinct eligibility framework for software, diagnostics, and business methods. It is important to tailor claim types accordingly.

For software/business methods, it is wise to emphasize specific technical improvements, data structures, or control of tangible processes; avoid purely result-oriented claim language.

For diagnostics/biotech, it can be helpful to anchor claims in concrete laboratory steps, specific reagents, and technical correlations. Where appropriate, applicants should consider composition or device claims.

For medical methods, applicants should consider divided infringement risks, and draft claims that minimize performance by multiple actors or include system/device claims as alternatives.

V. Options to Accelerate Examination

The backlog of unexamined applications at the USPTO is significant. However, there are several ways to expedite examination.

Applicants can consider the “Track One” program, where an additional fee paid at the time of filing can result in a first action being issued significantly faster than normal examination.

In cases where the priority application or a corresponding foreign application has received an indication of allowability, the USPTO will often accept a Request for the Patent Prosecution Highway. Even if the USPTO does not agree with the foreign office’s substantive determination, it will move the U.S. application out-of-turn for a much sooner first action than otherwise would have occurred. There is no government fee for proceeding under this program.

In what is possibly unique compared to patent offices around the world, the USPTO will examine a new application out-of-turn and without fee if one of the inventors of the application is 65 years of age or older. A simple form, called a Petition to Make Special Based on Age, can be filed to attest to this fact and often significantly reduce the length of application pendency.

VI. Conclusion

Entering the U.S. with a foreign-originated application includes several unique requirements and considerations. An experience and efficient U.S. registered practitioner can help navigate these hurdles and put the application in the best condition for streamlined examination and enforceable claims.

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This Intellectual Property Update is intended to keep readers current on developments in the law. It is not intended to be legal advice. If you have any questions, please contact Grant Coffield at 412.566.6105 or gcoffield@eckertseamans.com, Nate Wilks at 412.566.6993 or nwilks@eckertseamans.com, Mark Vogelbacker at 215.851.8504 or mvogelbacker@eckertseamans.com, or any other attorney at Eckert Seamans with whom you have been working.