

# Update on Recent and Future Developments in the PCT System



Virtual seminar

Geneva, October 28, 2020

# Program

- 16:35 – 17:00: Amendments to the PCT Regulations
- 17:00 – 17:30: Recent and future PCT developments
- 17:30 – 18:00: ePCT: Latest and future developments
- 18:00 – 19:00: Open PCT Q&A session



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PCT Operations  
Division



# Amendments to the PCT Regulations as from July 1, 2020

# Amendments to the PCT Regulations as from July 1, 2020 - Overview

- Incorporation by reference in case of erroneously filed elements and parts
- Rule 82*quater* (excuse delay in meeting time limits due to the unavailability of electronic means of communication at an Office)
- Availability of additional Chapter II related documents on PATENTSCOPE
- Rule 26*quater* (correction or addition of indications referred to in Rule 4.11)
- Transfer of PCT fees through International Bureau

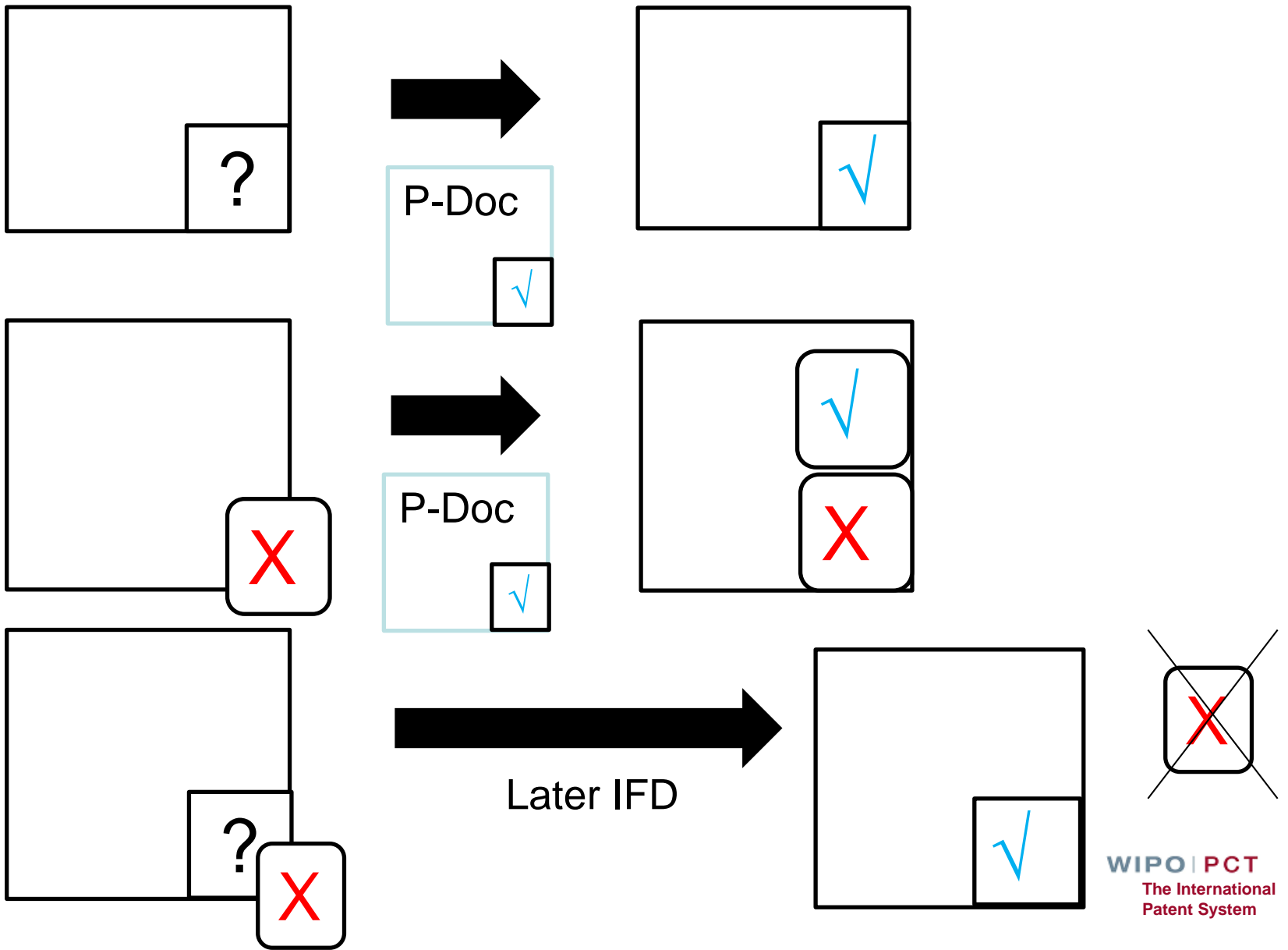


# Erroneously filed elements and parts

# Incorporation by reference in case of erroneously filed elements or parts

- Amended PCT Rules 4, 12, 20, 48, 51*bis*, 55 and 82*ter*, and introduced new Rules 20.5*bis* and 40*bis*
  - In addition to incorporating missing elements and parts, in the case of erroneously filed elements or parts, the correct element or part may also be incorporated by reference, if contained in the priority application
  - New legal basis to replace an erroneously filed element or part with the correct element or part (impacting the international filing date)
  - For international application filed on or after July 1, 2020

# Missing ≠ erroneously file ≠ completed/corrected



# Options in case of missing parts or erroneously filed elements or parts

	Incorporation by reference		Completion/Correction	
	Missing part	Erroneously filed element or part	Missing part	Erroneously filed element or part
<b>PCT Rules</b>	20.5(d), 20.5 <i>bis</i> (d), 20.6		20.5(b)&(c)	20.5 <i>bis</i> (b) and(c)
<b>Int. Filing Date</b>	Maintained		Will be changed	
<b>Applicability</b>	Not applied at some ROs and DOs		All ROs and DOs	
<b>How erroneously filed sheets are dealt with</b>	N/A	Remain in the application (published as part of the application —moved to the end of the respective element, e.g., description)	N/A	Removed from the application (and not visible on PATENTSCOPE)



# Main considerations in case of erroneously filed elements or parts

- Does your RO accept incorporation by reference in case of erroneously filed elements or parts?
  - If not, would it be acceptable for the application to be transferred to RO/IB?
- Would it be acceptable if the international filing date is changed?
  - Unproblematic if new international filing date is still within priority period
  - If new filing date is outside the priority period, might a request for restoration of priority right be successful?
- Would it be acceptable if the erroneously filed elements or parts remain in the application, and thus in the international publication?
  - If not, incorporation by reference should be avoided
  - Correction will still leave them in the file of the IB but not visible on PATENTSCOPE; withdrawal and refileing of the application may be considered
- Fee implications

# PCT Assembly Understandings

- In adopting PCT Rule 20.5*bis*, the Assembly agreed that, where a correct element or part had been incorporated by reference under PCT Rule 20.5*bis*(d), the ISA would not need to take into account any erroneously filed element or part
- In adopting PCT Rule 20.8(a-*bis*), the Assembly agreed that, where an RO could not incorporate a correct element or part because that Office had submitted a notice of incompatibility under this Rule, the RO concerned and the IB should agree to apply PCT Rule 19.4, with the authorization of the applicant
- Where an applicant had not paid additional fees following an invitation (PCT Rule 40*bis*) (when the ISA is notified that a correct element or part replaces the erroneously filed element or part or is incorporated by reference only after it had begun to draw up the ISR), the ISA would not need to take into account the correct element or part for the purposes of international search

■ **Excuse of delay in meeting time limits due to Office electronic system unavailability  
(Rule 82*quater*)**

# Excuse of delay in meeting time limits: Office electronic system unavailability (1) (Amendment to Rule 82*quater*)

- Allows an Office to excuse delays in meeting a time limit due to the unavailability of any permitted electronic means of communication at that Office, such as unforeseen outages or scheduled maintenance
- Does not apply to the priority period and the time limit for entering the national phase
- Applies to any time limit fixed in the Regulations that expires on or after July 1, 2020
- Offices providing for such a safeguard under their national/regional law will inform the International Bureau:
  - of the general availability of such measures
  - of any concrete cases where the Office's systems are down

# Excuse of delay in meeting time limits: Office electronic system unavailability (2) (Amendment to Rule 82*quater*)

- Application of PCT Rule 82*quater*.2(a) at the International Bureau (also as receiving Office):
  - Delays in meeting time limits may be excused where the ePCT system or the PCT Contingency Upload Service was unavailable for a minimum of a continuous one hour period on a specific working day at the International Bureau, subject to the applicant:
    - submitting a request indicating that the time limit was not met due to that reason
    - performing the action on the next available working day at the IB when ePCT or the PCT Contingency Upload Service is available again



# Availability of additional Chapter II related documents on PATENTSCOPE

# IPEAs required to copy certain documents in their files to the IB

(Amendments of PCT Rules 71 and 94)

- Requires the IPEA to copy certain documents from its file to the IB, which the IB would make available to the public on behalf of the elected Office
- Apply to any document received at or established by the IPEA on or after July 1, 2020
- However, implementation of the sending of such documents will also depend on whether IPEAs are technically ready to do so



**Rule 26*quater* (correction or addition  
of indications referred to in Rule 4.11)**



# Rule 26*quater* (correction or addition of indications referred to in Rule 4.11)

## ■ New PCT Rule 26*quater*

□ Allows for correction or addition during the international phase of indications referred to in Rule 4.11 in the request form, namely, indications of the applicant's wish that the PCT application be treated in a designated State as

- continuation or continuation-in-part of an earlier application
- patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition

□ Applicants will be able to submit a notice of correction or addition to the IB within 16 months from the priority date

■ Applies to international application filed on or after July 1, 2020



# Transfer of PCT fees through the International Bureau

# Transfer of PCT fees through the International Bureau

- Amendment of PCT Rules 15, 16, 57 and 96
  - Expressly allows the transfer via the IB of fees collected by one Office for the benefit of another Office
  - Apply to any international application for which fees will be transferred by the collecting Office on or after July 1, 2020

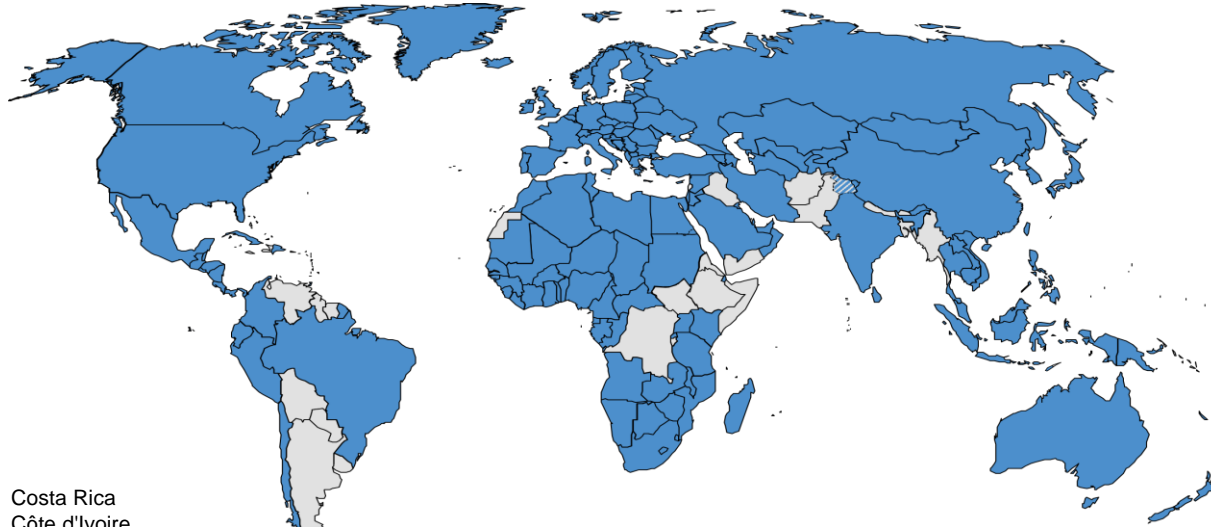


# Additional recent and future PCT developments



# Status update

# 153 PCT States



Albania  
Algeria  
Angola  
Antigua and Barbuda  
Armenia  
Australia  
Austria  
Azerbaijan  
Bahrain  
Barbados  
Belarus  
Belgium  
Belize  
Benin  
Bosnia and Herzegovina  
Botswana  
Brazil  
Brunei Darussalam  
Bulgaria  
Burkina Faso  
Cambodia  
Cameroon  
Canada  
Central African Republic  
Chad  
Chile  
China  
Colombia  
Comoros  
Congo

Costa Rica  
Côte d'Ivoire  
Croatia  
Cuba  
Cyprus  
Czech Republic  
Democratic People's  
Republic of Korea  
Denmark  
Djibouti  
Dominica  
Dominican Republic  
Ecuador  
Egypt  
El Salvador  
Equatorial Guinea  
Estonia  
Finland  
France  
Gabon  
Gambia  
Georgia  
Germany  
Ghana  
Greece  
Grenada  
Guatemala  
Guinea

Guinea-Bissau  
Honduras  
Hungary  
Iceland  
India  
Indonesia  
Iran (Islamic Republic of)  
Ireland  
Israel  
Italy  
Japan  
Jordan  
Kazakhstan  
Kenya  
Kuwait  
Kyrgyzstan  
Lao People's Dem Rep.  
Latvia  
Lesotho  
Liberia  
Liechtenstein  
Lithuania  
Luxembourg  
Madagascar

Malawi  
Malaysia  
Mali  
Malta  
Mauritania  
Mexico  
Monaco  
Mongolia  
Montenegro  
Morocco  
Mozambique  
Namibia  
Netherlands  
New Zealand  
Nicaragua  
Niger  
Nigeria  
Norway  
Oman  
Panama  
Papua New Guinea  
Peru  
Philippines

Poland  
Portugal  
Qatar  
Republic of Korea  
Republic of Moldova  
Romania  
Rwanda  
Russian Federation  
Saint Lucia  
Saint Vincent and  
the Grenadines  
**Samoa (Jan 2, 2020)**  
San Marino  
Sao Tomé e Príncipe  
Saudi Arabia  
Senegal  
Serbia  
Seychelles  
Sierra Leone  
Singapore  
Slovakia  
Slovenia  
South Africa  
Spain  
Sri Lanka  
Sudan  
Swaziland

St. Kitts and Nevis  
Sweden  
Switzerland  
Syrian Arab Republic  
Tajikistan  
Thailand  
The former Yugoslav  
Republic of Macedonia  
Togo  
Trinidad and Tobago  
Tunisia  
Turkey  
Turkmenistan  
Uganda  
Ukraine  
United Arab Emirates  
United Kingdom  
United Republic of Tanzania  
United States of America  
Uzbekistan  
Viet Nam  
Zambia  
Zimbabwe

# Countries not yet PCT Contracting States (40)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Cabo Verde

Democratic Republic of Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Iraq

Jamaica

Kiribati

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

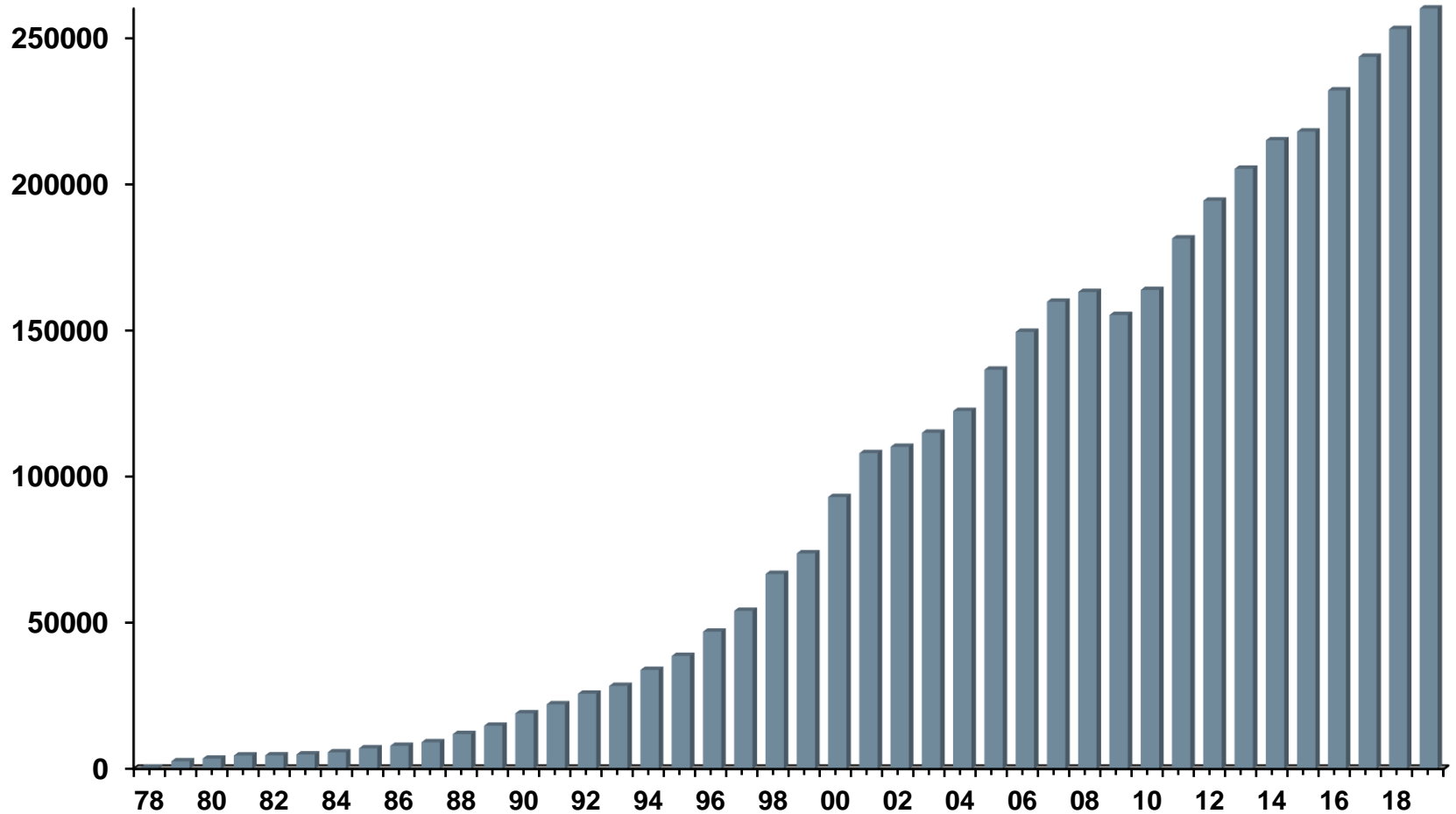
Uruguay

Vanuatu

Venezuela

Yemen

# Total PCT application filings since 1978

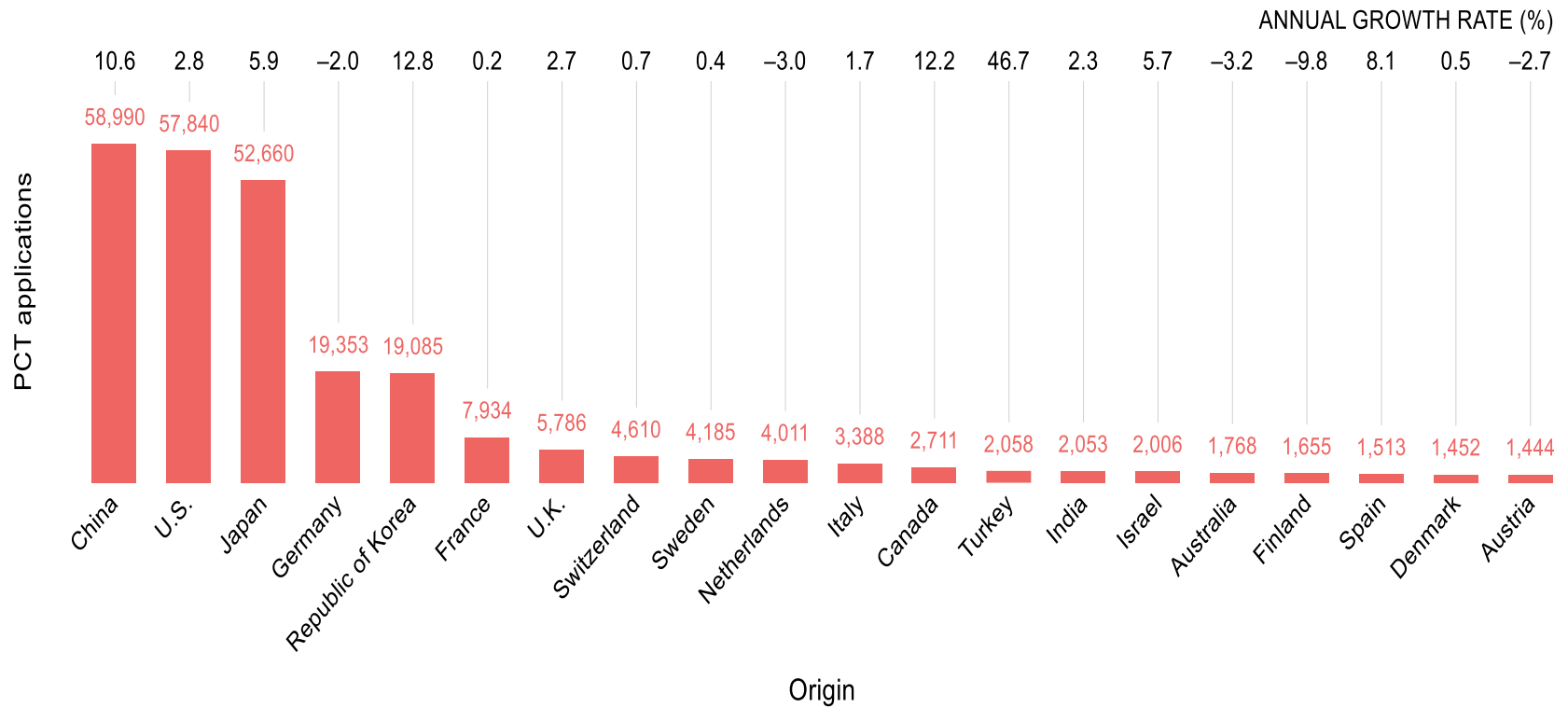


**2019:** 265,800 applications filed (+5.2%)



# International applications received in 2019

## Top 20 Origins



Asia: 52.4%  
 Europe: 23.2%  
 North America: 22.8%



# US Foreign Filing License Rule Changes Facilitating ePCT use

# ePCT-Filing for RO/US

- US foreign filing license scope amended (effective September 30, 2020)
  - covers PCT applications prepared using ePCT for filing with RO/US
  - no longer required to separately comply with export control regulations
- Foreign filing license still required if not previously obtained or new subject matter added



# Best Means of Communication with the IB

# Best means of communication with the IB (1)

- For filing new applications with RO/IB:
  - Applicants should use ePCT (*recommended*) or PCT-SAFE;
  - If neither service is available, international applications can also be uploaded via “Contingency Upload Service”  
(see [https://pct.wipo.int/ePCTExternal/pages/Upload Document.xhtml](https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml))

# Best means of communication with the IB (2)

- Submitting post-filing documents to the IB and RO/IB:
  - ❑ Applicants should use ePCT (*recommended*);
  - ❑ In the event that ePCT is not available, applicants can use the “Contingency Upload Service”
- Receiving Forms and communications from the IB in urgent cases:
  - ❑ Access your application file through ePCT (strong authentication) (*recommended*)
  - ❑ Authorize the IB to send forms and communications by e-mail (ideally “by e-mail only”)
  - ❑ Since January 2020, the IB no longer sends fax

# Best means of communication with the IB (3)

- The IB strongly discourages sending fax to the IB
  - ❑ Technical unreliability of fax transmissions
  - ❑ Transmission failures and/or legibility issues are always the applicant's responsibility (Rule 92.4(c))
  - ❑ Positive fax transmittal report on the applicant's side does not prove successful transmission
- Since January 2020, the IB nevertheless continues to operate a limited fax service as an additional safeguard for applicants who experience technical difficulties in submitting documents electronically
  - ❑ Two remaining PCT fax numbers can be found on the PCT resources website ([https://www.wipo.int/pct/en/#\\_contact](https://www.wipo.int/pct/en/#_contact))
  - ❑ Applicants are advised to contact the “authorized officer” in relation to the application before sending a fax during regular business hours at the IB (or otherwise leave a message on an answering device)



# Color Drawings



# Color drawings (1)

- Applications containing color or greyscale content
  - Not permitted in PCT applications (Rule 11)
  - Since applications often contain color or greyscale content, the IB has included some features in ePCT and PCT-SAFE
    - **ePCT-Filing** will automatically detect color or greyscale content and warn the applicant that the application content should be in black and white
    - **PCT-SAFE** allows applicants to indicate (checkbox) that the application contains color or greyscale content (only for filings with RO/IB)
  - A dedicated preview function has been made available by the IB in order to allow applicants to view the application content as it will be rendered by the IB
    - Directly available in ePCT-Filing
    - <https://pctdemo.wipo.int/DocConverter/pages/pdfValidator.xhtml>

# Color drawings (2)

- Publication of applications containing color or greyscale content
  - The application will be converted into black and white format for further processing and publication by the IB
  - If the application contained color or greyscale content, the front page of the published PCT application will contain a notice to that effect
  - Any original color or greyscale content will be made available on PATENTSCOPE as part of the public application file
- Attention:
  - Designated Offices are not obliged to take the color or greyscale content into account, and may rely on the PCT application as published in black and white



# **PCT Working Group and Committee for Technical Cooperation**

# PCT WG 2020

(Oct. 5-8, 2020)

- Draft amendments to the Regulations and Administrative Instructions to implement WIPO Standard ST. 26 (sequence listings in XML format)
  - Language of free text, treating languages other than English equally with it though providing that DOs could require translation
- EPO Document on Strengthening PCT Safeguards in Case of General Disruption
  - proposes to amend the PCT Regulations to introduce a new Rule which would explicitly allow an Office facing a general disruption to extend PCT time limits in the case of extraordinary circumstances (such as an epidemic) for a defined period
- Review of Supplementary International Search System
- Coordination of Patent Examiner Training
- Coordination of PCT Technical Assistance
  - [https://www.wipo.int/meetings/en/details.jsp?meeting\\_id=55850](https://www.wipo.int/meetings/en/details.jsp?meeting_id=55850)
- **PCT/CTC** (held together with the WG): Contracting States will consider EAPO request to seek appointment as 24<sup>th</sup> ISA

# Where to get help at WIPO on PCT-related questions

PCT Infoline

Telephone  
e-mail

+41 22 338 83 38  
[pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

RO/IB

Telephone  
e-mail

+41 22 338 92 22  
[ro.ib@wipo.int](mailto:ro.ib@wipo.int)

PCT eServices Help Desk

Telephone  
e-mail

+41 22 338 95 23  
[pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)



■ **ePCT – WIPO’s online service for filing and managing patent applications under the Patent Cooperation Treaty (PCT)**

**<https://pct.wipo.int>**

# Contents

- ePCT and WIPO IP Portal
- ePCT Modes and Main Functionalities
- ePCT-Filing for RO/US
- Management of Applications
  - eOwnership and access rights
  - eHandshake
- Post-filing Submission
  - Upload documents
  - ePCT Actions
- What's next

# What is ePCT?

- Web portal developed by WIPO that provides PCT online services for both applicants and IP Offices  
<https://pct.wipo.int>
- User interface available in all PCT publication languages
- Provides secure and direct interaction with PCT applications maintained by the International Bureau
- ePCT-Filing at 70+ PCT receiving Offices
- ePCT allows applicants to conduct a number of electronic PCT transactions ('Actions') with the IB and other participating IP Offices



# 2020 ePCT Statistics (Jan to Aug)

- % of PCT applications filed using ePCT by RO

- RO/IB 77%

- RO/US 23%

- RO/CA 81%

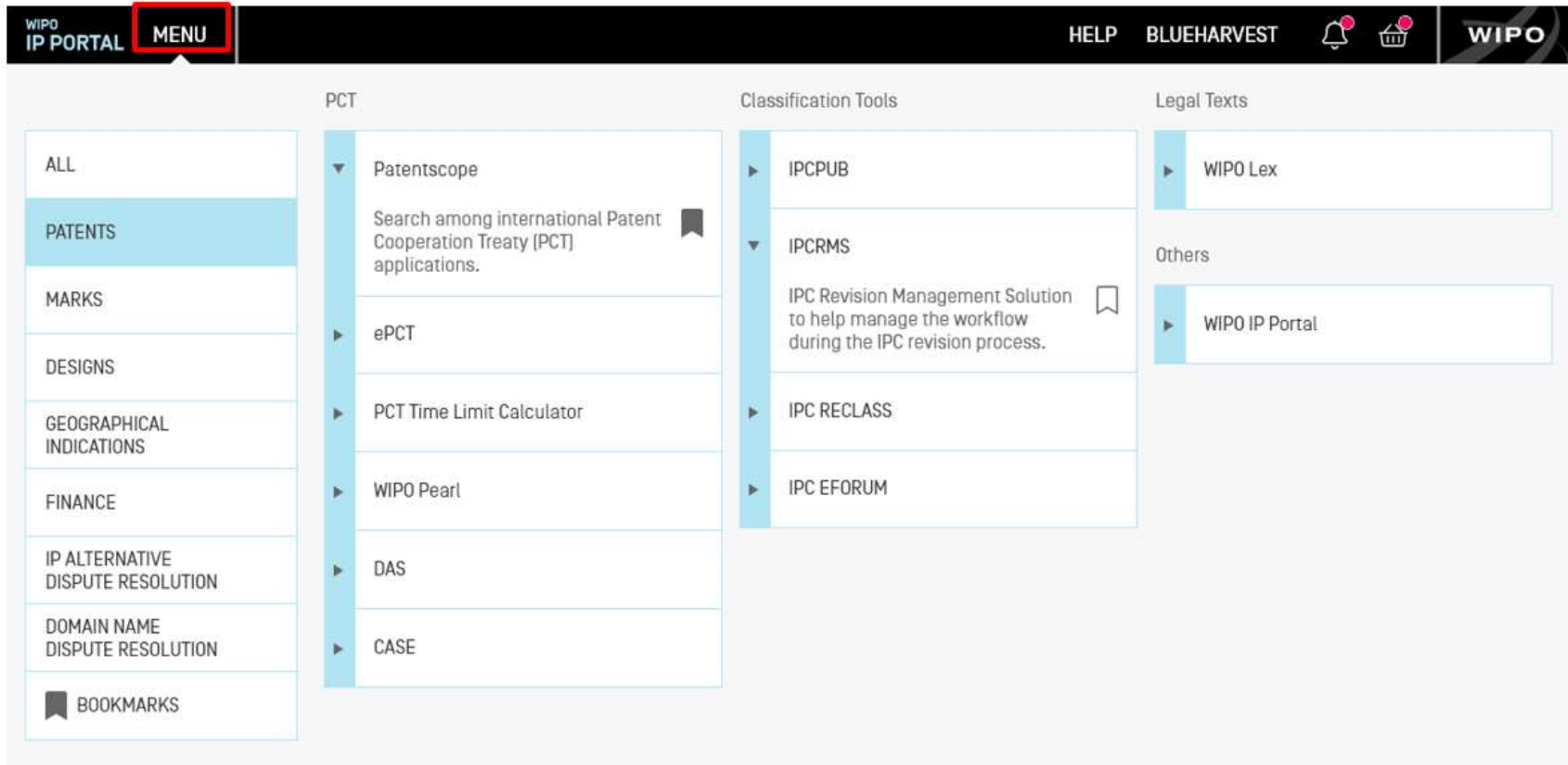
- Top 5 countries: US, KR, CA, AU, TR

# WIPO IP Portal - ePCT Integration (1)

- IP Portal launched in September 2019
- Existing ePCT bookmarks redirect to the IP Portal for login
- Notifications (bell icon in navigation bar) include all your messages from WIPO, e.g., ePCT, Madrid, WIPO Current Account, etc.

# WIPO IP Portal - ePCT Integration (2)

Menu – always available across the portal



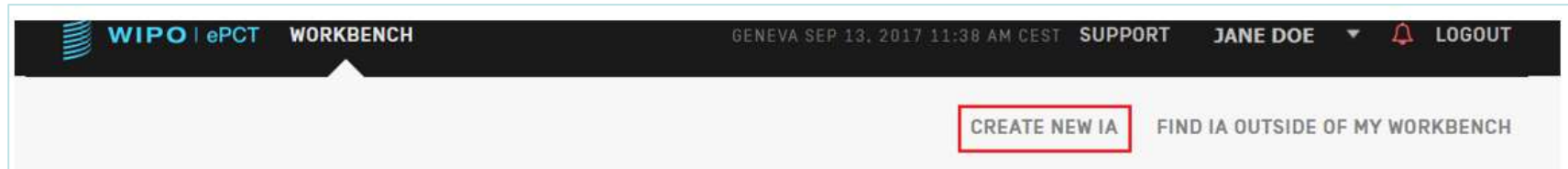
# ePCT modes

- Sign in without strong authentication:
  - ❑ Only a WIPO Account (username and password) required
  - ❑ Limited functionality: upload correspondence, actions Article 19 amendment and Rule 92bis (for published IAs), ePCT messages, and third party observations
- Sign in with strong authentication:
  - ❑ Authentication via one-time app or SMS or digital certificate (WIPO, EPO)
  - ❑ Access to full range of services and functions
  - ❑ Access to applications filed as of January 1, 2009

# Main functionalities

- Create new international application
- eOwnership request
  - At the time of filing
  - After filing
- Create e-Handshakes with colleagues
- Manage access rights
- Perform Actions on IAs, including upload documents
- Access to documents as held by the IB, but also other Authorities, ISA, IPEA, RO

# File a new PCT application



- Web-based filing of PCT applications available to all PCT applicants
- Request form can be prepared in all PCT publication languages
- Real-time validation of data against the electronic processing system of the International Bureau
- Fill in the screens in the order in which they appear to benefit from re-use of certain data

# ePCT-Filing for RO/US (1)

- US foreign filing license scope amended (effective September 30, 2020)
  - covers PCT applications prepared using ePCT for filing with RO/US
  - no longer required to separately comply with export control regulations
- Foreign filing license still required if not previously obtained or new subject matter added

# ePCT-Filing for RO/US (2)

- Functions in a similar manner to PCT-SAFE for the preparation and validation of data making up the PCT Request Form (PCT/RO/101) that is downloaded as a zip file for upload to EFS-Web
- “Clone” existing application to create a new one
  - Bibliographic data of an existing application (whether filed or not) can be used as application template
- No documents can be attached – documents prepared using ePCT-Filing must be downloaded as PDF files and subsequently uploaded into EFS-Web, i.e., RO/134, power of attorney

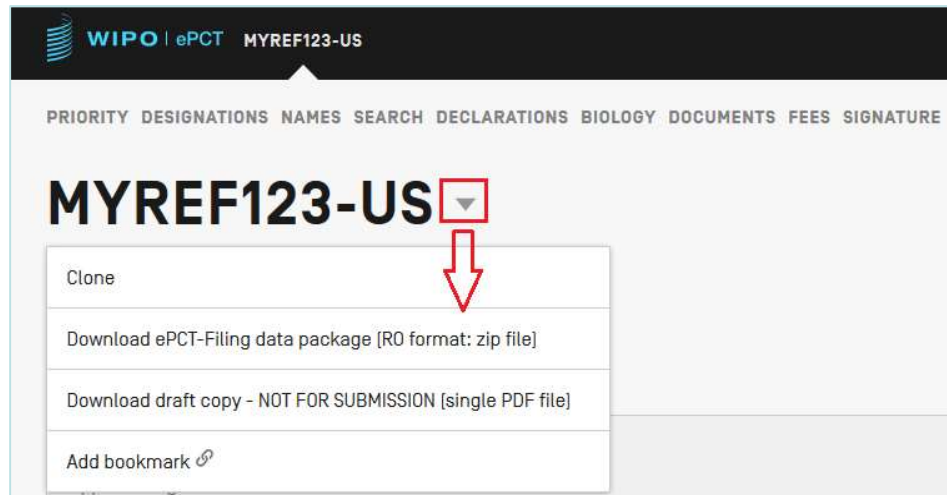


## ePCT-Filing for RO/US (3)

- If needed, download interim **draft copy** (NOT for submission) as a ZIP file or single PDF file, e.g., for external signature process
- Once preparation of draft filing is complete, proceed to the 'Review & create package' step to download filings for subsequent upload to EFS-Web
- Upload to EFS-Web preferably on the same day in order to guarantee the ePCT validation results
  - or at least be mindful of the validations that might be affected by uploading to EFS-Web on a later date
  - do not forget to upload the zip file in EFS-WEB at the time of filing**

# ePCT-Filing for RO/US (4)

- If a downloaded zip file for upload to EFS-Web cannot be located on your computer, it is possible to download it again in the required RO format via the dropdown menu next to the file reference



# eOwnership and Access Rights

- Access rights (eOwnership) allow you to manage a PCT application in ePCT
- eOwnership is automatic via ePCT-Filing
- If ePCT-Filing is not used, additional steps are required to take eOwnership in eOLF, CMS, PCT-SAFE
- eOwnership can be obtained to all PCT applications, paper-filed or electronically-filed
- Access rights can be assigned even to drafts prior to filing – practical for signing purposes (ePCT-Filing)
- eOwner can share access with eHandshake contacts
- Other roles: eEditor and eViewer

# Share Access Rights – eHandshake

- First step in sharing access rights to PCT applications
- Consists in the association and trusted recognition between different WIPO User Accounts with strong authentication before access rights can be shared
- eHandshakes do not directly result in shared access rights which have to be specifically assigned (default access rights options can be pre-defined)
- Best practice - always have **at least 2 eOwners** to facilitate access rights management

# Upload Post-filing Documents

- 'Upload documents' (mostly PDF format) to the IB and also to participating Offices in capacity as RO, ISA, IPEA
  - Types of document selectable depend on recipient selected
  - A cover letter is automatically generated – user can type a message to be included in the cover letter
- Simple, secure alternative to sending documents by mail
- Current date and time at the *recipient* Office is displayed in the interface and set as date of receipt
- After upload, documents are visible under Documents and the recipient Office is notified by the system

# Access to Documents on Record

- Access to documents on Record as held by the IB, but also documents submitted to ePCT participating Offices in their capacity as RO, ISA, IPEA

▼ DOCUMENTS				
▼ RECORD AS HELD BY THE IB				
<input type="checkbox"/>	Documents [Doc ID] ↕	Source ↕	Status ↕	Date ▼
<input type="checkbox"/>	<a href="#">E Filing Transmission Receipt [11]</a> 1 page	ePCT	Processed	06 Mar 2017
<input type="checkbox"/>	<a href="#">ePCT Message [9]</a> 1 page	RO	Not yet processed	06 Mar 2017
<input type="checkbox"/>	<a href="#">Application Body as Filed [2]</a> 4 pages	ePCT	Not yet processed	06 Mar 2017
▼ DOCUMENTS FOR ISA/EP				
<input type="checkbox"/>	Documents [Doc ID] ↕	Source ↕	Status ↕	Date ▼
<input type="checkbox"/>	<a href="#">ePCT Cover Letter [10]</a> 1 page	ePCT	Copy as received	07 Mar 2017
<input type="checkbox"/>	<a href="#">Request for Rectification [11]</a> 1 page	ePCT	Copy as received	07 Mar 2017
▼ DOCUMENTS FOR IPEA/EP				
<input type="checkbox"/>	Documents [Doc ID] ↕	Source ↕	Status ↕	Date ▼
<input type="checkbox"/>	<a href="#">Chapter II Demand for IPEA [13]</a> 6 pages	ePCT	Copy as received	07 Mar 2017
<input type="checkbox"/>	<a href="#">ePCT Cover Letter [12]</a> 1 page	ePCT	Copy as received	07 Mar 2017

# ePCT Actions

- Full suite of Actions only available if signed in to ePCT with strong authentication and with eOwner/eEditor access rights to an application

▼ **ACTIONS**

Select Action

Action \*

- Amendments Under Article 19 (text format only)
- Create Power of Attorney
- Declarations under Rule 4.17
- Licensing Availability Request
- Make international application available to DAS
- Observations on close prior art
- Obtain priority document from DAS
- Online Payment
- Prepare and submit indications relating to biological material (RO/134)
- Request for Early Publication
- Rule 92bis change request
- Submit Chapter II Demand
- Translation for international publication
- Upload Documents
- Withdraw Chapter II Demand
- Withdraw Designation(s)
- Withdraw Election(s)
- Withdraw International Application
- Withdraw Priority Claim(s)

# Benefits of Using ePCT Actions

- “Actions” should be used instead of the equivalent document upload
- The user benefits from pre-filled bibliographic data and automated validations to avoid errors; time limit checks
- Data and documents submitted through Actions are directly imported for processing with no need for retyping (reduces potential transcription errors)
- Secondary workflow benefits, e.g.,
  - Action to withdraw application automatically prevents publication if technical preparations not yet complete
  - Action to submit Chapter II Demand reroutes to IB if required for time limit (e.g., time limit just expired at IPEA/AU)



# File View

- Date and time in Geneva, Switzerland, is displayed at the top of the screen to facilitate awareness of deadlines
- Timeline: graphical representation of PCT time limits
- Summary of key dates
- Publication date and front page preview
- E-mail alerts for most of these time limits can be set up in Notifications Preferences

# What's next

- Offer full web-services for machine-to-machine access to ePCT for large companies and Offices
- Other means of strong authentication

# HELP with ePCT

- DEMO mode for practice <https://pctdemo.wipo.int>
- Interactive FAQ via the Support link on the PCT portal <https://pct.wipo.int>
- PCT eServices Help Desk
  - Tel: +41-22-338-9523
  - E-mail: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)
  - Monday to Friday, 9am-6pm Geneva time
  - Chat feature available

# Useful ePCT articles

- [Getting started](#)
- [ePCT strong authentication methods](#)
- [eOwnership, eHandshakes and Access Rights](#)
- [External signature](#)
- [Actions](#)
- [ePCT Filing](#)
  - [Filing at RO/IB \(as an example of ePCT-Filing\)](#)
  - [Filing at RO/US using ePCT in combination with EFS-Web](#)
  - [Advantages of using ePCT with EFS-Web](#)

# Thank you!



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WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION