

# Update on Recent and Future Developments in the PCT System



Virtual seminar

Geneva, October 14, 2020

# Program

- 9.05 – 9.30: Amendments to the PCT Regulations
- 9:30 – 10:00: Recent and future PCT developments
- 10.00 – 10:30: ePCT: Latest and future developments
- 10:30 – 11:30: Open PCT Q&A session



**Matthias  
Reischle-Park**  
Deputy Director  
PCT Legal and User  
Relations Division



**Eva  
Schumm**  
Senior Legal Officer  
PCT Legal and User  
Support Section  
PCT Legal and User  
Relations Division



**Thomas  
Henninger**  
Senior Legal Information  
Officer  
PCT User Resources  
Section  
PCT Legal and User  
Relations Division



**Viviane  
Gross**  
Head  
PCT eServices Unit  
PCT Information  
Systems Division



**Cécile  
Chatel**  
Operations Team  
Coordinator  
PCT RO/IB Team  
PCT Operations  
Division



# Amendments to the PCT Regulations as from 1 July 2020

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

- Incorporation by reference of erroneously filed elements and parts
- Rule 82*quater* (excuse of delays in meeting a time limit due to the unavailability of any permitted electronic means of communication at that 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

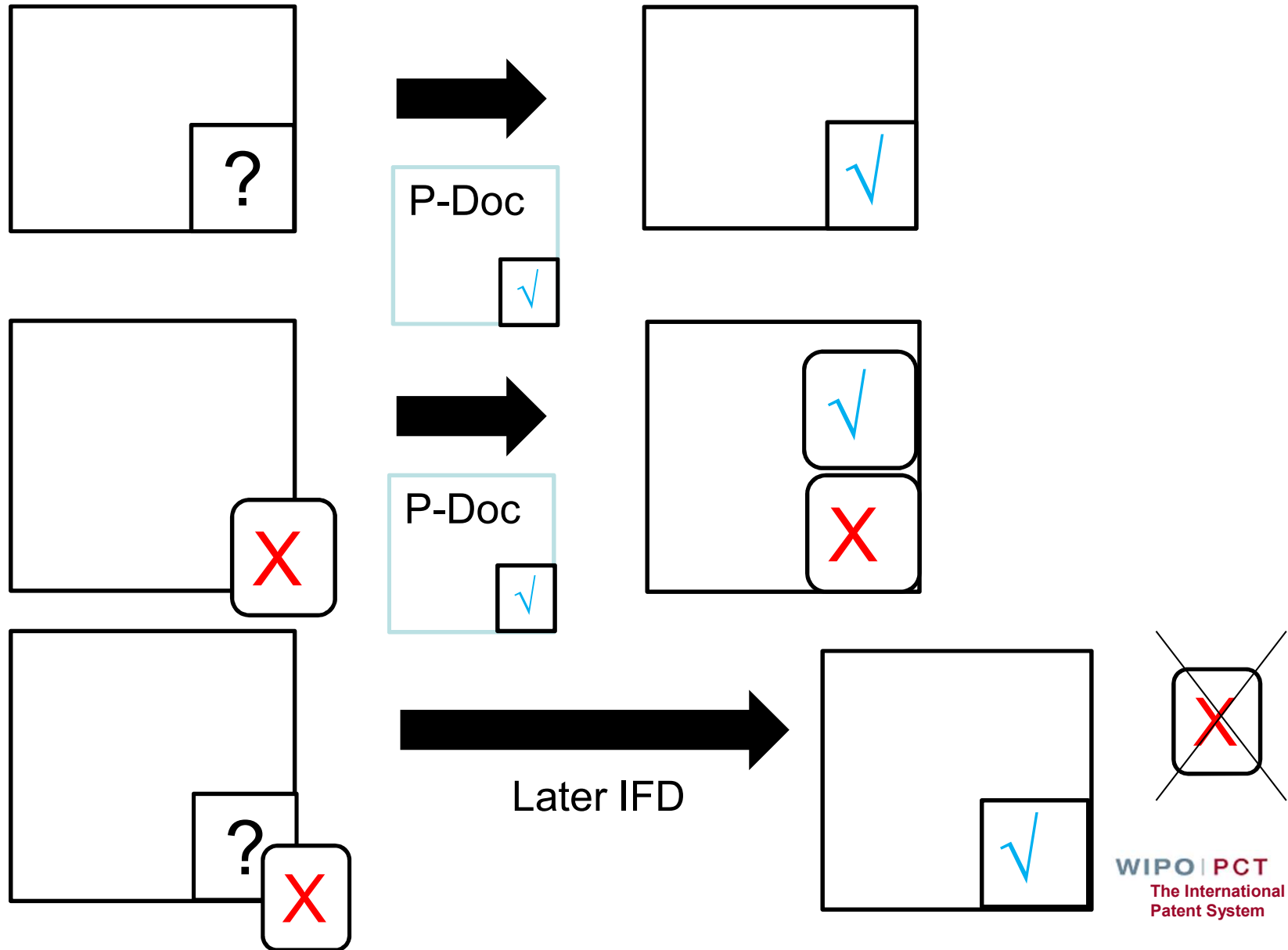


# Incorporation by reference of erroneously filed elements and parts

# Incorporation by reference of erroneously filed elements and parts

- Amendment of PCT Rules 4, 12, 20, 48, 51*bis*, 55 and 82*ter*, and new Rules 20.5*bis* and 40*bis*
  - Clarification that, in addition to incorporating missing elements and parts, in the case of erroneously filed elements or parts, the correct element or part can also be incorporated by reference, if contained in an earlier application
  - New legal basis for cases where incorporation by reference was not successful or applicable, to replace an erroneously filed element or part with the correct element or part (impacting the international filing date)
  - Apply to any international application filed on or after 1 July 2020

# Missing ≠ erroneously file ≠ completed/corrected



# Overview of 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>Main 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 cases 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 where new international filing date is still within priority period
  - If new filing date is outside the priority period, could 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 refiling of the application may be considered
- Fee implications

# Incorporation by reference of erroneously filed elements and parts: understandings

## ■ PCT Assembly Understanding

- ❑ 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 which remained in the application
- ❑ 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 that correct element or part for the purposes of international search

**■ Rule 82*quater* (excuse delays in meeting a time limit due to the unavailability of any permitted electronic means of communication at that Office)**

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

- Allows an Office to also 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 1 July 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 because of Office electronic system unavailability (Amendment of PCT Rule 82*quater*) (2)

- 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 1 July 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 26quater (correction or addition of indications referred to in Rule 4.11)

## ■ New PCT Rule *26quater*

□ 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 any international application filed on or after 1 July 2020



# Transfer of PCT fees through International Bureau

# Transfer of PCT fees through 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 1 July 2020



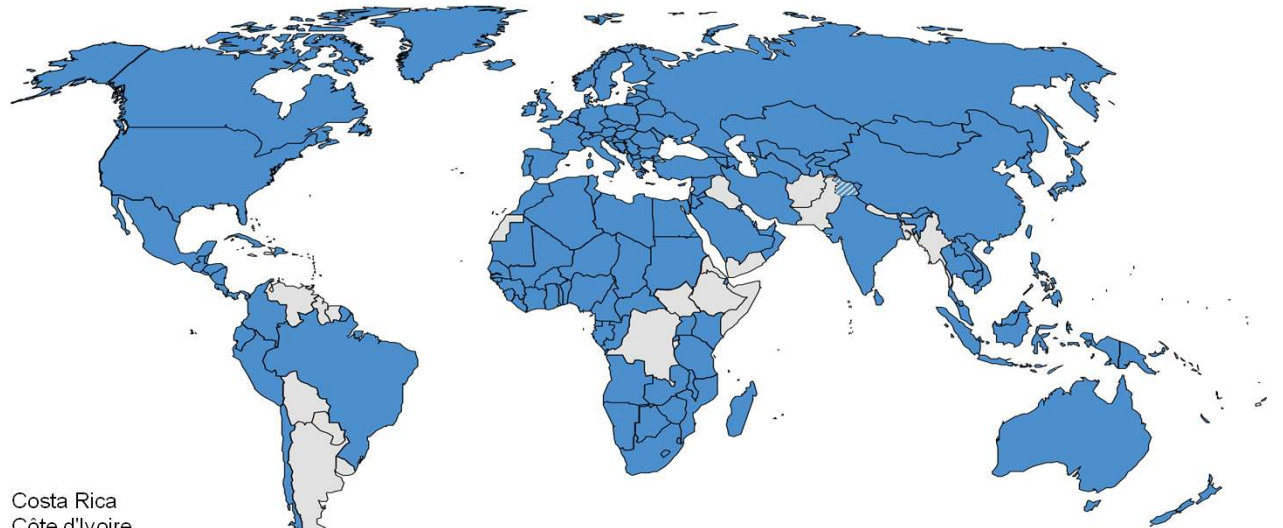
# Additional recent and future PCT developments



# Status update

Update GVA- Europe 21  
23.09.2020

# 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  
Libya  
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

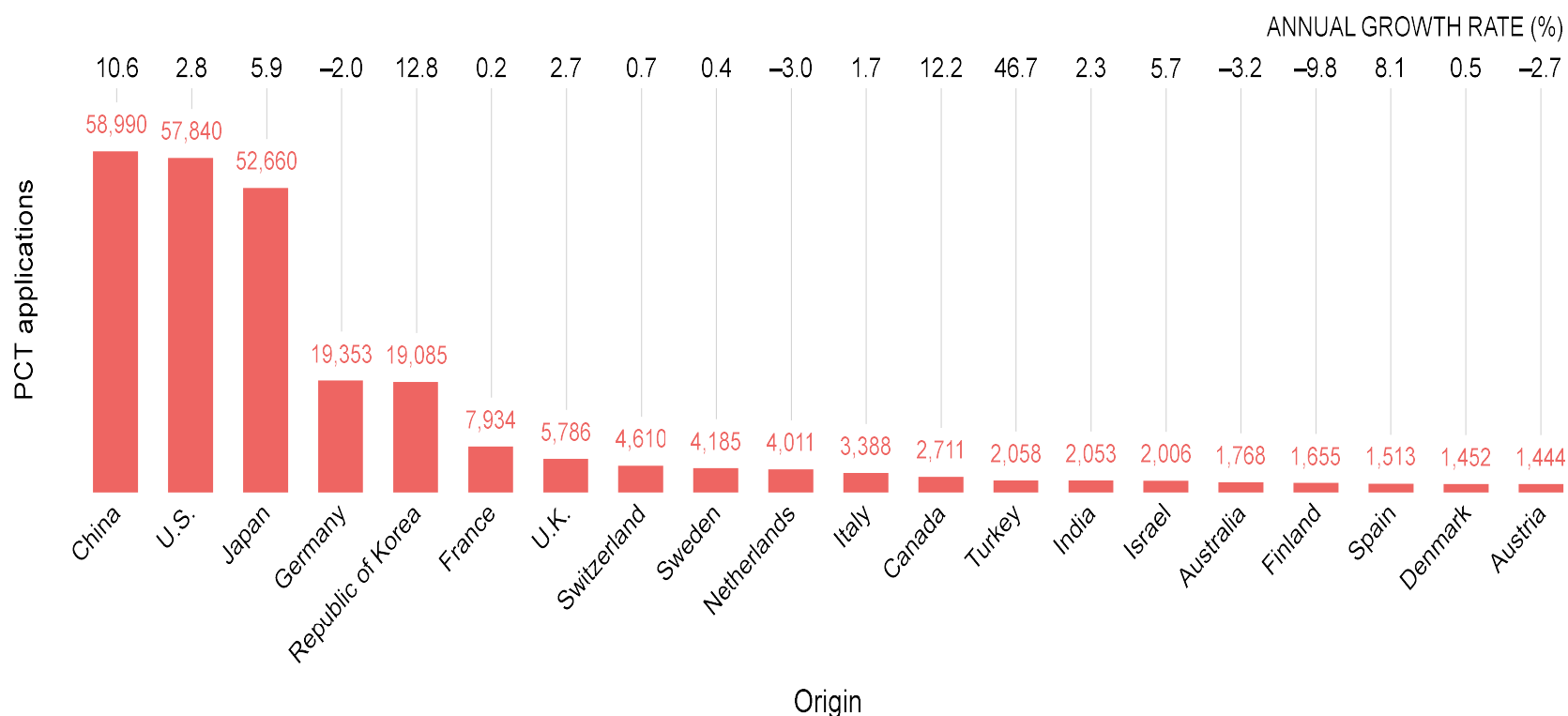
Uruguay

Vanuatu

Venezuela

Yemen

# International applications received in 2019 and Top 20 Origins

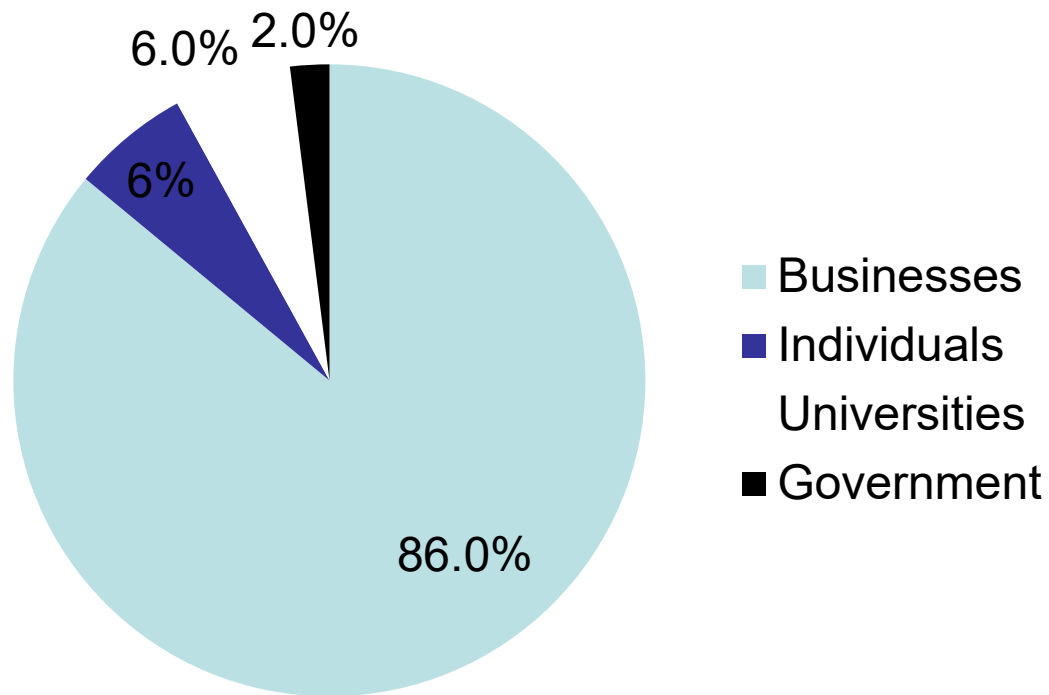


Asia: 52.4%  
 Europe: 23.2%  
 North America: 22.8%

Around **265,800 PCT** international applications were filed in 2019, up 5.2% on 2018. For the first time, applicants from China filed the most PCT applications.



# Distribution of PCT Applicants in 2019



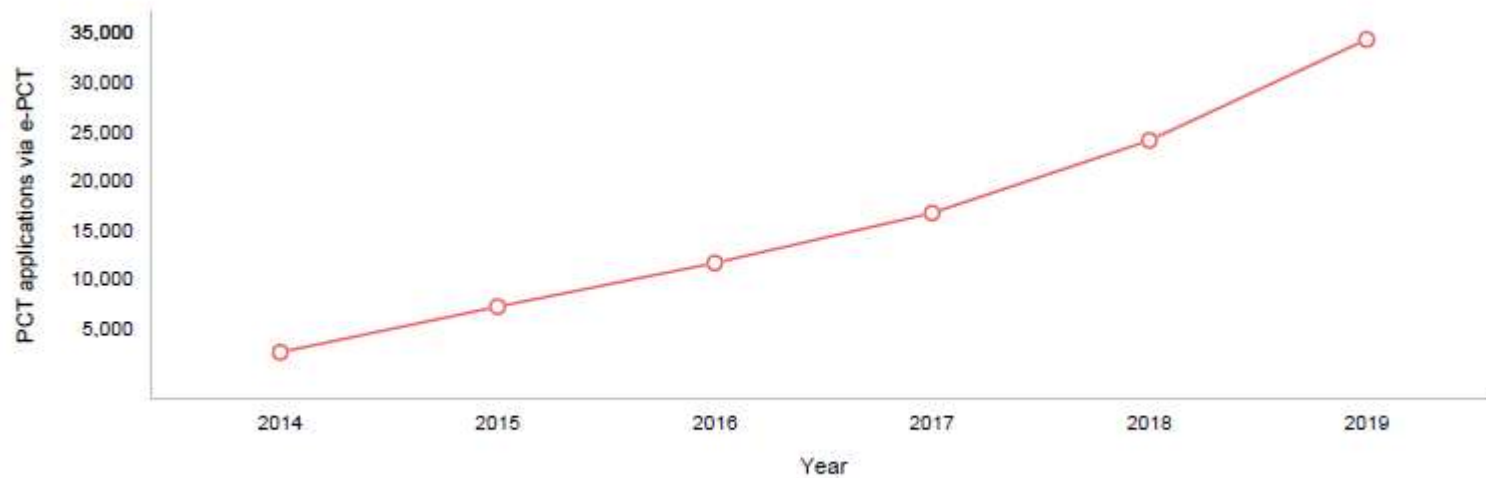
**127** (unchanged)  
**Countries in which PCT applications were filed**

**56.9%** (-0.5 percentage point)  
**Share of PCT national phase entries in worldwide non-resident filings**

**18.7%** (+1.6 percentage points)  
**Share of women among PCT inventors**

# Applications filed via ePCT in 2019

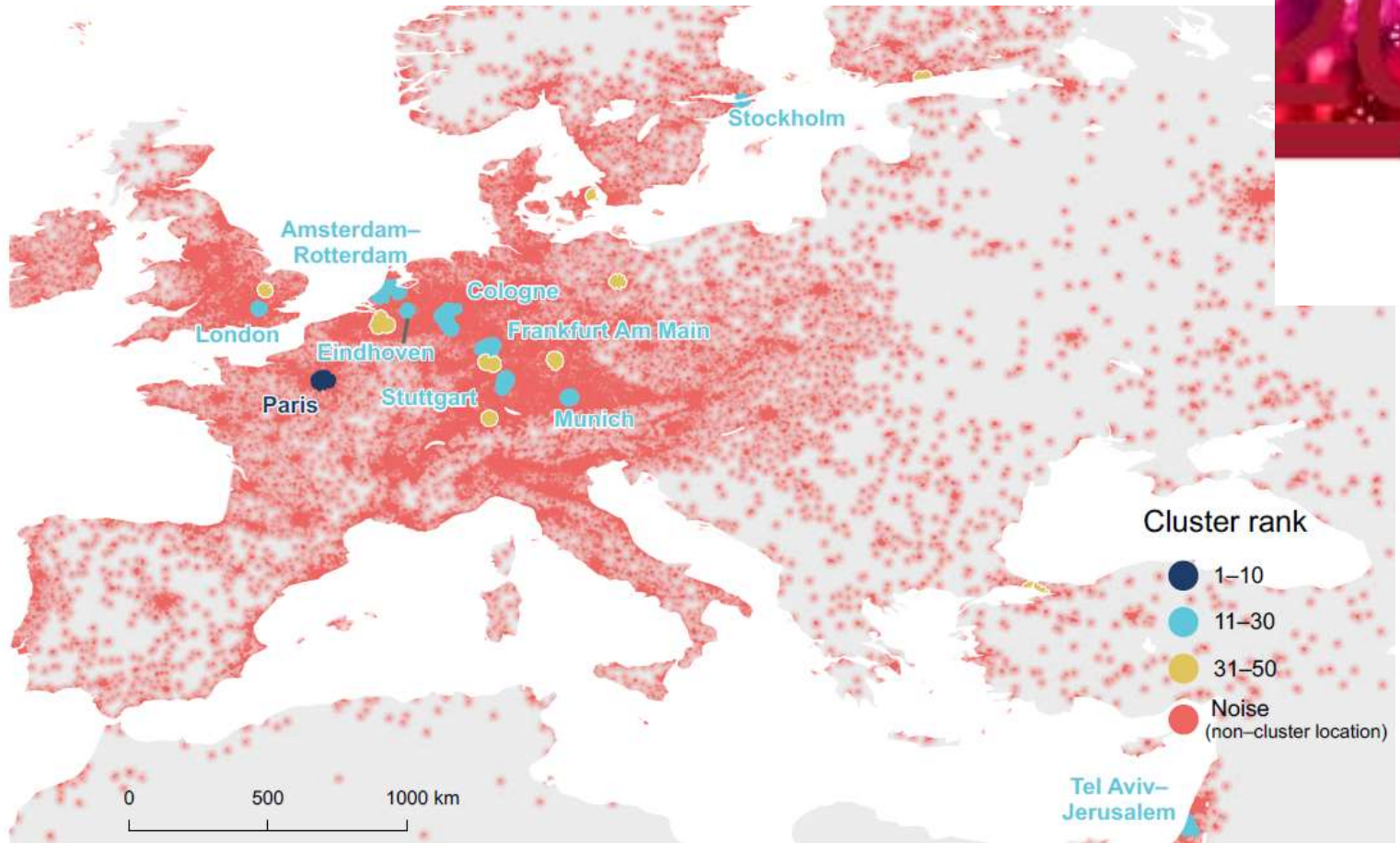
C3. Trend in PCT applications filed using ePCT, 2014–2019



■ PCT APPLICATIONS VIA E-PCT

- 34,335 applications (13% of total) filed via ePCT Portal in 2019 (+42,6% over 2018)

# Top PCT Clusters 2014-2018



# PCT-PPH requests 2019

C28. Distribution of PCT-PPH requests by international authority and office of PCT national phase entry, 2019

Office of later examination	Office of earlier examination														Total
	Japan	EPO	U.S.	China	Republic of Korea	Canada	Israel	Russian Federation	Australia	Sweden	Finland	Singapore	Spain	Others	
Japan	1,501	621	94	86	46	6	5	10	9	1	6	0	0	5	2,390
China	556	857	112	0	81	13	10	26	0	18	8	5	0	0	1,686
Republic of Korea	245	225	95	48	42	4	6	3	2	4	4	2	0	2	682
EPO	317	0	140	65	24	30	12	8	3	0	0	6	0	0	605
Canada	79	197	79	40	29	103	2	9	6	0	1	3	1	2	551
Philippines	301	20	120	0	10	0	0	0	0	0	0	0	0	0	451
Russian Federation	89	135	37	42	14	1	6	0	1	3	1	1	1	0	331
Australia	30	119	83	0	24	5	3	2	0	0	0	1	0	0	267
Mexico	84	67	9	3	0	0	0	0	0	0	0	0	12	0	175
Israel	3	86	18	8	3	0	30	0	2	0	0	0	0	1	151
Malaysia	93	0	0	0	0	0	0	0	0	0	0	0	0	0	93
Colombia	2	23	34	0	0	3	0	0	1	0	0	0	0	5	68
U.K.	13	0	21	4	3	1	2	2	2	0	0	0	0	0	48
Eurasian Patent Organization	10	26	0	0	0	0	0	0	0	0	0	0	0	0	36
Brazil	0	0	5	2	0	0	0	0	0	0	0	0	0	8	15
New Zealand	0	0	8	0	3	0	0	0	1	0	0	0	0	0	12
Singapore	0	9	0	0	0	0	0	0	0	0	0	0	1	0	10
Others	4	0	0	0	0	0	0	1	0	1	0	0	0	2	8
<b>Total</b>	<b>3,327</b>	<b>2,385</b>	<b>855</b>	<b>298</b>	<b>279</b>	<b>166</b>	<b>76</b>	<b>61</b>	<b>27</b>	<b>27</b>	<b>20</b>	<b>18</b>	<b>15</b>	<b>25</b>	<b>7,579</b>

Note: EPO is the European Patent Office. Data for several offices of later examination, such as Germany, Indonesia and the United States Patent and Trademark Office (USPTO) are missing.

Source: WIPO, based on data from the Japan Patent Office, March 2020.

Further information on PCT-PPH:

[www.wipo.int/pct/en/filing/pct\\_pph.html](http://www.wipo.int/pct/en/filing/pct_pph.html)

**WIPO | PCT**  
The International  
Patent System

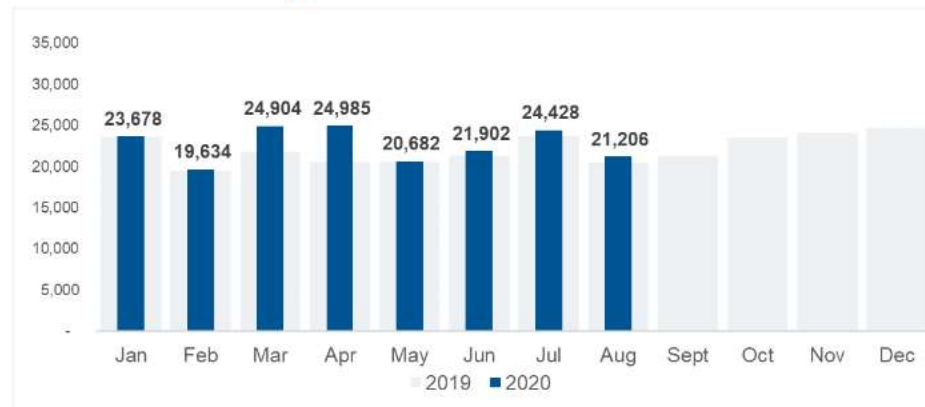
# Filings during COVID-19

## ■ WIPO Crisis Management Dashboard

[www.wipo.int/export/sites/www/covid-19/en/dashboard/crisis\\_mgt\\_dashboard.pdf](http://www.wipo.int/export/sites/www/covid-19/en/dashboard/crisis_mgt_dashboard.pdf)

### Filing Activities *(as at date of receipt at the International Bureau (IB))*

#### PCT International Applications



		Jan-August 2020			
		2020/21 Estimates	Target <sup>1</sup>	Actuals <sup>2</sup>	as % of Target
<b>PCT:</b>	International Applications	549,900	180,000	168,744	94%



# Best Means of Communication with the IB

# Best means of communication with the IB (1)

- For the filing of new applications with RO/IB:
  - Applicants should use ePCT (*recommended*) or PCT-SAFE;
  - In the event that neither service is available, international applications can also be uploaded through the new “Contingency Upload Service” (see <https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml>)

# Best means of communication with the IB (2)

- For the submission of 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 new “Contingency Upload Service”
- To receive 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 to you by e-mail (ideally “by e-mail only”)
  - ❑ Since January 2020, urgent communications are no longer being sent by fax



# Best means of communication with the IB (3)

- The IB strongly discourages the use of fax as a means of communication with the IB for the following reasons:
  - ❑ 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
  - ❑ The only remaining two 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)

# Particular safeguards under the PCT (1)

- PCT does not currently provide for a general extension of time limits except where Offices are officially closed
- Local measures which extend national time limits do not apply to PCT time limits during the international phase but may apply to time limits during the national phase
- Priority period:
  - Only where an Office has declared itself closed for the filing of applications will the protection of Article 4C(3) of the Paris Convention apply
  - Where Offices remain open, restoration of the priority right (Rule 26*bis*.3 and 49*ter*) may be relied upon (where available)

# Particular safeguards under the PCT (2)

- Rule 82*quater*.1 - excuse of delay in meeting time limits “due to ... natural calamity ... or other like reason”
  - Rule 82*quater*.1 applies to all time limits under the PCT (e.g. payment of fees, furnishing of priority documents, correction of priority claims, etc.), except to the priority period and the time limit to enter national phase
  - IB will treat requests favorably
  - Not require evidence that virus affected locality
  - Director General urges national Offices to do same ([https://www.wipo.int/pct/en/news/2020/news\\_0009.html](https://www.wipo.int/pct/en/news/2020/news_0009.html))
- Rules 80.6 and 82: delays in the mail (5- and 7-day-rule)

# Current Situation at the IB

- Forms and communications are currently provided to applicants and Offices only in electronic form
  - Forms are sent as PDF-attachments
  - Applicants need to provide e-mail addresses, if they have not yet done so, to allow IB to send Forms and other communications as e-mail attachments
  - Priority documents and certified copies of documents in the file of the IB issued in electronic form only
  - Rely on the Digital Access Service (DAS) where possible
- Information on how to best communicate electronically with the IB available on the PCT website  
([https://www.wipo.int/pct/en/news/2020/news\\_0008.html](https://www.wipo.int/pct/en/news/2020/news_0008.html))



# 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 (1)

PCT Infoline	Telephone e-mail	+41 22 338 83 38 <a href="mailto:pct.infoline@wipo.int">pct.infoline@wipo.int</a>
RO/IB	Telephone e-mail	+41 22 338 92 22 <a href="mailto:ro.ib@wipo.int">ro.ib@wipo.int</a>
PCT eServices Help Desk	Telephone Internet address e-mail	+41 22 338 95 23 <a href="http://www.wipo.int">www.wipo.int</a> <a href="mailto:pct.eservices@wipo.int">pct.eservices@wipo.int</a>