

# PCT – July 2020 Rule changes



Webinar

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# Amendments to the PCT Regulations as from 1 July 2020

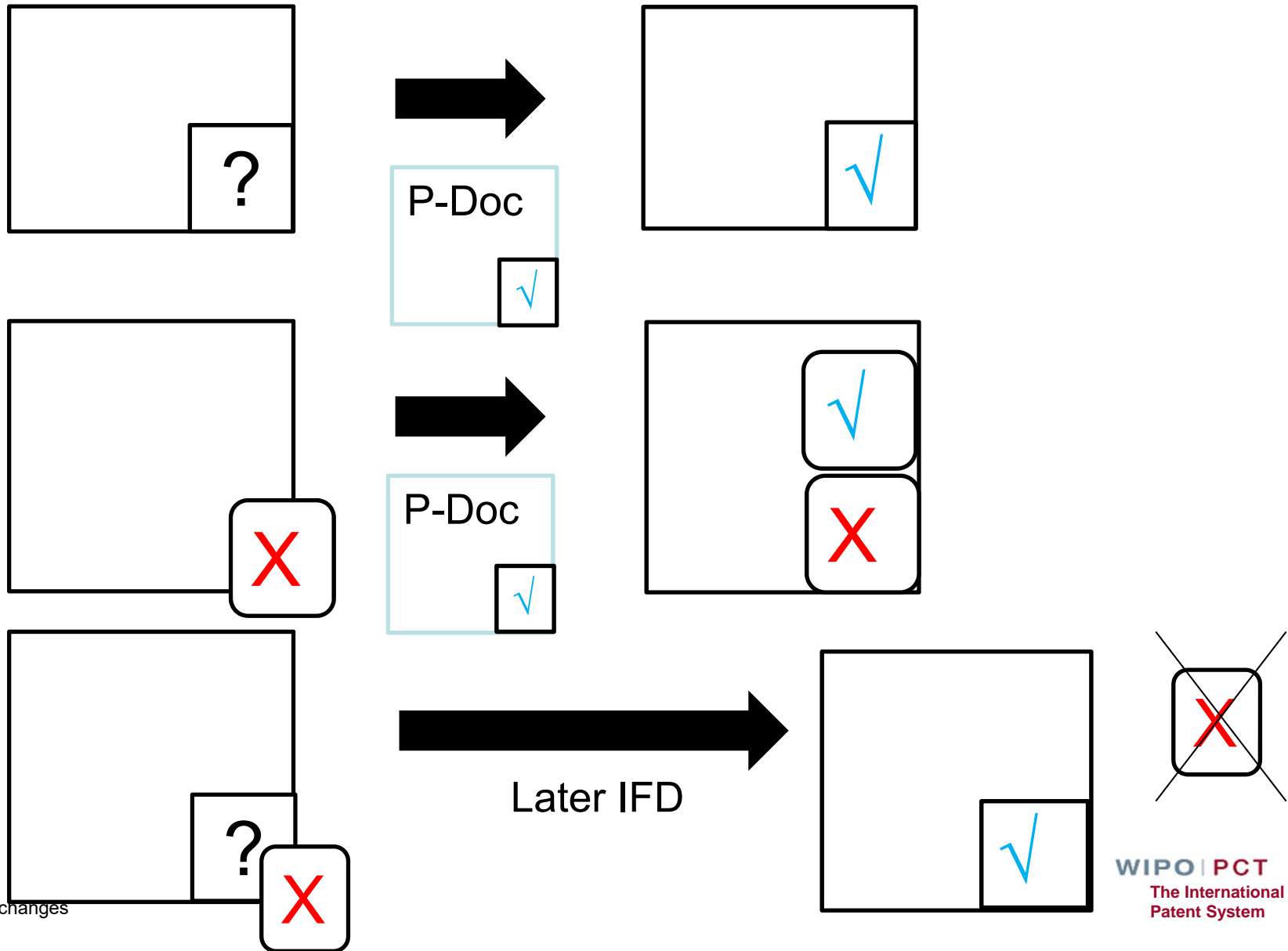
# Amendments to the PCT Regulations as from 1 July 2020 - Overview

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

# Amendments to the PCT Regulations as from 1 July 2020 (1)

- 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 refileing of the application may be considered
- Fee implications

# Amendments to the PCT Regulations as from 1 July 2020 (2)

## ■ 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



# Amendments to the PCT Regulations as from 1 July 2020 (3)

## ■ Amendment of PCT Rule 82<sup>quater</sup>

- ❑ 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 PCT 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 such provisions in general
  - of any specific occurrence of its system outage

# Amendments to the PCT Regulations as from 1 July 2020 (4)

## ■ New PCT Rule 26<sup>quater</sup>

- Allows for correction or addition 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

# Amendments to the PCT Regulations as from 1 July 2020 (5)

## ■ 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

## ■ Amendment of PCT Rules 71 and 94

- Requires the IPEA to transmit 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 when the IPEA is technically ready to do so

# PCT Information and Training

- 29 video segments on PCT topics, available on WIPO's YouTube channel and WIPO's PCT webpage
- PCT distance learning course available in 10 PCT publication languages, and an advanced DL course under preparation
- PCT Webinars
  - updates on developments in PCT procedures, and PCT strategies—previous webinars are archived and freely available
  - available upon request for companies or law firms, for example, for focused training on how to use ePCT
- Video and audio conferences also available upon request
- In-person PCT Seminars and training sessions: see PCT seminar calendar (<http://www.wipo.int/pct/en/seminar/seminar.pdf>)
- Monthly Newsletter (<http://www.wipo.int/pct/en/newslett/>)
- Extensive information resources on PCT website (<http://www.wipo.int/pct/en/>)
- Contact us to discuss PCT training opportunities

# PCT Resources/Information

- For general questions about the PCT, contact the PCT Information Service:

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