



Entering the national phase

WIPO PCT Webinar Series

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Mr. Matthias Reischle-Park
Deputy Director
PCT Legal and User Support Section
PCT Legal and User Relations
Division

Ms. Hanna Kang
Legal Officer
PCT Legal and User Support Section
PCT Legal and User Relations Division

What we will cover....

- Decision-making process
- Preparing your national phase entries
- National phase requirements
- Best practice tips

Poll questions



Decisions to be taken by the applicant

■ Whether

- to proceed with or drop the international application?

■ When

- at the end of 30 months (in some cases 31 months or more)

- under Chapter I?*
- under Chapter II?

- early entry?

■ Where (choice limited to designated/elected Offices)

- which national Offices
- which regional Offices

* LU and TZ continue to apply a 20-month time limit

Preparing for national phase entry

- Take relevant decisions as early as possible
- Double-check names of applicants to allow for last-minute Rule 92*bis* requests
- Provide local agent with all relevant information (via ePCT?)
- Instruct local agent how to further prosecute the case
 - National phase amendments?
 - How to argue the case
 - Continue to provide local agent with information

Use of PCT-PPH?

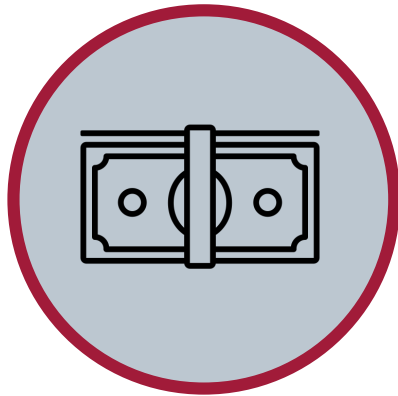
■ Some benefits:

- Reduces duplication of effort via patent office work-sharing
- Increases grant rate
- Reduces pendency and legal uncertainty
- Streamlines prosecution
- Reduces cost (by reducing number of office actions)

■ Procedural requirements

General requirements (Art. 22(1) and 39(1)(a))

■ Within the applicable time limit, furnish:



National fee



Copy of the
PCT application
(pre-publication)



Translation
(if required)

Time limit issues

- The time limit to enter national phase applies irrespective of possible delays in the international phase
- Where national phase entry time limit has been missed:
 - Does Rule 49.6 reinstatement of rights apply?
 - If yes, which criterion is applicable?
 - Which time limit applies?
 - Cases, where Rule 49.6 does not apply

DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law (Rule 49.6(f)):

CA	Canada	LV	Latvia
CN	China	MX	Mexico
DE	Germany	NZ	New Zealand
IN	India	PH	Philippines
KR	Republic of Korea	PL	Poland

- The national law applicable by some of these Offices may nevertheless provide for other forms of protection against loss of rights - for further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant's Guide*, National Phase

Translation issues

- Most Offices require translation of international application as filed and as amended
- Translations must be accurate
- Text matter in drawings
- Defects in translations?

Amendments under national law

- PCT guarantees opportunity to amend application in the national phase
- Details of amendment practice are governed by national law
- Adapt claim drafting to national preferences
- Reduce number of claims to avoid/reduce claims fees
 - Special cases: CN, DE, IN
- Time limit

Special national requirements

- Time limit under Rule 51*bis*.3
- Declarations should now pay off
- Translation of the priority document (Rule 51*bis*.1(e))

<https://www.wipo.int/pct/en/guide/index.html>

Is your agent requiring more than he/she should?

■ Legitimate cases:

- Original priority document where document was not furnished in time during international phase
- Proof or evidence concerning recorded changes under Rule 92*bis*
- By pass route in the US

■ Not so legitimate cases:

- Does request come from the Office?
- Clarify with International Bureau

Poll answers



Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

E-mail: pct.infoline@wipo.int

■ Questions about the ePCT

□ Contact PCT eServices Help Desk:

Telephone: +41 22 338 95 23

E-mail: pct.eservices@wipo.int

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