

Speaker Outline

■ The PCT System:

03 – The PCT International Phase

06 – The PCT National Phase

08 – The Promotion of Cooperation among IP Offices in the Arab Region

Dr. Ahmed Donia
International IP Expert
Abu-Ghazaleh Intellectual Property
Cairo



■ The PCT International Phase: Filing of PCT Applications

Elements making up the international application

- Request (Article 3(2))
- description (Article 3(2))
- one or more claims (Article 3(2))
- abstract (may be filed later without affecting the international filing date) (Articles 3(2) and 3(3))
- drawings (where applicable) — later submission may, subject to certain conditions, result in a later international filing date (Articles 3(2) and 14(2))
- sequence listing part of description (where applicable) (Rule 5.2(a))
- indications containing references to deposited microorganisms or other biological material (some designated Offices (e.g. Japan) require that they be in the description or in the international application on the international filing date) (Rule 13*bis*)

Elements which may accompany the international application

- translation of the international application for the purposes of international search or international publication — may be furnished later without affecting the international filing date (Rules 12.3 and 12.4)
- separate power of attorney or copy of general power of attorney — may be filed later without affecting the international filing date (Rules 90.4 and 90.5)
- priority document(s) — may be furnished until the date of international publication (Rule 17.1)
- sequence listing in electronic form complying with the Standard set out in Annex C of the Administrative Instructions—may be furnished later directly to the ISA without affecting the international filing date but subject to a late furnishing fee (Rule 13*ter*)
- separate indications concerning deposited biological material that are not part of the international application, for ex., Form PCT/RO/134 (Rule 13*bis*)

The request

- Printed request form (Form PCT/RO/101)
 - periodically updated
 - available on Internet (<http://www.wipo.int/pct/en/forms>)
 - may be obtained free of charge from the receiving Office or the International Bureau
- Computer-generated request (Rules 3.1 and 3.4, Section 102(h))
 - layout and contents must correspond to those of the printed form (no boxes may be omitted)
 - slight adjustments are permitted
 - any text printed in italics may be omitted
- PCT-SAFE (EASY mode) request (Rule 89*ter* and Section 102*bis*)
- Electronic filing of the international application in accordance with Part 7 and Annex F of the Administrative Instructions with ROs which accept the filing of international applications in electronic form

Concept and operation of designation system (Rule 4.9)

- Automatic and all-inclusive designation of all PCT Contracting States
 - exceptions to the all-inclusive designation possible for DE, JP and KR (countries with particular rules on “self-designation”)
 - but only if the international application contains a priority claim to an earlier application filed in the State that is to be excluded
 - otherwise withdrawals of designations possible
- Choice of types of protection postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- “Parent” information (continuation applications, patents of addition) may be included in PCT request form for search purposes

Signature of the request (1)

(Rules 4.15, 26.2*bis*(a))

- In principle, the request must be signed by all persons (legal entity or natural persons) indicated as “applicant” or “applicant and inventor”

BUT: if only one of the applicants signs, the lack of signature of the other applicants will not be considered a defect

WARNING: Any notice of withdrawal would have to be signed by or on behalf of all applicants (including applicant/inventors)

NOTE: DOs are entitled to require confirmation of the international application by the signature of any applicant for the DO who has not signed the request

Signature of the request (2)

(Rules 4.15, 26.2*bis*(a))

- Signature by a person not named as applicant (FOR---ON BEHALF OF---AS AUTHORIZED SIGNATORY OF) depends on national law applied by receiving Office:
 - either an officer or employee of a legal entity (an officer or employee who does not have to be a patent attorney or patent agent)
 - or a legal representative, if the applicant is a natural person who is incapacitated
 - or a legal representative, if the applicant is a bankrupt company
- A person indicated as “inventor only” need not sign the request

Signature of the request (3) (Rules 4.15, 26.2*bis*(a))

- If the request is not signed by the applicant(s) but by an agent, a separate power of attorney signed by all the applicant(s) must be filed (either original individual power or copy of general power)

BUT: if only a power of attorney signed by one applicant is filed , the lack of powers of attorney signed by the other applicants will not be considered a defect

NOTE: ROs may waive requirement that a separate power or a copy of a general power of attorney must be submitted

Physical requirements of the international application (Rule 11) (1)

- A4 size paper for all the sheets (Rule 11.5)
- Line spacing: 1 1/2 for pages of text in description, claims and abstract (Rule 11.9(c))
- Minimum and maximum margins for the sheets of text and drawings (Rule 11.6)
- Indication of the applicant's or agent's file reference (Rule 11.6(f) and Section 109)
 - 12 characters maximum
 - in the upper left-hand corner of the sheet
 - within 1.5 cm of the top of the sheet

Physical requirements of the international application (Rule 11) (2)

- Numbering of the sheets (Rule 11.7, Sections 207 and 311)
 - centered at the top or bottom of the sheets, not in the margin
 - 4 series: request
description, claims, abstract
drawings (if any)
sequence listing part of the description (if any)
- Special requirements for drawings (Rule 11.13)

Recommendation: no text matter in the drawings (avoids problems with translations for national phase)

Headings of the parts of the description (Rule 5 and Section 204 of the Administrative Instructions)

- Technical Field
- Background Art
- Disclosure of Invention *or* Summary of Invention
- Brief Description of Drawings
- Best Mode for Carrying Out the Invention *or, where appropriate, Mode(s) for Carrying Out the Invention*
- Industrial Applicability
- Sequence Listing
- Sequence Listing Free Text



Declarations

Declarations under Rule 4.17

- Purpose: possibility to anticipate certain national phase requirements during the international phase (Rule 51*bis*.2)
- Inclusion in request or subsequent filing is optional
- Declarations relate to the following matters (Rule 4.17):
 - identity of the inventor
 - applicant's entitlement to apply for and be granted a patent
 - applicant's entitlement to claim priority of an earlier application
 - declaration as to inventorship (for the US designation only)
 - non-prejudicial disclosures or exceptions to lack of novelty

Formal requirements

- Declarations have to use standardized wording as prescribed in Sections 211 to 215 of the Administrative Instructions
- Where a declaration has been furnished, no documents or evidence as to that matter may be required by the designated/elected Office
 - unless that Office may reasonably doubt the veracity of the declaration; and/or
 - evidence concerning non-prejudicial disclosures or exceptions to lack of novelty may be required

Declaration of inventorship (Rule 4.17(iv)) (only for US designation)

- New standardized wording since 16 September 2012
(see Section 214 of the AIs)
- All inventors need to be named in the same declaration
- Declaration must be signed and dated by all inventors
- Signatures may appear on different copies of the same complete declaration
- Signature does not have to be an original (fax copy)
- DO/US accepts a seal as signature when the international application is filed with receiving Offices which accept seals as signatures

Addition/correction of declarations (Rule 26*ter*)

- Applicants may correct or add any of the declarations filed under Rule 4.17
- Time limit: until the expiration of 16 months from the priority date (or even later, provided that the declaration is received by the International Bureau before the technical preparations for international publication have been completed)
- The receiving Office or International Bureau may invite the applicant to correct any declaration that is not worded as required or, in the case of the declaration of inventorship (Rule 4.17(iv)), is not signed as required

Publication of declarations

- Declarations received within the applicable time limit will be mentioned on the front page of the published international application
- The full text of the declarations will be published as part of the international application

Declarations referred to under Rule 4.17: Additional issues

- National forms should not be used for declarations in the international phase (for instance, a combined declaration of inventorship/ power of attorney) since they do not use the standardized wording
- When a declaration is furnished after the international filing date, no further page fee would be required
- If a defective declaration is not corrected during the international phase:
 - does not affect the processing of the declaration by the International Bureau
 - DOs/EOs may accept defective declaration
- No provision for the withdrawal of declarations



Agents and Common Representatives

Agents (Rule 90)

■ Who can act as agent?

- any person (attorney, patent agent, etc.) who has the right to practice before the RO can act as agent and automatically has the right to practice before the IB, the ISA and the IPEA (Article 49);
- an agent who has the right to practice before the ISA and/or IPEA can be appointed specifically for the purposes of the procedure before that ISA or IPEA (Rule 90.1(b) and (c));
- sub-agents may be appointed by agents (Rule 90.1(d))

■ What is a common agent?

- an agent appointed by all the applicants

Common representatives (Rule 90)

- Who can act as common representative?
 - one of the applicants, who is entitled to file an international application (i.e., who is a resident or national of a PCT Contracting State), may be appointed by all the other applicants, or
 - where neither a common agent nor a common representative has been appointed, the first named applicant in the request who is entitled to file an international application with the RO with which the international application was filed is automatically “deemed” to be common representative

Agents and common representatives (Rule 90)

- Any act by or in relation to a common agent or a common representative has the effect of an act by or in relation to all the applicants, except for:
 - a withdrawal made by a “deemed” common representative (Rules 90.3(c) and 90bis.5(a)); and,
 - where an RO does not require that powers of attorney have to be submitted (Rules 90.4 and 90.5), a withdrawal made by an agent or common representative who has not submitted powers signed by all applicants (Rule 90bis.5(a))

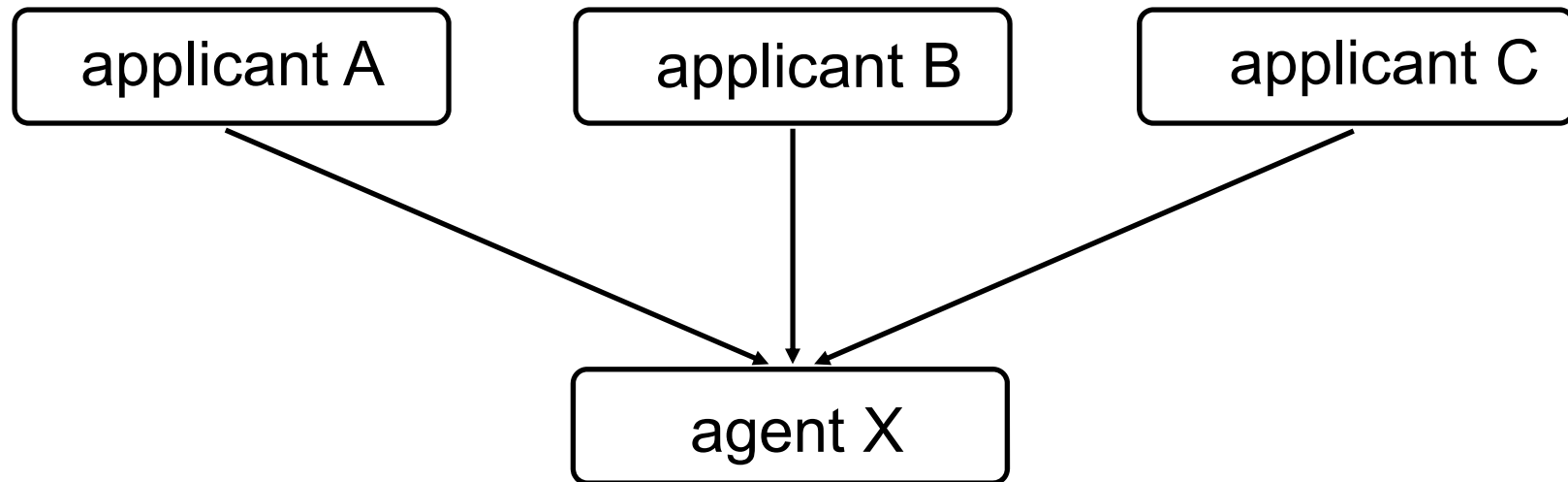
Appointment of agents and common representatives (Rules 90.4 to 90.6)

- Agents and common representatives may be appointed in any of the following ways:
 - in the request or, under Chapter II, in the demand;
 - in a separate power of attorney relating to a given international application;
 - in a general power of attorney relating to all international applications filed in the name of the applicant.
- General powers of attorney are to be filed with the RO or, where applicable, with the ISA or IPEA.
- For provisions on revocation of appointment of agents and renunciation by an agent of his appointment, see Rule 90.6

Waiver of requirement that a power of attorney be furnished (Rules 90.4(d) and 90.5(c))

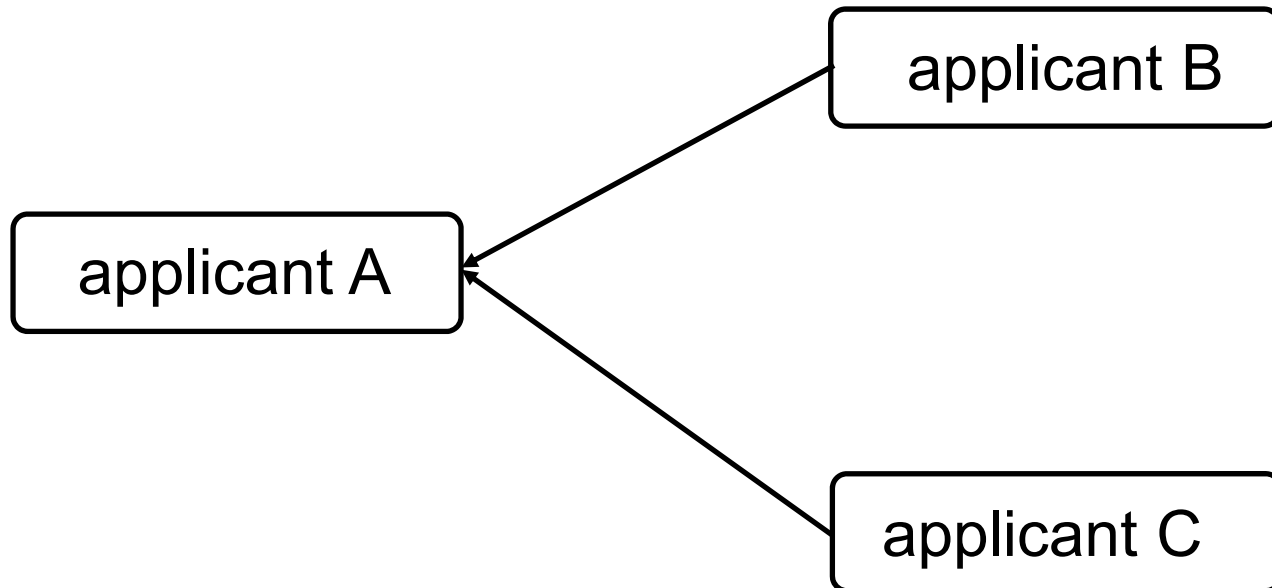
- RO, ISA, IPEA and IB may waive the requirement that:
 - a separate power of attorney; and/or
- RO, ISA and IPEA may waive the requirement that
 - a copy of a general power of attorney has to be furnished
- Any Office or Authority that has waived the requirement in general may nevertheless require that a power of attorney be furnished in particular instances
- For the table of Offices that made such a waiver, see www.wipo.int/pct/en/texts/pdf/p_a_waivers.pdf

Common agent



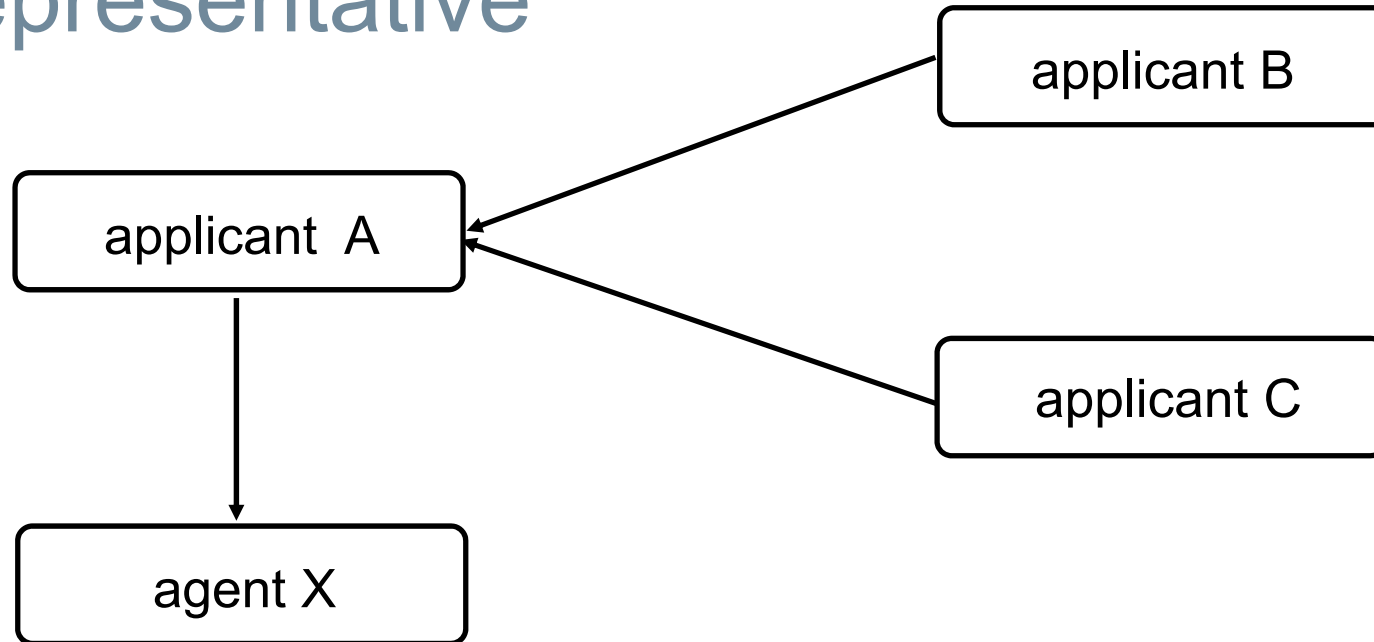
- Agent X is a common agent if he has been appointed by all applicants

Appointed common representative (Rule 90.2(a))



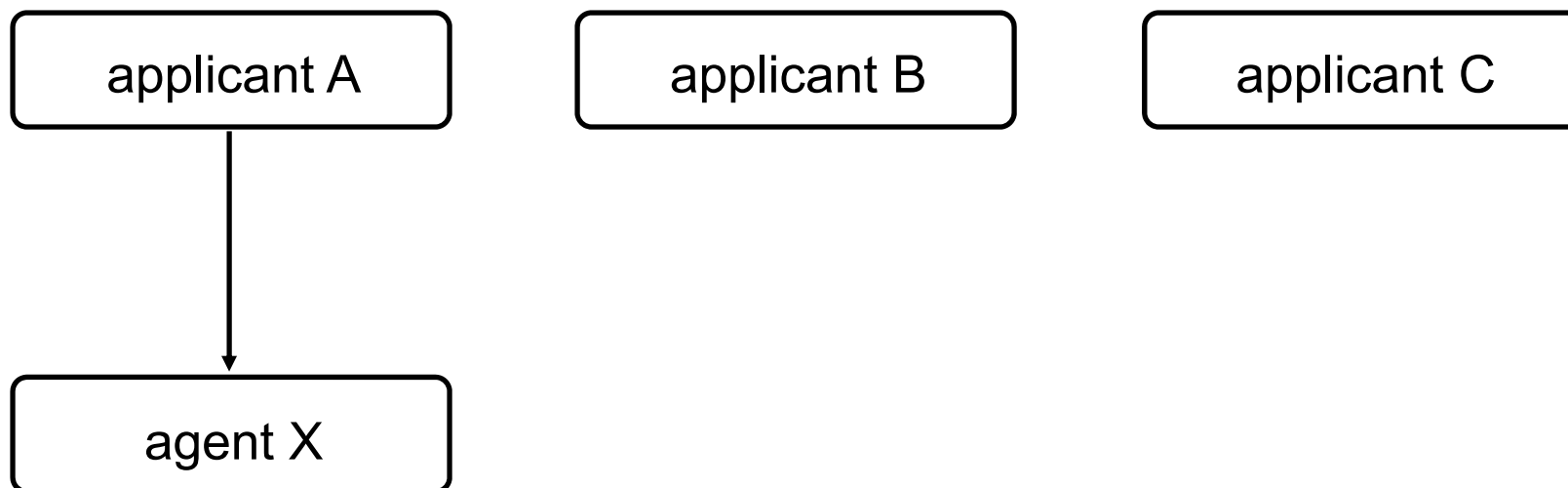
- Applicants B and C appoint applicant A as their common representative
- A may be so appointed only if national or resident of a PCT Contracting State

Agent of the appointed common representative



- Applicant A (e.g. corporate applicant), who has been appointed by the other applicants (e.g. applicants/inventors) as their common representative, appoints agent X
- Agent X can, on behalf of the appointed common representative, sign all documents for all applicants including any withdrawal (Rule 90.3(c)), provided that where a PCT Authority has waived the requirement that powers of attorney have to be submitted, such powers are on file

“Deemed” common representative (Rule 90.2(b))



- There is no common agent and the applicants have not appointed a common representative. Consequently applicant A is the "deemed" common representative (i.e., the first applicant named in the Request, who has the right to file an international application with the receiving Office with which the international application was filed)
- Agent X, appointed only by applicant A, can sign all documents for all applicants except any withdrawal (Rules 90.3(c) and 90*bis*.5(a))



Priority Claims

- PCT requirements
- Priority documents
- Correction/Addition of priority claims
- Restoration of the right of priority

The right of priority (1)

(Article 4 of the Paris Convention)

- Any filing of an application for a patent by an applicant in one member country, entitles that applicant (or his successor in title) to have certain rights when applying for patent protection in all other member countries within 12 months
- For prior art purposes, the later applications will be regarded as having been filed on the same date as the first application
- The right of priority can be based only on the first filed application on the subject matter (see Paris Convention Art.4C(4) for exception)

The right of priority (2)

(Article 4 of the Paris Convention)

- Multiple and partial priorities may be claimed
- The later application must concern the same subject as the first application the priority of which is claimed
- Withdrawal, abandonment or rejection of the first application does not destroy its capacity to serve as a basis for priority

Priority date (PCT Article 2(xi))

- The priority date for the purposes of computing time limits means:
 - where the international application contains a priority claim, the filing date of the application whose priority is claimed
 - where the international application contains several priority claims, the filing date of the earliest application whose priority is claimed
 - where the international application does not contain any priority claim, the international filing date

Claiming priority (PCT Article 8, Rule 4.10)

- The international application may contain a declaration claiming the priority of one or more earlier applications
 - filed in or, by way of a regional or international application, for any country party to the Paris Convention and/or
 - filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

Contents of priority claims (Rule 4.10) (1)

■ Earlier national application:

- filing date
- application number
- country party to the Paris Convention or Member of WTO in which earlier application was filed

■ Earlier regional application:

- filing date
- application number
- authority entrusted with the granting of regional patents (in practice, the regional Office concerned)
- where at least one country party to the regional patent treaty is neither party to the Paris Convention nor Member of WTO, at least one country party to that Convention or one Member of that Organization for which that earlier application was filed

Contents of priority claims (Rule 4.10) (2)

■ Earlier international application:

- international filing date
- international application number
- receiving Office with which the earlier international application was filed

Furnishing of priority documents (Rule 17.1)

- Where the priority of an earlier national, regional or international application is claimed, the applicant must provide a priority document for each corresponding earlier application (that is, a certified copy of the earlier application)
 - by furnishing such document directly to the receiving Office or the International Bureau (Rule 17.1(a)), or
 - by requesting the receiving Office to prepare such document and transmit it to the IB (Rule 17.1(b)), if the earlier application was filed with that Office, or
 - by requesting the IB to obtain the priority document from a digital library (Rule 17.1(b-*bis*)) (only for Offices participating in the Digital Access Service (DAS))

Digital Access Service for Priority Documents (DAS)

- Legal Basis:
 - PCT Rule 17.1(*b-bis*)
 - Administrative Instructions 715 and 716
- Applicants may request the IB to retrieve priority documents from digital libraries (may also be possible at some DOs)
- Participating Offices: AU, CN, DK, ES, FI, GB, IB, JP, KR, SE, US
- For detailed information on DAS, see: www.wipo.int/das/en

Retrieval of priority documents via DAS

- Possibility to request the IB to retrieve a copy of the priority document of an earlier application, in electronic form, via DAS
- The service is available for earlier national applications filed with AU, CN, DK, ES, FI, GB, JP, KR, SE and US and for earlier international applications filed with AU, CN, DK, FI, SE and RO/IB
- The Office with which the earlier national application was filed is known as the Office of First Filing (OFF) or the Depositing Office
- The Office that retrieves the document is known as the Office of Second Filing (OSF) or Accessing Office

Main steps for the use of DAS

- Request the OFF to make the earlier application available via DAS
- The OFF (or, in some cases, the IB on behalf of the OFF) provides the applicant with an access code
- File the PCT international application and request the IB to retrieve the priority document via DAS by checking the appropriate box on the request form and include the access code
- The IB retrieves the priority document via DAS and sends a confirmation of retrieval to the applicant by means of the form PCT/IB/304

Requesting DAS p-doc retrieval

Details of Priority Claim of Earlier Application

?

National Regional International (PCT)

Country: US United States of America

Filing date: 29 July 2011 15

Number: 61/274,654

The International Bureau is requested to obtain from a digital library a certified copy of the above-identified earlier application.

Access code: 1234

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the above-identified earlier application.

The receiving Office is requested to restore the right of priority

OK Cancel

- Select the checkbox on the Priority details page for the corresponding priority claim and indicate the access code.

Time limit for the furnishing of priority documents (Rule 17.1)

- Direct submission by the applicant to the RO:
 - within 16 months from the priority date
- Direct submission by the applicant to the IB:
 - before international publication
- Request to the RO to prepare and transmit the priority document to the IB:
 - within 16 months from the priority date
- Submission via DAS to IB:
 - The priority document must be made available to the IB via DAS and the request to the IB to retrieve the priority document must be made before international publication

Correction/addition of priority claims

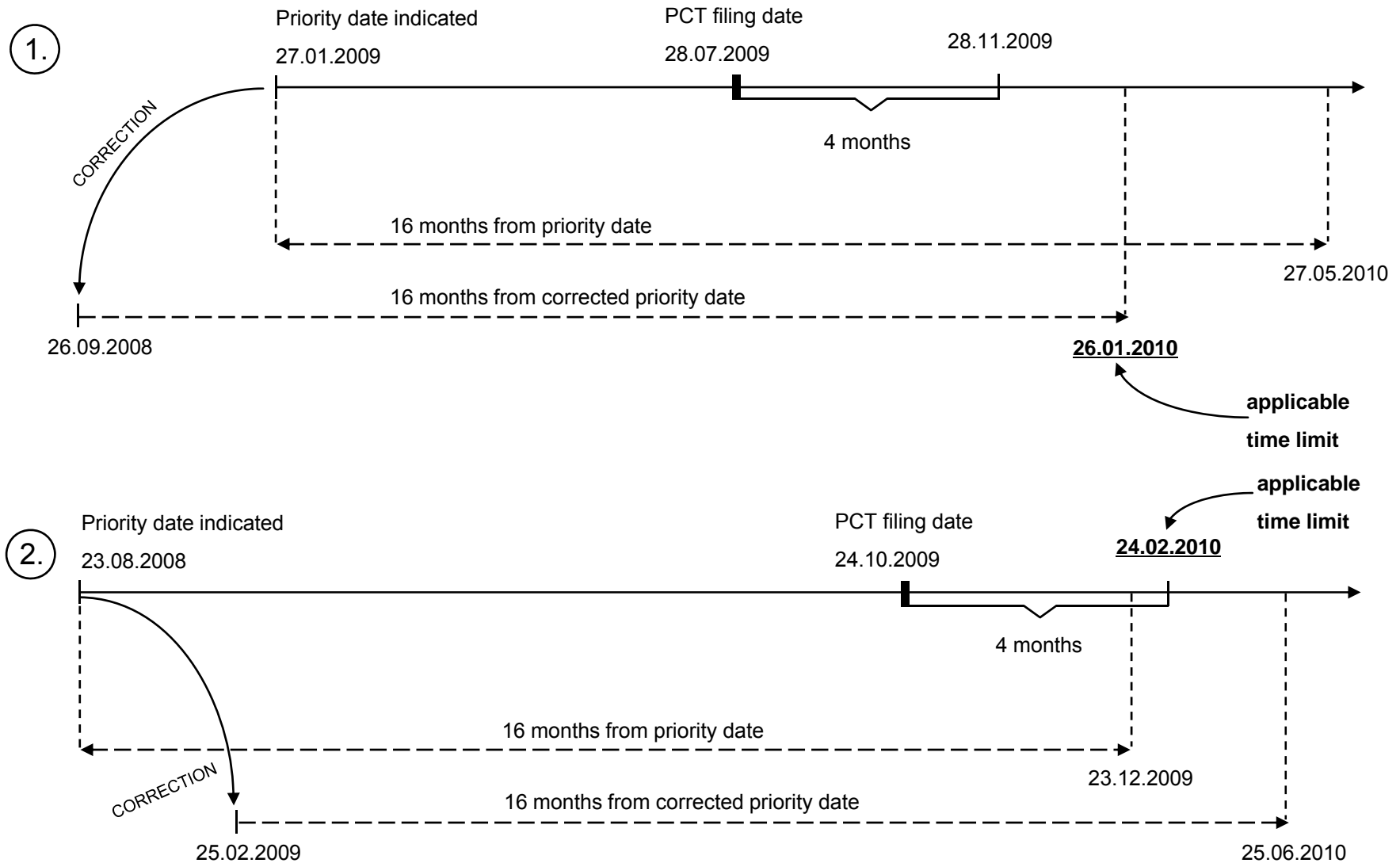
■ What can be the problem?

- missing priority claim
- missing priority date
- missing indications of the date, number or country of filing
- filing date of earlier application more than 12 months before the international filing date
- earlier filing not in a country party to the Paris Convention or a Member of WTO

■ Applicable provisions:

- Article 8
- Rules 4.10, 26*bis*, 48.2(a)(vii) and 91

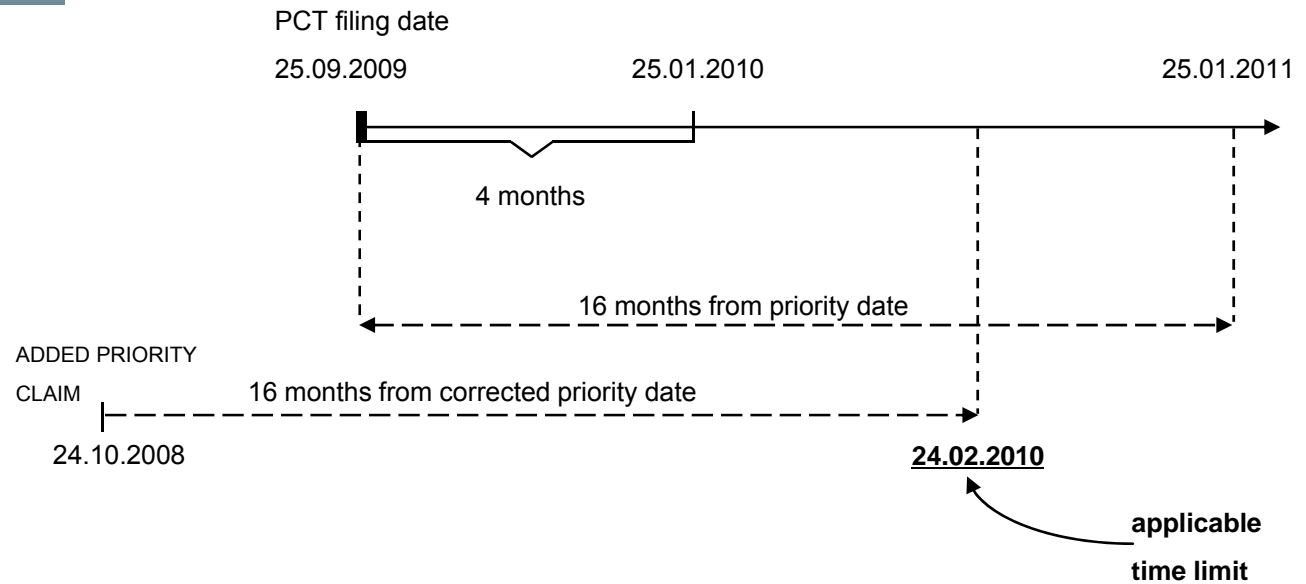
Correction and addition of priority claim (Rule 26bis)



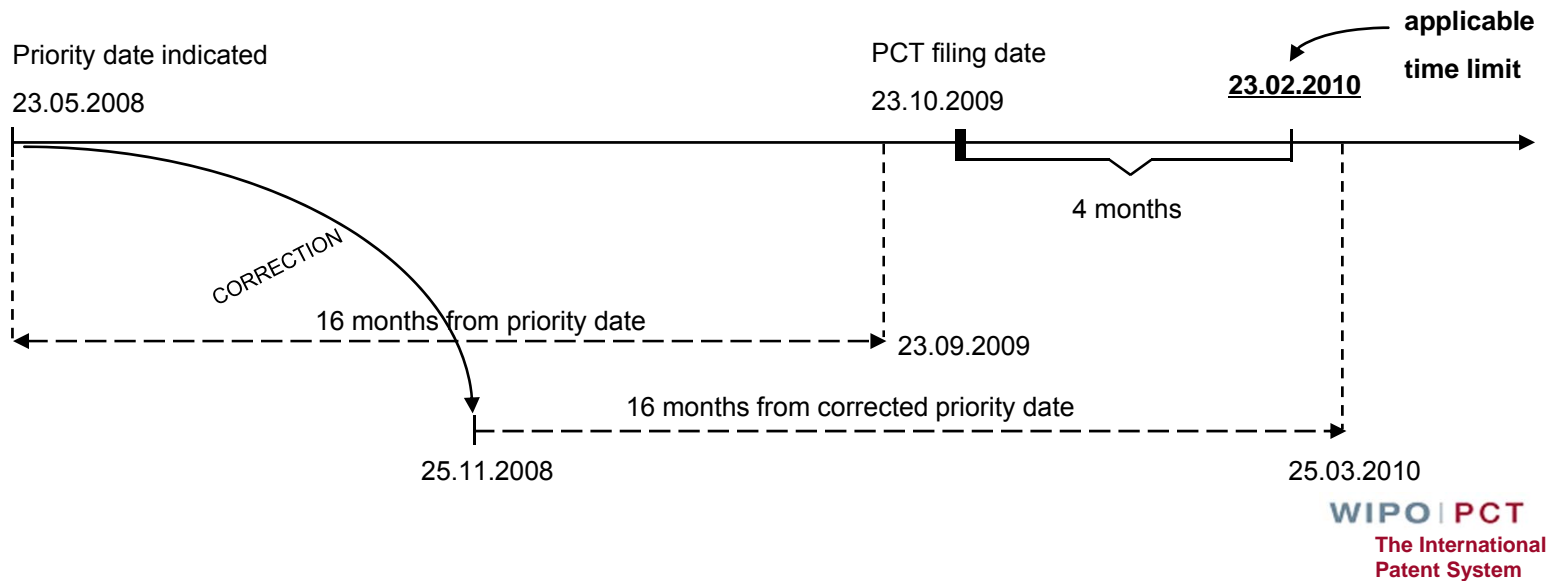
Correction and addition of priority claim (Rule 26bis)

— continued —

3.



4.



Correction/addition of priority claims affecting the priority date (Rule 26*bis*) (1)

■ Cases concerned:

- adding a priority claim with an earlier filing date than any priority claim present in the application
- correction of the filing date of the earliest priority claim

Correction/addition of priority claims affecting the priority date (Rule 26bis) (2)

■ Applicable time limit:

- within 4 months from the international filing date; or
- possibly later, if the earlier of the following two time limits expires later than the 4-month time limit:
 - 16 months from the priority date before the correction or addition
 - 16 months from the priority date after the correction or addition
- any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26bis.2(b))

NOTE: This does not apply to late additions of priority claims

Correction/addition of priority claims not affecting the priority date (Rule 26*bis*) (1)

■ Cases concerned:

- corrections which do not affect the filing date of the priority claim
- adding a priority claim with a later filing date than the earliest priority claim present in the application (e.g. second priority claim)
- corrections of the filing date of a priority claim which is not the earliest one

Correction/addition of priority claims not affecting the priority date (Rule 26*bis*) (2)

■ Applicable time limit:

□ Rule 26*bis*.1(a):

- within 4 months from the international filing date; or
- within 16 months from the priority date, whichever time limit expires later
- any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26*bis*.2(b))

NOTE: This does not apply to late additions of priority claims

□ Rule 91: within 26 months from the priority date

Invitation to correct by RO or IB (1)

■ Forms:

- receiving Office: Form PCT/RO/110
- International Bureau: Form PCT/IB/316

■ Invitation (Rule 26*bis*.2(a)), is issued if:

- priority claim does not comply with requirements of Rule 4.10
- any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document
- International application has an international filing date outside the priority period

Invitation to correct by RO or IB (2)

- The RO will also draw the attention of the applicant to the possibility to request restoration of the priority right (Rule 26*bis*.3) if the international filing date is outside of the priority period but within a period of two months from the date of expiration of the priority period
- If the applicant does not correct the priority claim in response to the invitation, the priority claim concerned will be considered void, for the purposes of the procedure under the PCT (Rule 26*bis*.2(b))

Invitation to correct by RO or IB (3)

- However, a priority claim will not be considered void only because (Rule 26*bis*.2(c)) :
 - the indication of the number of the earlier application is missing; or
 - an indication in the priority claim is not the same as the corresponding indication appearing on the priority document; or
 - the international filing date is outside of the priority period but within a period of two months from the date of expiration of the priority period

Invitation to correct by RO or IB (4)

- The finding that the priority claim is considered void for the purposes of the procedure under the PCT, would not prevent any designated Office from recognizing such a priority claim for the purposes of the national phase if so permitted or required by national law
- Warning to third parties: different priority dates may apply in different designated States (Rules 26*bis*.2(d) and 48.2(a)(ix))

Publication related to priority claims (1)

- Information concerning a priority claim considered void or only not considered void because:
 - the number was missing
 - inconsistency with the indications on priority document
 - the international filing date is outside of the priority period but with a period of two months from the date of expiration of the priority period

will be published by the International Bureau free of charge together with, where applicable, information furnished by the applicant concerning such priority claims (Rule 26*bis*.2(d))

Publication related to priority claims (2)

- Correction and addition of priority claims under Rule 26*bis*.1(a):

After the expiration of the applicable time limit to correct or add a priority claim, applicant may request the International Bureau (Rule 26*bis*.2(e)) to publish information concerning the priority claim concerned:

- within 30 months from priority date; and
- subject to the payment of a fee

Restoration of the right of priority - Competent Authorities

- RO during the international phase
(Rule 26*bis*.3)
- DO during the national phase
(Rule 49*ter*.2)

Restoration of the right of priority

Applicable criteria

- Applicable Rules: 26*bis*.3(a) and 49*ter*.2(a)
- Two possible criteria for restoration:
 - failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
 - failure to file the application within the priority period was unintentional
- All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law

Restoration by RO (Rule 26*bis*.3)

■ Conditions:

- request to restore must be filed with the RO
- time limit: within a period of 2 months from the date of the expiration of the priority period
- filing of statement of reasons for failure to comply with the time limit
- statement should preferably be accompanied by a declaration or other evidence to support such statement
- where applicable, payment of the required fee

Effects of refusal to restore by RO (Rule 26*bis*.3)

- Any priority claim to an earlier application filed less than 14 months before the international filing date
 - will not be declared void even if priority is not restored by the RO (Rule 26*bis*.2(c)(iii))
 - will serve as a basis to calculate time limits during the international phase
- The validity of such a priority claim in the national phase is not assured

Effects of restoration in the national phase (Rule 49*ter.1*)

- Effect of restoration by RO in the national phase:
 - RO restoration based on the “due care” criterion is effective in all DOs
 - RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
 - RO restoration is not conclusively binding on DOs: limited review by DOs is possible
 - RO refusal to restore is not binding on DOs
- For declarations of incompatibility with the national law (reservations), see the WIPO website at:
www.wipo.int/pct/en/texts/reservations/res_incomp.html

Reservations made by Offices

The following Offices have notified the International Bureau of the incompatibility of Rule 26*bis*.3(a) to (i), Rule 49*ter*.1(a) to (d) and/or Rule 49*ter*.2(a) to (g) with their national/regional law:

- ❑ Incompatibility as RO (Rule 26*bis*.3(j)):
BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, JP, KR,
NO, PH

- ❑ Incompatibility of the effect of decision of RO on DO
(Rule 49*ter*.1(g)):
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP, KR, MX,
NO, PH, TR, US

- ❑ Incompatibility as DO (Rule 49*ter*.2(h)):
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP,
KR, MX, NO, PH, TR, US



Correction of Defects Relating to the Filing of the Application

Defects which can be corrected without affecting the international filing date (1)

- Office not competent because of the applicant's nationality and residence (Rule 19.4(a)(i))
- International application filed in a language not accepted by the receiving Office (Rule 19.4(a)(ii))
- Errors in the indication of the applicant's nationality and/or residence (Section 329 of the Administrative Instructions)
- Non-admitted language for the request, abstract, text matter in drawings (Rule 26.3*ter*)
- Incomplete, erroneous or missing priority claim (Rule 26*bis*)

Defects which can be corrected without affecting the international filing date (2)

- Unpaid or not fully paid fees (Rule 16*bis*)
- Missing signature in the request (Rule 4.15)
- Incomplete, erroneous or missing declarations under Rule 4.17 (Rule 26*ter*)
- Formal defects (Rules 11 and 26)
- Missing title of the invention
- Missing abstract
- Obvious mistakes (Rule 91)

Defects which may result in a later international filing date (Rule 20.5)

- missing sheets of

- description

- claims

- drawings

Missing elements and parts of the international application (Rule 20) (1)

- Objective: Enable inclusion of accidentally omitted elements or parts that are contained in a priority application without affecting the international filing date
 - element = all of the description or all of the claims
 - part = part of the description, part of claims or part or all of pages of drawings

Missing elements and parts of the international application (Rule 20) (2)

■ Conditions:

- priority must have been claimed on the original filing date (Rule 4.18)
- priority application contains the element or part (Rule 20.6(b))
- request contains statement of (conditional) incorporation by reference (Rule 4.18)
- timely confirmation of incorporation by reference (Rules 20.6 and 20.7)

■ Competent Authority: RO

Confirmation of incorporation by reference (Rules 20.6 and 20.7) (1)

- Time limit: two months from filing or from invitation to correct (Rule 20.7)
- Documents to be filed (Rule 20.6):
 - notice of confirmation
 - missing sheets
 - copy of the earlier application as filed unless the priority document already submitted
 - translation if not in the language of the international application
 - indication as to where in the priority document (and translation) the missing parts are contained

Confirmation of incorporation by reference (Rules 20.6 and 20.7) (2)

- If not all requirements for incorporation by reference are fulfilled

(for example, if a missing element or part is not entirely contained in the earlier application):

- the international application is assigned a later filing date (date of receipt of missing element or part),
- applicant may request that missing part be disregarded (Rule 20.5(e))

Invitation by RO to correct defect under Article 11(1) (Rule 20.3)

Where the entire description or all claims are missing, RO invites the applicant to either:

- furnish a correction under Article 11(2) and the international application is accorded a later filing date or,
- confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained

Effect of incorporation by reference in the national phase (Rule 82*ter*.1(b))

- DOs may, to a limited extent, review the decision allowing the incorporation by reference
- Declarations of incompatibility with the national law (reservations) were made by a number of ROs and DOs
See WIPO website at:
www.wipo.int/pct/en/texts/reservations/res_incomp.html

Declarations of incompatibility with the national law

The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 with its national/regional law:

❑ Incompatibility as RO (Rule 20.8(a)):

BE, CU, CZ, DE, ID, IT, KR, MX

❑ Incompatibility as DO (Rule 20.8(b)):

CN, CU, CZ, DE, ID, KR, LT, MX, TR

Rectification of obvious mistakes (Rule 91) (1)

- No rectification shall be made except with the express authorization:
 - of the receiving Office if the mistake is in the request,
 - of the International Searching Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
 - of the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
 - of the International Bureau if the mistake is any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau

Rectification of obvious mistakes (Rule 91) (2)

- Time limit: 26 months from the priority date (Rule 91.2)
- Clarification as to mistakes which are not rectifiable under Rule 91:
 - missing pages and parts
 - mistake in the abstract
 - mistake in Article 19 amendments
 - mistake in the priority claims causing a change in the priority date

Rectification of obvious mistakes (3)

- DO may disregard a rectification “if it finds that it would not have authorized the rectification if it had been the competent authority”, but must give the applicant an opportunity to make observations (Rule 91.3(f))
- Authorized request for rectification:
 - if this is received after technical preparations for publication have been completed, the IB will publish a statement reflecting the rectifications, any replacement sheets and the request for rectification together with the republished front page (Rule 48.2(i))

Rectification of obvious mistakes (4) (Publication, Rule 48.2)

■ Refused request for rectification:

- this will be published, upon request by the applicant within two months from the refusal and against payment of a fee, together with the reasons for refusal and any brief comments by applicant (Rule 91.3(d)); if this is received after technical preparations for publication have been completed, it will be promptly published with the republished front page (Rule 48.2(k))

Correction procedure (Rule 26.4)

- Correction in the request:
 - may be stated in a letter
- Correction of any element of the international application other than the request:
 - replacement sheet and letter drawing attention to the differences between the replaced and the replacement sheet must be submitted

What is a replacement (substitute) sheet? (Rules 26.4, 46.5(a) and 66.8(a))

- A sheet filed during the international phase which differs from the sheet as originally (or previously) filed because it contains:
 - ❑ correction(s) of formal defects (Rule 26)
 - ❑ rectification(s) of obvious mistakes (Rule 91)
 - ❑ amendment(s) of claims (Article 19)
 - ❑ amendment(s) of description, claims, drawings (Article 34)
 - ❑ change(s) in the indication(s) in the Request concerning applicants, inventors, agents (Rule 92*bis*)

When and how to file a replacement sheet?

- A replacement sheet must be submitted
 - where the correction/rectification/amendment is in any part of the international application other than the request, in all cases
 - where the correction/rectification/amendment is in the request, in cases where it is of such a nature that it cannot be communicated in a letter and transferred to the request without adversely affecting the clarity and direct reproducibility of that sheet of the request
- It must be accompanied by a letter explaining the differences between the replaced sheet and the replacement sheet

Additional correction procedures

Review by and opportunity to correct before the designated/elected Offices:

(Articles 24(2), 25, 26, 39(3) and 48, Rules 82*bis* and 82*ter*)



Recording of Changes under Rule 92*bis*

Rule 92*bis*: cases covered

- Change of name
- Change of address
- Change of nationality
- Adding/deleting an inventor
- Change of applicant (assignment, addition, deletion)
- Change of agent

Request for recording of a change under Rule 92*bis*

- must be made in writing
- may be filed with the International Bureau or the receiving Office
- generally no evidence of the change is required during the international phase (the designated Offices may, however, require that evidence (for example, assignment) be submitted once the national phase has been entered)
- the International Bureau will notify the applicant (using Form PCT/IB/306) that the requested change has been recorded

Recording of a change in the person of the applicant under Rule 92*bis*

- Where such request is made by a person not yet named in the request (“the new applicant”) without the written consent of the (“old”) applicant, a copy of an assignment or other documentary evidence supporting the change in person must be filed with the request for the change
- Where such request is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time

Time limit under Rule 92*bis* (1)

- The request must reach the International Bureau before the expiration of 30 months from the priority date
 - Therefore, it is recommended to file it directly with the International Bureau even though it is possible to file it also with the receiving Office
- If it reaches the International Bureau after the expiration of the applicable time limit, the change will not be recorded and the applicant will have to proceed with such request before each designated or elected Office concerned

Time limit under Rule 92bis (2)

- If the applicant wishes that a particular change be taken into account for the international publication of the international application, the request for recording of that change must reach the International Bureau before the completion of technical preparations for international publication (normally, 15 days before the actual date of publication)
- If the request for recording of a change reaches the International Bureau too late to be reflected in the international publication, the International Bureau will notify all designated or elected Offices concerned



Functions of the receiving Office

The receiving Office (1)

- Specifies the International Searching Authority or Authorities competent for searching international applications filed with it (Article 16(2))
- Specifies the International Preliminary Examining Authority or Authorities competent for examining international applications filed with it (Article 32(2))
- Prescribes the language(s) in which international applications must be filed with it (Rule 12.1(a) and (c))
- Fixes the amount of the transmittal fee (Rule 14.1(b))

The receiving Office (2)

- Checks whether it is competent to act as receiving Office with regard to nationality/residence of the applicant (Rules 19.1 and 19.2), language of filing (Rule 12.1(a)) and, where applicable, transmits international application to RO/IB (Rule 19.4)
- Accords or refuses international filing date (Article 11(1) and Rule 20)
- Decides on requests for incorporation by reference of missing elements or parts (Rules 20.5 to 20.7)
- Checks if any drawings referred to are included (Article 14(2))

The receiving Office (3)

- Checks whether translation of international application is required (Rules 12.3 and 12.4)
- Checks for formal defects (Article 14(1))
- Collects fees for RO, IB and ISA (Rules 14, 15 and 16)
- Checks if the required fees are timely paid (Rule 16*bis*)
- Checks priority claim(s) (Rules 4.10 and 26*bis*)
- Decides on requests for restoration of the priority right (Rule 26*bis*.3)

The receiving Office (4)

- Obtains national security clearance, if required by national law (where RO is regional Office or RO/IB, clearance is applicant's responsibility)
- Forwards the record copy to IB and the search copy to ISA, including any required translation (Article 12 and Rules 22.1 and 23.1)
- Forwards and receives correspondence from applicants and the international authorities
- Establishes certified copies of PCT applications filed with it (Rule 21.2)



The International Bureau as receiving Office

International Bureau as receiving Office (RO/IB) (1)

- The International Bureau is available as receiving Office for nationals and residents of all PCT Contracting States (Rule 19.1(a)(iii))
- Compliance with national security provisions is applicant's responsibility
- RO/IB accepts international applications filed in ANY language
- The competence of ISAs and IPEAs will be determined as if the international application had been filed with a competent national or regional Office (Rules 35.3(a) and 59.1(b)). Choice of ISA must be indicated in the request (Rules 4.1(b)(iv) and 4.14*bis*)

International Bureau as receiving Office (RO/IB) (2)

- An agent has the right to practice before RO/IB if qualified to act before a competent national or regional Office (Rule 83.1 *bis*)
- RO/IB has waived the requirement that a separate power of attorney or a copy of a general power of attorney has to be submitted in respect of any agent or common representative indicated in Box IV of the request, subject to certain conditions (see www.wipo.int/pct/en/texts/pdf/p_a_waivers.pdf)
- No transmittal fee for applicants from certain Contracting States

Transmittal of international applications to RO/IB (Rule 19.4) (1)

- Cases where the international application will be transmitted to RO/IB:
 - if it is filed by an applicant from a PCT Contracting State with an Office which is not competent as receiving Office because of the nationality or residence of the applicant
 - if it is in a language which is not accepted by the Office with which it is filed
 - if for any other reason, the receiving Office and RO/IB agree to the transmittal and the applicant authorizes it

Transmittal of international applications to RO/IB (Rule 19.4) (2)

■ Conditions for the transmittal:

- any applicable national security requirements are met
- a fee, equal to the transmittal fee, is paid (not all Offices will require such a fee)

■ Effect of the transmittal on the international filing date: the international filing date will be the date of receipt by the “non competent” Office provided that

- the minimum requirements for according an international filing date are met

Transmittal of international applications to RO/IB (Rule 19.4) (3)

■ Consequences of the transmittal:

- ❑ all PCT filing fees will be payable to the International Bureau in Swiss Francs, Euro or US Dollars
 - the one-month time limit for payment being calculated from the actual date of receipt of the application by RO/IB
- ❑ any fees paid to the non-competent Office, other than a fee equal to the transmittal fee (if required), will be refunded
- ❑ the question whether the person previously appointed as agent is entitled to represent the applicant before RO/IB must be checked (Rule 83.1 *bis*)
- ❑ the question whether the International Searching Authority chosen by the applicant is correct will be checked (Rule 35)

Filing PCT applications by fax at RO/IB (1)

- RO/IB accepts filing of all documents, including international applications, by fax; some are subject to confirmation within 14 days, others only upon invitation (14 days or more)*
- Note time difference: if the document transmitted is due within a certain time limit, it is the expiration of that time limit in Geneva which will determine whether the document was filed on time (Rule 80.4(b))
- Mechanical failure or other problem associated with the fax transmission remains at the applicant's risk (Rule 92.4(c))

* See *PCT Applicant's Guide*, General Information, Annex B2(1B)

Filing PCT applications by fax at RO/IB (2)

- Acknowledgement of receipt of PCT application –
Form PCT/RO/199: by fax, if a fax number is given by the applicant/agent/sender;
(also) by special courier service (outside Europe)
- RO/IB decides on petitions if applicant does not agree with decision taken as to whether pages were received

Furnishing of priority document(s) in respect of PCT/IB applications (1)

- Where priority of an earlier national, regional or international (RO other than RO/IB) application is claimed in a PCT application filed with, or transmitted under Rule 19.4 to, RO/IB:
 - RO/IB cannot be requested to establish a certified copy of such application (“priority document”) since RO/IB is not the Office with which that earlier application was filed
 - if the relevant check-box in Box No. VI of the request is marked, RO/IB will delete the check-mark *ex officio*

Furnishing of priority document(s) in respect of PCT/IB applications (2)

- ❑ the priority document must be obtained by the applicant from the national or regional Office or receiving Office concerned and furnished within the 16-month time limit – Note that, even if the Office concerned sends the priority document to IB on behalf of the applicant, the 16-month time limit applies (in other words, Rule 17.1(b) does not apply); and that, in order to meet the time limit, the document may be sent by fax to IB, subject to confirmation
- ❑ RO/IB may be requested to obtain the priority document via DAS to the extent that the Office with which the earlier application was filed participates in DAS (Rule 17.1(b-*bis*))

Furnishing of priority document(s) in respect of PCT/IB applications (3)

- Where priority of an earlier PCT/IB application is claimed in a subsequent PCT/IB application, the relevant check-box in Box No. VI of the request may be marked and RO/IB will prepare and transmit to the IB the corresponding priority document (see Rules 17.1(b) and 21.2)

Translation for the purposes of international search (Rules 12.3, 20.1(c) and (d))

- Where the international application is filed with RO/IB in a language which is not accepted by the ISA that is to carry out the international search, the applicant is required:
 - to furnish to RO/IB
 - within one month from the date of receipt of the international application by RO/IB
 - a translation of the international application into a language which is a language accepted by the ISA that is to carry out the international search and a language of publication

Invitation to furnish required translation (Rule 12.3(c) and (e))

- Where, by the time RO/IB sends to the applicant the notification of the PCT number and of the international filing date, the applicant has not furnished the required translation, RO/IB will invite the applicant:
 - to furnish the required translation within one month from the date of receipt of the international application
 - in the event that the required translation is not furnished within that one month time limit, to furnish it (and to pay, where applicable, a late furnishing fee equal to 25% of the international filing fee) within
 - one month from the date of the invitation or
 - two months from the date of receipt of the international application by RO/IB,

whichever time limit expires later

Failure to furnish translation and/or pay late furnishing fee (Rule 12.3(d))

- Where the applicant has not, within the applicable time limit, furnished the required translation and/or paid, where applicable, the late furnishing fee, the international application will be considered withdrawn and RO/IB will so declare

- Any translation and any payment received by RO/IB

- before RO/IB makes the declaration that the international application is considered withdrawn and

- before the expiration of 15 months from the priority date

is considered to have been received before the expiration of the applicable time limit (that is, one month from the date of the invitation or two months from the date of receipt of the international application, whichever expires later)



Functions of the International Bureau

General responsibilities under the PCT (1)

- International coordination of the PCT system
- Assistance to Contracting States (which have already joined the PCT or which have shown interest in doing so) and their national/regional Offices
 - advice on how to implement the PCT into national law
 - advice on how to set up internal procedures for dealing with PCT applications, including receiving Office training

General responsibilities under the PCT (2)

■ Dissemination of information about the PCT system

- PCT Applicant's Guide*
- PCT Newsletter*
- Official Notices
- List server messages, etc.
- PCT's website

■ PCT Seminars and training courses

■ Receiving Office for applicants from all Contracting States

Responsibilities related to international applications (1)

- Performs a second formalities review of record copies of international applications
- Publishes international applications
- Receives and publishes Article 19 amendments
- Communicates copies of international applications, international search reports and related documents to designated Offices

Responsibilities related to international applications (2)

- Records changes under Rule 92*bis* in the indications related to applicants, inventors and agents
- Receives and reviews requests and collects fees for supplementary international search (SIS)
- Transmits SIS requests to the SISA concerned
- Performs second formalities review of demands

Responsibilities related to international applications (3)

- Communicates international preliminary reports on patentability (Ch.I or Ch.II) to DOs/EOs
- Translates titles and abstracts (into English and French), international search reports (into English, if necessary) and international preliminary reports on patentability (Ch.I or Ch.II) (into English, if necessary)



International Publication

International publication (1) (Article 21 and Rule 48)

■ When?

Promptly after 18 months from priority date on the Internet
(www.wipo.int/pctdb/)

■ Publication languages:

- Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish
- title, abstract and search report always (also) in English

■ Contents of published international application

- always:
 - front page with bibliographic data and abstract
 - description, claims, and drawings, if any
 - international search report

International publication (2) (Article 21 and Rule 48)

□ where applicable:

- amended claims (and any statement) under Article 19
- any declaration referred to in Rule 4.17 (Rule 48.2(a)(x))
- any relevant data concerning deposited biological material furnished under Rule 13*bis* (Rule 48.2(a)(viii))
- information regarding requests for restoration of right of priority (Rule 48.2(a)(xi))
- statement concerning authorized requests for rectification of obvious mistakes received after publication (Rule 48.2(i))
- information about a priority claim considered not to have been made (Rule 26*bis*.2(d))

International publication (3) (Article 21 and Rule 48)

□ upon applicant's request*:

- information about the applicant's wish to correct or add a priority claim after the expiration of the time limit under Rule 26*bis*.1(a) (Rule 26*bis*.2(e))
- refused request for rectification of an obvious mistake (Rule 91.3(d))

* See Annex B2/IB of the *PCT Applicant's Guide* for applicable fee

Communication of published international applications (Article 20 and Rule 47)

- Paper copies of published international applications are only sent to the applicant upon specific request
- Communicated to DOs by IB
- Notice of communication of the international application sent by IB to DOs serves as conclusive evidence of receipt of the application by DOs (Rule 47.1(c-bis), Form PCT/IB/308 (First Notice) for DOs which do not yet apply modified Article 22(1) and Form PCT/IB/308 (Second and Supplementary Notice) for all other DOs)

Early publication (Article 21(2)(b) and Rule 48.4(a))

- upon express request by applicant
- if international search report available, no fee required
- if international search report not yet available: see the *PCT Applicant's Guide* International Phase, General Information (Annex B2/IB) for applicable fee

Form of publication

- Published international applications are available at www.wipo.int/patentscope/search/en/structuredSearch.jsf
- Official notices (PCT Gazette) are available at www.wipo.int/pct/en/official_notices/index.htm

Frequency of international publication

- International publication of international applications and publication of the Official Notices takes place every Thursday,
 - except where that Thursday is a day on which the International Bureau is not open for official business, for example, Ascension Day or the Thursday that follows the first Sunday of September and certain Thursdays in the Christmas/New Year period.
- In such cases, inquire at the International Bureau as to what will be the publication date (possibly, but not always, the preceding Wednesday).

Technical preparations for international publication

- The technical preparations for international publication are normally completed 15 calendar days before the actual publication date

For example: if the publication date is: Thursday, *23 January 2014*, technical preparations are completed on Wednesday, *8 January 2014*

Consequently, any document that reaches the International Bureau on Tuesday, *7 January 2014*, is still taken into account for international publication (for example, change of name or address, amendment of the claims under Article 19, withdrawal of the international application or of a designation or of a priority claim)

- Technical preparations may be completed more than 15 days before the publication date where that publication date is not the “usual” Thursday because the International Bureau is not open for business or where there are a number of official holidays falling within that 15-day period. If in doubt, inquire at the International Bureau as to what will be the date of completion

Effects of international publication

- The PCT published application becomes part of the prior art as of its international publication date (Rule 34.1(b)(ii))
- International publication entitles PCT applicants to provisional protection in the designated States, if such protection is granted for published national applications (Article 29)
 - Such protection may be made conditional
 - on the furnishing of a translation (which may be of the claims only)
 - on receipt by the designated Office of a copy of the international application as published under the PCT, and/or
 - in the case of early publication under Article 21(2)(b), on the expiration of 18 months from the priority date
 - For further information on the specific requirements of a given Office, see the *PCT Applicant's Guide*, International Phase, General Information (Annexes B1 and B2)

Preventing publication of the international application (Rule 90*bis*.1(c)) (1)

- How: by withdrawing the international application
- When: before completion of the technical preparations for international publication
- The notice of withdrawal must:
 - be made in writing (use of Form PCT/IB/372 recommended)
 - be signed by all the applicants or on their behalf (by the appointed common agent or the appointed common representative), and
 - reach the International Bureau before completion of the technical preparations for publication

Preventing publication of the international application (Rule 90*bis*.1(c)) (2)

- Safeguard: the withdrawal should be made conditional on its being received by the International Bureau on time to prevent publication
- Consequence: the international application will not be published and will cease to have effect

Postponing publication of the international application (Rule 90*bis*.3(d) and (e)) (1)

- How: by withdrawing the (earliest) priority claim
- When: before completion of the technical preparations for international publication
- The notice of withdrawal must:
 - be made in writing (use of Form PCT/IB/372 recommended)
 - be signed by all the applicants or on their behalf (by the appointed common agent or the appointed common representative), and
 - reach the International Bureau before completion of the technical preparations for publication

Postponing publication of the international application (Rule 90*bis*.3(d) and (e)) (2)

- **Safeguard:** the withdrawal should be made conditional on its being received by the International Bureau on time to postpone publication
- **Consequences:** all time limits computed on the basis of the priority date which have not yet expired are recalculated on the basis of any remaining priority date or the international filing date, in particular for:
 - international publication
 - filing of demand
 - entry into the national phase



Access to File After Publication

- General principles
- Information accessible to third parties
- Access to files held by the IB
- Extending the period of confidentiality

General principles

- International applications are confidential in relation to third parties until international publication
- Applicant or anyone authorized by the applicant always has access to the international application file
- DOs have full access to all communications from IB and to documents in IB file insofar as they relate to Chapter I procedure (Article 30(1)(b))
- EOs, in addition, have full access to IPEA file once IPRP (Ch.II) is established (Article 38(1) and Rule 94.2) and to all communications from IB relating to the Chapter II procedure

Information accessible to third parties

- Published international applications
- Priority documents
- Other documents in file of IB/DOs/EOs

Access to priority documents (Rule 17.2(c))

- Electronically: www.wipo.int/pctdb/en/
- On paper from the IB:
 - upon request
 - subject to reimbursement of the cost
 - after international publication
- UNLESS, before international publication:
 - the international application was withdrawn
 - the priority claim was withdrawn
 - the priority claim was considered not to have been made

Access to files held by the International Bureau

- International applications filed before 1 July 1998: No access
- International applications filed on or after 1 July 1998
 - Generally, after international publication, copies of any document in the file are made available to third parties;

HOWEVER:

only made available after the expiration of 30 months from the priority date:

- copies of the written opinion of the ISA, informal comments on the written opinion of the ISA, the IPRP (Ch. I) or any translation thereof (Rule 44*ter*)
- copies of the IPRP (Ch.II) or only translation thereof

How to obtain access to files held by the International Bureau (1)

■ Via the database of published international applications:

www.wipo.int/patentscope/search/en/structuredSearch.jsf

- ❑ access to published international applications, the latest bibliographic data, certain documents and forms
- ❑ for international applications filed on or after 1 January 2009: access to full file content after publication
- ❑ details on availability of documents can be found by clicking on “data coverage” under the “help” tab

How to obtain access to files held by the International Bureau (2)

- By sending a fax to the PCT Legal Division at (41 22) 910 00 30 or by email to pct.infoline@wipo.int
 - paper copies of documents are sent, subject to reimbursement of the cost
 - information on the cost of the service is available at: www.wipo.int/pct/guide/en/gdvol1/annexes/annexb2/ax_b_ib.pdf
 - invoice sent separately once the documents are mailed

Extending the period of confidentiality

■ Delay access to the file by:

- withdrawing the (earliest) priority claim prior to completion of technical preparation for international publication so as to delay international publication

■ Prevent access to the file by:

- withdrawing the international application prior to completion of technical preparation for international publication so as to prevent international publication



Fees Payable under the PCT

Fees payable to the receiving Office (RO)

- **transmittal fee**
- **international filing fee** (for IB)
- **search fee** (for ISA)
- **supplement per sheet in excess of 30** (for IB)
- *fee for priority document*
- *late payment fee*
- *late furnishing fee (translation of international application)*
- *fee for requesting restoration of the right of priority*
- *fee for copies of documents*

(Fees indicated in italics are payable only in certain circumstances)

Fees payable to the International Searching Authority (ISA)

- *additional search fee*
- *protest fee (where applicable)*
- *fee for copies of documents*
- *late furnishing fee (furnishing of a sequence listing)*

(Fees indicated in italics are payable only in certain circumstances)

Fees payable to the International Bureau (IB)

- *fee for early publication (before issuance of ISR)*
- *fee for publication of refused request for rectification of obvious mistake*
- *fee for publication of late request for correction/addition of priority claim*
- *fee for copies of documents*
- *supplementary search fee (for the SISA)*
- *supplementary search handling fee*

(Fees indicated in italics are payable only in certain circumstances)

PCT fees payable to the International Preliminary Examining Authority (IPEA)

- **preliminary examination fee**
- **handling fee** (for IB)
- *late payment fee*
- *additional examination fee*
- *protest fee (where applicable)*
- *fee for copies of documents*
- *late furnishing fee (furnishing of a sequence listing)*

(Fees indicated in italics are payable only in certain circumstances)

Fees not payable during international phase

Under the PCT, there is:

- no fee for requesting extension of time to correct certain formal defects
- no claims fee (at the time of filing of the international application or during the international phase, if claims are added)
- no fee for late response to certain communication (for example, invitation to correct or written opinion)
- no fee for filing a request for rectification of an obvious mistake under Rule 91
- no fee for requesting a change in the indications concerning the applicant, inventor, etc. under Rule 92*bis*

Time limits for payment of fees (1)

■ Chapter I:

- transmittal fee, international filing fee, search fee:
one month from the date of receipt of the
international application by the RO
(Rules 14.1(c), 15.4 and 16.1(f))
- special provisions for cases where the international
application is transmitted to RO/IB under Rule 19.4
(Rule 19.4(c))

Time limits for payment of fees (2)

■ Chapter II:

- preliminary examination fee and handling fee: one month from the date of receipt of the demand by the IPEA or 22 months from the priority date, whichever expires later (Rules 57.3 and 58.1(b))
- special provisions for cases where the demand is transmitted to the competent IPEA under Rule 59.3 (Rules 57.3 and 58.1(b))

Safeguards in respect of payment of fees

- In respect of the transmittal, international filing and search fees payable to the receiving Office (Rule 16*bis*.1(d))
- In respect of the handling and preliminary examination fees payable to the IPEA (Rule 58*bis*.1(d))
- If fees concerned are paid after the expiration of the applicable time limit(s) but before any further action is taken by the Office or Authority concerned, the fees are considered to have been paid within the applicable time limit(s)

Invitation to pay missing fees (Chapter I) (Rule 16*bis*)

- If the fees due (i.e., transmittal fee, search fee, international filing fee) are not paid within the applicable time limit(s):
 - the RO invites the applicant to pay to it the missing fees within one month from the date of the invitation; and
 - the RO may require a late payment fee of 50% of the missing amount (minimum: transmittal fee; maximum: 50% of the international filing fee)
- The RO will not transmit the search copy to the ISA until the search fee is paid (Rule 23.1(a))
- Consequence in case of non-payment:
 - the international application will be considered withdrawn by the RO

Invitation to pay missing fees (Chapter II) (Rule 58*bis*)

- If the fees due (i.e., preliminary examination fee and handling fee) are not paid within the applicable time limit:
 - the IPEA invites the applicant to pay to it the missing fees within one month from the date of the invitation; and
 - the IPEA may require a late payment fee of 50% of the missing amount (minimum: handling fee; maximum: double the amount of the handling fee)
- Examination will not start until the fees are paid (Rule 69.1(a)(ii))
- Consequence in case of non-payment:

If the amount paid is not sufficient to cover the examination fee, the handling fee and, where applicable, the late payment fee, the demand will be considered by the IPEA as if it had not been submitted and the IPEA will so declare

Refund of fees by the receiving Office (Rules 15.6 and 16.2)

- If no international filing date is accorded, or, due to prescriptions concerning national security, the international application is not treated as such: international filing and search fee

- If the international application is withdrawn or considered withdrawn:
 - before transmittal of the record copy to the IB: international filing fee

 - before transmittal of the search copy to the ISA: search fee

- For the other fees (e.g. transmittal fee) or when outside of the time limits indicated, certain fees may be refunded under certain circumstances.
Check with the competent Office or Authority

Refund of fees by the IPEA

■ Handling fee: full refund (Rule 57.4)

- if demand withdrawn before having been sent by the IPEA to the IB
- if demand considered, under Rule 54.4, not to have been submitted

■ Preliminary examination fee: refund of up to 100%, depending on circumstances and IPEA

- where demand considered as if it had not been submitted (Rule 58.3)
- where demand withdrawn before start of international preliminary examination (Agreement between IPEA and IB of WIPO); see the *PCT Applicant's Guide*, International Phase, International Preliminary Examining Authorities (Annex E) for details

Warning – fraudulent requests for payment of registration fees

- PCT applicants and agents are receiving invitations to pay fees that do not come from the IB and are unrelated to the processing of international applications under the PCT
- Whatever registration services might be offered in such invitations, they bear no connection to WIPO or to any of its official publications
- The services offered do not give applicants any added value, since they are provided by the IB for no additional charge (www.wipo.int/pctdb)
- Examples of such misleading invitations can be viewed on our website at the following link:

http://www.wipo.int/pct/en/warning/pct_warning.htm



Amendments under the PCT

- Amendments under Article 19
- Amendments under Article 34
- Amendments upon National Phase Entry
- How to make amendments

Amendments under Article 19 (Rule 46) (1)

- One opportunity to amend the claims only after receipt of the international search report and written opinion of the ISA
- Amended claims must not go beyond disclosure of the international application as filed (Article 19(2)) (compliance with that requirement is, however, not checked at this point)
- Amended claims may be accompanied by a statement (Article 19(1), Rule 46.4)
- Normally must be filed within two months from the date of transmittal of the international search report and written opinion of the ISA (Rule 46.1)

Amendments under Article 19 (Rule 46) (2)

- Filed directly with the IB (Rule 46.2)
- Generally used to better define provisional protection, where available
- Published as part of the international application at 18 months, together with the claims as originally filed (Rule 48.2(f))

Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (1)

- Description, claims and drawings may be amended in connection with the international preliminary examination under Chapter II
- They should be filed
 - together with the demand for international preliminary examination so that examination will be based on the application as amended (Rule 53.9); or
 - at least before the expiration of the time limit to file a demand (Rule 54*bis*.1(a))
- Attention: amendments need not be taken into account by the examiner if they are received after he has begun to draw up another written opinion or the report (Rule 66.4*bis*)

Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (2)

- Amendments shall not go beyond the disclosure of the international application as filed (Article 34(2)(b))
- If an amendment goes beyond the disclosure in the international application as filed, the international preliminary examination report shall be established as if that amendment had not been made, and the report shall so indicate. The report shall also indicate the reasons why the amendment is considered to go beyond the disclosure in the international application as filed (Rule 70.2(c))

Comparison between types of amendments during international phase

Chapter I (Article 19)

- have effect in all DOs
- claims only
- filed upon receipt of the ISR and written opinion of ISA
- filed directly with IB (not ISA)
- formality examination by IB
- published as part of the international application by IB
- serve as basis for examination by IPEA unless reversed

Chapter II (Article 34)

- have effect in all EOs
- description, claims, drawings
- filed best together with the demand, or during examination by IPEA
- filed directly with IPEA
- formality and substantive examination by IPEA
- are confidential between IPEA and the applicant, are not published during the international phase
- serve as basis for examination by IPEA unless superseded

How to make amendments (Rules 46.5 and 66.8)

- Where claims are amended under Article 19 or 34, they have to be presented in the form of replacement sheets containing a complete set of claims
- Applicants must indicate the basis for the amendments in the application as filed, otherwise the IPRP (Ch.II) may be established as if the amendments had not been made
- In case of cancelation of certain claims, no renumbering of the remaining claims is required
- An accompanying letter explaining what has been amended is required
- Further details: Administrative Instructions Section 205

Replacement sheets containing amendments under Article 19 or 34

- May not be filed with the receiving Office
- If filed under Article 19 (claims only), must be filed directly with IB in Geneva
 - If, however, they also contain rectifications of obvious mistakes (Rule 91), they must also be submitted to the ISA for authorization of rectification
- If filed under Article 34 (description, claims, drawings), must be filed directly with competent IPEA
 - If they also contain rectifications of obvious mistakes (Rule 91), that IPEA will also be competent to authorize rectification

Amendments upon entry into the national phase (Articles 28 and 41 and Rules 52 and 78)

- Description, claims and drawings may be amended
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments possible for different DOs and EOs
- Generally, any claims fee due for the national phase will be calculated on the basis of the number of claims valid at the time of entry into the national phase