



DEPARTMENT OF  
INTELLECTUAL PROPERTY, THAILAND



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## NATIONAL SEMINAR

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**WIPO/PCT/BKK/19/2**  
**ORIGINAL: ENGLISH**  
**DATE: NOVEMBER 27, 2019**

## The System for Worldwide Filing of Patent Applications

*organized by*  
the World Intellectual Property Organization (WIPO)

*in cooperation with*  
the Department of Intellectual Property (DIP), Thailand

**Bangkok, Thailand, November 27, 2019**

*Prepared by the International Bureau of WIPO*



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## PREFACE

This document has been prepared by the International Bureau of the World Intellectual Property Organization (WIPO), Geneva, Switzerland, as a support material for seminars on the Patent Cooperation Treaty (PCT).

The following words and expressions used throughout the document should be understood as follows:

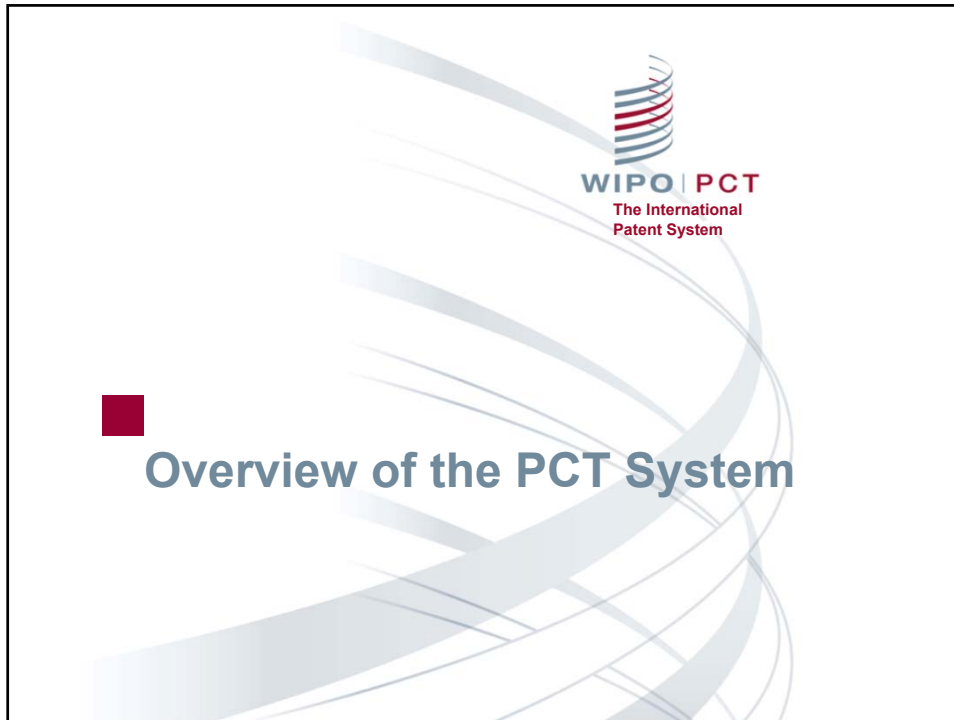
Administrative Instructions	–	the Administrative Instructions under the PCT
Article	–	an Article of the PCT
Chapter I	–	Chapter I of the PCT
Chapter II	–	Chapter II of the PCT
Contracting State	–	a State party to the PCT
Regulations	–	the Regulations under the PCT
Rule	–	a Rule of the Regulations under the PCT
Section	–	a Section of the Administrative Instructions under the PCT

References to “national” Office or national fees, national phase, national processing, etc., should be understood to include “regional” Office (e.g., the EPO), etc.

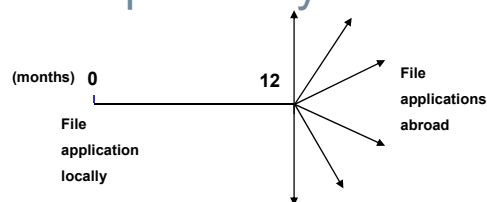
The following abbreviations should be understood as meaning:

ARIPO	–	African Regional Intellectual Property Organization
DAS	–	Digital Access Service for Priority Documents
DO	–	Designated Office
EAPC	–	Eurasian Patent Convention
EAPO	–	Eurasian Patent Office
EO	–	Elected Office
EPC	–	European Patent Convention
EPO	–	European Patent Office/European Patent Organisation
Euro-PCT	–	a Euro-PCT application is an international application containing the designation “EP” irrespective of the receiving Office with which it was filed
IB	–	International Bureau (of the World Intellectual Property Organization)
IPE	–	International Preliminary Examination
IPEA	–	International Preliminary Examining Authority
IPRP (Chapter I)	–	International Preliminary Report on Patentability (Chapter I of the PCT)
IPRP (Chapter II)	–	International Preliminary Report on Patentability (Chapter II of the PCT)
ISA	–	International Searching Authority
ISR	–	International Search Report
OAPI	–	African Intellectual Property Organization
RO	–	Receiving Office
SIS	–	Supplementary International Search
SISA	–	Supplementary International Searching Authority
SISR	–	Supplementary International Search Report
WIPO	–	World Intellectual Property Organization
WO of ISA	–	Written Opinion of the International Searching Authority
WTO	–	World Trade Organization

This document is based on the requirements of the Patent Cooperation Treaty (PCT), the Regulations and the Administrative Instructions under the PCT. In case of any discrepancy between this document and those requirements, the latter are applicable.

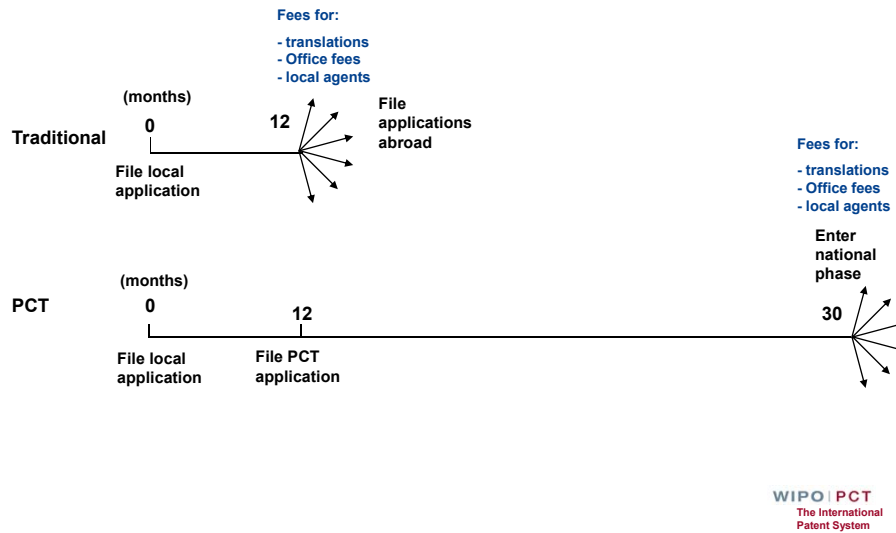


## Traditional patent systems



- Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:
  - multiple formality requirements
  - multiple searches
  - multiple publications
  - multiple examinations and prosecutions of applications
  - translations and national fees required at 12 months
- Some rationalization because of regional arrangements: ARIPO, EAPO, EPO, OAPI

## Traditional patent system vs. PCT system



## PCT system

Local patent application followed within 12 months by international application under the PCT, claiming Paris Convention priority, with “national phase” commencing at 30 months\*:

- one set of formality requirements
- international search
- international publication
- international preliminary examination
- international application can be put in order before national phase
- translations and national fees required at 30 months,\* and only if applicant wishes to proceed

\* For exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

WIPO PCT  
The International Patent System

## General remarks on the PCT system (1)

- The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT patent”
- The PCT system provides for
  - an international phase comprising:
    - filing of the international application
    - international search and written opinion of the ISA
    - international publication and
    - international preliminary examination
  - a national/regional phase before designated Offices
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase

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## General remarks on the PCT system (2)

- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles.
- Design and trademark protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively).
- The PCT is administered by WIPO as are other international treaties in the field of industrial property, such as the Paris Convention.

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## PCT Contracting States (153)

*States designated for regional protection and also, unless otherwise indicated, national protection*

### **EA Eurasian Patent**

AM Armenia  
AZ Azerbaijan  
BY Belarus  
KG Kyrgyzstan  
KZ Kazakhstan  
RU Russian Federation  
TJ Tajikistan  
TM Turkmenistan

### **EP European Patent**

AL Albania<sup>1</sup>  
AT Austria  
\* BE Belgium  
BG Bulgaria  
CH Switzerland  
\* CY Cyprus  
CZ Czech Republic  
DE Germany  
DK Denmark  
EE Estonia  
ES Spain  
FI Finland  
\* FR France  
\* GB United Kingdom  
\* GR Greece  
HR Croatia<sup>1</sup>  
HU Hungary  
\* IE Ireland  
IS Iceland

\* IT Italy  
LI Liechtenstein  
\* LT Lithuania  
LU Luxembourg  
\* LV Latvia  
\* MC Monaco  
MK North Macedonia<sup>1</sup>  
\* MT Malta  
\* NL Netherlands  
NO Norway  
PL Poland  
PT Portugal  
RO Romania  
RS Serbia<sup>1</sup>  
SE Sweden  
\* SI Slovenia  
SK Slovakia  
SM San Marino  
TR Turkey

\* Regional patent only

1 Extension agreement continues to apply to applications filed before 1 January 2008 (for HR), 1 January 2009 (for MK), 1 May 2010 (for AL) or 1 October 2010 (for RS)

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## PCT Contracting States (152) (continued)

*States designated for regional protection and also, unless otherwise indicated, national protection*

### **AP ARIPO Patent**

BW Botswana  
GH Ghana  
GM Gambia  
KE Kenya  
LR Liberia  
LS Lesotho  
MW Malawi  
MZ Mozambique  
NA Namibia  
RW Rwanda  
SD Sudan  
SL Sierra Leone  
ST Sao Tome and Principe  
\* SZ Eswatini  
TZ United Republic of Tanzania  
UG Uganda  
ZM Zambia  
ZW Zimbabwe

### **OA OAPI Patent**

\* BF Burkina Faso  
\* BJ Benin  
\* CF Central African Republic  
\* CG Congo  
\* CI Côte d'Ivoire  
\* CM Cameroon  
\* GA Gabon  
\* GN Guinea  
\* GQ Equatorial Guinea  
\* GW Guinea-Bissau  
\* KM Comoros  
\* ML Mali  
\* MR Mauritania  
\* NE Niger  
\* SN Senegal  
\* TD Chad  
\* TG Togo

\* Regional patent only

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## PCT Contracting States (153) (continued)

*States designated for national protection only except where otherwise indicated*

AE	United Arab Emirates	ID	Indonesia	NI	Nicaragua
AG	Antigua and Barbuda	IL	Israel	NZ	New Zealand
AO	Angola	IN	India	OM	Oman
AU	Australia	IR	Islamic Republic of Iran	PA	Panama
* BA	Bosnia and Herzegovina	JO	Jordan	PE	Peru
BB	Barbados	JP	Japan	PG	Papua New Guinea
BH	Bahrain	** KH	Cambodia	PH	Philippines
BN	Brunei Darussalam	KM	Union of the Comoros	QA	Qatar
BR	Brazil	KN	Saint Kitts and Nevis	SA	Saudi Arabia
BZ	Belize	KP	Democratic People's Republic of Korea	SC	Seychelles
CA	Canada	KR	Republic of Korea	SG	Singapore
CL	Chile	KW	Kuwait	ST	Sao Tome and Principe
CN	China	LA	Lao People's Democratic Republic	SV	El Salvador
CO	Colombia	LC	Saint Lucia	SY	Syrian Arab Republic
CR	Costa Rica	LK	Sri Lanka	TH	Thailand
CU	Cuba	LY	Libya	** TN	Tunisia
DJ	Djibouti	** MA	Morocco	TT	Trinidad and Tobago
DM	Dominica	** MD	Republic of Moldova	UA	Ukraine
DO	Dominican Republic	* ME	Montenegro	US	United States of America
DZ	Algeria	MG	Madagascar	UZ	Uzbekistan
EC	Ecuador	MN	Mongolia	VC	Saint Vincent and the Grenadines
EG	Egypt	MX	Mexico	VN	Viet Nam
GD	Grenada	MY	Malaysia	<b>WS</b>	<b>SAMOA (as from 2 January 2020)</b>
GE	Georgia	NG	Nigeria	ZA	South Africa
GT	Guatemala				
HN	Honduras				

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\* Extension of European patent possible  
\*\* Validation of European patent possible

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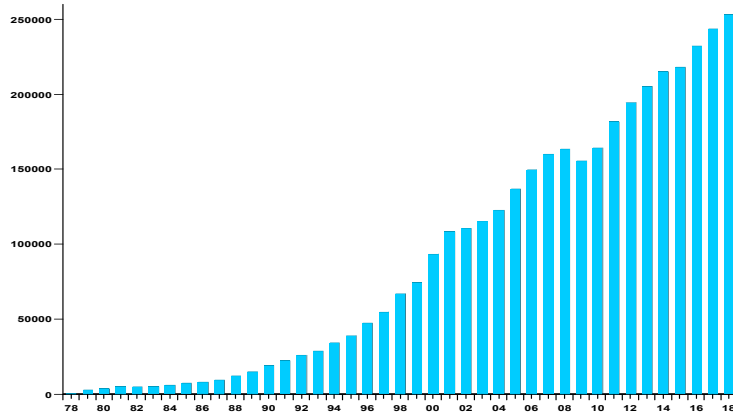
## Countries not yet PCT Contracting States (40)

Afghanistan	Guyana	Palau
Andorra	Haiti	Paraguay
Argentina	Iraq	Solomon Islands
Bahamas	Jamaica	Somalia
Bangladesh	Kiribati	South Sudan
Bhutan	Lebanon	Suriname
Bolivia	Maldives	Timor-Leste
Burundi	Marshall Islands	Tonga
Cabo Verde	Mauritius	Tuvalu
Democratic Republic of Congo	Micronesia	Uruguay
Eritrea	Myanmar	Vanuatu
Ethiopia	Nauru	Venezuela
Fiji	Nepal	Yemen
Guyana	Pakistan	

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## Tremendous growth in PCT applications since 1978

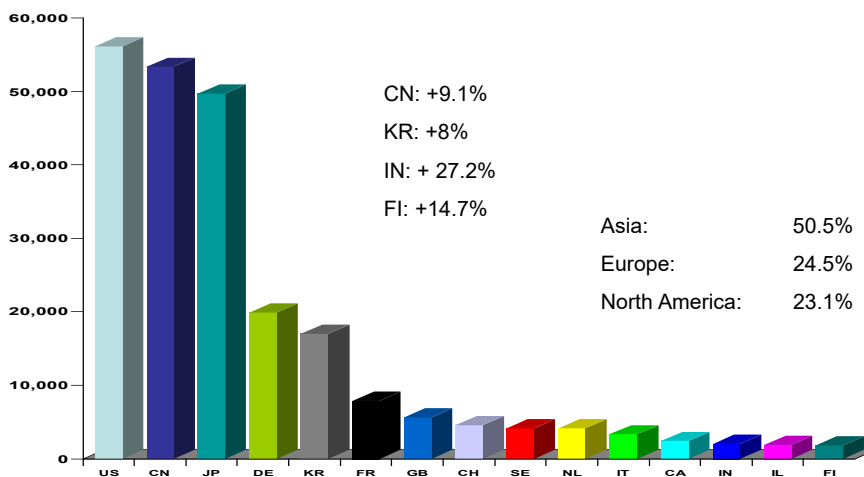


2018: +3.9%

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## International applications received in 2018 by country of origin



CN: +9.1%

KR: +8%

IN: +27.2%

FI: +14.7%

Asia: 50.5%

Europe: 24.5%

North America: 23.1%

• 22.1% originating in US, 21% in China, 19.6% in Japan

• 62.7% from the top 3 countries, 77.5% from top 5 countries, 92.4% of filings from top 15 countries

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## Top PCT Applicants in 2018

1. Huawei Technologies—CN (5,405)
  2. Mitsubishi Electric—JP (2,812)
  3. Intel—US (2,499)
  4. Qualcomm—US (2,404)
  5. ZTE—CN (2,080)
  6. Samsung—KR (1,997)
  7. BOE Technology Group—CN (1,813)
  8. LG Electronics—KR (1,697)
  9. Ericsson—SE (1,645)
  10. Bosch—DE (1,524)
  11. Microsoft—US (1,476)
  12. Panasonic—JP (1,465)
  13. Sony—JP (1,342)
  14. Siemens—DE (1,211)
  15. Hewlett-Packard—US (1,170)
- ( ) of published  
PCT applications*

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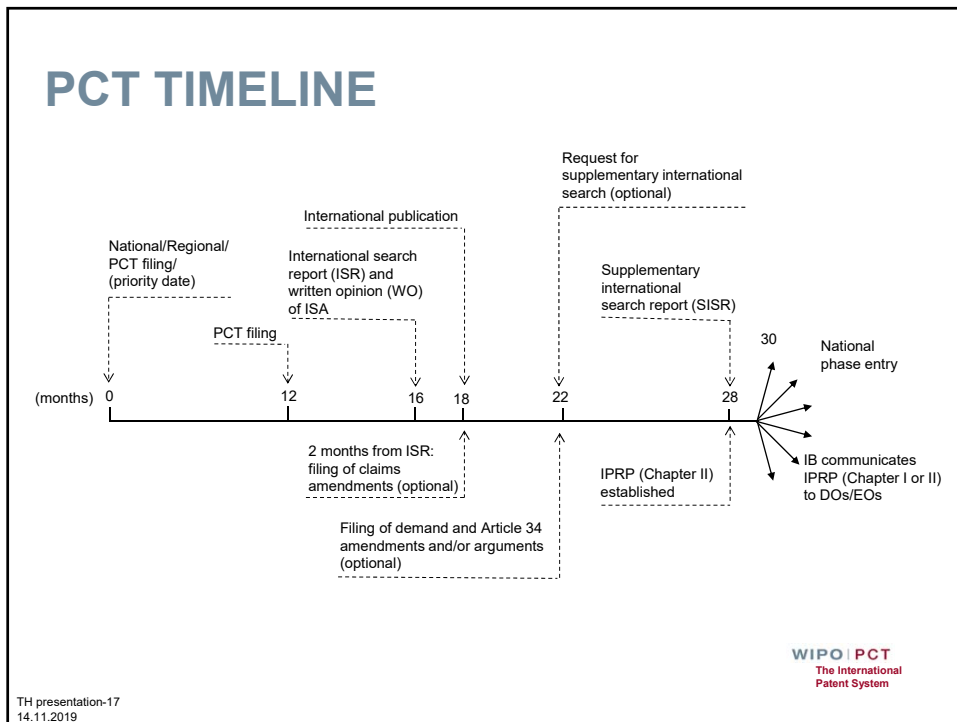
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## Top University PCT Applicants in 2018

1. University of California (US)
2. Massachusetts Institute of Technology (US)
3. Shenzhen University (CN)
4. South China University of Technology (CN)
5. Harvard University (US)
6. University of Texas (US)
7. Tsinghua University (CN)
8. Seoul National University (KR)
9. Stanford University (US)
10. China University of Mining and Technology (CN)
11. Osaka University (JP)
12. Johns Hopkins University (US)
13. Korea Advanced Institute of Science and Technology (KR)
14. University of Tokyo (JP)
15. Hanyang University (KR)

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## Non-applicability of time limit of 30 months under Article 22(1)

- The Offices of the following States have notified the International Bureau that they will not apply the 30 month time limit under Chapter I, as of 1 April 2002, for as long as modified Article 22(1) is not compatible with their national law:

LU Luxembourg  
TZ United Republic of Tanzania

- Where one of these States has been designated for the purposes of a regional patent, the applicable time limit is 31 months
- If no demand for international preliminary examination is filed before the expiration of 19 months in respect of above States, the national phase will have to be entered before the expiration of 20 or 21 months from the priority date



## Recent Developments

- New ISAs/IPEAs
- PCT Highlights
- Licensing availability
- Third Party Observations
- PATENTSCOPE
- WIPO Pearl
- PCT Direct
- PCT and PPH
- Arbitration and Mediation Center Fee Reductions

## New ISAs/IPEAs

- Twenty three (23) Offices now hold the status as ISA/IPEA
  - The State Intellectual Property Service of Ukraine (SIPSU) started operations as an ISA/IPEA on 5 February 2016
  - The Visegrad Patent Institute started operations as ISA/IPEA on 1 July 2016
  - Turkish Patent and Trademark Office started operations as from 8 March 2017
  - The Intellectual Property Office of the Philippines has been appointed as an ISA/IPEA (2017) (*operational as from 20 May 2019*)

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## PCT Highlights

- High-level summary of recent and future developments in the PCT, with hyperlinks to more detailed information, databases, videos, etc.
- Targeted, in particular, at managers and attorneys
- Possibility to subscribe to the PCT Highlights mailing list for update notifications
- [www.wipo.int/pct/en/highlights/index.html](http://www.wipo.int/pct/en/highlights/index.html)

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## Licensing availability (1)

- Applicants interested in concluding license agreements in relation to their international application may request the International Bureau to make this information available in PATENTSCOPE:
  - How? Applicants should submit a “Licensing Availability Request” to the IB using an ePCT “Action”
    - Alternatively, Form PCT/IB/382 may be used
  - When? At the time of filing or within 30 months from the priority date
  - Free of charge
  - Applicants can file multiple licensing requests or update previously submitted ones (within 30 months from the priority date)

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## Licensing availability (2)

- Licensing indications will be made publicly available after international publication of the application
- The licensing indications will be visible on PATENTSCOPE under the “*Bibliographic data*” tab with a link to the submitted licensing request itself
- International applications containing licensing information can be searched for in PATENTSCOPE
- The licensing indication displayed under the “*Bibliographic data*” tab may be revoked by the applicant at any time, that is, also after 30 months from the priority date

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## Third Party Observations - Main Features

- Allows third parties to submit prior art observations relevant to novelty and inventive step
- Web-based system using ePCT or web-forms in PATENTSCOPE
- Free-of-charge
- Submissions possible until the expiration of 28 months from the priority date
- Applicants may submit comments in response until the expiration of 30 months from the priority date
- Anonymous submission of third party observations possible
- Third-party supplied documents will not be available via PATENTSCOPE, but will be made available to International Authorities and national Offices

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## Third Party Observations – Role of the IB

- Checks for spam
- Notifies the applicant of submission of observations
- Makes observations available in PATENTSCOPE
- Sends to International Authorities and designated Offices observations, cited documents, and applicant responses
- Available since July 2012

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## PATENTSCOPE

- Interface available in 10 languages (plus mobile version)
- “Documents” tab includes the new section “Search and Examination-Related Documents”
- Information on national phase entry for more than 65 countries
- Access to more than 55 searchable national and regional patent collections
- New secure access to PATENTSCOPE via https
- WIPO Translate
  - translation tool based on neural machine translation technology that enables it to convert highly technical patent documents into a second language in a style and syntax that closely mirrors common usage
- Cross-Lingual Expansion
  - allows the search of a term/phrase and its variants in several languages by entering the term(s) in one language, the system will suggest variants and translate the term(s) allowing the search of patent documents in other languages

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Patent System

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## WIPO Pearl

- Multilingual terminology portal which gives access to scientific and technical terms derived from patent documents
- Available in all ten PCT languages
- Helps to promote accurate and consistent use of terms across different languages and makes it easier to search and share scientific and technical knowledge
- All content validated with reliability scores
- Integrated with PATENTSCOPE
- Further details can be found at:  
[www.wipo.int/wipopearl/search/home.html](http://www.wipo.int/wipopearl/search/home.html)

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## “PCT Direct” (1)

- Additional service offered by:
  - EPO since 1 November 2014
  - Israel Patent Office since 1 April 2015
  - Finnish Patent and Registration Office since 1 April 2019
- During the PCT procedure, applicants can address patentability issues raised in the search opinion established for the priority application by the same office
- Aims at improving the efficiency and quality of the procedure before the ISA
- Further details can be found on the EPO website: [www.epo.org/law-practice/legal-texts/official-journal/2014/09/a89.html](http://www.epo.org/law-practice/legal-texts/official-journal/2014/09/a89.html)
- Further details can be found on the Israel Patent Office website: [www.justice.gov.il/En/Units/ILPO/Departments/PCT/News/Pages/PCTDirect.aspx](http://www.justice.gov.il/En/Units/ILPO/Departments/PCT/News/Pages/PCTDirect.aspx)
- Further details can be found on the Finnish Patent and Registration Office website: [https://www.prh.fi/en/asiakastiedotteet/2019/P\\_17863.html](https://www.prh.fi/en/asiakastiedotteet/2019/P_17863.html)

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## “PCT Direct” (2)

- Requirements:
  - the informal comments are filed together with the PCT application
    - with any RO if ISA/EP is chosen
    - with RO/FI if ISA/FI (with any RO if ISA/FI as of 1 November 2019)
    - with any RO if ISA/IL;
  - ISA/EP, ISA/FI or ISA/IL are selected
  - the PCT application claims priority of an earlier application searched by the
    - ISA/EP (European first filing or national first filing)<sup>1</sup>
    - ISA/FI
    - ISA/IL
- Form:
  - the informal comments are filed in form of a “PCT Direct Letter” in a single document in PDF format and the words “PCT Direct/informal comments” have been indicated under “Other” in Box IX of the PCT request form (Form PCT/RO/101)

<sup>1</sup> The EPO performs national searches for France, Netherlands, Belgium, Luxembourg, Italy, Turkey, Greece, Cyprus, Malta, San Marino, Lithuania, Latvia and Monaco

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## “PCT Direct” (3)

### ■ Informal comments:

- They are arguments regarding the patentability of the claims of the PCT application
- May include explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the earlier application (e.g. marked-up copy)
- Aim at overcoming objections raised in the search opinion established for the priority application
- Do not form part of the PCT application, but are made publicly available on PATENTSCOPE

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## Patent Prosecution Highway (PPH) and PCT

- Accelerated examination in the national phase based on a positive work product of an International Authority (written opinion of the ISA or the IPEA, IPRP (Chapter I or II))
- Conditions:
  - At least one claim has been determined by the ISA or the IPEA to meet the PCT criteria of novelty, inventive step and industrial applicability; and
  - ALL the claims must sufficiently correspond to the claims deemed to meet the PCT criteria (they are of the same or similar scope or they are of narrower scope than the claims in the PCT application)
- Global PPH and PCT:
  - Introduction of Global PPH Pilot in January 2014
  - Single set of qualifying requirements that simplifies the existing PPH network so that it is more accessible for users

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## Patent Prosecution Highway (PPH) and PCT

- Global PPH complements existing bilateral PPH agreements
- Information on the PCT Website:  
[www.wipo.int/pct/en/filing/pct\\_pph.html](http://www.wipo.int/pct/en/filing/pct_pph.html)
- Information on the PPH Portal:  
[www.jpo.go.jp/pph-portal/index.htm](http://www.jpo.go.jp/pph-portal/index.htm)
- Information on procedures and forms can be found on the websites of the participating Offices
- The IB requests feedback on experience with PCT-PPH at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)

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## Arbitration and Mediation Center (AMC)

- Independent and impartial body that offers alternative dispute resolution options for the resolution of commercial disputes between private parties (time and cost efficient alternatives to litigation)
- Provides mediation, arbitration and expert determination services for IP and other commercial disputes
- 25% lifetime reduction on AMC's registration and administration fees where at least one party to the dispute has been named as an applicant or inventor in a published PCT application (no relationship to the dispute is required)
- Fee calculator

[www.wipo.int/amc/en/calculator/adr.jsp](http://www.wipo.int/amc/en/calculator/adr.jsp)

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**Basics of the PCT**

- The international application
- The international filing date
- The applicant
- Competent RO and ISA

## The international application

- Only one application filed, containing, by default, the designation of all States (for every kind of protection available) and usual priority claim(s)
- Has the effect of a regular national filing (including establishment of a priority date) in each designated State: the international filing date is the filing date in each designated State
- Filed in one language
- Filed with one office
- One set of formality requirements
- Delays national processing until 30 months from the priority date (for exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html))

## Minimum requirements for an international filing date (Article 11(1)) (1)

### ■ The application must contain at least:

- an indication that it is intended as an international application
- a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
- the name of the applicant (Rule 4.5)
- a description (Rule 5)
- a claim (Rule 6)

## Minimum requirements for an international filing date (Article 11(1)) (2)

### ■ Note that if:

- none of the applicants have the right to file with the receiving Office for reasons of residence or nationality (Rules 18 and 19); or
- the application is filed in a language not accepted by the receiving Office for that purpose (Rule 12.1),

the receiving Office will transmit the application to the receiving Office of the International Bureau for further processing (Rule 19.4)

## Not required for obtaining an international filing date

- Payment of fees
- Applicant's signature
- Title of the invention
- Abstract
- Drawings (for missing drawings, see Article 14(2) and Rule 20.5)
- Translation into language of search or publication

## The PCT applicant (Article 9 and Rule 18)

- The applicant may be a natural person (e.g. the inventor) or a legal entity (e.g. company, university, NGO) (also for the US since 16 September 2012)
- It is possible to indicate different applicants for different designated States (Rule 4.5(d))
- At least one of the applicants must be a national or resident of a PCT Contracting State (Rule 18.3)



## Where to file the international application (Rule 19)

- With a national Office
- With the International Bureau of WIPO, or
- With a regional Office

For details, see PCT Applicant's Guide, International Phase, General Information, Annexes B1 and B2

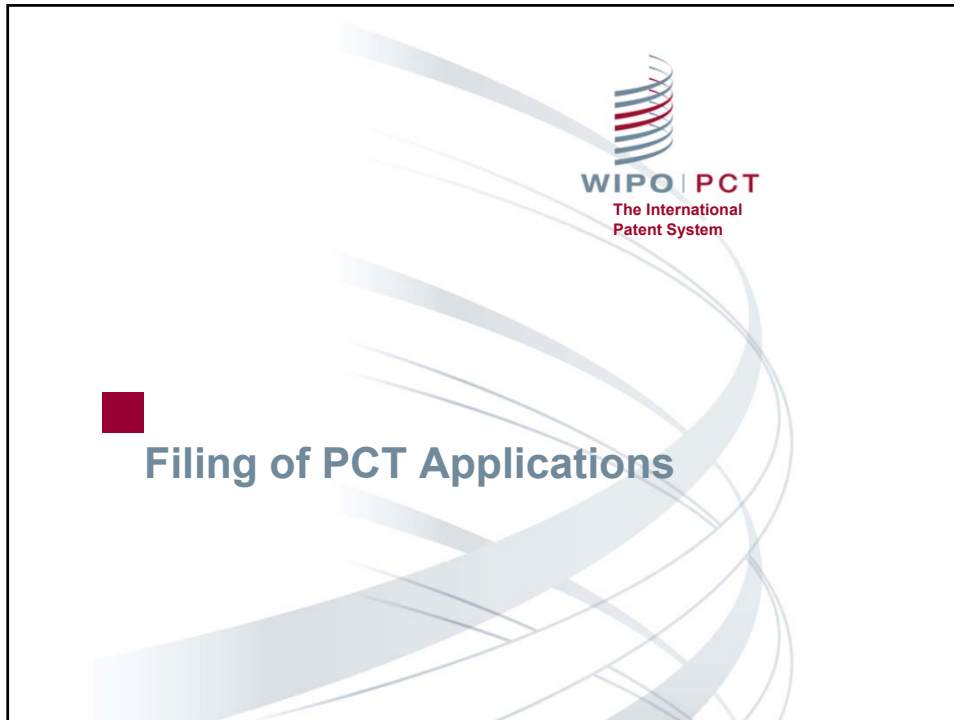
## Choice of receiving Office

Considerations:

- Accepted filing languages
- Choice of International Searching Authorities
- Criteria for restoration of the priority right and fee to be paid
- Possibility to incorporate by reference
- Acceptance of pre-conversion files

## Which ISA(s) is (are) competent (Rule 35)

- The competent ISA(s) is (are) specified by the RO
- If more than one is specified by the RO, the applicant has the choice:
  - in making that choice, the applicant must take into account the language(s) accepted by the ISA (a translation of the international application for the purposes of international search may be required in certain cases (Rule 12.3))
- If the international application is filed with RO/IB, the competent ISAs will be those which would have been competent if the international application had been filed with (any of) the national or regional Office(s) which, on the basis of applicant's nationality or residence, could be a competent RO
- Choice of ISA to be indicated in the request (Box No. VII)



## 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*)

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## The request (1)

- Electronic filing of the international application
  - ePCT-Filing
  - PCT-SAFE fully electronic
  - Other filing means provided by the receiving Office

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## The request (2)

- Printed request form (Form PCT/RO/101)
  - Available on Internet ([www.wipo.int/pct/en/forms](http://www.wipo.int/pct/en/forms))
- Computer print-out (Rules 3.1 and 3.4, Section 102(h))
  - For integration with in-house computer systems
  - Layout and content shall correspond to the paper form (minor adjustments permitted)

## 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

## Use of Earlier Search Results (Rule 4.12)

- The applicant may request the ISA to take into account the results of an earlier search in carrying out the international search
  - How? by filling-in the appropriate box on the request form
- To the extent that the ISA takes such earlier search results into account, it may reduce the search fee
  - For further details see the agreements between the International Bureau and the ISAs/IPEAs at:  
[www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)

## Transmittal of Earlier Search and/or Classification Results by ROs to ISAs (Rules 12*bis*, 23*bis* and 41) (1)

- Where the applicant does not request the ISA to take into account the results of an earlier search under Rule 4.12, ROs nevertheless forward the search/classification results from priority applications without the applicant's express permission
- Exceptions:
  - Applicants filing with RO/DE, RO/FI or RO/SE may request at the time of filing of the PCT application NOT to have earlier search results forwarded to the ISA, by checking the appropriate box on the request form

## Transmittal of Earlier Search and/or Classification Results by ROs to ISAs (Rules 12*bis*, 23*bis* and 41) (2)

### ■ Exceptions: (*cont.*)

- ROs which have notified the IB of incompatibility of such forwarding with their applicable national law will only forward earlier search and classification results to the ISA if the applicant expressly authorized the RO by checking the appropriate box on the request form (concerns the receiving Offices: AU, CZ, FI, HU, IL, JP, NO, SE, SG and US)
- If priority of an earlier PCT application is claimed and the earlier international search was carried out by a different ISA, ROs will only forward earlier search and classification results to the ISA if the applicant expressly authorized the RO by checking the appropriate box on the request form

## 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, 26.2bis(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

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

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## 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)
  - 25 characters maximum
  - in the upper left-hand corner of the sheet
  - within 1.5 cm of the top of the sheet

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## 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)

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## 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 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 26ter)

- 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

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## Publication of declarations

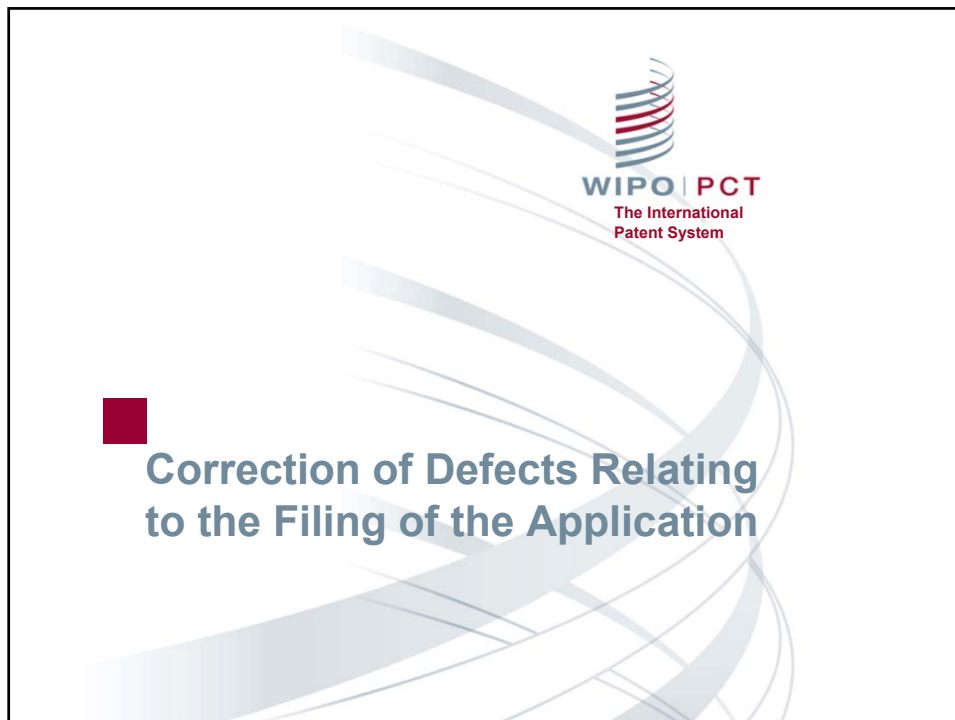
- Declarations received within the applicable time limit will be mentioned on the front page of the published international application
- The full text of the declarations will be published as part of the international application

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## 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



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

- Office not competent because of the applicant's nationality or residence (Article 11(1)(i), 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)

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

- Missing sheets of
  - description
  - claims
  - drawings

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## 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

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## 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))

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## 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](http://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)):
  - CU, CZ, DE, ID, IT, KR, MX
- Incompatibility as DO (Rule 20.8(b)):
  - CN, CU, CZ, DE, ID, KR, 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 sheets or elements
  - 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?

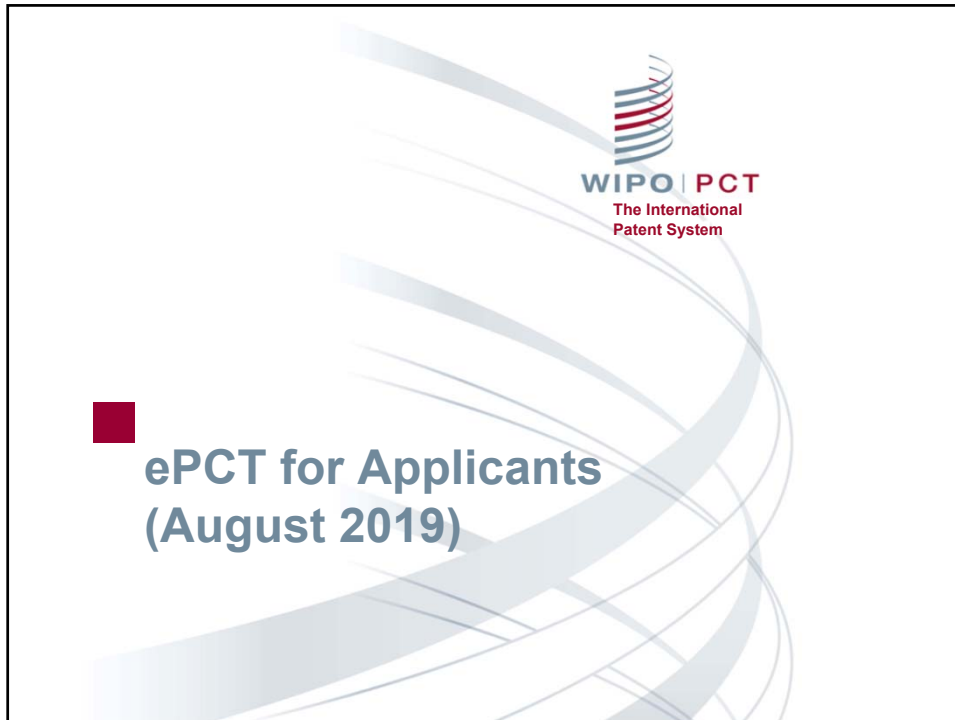
- A replacement sheet must be submitted
  - where the correction/rectification/amendment is in any part of the international application other than the request, in all cases
  - where the correction/rectification/amendment is in the request, in cases where it is of such a nature that it cannot be communicated 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*)





## ePCT Overview

- Getting started [pct.wipo.int/ePCT](https://pct.wipo.int/ePCT)
- Access to ePCT with and without strong authentication
- ePCT-Filing
- eOwnership of PCT applications
- eHandshakes, sharing/removal of access rights
- Features and functions
- Future developments

## What is ePCT? (1)

- Online portal that provides PCT services for both applicants and Offices (pct.wipo.int)
- User interface available in all PCT publication languages
- Provides secure and direct interaction with PCT applications maintained by the International Bureau
- Applicants can conduct most PCT transactions electronically with the International Bureau
- ePCT-Filing - Web-based filing of PCT applications

## What is ePCT? (2)

- Receiving Offices, International Searching Authorities, International Preliminary Examining Authorities and designated Offices have access to PCT applications via secure ePCT Office accounts
- Applicants can conduct a number of electronic PCT transactions via ePCT also with participating Offices

## ePCT modes

- Single WIPO Account (username and password) required to access ePCT
  - <https://pct.wipo.int/wipoaccounts/ePCT/>
- ePCT **without** strong authentication
  - Limited functionality, document upload
  - Practical alternative to paper (*fax transmissions to the IB no longer recommended since January 1, 2018*)
- ePCT **with** strong authentication
  - Additional identity verification
  - Access to full range of services and functions including the creation and filing of PCT applications
  - Access to PCT applications filed as of January 1, 2009 including before publication

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## ePCT without strong authentication

- Upload documents to the International Bureau only
  - PDF format
  - E-mail cannot be used to submit documents
- Submit Actions
  - Rule 92*bis* action for published PCT applications
  - Article 19 amendments
  - Third party observations
  - Actions cannot be saved as drafts when using ePCT without strong authentication

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## ePCT without strong authentication - Actions

**PCT/IB2016/080079** ▾

International Filing Date 14 Apr 2016

Portfolio

Processing Team at IP PCT RO/IB Team      Tel. +41 22 338 92 22  
Email ro.ib@wipo.int

▸ **DOCUMENTS**

▸ **ACTIONS**

Select Action

Action  
Select ▾

**Select**

Amendments Under Article 19 (Best format only)  
Rule 92bis change request  
Third Party Observations  
Upload Documents

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## ePCT with strong authentication

- Best practice: set up at least 2 strong authentication methods
  - Authenticator app with one-time password (recommended) on a mobile device or equivalent application for computer if mobile device forbidden
  - SMS text with one-time password (recommended)
  - Obtain/upload a “supported” digital certificate
- Set-up instructions and videos are available on the ePCT HELP page  
[https://www.wipo.int/pct/en/epct/pdf/pct\\_wipo\\_accounts\\_faq.html](https://www.wipo.int/pct/en/epct/pdf/pct_wipo_accounts_faq.html)

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## Digital Certificates

- Choice of “supported” certificates
  - WIPO digital certificate
  - EPO digital certificate (smart card)

## WIPO Digital Certificate (1)

- A small electronic file with data that identifies the user (must be installed in your browser in order to authenticate access under strong authentication)
- Supported browsers to request and pick up your certificate are Mozilla Firefox (recommended) and Internet Explorer
- Available free-of-charge from WIPO, valid 2 years, renewable
- One-time opportunity to pick up the requested digital certificate (must be done within a week)

## WIPO Digital Certificate (2)

- Back-up the digital certificate
  - Export and password protect the digital certificate (for details see the ePCT support page)
  - E-mail the digital certificate to yourself and/or save it on a USB stick (keep password safe)
  - Back-up may be required after a browser upgrade or to access ePCT with strong authentication from a different PC or browser

## Multilingual Address Book (1)

- Record and store contact details of applicants, inventors, and agents
- Possibility to include English transliteration for entries in Arabic, Chinese, Japanese, Korean, Russian
- Import of existing address book (.csv extension) from PCT-SAFE or EPO-OLF software
- Address book sharing based on access rights
  - eOwner (can edit, view and share)
  - eEditor (can edit and view)
  - eViewer (can view only)

## Multilingual Address Book (2)

The screenshot shows the WIPO ePCT WORKBENCH interface. The user is logged in as PASCAL PIRIOU. The main navigation bar includes 'WORKBENCH' and 'NEW IA'. A dropdown menu is open, showing options: Notifications, Address Book (highlighted with a red box), Default access rights, My History, My Account, Request eOwnership code, PCT Resources, WIPO Online Services, and Office Profiles. Below the menu, there are tabs for 'Current IAs', 'Drafts', 'Unpublished', 'Published', and 'Archived', along with a search field. At the bottom, there are filters for 'us', 'File Ref', 'IFD', 'Priority', and 'Applic'.

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## Multilingual Address Book (3)


The screenshot shows the WIPO ePCT ADDRESS BOOK interface. The user is logged in as PASCAL PIRIOU. The main navigation bar includes 'ADDRESS BOOK'. Below the navigation bar, there are tabs for 'CONTACTS' and 'ACCESS RIGHTS'. The user's name 'PASCAL' is displayed. There are buttons for 'Add' and 'Import', and a search field labeled 'Search contact'. Below the search field, there are links for 'Refresh' and 'Download list'. A table displays contact information:

Name / Address	Country...	Nat	Res	E-mail	Notifications method
[EN] ABC COMPANY Street 1 Sunset Blvd 1080 Miami 95100 Florida	US	US	US	info@abc.com	

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## ePCT-Filing (1)



■ Web-based filing of PCT applications available to all PCT applicants

■ Real-time validation of data against the electronic processing system of the International Bureau

■ Request form can be prepared in all PCT publication languages

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## ePCT-Filing (2)

- Specification in PDF, DOCX or XML formats
  - For PDF format, option to attach multiple files or a single specification with or without drawings
  - For XML format, single file only
- Application body in DOCX format for conversion to XML using online converter <https://pct.wipo.int/DocConverter>
  - Templates and sample files are available in all PCT publication languages
  - DOCX User Guide available in English

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## ePCT-Filing (3)

- Color or greyscale content
  - Not permitted in PCT applications (Rule 11)
  - ePCT will automatically detect color or greyscale content and warn the applicant that the IB will convert the color content into black and white for publication
  - However, any original color or greyscale content will be available on PATENTSCOPE as part of the public application file
  - If color or greyscale is used, the front page of the published PCT application will contain a notice that the application as filed contained color or greyscale content
  - 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

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## ePCT-Filing (4)

- “Cloning” of PCT applications
  - The bibliographic data of a previous filing under ePCT-New IA (whether already filed or not yet filed) is used as an application template
  - Option to include all data and documents
  - Option to also copy access rights
- Real-time online payment to the International Bureau of filing fees by credit card or by debiting a WIPO Current Account (only for filings with RO/IB)
  - Visa, MasterCard/Eurocard, American Express, Discover, Diners Club
  - Payment can be made at or after the time of filing

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## ePCT-Filing (5)

- Accompanying items (not part of the PCT application), for example
  - General correspondence
  - Documents in pre-conversion format
  - Translations for international publication and/or international search
  - Sequence listing for search purposes
  - Generate request to participate in the IP5 CS&E pilot
- Possibility to make same day corrections
- Download copy of new PCT application before filing (ZIP (multiple PDF) or single PDF), and in RO format if RO is CA, IL or US)
- Multiple Rule 4.17 declarations of the same type are now merged in order to reduce the page count

## eOwnership of PCT applications

- Right to access and manage a PCT application in ePCT
- Process is automatic when using ePCT-Filing
  - Access rights can be assigned prior to filing
  - Users with access rights can access the draft PCT application
- If ePCT-Filing is not used, additional steps are required to take eOwnership
- Default access rights can be set up and automatically applied each time you are confirmed as 'original eOwner', either to individuals or to groups of individuals

## Taking eOwnership

- Automatic assignment of access rights when using ePCT-Filing
- At the time of electronic filing using PCT-SAFE, EPO online filing or JPO PAS
- Subsequent to electronic filing using a supported digital certificate that is also uploaded to your WIPO Account
- Paper-filed applications or electronically-filed applications with non-supported digital certificate

## Taking eOwnership when using other compatible e-filing software

- Generate a one-time eOwnership code in ePCT and paste it into the relevant signature field along with your Customer ID when filing with PCT-SAFE, EPO online filing or JPO PAS
- The new application is therefore securely associated with your WIPO Account
- When the record copy is received by the International Bureau, access rights will be automatically assigned to you based on the matching eOwnership code and Customer ID

## Taking eOwnership PCT-SAFE, EPO online filing and JPO PAS

WIPO | ePCT REQUEST ACCESS RIGHTS GENEVA JUL 17, 2017 9:40 AM CEST SUPPORT PASCAL PIRIOU Close

**GENERATE eOWNERSHIP CODE FOR USE WHEN PCT-SAFE, EPO ONLINE FILING & JPO PAS**

Generate an eOwnership code to set up ePCT access rights as part of the filing process when using PCT-SAFE, EPO ONLINE FILING & JPO PAS.  
This eOwnership Code can only be used at the time of filing, for one application and is not applicable to multiple applications.

Copy/paste your Customer ID and eOwnership code below into the corresponding fields in the signature box in PCT-SAFE, EPO online filing or JPO PAS.  
When the record copy is received at the International Bureau, eOwnership will be automatically assigned to the holder of the Customer ID.

Customer ID user\_CH\_PIRIOU\_PASCAL\_1755  
eOwnership Code SVYYHX2QMGRPY0

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## Taking eOwnership - Subsequent to electronic filing using a supported digital certificate

- Unpublished e-filed applications using a supported digital certificate
  - Both the e-filing and ePCT digital certificates must match
  - Enter the confirmation code in the bottom right-hand corner of Form PCT/IB/301
  - eOwnership automatically assigned

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer <b>Bardini Ann</b> e-mail pt04.pct@wipo.int Telephone No. +41 22 338 74 04
Facsimile No. +41 22 338 82 70 Form PCT/IB/301 (July 2010)	I/EYK64AFLSN7PW0

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## Taking eOwnership

### Paper or non-supported digital certificate (1)

- Applications filed on paper or filed electronically with a non-supported digital certificate
- Search for application outside of your Workbench and select reason “Request access rights”

WORKBENCH

CREATE NEW IA FIND IA OUTSIDE OF MY WORKBENCH

Current IAs Draft IAs Draft Actions Unpublished Published Archived Search

Filter Applied | Save filter | Download list | Columns | Show rows (ALL)

FIND IA OUTSIDE OF MY WORKBENCH

International Application Number \* International Filing Date \*

Reason \*  
Request Access Rights

Cancel Search IA

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## Taking eOwnership

### Paper or non-supported digital certificate (2)

- Enter confirmation code indicated on Form PCT/IB/301 (unpublished applications only) or on Form PCT/IB/345 (applications containing Rule 92bis requests and published applications)

REQUEST ACCESS RIGHTS

The access rights confirmation code can be found in the bottom right-hand corner of Form PCT/IB/301, or on Form PCT/IB/345 if a new confirmation code was already requested from the International Bureau.

Access rights confirmation code \*

Cancel Confirm

- This will trigger an online form for the International Bureau to approve or reject the request for access rights
- You will receive an e-mail notification once the request for access rights has been processed by the International Bureau

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## Sharing of Access Rights – eHandshake (1)

- First step in providing access to PCT applications
- Consists in the association and trusted recognition between different WIPO User Accounts with strong authentication
- eHandshakes do not directly result in shared access rights which have to be specifically assigned (default access rights options can be pre-defined)
- eHandshakes are managed within your WIPO account (select “My Account” from the drop-down menu next to your name)

## Sharing of Access Rights – eHandshake (2)

- Shortcut link to eHandshake screen available when editing access rights

The screenshot shows a web interface titled "ACCESS RIGHTS". At the top, there are two buttons: "Current Access Rights" and "History". Below these is a table with two rows of user information. A red rectangular box highlights a message above the table: "To assign rights to another person you must first have established an eHandshake".

ACCESS RIGHTS	
<div style="border: 1px solid red; padding: 2px;">To assign rights to another person you must first have established an eHandshake</div>	
PIRIOU PASCAL eOwner	▼
ana mena[eHandshake user] eOwner	▼

## Sharing of Access Rights – eHandshake (3)

### ■ Request new eHandshake

- If you know the associate's customer ID, enter it in the corresponding field

**REQUEST NEW eHANDSHAKE**

Enter the Customer ID of the user to whom you want to send an ehandshake request.

Customer ID \*  
user\_US\_DOE\_JANE\_1234

- If you do not know the associate's customer ID, send yours by e-mail so that the associate can initiate the process

**INITIATE eHANDSHAKE**

Your Customer ID is **user\_GB\_BARDINI\_ANN\_7884**. Send Customer ID by e-mail to an associate to initiate an ehandshake request

## Types of Access Rights

### ■ eOwner

- Complete control over all aspects of the PCT application in ePCT
- May be the applicant, agent or other individual (e.g., paralegal, assistant, secretary) who actually filed the PCT application, or another individual to whom access rights were granted by an existing eOwner

### ■ eEditor

- Can do everything except assign access rights

### ■ eViewer

- “Look” but don’t “Touch”

## Assigning + Managing Access Rights (1)

- An eOwner can assign/modify/remove access rights of others via the Workbench (e.g. for multiple applications) or via the “Access Rights” of each application

Name	Granted On	Granted By	Rights
Alex Baudouin <a href="mailto:alex.baudouin@epo.ch">alex.baudouin@epo.ch</a> Original eHandshake user	14 Dec 2016	Alex Baudouin	eOwner
Raphaël BÉGIN-SHACHAR <a href="mailto:rshachar@epo.ch">rshachar@epo.ch</a> eHandshake user	14 Dec 2016	Alex Baudouin	eEditor
Agnès BLANC <a href="mailto:agnès.blanc@epo.ch">agnès.blanc@epo.ch</a> eHandshake user	14 Dec 2016	Alex Baudouin	eOwner

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## Assigning + Managing Access Rights (2)

- Access rights can be managed for multiple applications at the same time, including removal of all ePCT access rights for an eHandshake user in one step via your eHandshakes screen
- Access rights can be automatically assigned to a default group of eHandshake users
- Best practice - always have **at least 2 eOwners** to facilitate access rights management
- Access rights should be removed for ePCT users no longer requiring access (e.g., change of applicant, change of agent, departure, etc.)
- Full history of all access rights modifications is available

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## Signatures (1)

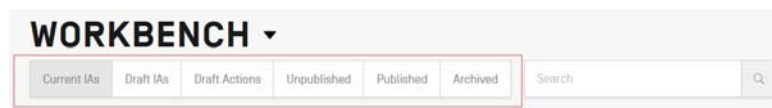
- ePCT access rights holders (eOwner or eEditor) are different from authorized signatories (applicant or agent)
- Applicant or agent may not necessarily be an eOwner or eEditor
- Applicant or agent signatures are required for ePCT-Filing and other PCT transactions, e.g., Rule 92*bis* changes, filing of Chapter II demand, Article 19 amendments, withdrawals
- Signatures may be applied in the form of a text string or by uploading an image file

## Signatures (2)

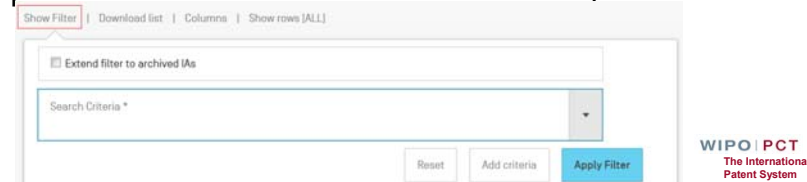
- It is also possible to indicate that the signature of an authorized signatory appears in an attached document
- 'External signature' process allows someone without ePCT access to apply their signature to a document prepared using ePCT (e.g., where the attorney does not have access to ePCT but needs to approve and sign a document prepared by a paralegal who uses ePCT)
- Possibility to add more than one signature in ePCT actions for withdrawal of the international application, priority claim, designation/election, Chapter II demand and SIS request
- Possibility to check a box to confirm that signatures of applicants are already on file

## Workbench (1)

- List of all PCT applications to which you have access rights (eOwner, eEditor, eViewer)
- The Workbench contains 6 pre-defined shortcut filter buttons to display applications as per their status



- Many combinations of filters can be applied and it is possible to save filter combinations for repeat use



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## Workbench (2)

- The Workbench columns can be re-arranged by dragging/dropping; customize columns to show/hide
- Workbench list can be downloaded to a spreadsheet
- Select one or more applications to reveal a bar that gives access to functions such as manage access rights, archiving and organizing applications into Portfolios



- Clicking on the IA number, file reference or 'My rights' link will open up a detailed file view

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## Viewing a PCT application

- Shortcut links for navigating to each section

The screenshot shows the WIPO ePCT interface for application 1234567 PCT/IB2017/080020. The top navigation bar includes links for DATA, DOCUMENTS, ACTIONS, ACCESS RIGHTS, TIMELINE, and HISTORY. Below the application number, there is a table with the following data:

IA Status Not yet Published	Int. Filing Date 23 Jan 2017	ISA/EP Search copy not yet sent
Applicant(s) ABC COMPANY (+1)		
Inventor(s) SMITH, John		
Portfolio	Team at IB PCT R0/IB Team	Language of Filing EN

Below the table is a vertical list of navigation links: DATA, DOCUMENTS, ACTIONS, ACCESS RIGHTS, TIMELINE, and HISTORY.

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## Dropdown menu on IA number

- Gives quick access to a number of useful functions

The screenshot shows the WIPO ePCT interface for application A10RIADH PCT/IB2017/080337. The top navigation bar includes links for DATA, DOCUMENTS, ACTIONS, ACCESS RIGHTS, TIMELINE, NATIONAL PHASE, and HISTORY. Below the application number, there is a table with the following data:

Int. Filing Date 07 Nov 2017
Team at IB PCT R0/IB Team

A dropdown menu is open, listing the following functions:

- Archive
- Add to Portfolio
- Warning Message
- My Comments
- Clone IA
- View draft IA as filed via ePCT
- IA Status Report (PDF)
- IA Status Report (XML)
- History
- Add bookmark

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## Data

- Up-to-date bibliographic data for the PCT application being viewed
- Information about the target date for international publication/republication and preview of bibliographic data in publication front page layout
- Where the language of filing of a PCT application is in Arabic, Chinese, Japanese, Korean or Russian, bibliographic data are available in those languages in addition to the English transliteration
- Data are available as “IA Status Report” (IASR) in PDF or XML format

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## Documents (1)

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

DOCUMENTS			
RECORD AS HELD BY THE IB			
Documents (Doc ID)	Source	Status	Date
Efiling Transmission Receipt (11)	ePCT	Processed	06 Mar 2017
ePCT Message (03)	IB	Not yet processed	06 Mar 2017
Application Body as Filed (21)	ePCT	Not yet processed	06 Mar 2017
DOCUMENTS FOR ISA/EP			
Documents (Doc ID)	Source	Status	Date
ePCT Cover Letter (10)	ePCT	Copy as received	07 Mar 2017
Request for Rectification (11)	ePCT	Copy as received	07 Mar 2017
DOCUMENTS FOR IPEA/EP			
Documents (Doc ID)	Source	Status	Date
Chapter II Demand for IPEA (13)	ePCT	Copy as received	07 Mar 2017
ePCT Cover Letter (12)	ePCT	Copy as received	07 Mar 2017

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## Documents (2)

- Click on 'More' to view indications about the status and public availability of each document type in PATENTSCOPE, plus audit trail information, where available

▼ RECORD AS HELD BY THE IB

Documents (Doc ID) ▾	Source ▾	Status ▾	PATENTSCOPE ▾	Date ▾	View	More
Validation Log [7]. 1 page	ePCT	Not yet processed	Pending process...	02 May 2...	View	More
IB/1011 Request form [6]. 3 pages	ePCT	Not yet processed	Pending process...	02 May 2...	View	More
Fee Calculation Sheet [5]. 1 page	ePCT	Not yet processed	Pending process...	02 May 2...	View	More

Document : Fee Calculation Sheet[S]  
 Status : Not yet processed  
 Available on PATENTSCOPE : Pending processing  
 View document as it will be rendered at the IB

02 May 2019 Ann BARDINI Import

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## Documents (3)

- 'Upload' shortcut button to ePCT Action to 'Upload documents' (mostly PDF format) to the IB and also to participating Offices in capacity as RO, ISA, IPEA

- Types of document selectable for upload depend on the recipient selected
- A cover letter is automatically generated – user can type a comment to be included in the cover letter

Simple, secure alternative to sending documents by mail  
*(fax transmissions to the IB no longer recommended since January 1, 2018)*

- Current date and time at the *recipient* Office is displayed in the interface and is set as the date of receipt of uploaded documents
- After upload, documents are visible under Documents and the recipient Office is notified by the system

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## Upload Documents – Priority Document

- Upload of digitally signed priority documents
  - Available only for priority documents issued in electronic format by BR, PT and US

## Actions (1)

- Full suite of Actions only when using ePCT with strong authentication and with eOwner/eEditor access rights

▼ ACTIONS

Select Action

Action \*

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

## Actions (2)

- The user benefits from pre-filled bibliographic data and automated validations to avoid errors; time limit checks
- Data and documents submitted through “Actions” are directly imported for processing with no need for retyping (reduces potential transcription errors)
- “Actions” are subject to review by the recipient (the IB or any participating Offices in capacity as RO, ISA, IPEA)
- “Actions” should be used instead of the equivalent document upload
- Option to save “Actions” as a draft only with strong authentication

## Actions (3)

- “Action” for Article 19 amendments
  - Option always appears but can only be used if the ISR has been received by the IB and time limit has not expired (also available when using ePCT without strong authentication provided that the application has been published)
  - Can only be uploaded in DOCX or text-based PDF format
  - DOCX files converted to XML using online converter (templates and samples are provided)
  - Accompanying letter can be prepared online
- Output of Actions is always rendered in language of publication of the application (regardless of language of interface)

## Time Line

- Date and time in Geneva, Switzerland, is displayed at the top of the screen to facilitate awareness of deadlines
- Graphical representation of PCT time limits
- Summary of key dates
- E-mail alerts for most of these time limits can be set up in Notification Preferences

## History

- List of actions taken by all ePCT users for the PCT application
  - Filter option
- Default view is for the last one week period
- Similar 'My History' function is available via the dropdown menu next to your name in the ePCT header which lists only your actions taken in ePCT in respect of any international application



## Notifications

### ■ Preferences

- Specify the events in the lifecycle of a PCT application for which you want to receive notifications
- Method (e-mail, Notifications list, or both) and type of notifications

### ■ Filters

- Received date, read date, unread, date range

### ■ Clearing of notifications from the list

### ■ Only most recent 1000 notifications are stored

## Portfolios

### ■ User-defined, personal 'virtual folders' for grouping PCT applications

### ■ Portfolios are basically filters for viewing PCT applications in groups that are meaningful for the user who defines them

### ■ Deletion of PCT applications from a Portfolio or deletion of the Portfolio itself only deletes the virtual grouping, not the applications themselves

### ■ Switch between the Workbench view and Portfolio-based view of your applications

## Future Developments

- Extension of ePCT-Filing to other receiving Offices
- Machine-to-machine functionality
- Extend the online payment function to other types of fees for the IB (post-filing)

## ePCT in DEMO mode

- [pctdemo.wipo.int](http://pctdemo.wipo.int)
- Demo environment in which you can practice and familiarize yourself with ePCT
- Do not use confidential or sensitive data in the ePCT demo environment

## Need help with ePCT – SUPPORT (1)

- Use the “SUPPORT” link in the ePCT header
- PCT eServices
  - Tel: +41-22-338-9523
  - E-mail: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)
  - Monday to Friday, 9am-6pm Geneva time

## Need help with ePCT – SUPPORT (2)

- FAQs and user documentation
  - Database of help info
  - Live Chat (during business hours) available via FAQ answers and CONTACT US
- Webinars on ePCT
  - [www.wipo.int/pct/en/seminar/webinars/index.html](http://www.wipo.int/pct/en/seminar/webinars/index.html)



## The International Searching Authority (1)

- Checks unity of invention (Rules 13 and 40)
- Checks title (Rule 37); checks abstract (Rule 38)
- Searches claimed invention (Article 15(3), Rule 33.3)
- Authorizes rectification of obvious mistakes if the mistake is:
  - in any part of the international application other than the request, (Rule 91.1(b)(ii)) or
  - in any paper submitted to that Authority (Rule 91.1(b)(iv))

## The International Searching Authority (2)

- Establishes international search report (ISR) (Rules 42 and 43) and/or declaration that no international search report will be established (Article 17(2))
- Establishes written opinion of the ISA (Rule 43*bis*): non-binding first opinion on novelty, inventive step (non-obviousness) and industrial applicability of claimed invention

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## International Searching Authorities (23 in total)

- |                  |   |
|------------------|---|
| ■ AT – Austria   | ■ KR – Republic of Korea  |
| ■ AU – Australia | ■ PH – Philippines  |
| ■ BR – Brazil    | ■ RU – Russian Federation   |
| ■ CA – Canada    | ■ SE – Sweden   |
| ■ CL – Chile     | ■ SG – Singapore  |
| ■ CN – China     | ■ TR – Turkey   |
| ■ EG – Egypt     | ■ UA – Ukraine  |
| ■ ES – Spain     | ■ US – United States of America   |
| ■ FI – Finland   | ■ EP – European Patent Office   |
| ■ IL – Israel    | ■ XN – Nordic Patent Institute<br>(Denmark, Iceland, Norway)                          |
| ■ IN – India     | ■ XV – Visegrad Patent Institute (VPI)<br>(Czech Republic, Hungary, Poland, Slovakia) |
| ■ JP – Japan     |   |

Receiving Office decides on which ISAs is/are competent

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## Prior art for international search (Article 15(2) and Rule 33)

### ■ Prior art:

- everything which has been made available to the public,
- anywhere in the world,
- by means of written disclosure,
- which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step,
- provided the making available to the public occurred prior to the international filing date.

### ■ PCT Minimum Documentation (Rule 34)

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## International Search Report (ISR) (Rules 42 and 43)

### ■ Contains:

- IPC (International Patent Classification) symbols
- indications of the technical areas searched
- indications relating to any finding of lack of unity
- a list of the relevant prior art documents
- indications relating to any finding that a meaningful search could not be carried out in respect of certain (but not all) claims

### ■ Time limit to establish ISR and written opinion of the ISA:

- 3 months from the date of receipt of the search copy by the ISA (usually within approximately 16 months from the priority date if priority is claimed); or
- 9 months from the priority date, whichever time limit expires later

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## Cases where no international search report will be established (1)

- The application relates to a subject matter which the ISA is not required to search, and in the particular case decides not to search (Article 17(2)(a)(i) and Rule 39.1)
- The description, claims or drawings do not comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out in respect of any of the claims (Article 17(2)(a)(ii))
- The application contains the disclosure of a nucleotide and/or amino acid sequence, but:
  - no listing of that sequence is furnished,
  - the listing furnished does not comply with the Standard set out in Annex C of the Administrative Instructions or is not in electronic form (Rule 13*ter*.1(d)), or
  - the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13*ter*.1(d))

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## Cases where no international search report will be established (2)

- Consequences:
  - the ISA will declare that no international search report has been established and that declaration will be published as part of the published international application (Rule 48.2(a)(v))
  - the application remains valid but the IPEA will not be obliged to carry out the international preliminary examination for lack of an international search report (Rule 66.1(e))

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## Written opinion of the ISA (Rule 43bis) (1)

- Initial preliminary non-binding opinion on:
  - novelty (not anticipated)
  - inventive step (not obvious)
  - industrial applicability
- A written opinion will be established for all international applications at the same time as the ISR
- The written opinion is sent to applicant and the International Bureau together with the ISR

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## Written opinion of the ISA (Rule 43bis) (2)

- The written opinion is made publicly available on PATENTSCOPE in its original language as of the date of publication of the international application
- No formal procedure for applicants to respond to written opinion of the ISA
- Possibility to submit informal comments to the International Bureau
  - They are made publicly available together with the written opinion in their original language
  - They are communicated to the DOs together with the IPRP (Chapter I) if and when it is sent
- Note: The IPRP Chapter I and its translation are established at 30 months from the priority date

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## Prior art for written opinion of the ISA (Rules 43bis.1(b) and 64.1)

- Prior art:
  - same as for international search purposes; BUT:
  - relevant date: everything made available to the public prior to the priority date
- The ISA may request a copy of a priority document from the International Bureau (Rule 66.7(a)); however, even if, at the time of establishment of the written opinion of the ISA, a copy cannot be made available to the ISA, the written opinion will nevertheless be established on the assumption that the priority date is the relevant prior art date, except if the applicant had failed to comply with his obligations under Rule 17.1

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## International preliminary report on patentability (IPRP) (Chapter I of the PCT) (Rule 44bis)

- If applicant does not file a demand for international preliminary examination:
  - IB establishes the IPRP (Chapter I) on the basis of the written opinion of the ISA
  - IPRP (Chapter I) and its translation
    - are sent to designated Offices
    - are made publicly available on PATENTSCOPE (but not “published” like the international application and ISR) at the expiry of 30 months from the priority date

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## Use of the written opinion of the ISA for the purposes of the Chapter II procedure (Rule 66.1 *bis*)

- If applicant files a demand for international preliminary examination:
  - written opinion of the ISA becomes written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain ISAs)
  - informal comments by applicant on written opinion of ISA will not be sent to IPEA (Article 34 amendments/arguments only)
  - if an international preliminary examination report is established, any informal comments submitted to the IB will not be sent to DOs or EOs



## Objectives

- To address PCT applicants' concerns about new prior art being found once they have already incurred significant costs and entered national phase
- To reduce this risk by introducing optional supplementary searches in the PCT international phase
- To expand the scope of search in the international phase taking into account the growing linguistic diversity in prior art

## Main Features

- An optional service for applicants,
  - it is currently offered by: AT, EP, FI, RU, SE, SG, TR, UA, XN and XV
  - more Authorities are expected to offer SIS in the future
- An applicant can request supplementary search by any Authority offering this service, except the one responsible for main international search
- Each Authority determines the scope and fees for its supplementary search
- Supplementary international search (SIS) covers only one invention – there is no option for paying additional fees

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## Deciding When to Use the Service (1)

- The main international search report is intended to be of a high quality, sufficient for normal purposes
- Consequently, this service need not be used for every international application, but to give extra information in some cases where the applicant believes that this additional expense in the international phase will be worthwhile
- Before requesting supplementary search, applicants should consider:
  - the main international search report
  - the commercial value of particular application
  - the number of disclosures relevant to the particular technical field which are known to be made in languages that are not a speciality of the main ISA

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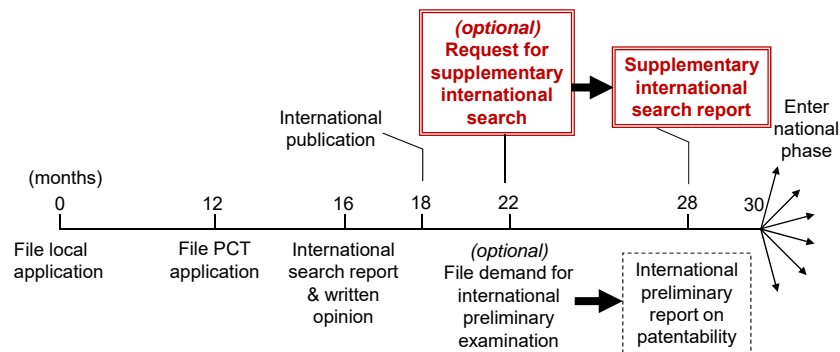
## Deciding when to Use the Service (2)

- Interest in a search being carried out by a particular International Authority (free choice of SISA)
- Interest in a search being carried out in prior art documents in a particular language
- Interest in a particular subject matter not searched by the main ISA in accordance with Article 17(2) (e.g. methods of treatment, Rule 39.1(iv))

## Timing and Fees

- The supplementary search request must be filed with the **International Bureau** within 22 months from the priority date
- Fees must be paid in **Swiss francs within 1 month** of filing the request:
  - supplementary search fee\*
  - supplementary search handling fee\*
- The Authority begins SIS on receipt of the SIS request and international search report (ISR) (at the latest at 22 months from the priority date, even if the main ISR has not yet been received)
- The SIS Report is established by 28 months from the priority date

## SIS in the PCT System



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## Supplementary Search Request (1)

- The request must be filed using the supplementary search request Form PCT/IB/375, specifying
  - which Authority is to carry out the supplementary search
  - (in certain circumstances - see Unity of Invention) which claims are to be searched
  
- The request may need to be accompanied by:
  - a translation of the international application into a language accepted by the Authority\*
  - any sequence listing in electronic format\*

\* (see *PCT Applicant's Guide*, Annex SISA)

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## Supplementary Search Request (2)

- There is no requirement that an agent be appointed to represent the applicant before the Authority specified for supplementary international search; applicants may, however, appoint an agent if they so wish
- A late payment fee may also apply if fees are not paid within one month and the IB issues an invitation to pay fees (Form PCT/IB/377)
- The request is considered withdrawn if the fees for supplementary search are not paid

## Unity of Invention

- Only one invention is searched – there is no option of paying additional fees for additional inventions
- Usually the first claimed invention is searched, but if the main ISA has found lack of unity of invention, the applicant may request supplementary search to focus on an invention other than the first
  - note that the Authority is not obliged to search inventions which have not been searched by the main ISA (Rule 45bis.5(d))
- The Authority is not obliged to follow the views of the main ISA on unity of invention
- A review procedure is available which is similar to the “protest” procedure for the main search

## Scope of Search (1)

- Supplementary search is carried out on the claims as filed, usually on the first claimed invention (Article 19 and 34 amendments are not taken into account)
- The Authority is not required to search:
  - subject matter which it would not normally search in accordance with Article 17(2)
  - claims which have not been searched by the main ISA
  - any international application which is subject to a limitation set out in the Agreement between WIPO and the Authority defining the scope of their service (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html))
    - limitation of number of supplementary searches carried out
    - limitation of number of claims searched

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## Scope of Search (2)

- The range of prior art to be searched is determined by the Authority
  - the search may be either a new search which takes into account all PCT minimum documentation as well as documents held in other languages by that Authority or
  - the search may be a complement to the main search, typically including a subset of language-related documentation held by that Authority

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## Services currently available (1)

- SISA/AT: three search options
  - search of only the German-language documentation
  - search of only the European and North American documentation
  - search of only the PCT minimum documentation
- SISA/EP: search of the PCT minimum documentation as well as documents held in its search collection
- SISA/FI and SISA/SE: search of the PCT minimum documentation as well as documents in Danish, Finnish, Norwegian and Swedish held by the Authority

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## Services currently available (2)

- SISA/RU: two search options
  - search of only the Russian language documentation and certain other patent documentation of the former Soviet Union and CIS States
  - for applications where the main ISA has made an Article 17(2)(a) declaration because of subject matter referred to in Rule 39.1(iv) (methods of treatment): the PCT minimum documentation, plus the above
- SISA/SG: search of the PCT minimum documentation as well as documents in English and Chinese held by the Authority
- SISA/TR: search of the PCT minimum documentation as well as documents in Turkish held by the Authority

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## Services currently available (3)

- SISA/UA: three search options
  - search of only the PCT minimum documentation
  - search of only the Russian language documentation of the former USSR and the Ukrainian language documentation
  - search of only the European and North American documentation
- SISA/XN: search of the PCT minimum documentation, as well as documents in Danish, Icelandic, Norwegian and Swedish held by the Authority
- SISA/XV: two search options
  - search of only the documents in Czech, Hungarian, Polish and Slovak held by the Authority
  - search of the PCT minimum documentation as well as documents in Czech, Hungarian, Polish and Slovak held by the Authority

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## Supplementary International Search Report

- The supplementary international search report (Form PCT/SISA/501) is very similar to the ISR, but:
  - it does not contain the classification of the international application or comments on the title and abstract
  - it need not contain citations of documents contained in the ISR unless cited in conjunction with a new reference not cited in the ISR
  - it may contain explanations regarding:
    - citations that are considered relevant (these are more detailed than references in the ISR)
    - the scope of the SIS (particularly where the ISR is late and assumptions have been made on the likely scope of main search)
- No written opinion is issued with the supplementary international search report

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## Further Processing of Report

- The supplementary international search report is transmitted to the applicant and to the IB
- The IB makes the report publicly available (if the international application has been published)
- If the report is not in English, it will be translated into English by the IB
- The IB sends the report and translations, where appropriate, to the IPEA and designated Offices

## Refunds When No Search Is Carried Out

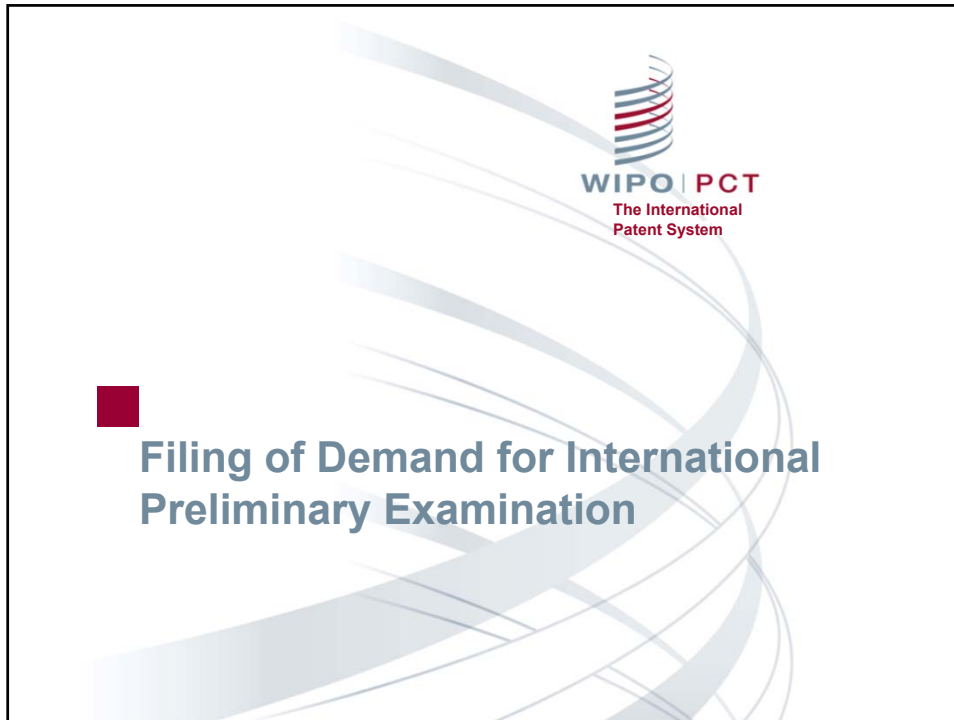
- If the Authority **commences** work, but **no** search is carried out:

- for reasons equivalent to those available for the main international search (subject matter, lack of clarity or lack of sequence listing in electronic format) or
- because the main ISA has made an Article 17(2)(a) declaration

the supplementary search fee **will not** be refunded

- because of limitations specific to the scope of the service offered by the Authority, the supplementary search request is considered not to have been submitted and

the supplementary search fee **will** be refunded



## What is a demand?

- The demand is a request for International Preliminary Examination under Chapter II of the PCT
- International Preliminary Examination is an optional procedure that provides for continued examination of the PCT application before an International Preliminary Examining Authority (IPEA)
- Filing a demand constitutes the automatic “election” of all designated PCT Contracting States

## Why file a demand? (1)

- Provides an opportunity during international preliminary examination to make amendments to the description, claims and drawings
- Can submit arguments to address patentability objections raised by the ISA
- International preliminary examination is the final opportunity to obtain a more positive patentability assessment during the international phase

## Why file a demand? (2)

- Results in the establishment of an International Preliminary Report on Patentability (Chapter II)
- Likelihood of more favorable treatment in the national phase on the basis of a positive patentability report

## Who is entitled to make a demand? (Article 31(2)(a) and Rule 54.2)

The applicant, or if there are two or more applicants, at least one of them,

- who is a resident or national of a PCT Contracting State, and
- whose international application has been filed with a receiving Office of or acting for a Contracting State (currently all States)

## The demand form

- ePCT
- Electronic filing software provided by the IPEA
- Printed demand form (PCT/IPEA/401)
- Computer-generated demand (Rule 53.1(a) and Section 102(h) and (i))
  - Same requirements regarding layout and contents as for request form

## The demand for international preliminary examination: contents (Rule 53)

- The demand must contain the following indications:
  - a petition
  - particulars enabling the international application to be identified (for example, the international application number)
  - the name of the applicant(s) under Chapter II
  - where appropriate, the name of the agent
  - the basis on which international preliminary examination should be carried out (a statement concerning amendments)
  - the language for the purposes of international preliminary examination
  - the signature of (at least one of) the applicant(s) or of the agent

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## Signature of demand (Rule 53.8)

- Only the persons indicated as applicants for the States elected in the demand need to sign the demand
- If these applicants have appointed an agent or a common representative, that agent or common representative may sign
- If there is no appointed agent or common representative, it is sufficient that the demand is signed by at least one of the applicants (see Rule 60.1(a-ter))
- Note that some Authorities do not require that a separate power of attorney or a copy of a general power of attorney is furnished (Rules 90.4 and 90.5)

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## Where to file the demand? (Rule 59) (1)

- Directly with the competent IPEA
  - specified by the RO
  - if more than one is specified by the RO, applicant has the choice
- In making his choice, the applicant must take into account
  - the language(s) accepted by the IPEA
  - that some IPEA(s) accept only international applications which have been searched by certain ISAs (that is the case, for example, of IPEA/EP)

## Where to file the demand? (Rule 59) (2)

- If the international application was filed with IB as RO, the competent IPEAs will be those which would have been competent if the international application had been filed with (any of) the national Office(s) which, on the basis of applicant's nationality or residence, could be a competent RO
- Choice of IPEA should be indicated in the demand



## Transmittal of demand to competent IPEA (Rule 59.3)

- Where a demand is submitted to a non-competent IPEA or to a RO, an ISA or the IB, that Authority or Office must:
  - mark the date of receipt on the demand and,
  - either forward it to the IB, which will in turn transmit it to the competent IPEA (or, if more than one, to the competent IPEA chosen by the applicant)
  - or transmit it directly to the competent IPEA (or, if more than one, to the competent IPEA chosen by the applicant)
- Any demand so transmitted to the competent IPEA will be considered to have been received on behalf of that Authority on the date on which it was received by the RO, ISA or IB or the non-competent IPEA concerned

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## When should a demand be filed? (Rule 54bis.1(a)) (1)

- At any time prior to the expiration of whichever of the following periods expires later:
  - 3 months from the date of transmittal of the ISR and WO of the ISA
  - 22 months from the priority date
- In respect of designated Offices for which the 20-month time limit under Article 22(1) continues to apply, prior to the expiration of 19 months from the priority date, in order to delay national phase from 20 to 30 months from the priority date
  - Only applies to LU and TZ

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## When should a demand be filed? (Rule 54bis.1(a)) (2)

### ■ Recommendation:

Upon receipt of the international search report and the written opinion of the ISA, evaluate the cited prior art documents and decide whether to proceed further, and if so, file the demand as soon as possible thereafter together with any amendments/arguments in light of the written opinion, thus allowing maximum time prior to issuance of international preliminary examination report (i.e, usually 28 months from the priority date)

## Defects under Chapter II (1)

- Defects whose correction results in a later filing date of the demand
  - no eligible applicant for filing the demand (Rule 54.2)
  - international application not identifiable (Rule 60.1(b))
- A demand filed after the expiration of 19 months from the priority date but within the applicable time limit under Rule 54bis.1(a), is valid but entry into the national phase will not be postponed until 30 months (Article 39(1)(a)) for LU and TZ

## Defects under Chapter II (2)

- Defects which can be corrected without any adverse consequences:
  - demand not filed with a competent IPEA (Rule 59.3)
  - form of the demand (Rule 53.1)
  - indications relating to applicants and agents (Rules 53.4 and 53.5)
  - language of the demand (Rule 55.1)
  - lack of at least one signature (Rules 53.8 and 60.1(a-ter))
  - amendments under Article 34 referred to but not furnished (Rule 53.9(a)(i))

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## ePCT and the filing of a demand

- ePCT **with** strong authentication can be used to prepare and file a demand
- Fields are automatically populated
- Automatic validations are done at the time of preparation
- All accompanying documents may be attached, e.g., Article 19 amendments, Article 34 amendments, translations, etc.
- The International Bureau automatically transmits the demand to the competent IPEA
- Fees and all subsequent correspondence are to be submitted directly to the IPEA

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## Chapter II correction procedure

- Invitation by the IPEA to correct defects (Rule 60.1)
- Invitation by the IPEA to pay missing fees (Rule 58*bis*)
- Further possibilities:
  - request rectification of obvious mistakes before IPEA (Rule 91)
  - request review by and use opportunity to correct before the designated or elected Offices (Articles 25, 26 and 39(3))



## International preliminary examination (1)

- Results in the establishment by the IPEA of a non-binding opinion on
  - novelty (not anticipated) (Article 33(2) and Rule 64)
  - inventive step (not obvious) (Article 33(3) and Rule 65)
  - industrial applicability (Article 33(4))
- International preliminary examination provides an opportunity to make amendments and to address patentability issues raised by the ISA

## International Preliminary Examination (2)

- Only claims relating to the invention(s) searched by the ISA will be examined by the IPEA (Rules 66.1(e) and 66.2(a)(vi))

## Start of international preliminary examination (Rule 69.1)

- When the IPEA is in possession of:
  - the demand
  - the international search report (or the declaration under Article 17(2)(a)) and the written opinion of the ISA
  - the preliminary examination and handling fees

it does not wait for the expiration of the applicable time limit under Rule 54*bis*.1(a) unless the applicant expressly requests postponement
- If the demand contains a statement about amendments, when copies of these amendments are available (see Rule 69.1(c), (d) and (e))
- If international preliminary examination is to be carried out on the basis of a translation of the international application, when that translation is available (see Rule 55.2(c))

## Finding of lack of unity of invention (Rule 68)

- Same criteria as for international search (Rule 13 and paragraphs 10.20 to 10.59 of the International Search and Preliminary Examination Guidelines)
- Invitation by the IPEA to restrict the claims or to pay additional fees (which can be paid under protest)
- Applicant can select invention as “main invention” and those inventions for which additional fees are paid

## Prior art for IPE (Rule 64.1) (1)

- What is considered prior art?

Everything made available to the public anywhere in the world by means of written disclosure (including drawings and other illustrations) provided that such making available occurred prior to the relevant date

## Prior art for IPE (Rule 64.1) (2)

### ■ What is the relevant date?

- the date of the earlier application of which priority is claimed unless the IPEA considers that the priority claim is not valid for reasons other than the fact that the international filing date is later than the date on which the priority period expired, but is within two months from that date; or
- the international filing date of the international application in all other cases

## Mandatory top-up search (Rule 66.1 *ter*)

- Aims at uncovering any prior art not available at the time when the ISR was established, in particular “secret” prior art (patent applications published on or after the date of establishment of the ISR but which have an earlier priority date)
- Exceptions:
  - Only in respect of claims for which the IPEA establishes an IPRP Chapter II
  - Where a search would serve no useful purpose, e.g. where the IPEA considers that the documents cited in the ISR are sufficient to demonstrate lack of novelty of the entire subject matter



## Written opinion of IPEA (Rules 66.2 and 66.6)

- The written opinion of the ISA is considered to be the written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain other ISAs)
- Where the written opinion of the ISA is taken as the written opinion of the IPEA, no second written opinion has to be issued
- If a second written opinion is issued, the applicant may respond within the time limit fixed in that second written opinion
- Possibility to request an interview with the examiner at the IPEA (Rule 66.6)

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## The international preliminary report on patentability (Chapter II) (1)

- Must be established by the IPEA within:
  - 28 months from the priority date
  - 6 months from the time provided under Rule 69.1 for the start of the international preliminary examination
  - 6 months from date of receipt by IPEA of translation under Rule 55.2,whichever expires last (Rule 69.2)

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## The international preliminary report on patentability (Chapter II) (2)

### ■ May contain “annexes” (Rule 70.16):

- replacement sheets containing amendments under Art. 19 or Art. 34 and any letter indicating the basis for the amendments
- replacement sheets containing rectifications of obvious mistakes authorized under Rule 91 by the IPEA and accompanying letter
- when referred to in the report, any sheet and letter concerning the rectification of an obvious mistake which has not been taken into account because it was not available in time (Rule 66.4*bis*)

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## The international preliminary report on patentability (Chapter II) (3)

### ■ May contain “annexes” (Rule 70.16):

- earlier amendments when later amendments are not used as a basis for the report because they are
  - considered to go beyond the disclosure in the international application or
  - not accompanied by a letter indicating the basis for the amendments
- Not annexed to the report: any other correspondence or copies of amendments superseded by later amendments

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## The international preliminary report on patentability (Chapter II) (4)

- No provisions for appeal or further proceedings during the international phase before the International Authorities
- Sent to the applicant and the IB (Rule 71.1)
- IB forwards copies of the report, and any required translation of the report into English (prepared by the IB), to the elected Offices (Article 36(3)(a) and Rule 72.1)
- The annexes are not translated by the IB (Article 36(3)(b))

## The international preliminary report on patentability (Chapter II) (5)

- Calls attention to:
  - non-written disclosures (see Rules 64.2 and 70.9)
  - certain published documents (see Rules 64.3 and 70.10)
- Shall cite (Rule 70.7):
  - all documents considered to be relevant for supporting statements made concerning claims
  - documents whether or not they are cited in the ISR
  - documents cited in the ISR when the IPEA considers them relevant

## Reasons for delays in international preliminary examination (1)

### ■ On the part of the applicant:

- late payment of fee(s)
- late correction of defects in the demand
- incomplete statement, in the demand, concerning amendments
- failure to attach amendments referred to in the statement
- late furnishing of any required translation of the international application or of amendments
- late response to invitation to pay additional examination fees in case of finding of lack of unity
- late response to written opinion
- failure to file replacement sheets containing amendments

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## Reasons for delays in international preliminary examination (2)

### ■ On the part of the ISA:

- late issuance of international search report

### ■ On the part of the IPEA:

- finding of lack of unity
- late issuance of written opinion

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

### ■ When?

Promptly after 18 months from priority date on the Internet  
(<https://patentscope.wipo.int>)

### ■ 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))

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## 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

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## International publication (4) (Article 21 and Rule 48)

- Omission of certain information from international publication (Rule 48.2)
  - Reasoned request by the applicant to the IB
    - Accompanied by replacement sheets and letter drawing attention to the differences between the replaced and the replacement sheet
  - Time limit for a request under Rule 48.2:
    - Completion of technical preparations for international publication
  - Information qualifies for omission from publication, if
    - it does not obviously serve the purpose of informing the public about the international application,
    - publication of such information would clearly prejudice the personal or economic interests of any person, and
    - there is no prevailing public interest to have access to that information

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## International publication (5) (Article 21 and Rule 48)

- Omission of certain information from international publication (Rule 48.2) (*continued*)
  - RO, ISA, SISA or IB may draw the applicant's attention to information which it believes would qualify for omission from international publication under Rule 48, and suggest to the applicant to make a request under Rule 48
  - If the IB grants a request under Rule 48, it also informs all Offices and Authorities which have that information in their files not to give access to that information either

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## 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 <https://patentscope.wipo.int/search/en/structuredSearch.jsf>
- Official notices (PCT Gazette) are available at [www.wipo.int/pct/en/official\\_notices](http://www.wipo.int/pct/en/official_notices)

## 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, *24 January 2019*, technical preparations are completed on Wednesday, *9 January 2019*

Consequently, any document that reaches the International Bureau on Tuesday, *8 January 2019*, 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 of technical preparations

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## 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)

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## Preventing publication of the international application (Rule 90bis.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

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## Preventing publication of the international application (Rule 90bis.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

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## Postponing publication of the international application (Rule 90bis.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

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## Postponing publication of the international application (Rule 90bis.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

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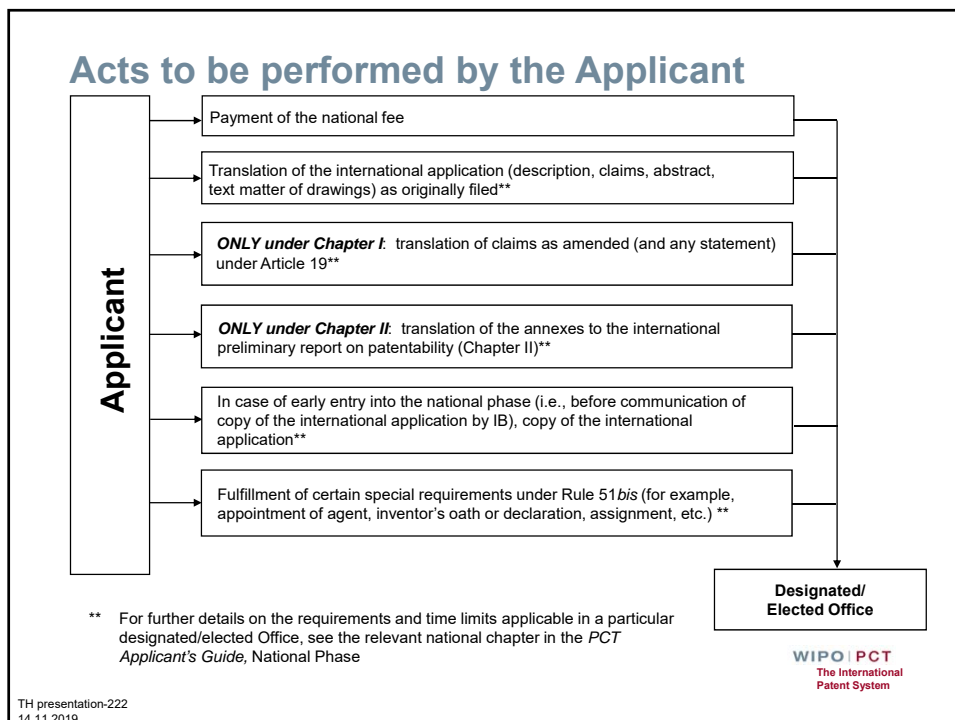
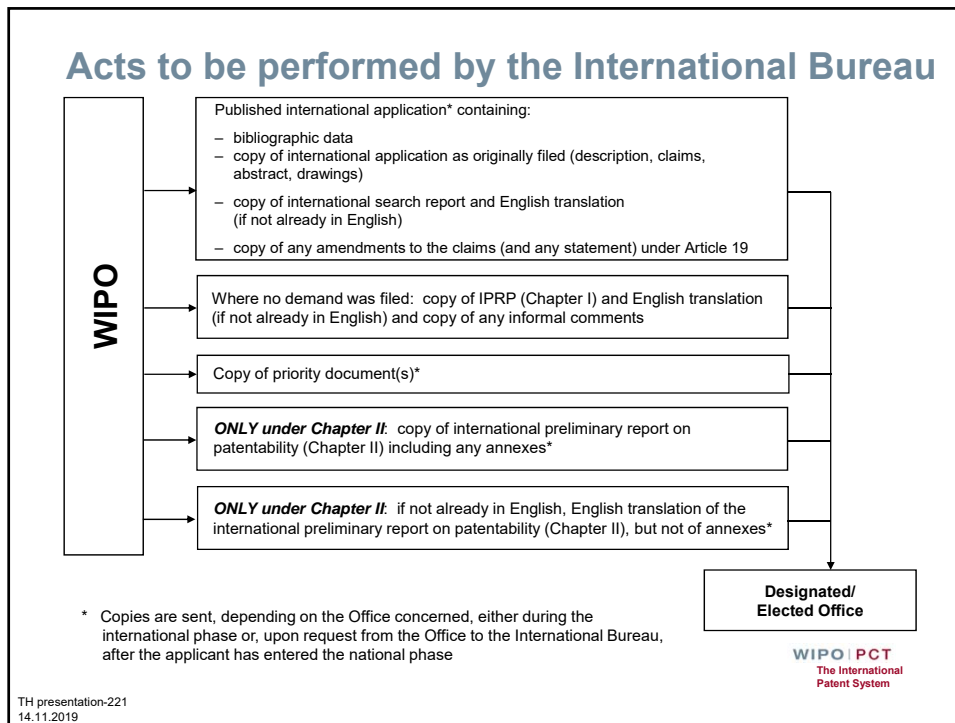
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## Decisions to be taken by the applicant

- 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



## Time limit for entry in the national phase

The time limit applies irrespective of possible delays in the international phase due to:

- late international search report and written opinion of the ISA
- international preliminary examination delayed
- late international preliminary report on patentability (Chapter II)
- late translation of international preliminary report on patentability (Chapter II)

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

- Requirements:
  - Translation, if applicable
  - Payment of national fee
  - Copy of international application in particular circumstances only
- Time limit under Art. 22(1): 30 months from the priority date
  - For additional time, see PCT Applicant's Guide, national phase summaries
  - For exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)
- Time limit under Art. 39(1)(a): 30 months from the priority date
  - For additional time, see PCT Applicant's Guide, national phase summaries

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## Special national requirements (Art. 27 and Rule 51*bis*.1)

- Time limit under Rule 51*bis*.3:
  - If requirements are not fulfilled within the time limit for entry into national phase under Art. 22 or 39:
    - Invitation by DO
    - At least 2 months from the invitation

## Examples of special requirements under Rule 51*bis*.1 (1)

- Oath or declaration by the inventor (US only):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by DO/EO/US unless that Office may reasonably doubt the veracity of the declaration
- Assignment documents (of the priority rights or of the application):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by the DO/EO unless that Office may reasonably doubt the veracity of the declaration



## Examples of special requirements under Rule 51 *bis*.1 (2)

- Translation of the priority document may only be required (Rule 51 *bis*.1(e)):
  - where the validity of the priority is relevant to the determination whether the invention is patentable
  - in cases of incorporation by reference
- Appointment of local agent and submission of power of attorney
- Translation or other documents relating to the international application in more than one copy
- Certified translation of the international application (only where the Office may reasonably doubt the accuracy of the translation)

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## National requirements simplified for PCT applications (1)

- Priority document
  - The applicant does not need to furnish the priority document since the IB transmits copies to the DO/EOs
  - If the DO/EO did not receive a copy of the priority document from the IB, it must request a copy from the IB (not from the applicant)
- Drawings
  - If the drawings do not contain any text matter to be translated, a simple copy of the drawings as filed is required by a few DOs
  - If the drawings contain text matter to be translated, a set of drawings containing the translated text matter needs to be furnished

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## National requirements simplified for PCT applications (2)

- No legalized or certified translation of the international application
  - Otherwise, a simple translation is required
  - A few Offices (such as, AU, GB, IN, NZ, SG, ZA) require a "verified" translation
- No special form required (but strongly recommended) for entry into national phase

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## Communication with DOs/EOs (Rule 93bis)

- Any communication, notification, correspondence or other document relating to an international application will be communicated by the International Bureau to DOs/EOs only upon their request and at the time specified by the Offices
- Most DOs/EOs will receive the majority of documents concerned only after an applicant has entered the national phase before its Office
- Almost all PCT Contracting States now receive the DVD collections containing the full texts of the published international applications

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## Furnishing by International Bureau of copies of priority documents (Rule 17.2(a))

- The International Bureau provides copies of priority documents to designated Offices:
  - upon request
  - after international publication, unless the applicant made a specific request for early processing under Article 23(2)
- Almost all Offices request a copy of the priority document only after the application entered the national phase
- Only the European Patent Office systematically receives copies of all priority documents

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## Recommendations for preparing entry into the national phase (1)

- Leave sufficient time, where necessary, to prepare the translation of the international application
- Send your local agent, copies of the (relevant) documents on file: the published international application, the international search report and written opinion by the ISA, the international preliminary examination report, priority documents; note that none of these documents are required to be filed by the local agent at the local patent office

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## Recommendations for preparing entry into the national phase (2)

- Where you would prefer avoiding paying additional claims fee or other fees that are applicable under any particular national law, prepare the application, and any amendments thereof, according to the national practice
- Even though several designated/elected Offices provide for longer time limits, it is preferable to docket the 30-month time limits for all Offices (See [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html) for exceptions under Article 22(1))

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## A few further tips to remember

- Remember to monitor time limits for entering national phase
  - they apply irrespective of delays in the international phase
- Make necessary indications that application is entering the national phase, i.e., that it is not a direct national filing
- Translation of the international application must be correct and complete (no subject matter may be added and/or deleted)
- Pay the required fees (amount may be different from that applicable to direct national filing)

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## Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
  - unintentionally
    - or - at the option of the Office -*
  - in spite of due care required by the circumstances

## Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Applicants may submit a request for reinstatement and enter the national phase within:
  - 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
  - 12 months from the date of expiration of the time limit to enter national phase;whichever period expires first

## Reinstatement of rights by DO/EOs (Rule 49.6) (3)

- Longer time limits and/or further requirements may apply depending on the applicable national law
- For further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant's Guide*, National Phase

## DO/EOs to which Rule 49.6 does not apply

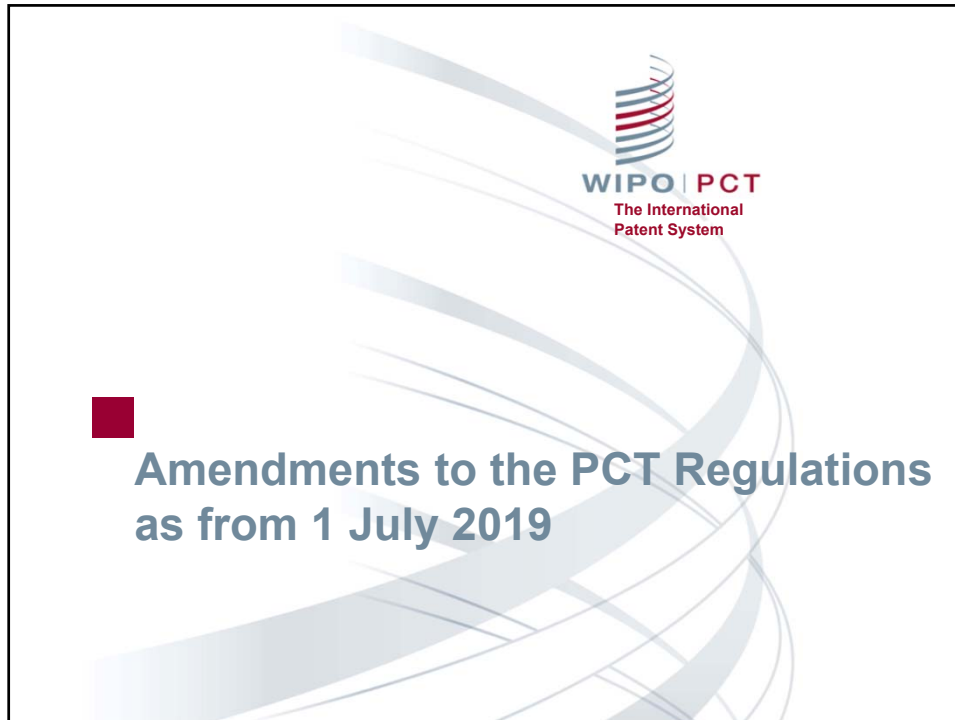
- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f):

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

## Additional cases of protection against loss of rights

- Other than the (minimum) protection under Rule 49.6: excuse of delays in meeting time limits by designated/elected Offices (Article 48 and Rule 82*bis*)
- Rectification by designated/elected Offices of errors made by RO or IB (Rule 82*ter*)
- 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*)

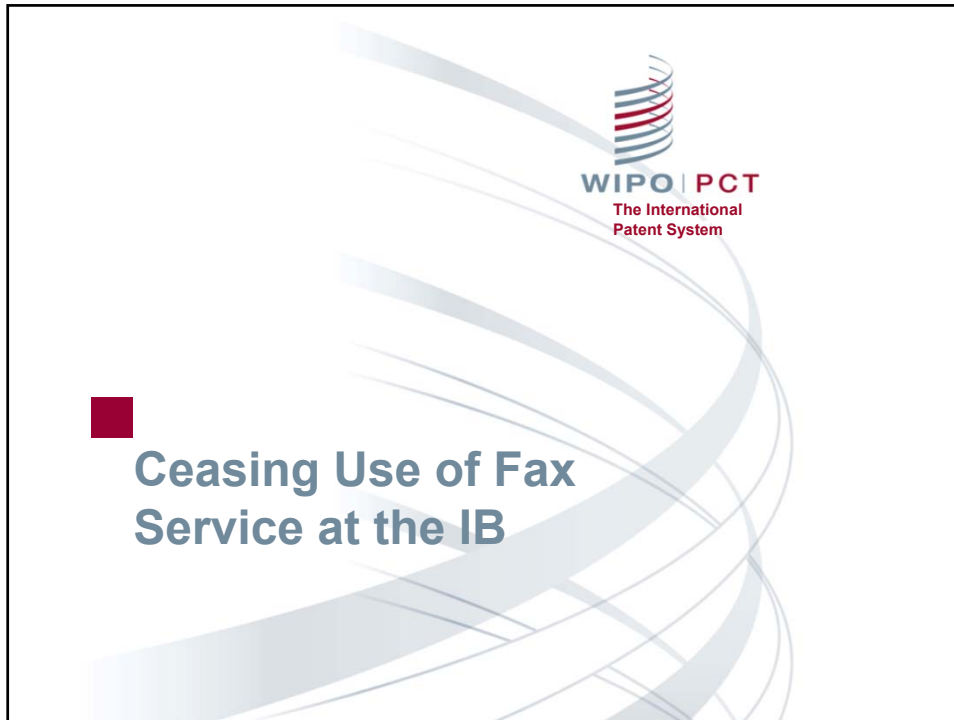


## PCT Rule Changes

### ■ Amendment to PCT Rule 69.1(a)

- Allows the IPEA to start the international preliminary examination when:
  - it is in possession of the demand, relevant fees, ISR and written opinion;
  - unless the applicant expressly requests the IPEA to postpone the start of the examination until expiration of the time limit for filing a Chapter II demand (Rule 54*bis*.1(a)) (as opposed to starting examination only once that time limit has expired)
- Effective for demands made on or after July 1, 2019





## Ceasing Use of Fax Service at the IB (1)

- The IB will continue to operate fax services until 31 December 2019
- Subsequently, it will no longer be possible to send documents by fax to the IB, and the IB will cease sending communications by fax
- For the filing of new applications with RO/IB:
  - Applicants should use ePCT (*recommended*) or PCT-SAFE
  - Alternatively, and in particular if no other e-filing service accepted by RO/IB is readily available, international applications can also be uploaded through a new “Contingency Upload Service” (see <https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml>)

## Ceasing Use of Fax Service at 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 urgent notifications and forms from the IB and access all IB communications:
  - Authorize the IB to send PCT forms, notifications and communications by e-mail (can opt for “email and paper”, ideally “by email only”)
- To access international applications:
  - use ePCT (strong authentication) (*recommended*).
  - use PATENTSCOPE (after international publication)