



Regional Seminar on the Patent Cooperation Treaty (PCT) for Selected African Countries

Topic 5 (a): Entry into the National Phase

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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)

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

■ Time limit under Art. 39(1)(a): 30 months from the priority date

- For additional time, see PCT Applicant's Guide, national phase summaries

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

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

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

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

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

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

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 for exceptions under Article 22(1))

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)

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*)

Before/After Amendments

Before Amendment



After Amendment

■ Invention composed of

- Element 1
- Element 2
- Element 3
- Element 4

■ Invention composed of

- Element 1
- Element 2
- Element 3
- Element 4
- Element 5**

Other Challenges

- Patentability Requirements (ISR, WOISA, IPRP Ch. II)
 - methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods
 - Computer programs
 - Business Method

- Insufficient Search Results (e.g. lack of unity)

Practical Approach for Better Quality

- Different size of the Office (could be different approach)
 - 1000 examiners or 10 examiners (for the whole technological fields)
 - Examination by its own examiners, outsourcing, temporary examiners ...

- Utilization of the results from other Offices
 - Wait for such results?