



Ministry for Industry & Handicraft



PCT SEMINAR

WIPO/PCT/PNH/16/3
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Seminar on the Patent Cooperation Treaty (PCT)

The System for Worldwide Filing of Patent Applications

organized by the
World Intellectual Property Organization (WIPO)

in cooperation with the
Department of Intellectual Property, Ministry of Commerce, Cambodia

Phnom Penh, February 25 and 26, 2016

prepared by the International Bureau

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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:

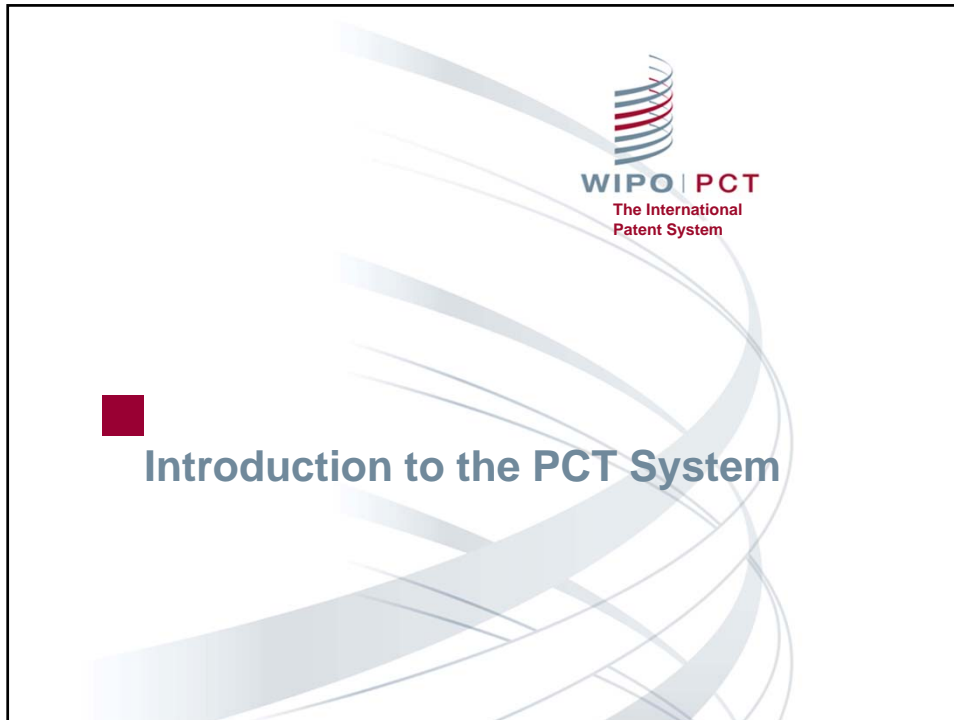
Administrative Instructions	–	the Administrative Instructions under the PCT
Article	–	an Article of the PCT
Chapter I	–	Chapter I of the PCT
Chapter II	–	Chapter II of the PCT
Contracting State	–	a State party to the PCT
Regulations	–	the Regulations under the PCT
Rule	–	a Rule of the Regulations under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

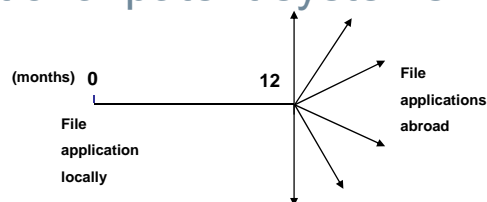
The following abbreviations should be understood as meaning:

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

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*:

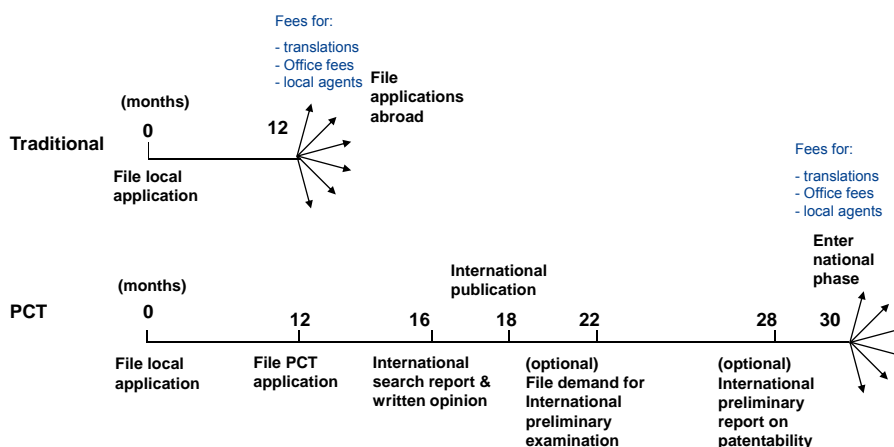
- one set of formality requirements
- international search
- international publication
- international preliminary examination
- international application can be put in order before national phase
- translations and national fees required at 30 months,* and only if applicant wishes to proceed

* For exceptions, see http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

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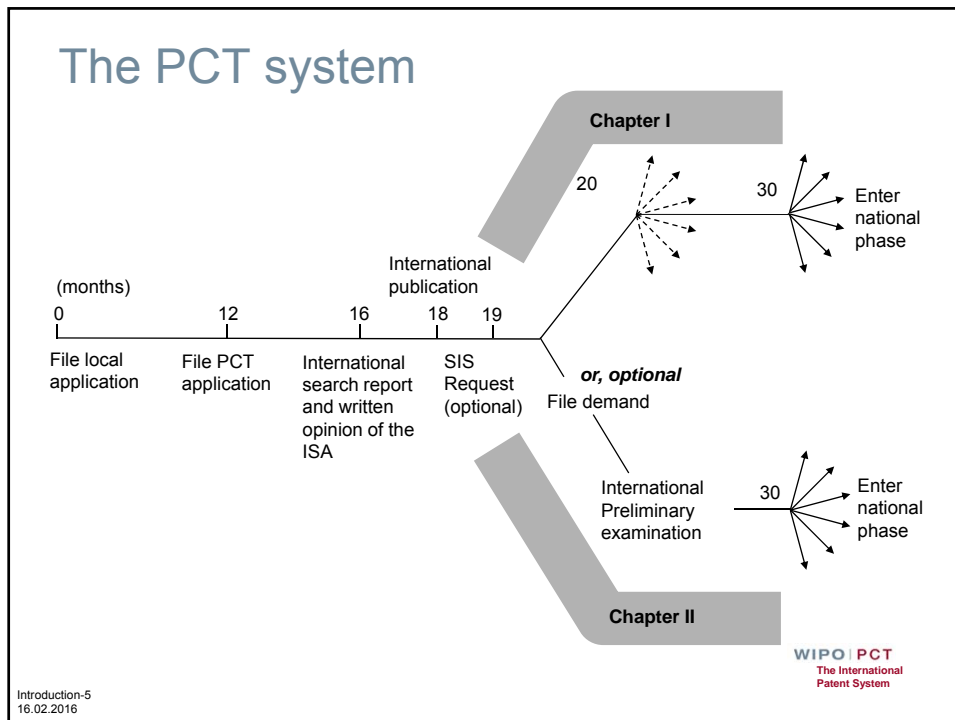
Introduction-3
16.02.2016

Traditional patent system vs. PCT system



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16.02.2016



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

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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16.02.2016

PCT Contracting States (148)

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 Albania¹
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 Croatia¹
HU Hungary
* IE Ireland
IS Iceland
* IT Italy

LI Liechtenstein
* LT Lithuania
LU Luxembourg
* LV Latvia
* MC Monaco
MK The former Yugoslav
Republic of Macedonia¹
* MT Malta
* NL Netherlands
NO Norway
PL Poland
PT Portugal
RO Romania
RS Serbia¹
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 (148) (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	Swaziland
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 (148) (continued)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	ID	Indonesia	NZ	New Zealand
AG	Antigua and Barbuda	IL	Israel	OM	Oman
AO	Angola	IN	India	PA	Panama
AU	Australia	IR	Islamic Republic of Iran	PE	Peru
* BA	Bosnia and Herzegovina	JP	Japan	PG	Papua New Guinea
BB	Barbados	KM	Union of the Comoros	PH	Philippines
BH	Bahrain	KN	Saint Kitts and Nevis	QA	Qatar
BN	Brunei Darussalam	KP	Democratic People's Republic of Korea	SA	Saudi Arabia
BR	Brazil		Republic of Korea	SC	Seychelles
BZ	Belize	KR	Republic of Korea	SG	Singapore
CA	Canada	LA	Lao People's Democratic Republic	ST	Sao Tome and Principe
CL	Chile		Republic	SV	El Salvador
CN	China	LC	Saint Lucia	SY	Syrian Arab Republic
CO	Colombia	LK	Sri Lanka	TH	Thailand
CR	Costa Rica	LY	Libya	TN	Tunisia
CU	Cuba	** 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	ZA	South Africa
GE	Georgia	NG	Nigeria		
GT	Guatemala	NI	Nicaragua		
HN	Honduras				

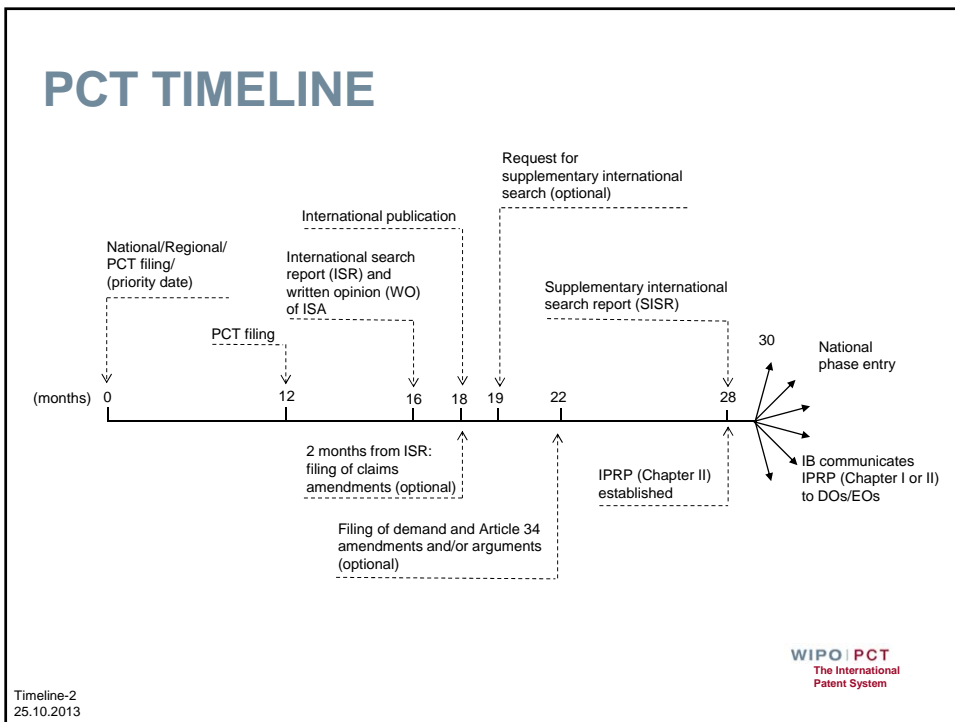
* Extension of European patent possible
** Validation of European patent possible

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Countries not yet PCT Contracting States (45)

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



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
 - UG Uganda
- 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



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)

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)

Basics-3
25.10.2013

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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)

Basics-4
25.10.2013

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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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Filing-3
19.05.2015

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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Filing-4
19.05.2015

The request (2)

- Printed request form (Form PCT/RO/101)
 - Available on Internet
(<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

Signature of the request (1) (Rules 4.15, 26.2bis(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

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

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

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

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

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

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

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Filing-11
19.05.2015

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

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Filing-12
19.05.2015



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

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Declarations-3
25.10.2013

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

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Declarations-4
25.10.2013

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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Declarations-5
25.10.2013

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-6
25.10.2013

Declarations referred to under Rule 4.17: Additional issues

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



Agents (Rule 90)

■ Who can act as agent?

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

■ What is a common agent?

- an agent appointed by all the applicants

Common representatives (Rule 90)

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

Agents and common representatives (Rule 90)

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

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

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

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Agents-5
23.10.2014

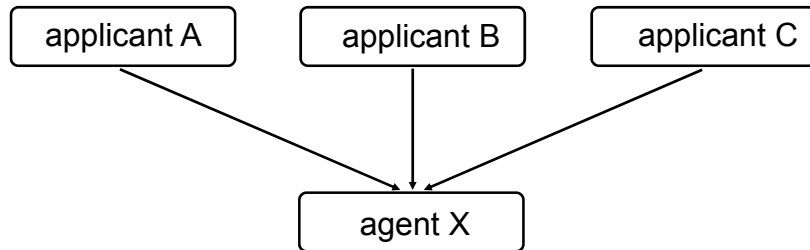
Waiver of requirement that a power of attorney be furnished (Rules 90.4(d) and 90.5(c))

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

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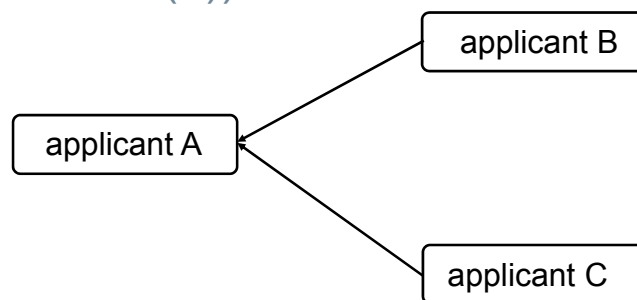
Agents-6
23.10.2014

Common agent



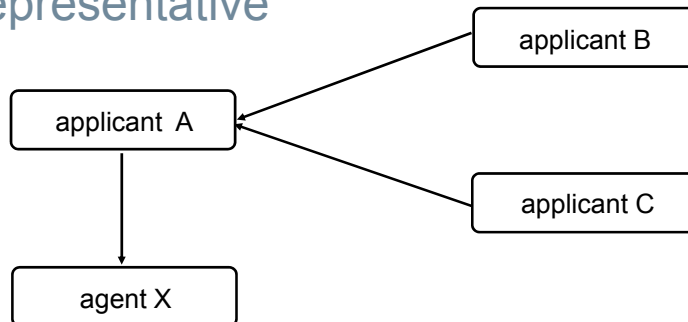
- Agent X is a common agent if he has been appointed by all applicants

Appointed common representative (Rule 90.2(a))



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

Agent of the appointed common representative

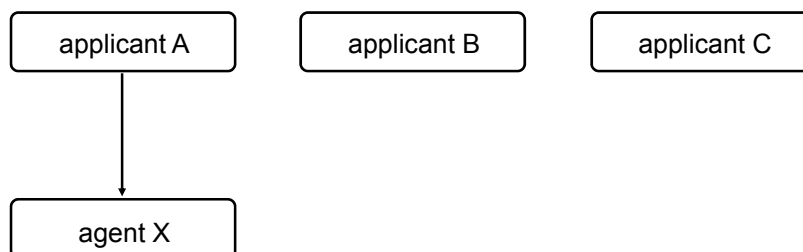


- Applicant A (e.g. corporate applicant), who has been appointed by the other applicants (e.g. applicants/inventors) as their common representative, appoints agent X
- Agent X can, on behalf of the appointed common representative, sign all documents for all applicants including any withdrawal (Rule 90.3(c)),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

Agents-9
23.10.2014

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



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

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Priority Claims

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

The right of priority (1) (Article 4 of the Paris Convention)

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

The right of priority (2) (Article 4 of the Paris Convention)

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

Claiming priority (PCT Article 8, Rule 4.10)

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

Priority date (PCT Article 2(xi))

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

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Priority claims-5
07.05.2015

Contents of priority claims (Rule 4.10) (1)

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

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Priority claims-6
07.05.2015

Contents of priority claims (Rule 4.10) (2)

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

Priority claims-7
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Furnishing of priority documents (Rule 17.1)

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

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

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

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Priority claims-9
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Digital Access Service for Priority Documents (DAS)

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

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Priority claims-10
07.05.2015

Retrieval of priority documents via DAS

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

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Priority claims-11
07.05.2015

Main steps for the use of DAS

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

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Priority claims-12
07.05.2015

Requesting DAS p-doc retrieval

Details of Priority Claim of Earlier Application

National Regional International (PCT)

Country: US United States of America

Filing date: 29 July 2011

Number: 61/274,654

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

Access code: 1234

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

The receiving Office is requested to restore the right of priority

OK Cancel

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

Correction/addition of priority claims

- What can be the problem?
 - missing priority claim
 - missing priority date
 - missing indications of the date, number or country of filing
 - filing date of earlier application more than 12 months before the international filing date
 - earlier filing not in a country party to the Paris Convention or a Member of WTO
- Applicable provisions:
 - Article 8
 - Rules 4.10, 26*bis*, 48.2(a)(vii) and 91

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

■ Cases concerned:

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

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

■ Applicable time limit:

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

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

■ Cases concerned:

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

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

■ Applicable time limit:

- Rule 26bis.1(a):
 - within 4 months from the international filing date; or
 - within 16 months from the priority date, whichever time limit expires later
 - any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26bis.2(b))

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

- Rule 91: within 26 months from the priority date

Invitation to correct by RO or IB (1)

■ Forms:

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

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

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

Invitation to correct by RO or IB (2)

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

Invitation to correct by RO or IB (3)

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

Invitation to correct by RO or IB (4)

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

Publication related to priority claims (1)

■ Information concerning a priority claim considered void or only not considered void because:

- the number was missing
- inconsistency with the indications on priority document
- the international filing date is outside of the priority period but with a period of two months from the date of expiration of the priority period

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

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Priority claims-23
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Publication related to priority claims (2)

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

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

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

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Priority claims-24
07.05.2015

Restoration of the right of priority - Competent Authorities

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

Restoration of the right of priority Applicable criteria

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

Restoration by RO (Rule 26bis.3)

■ Conditions:

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

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

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

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

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

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Priority claims-29
07.05.2015

Reservations made by Offices

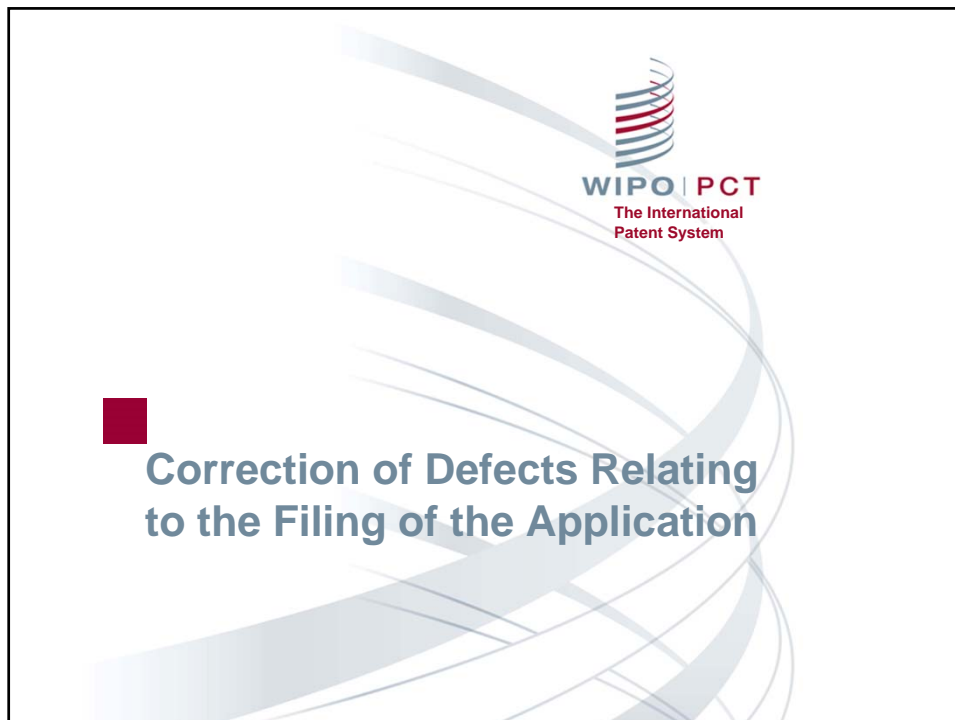
The following Offices have notified the International Bureau of the incompatibility of Rule 26bis.3(a) to (i), Rule 49ter.1(a) to (d) and/or Rule 49ter.2(a) to (g) with their national/regional law:

- Incompatibility as RO (Rule 26bis.3(j)):
 - BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, JP*, KR, NO, PH
- Incompatibility of the effect of decision of RO on DO (Rule 49ter.1(g)):
 - BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP*, KR, LT, MX, NO, PH, TR
- Incompatibility as DO (Rule 49ter.2(h)):
 - BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP*, KR, MX, NO, PH, TR

* Notification withdrawn effective 1 April 2015 (JP)
See the Table of “PCT Reservations, Declarations, Notifications and Incompatibilities” www.wipo.int/pct/en/texts/reservations/res_incomp.html

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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 26.3ter)
- Incomplete, erroneous or missing priority claim (Rule 26bis)

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-3
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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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Defects-4
07.05.2015

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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Defects-7
07.05.2015

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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Defects-8
07.05.2015

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

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

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

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

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

Declarations of incompatibility with the national law

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

Incompatibility as RO (Rule 20.8(a)):

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

Incompatibility as DO (Rule 20.8(b)):

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

Rectification of obvious mistakes (Rule 91) (1)

■ No rectification shall be made except with the express authorization:

- of the receiving Office if the mistake is in the request,
- of the International Searching Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
- of the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
- of the International Bureau if the mistake is any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau

Rectification of obvious mistakes (Rule 91) (2)

- Time limit: 26 months from the priority date (Rule 91.2)
- Clarification as to mistakes which are not rectifiable under Rule 91:
 - missing 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*)

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Defects-17
07.05.2015

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

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Defects-18
07.05.2015

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*)



Rule 92bis: cases covered

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

Request for recording of a change under Rule 92bis

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

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Changes 92bis-3
25.10.2013

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

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

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Changes 92bis-4
25.10.2013

Time limit under Rule 92bis (1)

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

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Changes 92bis-5
25.10.2013

Time limit under Rule 92bis (2)

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

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Changes 92bis-6
25.10.2013



The receiving Office (1)

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

The receiving Office (2)

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

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Ro functions-3
27.05.2015

The receiving Office (3)

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

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Ro functions-4
27.05.2015

The receiving Office (4)

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



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

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

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

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

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IB-RO-3
25.10.2013

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

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

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IB-RO-4
25.10.2013

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

- Conditions for the transmittal:
 - ❑ any applicable national security requirements are met
 - ❑ a fee, equal to the transmittal fee, is paid (not all Offices will require such a fee)
- Effect of the transmittal on the international filing date: the international filing date will be the date of receipt by the “non competent” Office provided that
 - ❑ the minimum requirements for according an international filing date are met

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IB-RO-5
25.10.2013

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

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

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IB-RO-6
25.10.2013

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

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

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

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IB-RO-7
25.10.2013

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

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

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IB-RO-8
25.10.2013

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

■ Where priority of an earlier national, regional or international (RO other than RO/IB) application is claimed in a PCT application filed with, or transmitted under Rule 19.4 to, RO/IB:

- RO/IB cannot be requested to establish a certified copy of such application (“priority document”) since RO/IB is not the Office with which that earlier application was filed
- if the relevant check-box in Box No. VI of the request is marked, RO/IB will delete the check-mark *ex officio*

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IB-RO-9
25.10.2013

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

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

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IB-RO-10
25.10.2013

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

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

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

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

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

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

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IB-RO-13
25.10.2013

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

- Where the applicant has not, within the applicable time limit, furnished the required translation and/or paid, where applicable, the late furnishing fee, the international application will be considered withdrawn and RO/IB will so declare
 - Any translation and any payment received by RO/IB
 - before RO/IB makes the declaration that the international application is considered withdrawn and
 - before the expiration of 15 months from the priority date
- is considered to have been received before the expiration of the applicable time limit (that is, one month from the date of the invitation or two months from the date of receipt of the international application, whichever expires later)

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IB-RO-14
25.10.2013



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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Search-3
16.02.2016

International Searching Authorities (21 in total, 20 in operation)

- | | |
|------------------|---|
| ■ AT – Austria | ■ KR – Republic of Korea |
| ■ AU – Australia | ■ RU – Russian Federation |
| ■ BR – Brazil | ■ SE – Sweden |
| ■ CA – Canada | ■ SG – Singapore |
| ■ CL – Chile | ■ UA – Ukraine |
| ■ CN – China | ■ US – United States of America |
| ■ EG – Egypt | ■ EP – European Patent Office |
| ■ ES – Spain | ■ VP – <i>Visegrad Patent Institute</i>
<i>(Czech Republic, Hungary, Poland,
Slovakia) (not yet operational)</i> |
| ■ FI – Finland | |
| ■ IL – Israel | ■ XN – Nordic Patent Institute
(Denmark, Iceland, Norway) |
| ■ IN – India | |
| ■ JP – Japan | |

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Search-4
16.02.2016

Office of filing (Receiving Office) decides on which ISAs is/are available

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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Search-5
16.02.2016

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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Search-6
16.02.2016

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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Search-7
16.02.2016

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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Search-8
16.02.2016

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

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

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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Search-11
16.02.2016

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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Search-12
16.02.2016

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 and XN
 - 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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SIS-3
15.01.2016

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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SIS-4
15.01.2016

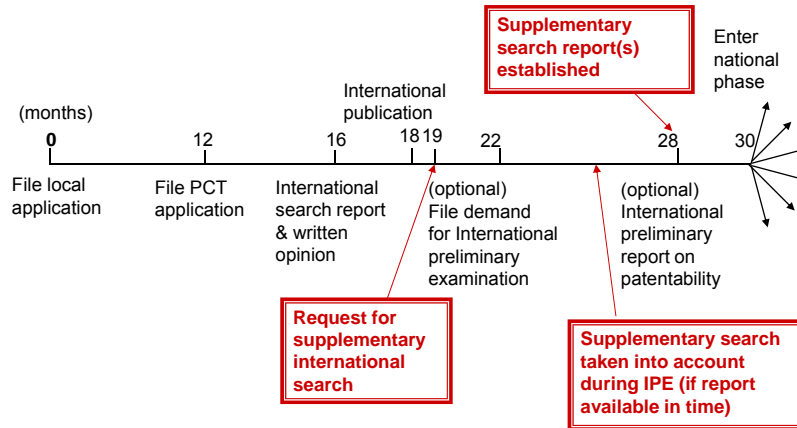
Deciding when to Use the Service (2)

- 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 19 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 request and international search report (ISR), or 22 months from the priority date, at latest, if the main ISR is late
- The SIS Report is established by 28 months from the priority date

SIS in the PCT System



SIS-7
15.01.2016

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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)

SIS-8
15.01.2016

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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

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SIS-9
15.01.2016

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

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SIS-10
15.01.2016

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)
 - limitation of number of supplementary searches carried out
 - limitation of number of claims searched

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SIS-11
15.01.2016

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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SIS-12
15.01.2016

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: supplementary search includes the PCT minimum documentation as well as documents held in its search collection
- SISA/FI and SISA/SE: supplementary search includes the PCT minimum documentation as well as documents in Danish, Finnish, Norwegian and Swedish held by the Authority

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SIS-13
15.01.2016

Services currently available (2)

- SISA/RU: two supplementary search options
 - The first includes Russian-language documentation and certain other patent documentation of the former Soviet Union and CIS States
 - The second is only available 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): Includes the PCT minimum documentation, plus the above
- SISA/XN: supplementary search includes the PCT minimum documentation, as well as documents in Danish, Icelandic, Norwegian and Swedish held by the Authority

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SIS-14
15.01.2016

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

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

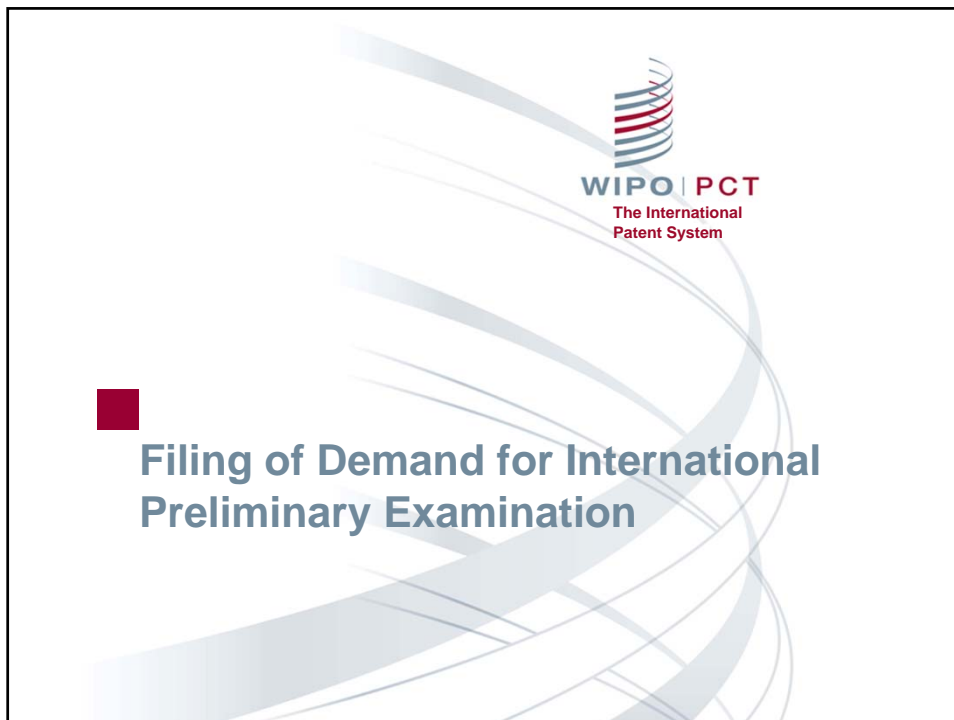
■ If the Authority **commences** work, but **no** search is carried out:

- 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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Demand-7
30.07.2014

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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Demand-8
30.07.2014

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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Demand-11
30.07.2014

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, TZ and UG

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Demand-12
30.07.2014

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, TZ and UG

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))

ePCT and the filing of a demand

- ePCT private services 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

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

provided that the IPEA shall not start the international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start
- 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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01.07.2014

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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IPE-10
01.07.2014

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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IPE-11
01.07.2014

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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IPE-12
01.07.2014

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

IPE-15
01.07.2014

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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

IPE-16
01.07.2014

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Requirement of unity of invention (Rule 13)

- An international application must relate to
 - one invention only or,
 - if there is more than one invention, those inventions must be so linked as to form a single general inventive concept (Rule 13.1).
- Inventions are considered linked so as to form a single general inventive concept only when there is a technical relationship involving one or more of the same or corresponding “special technical features”.
- The expression “special technical features” means those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art (Rule 13.2).

(For further details and examples, see paragraphs 10.20 to 10.59 of the International Search and Preliminary Examination Guidelines)

Lack of unity of invention before ISA (1) (Article 17(3) and Rule 40)

- Where there are several inventions, the first claimed invention (“main invention”) is always searched; further inventions are searched only if additional search fees are paid.
- The ISA will:
 - specify the reasons for the finding of lack of unity of invention (ISA/EP will send together with this notification the results of a partial search on the main invention); and
 - invite the applicant to pay, within one month from the date of the invitation, additional search fees and, if the applicant wishes to pay the additional fees under protest, a protest fee where applicable

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Unity-3
25.10.2013

Lack of unity of invention before ISA (2) (Article 17(3) and Rule 40)

- Failure to pay additional fees does not affect the application; however, the additional inventions will not be searched and the written opinion will not contain a preliminary opinion on the unsearched claims; subsequently, the claims relating to unsearched inventions need not be examined by the IPEA
- No provisions for filing divisional applications during the international phase. This may only be done in the national phase before certain DOs (refer to applicable national law)

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Unity-4
25.10.2013

Protest procedure before the ISA (1) (Rule 40.2)

- If the applicant pays any or all additional fees under protest, the ISA carries out the search on the additional inventions and, in parallel, reviews the invitation to pay additional fees
- Depending on the ISA, the review may be subject to the payment of a protest fee
- If, upon review, the ISA concludes that the protest was justified, the additional search fees paid will be refunded either totally or partially; the protest fee will only be refunded if the ISA finds that the protest was entirely justified

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Unity-5
25.10.2013

Protest procedure before the ISA (2) (Rule 40.2)

- If, upon review, the ISA concludes that the invitation was justified, the protest is denied. The applicant will be given detailed reasons for the denial.
- The applicant may request that the text of the protest and the decision thereon be notified to the designated Offices. (Attention: the designated Offices may require that the applicant furnish a translation thereof)

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Unity-6
25.10.2013

Lack of unity of invention before IPEA (Article 34(3)(a) and Rule 68)

- Unity of invention based on same criteria as for international search (Rules 13 and 68)
- If IPEA considers there is lack of unity of invention, it invites the applicant to restrict the claims or pay additional examination fees
- Applicant can select part of the application to be examined as “main invention” and for which additional fees are paid
- Payment of additional fees may be made under protest, subject to the payment of a protest fee
- Decision on protest made in same manner as for international search

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Unity-7
25.10.2013

Protest procedure before the IPEA (1) (Rule 68.3)

- If the applicant pays any or all additional fees under protest, the IPEA carries out the international preliminary examination on the additional inventions and, in parallel, reviews the invitation to pay additional fees.
- Depending on the IPEA, the review may be subject to the payment of a protest fee.
- If, upon review, the IPEA concludes that the protest was justified, the additional examination fees concerned will be refunded either totally or partially; the protest fee will only be refunded if the IPEA finds that the protest was entirely justified.

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Unity-8
25.10.2013

Protest procedure before the IPEA (2) (Rule 68.3)

- If, upon review, the IPEA concludes that the invitation was justified, the protest is denied. The applicant will be given detailed reasons for the denial.
- The applicant may request that the text of the protest and the decision thereon be notified to the elected Offices as an annex to the international preliminary examination report. (Attention: the elected Offices may require that the applicant furnish a translation thereof)



General responsibilities under the PCT (1)

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

General responsibilities under the PCT (2)

- Dissemination of information about the PCT system
 - *PCT Applicant's Guide*
 - *PCT Newsletter*
 - Official Notices
 - List server messages, etc.
 - PCT's website
- PCT Seminars and training courses
- Receiving Office for applicants from all Contracting States

Responsibilities related to international applications (1)

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

Responsibilities related to international applications (2)

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

Responsibilities related to international applications (3)

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



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

■ When?

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

■ Publication languages:

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

■ Contents of published international application

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

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

☐ where applicable:

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

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Publication-3
15.01.2016

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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Publication-4
15.01.2016

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)

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Publication-5
15.01.2016

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

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Publication-6
15.01.2016

Form of publication

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

Frequency of international publication

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

Technical preparations for international publication

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

For example: if the publication date is: Thursday, *21 January 2016*, technical preparations are completed on Wednesday, *6 January 2016*

Consequently, any document that reaches the International Bureau on Tuesday, *5 January 2016*, 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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Publication-9
15.01.2016

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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Publication-10
15.01.2016

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

Publication-11
15.01.2016

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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

Publication-12
15.01.2016

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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

Publication-13
15.01.2016

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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

Publication-14
15.01.2016

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Access to File

- General principles
- Access to files held by Offices and Authorities

General principles

- The RO, ISA, IPEA, DO, EO and the IB all maintain their own files related to the international application
- Applicant or any person authorized by the applicant always has access to the international application file
- International applications are confidential in relation to third parties and other Offices until international publication
- DOs have access to documents in the IB file insofar as they relate to the Chapter I procedure
- EOs, in addition, have full access to IPEA file once the IPRP Chapter II is established

Access to files held by the IB (1)

- Before publication of the IA: Only applicant or any person authorized by the applicant has access to the full file content (preferably via ePCT *private services*)
- All published PCT applications are available on PATENTSCOPE

Access to files held by the IB (2)

- For access to other documents in the file of the IB by third parties after publication:
 - International applications filed after 1 January 2009:
 - The entire publicly available file content is on PATENTSCOPE
 - International applications filed on or after 1 July 1998 and before 1 January 2009:
 - Certain documents are available on PATENTSCOPE
 - Some documents are available in paper form only and are made available upon request against payment of a fee
 - International applications filed before 1 July 1998:
No access to file content

Access to files held by the IB (3)

■ Restrictions:

- Copies of the IPRP (Chapter I or II) or any translation thereof are only made publicly available on PATENTSCOPE after 30 months from the priority date
- No access:
 - Any document in the file relating to the Chapter II procedure (such as demand, written opinion by the IPEA, etc.), except for the IPRP Chapter II
 - Purely internal documents and communications between Offices

How to obtain third party access to files held by the IB (1)

■ PATENTSCOPE www.wipo.int/patentscope

- Access to published international applications, the latest bibliographic data, certain documents and forms
- Details on the availability of documents can be found by clicking on “data coverage” under the “help” tab

How to obtain third party access to files held by the IB (2)

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

Access to files held by RO/ISA/IPEA (1)

- Before publication of the IA: Only applicant or any person authorized by the applicant has access to documents in the file of the RO, ISA or IPEA
- After publication, and only if provided for by the applicable national law:
 - Documents in the file of the RO:
 - Third parties have access to any document in the file (Article 30(3))

Access to files held by RO/ISA/IPEA (2)

- After publication, and only if provided for by the applicable national law:
 - Documents in the file of the ISA:
 - Third parties have access to any document in the file (Article 30(1)) (also to the written opinion and any informal comments by the applicant for international applications filed on or after 1 July 2014)
 - Documents in the file of the IPEA:
 - EOs: Access to any document after the establishment of the IPRP Chapter II
 - Third parties: No access (Article 38)

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Access-9
01.07.2014

Access to files held by DO/EO (1)

- Before publication of the IA: Only applicant or any person authorized by the applicant has access to documents in the file of the DO or EO
- After publication, and only if provided for by the applicable national law:
 - Documents in the file of the DO:
 - Third parties have access to any document after receipt of a copy of the international application by the DO (Article 30)

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Access-10
01.07.2014

Access to files held by DO/EO (2)

- After publication, and only if provided for by the applicable national law:
 - Documents in the file of the EO:
 - International applications filed on or after 1 July 1998:
 - Third parties have access to any document
 - International applications filed before 1 July 1998:
 - Third parties have access to any document relating to the Chapter I procedure, but generally not to the documents relating to the Chapter II procedure



Fees payable to the receiving Office (RO)

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

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

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Fees payable to the International Searching Authority (ISA)

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

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

Fees payable to the International Bureau (IB)

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

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

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

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

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

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Fees-5
06.06.2014

Fees not payable during international phase

Under the PCT, there is:

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

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Fees-6
06.06.2014

Time limits for payment of fees (1)

■ Chapter I:

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

Fees-7
06.06.2014

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Time limits for payment of fees (2)

■ Chapter II:

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

Fees-8
06.06.2014

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Safeguards in respect of payment of fees

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

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

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

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

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

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

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Fees-11
06.06.2014

Refund of fees by the receiving Office (Rules 15.4 and 16.2)

- If no international filing date is accorded, or, due to prescriptions concerning national security, the international application is not treated as such: international filing and search fee
- If the international application is withdrawn or considered withdrawn:
 - before transmittal of the record copy to the IB: international filing fee
 - before transmittal of the search copy to the ISA: search fee
- For the other fees (e.g. transmittal fee) or when outside of the time limits indicated, certain fees may be refunded under certain circumstances. Check with the competent Office or Authority

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Fees-12
06.06.2014

Refund of fees by the IPEA

- Handling fee: full refund (Rule 57.4)
 - if demand withdrawn before having been sent by the IPEA to the IB
 - if demand considered, under Rule 54.4, not to have been submitted
- Preliminary examination fee: refund of up to 100%, depending on circumstances and IPEA
 - where demand considered as if it had not been submitted (Rule 58.3)
 - where demand withdrawn before start of international preliminary examination (Agreement between IPEA and IB of WIPO); see the *PCT Applicant's Guide*, International Phase, International Preliminary Examining Authorities (Annex E) for details

Fees-13
06.06.2014

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Warning – fraudulent requests for payment of registration fees

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

Fees-14
06.06.2014

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Amendments under the PCT

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

Amendments under Article 19 (Rule 46) (1)

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

Amendments under Article 19 (Rule 46) (2)

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

Amendments-3
30.07.2014

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

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

Amendments-4
30.07.2014

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

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

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Amendments-5
30.07.2014

Comparison between types of amendments during international phase

Chapter I (Article 19)

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

Chapter II (Article 34)

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

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Amendments-6
30.07.2014

How to make amendments (Rules 46.5 and 66.8)

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

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Amendments-7
30.07.2014

Replacement sheets for amendments under Article 19

- May not be filed with the receiving Office
- Must be filed directly with the IB preferably using ePCT
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 19 amendments and are sent directly to the ISA

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Amendments-8
30.07.2014

Replacement sheets containing amendments under Article 34

- Can be filed in ePCT when preparing the demand
- Otherwise, must be filed directly with the competent IPEA
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 34 amendments

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

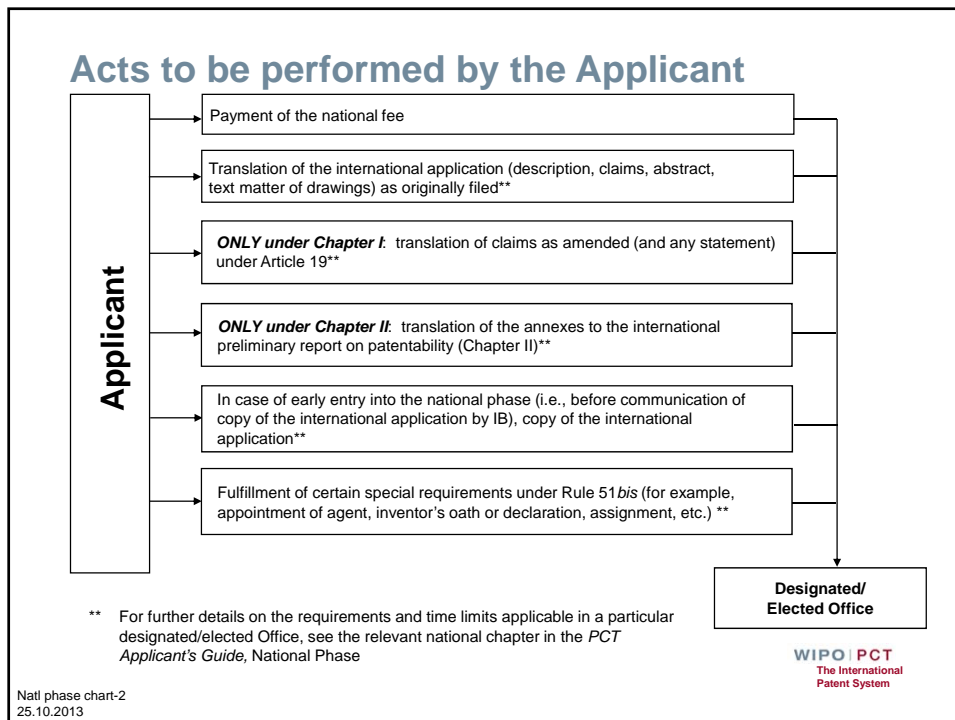
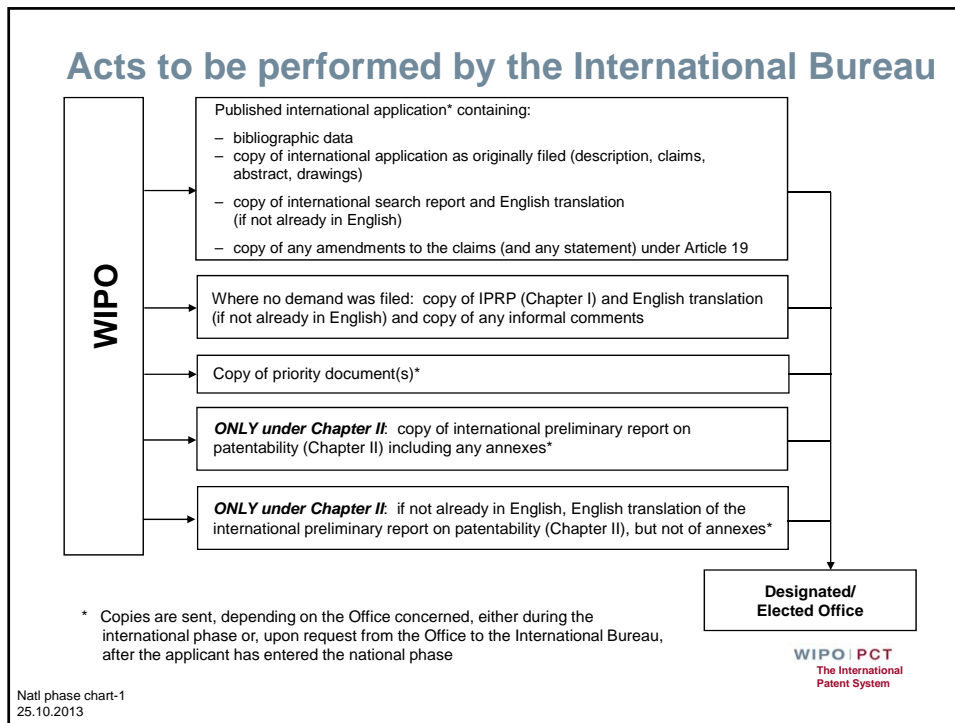
- Description, claims and drawings may be amended
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments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



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, TZ and UG 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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NatIphase-3
15.01.2016

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

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NatIphase-4
15.01.2016

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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NatIphase-7
15.01.2016

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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NatIphase-8
15.01.2016

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

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NatIphase-11
15.01.2016

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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NatIphase-12
15.01.2016

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))

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NatIphase-13
15.01.2016

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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NatIphase-14
15.01.2016

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*)



Withdrawals under Chapter I (1) (Article 24(1)(i) and Rule 90*bis*)

■ What?

- international application, designations (also for certain kinds of protection), priority claim

■ When?

- before the expiration of 30 months from the priority date

■ How?

- by a notice of withdrawal (use of Form PCT/IB/372 recommended) signed by all applicants, their agent or the appointed common representative, and filed with the RO or the IB

Withdrawals under Chapter I (2) (Article 24(1)(i) and Rule 90*bis*)

■ Effect:

- withdrawal effective upon receipt by the RO or the IB
- withdrawal has no effect in DOs where national processing or examination has already started
- withdrawal of international application or designations:
 - effect ceases in each designated State concerned, with same consequences as withdrawal of a national application in that State
 - if notice of withdrawal received by the IB before completion of technical preparations for international publication, there will be no international publication (withdrawal can be made conditional on receipt in time to prevent publication)
- withdrawal of priority claim: time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal

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Withdrawals-3
25.10.2013

Withdrawals under Chapter II (1) (Article 37 and Rule 90*bis*)

■ What?

- international application, designations, demand, elections, priority claim

■ When?

- before the expiration of 30 months from the priority date

■ How?

- by a notice of withdrawal (use of Form PCT/IB/372 recommended) signed by all applicants, their agent or the appointed common representative, and filed with:
 - the RO, the IB or the IPEA, if withdrawing international application or priority claim
 - the IB, if withdrawing demand or elections

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Withdrawals-4
25.10.2013

Withdrawals under Chapter II (2) (Article 37 and Rule 90*bis*)

■ Effect:

- withdrawal effective upon receipt by appropriate Authority (see above)
- withdrawal has no effect in DOs/EOs where national processing or examination has already started
- withdrawal of demand or elections: withdrawal after expiration of Chapter I time limit for entry into national phase is considered to be withdrawal of the international application in relation to the State(s) concerned
- withdrawal of priority claim: time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal



Microbiological inventions

- Deposit of a sample in order to meet the requirement of full disclosure:
 - Many national laws require that, where a patent application refers to biological material which has not been made available to the public, a sample thereof be deposited with a recognized culture collection
- The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (Budapest Treaty)
 - provides for the recognition by its Contracting States of deposits made with any International Depository Authority (IDA) under the Budapest Treaty
- The IDAs are recognized by all PCT Contracting States, whether they are Contracting States of the Budapest Treaty or not

When must the deposit be made?

- Many Offices require the deposit to be made before the filing date of the PCT application
- A late deposit, however, is no excuse for filing a PCT application claiming priority after the expiration of 12 months from the priority date (restoration of the right of priority may not work)
- Some Offices require that the deposit be made before the filing date of the application of which priority is claimed in the PCT application and that the priority application also makes reference to the deposited biological material, e.g. BY, CN, US

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Biomat-Seqlist-3
09.02.2015

Reference to deposited biological material in a PCT application (Rule 13bis)

- Required in a PCT application only where the national law of a designated State provides for it. Usually needed for full disclosure of the invention.
- The *PCT Applicant's Guide*, Deposits of Biological Material (Annex L), contains information on the requirements of the designated States whose national law includes provisions on the deposit of biological material and indicates when and how reference to such deposited biological material should be made.

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Biomat-Seqlist-4
09.02.2015

Time limit for furnishing references to deposited biological material (Rule 13*bis*.4)

- At the time of filing, as part of the international application (in the description): references in accordance with Rule 13.*bis*.3(a)(i) to (iv)
- Within 16 months from the priority date, or before completion of technical preparations for international publication: any further references related to the deposited biological material not part of the international application
- In case of a request for early publication: before completion of technical preparations for international publication

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Biomat-Seqlist-5
09.02.2015

Reference to deposited biological material to be made in the description

- In accordance with Rule 13*bis*.3, the reference must include:
 - the name and address of the depositary institution
 - the date of deposit of the biological material with that institution
 - the accession number given to the deposit by that institution
 - any relevant information on the characteristics of the biological material
- Usually included in a paragraph at the beginning of the description
- Alternatively, Form PCT/RO/134 may be used for that purpose and be numbered as a sheet of the description

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Biomat-Seqlist-6
09.02.2015

Reference to deposited biological material separate from the description

- Statement concerning the “expert solution”
- In the case where the applicant is not the depositor, a statement by the depositor concerning the right of the applicant to make reference to the biological material and to make it available to the public
- Form BP/4: acknowledgement of receipt by the IDA
- Form BP/9: viability statement
- All the above documents will be published by the IB with the international application

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Biomat-Seqlist-7
09.02.2015

The “expert solution” (Rule 13bis.6)

- In respect of certain designated Offices, the applicant is entitled to request that a sample be issued only to an expert nominated by the requester
- A space is provided in form PCT/RO/134 to make such indication
- The request must reach the IB before the completion of technical preparations for the international publication of the application
- Some Offices also require the applicant to notify them directly before international publication takes place, e.g. DO/AU, DO/DE, DO/DK

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Biomat-Seqlist-8
09.02.2015

Applicant and depositor of the sample are not the same person

- In this case, DO/GB and DO/EP require
 - within the time limit of 16 months from the priority date or before technical preparations for international publication have been completed
 - the name and address of the depositor to be included in the reference and
 - a statement specifying that the depositor has authorized the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public
- Failure to do so may result in the application being refused in the national phase for insufficient disclosure

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Biomat-Seqlist-9
09.02.2015

Which type of reference is covered by Rule 13bis?

- Only references to deposits under the Budapest Treaty will be treated as references to biological material under Rule 13bis
- Certificates on the Grant of Community Plant Variety Rights issued by the Community Plant Variety Office, a European Union Agency, are not covered by the Budapest Treaty and Rule 13bis
- References other than to biological material under Rule 13bis will not be published as part of the international application, but will be made available on PATENTSCOPE under “related documents on file at the International Bureau”

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Biomat-Seqlist-10
09.02.2015

Filing of sequence listings forming part of the international application

- No page fees are payable for sequence listings filed in ST. 25 **text** format as part of an international application filed in electronic form
- Full page fees are payable for all pages of a sequence listing filed in **image** format as part of an international application in electronic form
- Full page fees are payable for sequence listings filed on paper
- **ATTENTION:** mixed mode filings (former Part 8 of the Administrative Instructions) no longer permissible

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Biomat-Seqlist-11
09.02.2015

Tables related to sequence listings

- Pages of tables relating to sequence listings count as regular pages of the description
- Full page fees are payable for pages containing tables related to sequence listings, irrespective of whether or not they are submitted in electronic form

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Biomat-Seqlist-12
09.02.2015

Filing of sequence listings not forming part of the international application

- Where a copy of a ST.25-compliant text format sequence listing has been furnished to the ISA under Rule 13*ter*.1 (for the purposes of international search only), the ISA will forward a copy of such a sequence listing to the International Bureau
- The International Bureau will make a copy of all sequence listings in text format received publicly available on PATENTSCOPE

Presentation of nucleotide and/or amino acid sequence listings (1)

- Relevant provisions:
 - Rules 5.2 and 49.5(a-*bis*)
 - Section 208 and Annex C of the Administrative Instructions
- Where the international application contains disclosure of one or more nucleotide and/or amino acid sequences, the description must contain a sequence listing complying with the standard provided for in Annex C of the Administrative Instructions (“PCT Sequence Listing Standard”) (that standard has replaced the previously applicable various requirements of the ISAs, IPEAs and designated/elected Offices)

Presentation of nucleotide and/or amino acid sequence listings (2)

- If so required by the competent ISA, a copy of the sequence listing must also be submitted in electronic form complying with the Standard, in addition to the sequence listing as contained in the application; that copy:
 - must be identical to the written sequence listing
 - must be accompanied by a statement to that effect
- A sequence listing which complies with the Standard must be accepted:
 - by all ROs, ISAs and IPEAs for the purposes of the international phase and
 - by all designated/elected Offices for the purposes of the national phase

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Biomat-Seqlist-15
09.02.2015

PCT Sequence Listing Standard (1)

- Basis: Section 208 and Annex C of the Administrative Instructions
- Where the sequence listing is filed together with the international application, it:
 - must be presented as a separate “Sequence Listing Part” of the description
 - must be placed at the end of the application
 - must begin on a new page
 - should preferably have independent page numbering

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Biomat-Seqlist-16
09.02.2015

PCT Sequence Listing Standard (2)

- The Standard provides further details as to:
 - the symbols and the format which must be used for the presentation of nucleotide and/or amino acid sequences
 - with regard to other available information to be included in the sequence listing, the mandatory items which must, and the optional item which may, be included, and the order in which those items must appear
 - the presentation of features of sequences
 - the presentation of “free text”

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Biomat-Seqlist-17
09.02.2015

PCT Sequence Listing Standard: presentation of free text (1)

- The Standard defines “free text” as a wording describing characteristics of the sequence which does not use “language neutral vocabulary”, that is, controlled vocabulary used in the sequence listing that represents scientific terms as prescribed by sequence database providers (including scientific names, qualifiers and their controlled vocabulary values, the symbols and the feature keys appearing in the Appendices to the Standard).
- Where the sequence listing part of the international application contains free text, that free text:
 - may, and preferably should, be in English (irrespective of the language of the main part of the description) (Rule 12.1(d))
 - must be repeated in the main part of the description (“Sequence Listing Free Text”) in the language thereof (ISA invites to furnish correction if not contained in main part of description as filed) (Rules 5.2(b) and 13^{ter}.1(f))

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Biomat-Seqlist-18
09.02.2015

PCT Sequence Listing Standard: presentation of free text (2)

- For the purposes of the national phase (Rule 49.5(a-bis)), no designated Office is entitled to require the applicant to furnish to it a translation of any text matter contained in the sequence listing part of the description if such text matter:
 - is presented in accordance with the Standard
 - is repeated in the main part of the description (and hence in any translation thereof)

Procedure where the sequence listing does not comply with the Standard (1)

- If the international application as filed does not contain:
 - a written sequence listing complying with the Standard; and/or
 - a sequence listing in electronic form complying with the Standard,the ISA invites the applicant to furnish to it a listing (in such format) complying with the Standard, unless such a listing is already available to it, and to pay to it, where applicable, a late furnishing fee (Rule 13ter.1(a) and (b))

Procedure where the sequence listing does not comply with the Standard (2)

- Any sequence listing which is not contained in the international application as filed but which is furnished subsequently must not go beyond the disclosure in the application as filed and must be accompanied by a statement to that effect (Rule 13*ter*.1(e))
- If the applicant does not comply with the invitation within the time limit fixed in the invitation, the ISA is not required to search the application to the extent that a meaningful search cannot be carried out without the listing (Rule 13*ter*.1(d))

Biomat-Seqlist-21
09.02.2015

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Sequence listing for International Preliminary Examining Authority (Rule 13*ter*.2)

The requirements applicable in respect of the procedure before the ISA apply *mutatis mutandis* in respect of the procedure before the IPEA

Biomat-Seqlist-22
09.02.2015

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Sequence listing for designated/elected Offices (Rule 13^{ter}.3)

- Once the processing of the international application has started before a designated/elected Office, the requirements applicable in respect of the procedure before the ISA (and IPEA) apply *mutatis mutandis* in respect of the procedure before that Office
- No designated/elected Office is entitled to require the applicant to furnish to it a sequence listing other than a sequence listing complying with the PCT Sequence Listing Standard

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Biomat-Seqlist-23
09.02.2015

PatentIn Software

- Windows-based version (available free of charge from the JPO, the USPTO and the EPO) designed to expedite the process of preparing sequence listings in a standardized electronic format complying with the WIPO Sequence Listing Standard
- Helps in creating a database of patent-disclosed sequences
- Supports the exchange of published sequence data between the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office in a Trilateral Sequence Exchange Project

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Biomat-Seqlist-24
09.02.2015



Procedural safeguards (1)

- Transmittal of international application by a non-competent receiving Office to the International Bureau as receiving Office (Rule 19.4)
- Invitation to correct defects (formal defects, priority claims)
- Extension of time limits by the receiving Office (except for payment of fees, correction and/or addition of priority claims)
- Invitation to pay missing or not fully paid fees (Rules 16*bis* and 58*bis*)
- Incorporation by reference (Rule 20)

Procedural safeguards (2)

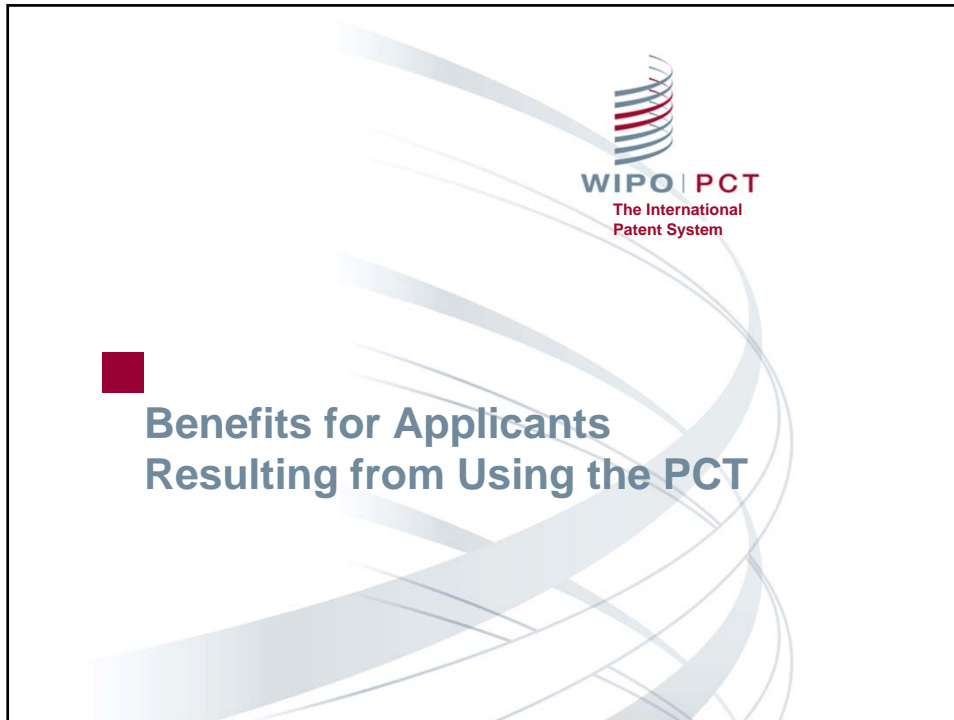
- Restoration of the right of priority (Rules 26*bis*.3 and 49*ter*)
- Rectification of obvious mistakes (Rule 91)
- Withdrawal of application in order to prevent its publication
- Withdrawal of priority claim in order to delay publication of application and/or postpone entry into national phase
- Filing by facsimile in order to meet time limits (Rule 92.4)
- Delay in mail sent to applicant: 7-day rule (Rule 80.6)

Procedural safeguards (3)

- Delay or loss in mail sent by applicant: 5-day rule, registered airmail and delivery services (Rule 82.1)
- Reinstatement of rights after failure to enter national phase within applicable time limits (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 designated/elected Offices (Articles 24, 25 and 26)

Procedural safeguards (4)

- Excuse of delay in meeting time limits due to *force majeure* (Rule 82*quater*)
 - RO, ISA, SISA, IPEA or IB will excuse a delay in meeting any time limit provided for in the Regulations, if it is proven to the Office's satisfaction that
 - the time limit could not be met due to war, revolution, civil disorder, strike, natural calamity, or other similar reason, and
 - evidence is offered not later than six months after the expiration of the relevant time limit
 - The Rule does not apply to
 - the 12 month priority period under the Paris Convention
 - the time limit for entry into the national phase
 - The excuse of delay need not be considered by the DOs before which the national phase has already started



Benefits from using the PCT: a unique procedure

- One application, in one language, filed with one Office, replaces multiple foreign filings until entry into the national phase
- Permits last minute foreign filing (before expiration of priority year)
- International filing date has the effect of national filing date in all designated Offices
- Uniform formal requirements accepted by all designated Offices
- Greater home control of the prosecution
- Decision on foreign filings can be postponed up to 30 months from the priority date at minimal cost
- Enables assessment of economic value of the invention and the chances of obtaining a patent before entering national phase

Benefits from using the PCT: greater flexibility

- Keep options open by making all possible designations for all types of protection
- Various possibilities for withdrawal
- International publication can be prevented or postponed until as late as 15 days before the actual publication date – conditional withdrawal possible
- Further expenses can be avoided simply by no longer prosecuting the application or not entering the national phase
- Amendments made during the international phase have effect in all designated/elected States
- More time for better quality translation for the national phase
- Better planning of the expenditures for the national phase

Benefits-
Advantages-3
29.01.2014

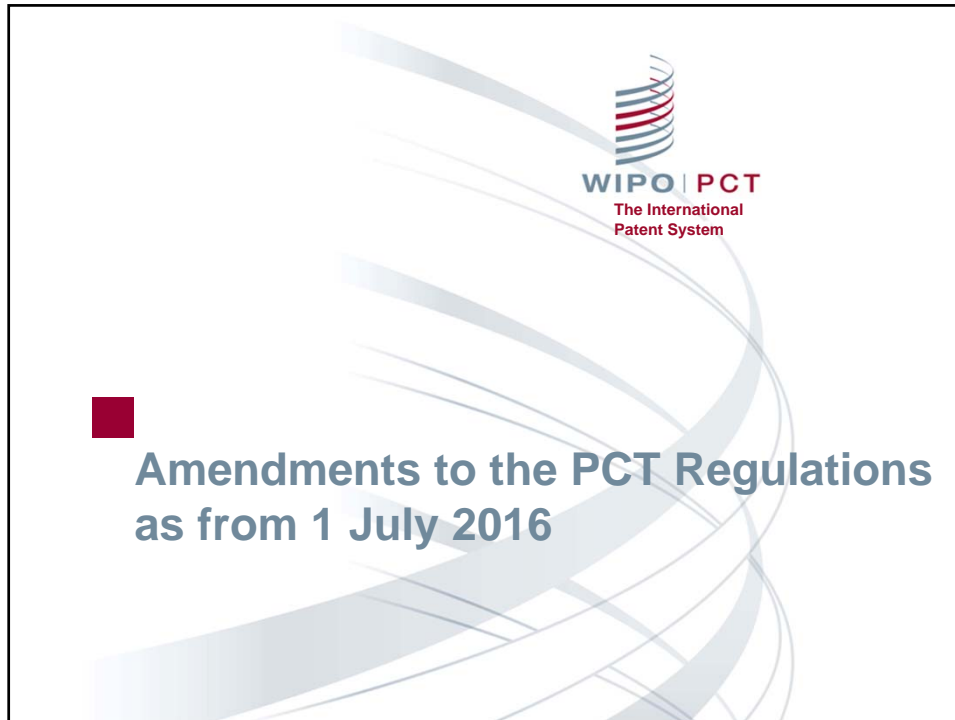
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Benefits from using the PCT: further features

- Postponing national filings costs earns interest on capital
- Fee reductions in national phase in certain national Offices
- More straightforward and rapid national patent granting
- Less restrictive unity of invention requirements permit a reduced number of applications in the US
- Provisional protection after publication at 18 months from the priority date (in countries which afford such protection)
- 90% reduction in PCT fees for applicants from certain Contracting States

Benefits-
Advantages-4
29.01.2014

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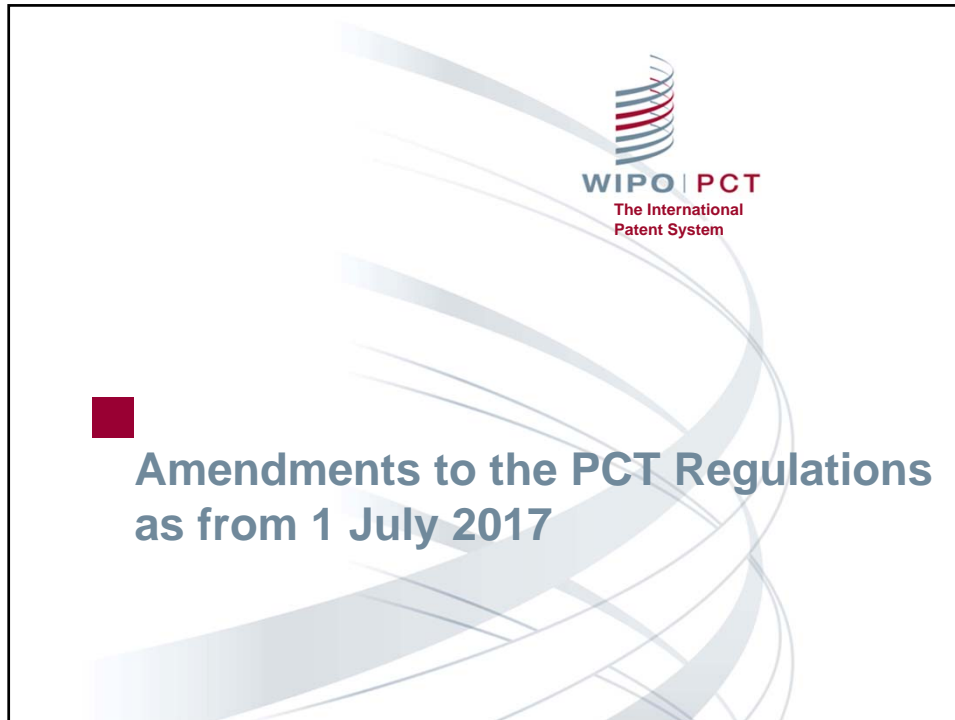


PCT Rule Changes (1)

- Amendment of PCT Rule 9.2
 - Extension of Rule 9.2 to the IB and SISA to suggest to the applicant to correct the PCT application before publication if it contains certain expressions defined under Rule 9.1
- Amendment of PCT Rules 48 and 94
 - At the request of the applicant, omission of certain “sensitive information” from publication (Rule 48) or public file access (Rule 94)
- Amendment of PCT Rule 26bis.3
 - Obligation of the RO to forward to the IB all documents received from the applicant in relation to a restoration request, except for “sensitive information”

PCT Rule Changes (2)

- Amendment of PCT Rule 82^{quater}
 - Extension of *force majeure* provisions to time limits missed due to general failures of electronic communications
- Amendment of PCT Rule 92.2(d)
 - Expansion of the languages of communication from the applicant to the International Bureau via ePCT to all 10 publication languages



PCT Rule Changes

- Amendment of PCT Rules 12*bis*, 23*bis* and 41
 - Transmittal of earlier search and/or classification results by ROs to ISAs
- Amendment of PCT Rules 86 and 95
 - Obligation for designated Offices to timely send information concerning national phase entry to the IB



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

- The Intellectual Property Office of Singapore (IPOS) started operations as an ISA/IPEA on 1 September 2015
- The State Intellectual Property Service of Ukraine (SIPSU) started operations as an ISA/IPEA on 5 February 2016
- The Visegrad Patent Institute has been appointed as an ISA/IPEA
- Twenty one (21) Offices now hold the status as an ISA/IPEA (Visegrad Patent Institute (2015) - not yet operational)

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Recent dev-3
03.02.2016

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
- <http://www.wipo.int/pct/en/highlights/index.html>

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Recent dev-4
03.02.2016

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)

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

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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Recent dev-7
03.02.2016

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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Recent dev-8
03.02.2016

PATENTSCOPE

- Interface available in 9 languages (plus mobile version)
- “Documents” tab includes the new section “Search and Examination-Related Documents”
- Information on national phase entry for more than 50 countries
- Access to more than 40 searchable national and regional patent collections
- New secure access to PATENTSCOPE via https
- Cross-Lingual Information Retrieval (CLIR) (Cross-Lingual Expansion)
 - allows the search of a term/phrase and its variants in several languages by entering the terms(s) in one language, the system will suggest variants and translate the term(s) allowing the search of patent documents to other languages

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Recent dev-9
03.02.2016

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

WIPO | PCT
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Recent dev-10
03.02.2016

“PCT Direct” (1)

- New service offered by:
 - EPO since 1 November 2014
 - Israel Patent Office since 1 April 2015
- 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:
<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:
<http://index.justice.gov.il/En/units/ILPO/Departments/PCT/News/Pages/PCTDirect.aspx>

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Recent dev-11
03.02.2016

“PCT Direct” (2)

- Requirements:
 - the informal comments are filed together with the PCT application
 - with any RO if ISA/EP is chosen
 - with RO/IL if ISA/IL;
 - EPO or Israel Patent Office is selected as ISA;
 - the PCT application claims priority of an earlier application searched by the
 - EPO (European first filing or national first filing)¹
 - Israel Patent Office
- 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)

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Recent dev-12
03.02.2016

¹ The EPO performs national searches for France, Netherlands, Belgium, Luxembourg, Italy, Turkey, Greece, Cyprus, Malta, San Marino and Lithuania

“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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Recent dev-13
03.02.2016

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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Recent dev-14
03.02.2016

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
- Information on the PPH Portal:
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

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Recent dev-15
03.02.2016

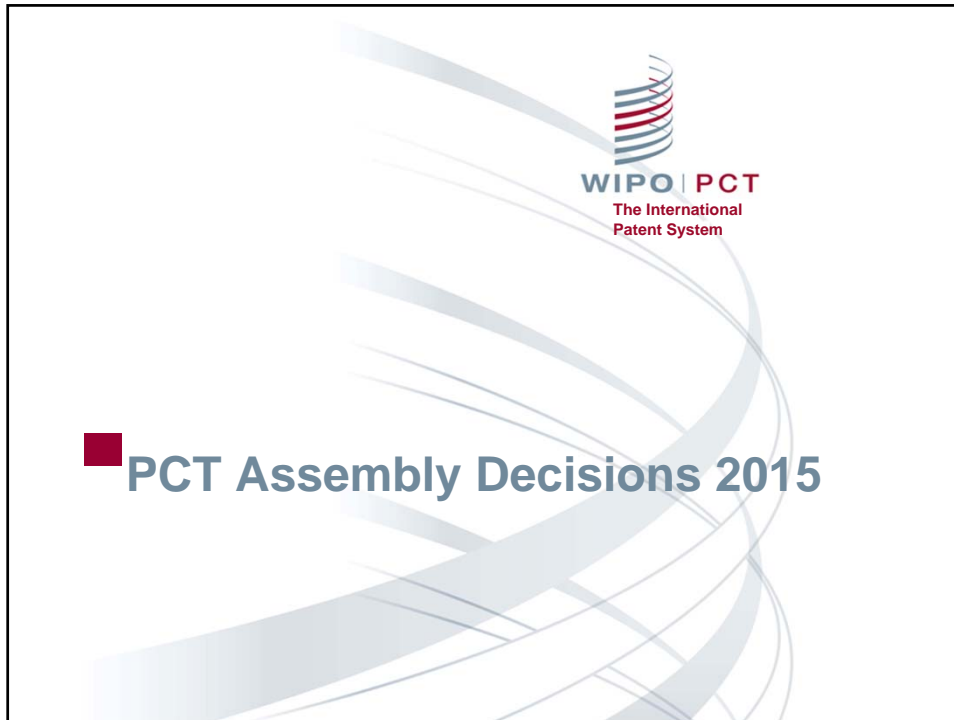
Arbitration and Mediation Center (AMC)

- 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

<http://www.wipo.int/amc/en/calculator/adr.jsp>

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Recent dev-16
03.02.2016



PCT Assembly 2015

■ Outcomes

- Appointment of Visegrad Patent Institute as PCT ISA/IPEA (#21)
 - VPI=IP Offices of Poland, Hungary, Slovakia & Czech Republic
- Amendments to the PCT Regulations (*entry into force: 1 July 2016*)
 - legal basis and procedure for removing/withholding certain “sensitive information” from public access on applicant’s request (Rules 9, 48 & 94)
 - required transmittal by RO to IB of documents submitted in support of requests for restoration of priority right (Rules 26*bis* & 48)
 - “general unavailability of electronic communications services” as grounds for excuse of delay in meeting certain time limits (Rule 82*quater*)
 - language of communication with IB via ePCT opened to all publication languages (Rule 92)
- Amendments to the PCT Regulations (*entry into force: 1 July 2017*)
 - designated Offices required to provide IB with timely national phase entry and related data (Rules 86 & 95)
 - transmittal by RO of earlier search and/or classification results to ISA, where national law permits (Rules 12*bis*, 23*bis* & 41)

■ Documents:

- (PCT Assembly)

http://www.wipo.int/meetings/en/details.jsp?meeting_id=36343

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2016 PCT Regulation amendments (1)

- Legal basis and procedure for removing/withholding certain sensitive information from public access on applicant's request (Rules 48 & 94)
 - Main change is that IB has authority to exclude from publication and/or public file access information, if (*all three must be met*):
 - information in question “does not obviously serve the purpose of informing the public about the international application” (*must basically be irrelevant to the disclosure*)
 - publication of such information “would clearly prejudice the personal or economic interests of any person” (*harm would result*), **and**
 - “there is no prevailing public interest to have access to that information”
 - Reasoned request by applicant required
 - Time limit to submit Rule 48 request: completion of technical preparations for international publication (15 days before publication date, in most cases)

PCT Assembly
Decisions-3
03.02.2016

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2016 PCT Regulation amendments (2)

- Legal basis and procedure for removing/withholding certain sensitive information from public access on applicant's request (Rules 48 & 94) (cont.)
 - RO, ISA, SISA or IB may draw the applicant's attention to information it believes would qualify, and suggest that applicant make a request
 - IB notifies all relevant Authorities of decision, and where request was granted, they accordingly do not give access under Rule 94
 - Will apply to international applications with an international filing date on or after July 1, 2016

PCT Assembly
Decisions-4
03.02.2016

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2016 PCT Regulation amendments (3)

- Required transmittal by RO to IB of documents submitted in support of requests for restoration of priority right (Rules 26*bis* & 48)
 - **General Rule:** ROs required to forward to IB copies of documents submitted in connection with request for restoration of priority (e.g., declarations or other evidence, in support of the “due care” criterion)
 - **Exceptions:**
 - applicant may request that certain documents NOT be forwarded to the IB
 - “reasoned request” by applicant and same criteria as under Rule 48.2(l)
 - RO may note information that applicant might wish to have excluded, and prompt such a request
 - RO may decide, even without “reasoned request” to not forward certain information
 - Why might an applicant want to have such documents not forwarded to the IB?
 - Medical certificates (which might contain “uncomfortable” information) or extracts from docketing systems (which might contain confidential information) which would become publicly available

PCT Assembly
Decisions-5
03.02.2016

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2016 PCT Regulation amendments (4)

- Required transmittal by RO to IB of documents submitted in support of requests for restoration of priority right (Rules 26*bis* & 48) (cont.)
 - Risk: if key evidence is not submitted to IB, then DOs may decide to review the restoration request in the national phase (under 49*ter*) and this evidence may be required by the DO at that time
 - Will apply to international applications with international filing date on or after July 1, 2016

PCT Assembly
Decisions-6
03.02.2016

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2016 PCT Regulation amendments (5)

- “general unavailability of electronic communications services” as grounds for excuse of delay in meeting certain time limits (Rule 82*quater*)
 - “force majeure” provision has been extended to allow excuse of delay on this basis
 - evidence would need to be provided about the outage, how it prevented the applicant from meeting the time limit, that the relevant action was subsequently taken as soon as reasonably possible, etc.
 - PCT Assembly Understanding:
 - “In adopting the amendments to Rule 82*quater*.1, the Assembly noted that the [Offices and Authorities] should, in considering [such a request], interpret ‘general unavailability of electronic communications’ to apply to outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user.”

PCT Assembly
Decisions-7
03.02.2016

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2016 PCT Regulation amendments (6)

- “general unavailability of electronic communications services” as grounds for excuse of delay in meeting certain time limits (Rule 82*quater*) (cont.)
 - Will apply to:
 - international applications with international filing dates on or after July 1, 2016; and
 - international applications with an international filing date before July 1, 2016 where the “event” occurred on or after July 1, 2016

PCT Assembly
Decisions-8
03.02.2016

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Patent System

2016 PCT Regulation amendments (7)

■ Language of communication with IB via ePCT opened to all publication languages (Rule 92)

- ❑ IB will allow applicants, *IF they are communicating through ePCT*, to write to IB in addition to English and French, in the language of publication of the particular international application
- ❑ Could later be further extended after evaluation of impact/workload...
- ❑ Will apply to:
 - international applications with international filing dates on or after July 1, 2016
 - correspondence received by the IB on or after July 1, 2016 in respect of international applications the international filing dates of which are before July 1, 2016, to the extent provided at the time of promulgation of the Administrative Instructions made under this Rule

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PCT Assembly
Decisions-9
03.02.2016

2017 PCT Regulation amendments (1)

■ Designated Offices required to provide IB with timely national phase entry and related data (Rules 86 & 95)

- ❑ Will provide greater transparency on which applications have entered national phase and where—available on PATENTSCOPE “National phase” tab
- ❑ Data required to be reported:
 - Date national phase entered
 - National application number
 - Number and date of national publication
 - Date of grant, and number and date of national publication as granted
- ❑ Time limit for reporting: 2 months from event (or as soon as reasonably possible thereafter)
- ❑ Assembly Understanding:
 - “In adopting the amendments to Rule 86.1(iv), the Assembly noted that the information concerning national phase entry will be made available to the public not only by way of inclusion in the Gazette on the PATENTSCOPE website but also as part of the bulk PCT bibliographic data offered to Offices and other subscribers to the PATENTSCOPE subscription data services.”

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PCT Assembly
Decisions-10
03.02.2016

2017 PCT Regulation amendments (2)

- Designated Offices required to provide IB with timely national phase entry and related data (Rules 86 & 95) (cont.)
 - Will apply to international applications in respect of which acts required to enter the national phase entry (PCT Art. 22/39) are performed on or after July 1, 2017
 - Assembly strongly encouraged offices to begin to provide this information as soon as possible (and not wait until 2017)
 - Information about national phase non-entry will be especially useful in developing/least developed countries, since such technologies would then be in the public domain

2017 PCT Regulation amendments (3)

- Transmittal by RO of earlier search and/or classification results to ISA (Rules 12*bis*, 23*bis* & 41)
 - **General Rule:** ROs would forward details of search and/or classification results from earlier (priority) applications to the ISA without applicant's express permission, where permitted by national law
 - **Exception:** ROs which have notified IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law are not required to do it (23*bis*.2(e))
 - Even in cases where such forwarding is compatible with the applicable national law, may allow applicants to request to not forward such information at the time of filing if the RO has notified the IB accordingly (before April 14, 2016)
 - Will apply to international applications the international filing dates of which are on or after July 1, 2017

PCT Working Group 2016

■ Among the issues on the agenda will be:

- Proposals for 2016 WG requested by Member States:
 - erroneously filed parts (to try to break impasse on interpretations of rules relating to “missing parts”)
 - provision under which ROs would be required to retain same day priority claims in the application
- Further amendment to Rule 23*bis* which was amended in October 2015 (effective 1 July 2017), requiring ROs to provide ISAs with results of earlier searches and/or classifications carried out on priority applications as national Office
 - Further amendment will clarify relationship between 23*bis*.2(a) and Article 30(2) where earlier application was IA, RO for subsequent IA acted as ISA for earlier IA, and different ISA is being used for subsequent IA
- IB to play greater role in coordinating training for patent examiners in patent offices of developing and least-developed countries
- Proposed pilot to test ePCT national phase entry functionality for IB/DO communication

PCT Assembly
Decisions-13
03.02.2016

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Continued areas of PCT focus (1)

■ Quality:

- Improve the quality and consistency of PCT international phase reports
- Develop quality metrics for measuring usefulness of international phase reports
- Develop quality feedback system for offices (e.g., DO to ISA)
- Explore collaborative search and examination

■ Help designated Offices to better understand reports

- Search strategies, standardized clauses, explanations of relevance of cited documents, etc.

■ Improve timeliness of actions in international phase

- ISAs/IPEAs, ROs (eSearchCopy)

■ Improve access to national search and examination reports

- PATENTSCOPE, WIPO-CASE, Global Dossier

■ Make progress against misleading invitations sent to PCT users

PCT Assembly
Decisions-14
03.02.2016

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Continued areas of PCT focus (2)

■ ePCT: electronic interface to entire PCT international phase process

- ❑ Online electronic preparation and filing with real-time validations (currently with 36 receiving offices, including IB, Algeria, Austria, Australia, Azerbaijan, Brazil, Brunei, Canada, Chile, Colombia, Cuba, Czech Republic, Denmark, EAPO, Estonia, EPO, Finland, Hungary, India, Iceland, Indonesia, Latvia, Malaysia, Mexico, New Zealand, Norway, Philippines, Poland, Portugal, Qatar, Russian Federation, Saudi Arabia, Sweden, Singapore, Turkey and South Africa)
- ❑ Multilingual (10 language) interface available
- ❑ Hoping to have RO/US authorization soon for use of reduced functionality “EFS-Web” mode of ePCT-Filing
- ❑ Bulk ePCT upload by IB possible for users
- ❑ Working on centralized fee payment mechanisms



PCT information available on the Internet (1)

- PCT Treaty and Regulations (www.wipo.int/pct/en/texts/)
- PCT Administrative Instructions (www.wipo.int/pct/en/texts/)
- PCT Applicant's Guide (updated weekly)
(www.wipo.int/pct/guide/en/)
- PCT Newsletter (monthly) (www.wipo.int/pct/en/newslett/)
- PCT Highlights (www.wipo.int/pct/en/highlights/)
- PCT Legal Text Index, providing references to PCT Articles, Rules, Administrative Instructions, Forms and various PCT Guidelines (www.wipo.int/pct/en/texts/pdf/legal_index.pdf)
- Official Notices
(www.wipo.int/pct/en/official_notices/index.html)

PCT information available on the Internet (2)

- PCT Receiving Office Guidelines
(www.wipo.int/pct/en/texts/gdlines.html)
- PCT International Search and Preliminary Examination Guidelines (www.wipo.int/pct/en/texts/gdlines.html)
- WIPO Standards
(www.wipo.int/standards/en/part_03_standards.html)
- PCT Minimum Documentation, Patents and Non-Patent Literature (www.wipo.int/scit/en/standards/pdf/04-01-01.pdf and www.wipo.int/scit/en/standards/pdf/04-02-01.pdf)
- Agreements between International Bureau of WIPO and International Searching and/or Preliminary Examining Authorities
(www.wipo.int/pct/en/access/isa_ipea_agreements.html)

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Help-3
28.04.2015

PCT Applicant's Guide (1)

- Regularly updated, web-based publication, available free-of-charge at www.wipo.int/pct/guide/en/
- Free weekly e-mail updating service detailing updated information
- Contents:
 - International phase
 - instructions concerning the preparation, filing and processing of international applications
 - blank forms (request, demand, power of attorney, etc.)
 - “Annexes” setting out information relevant to each Contracting State and regional or international Organization and each Office and Authority

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Help-4
28.04.2015

PCT Applicant's Guide (2)

- ❑ National phase
 - information on all acts that must or may be performed before the DO/EOs
 - time limits
 - fees
 - blank national forms

Help-5
28.04.2015

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PCT training options

- “Learn the PCT” Video Series
(<http://www.wipo.int/pct/en/training/index.html>)
 - ❑ A series of 29 short videos designed to provide a basic introduction to important aspects and issues in the PCT system (in English)
- PCT Distance Learning Course available in the 10 publication languages
(http://www.wipo.int/pct/en/distance_learning/index.html)
- PCT Webinars
(<http://www.wipo.int/pct/en/seminar/webinars/index.html>)
 - ❑ Free webinars on PCT topics for companies/law firms on request
- More information on the PCT resources website:
www.wipo.int/pct

Help-6
28.04.2015

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Where to get help at WIPO on PCT-related questions (1)

PCT Infoline	Telephone	+41 22 338 83 38
	Fax	+41 22 338 83 39
	e-mail	<i>pct.infoline@wipo.int</i>
PCT Processing Service	Gijsbertus Beijer	+41 22 338 94 79
	Fax	+41 22 338 82 70
Also for questions relating to RO/IB	Gijsbertus Beijer	+41 22 338 92 22
	Fax	+41 22 910 06 10
PCT eServices Help Desk	Telephone	+41 22 338 95 23
	Internet address	www.wipo.int/pct-safe
	e-mail	epct@wipo.int

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Help-7
28.04.2015

Where to get help at WIPO on PCT-related questions (2)

Marketing and Distribution Section (PCT Publications)	Telephones	+41 22 338 96 18
		+41 22 338 99 30
		+41 22 338 95 90
	Fax	+41 22 740 18 12
		+41 22 733 54 28
Order online at	Internet address e-mail	www.wipo.int/ebookshop publications.mail@wipo.int
WIPO Switchboard		+41 22 338 91 11
PCT Internet Site	Internet address	www.wipo.int/pct/en/

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Help-8
28.04.2015

The screenshot shows the WIPO PCT Information Service webpage. At the top, there is a navigation bar with links for Media, Meetings, Contact Us, My Account, and English. Below this is a search bar and a menu with options like IP Services, Policy, Cooperation, Reference, About IP, and Inside WIPO. The main heading is "PCT Information Service".

The PCT Information Service answers general inquiries about the filing of international applications and the procedure to be followed during the international phase of the PCT. For an overview of the PCT system please see *Protecting your Inventions Abroad: Frequently Asked Questions about the Patent Cooperation Treaty (PCT)*.

Please note that correspondence relating to specific international applications should be addressed to the PCT Operations Division, preferably uploaded through ePCT: (this may be done through ePCT public services, which does not require you to obtain a digital certificate) or by facsimile: (+41-22) 338 82 70 or the specific fax number indicated on the forms issued by the International Bureau (IB), or you can contact the "authorized officer" directly.

Specifically and only for inquiries relating to:

- international applications filed directly with the IB in its capacity as receiving Office, or
- international applications transmitted to the IB as receiving Office under PCT Rule 19.4 (that is: where the national (or regional) Office with which the application was filed is not competent to receive the application concerned; where the application is not in a language accepted by that national Office; or for any other reason where the national Office and the IB agree that the procedure under this Rule should apply),

please contact the PCT Receiving and Processing Section of the IB: telephone: (41-22) 338 92 22, facsimile: (41-22) 910 06 10 or e-mail: ro.ib@wipo.int. Further information on filing directly at the IB.

The PCT Information Service can be contacted as follows:

- Telephone: (+41-22) 338 83 38
- Facsimile: (+41-22) 338 83 39
- E-mail: pct.infoline@wipo.int

Telephone opening hours are from 9.00 a.m. to 6.00 p.m. Central European time (from 3.00 a.m. to 12.00 p.m. (noon) US Eastern time zone).

Shortcuts

- For orders of or subscriptions to PCT information products or publications please use the WIPO Electronic Bookshop or contact the Marketing and Distribution Section: publications.ma@wipo.int or facsimile (+41-22) 740 18 12.
- International Bureau closed dates

The screenshot shows the WIPO PATENTSCOPE search interface. At the top, there is a navigation bar with links for Mobile, Deutsch, Español, Français, 日本語, 한국어, Português, and Pycckий. Below this is a search bar and a menu with options like Search, Browse, Translate, Options, News, Login, and Help. The main heading is "Search for Contact Details of the Team in Charge of your PCT Application".

If you wish to ask any questions relating to a specific international patent application, you can contact the "authorized officer" directly. To know who is the authorized officer in charge of your PCT application, type your IA number in the box below; the name and contact details of the staff in charge will appear.

IA Number

Search For e.g. EP2007001234

The screenshot shows the WIPO PATENTSCOPE website interface. At the top, there is a navigation bar with the WIPO logo and the text "PATENTSCOPE Search International and National Patent Collections". Below this is a menu with options: Search, Browse, Translate, Options, News, Login, and Help. The main heading reads "Search for Contact Details of the Team in Charge of your PCT Application". A sub-heading explains: "If you wish to ask any questions relating to a specific international patent application, you can contact the 'authorized officer' directly. To know who is the authorized officer in charge of your PCT application, type your IA number in the box below; the name and contact details of the staff in charge will appear." Below this text is a search form with a text input field containing "US2009051003" and a "Search" button. To the right of the search form, the results for "US2009051003" are displayed in a table:

US2009051003	
Team	PT09
Coordinator	Simin Bahariou
Phone	+41 22 338 74 09
Fax	+41 22 338 71 30
Email	pt09.pct@wipo.int

PCT case law database

■ Text-searchable PCT case law database available at:
www.wipo.int/pctcaselawdb/en

■ Contents:

- decisions from national courts
- decisions from regional administrative bodies
- abstracts and legal references added by IB

■ Any comments or submissions for addition can be sent to the IB at: pct.legal@wipo.int

WIPO – PCT LEGAL DIVISION (1)

Director	Matthew Bryan	+41 22 338 96 01
	Fax	+41 22 910 00 30
	E-mail	pct.legal@wipo.int
PCT Legal Affairs Section	Matthias Reischle-Park	+41 22 338 96 27
	Christine Bonvallet	+41 22 338 70 67
	Masanori Tachibana	+41 22 338 99 16
	Zhilong Yu	+41 22 338 71 79
	Ingrid Aulich	+41 22 338 95 77
	Fabienne Gateau	+41 22 338 95 63
	Margret Fourné-Godbersen	+41 22 338 93 28

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28.04.2015

WIPO – PCT LEGAL DIVISION (2)

PCT Information Services Section	Eva Schumm	+41 22 338 83 38
	Isabel Happe	+41 22 338 83 38
	Anne Gallois-Montbrun	+41 22 338 83 38
	Fax	+41 22 338 83 39
	E-mail	pct.infoline@wipo.int
PCT Outreach and User Relations Section	Quan-Ling Sim	+41 22 338 90 56
	Silke Weiss	+41 22 338 88 44
	Beatriz Largo	+41 22 338 95 72
PCT Legal Publication Section	David Barmes	+41 22 338 93 61
PCT Knowledge Management Section	Rosina Bisi-Kurkdjian	+41 22 338 95 66
	Thomas Henninger	+41 22 338 84 29

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28.04.2015

WIPO – PCT INTERNATIONAL COOPERATION DIVISION

Director	Kenichiro Natsume	+41 22 338 88 87
Senior Counsellor	Ali Jazairy	+41 22 338 8173
Offices Services Section	Rolando Hernandez Vigaud	+41 22 338 86 68
	'Nyalleng Pii	+41 22 338 81 48
	Patrick Genin	+41 22 338 86 67
	Anjali Aeri	+41 22 338 70 66
Technical Cooperation Section	Peter Waring	+41 22 338 85 21
	Carlos Roy	+41 22 338 95 61

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WIPO – PCT BUSINESS DEVELOPMENT DIVISION

Director	Claus Matthes	+41 22 338 98 09
	Fax	+41 22 338 71 50
	Michael Richardson	+41 22 338 91 71
	Ann Bardini	+41 22 338 91 17
	Allal Aloui	+41 22 338 74 24
	Thomas Marlow	+41 22 338 74 23

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