

# The Patent Cooperation Treaty (PCT)



## PCT Update and selected PCT topics of particular interest for paralegals

organized by BELAIPA

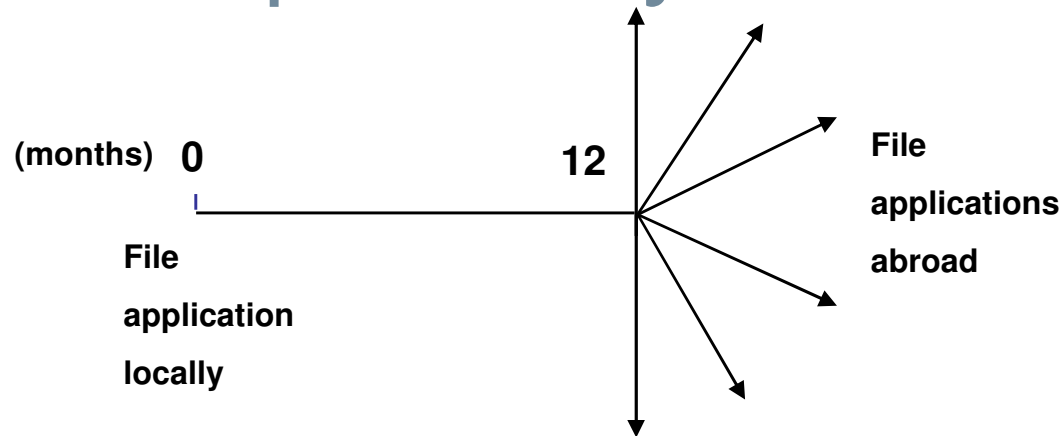
Beerse, March 16, 2023





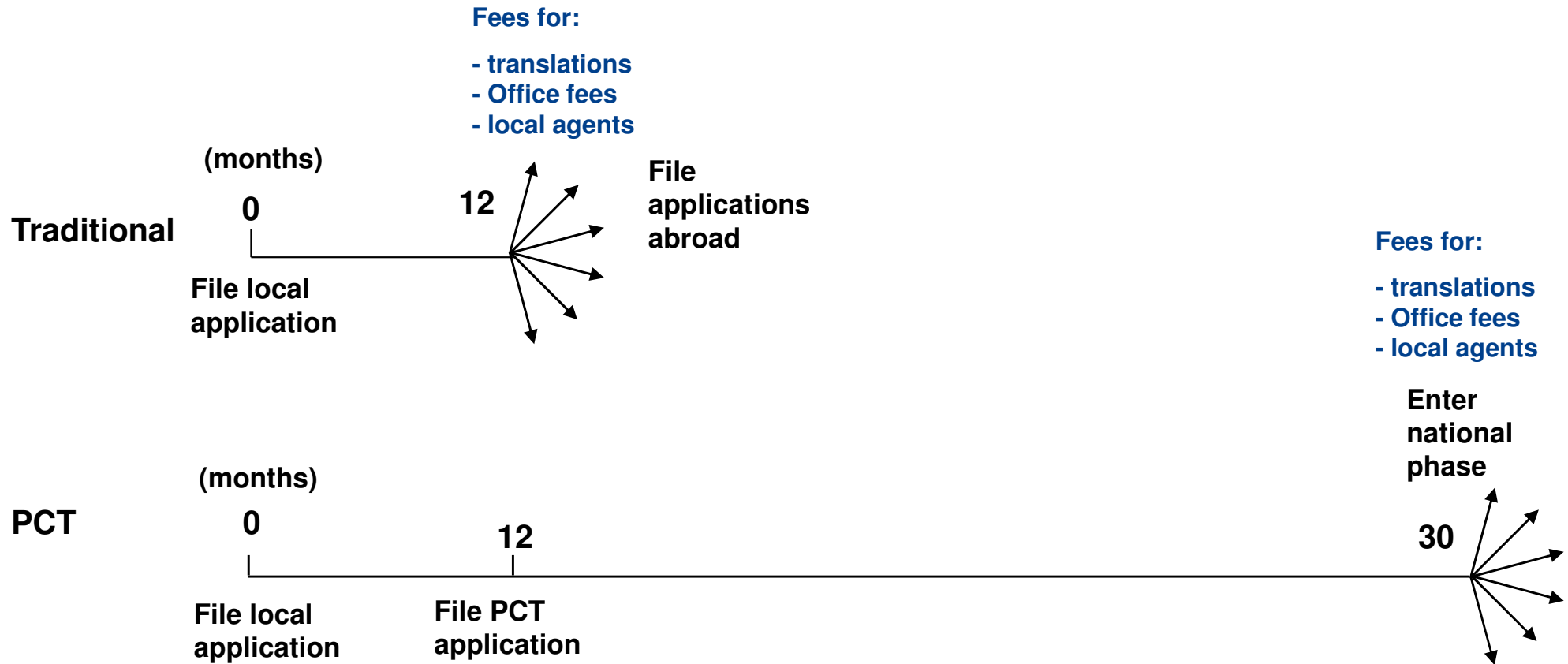
# Brief Review of the PCT Procedure and Time Limits

# Traditional patent systems



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

# Traditional patent system vs. PCT system



# PCT system

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

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

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

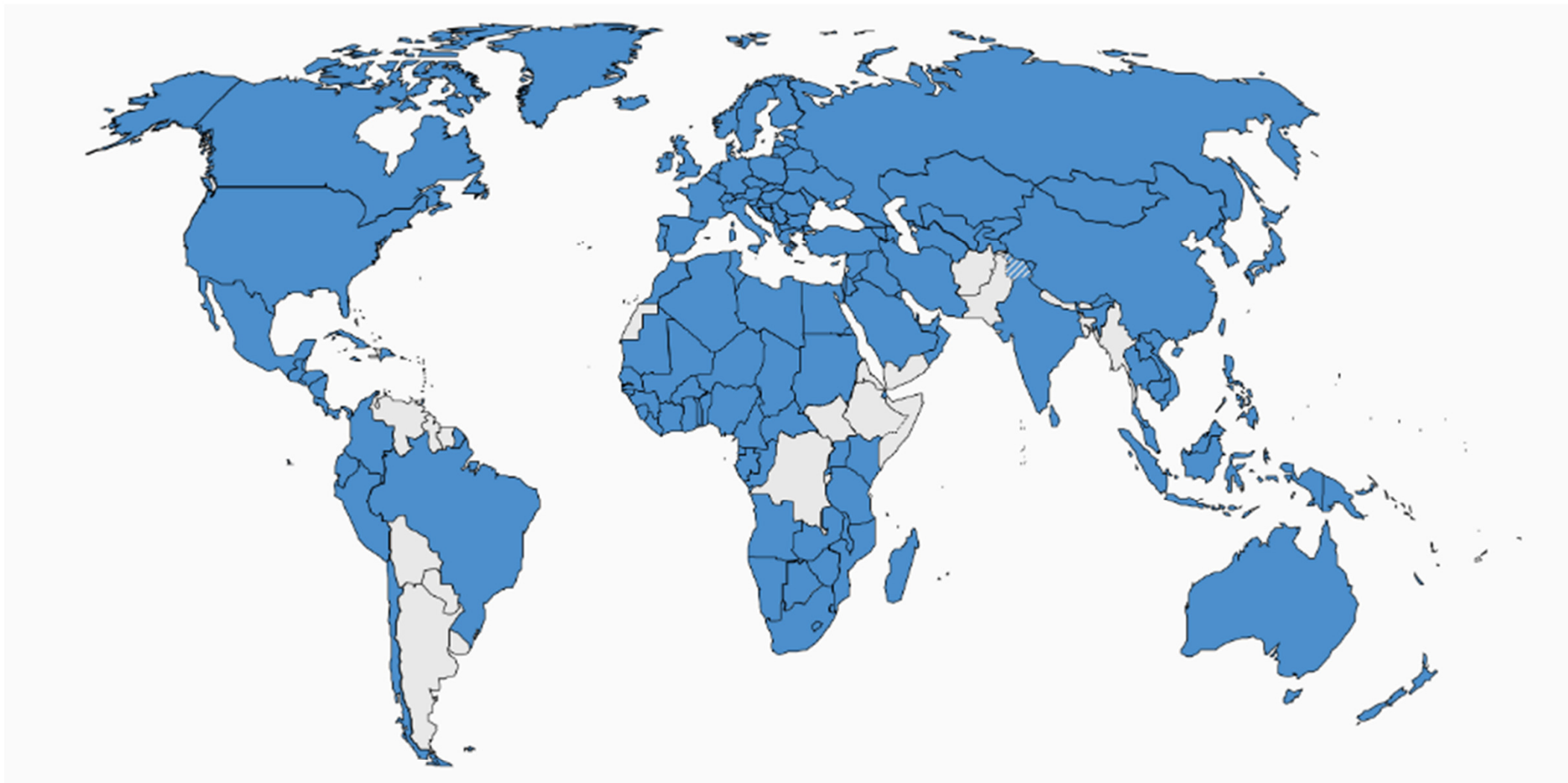
# General remarks on the PCT system (1)

- 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.

# PCT Coverage Today





# PCT Contracting States (157)

*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

- Regional patent only

## EP European Patent

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

IT Italy<sup>2</sup>  
LI Liechtenstein  
\* LT Lithuania  
LU Luxembourg  
\* LV Latvia  
• MC Monaco  
\* ME Montenegro<sup>3</sup>  
MK North Macedonia<sup>1</sup>  
\* MT Malta  
\* NL Netherlands  
NO Norway  
PL Poland  
PT Portugal  
RO Romania  
RS Serbia<sup>1</sup>  
SE Sweden  
\* SI Slovenia  
SK Slovakia  
\* SM San Marino  
TR Türkiye

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)

2 For international applications filed on or after 1 July 2020

3 For international applications filed on or after 1 October 2022; extension agreement continues to apply to

# PCT Contracting States (157) (continued)

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

## AP ARIPO Patent

BW Botswana  
CV Cabo Verde (as of 14.10.2022)  
GH Ghana  
GM Gambia  
KE Kenya  
LR Liberia  
LS Lesotho  
MW Malawi  
MZ Mozambique  
NA Namibia  
RW Rwanda  
SC Seychelles (as of 01.01.2022)  
SD Sudan  
SL Sierra Leone  
ST Sao Tome and Principe  
\* SZ Eswatini  
TZ United Republic of Tanzania  
UG Uganda  
ZM Zambia  
ZW Zimbabwe

## OA OAPI Patent

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

\* Regional patent only

# PCT Contracting States (157) (continued)

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

AE	United Arab Emirates	ID	Indonesia	MY	Malaysia
AG	Antigua and Barbuda	IL	Israel	NG	Nigeria
AO	Angola	IN	India	NI	Nicaragua
AU	Australia	IQ	Iraq (as of 30.04.2022)	NZ	New Zealand
* BA	Bosnia and Herzegovina	IR	Islamic Republic of Iran	OM	Oman
BB	Barbados	JM	Jamaica (as of 10.02.2022)	PA	Panama
BH	Bahrain	JO	Jordan	PE	Peru
BN	Brunei Darussalam	JP	Japan	PG	Papua New Guinea
BR	Brazil	** KH	Cambodia	PH	Philippines
BZ	Belize	KM	Union of the Comoros	QA	Qatar
CA	Canada	KN	Saint Kitts and Nevis	SA	Saudi Arabia
CL	Chile	KP	Democratic People's Republic of Korea	SG	Singapore
CN	China	KR	Republic of Korea	ST	Sao Tome and Principe
CO	Colombia	KW	Kuwait	SV	El Salvador
CR	Costa Rica	LA	Lao People's Democratic Republic	SY	Syrian Arab Republic
CU	Cuba	LC	Saint Lucia	TH	Thailand
CV	Cabo Verde (as of 06.07.22)	LK	Sri Lanka	** TN	Tunisia
DJ	Djibouti	LY	Libya	TT	Trinidad and Tobago
DM	Dominica	** MA	Morocco	UA	Ukraine
DO	Dominican Republic	** MD	Republic of Moldova	US	United States of America
DZ	Algeria	MG	Madagascar	UZ	Uzbekistan
EC	Ecuador	MN	Mongolia	VC	Saint Vincent and the Grenadines
EG	Egypt	MU	Mauritius (as of 15.03.23)	VN	Viet Nam
GD	Grenada	MX	Mexico	WS	Samoa
GE	Georgia			ZA	South Africa
GT	Guatemala				
HN	Honduras				

\* Extension of European patent possible

\*\* Validation of European patent possible

# Countries not yet PCT Contracting States (36)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Democratic Republic of Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Kiribati

Lebanon

Maldives

Marshall Islands

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

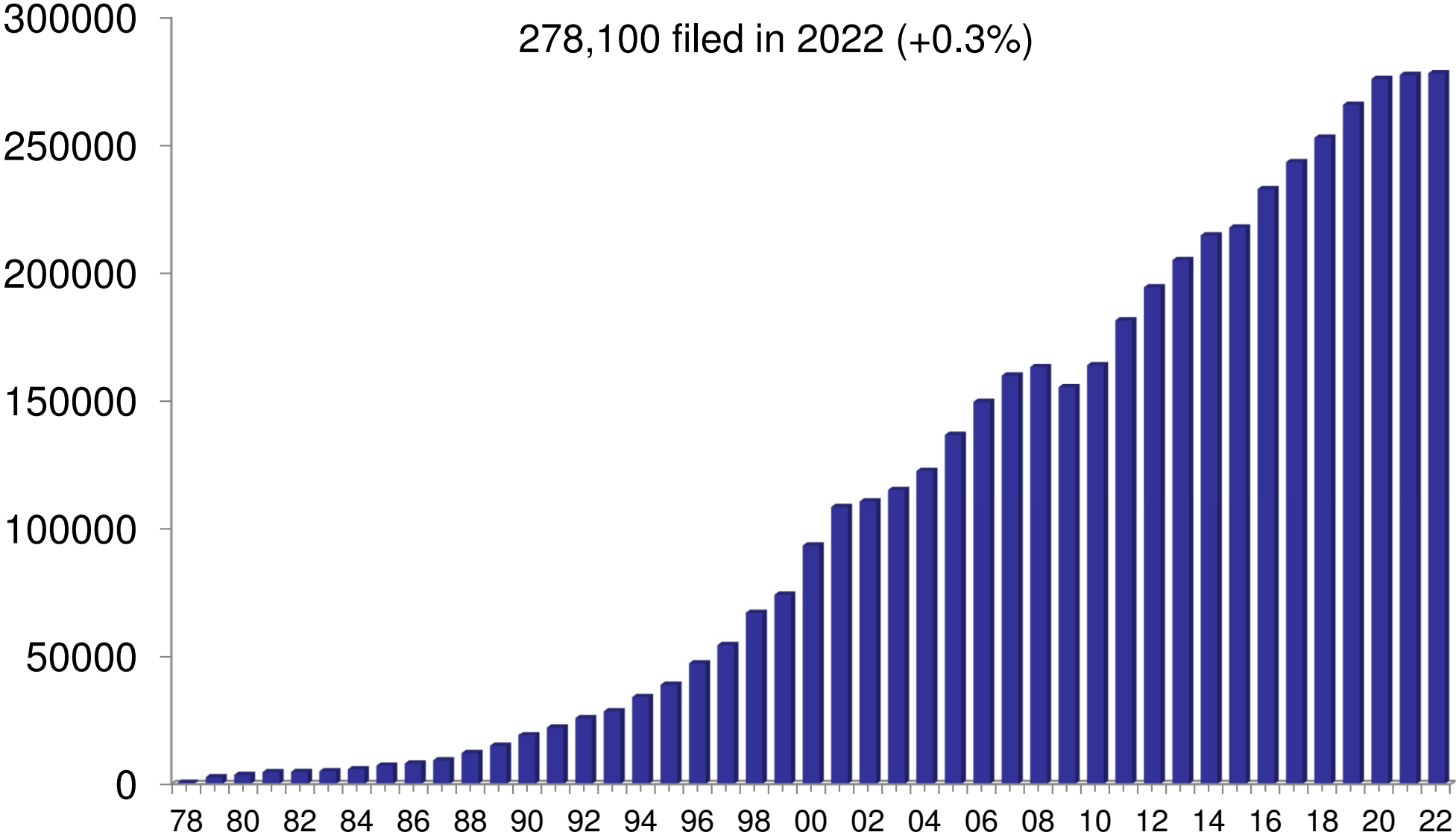
Uruguay

Vanuatu

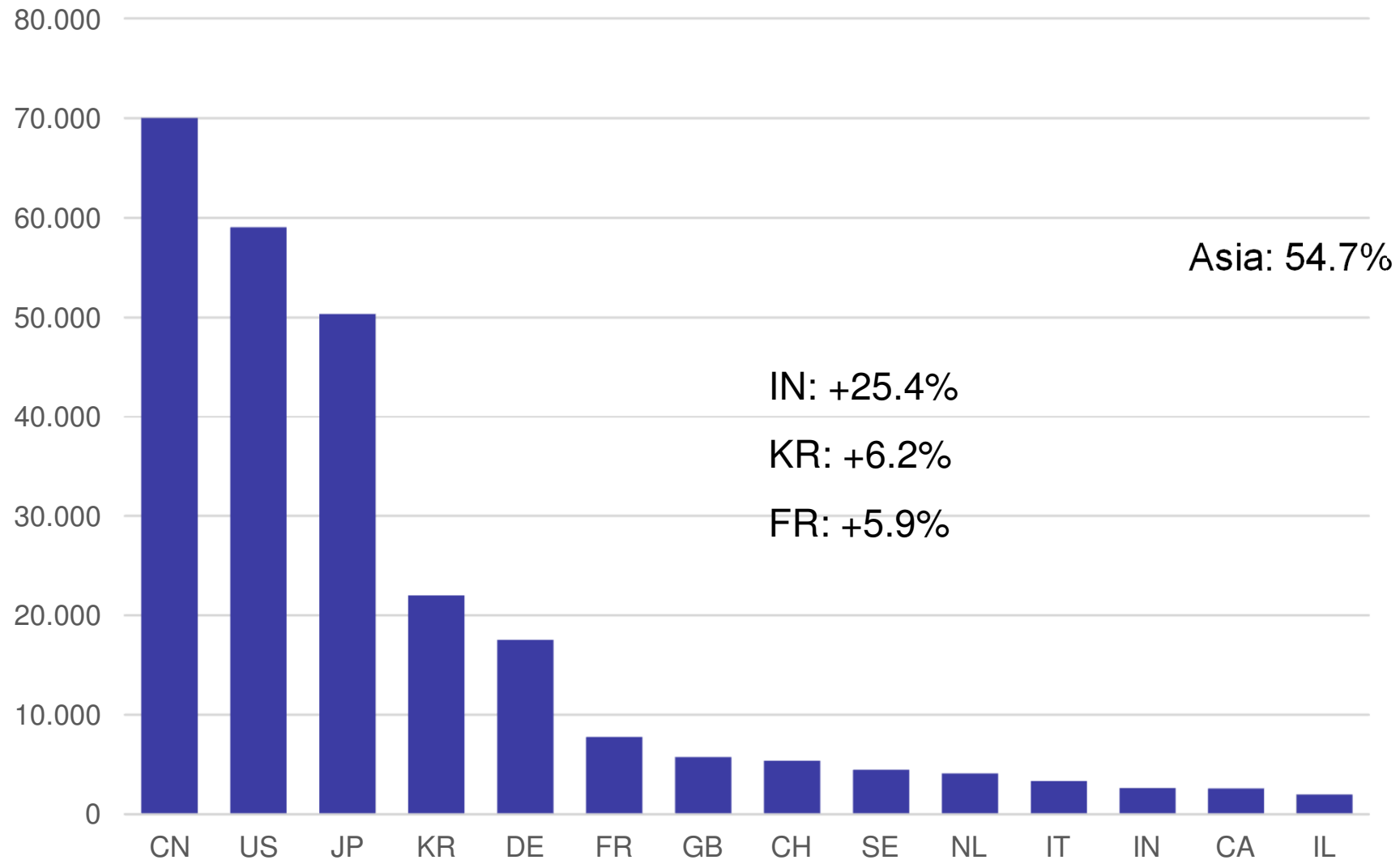
Venezuela

Yemen

# Growth in PCT applications 1978-2022



# International applications in 2022 by country of origin



- 25% originating in China, 21% in US, 18% in Japan
- 64% from the top 3 countries, 79% from top 5 countries, 92% of filings from top 15 countries

# PCT applications 2022 by technology field

## Annex 4: International applications by field of technology (PCT System)

Technical Field	2020	2021	2022	Share (%)	Growth (%)
<b>I Electrical engineering</b>					
1 Electrical machinery, apparatus, energy	17,367	18,229	19,348	7.1	6.1
2 Audio-visual technology	11,534	10,839	10,157	3.7	-6.3
3 Telecommunications	6,445	6,375	6,426	2.4	0.8
4 Digital communication	22,079	23,609	25,664	9.4	8.7
5 Basic communication processes	1,610	1,647	1,697	0.6	3.0
6 Computer technology	24,344	26,109	28,220	10.4	8.1
7 IT methods for management	5,891	5,298	5,374	2.0	1.4
8 Semiconductors	8,862	8,346	8,912	3.3	6.8
<b>II Instruments</b>					
9 Optics	8,371	7,920	7,395	2.7	-6.6
10 Measurement	12,704	12,158	12,645	4.6	4.0
11 Analysis of biological materials	2,062	2,154	2,248	0.8	4.4
12 Control	5,457	5,181	5,252	1.9	1.4
13 Medical technology	17,500	18,553	19,014	7.0	2.5
<b>III Chemistry</b>					
14 Organic fine chemistry	6,351	6,155	6,494	2.4	5.5
15 Biotechnology	7,985	8,747	9,334	3.4	6.7
16 Pharmaceuticals	10,767	12,160	12,553	4.6	3.2
17 Macromolecular chemistry, polymers	4,656	4,479	4,652	1.7	3.9
18 Food chemistry	2,383	2,468	2,578	0.9	4.5
19 Basic materials chemistry	5,712	5,484	5,552	2.0	1.2
20 Materials, metallurgy	4,685	4,314	4,632	1.7	7.4
21 Surface technology, coating	4,014	3,834	3,979	1.5	3.8
22 Micro-structural and nano-technology	456	440	422	0.2	-4.1
23 Chemical engineering	5,285	5,230	5,503	2.0	5.2
24 Environmental technology	3,020	2,771	2,841	1.0	2.5
<b>IV Mechanical engineering</b>					
25 Handling	6,413	6,258	6,575	2.4	5.1
26 Machine tools	4,315	4,308	4,282	1.6	-0.6
27 Engines, pumps, turbines	5,123	4,443	4,369	1.6	-1.7
28 Textile and paper machines	2,952	2,623	2,425	0.9	-7.5
29 Other special machines	7,483	7,232	7,274	2.7	0.6
30 Thermal processes and apparatus	4,306	3,928	4,034	1.5	2.7
31 Mechanical elements	5,847	5,162	5,048	1.9	-2.2
32 Transport	11,290	10,117	10,051	3.7	-0.7
<b>V Other fields</b>					
33 Furniture, games	4,718	4,491	4,933	1.8	9.8
34 Other consumer goods	6,045	5,842	6,331	2.3	8.4
35 Civil engineering	6,502	6,319	5,940	2.2	-6.0

# Top PCT applicants in 2022

1. Huawei Technologies—CN (7,689)
2. Samsung—KR (4,387)
3. Qualcomm—US (3,855)
4. Mitsubishi Electric—JP (2,320)
5. Ericsson—SE (2,158)
6. Guang Dong Oppo Mobile Telecom—CN (1,963)
7. Nippon Telegraph & Telephone—JP (1,884)
8. BOE Technology Group—CN (1,884)
9. LG Electronics—KR (1,793)
10. Panasonic—JP (1,776)
11. Vivo Mobile Communications—CN (1,515)
12. Sony—JP (1,513)
13. ZTE—CN (1,479)
14. NEC —JP (1,428)
15. Robert Bosch Corp —DE (1,290)

*( ) of published  
PCT applications*



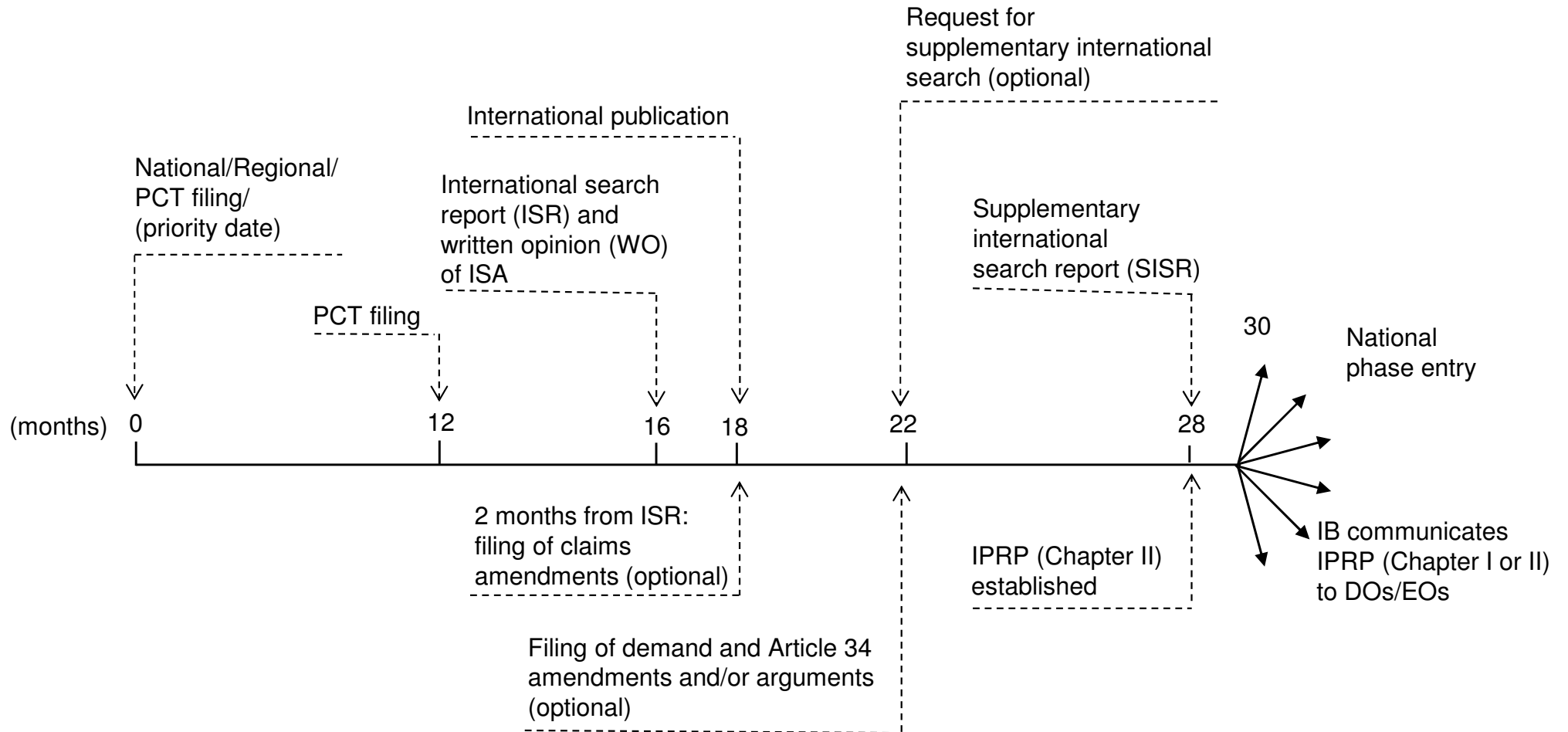
# Top PCT University applicants in 2022

1. University of California (US)
2. Zhejiang University (CN)
3. Suzhou University (CN)
4. Stanford University(US)
5. University of Texas (US)
6. Tsinghua University (CN)
7. Massachusetts Institute of Technology (US)
8. Johns Hopkins University (US)
9. Seoul National University (KR)
10. Hanyang University (KR)
11. Yonsei University (KR)
12. Korea University (KR)
13. National University of Singapore (SG)
14. Jiangnan University (CN)
15. Jiangsu University (CN)



# PCT Timeline

# PCT TIMELINE




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

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

LU      Luxembourg

TZ      United Republic of Tanzania

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



**WIPO Standard ST.26**  
**New requirement for presenting nucleotide  
and amino acid sequences**

# Why a new Standard?

- Compliance with international sequence database standards
- Reflect advances in biotechnology
  - E.g., branched sequences, D-amino acids and nucleotide analogs
- Structured data allows automated validations and facilitates data exchange
- Harmonize practices across all patent offices

# ST.25 versus ST.26

ST.25	ST.26
ASCII .txt with numeric identifiers	XML with elements and attributes
Not required to include: <ul style="list-style-type: none"><li>- D-amino acids</li><li>- Linear portions of branched sequences</li><li>- Nucleotide analogs</li></ul>	Must include: <ul style="list-style-type: none"><li>- D-amino acids</li><li>- Linear portions of branched sequences</li><li>- Nucleotide analogs</li></ul>
Annotation of sequences: <ul style="list-style-type: none"><li>- Feature keys only</li></ul>	Annotation of sequences: <ul style="list-style-type: none"><li>- Feature keys and qualifiers</li></ul>
Permitted to include sequences: <ul style="list-style-type: none"><li>- &lt; 10 specifically defined nucleotides</li><li>- &lt; 4 specifically defined amino acids</li></ul>	Prohibited sequences: <ul style="list-style-type: none"><li>- &lt; 10 specifically defined nucleotides</li><li>- &lt; 4 specifically defined amino acids</li></ul>

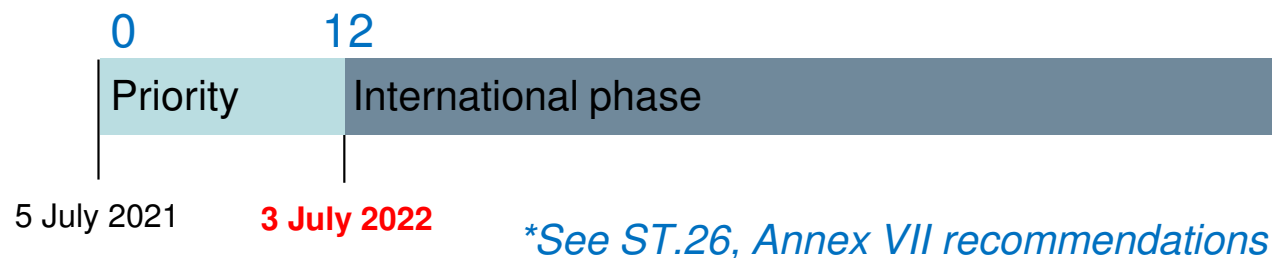
# ST.26 Sequence Listing

```
▼<SequenceData sequenceIDNumber="5">
  ▼<INSDSeq>
    <INSDSeq_length>12</INSDSeq_length>
    <INSDSeq_moltype>DNA</INSDSeq_moltype>
    <INSDSeq_division>PAT</INSDSeq_division>
    ▼<INSDSeq_feature-table>
      ▼<INSDFeature>
        <INSDFeature_key>source</INSDFeature_key>
        <INSDFeature_location>1..12</INSDFeature_location>
        ▼<INSDFeature_qual>
          ▼<INSDQualifier>
            <INSDQualifier_name>organism</INSDQualifier_name>
            <INSDQualifier_value>synthetic construct</INSDQualifier_value>
          </INSDQualifier>
          ▼<INSDQualifier>
            <INSDQualifier_name>mol_type</INSDQualifier_name>
            <INSDQualifier_value>other DNA</INSDQualifier_value>
          </INSDQualifier>
        </INSDFeature_qual>
      </INSDFeature>
      ▼<INSDFeature>
        <INSDFeature_key>misc_feature</INSDFeature_key>
        <INSDFeature_location>12</INSDFeature_location>
        ▼<INSDFeature_qual>
          ▼<INSDQualifier>
            <INSDQualifier_name>note</INSDQualifier_name>
            <INSDQualifier_value>cytosine attached to a C3 spacer, which is joined to another nucleic acid</INSDQualifier_value>
          </INSDQualifier>
        </INSDFeature_qual>
      </INSDFeature>
    </INSDSeq_feature-table>
    <INSDSeq_sequence>atgcatgcatgc</INSDSeq_sequence>
  </INSDSeq>
</SequenceData>
```



# ST.26 applicability

- ST.26 applies to all patent applications having a *filing date* on or after 1 July 2022.
  - NOT based on the priority date!



- ST.25 continues to apply to applications filed on or before June 30, 2022



# PCT requirements (Rule 5.2(a))

- Where the international application contains disclosure of nucleotide and/or amino acid sequences that, pursuant to the Administrative Instructions, are **required to be included in a sequence listing**, the description shall include **a sequence listing part of the description** complying with the standard provided for in the Administrative Instructions (WIPO Standard **ST.26**)

# Sequence listing filed on international filing date

- Can only be considered a sequence listing part of the description if filed in the correct format (XML)
  - Application filed electronically
    - Separate XML file containing sequence listing
  - Application filed on paper
    - sequence listing in XML on physical media
- RO only required to confirm the correct file type (XML)
- If filed in ST.25, cannot simply replace with ST.26
  - Applicant may only add the content as sheets of the description

# Non-compliant file type submissions

- RO informs the applicant that the sequence listing must be filed in XML under ST.26
- Invites the applicant to confirm addition of the content as sheets of the main part of the description
  - May require additional fee (sheets in excess of 30)
- If no confirmation/payment, the submission will not be part of the international application

# Sequence listing language requirements (Rule 12)

- Only applies to the language-dependent free text
- Each RO determines the language(s) it accepts
  - May be different from the language of the main body of the application
  - RO/IB accepts any language
- RO may permit more than one language
  - English + another
- Transmittal to RO/IB under Rule 19.4

# Subsequently furnished sequence listing

- Sequence listing part of the description (Rule 5.2(a))
  - Incorporation by reference
    - Priority contains ST.25 → pages of description
    - Priority contains ST.26 → ST.26 sequence listing part of the description
  - To complete (Rule 20.5(a)(i)) or correct (Rule 20.5*bis*(a)(i)) the international application
    - Results in a change in international filing date
  
- Furnished for search purposes only (Rule 13*ter*)?

# Sequence listing for search purposes (Rule 13*ter.*1) (1)

- International Authorities may invite the applicant to furnish a standard-compliant sequence listing
  - in a language accepted by the ISA
  - with a statement that it does not go beyond the original disclosure
  - late furnishing fee
- If the applicant fails to furnish a standard-compliant sequence listing, the ISA is only required to search to the extent a meaningful search can be done without the sequence listing

# Sequence listing for search purposes (Rule 13*ter*.1) (2)

- A sequence listing furnished for search (Rule 13*ter*) does not form part of the international application
- The ISA forwards any Rule 13*ter* sequence listing to the International Bureau, to be made available on PATENTSCOPE



# International publication

- Sequence listing published as a separate XML file
- WIPO has develop a sequence listing reader integrated into PATENTSCOPE

**1 Sequence Listing Information**

1-1	File Name	SARS-COV-2-Ab-ZJU.xml
1-2	DTD Version	VI_3
1-3	Software Name	WIPO Sequence
1-4	Software Version	2.1.0
1-5	Production Date	2022-07-18

**2 General Information**

2-1	Current application: IP Office	
2-2	Current application: Application number	
2-3	Current application: Filing date	
2-4	Current application: Applicant file reference	P2022040Z
2-5	Earliest priority application: IP Office	CN
2-6	Earliest priority application: Application number	202110888463.6
2-7	Earliest priority application: Filing date	2021-08-03
2-8zh	Applicant name	浙江大学医学院附属第一医院
2-8en	Applicant name: Name Latin	The First Affiliated Hospital, Zhejiang University School of Medicine
2-9	Inventor name	
2-9en	Inventor name: Name Latin	
2-10zh	Invention title	人源化广谱高中和活性抗新型冠状病毒单克隆抗体及应用
2-11	Sequence Total Quantity	16

**3-1 Sequences**

3-1-1	Sequence Number [ID]	1
3-1-2	Molecule Type	AA
3-1-3	Length	125
3-1-4-1	Features Location/Qualifiers	source 1..125 mol_type=protein organism=Homo sapiens
3-1-5	Residues	<p>QMQLVQSGPE VKKPGTSVKV SCRASGFTFT NSAMQWVRQA RGQRLEWVGW IVVASGNANS 60</p> <p>ARRFHDRVTI TSDMSTSTAY LELSSLRSED TAVYYCALNH CSNTTCLDGF DIWGQGTMVS 120</p> <p>VSSAS 125</p>

**3-2 Sequences**

3-2-1	Sequence Number [ID]	2
3-2-2	Molecule Type	DNA



# National phase requirements (Rules 13*ter*.3 and 49.5(a-*bis*))

- No DO/EO may require a sequence listing other than one complying with WIPO Standard ST.26
- Offices may require translation of the free text contained in the sequence listing:
  - into a language the Office accepts for the free text contained in the sequence listing
  - may also require translation into English if required by database providers

# WIPO Sequence Software

- WIPO Sequence (for users)
  - Free desktop tool developed by WIPO to support authoring, validation, and generation of ST.26 compliant sequence listings
  - <https://www.wipo.int/standards/zh/sequence/index.html>
  - Subscribe for updates
- Remember to always validate the sequence listing before filing!

# Practical implications (1)

1. PCT application was filed on February 3, 2022. Should the applicant furnish an ST.26 XML sequence listing as a follow-on submission after July 1, 2022? For search purposes? For national phase entry after July 1, 2022?

*No, ST.25 applies to applications filed before July 1, 2022*

2. If a PCT application claims priority to an application with an ST.25 sequence listing, is it necessary to transform that sequence listing to WIPO ST.26 XML format if the PCT application is filed on July 7, 2022?

*Yes*

# Practical implications (2)

3. Are receiving Offices responsible for verifying sequence listings?

*ROs may but are not required to check for ST.26 compliance;  
Standard compliance will be checked by the ISA*

4. If after July 1, 2022, the PCT application is filed with a ST.25 TXT listing, can you subsequently furnish ST.26 XML to form part of the description?

*It will affect the international filing date, unless incorporation by reference applies or later amended (Art. 34 or at national phase)*

# Practical implications (3)

5. Does a sequence listing furnished for search (Rule 13*ter*) form part of the international application?

*No, the description should be later amended*

6. Are sequence listings furnished for search under Rule 13*ter* transmitted to DO/EOs?

*Rule 13ter sequence listings are not published as part of the international application, but they are made available to Offices on PATENTSCOPE as part of the file.*

# ST.26 Training & Resources

- [WIPO Standard ST.26](#)
- [WIPO Sequence software download](#)
- Training webinars
  - [WIPO ST.26: Introduction](#)
  - [WIPO ST.26: Advanced](#)
  - [WIPO Sequence](#)
- [WIPO Standard ST.26 FAQs](#)
- [WIPO Sequence and ST.26 Knowledge Base](#)



# Need more help?

- For ST.26 technical questions:

[wiposequence@wipo.int](mailto:wiposequence@wipo.int)

- General PCT questions:

[pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)



# ■ ePCT Update (January 2023)


# Introduction

- New version released on 24 January 2023
- [What's New for Applicants in ePCT](#)
  - New process for requesting access rights
  - WIPO Standard ST.26 for Sequence Listings
  - ePCT-Filing: .zip file type for XML specification; new online payment method for RO/IB
  - Action: Rule 92bis change request; File reference update
  - Others: Declarations under Rule 4.17; Workbench - Filters; ePCT Messages

# Request Access Rights after Filing (1)

- Access rights requests are no longer sent to the IB but instead are sent to the e-mail for correspondence for the applicant/agent on record at the IB

**FIND IA OUTSIDE OF MY WORKBENCH**

International Application Number * PCT/IB2022/040040	International Filing Date * 01/02/2022	
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Reason \*

- Request access rights
- Upload Documents
- View contents
- Third Party Observations

# Request Access Rights after Filing (2)

- ePCT compares the e-mail of the WIPO Account of the current user with the e-mail for correspondence for the applicant/agent on record at the IB
  - If both e-mails are the same, access rights are automatically granted to the current user and any access rights group that was selected as part of the request
  - If the e-mails are not the same, the user is presented with an online form to submit the access rights request to the applicant/agent
    - applicant/agent to approve or refuse the access rights request via a link to a dedicated webpage

# Request Access Rights after Filing (3)

## ■ FAQ

[Action - Request access rights to an international application after filing](#)

## ■ ePCT Video Tutorial



[Request Access Rights after Filing](#)

# WIPO Standard ST.26 for sequence listings

- [WIPO Standard ST.26](#) applies for applications filed on or after 1 July 2022
- WIPO Sequence software should be used to create sequence listings in compliance with WIPO Standard ST.26, in XML format
- ST.25 still applies for applications filed before 1 July 2022 (.txt, .app, .zip)
- BiSSAP (EPO) & PatentIn (USPTO) can only be used to produce ST.25 sequence listings

# WIPO Sequence: Installation & Updates

- Download WIPO Sequence from <https://www.wipo.int/standards/en/sequence/index.html>
- Available for Windows, Mac OSX and Linux O/S
- ALWAYS UPDATE TO THE LATEST VERSION  
(version 2.1.1)
- Auto-update functionality – indicates when new version available
- Patches for bugs will be provided as required
- User manual available at: <https://www.wipo.int/export/sites/www/standards/en/sequence/wipo-sequence-manual-2-1-0.pdf>



# ePCT Filing: SL in ST.26 Format

- At the time of adding a sequence listing file in ST.26 format, the applicant/agent's file reference and the applicant name is extracted and temporarily displayed in the interface to help the user spot if perhaps the wrong file was added in error

Sequence listing part of the description  
ST26\_SEQ1.xml 4 KB  
Applicant/agent's file reference ABC123  
Name O'Neill, KIM LESLIE

# WIPO Sequence: Resources

- Training recordings can be found at:

[https://www.wipo.int/meetings/en/topic.jsp?group\\_id=330](https://www.wipo.int/meetings/en/topic.jsp?group_id=330)

- WIPO ST.26 and Sequence knowledge base can be found at:

<https://www3.wipo.int/confluence/display/WSSKB/WIPO+Sequence+and+ST.26+Knowledge+Base+Home>

- Subscribe for important updates at:

<https://www.wipo.int/standards/en/sequence/signup.html>

- Contact us at:

[https://www3.wipo.int/contact/en/area.jsp?area=wipo\\_sequence](https://www3.wipo.int/contact/en/area.jsp?area=wipo_sequence)

# ePCT Filing: zip added as file type for XML specification

- In order to optimize performance, it is strongly recommended to zip all the .xml and image files making up the specification and to attach a single .zip file

The specification is attached as:

- PDF format - separate files for description, claims, abstract, drawings [\[Tips for converting to PDF\]](#)
- PDF format - single specification for description, claims, abstract [drawings can be included or attached separately]
- DOCX format - for conversion to Application Body XML [\[Template file\]](#) [\[User guide\]](#) [\[Sample file\]](#)
- XML format - full application body

Application Body XML  
EN - English

Add documents [ zip, .xml, .jpg, .tif, .st33, .st35]

For optimized performance, it is recommended to attach a single .zip file (containing xml and all images).

# ePCT Filing: Online Payment of Filing Fees for RO/IB

- Bank payment online (secured by SOFORT)
  - A new [online payment method](#) on the WIPO Pay platform for the payment of filing fees in Swiss francs (CHF) to the RO/IB
  - Can be used by applicants who have accounts with participating banks in a number of European countries
  - Use of SOFORT as an [online](#) banking transaction is strongly encouraged where possible
    - it enables WIPO's accounting systems to process payments more efficiently than offline bank transfers as the WIPO Pay reference data is already automatically included as part of the process

# ePCT Actions: Rule 92bis Change Request

- A new validation is added to ensure that an e-mail address is always available for sending PCT forms to the recipient entitled to receive correspondence for the international application

**SUBMIT REQUEST** 1 issue

For communication purposes, an email address must be indicated for DOE, John

Add informal message

Signature type

- Text signature
- Image signature
- Document(s) signed by Applicant/Agent included in the attachment(s)
- External Signature

Signatory \*

BLACK, Joseph [Agent]

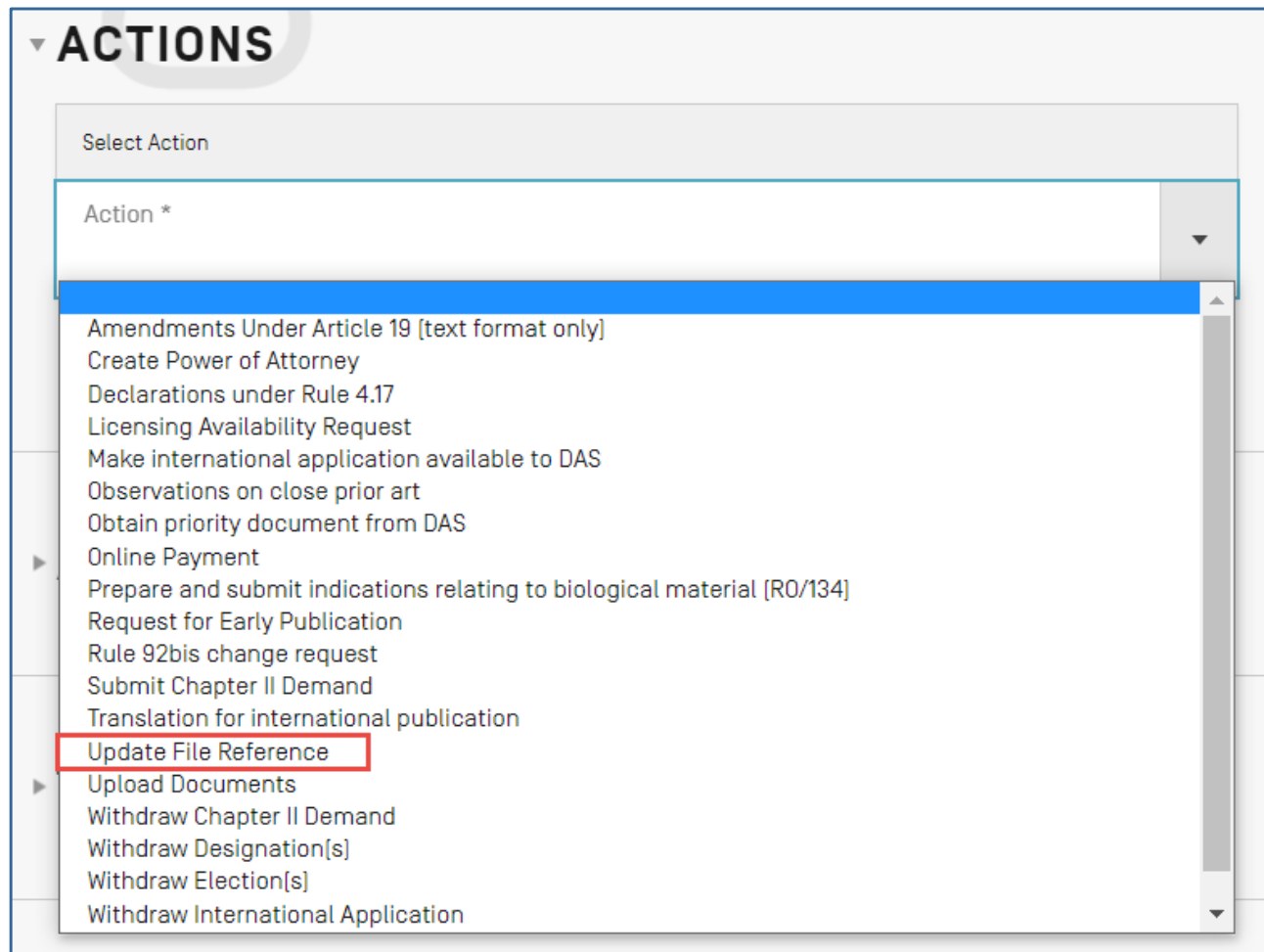
Signature (should include full name) \*

/ Joseph BLACK /

Full name automatically added as text signature

# ePCT Actions: Update File Reference

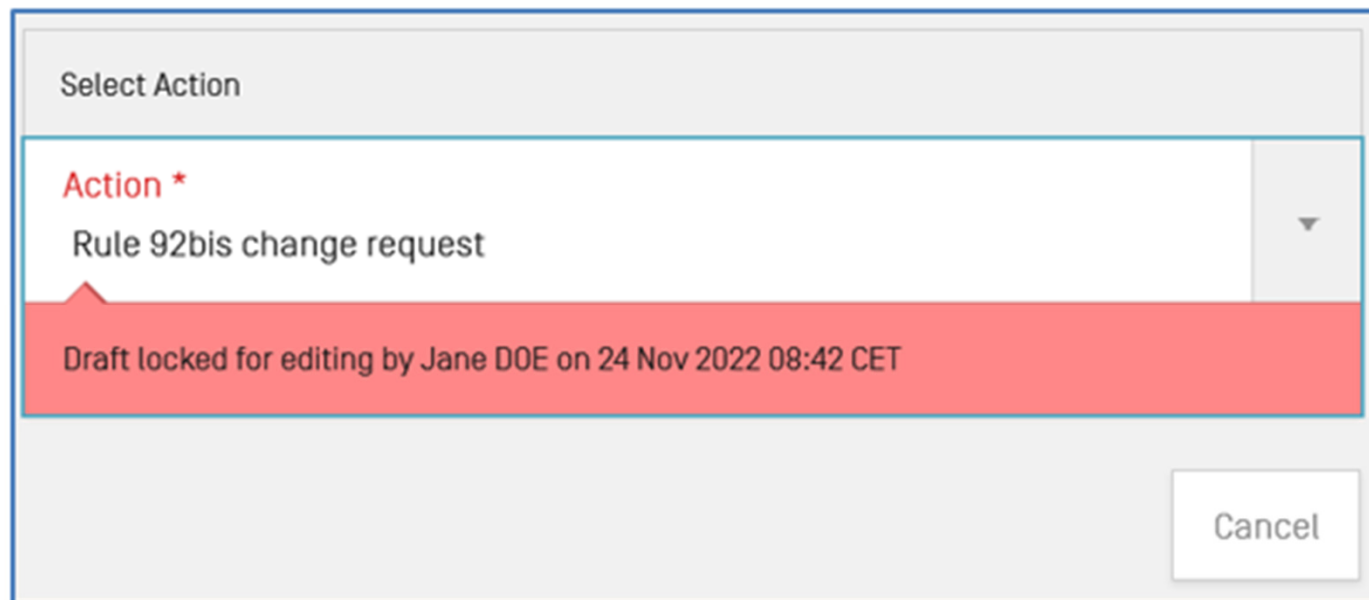
- New ePCT Action allows you to modify the applicant/agent's file reference



The screenshot shows a web interface for ePCT Actions. At the top, there is a dropdown menu labeled 'ACTIONS'. Below it, a 'Select Action' field is visible. A list of actions is displayed, with 'Update File Reference' highlighted in a red box. The list includes various actions such as 'Amendments Under Article 19 (text format only)', 'Create Power of Attorney', 'Declarations under Rule 4.17', 'Licensing Availability Request', 'Make international application available to DAS', 'Observations on close prior art', 'Obtain priority document from DAS', 'Online Payment', 'Prepare and submit indications relating to biological material [R0/134]', 'Request for Early Publication', 'Rule 92bis change request', 'Submit Chapter II Demand', 'Translation for international publication', 'Update File Reference', 'Upload Documents', 'Withdraw Chapter II Demand', 'Withdraw Designation(s)', 'Withdraw Election(s)', and 'Withdraw International Application'.

# Actions Locked for Editing

- If a draft Action is being edited by one user, it cannot be edited by another user at the same time
- The name of the user who is editing the draft Action is displayed for information



The screenshot shows a 'Select Action' dialog box. At the top, it says 'Select Action'. Below that is a dropdown menu with the text 'Action \*' and 'Rule 92bis change request'. A red banner with a white triangle on the left side is overlaid on the dropdown, containing the text 'Draft locked for editing by Jane DOE on 24 Nov 2022 08:42 CET'. At the bottom right of the dialog box is a 'Cancel' button.

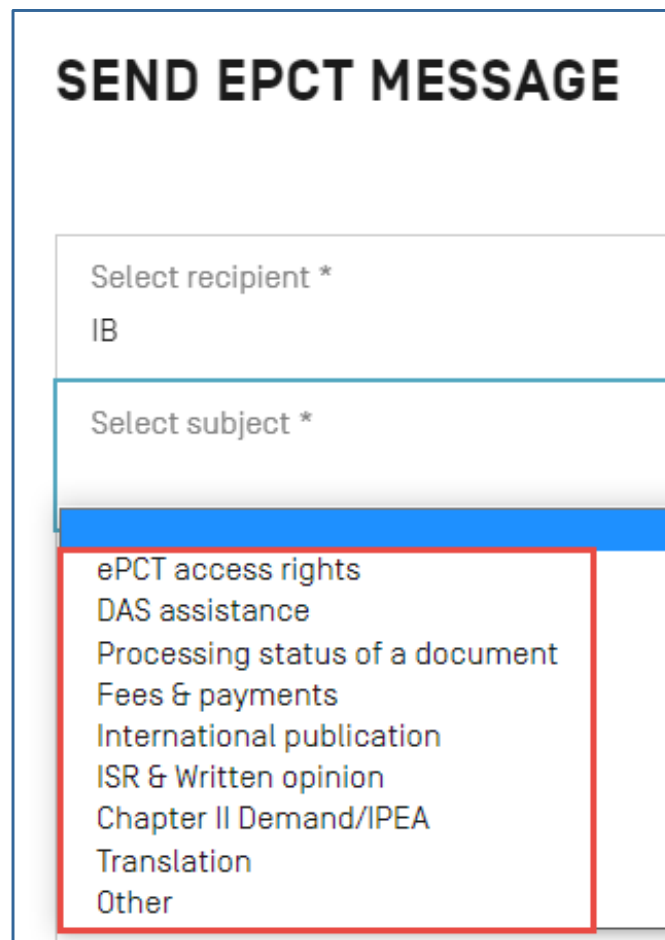
# Declarations under Rule 4.17

- Process improved for Declarations under Rule 4.17(iv)
  - Possible to manage the external signature requests per declaration
    - for example, to delete individual external signature requests if required, without affecting the external signature status of the other declarations



# ePCT Messages

- Possible to select the subject of your ePCT Message from a dropdown list of pre-defined topics
  - 'Other' is for typing free text



**SEND EPCT MESSAGE**

Select recipient \*

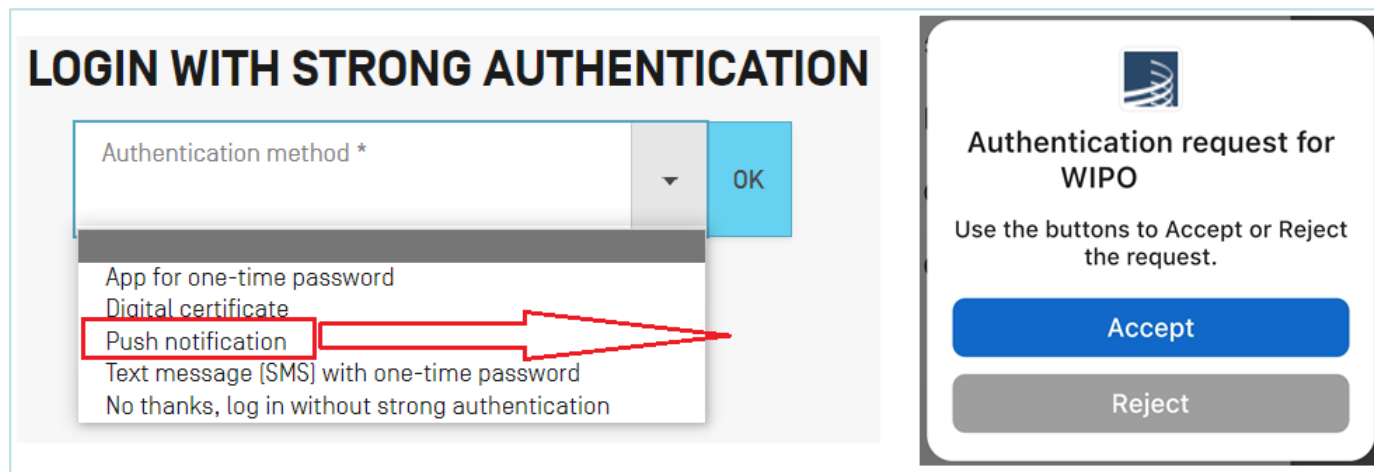
IB

Select subject \*

- ePCT access rights
- DAS assistance
- Processing status of a document
- Fees & payments
- International publication
- ISR & Written opinion
- Chapter II Demand/IPEA
- Translation
- Other

# WIPO Account – Push notification

- New strong authentication option - [Push notification](#)
  - Install the ForgeRock app on a mobile device and then register it with your WIPO Account



# ePCT HELP

## ■ PCT Operations Customer Support Section

□ Tel: +41 22 338 9523

□ Email: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)

□ Live Chat & Web Contact Form available via  
FAQ answers

□ Monday to Friday, 9am-6pm Geneva time (CET)



# Declarations

# Declarations under Rule 4.17

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

# Formal requirements

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

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

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

# Addition/correction of declarations (Rule 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



# Publication of declarations

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

# Declarations referred to under Rule 4.17: Additional issues

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



# Correction of Defects

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

- Office not competent because of the applicant's nationality or residence (Article 11(1)(i), Rule 19.4(a)(i))
- International application filed in a language not accepted by the receiving Office (Rule 19.4(a)(ii))
- Errors in the indication of the applicant's nationality and/or residence (Section 329 of the Administrative Instructions)
- Non-admitted language for the request, abstract, text matter in drawings (Rule 26.3*ter*)
- Incomplete, erroneous or missing priority claim (Rule 26*bis*)
- Correction/addition of any indications referred to in Rule 4.11 (Rule 26*quater*)

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

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

# Defects which may result in a later international filing date (Rules 20.5 and 20.5(*bis*))

- Missing sheets or furnishing of correct elements of parts of
  - description
  - claims
  - drawings



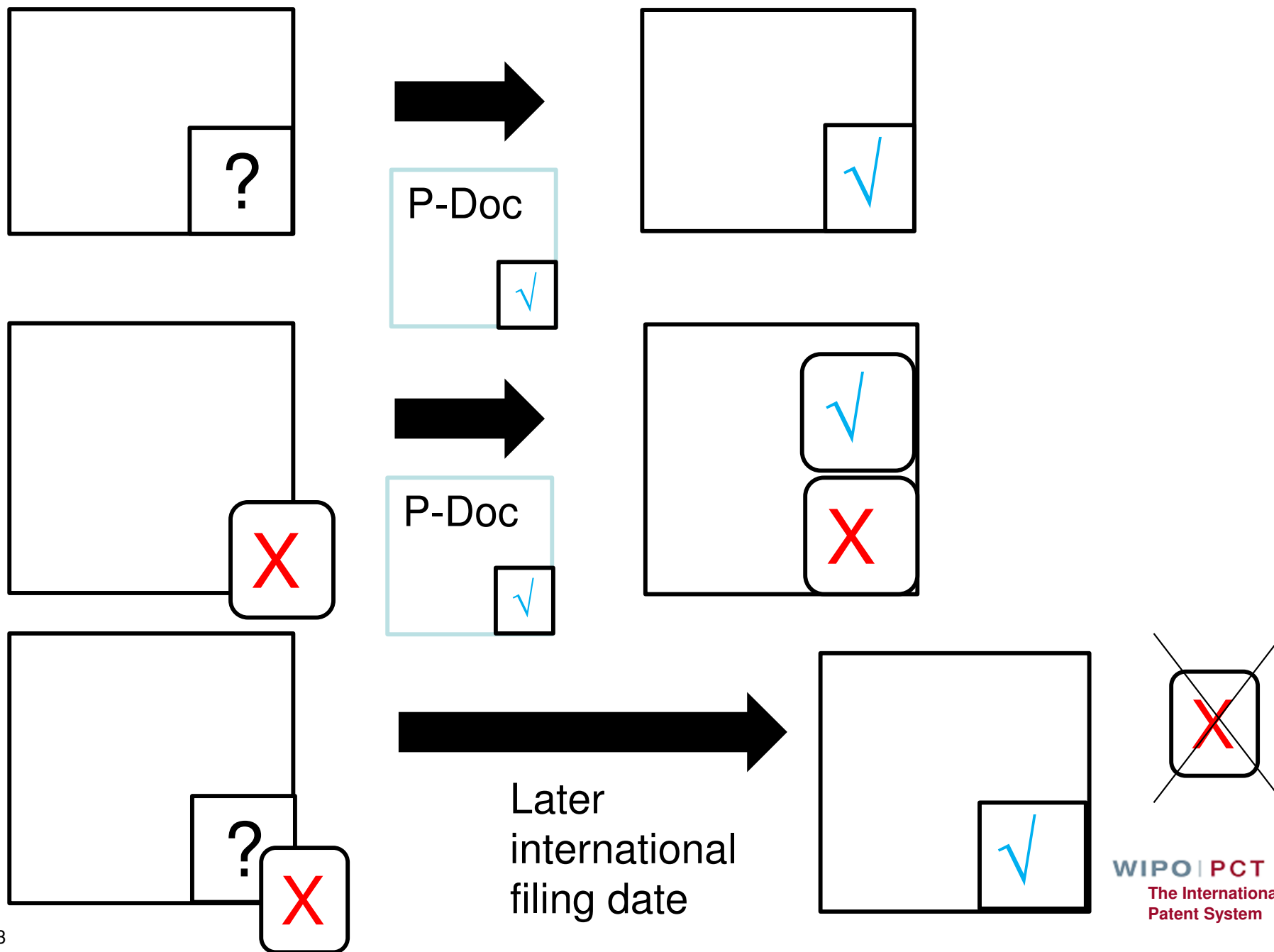
# Incorporation by reference

# Incorporation by reference of missing or correct elements and parts of the international application (Rules 20.5 and 20.5bis) (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
- Erroneously filed elements or parts cannot be removed under incorporation by reference



# Missing ≠ erroneously filed ≠ completed/corrected



# Incorporation by reference of missing or correct elements and parts of the international application (Rules 20.5 and 20.5*bis*) (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 20.5*bis*, 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 or correct sheets
  - copy of the earlier application as filed unless the priority document already submitted
  - translation if not in the language of the international application
  - indication as to where in the priority document (and translation) the missing parts are contained

# Confirmation of incorporation by reference (Rules 20.5*bis*, 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 or correct element or part),
- applicant may request that missing part or the correct element or part be disregarded (Rule 20.5(e) and Rule 20.5*bis*(e))

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

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

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

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

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

# Declarations of incompatibility with the national law (1)

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), 20.5*bis*(a)(ii) and (d) and 20.6 with its national/regional law:

Incompatibility as RO (Rule 20.8(a)):

CU, CZ, DE, ID, KR, MX

Incompatibility as DO (Rule 20.8(b)):

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

# Declarations of incompatibility with the national law (2)

- ❑ Incompatibility as RO (Rule 20.8(a-*bis*)):

CL, CU, CZ, DE, ES, FR, ID, KR, MX

- ❑ Incompatibility as DO (Rule 20.8(b-*bis*)):

CL, CN, CU, CZ, DE, ES, ID, KR, MX, TR





# Omission of sensitive information

## Case No. 1:

Trademarked names of chemical compounds were included in the description of a PCT application. Applicant would like them to be removed.

## Case No. 2:

*92bis* request from a new agent requesting to record his client as a new applicant; request is accompanied by an assignment document containing all financial arrangements made in the context of the transfer of rights; the agent would like to replace the submitted assignment document with a redacted version.

# Omission of sensitive information from publication (Article 21 and Rule 48)

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

# Omission of sensitive information from public access (Rule 94.1)

- Requirements to omit certain information from public file access under Rule 94.1(e)
  - Reasoned request by the applicant to the IB
    - Accompanied by replacement sheets and letter drawing attention to the differences between the replaced and the replacement sheet (where applicable)
  - Time limit for a request under Rule 94.1: any time
  - Information qualifies for omission from public file access , if
    - it does not obviously serve the purpose of informing the public about the international application,
    - public access to such information would clearly prejudice the personal or economic interests of any person, and
    - there is no prevailing public interest to have access to that information



# Priority Claims

- PCT requirements
- Priority documents

# Contents of priority claims (Rule 4.10) (1)

## ■ Earlier national application:

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

## ■ Earlier regional application:

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

# Contents of priority claims (Rule 4.10) (2)

## ■ Earlier international application:

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

# Furnishing of priority documents (Rule 17.1)

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



# 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

# 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: AR, AT, AU, BR, CA, CL, CN, CO, DK, EA, EE, EP, ES, EUIPO, FI, **FR**, GB, GE, IB, IL, IN, IT, JP, KR, MA, MX, NL, NO, NZ, SE, US

## ■ For detailed information on DAS, see: [www.wipo.int/das/en](http://www.wipo.int/das/en)

# Retrieval of priority documents via DAS

- Possibility to request the IB to retrieve a copy of the priority document of an earlier application, in electronic form, via DAS
- The service is available for earlier national or regional applications filed with AR, AT, AU, BR, CL, CN, CO, DK, EA, EE, EP, ES, FI, **FR**, GB, GE, IL, IN, IT, JP, KR, MA, MX, NL, NO, NZ, SE and US and for earlier international applications filed with AT, AU, BR, CL, CN, CO, DK, EA, EP, ES, FI, **FR**, GE, IL, IN, IT, MA, MX, NL, NO, SE and RO/IB
- The Office with which the earlier national application was filed is known as the Office of First Filing (OFF) or the Depositing Office
- The Office that retrieves the document is known as the Office of Second Filing (OSF) or Accessing Office

# Main steps for the use of DAS

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

# Requesting DAS p-doc retrieval

**PRIORITY CLAIMS**

Add

Type *	National	▼	Option(s) for providing the priority document to the IB *
Country/Office *	US - United States of America	▼	<input type="radio"/> Receiving Office to prepare and transmit to the International Bureau
Filing Date *	29/10/2019	📅	<input type="radio"/> To be provided by the applicant
filing date does not match for US - 61/274654 in DAS.			<input type="radio"/> An electronic copy of the priority document (certified by the issuing Office) will be submitted with this data package at the time of filing
			<input checked="" type="radio"/> International Bureau to obtain from a digital library (DAS)
Application number *			DAS access code *
61/274654			1234
format should be "08/999,999"			<input type="checkbox"/> The receiving Office is requested to restore the right of priority for this earlier application.

Cancel OK



# Correction and Addition of Priority Claims

# 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 26*bis*) (1)

## ■ Cases concerned:

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



# Correction/addition of priority claims affecting the priority date (Rule 26*bis*) (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 26*bis*.2(b))

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

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

## ■ Cases concerned:

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

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

## ■ Applicable time limit:

### □ Rule 26*bis*.1(a):

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

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

### □ Rule 91: within 26 months from the priority date

# Invitation to correct by RO or IB (1)

## ■ Forms:

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

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

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

# Invitation to correct by RO or IB (2)

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

# Invitation to correct by RO or IB (3)

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

# Invitation to correct by RO or IB (4)

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

# Publication related to priority claims (1)

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

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



# Publication related to priority claims (2)

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

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

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



# Restoration of the Right of Priority

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

## ■ Conditions:

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

# Restoration of the right of priority

## Applicable criteria

- Applicable Rules: *26bis.3(a)* and *49ter.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

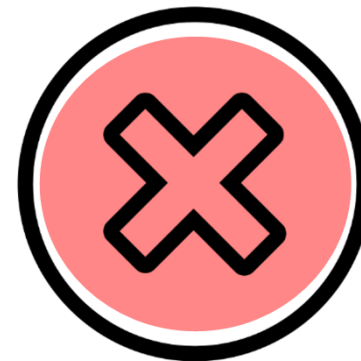
# Will the request be granted?

## Unintentional

- Applicant failed to obtain sufficient funds to pay the filing fee before the priority period expired.



Granted



Refused

# Will the request be granted?

## Due care #1

- Docketing clerk made a priority date entry error. The clerk has docketed over 500 filings without similar mistakes in the past and participates in regular trainings.

## Due care #2

- Applicant was hospitalized starting one week prior to the expiry of the priority period for three week and could not timely instruct the agent to file the PCT application

# Restoration by RO

## Communication of documents to the IB

- General Rule: Obligation of the RO to forward to the IB all documents received from the applicant in relation to a request to restore the priority right
- Exception:
  - Upon reasoned request by the applicant or on its own decision, the RO may not forward information, if
    - it does not obviously serve the purpose of informing the public about the international application,
    - publication of or public access to such information would clearly prejudice the personal or economic interests of any person, and
    - there is no prevailing public interest to have access to that information
  - The applicant may be required to submit replacement sheets



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

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

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

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

# Reservations made by Offices

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

- ❑ Incompatibility as RO (Rule 26*bis*.3(j)):  
BR, CO, CU, CZ, DE, DZ, GR, ID, IN, KR, PH
- ❑ Incompatibility of the effect of decision of RO on DO  
(Rule 49*ter*.1(g)):  
BR, ~~CA~~<sup>\*</sup>, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, LT, MX, PH  
\* For applications filed on or after October 30, 2019
- ❑ Incompatibility as DO (Rule 49*ter*.2(h)):  
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, PH

See the Table of “PCT Reservations, Declarations, Notifications and Incompatibilities” [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)



## **Recording of Changes under Rule 92*bis***

# 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 92*bis*

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

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

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

# Time limit under Rule 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



# Time limit under Rule 92*bis* (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



# 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 and TZ continue to apply a 20-month time limit

# Time limit for entry in the national phase

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

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

# General national requirements

## Art. 22(1) and 39(1)(a)

### ■ Requirements:

- Translation, if applicable
- Payment of national fee
- Copy of international application in particular circumstances only

### ■ Time limit under Art. 22(1): 30 months from the priority date

- For additional time, see PCT Applicant's Guide, national phase summaries
- For exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

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

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

# 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)



# National requirements simplified for PCT applications (1)

## ■ Priority document

- The applicant does not need to furnish the priority document since the IB transmits copies to the DO/EOs
- If the DO/EO did not receive a copy of the priority document from the IB, it must request a copy from the IB (not from the applicant)

## ■ Drawings

- If the drawings do not contain any text matter to be translated, a simple copy of the drawings as filed is required by a few DOs
- If the drawings contain text matter to be translated, a set of drawings containing the translated text matter needs to be furnished

# National requirements simplified for PCT applications (2)

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

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

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

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

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

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

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

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

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

# A few further tips to remember

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

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

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



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

- Applicants may submit a request for reinstatement and enter the national phase within:

- 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or

- 12 months from the date of expiration of the time limit to enter national phase;

whichever period expires first

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

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

# DO/EOs to which Rule 49.6 does not apply

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

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

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

# Additional cases of protection against loss of rights

- Other than the (minimum) protection under Rule 49.6: excuse of delays in meeting time limits by designated/elected Offices (Article 48 and Rule 82*bis*)
- Rectification by designated/elected Offices of errors made by RO or IB (Rule 82*ter*)
- Review by and opportunity to correct before the designated/elected Offices (Articles 24(2), 25, 26, 39(3) and 48, Rules 82*bis* and 82*ter*)



# Recent developments

# Recent Developments

- Best means of communicating with the IB
- Color drawings
- PCT Direct
- PCT and PPH

# Best means of communication with the IB (1)

- For the filing of new applications with RO/IB:
  - Applicants should use ePCT (*recommended*) or PCT-SAFE (RO/IB will stop accepting filings using PCT-SAFE from 1 July 2021)
  - In the event that neither service is available, international applications can also be uploaded through the “Contingency Upload Service” (see <https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml>)

# Best means of communication with the IB (2)

- For the submission of post-filing documents to the IB and RO/IB:
  - ❑ Applicants should use ePCT (*recommended*);
  - ❑ In the event that ePCT is not available, applicants can use the “Contingency Upload Service”
- To receive Forms and communications from the IB in urgent cases:
  - ❑ Access your application file through ePCT (strong authentication) (*recommended*)
  - ❑ Authorize the IB to send forms and communications to you by e-mail (ideally “by e-mail only”)
  - ❑ As of January 1, 2020, urgent communications will no longer be sent by fax



# Best means of communication with the IB (3)

- The IB strongly discourages the use of fax as a means of communication with the IB for the following reasons:
  - Technical unreliability of fax transmissions
  - Transmission failures and/or legibility issues are always the applicant's responsibility (Rule 92.4(c))
  - Positive fax transmittal report on the applicant's side does not prove successful transmission
- As from January 1, 2020, the IB will nevertheless continue to operate a limited fax service as an additional safeguard for applicants who experience technical difficulties in submitting documents electronically
  - The only remaining two PCT fax numbers can be found on the PCT resources website ([https://www.wipo.int/pct/en/#\\_contact](https://www.wipo.int/pct/en/#_contact))
  - Applicants are advised to contact the “authorized officer” in relation to the application before sending a fax during regular business hours at the IB (or otherwise leave a message on an answering device)

# Color drawings (1)

- Applications containing color or greyscale content
  - Not permitted in PCT applications (Rule 11)
  - Since applications often contain color or greyscale content, the IB has included some features in ePCT and PCT-SAFE
    - **ePCT-Filing** will automatically detect color or greyscale content and warn the applicant that the application content should be in black and white
    - **PCT-SAFE** allows applicants to indicate (checkbox) that the application contains color or greyscale content (only for filings with RO/IB)
  - A dedicated preview function has been made available by the IB in order to allow applicants to view the application content as it will be rendered by the IB
    - Directly available in ePCT-Filing
    - <https://pctdemo.wipo.int/DocConverter/pages/pdfValidator.xhtml>

# Color drawings (2)

## ■ Publication of applications containing color or greyscale content

- The application will be converted into black and white format for further processing and publication by the IB

- If the application contained color or greyscale content, the front page of the published PCT application will contain a notice to that effect

- Any original color or greyscale content will be made available on PATENTSCOPE as part of the public application file

## ■ Attention:

- Designated Offices are not obliged to take the color or greyscale content into account, and may rely on the PCT application as published in black and white

# “PCT Direct” (1)

- Additional service offered by:
  - EPO since 1 November 2014
  - Israel Patent Office since 1 April 2015
  - Finnish Patent and Registration Office since 1 April 2019
  - Spanish Patent and Trademark Office (OEPM) since 25 May 2020
- 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 websites of the Offices concerned

# “PCT Direct” (2)

## ■ Requirements:

- the informal comments are filed together with the PCT application
  - with any RO if ISA/EP, ISA/ES, ISA/FI or ISA/IL is chosen
- ISA/EP, ISA/ES, ISA/FI or ISA/IL are selected
- the PCT application claims priority of an earlier application searched by the
  - ISA/EP (European first filing or national first filing)<sup>1</sup>
  - ISA/ES
  - ISA/FI
  - ISA/IL

## ■ Form:

- the informal comments are filed in form of a “PCT Direct Letter” in a single document in PDF format and the words “PCT Direct/informal comments” have been indicated under “Other” in Box IX of the PCT request form (Form PCT/RO/101)

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

# “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

# 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

# Patent Prosecution Highway (PPH) and PCT

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



# PCT Information and Training

- 29 video segments on WIPO's Youtube channel and WIPO's PCT page about individual PCT topics
- PCT Distance learning course content available in the 10 PCT publication languages, and a 2<sup>nd</sup> detailed PCT DL course under preparation
- PCT Webinars
  - free updates on developments in PCT procedures, and PCT strategies—previous webinars are archived and freely available
  - upon request also for companies or law firms, for example, for focused training on how to use ePCT
- Videoconference and audio possibilities also available
- In-person PCT Seminars and training sessions: see PCT seminar calendar (<http://www.wipo.int/pct/en/seminar/seminar.pdf>)
- Monthly Newsletter (<http://www.wipo.int/pct/en/newslett/>)
- Extensive information resources on PCT website (<http://www.wipo.int/pct/en/>)
- If you'd like to discuss PCT training, contact us

# PCT Resources/Information

## ■ General questions about the PCT

PCT Information Service: +41 22 338 83 38

E-mail: [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

## ■ Questions about ePCT:

eServices Help Desk: +41 22 338 95 23

E-mail: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)

## ■ Speakers:

[matthias.reischle@wipo.int](mailto:matthias.reischle@wipo.int)

+41 22 338 96 27

# Thank you!

