



# PCT Seminar on the Patent Cooperation Treaty (PCT)

*organized by the Industrial Property Organisation (OBI)*

Athens, 18 October 2013

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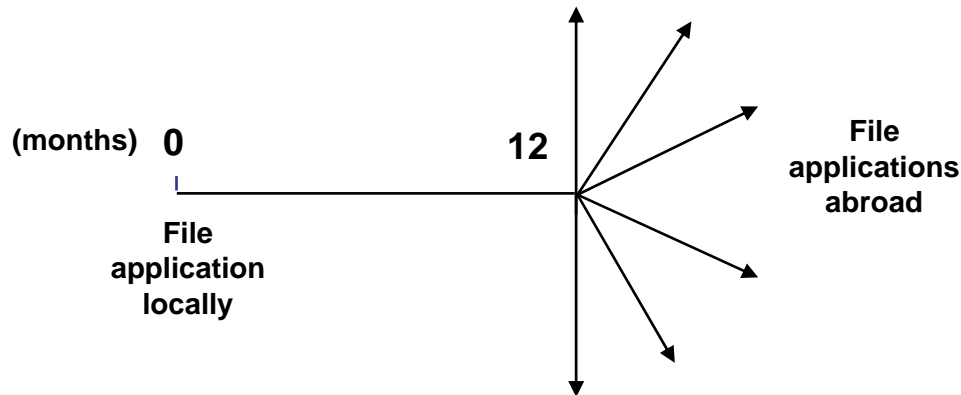


## **Topic 1:**

**-Introduction to the PCT System and  
PCT Timeline**

**-The advantages of the PCT System**

# Traditional patent systems

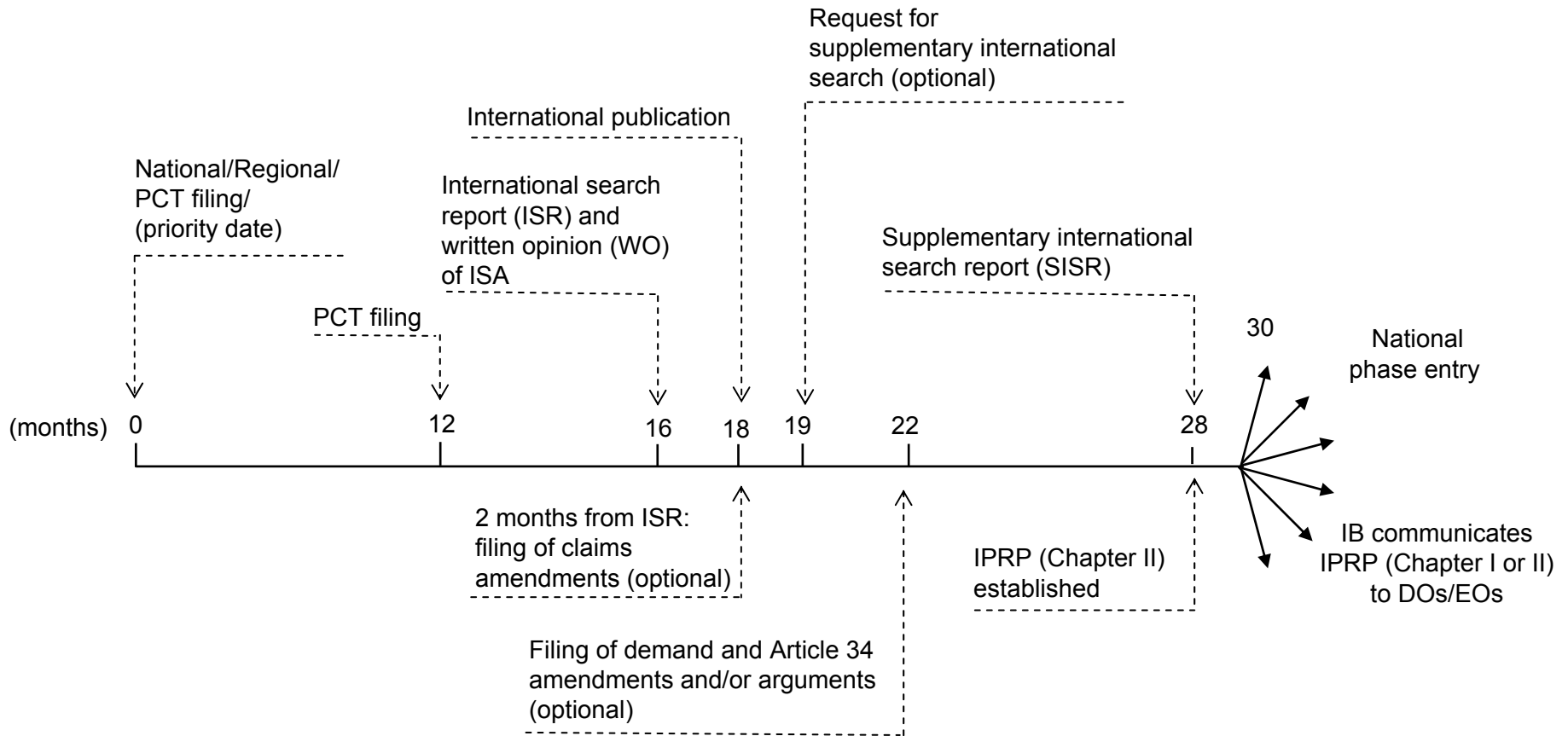


- Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:
  - multiple formality requirements
  - multiple searches
  - multiple publications
  - multiple examinations and prosecutions of applications
  - translations and national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

# PCT system

- 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
  - 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

# PCT TIMELINE



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

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

\* Regional patent only

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

# 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 (from 24.09.2011)
SD	Sudan
SL	Sierra Leone
* 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
* ML	Mali
* MR	Mauritania
* NE	Niger
* SN	Senegal
* TD	Chad
* TG	Togo

\* Regional patent only

# PCT Contracting States (148) (continued)

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

AE	United Arab Emirates	HN	Honduras	NZ	New Zealand
AG	Antigua and Barbuda	ID	Indonesia	OM	Oman
AO	Angola	IL	Israel	PA	Panama
AU	Australia	IR	Iran (Islamic Republic of)	PE	Peru
* BA	Bosnia and Herzegovina	IN	India	PG	Papua New Guinea
BB	Barbados	JP	Japan	PH	Philippines
BH	Bahrain	KM	Union of the Comoros	QA	Qatar
BN	Brunei Darussalam	KN	Saint Kitts and Nevis	SA	Saudi Arabia
BR	Brazil			SC	Seychelles
BZ	Belize	KP	Democratic People's Republic of Korea	SG	Singapore
CA	Canada	KR	Republic of Korea	ST	Sao Tome and Principe
CL	Chile	LA	Lao People's Democratic 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		

# Countries not yet PCT Contracting States (45)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Cambodia

Cape Verde

Democratic Republic of Congo

Djibouti

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Iraq

Jamaica

Jordan

Kiribati

Kuwait

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Samoa

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

Uruguay

Vanuatu

Venezuela

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

# Why use the PCT?

- “Internationalization” of a single PCT application providing near global geographical coverage
- Time delay (additional time for decision making)
- Cost deferral
- Patentability assessment

# Cost deferral

- Seeking patents in foreign countries requires a significant capital investment
- The PCT provides for the deferral of main initial costs associated with internationalization:
  - Cost of translations
  - Local patent agent fees
  - Local patent Office fees

# When are these initial costs incurred?

## Traditional Patent System vs PCT System

### Traditional

(months)  
0  
File local application

12

File applications abroad

**Fees for:**  
- translations  
- Office fees  
- local agents

### PCT

(months)  
0  
File local application

12

File PCT application

16

International search report & written opinion

(optional)  
Request for supplementary international search

Supplementary international search report

(optional)  
File demand for international preliminary examination

International preliminary report on patentability

Enter national phase

30

2.2.2

**WIPO | PCT**  
The International Patent System

# Patentability assessment

- Strong basis for patenting decisions
- Valuable information that is of assistance in making patenting decisions
- The International Search Report (ISR) and the written opinion of the International Searching Authority
- International Preliminary Report on Patentability (IPRP (Ch.II)) of the International Preliminary Examining Authority (optional)

# Other PCT advantages

- Amendment possibilities under the Chapter II procedure prior to entry into the national phase
  - Description
  - Claims
  - Drawings
- Electronic filing of PCT applications at reduced expense
- Centralized management of your PCT application in ePCT



## **Topic 2:**

- Preparing and filing of PCT applications and common mistakes**
- Declarations**
- Fees payable under the PCT**

# Overview

- Getting ready to file
- Filing of an international application

# Getting ready to file (1)

- Decision-making process
- Avoid last-day and even more so last-minute filings
- Have a plan B ready if something goes wrong
- Make sure that you already have your accession number for your deposited biological material
- Ensure that your filing software is fully up-to-date

# Getting ready to file (2)

## ■ Preparing the request form ([PCT/RO/101](#)):

### □ Naming of the applicants:

- Impact of the AIA legislation
- Careful to always include one applicant who has the right to file an international application
- Addresses of inventors/applicants

### □ Representation: agent, common representative or address for correspondence?

### □ Exclusion of certain designations? Special situation of DE, JP or KR

# Impact of AIA on how to fill-in the PCT request form

## ■ Old:

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> all designated States except the United States of America	<input type="checkbox"/> the United States of America only	<input type="checkbox"/> the States indicated in the Supplemental Box
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## ■ New:

This person is applicant for the purposes of:	<input type="checkbox"/> all designated States	<input type="checkbox"/> the States indicated in the Supplemental Box
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# Getting ready to file (3)

## ■ Preparing the request form (cont.):

- Don't forget to and correctly indicate all priority claims
- Make use of PCT declarations

Box No. VI PRIORITY CLAIM AND DOCUMENT				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application <i>(day/month/year)</i>	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: regional Office	international application: receiving Office
item (1)				
item (2)				
item (3)				
<input type="checkbox"/> Further priority claims are indicated in the Supplemental Box.				

# 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

# Filing of an international application (1)

- What needs to be submitted?

# 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 (“[petition](#)”)

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

- a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
- the name of the applicant (Rule 4.5)
- a description (Rule 5)
- a claim (Rule 6)

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

## ■ Note that if:

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

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

# Not required for obtaining an international filing date

- payment of fees
- applicant's signature
- title of the invention
- abstract
- drawings (for missing drawings, see Article 14(2) and Rule 20.5)
- translation into language of search or publication

# The PCT applicant (Article 9 and Rule 18)

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

# Where to file the international application (Rule 19)

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

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

# Choice of receiving Office

## Considerations:

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

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

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

# Elements making up the international application

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

# Elements which may accompany the international application

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

# Filing of an international application (2)

## ■ Efiling specific issues:

- Add the correct and complete application documents; good file management is essential
- Conversion problems; submit, if possible, also pre-converted files

## ■ Signature issues:

- Only one digital signature
- Otherwise simple electronic signatures

# Signature of the request (1)

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

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

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

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

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

# Signature of the request (2)

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

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

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

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

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

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

# PCT-SAFE

## (Secure Applications Filed Electronically)

- Allows for preparation and submission of entire PCT international application in electronic format
- Provides safety, confidence, convenience, efficiency, wide accessibility and simplicity to PCT E-filing
- Based on agreed standards, interoperable with other user software, means for preparing an international application once and the ability to file it anywhere
- Facilitates communications and data exchange between Offices (long term)

# PCT-SAFE: two options

## ■ Fully electronic filing of application:

- entire application in electronic form (image or character-coded), electronically signed
- transmitted via secure internet connection or on physical media

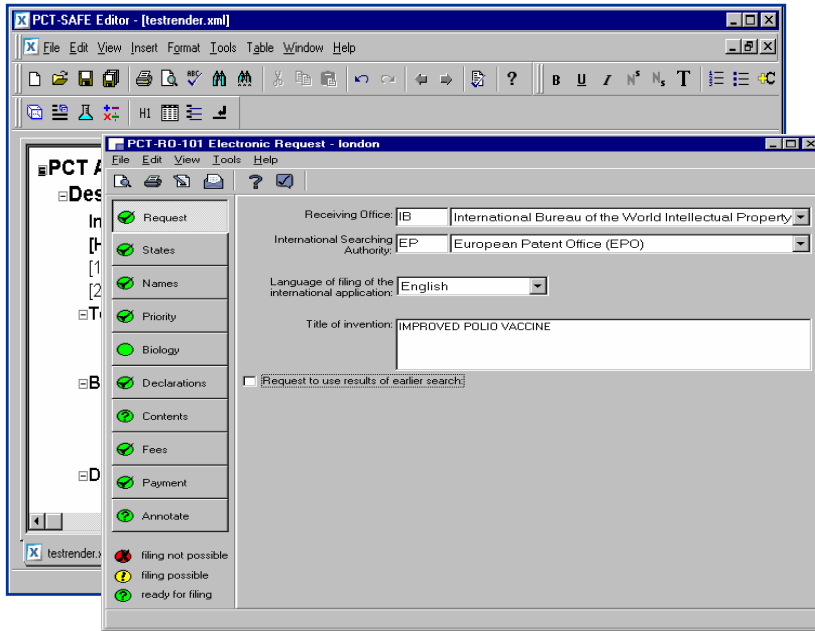
## ■ Preparing request in “PCT-EASY mode”

- entire application in paper form (legal copy) including the PCT-EASY request form printout
- plus physical medium with electronic request form and abstract data

# PCT-SAFE: fee reductions

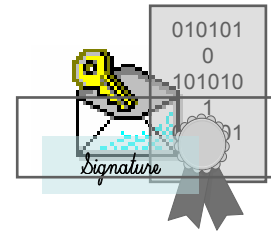
- “PCT-EASY” type of filing (on paper + request and abstract on physical medium)  
CHF 100 (EUR 83 or USD 107 or equivalent amount)
- Fully electronic type of filing with application body in image format (for example PDF, TIFF attachments) and only the request in character coded format (XML)  
CHF 200 (EUR 165 or USD 213 or equivalent amount)
- Fully electronic type of filing with application body and request in character coded format (XML)  
CHF 300 (EUR 248 or USD 320 or equivalent amount)

# PCT-SAFE: Overview



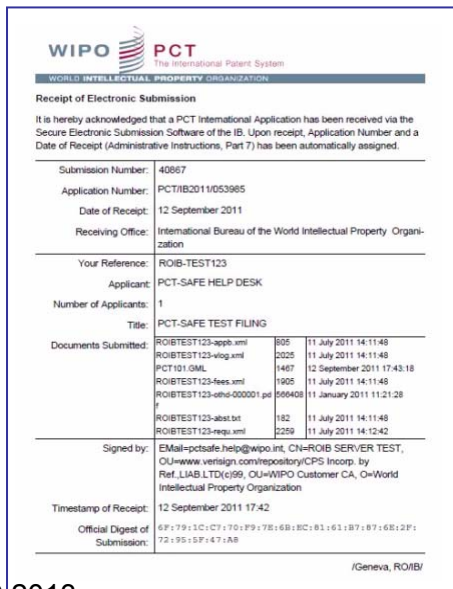
1. Prepare application body:  
PDF or XML

2. Prepare Request: PCT-SAFE  
Client software

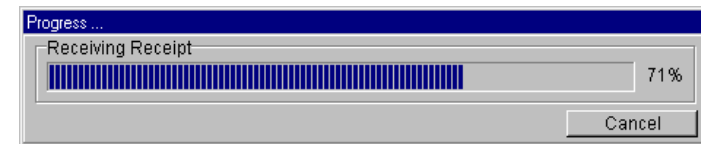


3. Electronically  
sign: WIPO  
Customer  
certificate or  
other

4. Transmit (on-line  
or on CD-R)



5. Receive a  
receipt (on-line)



# Type of filing: Fully electronic

**PCT-RO-101 Electronic Request**

File Edit View Tools Help

Select type of filing: Fully electronic

Type of filing:  PCT-EASY  Fully electronic  Single specification file

Document	Details	Pages	Electronic File	Val.
Request (including declaration sheets)		4		
Description				
Claims				
Abstract				
Drawings				

Document	Details	Pages	Electronic File	Val.
Application body				

Open

Calculate total:  pages

**International Application** **Accompanying Items**

In total:  documents  files

Request (including declaration sheets)

# Attaching the application body (image format - single specification pdf)

The screenshot displays the 'PCT-R0-101 Electronic Request - singlespec' interface. The main window shows a table of documents with columns for Document, Details, Pages, Electronic File, and Val. The 'Single specification file' option is selected under 'Type of filing'. A 'Content Details' dialog box is open, showing the 'Application body' document with 40 pages. The 'Electronic File' field contains 'specification.pdf'. The 'Status' is 'Attached As "specification.pdf"'. The dialog also shows a table of page ranges for Description, Claims, and Abstract, with a total of 40 pages. An 'Open' button is visible at the bottom of the dialog.

Document	Details	Pages	Electronic File	Val.
Request (including declaration sheets)				✓
Specification				✗
Drawings				?

Document	Details	Pages	Electronic File	Val.
Request (including declaration sheets)		4		✓
Specification		40	specification.pdf	✓
Application body				✓

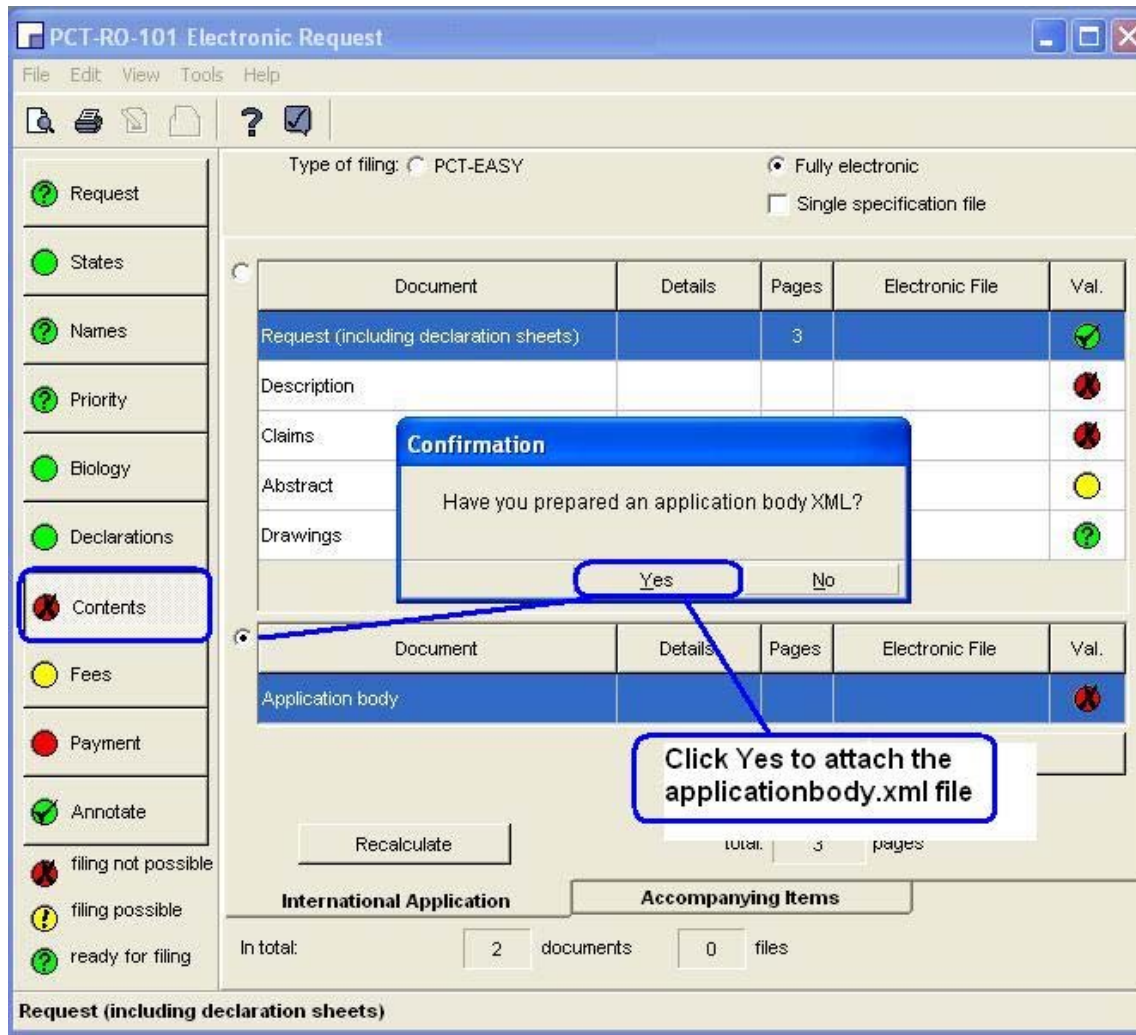
  

Document	Details	Pages	Electronic File	Val.
Application body		40	application-body.xml	✓

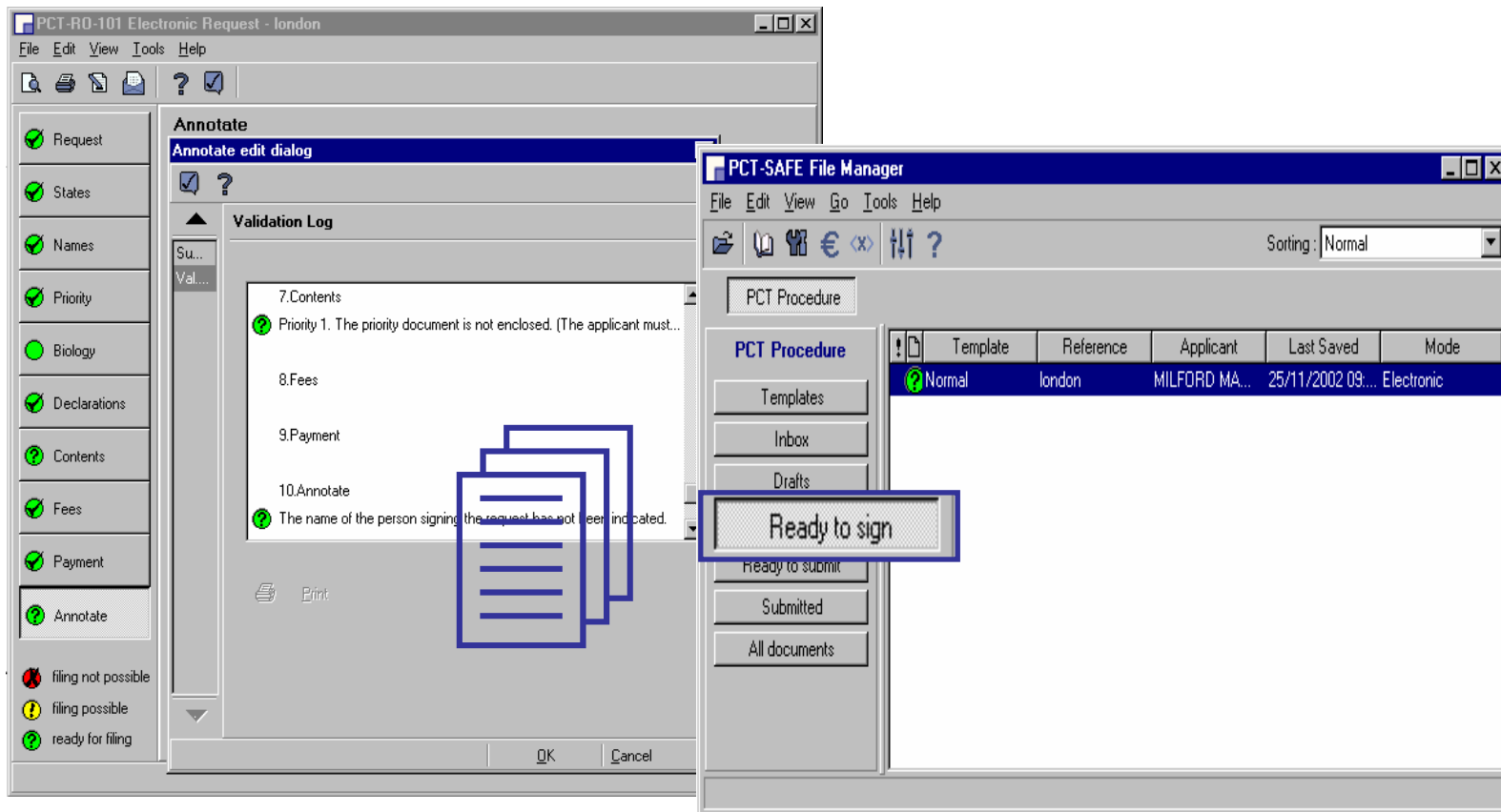
  

Description	from page	till	pages
Description	1	20	20 pages
Claims	21	39	19 pages
Abstract	40	40	1 pages
In total		40	pages

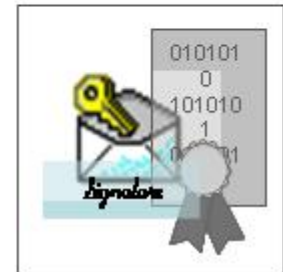
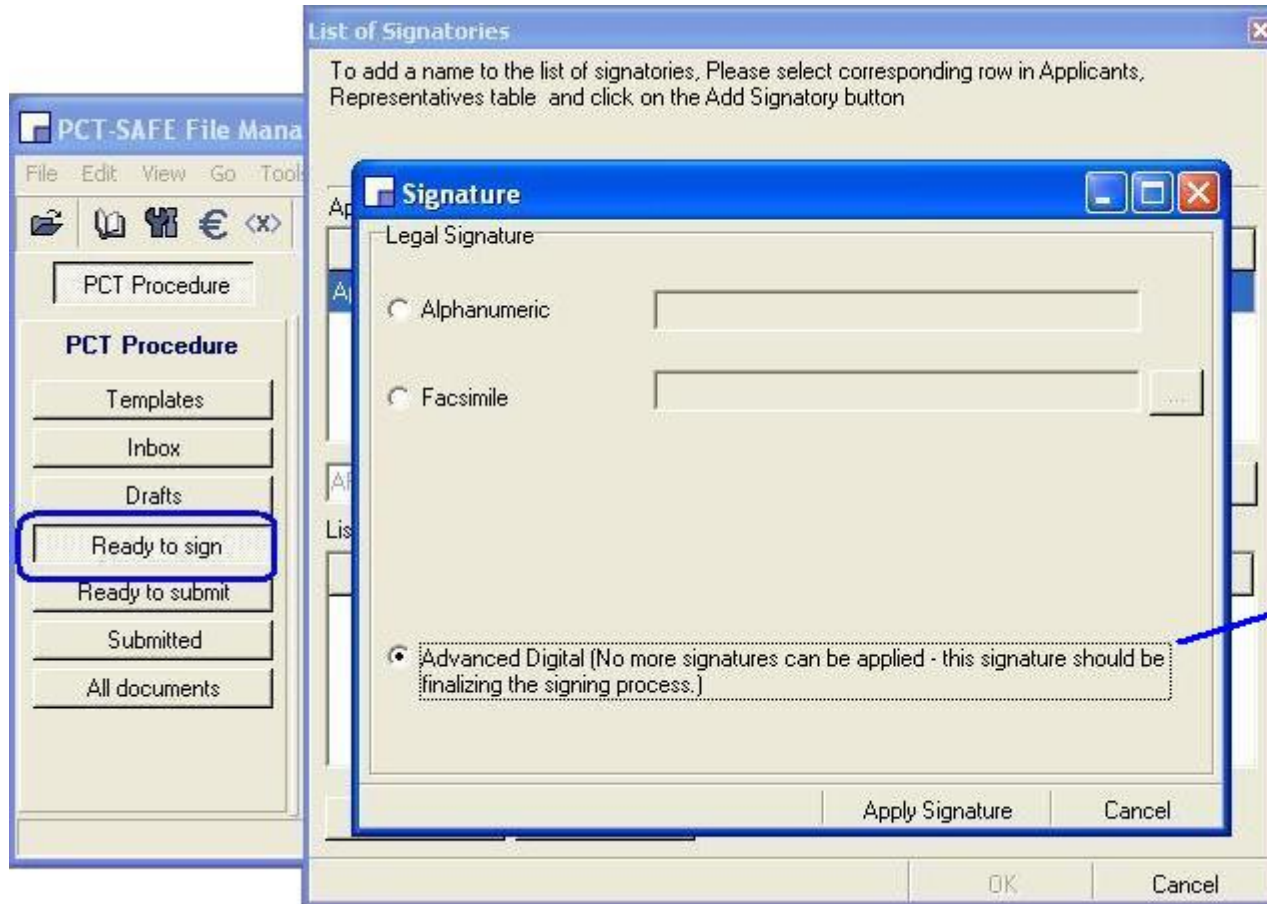
# Attaching the application body (character-coded format)



# Save as 'Ready to Sign'



# Signing the application



Digital certificate

# Ready to submit

The image displays two software windows from the PCT-SAFE system. The left window, 'PCT-SAFE Editor', shows a 'PCT REQUEST' form with the following fields:

PCT REQUEST		115	error
Original for SUBMISSION			
01	International application No.		
02	International filing date		
03	Name of applicant (individual or international applicant)		
04	Form: PCT/RO/RI/1 (English)	PCT-SAPB	
04.1	Prepared using	Version 3.0 (beta)	
05	Name of inventor (individual or international applicant)		
06	Address of inventor (individual or international applicant)		
07	Applicant or originator (reference)	International Bureau of the World Intellectual Property Organization	
08	Applicant	applicant only	
08.1	Applicant to	all designated States except US	
08.2	Name (last, first)	MILKENDON MANUFACTURING PLC	
08.3	Address	Perby Road Coke Works, Nottinghamshire NG2 0 0Z United Kingdom	
08.4	State of nationality	GB	
08.5	State of residence	GB	
08.6	Telephone No.	(44-115) 453 23 23	
08.7	Facsimile No.	(44-115) 453 23 24	
09	Applicant information	applicant and inventor	
09.1	Applicant to	US only	
09.2	Name (last, first)	JOHNS, Richard	
09.3	Address	43 West Coast Lane London SE2 4ST United Kingdom	
09.4	State of nationality	AD	
09.5	State of residence	AD	
10	Agent for correspondence	agent	
10.1	Name (last, first)	WILKENDON, John	
10.2	Address	25 Castle Street Nottingham, Nottinghamshire NG2 4AE United Kingdom	
10.3	Telephone No.	(44-115) 122 1237	
10.4	Facsimile No.	(44-115) 122 1238	

The right window, 'PCT-SAFE File Manager', shows a list of files with the following columns: Template, Reference, Applicant, Last Saved, Retry, and Mode. The first row is highlighted:

Template	Reference	Applicant	Last Saved	Retry	Mode
Normal	london	MILFORD ...	25/11/2002...	0	Electronic

A blue box highlights the 'Ready to submit' button in the File Manager window.

# “PCT-EASY Mode”

## Definition:

Portion of PCT-SAFE software for preparing electronic request form and abstract data on physical medium (such as diskettes, CD-R, DVD-R, depending on the RO concerned\*) and printing paper request form

## Purpose:

Assist applicants to prepare PCT request forms & check for errors

International Bureau receives validated bibliographic data and abstract in electronic format

- \* For further information, see Annex C of the *PCT Applicant's Guide* for each RO concerned

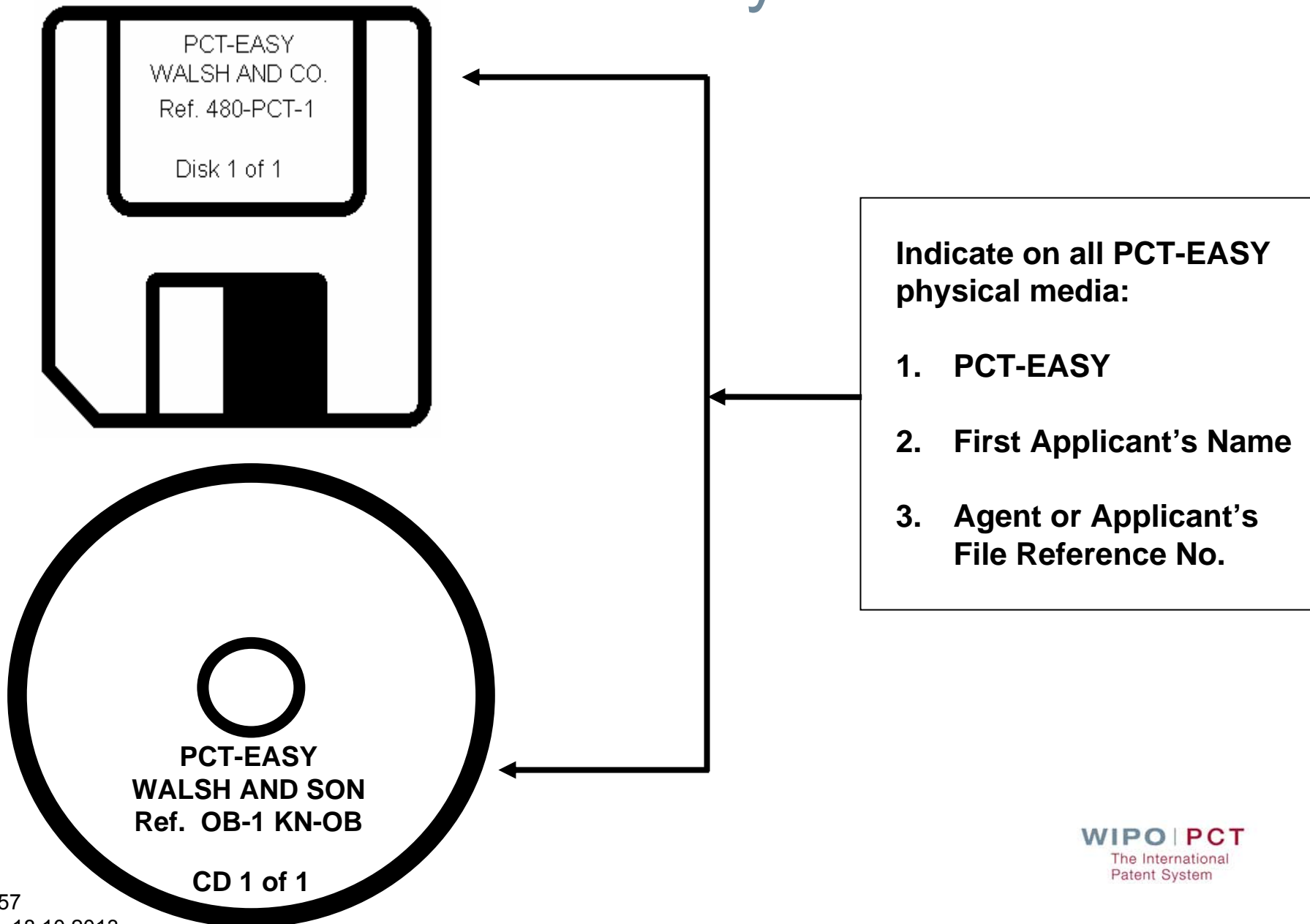
# “PCT-EASY Mode”: Features

- Validate request form data
- Print computer-generated request form including the fee calculation sheet
- Copy zip file containing request form, fee calculation sheet and abstract on a physical medium for submission with paper filing
- Generate and print PCT power of attorney
- Generate and print Form PCT/RO/134 for deposited microorganisms or other biological material

# “PCT-EASY Mode”: How to use

- If PCT-EASY mode used, the international application should have the following:
  - paper print-out of completed PCT-EASY request form
  - physical medium containing completed request form, fee calculation sheet and abstract
  - paper copy of remainder of international application (description, claims, abstract and drawings)
- The international application must be filed with a receiving Office prepared to accept requests in PCT-EASY format together with PCT-EASY physical media (see *PCT Applicant's Guide*, Annex C)

# “PCT-EASY Mode”: Physical Medium



# Correction of “PCT-EASY Mode” Request form printout

- Correction stated in a letter
  - without a replacement print-out of the request form printout:  
only if the correction can be transferred from the letter to the record copy without affecting clarity and direct reproducibility
  - with replacement of request form printout:  
if transfer of the correction is not possible;  
the letter draws attention to differences between the replaced printout and the replacement printout
- No replacement physical medium should be submitted when correcting the request form printout; any replacement physical medium will not be processed by the receiving Office

# “Notebook” Structure (same in fully electronic & “PCT-EASY mode”)

PCT-RO-101 Electronic Request - t

File Edit View Tools Help

Request

States

Names

Priority

Biology

Declarations

Contents

Fees

Payment

Annotate

Receiving Office: US United States Patent and Trademark Office (USPTO)

International Searching Authority: US United States Patent and Trademark Office (USPTO)

Language of filing of the international application: English

Title of invention: AGRICULTURAL PLOUGH

Request to use results of earlier search:

filing not possible

filing possible

ready for filing

# “Notebook” Page Contents

- **Request:** receiving Office, International Searching Authority, language used, title of invention and earlier search
- **States:** optionally exclude DE, JP or KR from automatic designation
- **Names:** details concerning applicants, inventors, agents, common representative, etc., create power of attorney
- **Priority:** priority claim details
- **Biology:** details on biological material/sequence listings
- **Declarations:** make declarations referred to in Rule 4.17
- **Contents:** number of pages and identify attached documents
- **Fees:** calculate prescribed fees
- **Payment:** choose mode of payment
- **Annotate:** indicate/view supplemental information (e.g. validation log, remarks and signatories)

# Validation function (automatic formality check)

## “Traffic lights” assist in completing request form data:

- Missing indications mandatory for according an international filing date
- ⊗ Incomplete or erroneous indications also mandatory for the according of international filing date or other obvious error
- Missing indications, the omission of which could prompt further communication from the RO (for example, invitation to correct defects)
- ! Incomplete or erroneous indications which could prompt further communication from the RO
- No indication required, but applicant should evaluate the need to make such indications
- ? A reminder questioning the need for indications or verification
- ✓ The indications appear to be in order

## Fees Payable under the PCT

# Fees payable to the receiving Office (RO)

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

# Fees 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)*

# Time limits for payment of fees (1)

## ■ Chapter I:

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

# Time limits for payment of fees (2)

## ■ Chapter II:

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

# 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](http://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](http://www.wipo.int/pct/en/warning/pct_warning.htm)*


**F.I.P.T.R.**  
 SERVICE

FEDERATED INSTITUTE FOR PATENT &amp; TRADEMARK REGISTRY, INC.

## Register International Patent Application

### Description: Registration of the International Patent Application

<b>Publication Number:</b> WO/	<b>Priority Date:</b>
<b>Publication Date:</b>	<b>Title:</b>
<b>International Application No.:</b> PCT/	
<b>International Filing Date:</b>	<b>Reference No.:</b>

**Please read carefully:**

Above mentioned the Publication Number, Publication Date, international Application No., International Filing Date, Priority Date, Title and reference number. You confirm this offer by remitting the following amount and in doing so, you confirm that the wording of the entry entered by ourselves and rendered here is correct. THIS IS NOT A BILL. THIS IS A SOLICITATION. YOU ARE UNDER NO OBLIGATION TO PAY THE AMOUNT STATED UNDERNEATH UNLESS YOU ACCEPT THIS OFFER. Please take notice of our general terms of trade overleaf. Any requests for amendments and additions are to be made in writing.

<b>Subject:</b>	<b>Amount:</b>
Charges of registration	USD 1629,30
Extra charges	USD 0,00
<b>Total due</b>	<b>USD 1629,30</b>

**Attention: It is important that you always quote the Reference number**

Please use a cheque and send it to the below mentioned addressor or transfer the amount to the bank account mentioned also below:

<b>Payment per cheque:</b>	FIPTR Federated Institute for Patent & Trademark Registry, INC. 6574 North State Road 7, Suite 337 Coconut Creek, FL 33073 USA	<b>Payment per money transfer:</b>	Bank: SunTrust 1761 W Hillsboro Blvd Deerfield Beach, FL 33442 USA SWIFT: SNTRUS3A ABA: 061000104 Account #: 1000045980835
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Please pay the whole amount of \$1629,30 either by cheque or money transfer, indicating the reference number, within 8 days.

FIPTR Federated Institute for Patent & Trademark Registry, INC.  
 6574 North State Road 7, Suite 337  
 Coconut Creek, FL 33073 USA  
 Phone 954-427-9496

**WIPO | PCT**  
 The International  
 Patent System



## Topic 3: Priority Claims

- PCT requirements
- Correction/Addition of priority claims
- Restoration of the right of priority
- Priority documents (including DAS)

# The right of priority (1)

## (Article 4 of the Paris Convention)

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

# The right of priority (2)

## (Article 4 of the Paris Convention)

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

# Priority date (PCT Article 2(xi))

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

# Claiming priority (PCT Article 8, Rule 4.10)

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

# Contents of priority claims (Rule 4.10)

- Filing date
- Application number Earlier national application:
- “Country Code”:
  - country party to the Paris Convention or Member of WTO in which earlier application was filed (for national earlier application)
  - authority entrusted with the granting of regional patents (in practice, the regional Office concerned) (regional earlier application)
  - 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 (regional earlier application)
  - receiving Office with which the earlier international application was filed (priority is an international application)

# 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 changing the priority date (Rule 26*bis*) (1)

## ■ Cases concerned:

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

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

## ■ Applicable time limit:

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

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

# Correction/addition of priority claims not changing 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 changing 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))

# Restoration of the right of priority - Competent Authorities

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

# Restoration of the right of priority

## Applicable criteria

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

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

## ■ Conditions:

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

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

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

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

- Effect of restoration by RO in the national phase:
  - ❑ RO restoration based on the “due care” criterion is effective in all DOs
  - ❑ RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
  - ❑ RO restoration is not conclusively binding on DOs: limited review by DOs is possible
  - ❑ RO refusal to restore is not binding on DOs
- For declarations of incompatibility with the national law (reservations), see the WIPO website at:  
[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](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)):  
BE, BR, CO, CU, CZ, DE, DZ, ES, GR, ID, IN, IT, JP, KR, NO, PH
  
- ❑ Incompatibility of the effect of decision of RO on DO (Rule 49*ter*.1(g)):  
BR, CA, CN, CO, CU, CZ, DE, DZ, ES, ID, IN, JP, KR, MX, NO, PH, TR, US
  
- ❑ Incompatibility as DO (Rule 49*ter*.2(h)):  
BR, CA, CN, CO, CU, CZ, DE, DZ, ES, ID, IN, JP, KR, MX, NO, PH, TR, US

# 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))

# 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 DK, FI, SE and RO/IB
- The Office with which the earlier national application was filed is known as the Office of First Filing (OFF) or the Depositing Office
- The Office that retrieves the document is known as the Office of Second Filing (OSF) or Accessing Office

# Main steps for the use of DAS

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

# Requesting DAS p-doc retrieval

Details of Priority Claim of Earlier Application

National     Regional     International (PCT)

Country: US United States of America

Filing date: 29 July 2011

Number: 61/274,654

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

Access code: 1234

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

The receiving Office is requested to restore the right of priority

OK Cancel

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

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

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



## **Topic 4:**

- Correction of Defects Relating to the Filing of the Application**
- Rectification of Obvious Mistake**

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

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

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

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

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

- missing sheets of
  - description
  - claims
  - drawings

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

- Enable the inclusion of accidentally omitted elements or parts that are contained in an earlier application of which priority is validly claimed, **without affecting the international filing date**
- What is a missing part? **part** of the description, **part** of the claims, **part** or **all** of the drawings
- What is a missing element? the **whole** description, the **full set** of claims

# Missing parts:

■ Where the RO finds a part is missing, it invites the applicant ([PCT/RO/107](#)):

- to **complete** the purported international application by furnishing the missing part
  - the IFD changes into the date of receipt of the missing part (PCT Rules 20.5(b) and (c))

**or**

- to **confirm** that the part was incorporated by reference
  - if the conditions for incorporation by reference are met, the IFD is maintained (PCT Rules 20.6(b) and 20.5(d))

# Missing elements

■ If the RO finds elements are missing it shall invite the applicant ([PCT/RO/103](#)):

- to **furnish** the required missing element
  - the IFD changes into the day the requirements for filing an international application are fulfilled (PCT Article 11(2)(b) and Rule 20.3(b)(i))

**or**

- to **confirm** that the element is incorporated by reference
  - if the conditions of incorporation by reference are met, the IFD is maintained (PCT Rule 20.6(b) and 20.3(b)(ii))

# 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

# Requirement: 'completely contained' (Rule 20.6 PCT)

- The omitted part(s) or element(s) are **completely contained** in the earlier application from which the priority was validly claimed
  - the later filed missing part must be **identical** to the corresponding text/drawing in the priority document
- Request contains a statement of (conditional) incorporation by reference (Rule 4.18 PCT)
  - automatic on Form PCT/RO/101

**Incorporation by reference:** where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.

# Confirmation of incorporation by reference (1) : time limit (PCT Rule 20.7)

- Where an invitation to file the missing parts/elements was sent by the RO: **two months** from the date of the invitation (Rule 20.7(i))
- Where no invitation was sent to the applicant by the RO: **two months** from the international filing date (Rule 20.7(ii))

# Confirmation of incorporation by reference (Rule 20.6) (2): requirements

## ■ Documents to be filed (Rule 20.6):

- Written notice of confirmation
- Missing sheets (replacement sheets)
- Copy of the earlier application as filed (unless the priority document already submitted)
- Translation of the priority document if priority claim not in the language of the international application
- Indication(s) as to where in the priority document (and translation) the missing parts are contained

# Requirement: 'completely contained' (Rule 20.6 PCT)

- The omitted part(s) or element(s) are **completely contained** in the earlier application from which the priority was validly claimed
  - the later filed missing part must be **identical** to the corresponding text/drawing in the priority document
- Request contains a statement of (conditional) incorporation by reference (Rule 4.18 PCT)
  - automatic on Form PCT/RO/101

**Incorporation by reference:** where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in this international application but is completely contained in an earlier application whose priority is claimed on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in this international application for the purposes of Rule 20.6.

# Confirmation of incorporation by reference (1) : time limit (PCT Rule 20.7)

- Where an invitation to file the missing parts/elements was sent by the RO: **two months** from the date of the invitation (Rule 20.7(i))
- Where no invitation was sent to the applicant by the RO: **two months** from the international filing date (Rule 20.7(ii))

# Procedure at RO (2)

■ Upon receipt of confirmation notice + replacement sheets (“real” cases of missing parts/elements):

□ RO stamps them pursuant to Section 309 of the AIs

(a) This Section applies, subject to paragraph (f), to later submitted sheets which accompany a notice confirming under Rule 20.6 that an element or part embodied in those sheets was incorporated by reference.

(b) Where later submitted sheets as referred to in paragraph (a) are received within the applicable time limit referred to in Rule 20.7 and the receiving Office makes a finding under Rule 20.6(b), the receiving Office shall:

(i) indelibly mark, in the middle of the bottom margin of each later submitted sheet, the words “INCORPORATED BY REFERENCE (RULE 20.6)”, or their equivalent in the language of publication of the international application;

(ii) notify the applicant that the element or part contained in the later submitted sheets is considered to have been contained in the international application or purported international application on the date when sheets were first received and that that date has been accorded or retained, as the case may be, as the international filing date;

(iii) keep in its files a copy of the later submitted sheets marked under item (i) and of the notice under Rule 20.6(a);

(iv) where transmittals under Article 12(1) have already been made, notify the International Bureau and the International Searching Authority accordingly, and transmit the later submitted sheets marked under item (i) to the said Bureau and a copy thereof to the said Authority;

(v) where transmittals under Article 12(1) have not yet been made, attach the later submitted sheets marked under item (i) and the notice under Rule 20.6(a) to the record copy and a copy thereof to the search copy.

# Procedure at RO (3)

- Upon receipt of confirmation notice + replacement sheets (case where the applicant intends to “replace” existing IA body):
  - RO stamps them pursuant to Section 309 of the AIs AND process them according to paragraph 205F of the ROGLs

## Incorporation by Reference Cannot Replace Elements/Parts of the International Application as Originally Filed

205F. Where the applicant wishes to completely replace an element or all elements of an international application as originally filed with different elements through incorporation by reference of missing parts, the receiving Office may only add any elements of the international application as missing parts but may not perform a substitution of the international application as filed with the subsequently furnished missing parts. The description, claims or drawings from the earlier application, which are to be incorporated by reference, cannot replace the description, claims or drawings of the international application as filed. The parts to be incorporated by reference (Rule 20.5) should be combined with the elements of the international application originally submitted and should be checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. The receiving Office should invite the applicant to, or, if at all feasible and if the Office so wishes, by way of an ex officio correction, order the pages of the combined international application in such a manner that the sheets incorporated by reference are placed first, sequentially followed by the pages which were originally filed such as in the following example:

Description incorporated from earlier application

Description as originally filed

Claims incorporated from earlier application

Claims as originally filed

Drawings incorporated from earlier application

Drawings as originally filed

# Procedure at RO (3)

- Once replacement sheets are processed, RO issues:
  - Form [PCT/RO/114](#), notifying the applicant of RO's decision in the matter; points out to the pages concerned –RO should pay careful attention when filling– in this form, very useful for DOs, especially where only very “small” parts are missing but the entire sheet embodying the incorporated part is stamped pursuant to Section 309–
  - Where replacement sheets **are not** considered under the “umbrella” of Rule 20.6 and incorporation by reference or where incorporation is not granted = completing the IA body will result in a later IFD, RO to issue form(s) [PCT/RO/126](#);
    - If the applicant comes back and **does not** want the replacement sheets to be implemented (for **missing part ONLY**), 2<sup>nd</sup> form PCT/RO/126 to be issued

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

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

# Declarations of incompatibility with the national law

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

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

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

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

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

# Rectification of obvious mistakes (Rule 91) (1)

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

# Rectification of obvious mistakes (Rule 91) (2)

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

# Rectification of obvious mistakes (3)

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

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

## ■ Refused request for rectification:

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

# Correction procedure (Rule 26.4)

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

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

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

# When and how to file a replacement sheet?

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



## Topic 5:

- Agents and Common Representatives
- Recording of changes under Rule 92*bis*
- Withdrawals

# 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(a)); and,
  - where an RO does not require that powers of attorney have to be submitted (Rules 90.4 and 90.5), a withdrawal made by an agent or common representative who has not submitted powers signed by all applicants (Rule 90*bis*.5(a))

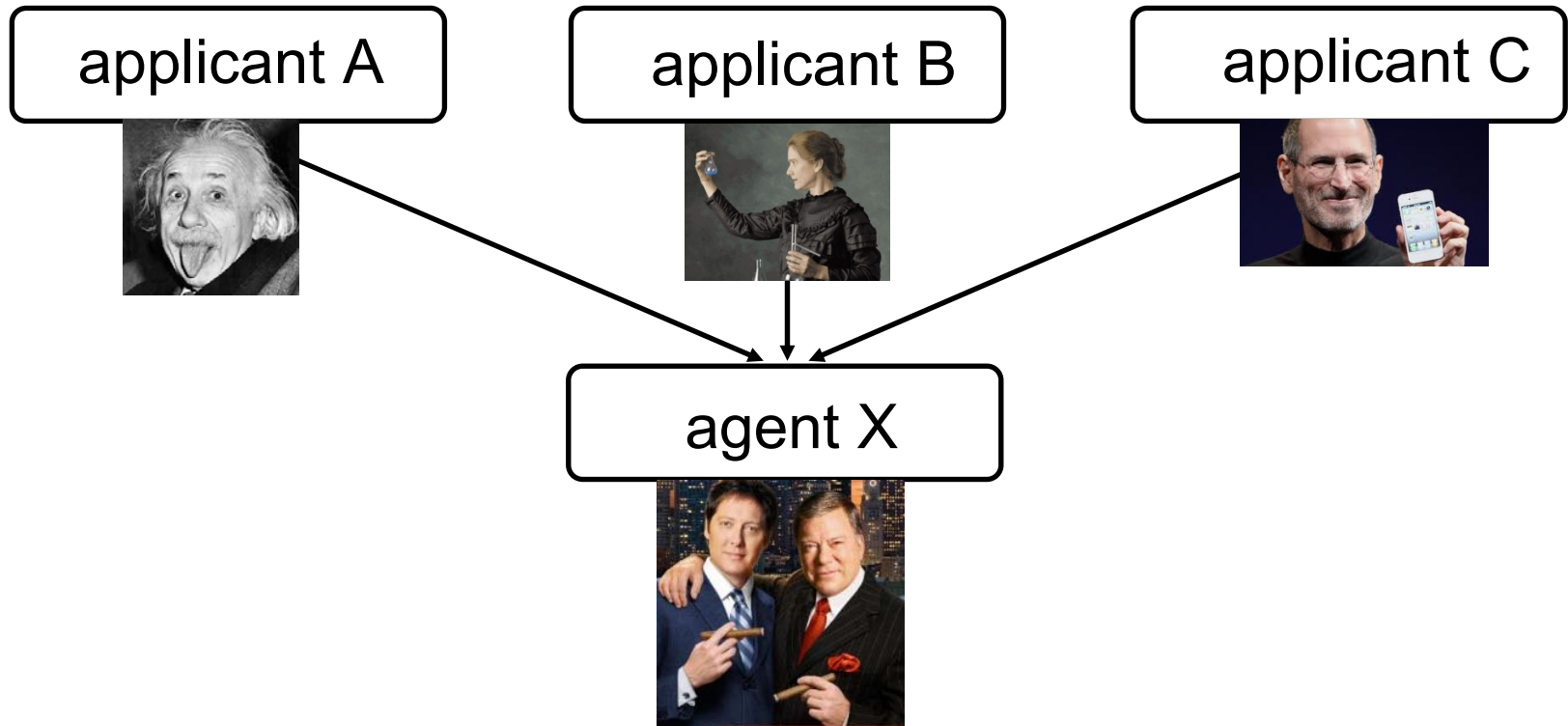
# Appointment of agents and common representatives (Rules 90.4 to 90.6)

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

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

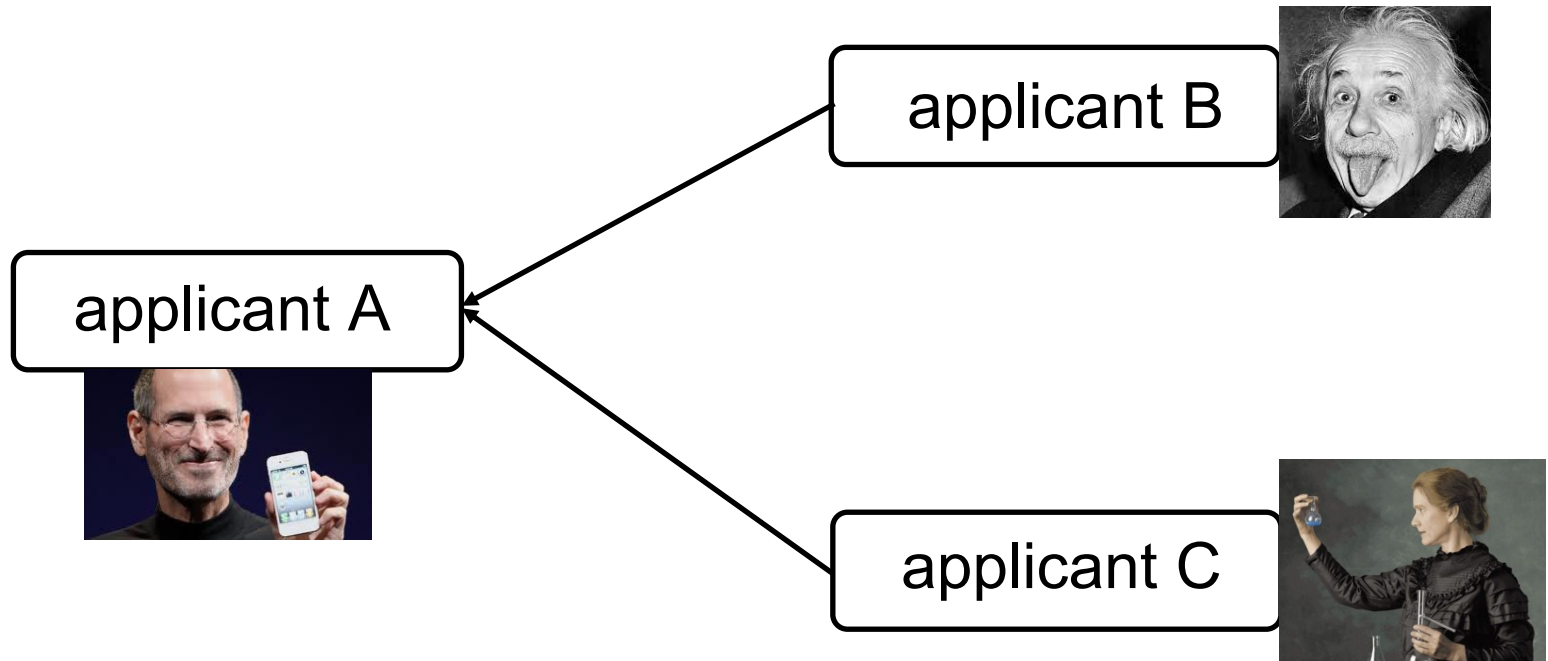
- RO, ISA, IPEA and IB may waive the requirement that:
  - a separate power of attorney; and/or
- RO, ISA and IPEA may waive the requirement that
  - a copy of a general power of attorney has to be furnished
- Any Office or Authority that has waived the requirement in general may nevertheless require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

# Common agent



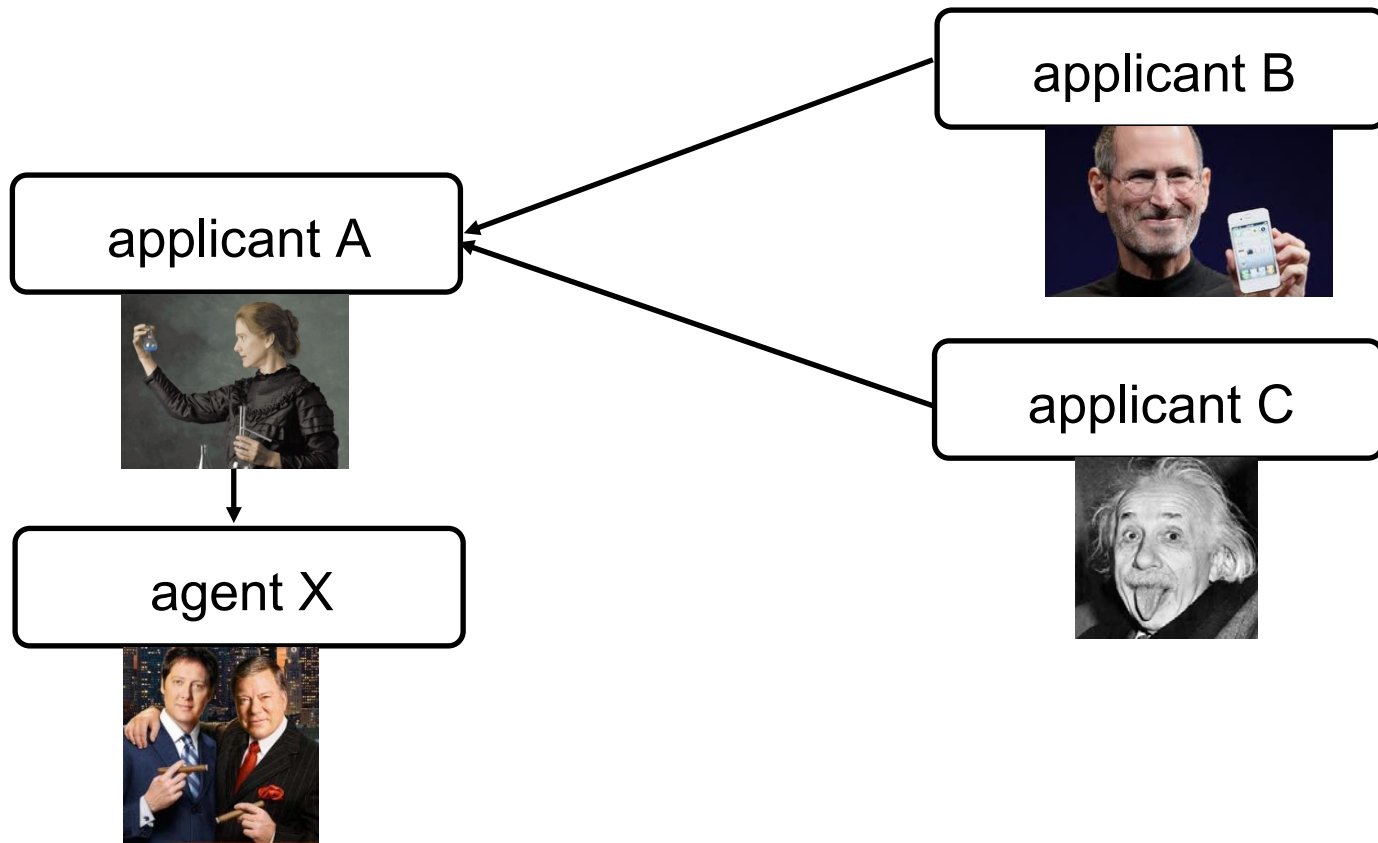
Agent X is a common agent if he has been appointed by all applicants. He can sign the withdrawal on behalf of all applicants.

# Appointed common representative



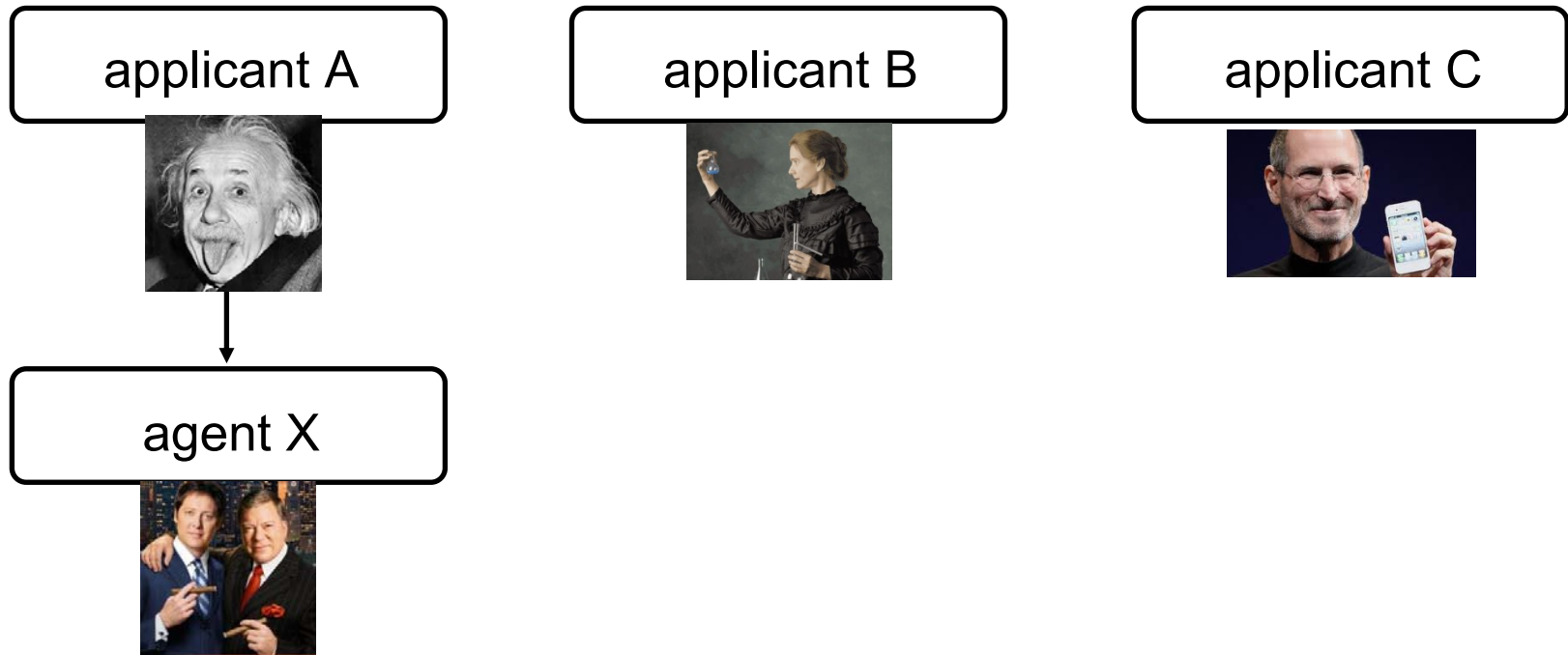
- Applicants B and C appoint applicant A as their common representative.
- Applicant A may be so appointed only if national or resident of a PCT Contracting State.
- Applicant A can sign the withdrawal on behalf of all applicants.

# Agent of the appointed common representative



- Applicant A, who has been appointed by the other applicants as their common representative, appoints agent X.
- Agent X can sign all documents for all applicants including any withdrawal, provided that where an RO has waived the requirement that powers of attorney have to be submitted, such powers are on file.

# “Deemed” common representative



- There is no common agent and no common representative. Consequently applicant A is the "deemed" common representative.
- Agent X, appointed only by applicant A, can sign all documents for all applicants, except any withdrawal. A withdrawal has to be signed by agent X and applicant B and C.

# Recording of changes under Rule 92*bis*: cases covered

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

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

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

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

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

# Time limit under Rule 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 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.

# Withdrawals under Chapter I (1)

## ■ What?

- international application, designations of a State or any kind of protection, priority claim

## ■ When?

- before the expiration of 30 months from the priority date
- before completion of the technical preparations for international publication (~15 days before publication), if the applicant wishes to prevent or postpone international publication

## ■ How?

- by a written notice of withdrawal (use of Form PCT/IB/372 recommended) to RO or IB
- signed by all applicants or
- on their behalf by the appointed agent or the appointed common representative (applicant appointed by all the other applicants)
  - appointment has been effected by each applicant signing the Request or a power of attorney
  - Otherwise: the withdrawal has to be accompanied by a power of attorney signed by all applicants

# Withdrawals under Chapter I (2)

## ■ Effect:

- effective upon receipt by the RO or the IB
- withdrawal has no effect in Offices where national processing or examination has already started
- withdrawal of international application or designations:
  - effect ceases in each designated State concerned, with the 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 earliest priority claim: time limits which have not expired are re-calculated on the basis of the revised priority date

# Withdrawals under Chapter II (1)

## ■ What?

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

## ■ When?

- before the expiration of 30 months from the priority date

## ■ How?

- by a written 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 of a State

# Withdrawals under Chapter II (2)

## ■ Effect:

- withdrawal effective upon receipt by appropriate Authority (RO,IB,IPEA)
- withdrawal of priority claim: time limits which have not expired are re-calculated on the basis of the revised priority date

# Withdrawals under Chapter II (3)

- Early national phase entry:
  - withdrawal has no effect in Offices where national processing or examination has already started
- Offices which do not apply the 30 months time limit (LU,TZ,UG):
  - If a demand is filed before the expiration of 19 months, the time limit for national phase entry for those States is delayed from 20/21 months to 30 months from the priority date
  - withdrawal of demand or elections before the expiration of 20/21 months, the usual 20/21 months time limit for national phase entry applies
  - withdrawal of demand or elections after the expiration of 20/21 months is considered to be withdrawal of the IA for those States (unless the applicant has already entered the national phase)



## **Topic 6:**

- Functions of the International Bureau**
- International Publication and Patentscope**
- The International Bureau as receiving Office**

## **Functions of the International Bureau**

# General responsibilities under the PCT (1)

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

# General responsibilities under the PCT (2)

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

# Responsibilities related to international applications (1)

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

# Responsibilities related to international applications (2)

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

# Responsibilities related to international applications (3)

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



# International Publication and PATENTSCOPE

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

## ■ When?

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

## ■ Publication languages:

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

## ■ Contents of published international application

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

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

□ where applicable:

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

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

□ upon applicant's request\*:

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

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

# 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

# Frequency of international publication

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

# Technical preparations for international publication

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

For example: if the publication date is: Thursday, *24 January 2013*, technical preparations are completed on Wednesday, *9 January 2013*.

Consequently, any document that reaches the International Bureau on Tuesday, *8 January 2013*, 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.

# Effects of international publication

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

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

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

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

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

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

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

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

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

## The International Bureau as receiving Office (RO/IB)

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

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

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

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

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

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

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

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

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

## ■ Consequences of the transmittal:

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

whichever time limit expires later

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

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



## Topic 7:

**-International Search and Written  
Opinion of the ISA**

**-Supplementary international search**

**-Amendments under Article 34**

# International Searching Authorities (19 in total, 17 in operation)

- AU - Australia
- AT - Austria
- BR - Brazil
- CA – Canada
- CL – *Chile (exp. October 2014)*
- CN - China
- EG - Egypt (July 2013)
- FI - Finland
- IN - *India (15 October 2013)*
- IL - Israel
- JP - Japan
- KR - Republic of Korea
- RU - Russian Federation
- ES - Spain
- SE – Sweden
- UA - *Ukraine (appointed in 2013)*
- US - United States of America
- EP - European Patent Office
- XN - Nordic Patent Institute  
(Denmark, Iceland, Norway)

# International Searching Authority

## ■ Main roles:

- ❑ 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*)

## ■ Other responsibilities:

- ❑ Checks title (Rule 37); checks abstract (Rule 38)
- ❑ Authorizes rectification of obvious mistakes (Rules 91.1(b)(ii) and (iv))

# 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.

# Non-establishment of international search report

- Application relates to a subject matter not searched by the ISA (Article 17(2)(a)(i) and Rule 39.1)
  - See Annex B to ISA and IPEA Agreements  
[http://www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html)
- No meaningful search can be carried out in respect of any of the claims (Article 17(2)(a)(ii))
- A disclosed nucleotide and/or amino acid sequence is not furnished in compliance with Annex C of the Administrative Instructions or is not in electronic form (Rule 13<sup>ter</sup>.1(d))

# Consequences of non-establishment of International Search Report

- 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))
- 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))

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

- Initial preliminary non-binding opinion on:
  - novelty (not anticipated)
  - inventive step (not obvious)
  - industrial applicability
- Prior art:
  - same as for international search purposes; BUT:
  - relevant date: everything made available to the public prior to the priority date
- NOT published together with the application (will be made available on PATENTSCOPE for applications with international filing date after July 1, 2014)

# Time limit to establish ISR and written opinion

- 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

# Example of an ISR

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
X Y A	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1 page 3, lines 5-7 Fig. 5, support 36	1-3 4, 10 11-12
X Y	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3 4
A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1
A	GREEN, J.P. Integrated Circuit and Electronic IBM Technical Disclosure Bulletin Vol. 17, No. 6, page	1-5

**Symbols indicating which aspect of patentability the document cited is relevant to (for example, novelty, inventive step, etc.)**

**Documents relevant to whether or not your invention may be patentable**

**The claim numbers in your application to which the document is relevant**

# Example of the Written Opinion

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY				International application No.
Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement			
1.	Statement			
	Novelty (N)	Claims	<u>Claim(s) 3-15</u>	YES
		Claims	<u>Claim(s) 16</u>	NO
	Inventive step (IS)	Claims	<u>Claim(s) 8, 10-12</u>	YES
		Claims	<u>Claim(s) 3-7, 9, 14-16</u>	NO
	Industrial applicability (IA)	Claims	<u>Claim(s) 3-16</u>	YES
		Claims	_____	NO
2.	Citations and explanations:			
	<b>INDEPENDENT CLAIM 3</b>			
	Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject matter of INDEPENDENT CLAIM 3			
	Document US-A-5 332 238, which is considered to represent the most relevant state of the art,			

**Patentability assessment of the claims**

**Reasoning supporting the assessment**

# Options for applicant on receipt of ISR and Written Opinion

- File amendments under Article 19
- Request a supplementary international search
- File demand for international preliminary examination (Chapter II)
- Submit informal comments on written opinion to the International Bureau

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

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

# 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 established 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 EOs

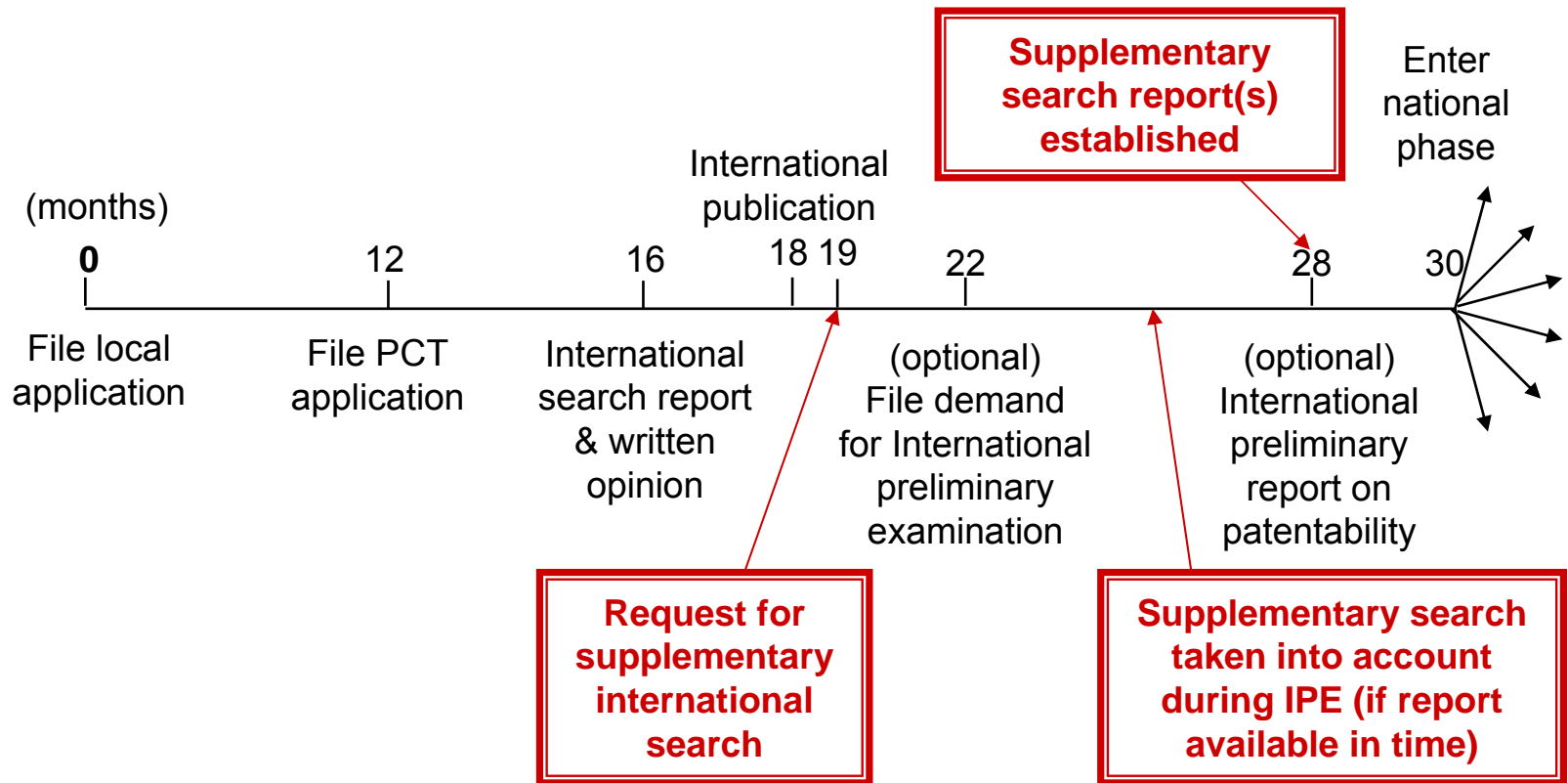
# Amendments under Article 19 (Rule 46)

- One opportunity to amend the claims only after receipt of the international search report and written opinion of the ISA
- Must be filed with IB (Rule 46.2)
- In language of publication (Rule 46.3)
- Time limit - normally within two months from the date of transmittal of the international search report and written opinion of the ISA (Rule 46.1)
- Published as part of the international application at 18 months, together with the claims as originally filed (Rule 48.2(f))

# Form of Amendments under Article 19 (Rule 46)

- Replacement sheets containing a complete set of claims
- Accompanying letter
  - Explaining what claims have been amended
  - Indicating the basis for amendments in the application as filed
- Optional - statement explaining amendments and impact on description and drawings (Article 19(1), Rule 46.4)

# SIS in the PCT System



# Supplementary International Search (SIS) (Rule 45*bis*)

- An applicant can request optional supplementary search by any Authority offering this service\* except the one responsible for main international search
- Request must be filed with the International Bureau within 19 months from priority date
- Authority begins SIS on receipt of request and ISR, or 22 months from priority date, at the latest
- SIS report established by 28 months from priority date

\* Currently AT, EP, FI, RU, SE, XN

# Deciding When to Request SIS

- The main international search report is intended to be of a high quality, sufficient for normal purposes
- Service may give extra information and could be useful in certain situations:
  - 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))

# Scope of Search (1)

- Supplementary search is carried out on the claims as filed (Article 19 and 34 amendments are not taken into account)
- Only one invention searched – no option to pay additional fees - but applicant may request supplementary search to focus on an invention other than the first (Rule 45*bis*.1(d))
- 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

# 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

# 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



## **Topic 8:**

**-International Preliminary  
Examination**

**-Amendments under Article 34**

# Effects of International Preliminary Examination

- Provides a preliminary 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))
- Gives opportunity to amend entire international application (Article 34) before entering the national phase in the elected Offices
- Delays national phase entry to 30 months at designated Offices where the 20-month time limit under Article 22(1) continues to apply (LU, TZ, UG)

# 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 bound by Chapter II, and
- whose international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II (currently all States)

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

- Directly with the competent IPEA
- The competent IPEA(s):
  - is (are) 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 on the first sheet of 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

# At what time 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
- International preliminary examination will not start before the expiration of the time limit under Rule 54bis.1(a) unless applicants expressly request earlier start

# At what time should a demand be filed? (Rule 54*bis*.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)

# 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)

# 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

# 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))

# Prior art for IPE (Rule 64.1)

## ■ 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

## ■ 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

# Written opinion of IPEA (Rule 66.2)

- 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

# 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)

# 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*)

# 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

# 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

# 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*)

# Form of amendments (Rule 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



## **Topic 9: ePCT Workshop**

Electronic portal for PCT applications

# Overview

- What is ePCT?
  - <http://pct.wipo.int/ePCT>
- Getting started
- Managing your PCT applications

Screen views are from the ePCT demo portal

# ePCT


- Online portal that provides PCT services for both applicants and offices
- Available since May 2011
- Provides secure and direct interaction with PCT applications maintained by the International Bureau
- Applicants may now conduct most PCT transactions electronically
- Web-based electronic filing is coming soon

## ePCT for Applicants and Third Parties

The ePCT system offers two distinct types of online services:

- ePCT *public* services, requiring the creation of a standard WIPO user account (no access to confidential documents or data).
- ePCT *private* services, requiring additional authentication by uploading a digital certificate to a WIPO user account.

Note that this does not yet include the filing of new international applications.

 ePCT *private* services

**Access ePCT private services**  
(certified account holders only)

Smartcard holders using Internet Explorer should log in by clicking [here](#).

ePCT *private* online services enable access to international applications filed as of 1 January 2009, that are owned or managed by you. [Create an account](#)

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Supported browsers: Mozilla Firefox 3.6+ (recommended), Internet Explorer 7+  
The system may not work correctly with other browsers and we will not be able to give assistance in these cases.

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# ePCT modes

## ■ “Private” Services

- Authentication using both a WIPO User Account (username and password) and a digital certificate
- Access to full range of services and functions
- Access to applications filed as of January 1, 2009, including before publication

## ■ “Public” Services

- Limited functionality (document upload and third party observations)
- Only a WIPO User Account (username and password) is required

# Getting Started

- <http://pct.wipo.int/epct>
- Creating a WIPO User Account using the WIPO Accounts service
- Obtaining/Uploading a certificate (the following certificates are currently supported)
  - WIPO digital certificate
  - EPO digital certificate (smart card)
  - KIPO digital certificate
  - JP SECOM digital certificate
- USPTO digital certificates are not supported

# WIPO Digital Certificate

- A small electronic file with data that identifies the user (must be installed in your browser in order to authenticate access to ePCT private services)
- Available free-of-charge from WIPO, valid 2 years, renewable
- One-time opportunity over a two week period to download the digital certificate
- Backup the digital certificate
  - Export and password protect the digital certificate ([ePCT User Guide](#), page 31)
  - E-mail the digital certificate to yourself and/or save it on a USB stick

# e-Handshake

- First step in providing access to PCT applications
- Consists in the association and trusted recognition between different WIPO User Accounts
- e-Handshakes do not directly result in shared access rights which have to be specifically assigned
- e-Handshake screen is hosted in WIPO Accounts (your name at the top of the screen functions as a shortcut link, **or select “My Account” from the cogwheel**)
- Possibility to create default list of e-Handshake users

New

Current time in Geneva, Switzerland  Monday, 11 February 2013, 15:07 CET

Search by IA Number

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eOwnership

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## e-handshakes

### Initiate e-handshake

---

Your Customer ID is **user\_CH\_CONTI-LANDER\_PAOLA\_6375**. 

### Request new e-handshake







---

Enter the Customer ID of the user to whom you want to send an e-handshake request:

Customer ID \*

### My e-handshakes

---

 <b>Aino METCALFE</b>	[user_CH_METCALFE_AINO_7918]	<a href="#">delete</a>	
 <b>Beatriz LARGO</b>	[user_CH_LARGO_BEATRIZ_4657]	<a href="#">delete</a>	
 <b>Friedrich Feistauer</b>	[user_CH_FEISTAUER_FRIEDRICH_0083]	<a href="#">delete</a>	
 <b>Quan-Ling Sim</b>	[user_CA_SIM_QUAN-LING_0554]	<a href="#">delete</a>	
 <b>Rosalina ARGANOZA</b>	[user_CH_ARGANOZA_ROSALINA_3612]	<a href="#">delete</a>	

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- Subsequent to electronic filing using a supported digital certificate
- Paper-filed applications or electronically-filed applications with non-supported digital certificate
- All other cases
- Multiple applications

# Taking “eOwnership” At the time of electronic filing

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Search by IA Number

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## Default access rights for my eHandshake user(s)

Manage my default access rights

## Confirm eOwnership

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Confirm eOwnership

Single IA  Multiple IAs

International Application Number \* :

International Filing Date \* :  

Confirmation Code \* :

Only for unpublished IAs

## Request eOwnership Code for use in PCT e-filing software

Request eOwnership  
Code

# Taking “eOwnership” PCT-SAFE electronic filing

**eOwnership Code**

Copy/Paste your Customer ID and eOwnership Code to the fields on the e-filing software signature screen.  
The eOwnership Code can only be used for one application.

Customer ID	user_CH_CONTI-LANDER_PAOLA_6375
eOwnership Code	RZ.JWVEWYY4QW60

Close

**Signature**

Legal Signature

Alphanumeric

Facsimile

Advanced Digital (No more signatures can be applied - this signature should be finalizing the signing process.)

**Assign eOwnership in ePCT (optional)**

ePCT Customer ID:

ePCT eOwnership code:

Apply Signature Cancel

# Taking “eOwnership” eOLF electronic filing

Sign Application

Select an entry from the list, choose the type of signature and enter the corresponding details.

**Applicants**  
METCALFE, AINO  
<other>  
**Representatives**  
<other>

**Sign for applicant METCALFE, AINO:**

Applicant Name: METCALFE, AINO

ePCT Customer ID: er\_CH\_METCALFE\_AINO\_7918

ePCT eOwnership code: GXDRQZ25KF6920

Type of signature:

Smart Card  
 Soft Certificate  
 Alphabetical  
 Facsimile

Smart card details:

Enter PIN Code: \*\*\*\*\*

Place of Signing: Geneva

Save settings as default (Can be changed in preferences)

Sign

Close

# Taking “eOwnership” At the time of electronic filing

- Indications provided at the time of filing will be verified by the International Bureau against the record in ePCT
- eOwnership automatically assigned

# Taking “eOwnership”

## E-filed applications (unpublished)

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

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

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## Paper or non-supported digital certificate

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- Enter PCT/IB/301 confirmation code
- Will trigger an on-line form for the International Bureau to approve or reject the request

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eOwnership ⓘ

All fields marked with \* are mandatory

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International Application Number \* : FI1230012

International Filing Date \* : 1/1/2012

Confirmation Code \* : MGPLAAG69XMVCD  
Only for unpublished IAs

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Do you want to request eOwnership from the IB? [Yes](#)

eOwnership request

Please complete the form below to request eOwnership from the International Bureau.

International Application Number : PCT/FI2012/030012
International Filing Date : 01 Jan 2012
First Name : Quan-Ling
Last Name : Sim
Customer ID : user\_CA\_SIM\_QUAN-LING\_0554
Email : sim@wipo.int
Telephone Number :

Address \*
If not available from WIPO Accounts

Company Name : WIPO
Company Address :

Position in company :

Role in IA \*
Agent Applicant Common representative Address for correspondence

Number of claims in IA \*

Message :

Request eOwnership Cancel


# Taking “eOwnership” Other Cases

- For all other cases, by online request to the International Bureau, e.g., published applications, Rule 92*bis* changes

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eOwnership 

Confirm eOwnership  Single IA  Multiple IAs

International Application Number :

International Filing Date :  

Confirmation Code :

 The confirmation code is no longer valid for the following reason:  
-92bis change since filing.

Do you want to request a new confirmation code from the IB? [Yes](#)

# Taking “eOwnership” Multiple Applications

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**eOwnership** ⓘ

**Confirm eOwnership**       Single IA    Multiple IAs

eOwnership can only be confirmed for multiple IAs that fulfill the following conditions:

- filed electronically with a certificate supported by ePCT that has been uploaded to your WIPO account;
- not yet published;
- no 92bis request has been submitted since filing;

For such IAs please use the single IA option to request confirmation code / request eOwnership.

IB11/500052,S6TKATRLGX2KF0  
IB11/500053,D55M37TVR4FPA0  
IB11/500054,G5Y7QUKCAHLDF0

Accepted formats:

PCT/IB2011/000123, [Confirmation code from Form 301]  
IB2011/000123, [Confirmation code from Form 301]  
IB11/000123, [Confirmation code from Form 301]

Each IA number and code pair should be on a new line ("Enter" after code).

---

**eOwnership confirmation results**


You have successfully confirmed eOwnership of the following international applications:

IA Number
<a href="#">PCT/IB2011/500052</a>
<a href="#">PCT/IB2011/500053</a>
<a href="#">PCT/IB2011/500054</a>

# eOwnership approval by the International Bureau

- Only requests from persons on the file of an IA can be approved
  - Applicant, agent, person appointed as address for correspondence, person name on the transmittal receipt for e-filed applications
- If the International Bureau cannot match the request with a person on the file, form PCT/IB/345 containing the confirmation code will be sent to the address for service
- The notification also contains the contact details of the requestor, so that the person at the address for service can pass on the confirmation code if appropriate


# Workbench









- List of all PCT applications to which you have access (eOwner, eEditor, eViewer)
- The Workbench contains a number of columns
  - IA Number
  - IA Status
  - File Ref
  - [...]
-   Various filter options: outstanding fees with RO/IB, receipt of search copy not yet confirmed by ISA, comments and warnings containing keywords
- Clicking on a PCT application will open up a detailed file view

Current time in Geneva, Switzerland  Tuesday, 26 February 2013, 15:14 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) **[Workbench](#)** [PCT/IB2012/030581](#) 

Items 1-3 of 3  per page Filter IAs:  

<input type="checkbox"/>	IA Number	IA Status	File Ref	IFD	Last Accessed	Portfolio Name	IASR	Applicant Name	My Rights	My Comments	Warning
<input type="checkbox"/>	<a href="#">PCT/IB2012/030581</a>	Not yet Published	<a href="#">Demo-101</a>	02 Aug 2012	26 Feb 2013			Sim, Guan-Ling	<a href="#">eOwner</a>		 Priority period expir ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030282</a>	Not yet Published	<a href="#">epct24</a>	11 May 2012	31 Jul 2012			EPCT COMPANY	<a href="#">eEditor</a>		 Erik is on holiday ne ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030212</a>	Not yet Published	<a href="#">beatriz1</a>	30 Apr 2012				ABC COMPANY	<a href="#">eOwner</a>		

Perform action on selected applications

# File View

- Access to the PCT file maintained by the International Bureau (documents plus up-to-date bibliographic data)
- Front-page preview
- My Comments (visible only to the current ePCT user)
- Warning (viewable to all users who have access rights)
- Information about target date for international publication
- Indications about the public availability of each document type
- Direct link to the PCT application in PATENTSCOPE (as of the publication date)

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 10:10 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#) 

**PCT/IB2012/030581** 

[File View](#) [Upload Documents](#) [Time Line](#) [Access Rights](#) [History](#) [Actions](#) [Bibliographic Data](#)

Title	:	(EN) MY INVENTION	File Reference	:	Demo-101
International Filing Date	:	02 Aug 2012	Applicant Name	:	Sim, Quan-Ling
Priority Date	:	No Priority Claim	Inventor Name	:	Sim, Quan-Ling
International Publication Date	:		Filing Type	:	E-Filing PDF
International Publication Number	:		Portfolio	:	 TOP_INVENTIONS
IA Status	:	<b>Not yet Published</b>	My Comments	:	
International Application Status Report	:	  	Warning	:	 Priority period expi ...
Processing Team at IB	:	R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>			
Address for Service 	:				

<input type="checkbox"/>	Documents on file at the International Bureau [Doc ID] <sup>o</sup>	Date <sup>o</sup>	Status	Pages	
<input type="checkbox"/>	<b>Related Documents</b>				
<input type="checkbox"/>	 Request for Change under Rule 92bis [10]	28 Nov 2012		1	
<input type="checkbox"/>	 Request for Change under Rule 92bis [8]	22 Nov 2012	<b>10</b>	1	
<input type="checkbox"/>	  Notification of receipt of record copy (IB/301) [8]	02 Aug 2012	<b>10</b>	1	
<input type="checkbox"/>	 Fee Calculation Sheet [7]	02 Aug 2012		1	
<input type="checkbox"/>	 E-filing Transmission Receipt [6]	02 Aug 2012		1	
<input type="checkbox"/>	 Validation Log [5]	02 Aug 2012		1	
<input type="checkbox"/>	 RO WASP File [4]	02 Aug 2012		0	
<input type="checkbox"/>	 Request form (RO/101) [3]	02 Aug 2012		3	
<input type="checkbox"/>	 Application Body as Filed [2]	02 Aug 2012		6	

[Multiple Downloads](#)

# Access Rights

- eOwner
  - Complete control over all aspects of the PCT application
- eEditor
  - Can do everything except assign access rights
- eViewer
  - “Look” but don’t “Touch”
- Full history of all access rights modifications is available
- Assignment of access rights for multiple applications
- Access rights automatically assigned to default list of e-Handshake users

New

Current time in Geneva, Switzerland  Friday, 1 March 2013, 13:49 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#) 

PCT/IB2012/030581 



[File View](#) [Upload Documents](#) [Time Line](#) [Access Rights](#) [History](#) [Actions](#) [Bibliographic Data](#)

<b>Title</b>	: (EN) MY INVENTION	<b>File Reference</b>	: Demo-101
<b>International Filing Date</b>	: 02 Aug 2012	<b>Applicant Name</b>	: Sim, Quan-Ling
<b>Priority Date</b>	: No Priority Claim	<b>Inventor Name</b>	: Sim, Quan-Ling
<b>International Publication Date</b>	: 	<b>Filing Type</b>	: E-Filing PDF
<b>International Publication Number</b>	:	<b>Portfolio</b>	: 
<b>IA Status</b>	: <b>Not yet Published</b>	<b>My Comments</b>	: 
<b>International Application Status Report</b>	:   	<b>Warning</b>	:  Priority period expi ...
<b>Processing Team at IB</b>	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
<b>Address for Service</b> 	: 		

**Current Access Rights**

[Edit](#) [History](#)

My Rights

Logged User Name	Time	Assigned By	Role
Paola Conti Lander <a href="mailto:paola.conti@wipo.int">paola.conti@wipo.int</a>	22 Nov 2012 10:01:42 CET	Quan-Ling Sim	eOwner

eOwner

Users	Time	Assigned By
  Quan-Ling Sim <a href="mailto:sim@wipo.int">sim@wipo.int</a>	02 Aug 2012 01:00:00 CEST	Quan-Ling Sim
Carol Bidwell <a href="mailto:pct-carol@wbhsi.net">pct-carol@wbhsi.net</a>	28 Sep 2012 16:37:24 CEST	Quan-Ling Sim

Current time in Geneva, Switzerland Tuesday, 5 March 2013, 15:35 CET

Search by IA Number  Search

ePCT eOwnership Notifications My History Portfolios Workbench PCT/IB2012/030581

PCT/IB2012/030581

File View Upload Documents Time Line Access Rights History Actions Bibliographic Data

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	:	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	:
International Application Status Report	:	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service	:		

Current Access Rights

[Edit](#) [History](#)

My Rights

Logged User Name	Time	Assigned By	Role
Paola Conti Lander <a href="mailto:paola.conti@wipo.int">paola.conti@wipo.int</a>	22 Nov 2012 10:01:42 CET	Quan-Ling Sim	eOwner

eOwner

Users*	Time*	Assigned By*
Quan-Ling Sim <a href="mailto:sim@wipo.int">sim@wipo.int</a>	02 Aug 2012 01:00:00 CEST	Quan-Ling Sim
Carol Bidwell <a href="mailto:pct-carol@wbhsi.net">pct-carol@wbhsi.net</a>	28 Sep 2012 16:37:24 CEST	Quan-Ling Sim

eEditor

Users*	Time*	Assigned By*
Beatriz LARGO <a href="mailto:beatriz.largo@wipo.int">beatriz.largo@wipo.int</a>	04 Mar 2013 15:57:36 CET	Paola Conti Lander
David Reed <a href="mailto:wordhopper@gmail.com">wordhopper@gmail.com</a>	28 Sep 2012 16:58:59 CEST	Carol Bidwell
Rosalina ARGANOA <a href="mailto:rosalina.arganoza@wipo.int">rosalina.arganoza@wipo.int</a>	04 Mar 2013 15:57:36 CET	Paola Conti Lander
Aino METCALFE <a href="mailto:aino.metcalfe@wipo.int">aino.metcalfe@wipo.int</a>	22 Nov 2012 10:01:42 CET	Quan-Ling Sim
Erik Lundell <a href="mailto:erik.lundell@prv.se">erik.lundell@prv.se</a>	29 Nov 2012 10:44:56 CET	Quan-Ling Sim


eViewer























Users*	Time*	Assigned By*
carl oppedahl <a href="mailto:carl@oppedahl.com">carl@oppedahl.com</a>	28 Sep 2012 17:01:12 CEST	Carol Bidwell

Current time in Geneva, Switzerland  Monday, 4 March 2013, 15:30 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#) 

Items 1-10 of 12  per page Filter IAs:  

<input type="checkbox"/>	IA Number*	IA Status*	File Ref*	IFD*	Last Accessed*	Portfolio Name*	IASR	Applicant Name*	My Rights*	My Comments*	Warning*
<input checked="" type="checkbox"/>	<a href="#">PCT/IB2012/030581</a>	Not yet Published	<a href="#">Demo-101</a>	02 Aug 2012	04 Mar 2013			Sim, Quan-Ling	<a href="#">eOwner</a>		 Priority period expir ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030288</a>	Not yet Published	<a href="#">epct30</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input checked="" type="checkbox"/>	<a href="#">PCT/IB2012/030287</a>	Not yet Published	<a href="#">epct29</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030286</a>	Not yet Published	<a href="#">epct28</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030285</a>	Not yet Published	<a href="#">epct27</a>	11 May 2012	01 Mar 2013			EPCT COMPANY	<a href="#">eOwner</a>		
<input checked="" type="checkbox"/>	<a href="#">PCT/IB2012/030284</a>	Not yet Published	<a href="#">epct26</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030282</a>	Not yet Published	<a href="#">epct24</a>	11 May 2012	26 Feb 2013			EPCT COMPANY	<a href="#">eOwner</a>		 Erik is on holiday ne ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030281</a>	Not yet Published	<a href="#">epct25</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030280</a>	Not yet Published	<a href="#">epct23</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030279</a>	Not yet Published	<a href="#">epct22</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		

Perform action on selected applications:

Assign New Rights

To assign rights to another person you must first have established an [eHandshake](#)

Users with existing rights	New Rights
Paola Conti Lander	<input type="text" value="No changes to existing rights"/>
Atsushi SHIOMI	<input type="text" value="No changes to existing rights"/>
Peter WARING	<input type="text" value="No changes to existing rights"/>
Zhilong YU	<input type="text" value="No changes to existing rights"/>
Leila CHAHINE	<input type="text" value="eViewer"/>
Allal Applicant	<input type="text" value="eOwner"/>
Matthias REISCHLE	<input type="text" value="eEditor"/>
Shuhei Yoshiura	<input type="text" value="Remove access rights"/>
	<input type="text" value="No changes to existing rights"/>

# Notifications

## ■ Preferences

- Specify the events in the lifecycle of a PCT application for which you want to receive notifications
- Manner and type of notifications

## ■ Filters

- Received date, read date, date range and


## ■ Clearing notifications



- Removing notifications from the list

Current time in Geneva, Switzerland  Monday, 4 March 2013, 15:42 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#)  [PCT/IB2012/030288](#) 

Items 1-10 of 14  per page [Preferences](#) 

Filter By  Received Date  Read Date  
 Start Date   End Date  

<input type="checkbox"/>	View 	Subject 	IA Number 	Received (14) 	Read (2) 
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030288</a>	01 Mar 2013	04 Mar 2013
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030287</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030286</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030282</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030279</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030278</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030281</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030284</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030285</a>	01 Mar 2013	
<input type="checkbox"/>		<a href="#">ePCT access rights modified</a>	<a href="#">PCT/IB2012/030280</a>	01 Mar 2013	

« « 1 2 » »»»

Current time in Geneva, Switzerland Wednesday

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#)

Items 1-10 of 17  per page

Filter By  
Start Date

<input type="checkbox"/>	View*	
<input checked="" type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>
<input type="checkbox"/>		<a href="#">ePCT access rights mo</a>

Clear Notifications

Notification Preferences

Notify me about events in IAs where my access rights are:

- eEditor
- eOwner
- eViewer

Method of Notification:

- e-mail
- Notifications tab

Notify me about the following events for all IAs in my workbench:

- I am eOwner and access rights changes are made by another eOwner
- Priority document(s) still outstanding and international publication is scheduled to take place in 2 weeks
- Time limit for submitting Article 19 amendments expires in 2 weeks
- Technical preparations for publication scheduled to close in 2 weeks
- Republication event has been scheduled by the IB
- Time limit to request supplementary international search expires in 2 weeks
- Time limit to file Chapter II Demand expires in 2 weeks
- 30 month time limit (end of the international phase) expires in 1 month
- IA Warning added/modified
- New document processed and/or new form issued

OK

Cancel

CONTACT US

Search by IA Number

[Preferences](#)

ived (17)*	Read (3)*
Mar 2013	06 Mar 2013
Mar 2013	
Mar 2013	
Mar 2013	
Mar 2013	04 Mar 2013
Mar 2013	
Mar 2013	
Mar 2013	
Mar 2013	
Mar 2013	

# My History



- All actions that “you” as a user have performed in ePCT
- Default view is for the last one week period
- There is also a similar History function within each PCT application which includes all actions by all ePCT users

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 15:38 CET





Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#) 

My History 

Start Date   End Date  

IA Number *	IFD *	File Ref *	Type of Action *	Audit Info *	Date/Time *
			Set user code (for PCT-SAFE)	eOwnership code requested for use in PCT-SAFE.	05 Mar 2013
<a href="#">PCT/IB2012/030287</a>	May 11, 2012	epct29	Confirm IA	Confirmation failed - Reason: eOwnership of this IA has already been confirmed by another user.	05 Mar 2013
			Set user code (for PCT-SAFE)	eOwnership code requested for use in PCT-SAFE.	05 Mar 2013
			Set user code (for PCT-SAFE)	eOwnership code requested for use in PCT-SAFE.	05 Mar 2013
<a href="#">PCT/IB2012/030287</a>	May 11, 2012	epct29	Confirm IA	Confirmation failed - Reason: eOwnership of this IA has already been confirmed by another user.	05 Mar 2013
<a href="#">PCT/IB2012/030288</a>	May 11, 2012	epct30	Confirm IA	Confirmation failed - Reason: You already have eOwner access rights to this IA.	05 Mar 2013
<a href="#">PCT/IB2012/030278</a>	May 11, 2012	epct21	Confirm IA	Confirmation failed - Reason: You already have eOwner access rights to this IA.	05 Mar 2013
			Rename portfolio	Portfolio TOP.INVENTIONS renamed to TOP_INVENTIONS.	05 Mar 2013
<a href="#">PCT/IB2012/030212</a>	Apr 30, 2012	beatriz1	Add IA to portfolio	IB2012030212 added to portfolio CREATIVE_INVENTIONS.	05 Mar 2013
<a href="#">PCT/IB2012/030278</a>	May 11, 2012	epct21	Add IA to portfolio	IB2012030278 added to portfolio CREATIVE_INVENTIONS.	05 Mar 2013

  1 2 3  

# Portfolios

- User-defined personal folders for filing and grouping PCT applications
- PCT applications contained in portfolios are links to applications contained in the workbench
- Deletion of PCT applications from a portfolio only deletes the folder link

Current time in Geneva, Switzerland 🇨🇭 Tuesday, 5 March 2013, 9:51 CET

Search by IA Number

- [ePCT](#)
- [eOwnership](#)
- [Notifications](#)
- [My History](#)
- Portfolios**
- [Workbench](#)

2 Portfolio(s)

[Create Portfolio](#) 























Portfolio Name+	Last Accessed+	No of IAs+
<a href="#">CREATIVE_INVENTIONS</a>	05 Mar 2013	2
<a href="#">TOP_INVENTIONS</a>	05 Mar 2013	5

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 9:58 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) **[Workbench](#)**

Items 1-10 of 12  per page Filter IAs: All in workbench

<input type="checkbox"/>	IA Number	IA Status	File Ref	IFD	Last Accessed	Portfolio Name	IASR	Applicant Name	My Rights	My Comments	Warning
<input type="checkbox"/>	<a href="#">PCT/IB2012/030581</a>	Not yet Published	<a href="#">Demo-101</a>	02 Aug 2012	04 Mar 2013	TOP_INVENTIONS		Sim, Quan-Ling	<a href="#">eOwner</a>		 Priority period expir ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030288</a>	Not yet Published	<a href="#">epct30</a>	11 May 2012	04 Mar 2013			EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030287</a>	Not yet Published	<a href="#">epct29</a>	11 May 2012	04 Mar 2013	TOP_INVENTIONS		EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030286</a>	Not yet Published	<a href="#">epct28</a>	11 May 2012	04 Mar 2013	TOP_INVENTIONS		EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030285</a>	Not yet Published	<a href="#">epct27</a>	11 May 2012	04 Mar 2013	TOP_INVENTIONS		EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030284</a>	Not yet Published	<a href="#">epct26</a>	11 May 2012	04 Mar 2013			EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030282</a>	Not yet Published	<a href="#">epct24</a>	11 May 2012	04 Mar 2013	TOP_INVENTIONS		EPCT COMPANY	<a href="#">eOwner</a>		 Erik is on holiday ne ...
<input type="checkbox"/>	<a href="#">PCT/IB2012/030281</a>	Not yet Published	<a href="#">epct25</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030280</a>	Not yet Published	<a href="#">epct23</a>	11 May 2012				EPCT COMPANY	<a href="#">eOwner</a>		
<input type="checkbox"/>	<a href="#">PCT/IB2012/030279</a>	Not yet Published	<a href="#">epct22</a>	11 May 2012	04 Mar 2013			EPCT COMPANY	<a href="#">eOwner</a>		

« « « 1 2 » » » »

Perform action on selected applications

Manage access rights

W  
A

# Upload Documents

- Article 19 Amendments
- Request Supplementary International Search
- Other (General correspondence, Power of Attorney, Licensing indications, Applicant comments on 3<sup>rd</sup> party observations, etc.)
- Declarations under Rule 4.17
- Corrections/Rectifications (RO/IB applications only)
- Translations (RO/IB applications only)
- Withdrawals (use of ePCT Actions is recommended for withdrawal of application, designations, and priority claims)

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 10:19 CET

Search by IA Number

PCT/IB2012/030581 


Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	: 	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	: 
International Application Status Report	:   	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service 	: 		

1. Select document type >>
- +  Article 19 Amendments
  - +  Supplementary International Search
  - +  Other
  - +  Declarations under Rule 4.17
  - +  Corrections/Rectifications
  - +  Translations
  - +  Withdrawal under Rule 90bis

Maximum upload limit - 20MB per file

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 15:41 CET
















Search by IA Number

ePCT | eOwnership | Notifications | My History | Portfolios | Workbench | PCT/IB2012/030581 

PCT/IB2012/030581 

Title	:	(EN) MY INVENTION	File Reference	:	Demo-101
International Filing Date	:	02 Aug 2012	Applicant Name	:	Sim, Quan-Ling
Priority Date	:	No Priority Claim	Inventor Name	:	Sim, Quan-Ling
International Publication Date	:		Filing Type	:	E-Filing PDF
International Publication Number	:		Portfolio	:	 TOP_INVENTIONS
IA Status	:	Not yet Published	My Comments	:	
International Application Status Report	:	  	Warning	:	 Priority period expi ...
Processing Team at IB	:	R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>			
Address for Service 	:				

1. Select document type >>

- +  Article 19 Amendments
- +  Supplementary International Search
-  Other
  -  General Correspondence
  -  Fee-related Correspondence
  -  Power of Attorney
  -  Request for Change under Rule 92bis
  -  Request for Change under Rule 92bis (for multiple IAs)
  -  Informal Comments by Applicant on W/O-ISA
  -  Request for indication of availability for licensing purposes
  -  Applicant Comments on Third Party Observation
- +  Declarations under Rule 4.17
- +  Corrections/Rectifications
- +  Translations
- +  Withdrawal under Rule 90bis

Maximum upload limit - 20MB per file

# Actions

- Actions submitted online to the International Bureau
  - Declarations of inventorship
  - Make RO/IB international application available to DAS
  - Observations on close prior art
  - Request to obtain priority document from DAS
  - Rule 92*bis* change request (access rights may be temporarily suspended)
  - Withdrawals (designations, international application, priority claim)


New

# Actions

- New Actions submitted online to the International Bureau
  - Request withdrawal of Chapter II Demand
  - Request withdrawal of election(s)
  - Request indication of availability for licensing purposes to be displayed in PATENSCOPE
- Actions are subject to validation by the International Bureau

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 10:21 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#) 

**PCT/IB2012/030581** 

[File View](#) [Upload Documents](#) [Time Line](#) [Access Rights](#) [History](#) [Actions](#) [Bibliographic Data](#)

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	: 	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	: 
International Application Status Report	:   	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service 	: 		

Select Action

Select the action to submit to the IB

- Select
- Declaration of inventorship
- Licensing Availability Request
- Make international application available to DAS
- Observations on close prior art
- Obtain priority document from DAS
- Rule 92bis change request
- Withdraw Chapter II Demand
- Withdraw Designation(s)
- Withdraw Election(s)
- Withdraw IA
- Withdraw Priority Claim(s)

Current time in Geneva, Switzerland Tuesday, 5 March 2013, 15:44 CET

Search by IA Number  Search

ePCT eOwnership Notifications My History Portfolios Workbench PCT/IB2012/030581

PCT/IB2012/030581

File View Upload Documents Time Line Access Rights History Actions Bibliographic Data

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	:	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	:
International Application Status Report	:	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service	:		

Select Action

Select the action to submit to the IB :

Withdraw IA

Withdrawal Date : 05 Mar 2013

IMPORTANT: The signature of all applicants is required for withdrawals. Check that any required powers of attorney are already on file or attach them below.

Attach File (Optional)

Send Request

Message

Signature of Applicant/Agent

Current time in Geneva, Switzerland Tuesday, 5 March 2013, 15:50 CET

Search by IA Number  Search

ePCT eOwnership Notifications My History Portfolios Workbench PCT/IB2012/030581 X

PCT/IB2012/030581

File View Upload Documents Time Line Access Rights History Actions Bibliographic Data

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	:	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	:
International Application Status Report	:	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service	:		

Select Action

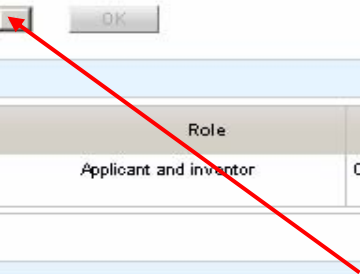
Select the action to submit to the IB :

Select Party

	Name	Address	Role	Nat	Res	Applicable designations	Telephone	Fax	Email Address
<input type="radio"/>	Sim, Quan-Ling	Address 1 City, Ontario xxx xxx (CA)	Applicant and inventor	CA	CA	All	1112223333	1112223333	sim@wipo.int

- Changes (0)
- Attach File (Optional)
- Submit Request

Message



Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 10:38 CET

Search by IA Number

ePCT | eOwnership | Notifications | My History | Portfolios | Workbench | PCT/IB2012/030581  | PCT/IB2012/030284 

PCT/IB2012/030284 

File View | Upload Documents | Time Line | Access Rights | History | Actions | Bibliographic Data

Title	: (EN) ePCT TEST APPLICATION	File Reference	: epct26
International Filing Date	: 11 May 2012	Applicant Name	: EPCT COMPANY (+1)
Priority Date	: 29 Apr 2011	Inventor Name	: DOE, John
International Publication Date	: 	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	: 
IA Status	: <b>Not yet Published</b>	My Comments	: 
International Application Status Report	:  	Warning	: 
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service 	: 		

Select Action

Select the action to submit to the IB :  

Request to obtain priority document from DAS

Date of Request : 05 Mar 2013

Select the Priority Claim(s)

- US 61/123,456 29 Apr 2011 DAS access code \*
- EP 11080030.1 29 May 2011 EP is not a DAS depositing office

Send Request

Signature of Applicant/Agent /|  /  
Should include name

Current time in Geneva, Switzerland Tuesday, 5 March 2013, 15:53 CET

Search by IA Number  Search

ePCT eOwnership Notifications My History Portfolios Workbench PCT/IB2012/030581

PCT/IB2012/030581

File View Upload Documents Time Line Access Rights History Actions Bibliographic Data

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
Priority Date	: No Priority Claim	Inventor Name	: Sim, Quan-Ling
International Publication Date	:	Filing Type	: E-Filing PDF
International Publication Number	:	Portfolio	:  TOP_INVENTIONS
IA Status	: <b>Not yet Published</b>	My Comments	:
International Application Status Report	:	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service	:		

Select Action

Select the action to submit to the IB :

Observations by or on behalf of the Applicant on Closest Prior Art - Add/edit citation

This function allows you to enter references to documents which are considered to be close prior art and, optionally, to comment on how the claims differ from them.

You may submit observations (10 documents maximum per observation) up until 02 Feb 2015.

Please upload copies of the documents to which you refer if you are permitted to do so.

IMPORTANT: Uploaded documents will be made available to Offices and International Authorities only, but not to the public.

Person submitting the observation

You are currently logged in as Paola Conti Lander. You should only submit this observation if you are authorized to do so by the applicant.

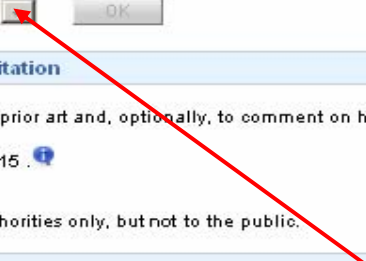
Details concerning the observation

Observation is made in relation to :

The observation is made in :

Add Citation

Types of Citation



# Timeline

New

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

Current time in Geneva, Switzerland Tuesday, 5 March 2013, 15:56 CET

Search by IA Number

ePCT | eOwnership | Notifications | My History | Portfolios | Workbench | PCT/IB2012/030581

PCT/IB2012/030581

File View | Upload Documents | Time Line | Access Rights | History | Actions | Bibliographic Data

Title	: (EN) MY INVENTION	File Reference	: Demo-101
International Filing Date	: 02 Aug 2012	Applicant Name	: Sim, Quan-Ling
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IA Status	: <b>Not yet Published</b>	My Comments	:
International Application Status Report	:	Warning	:  Priority period expi ...
Processing Team at IB	: R&PT Tel. +41 22 338 95 23 e-mail: <a href="mailto:epct@wipo.int">epct@wipo.int</a>		
Address for Service	:		



Timeline of key PCT time limits



Summary of key dates

<b>International Filing Date</b>	02 Aug 2012
<b>Current target date for international publication</b> DISCLAIMER: Please note that this is the expected date of international publication and could still be subject to change	06 Feb 2014
<b>International Search Report/Written Opinion of the ISA expected</b>	02 Dec 2013

# Bibliographic Data

- Up-to-date bibliographic data for the PCT application being viewed
-  ■ Download of bibliographic data in PDF format
-  ■ Preview of bibliographic data in publication front page layout
- Where the language of filing of an international application is Chinese, Japanese, Korean or Russian, bibliographic data is now available in those languages in addition to the English transliteration

Current time in Geneva, Switzerland  Tuesday, 5 March 2013, 10:52 CET

Search by IA Number

[ePCT](#) [eOwnership](#) [Notifications](#) [My History](#) [Portfolios](#) [Workbench](#) [PCT/IB2012/030581](#)  [PCT/IB2012/030284](#) 

**PCT/IB2012/030581** 

[File View](#) [Upload Documents](#) [Time Line](#) [Access Rights](#) [History](#) [Actions](#) [Bibliographic Data](#)

 [Expand/Collapse all](#)

Preview publication front page:



Download bibliographic data: 

Report generated on: 05 Mar 2013 (05.03.2013)

 General Information

International application number:	PCT/IB2012/030581
International Filing Date:	02 Aug 2012 (02.08.2012)
Received at the International Bureau on:	02 Aug 2012 (02.08.2012)
Applicant/agent's file reference:	Demo-101
Language of filing:	English
Filing type:	E-Filing PDF
Processing Team at the IB:	R&PT
Request for indication of availability for licensing purposes received:	No

 International Publication


 Priority claim(s)

 Applicant(s) and Inventor(s)

 Address for Correspondence

 Designations

 Declarations

 Title & Abstract

 International Patent Classification

 International Search

 Supplementary International Search (SIS)

 International Preliminary Examination

 [Expand/Collapse all](#)

# Recent improvements

- ePCT web-based filing
- Online actions:
  - Prepare Chapter II Demand form online and submit to the International Bureau for transmittal to the competent IPEA
  - Real time look-up in DAS feature when requesting the IB to obtain the priority document from DAS
  - Download contents of Workbench and My History data in Excel format



# 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)

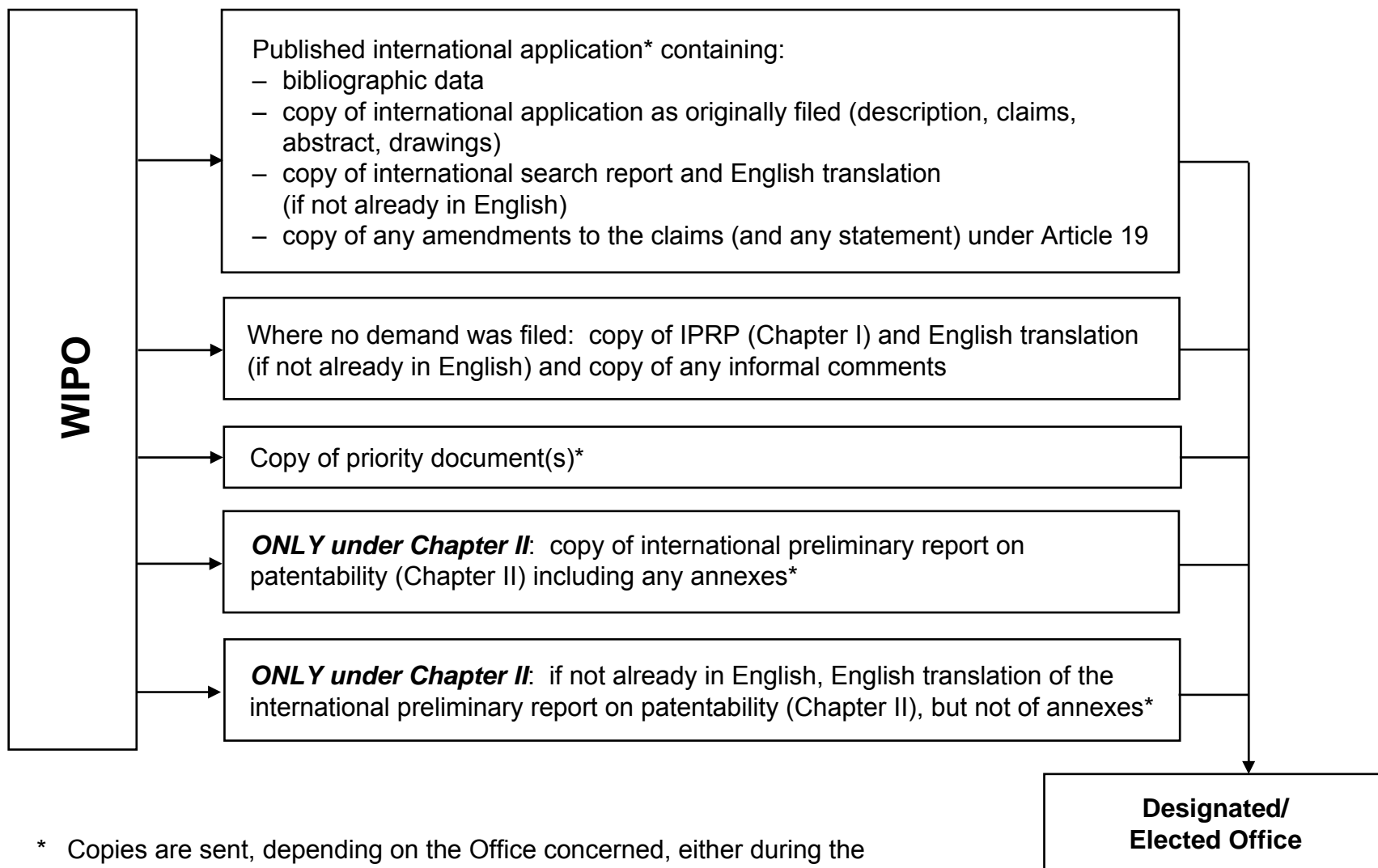
which national Offices

which regional Offices

# Time limit for entry in the national phase

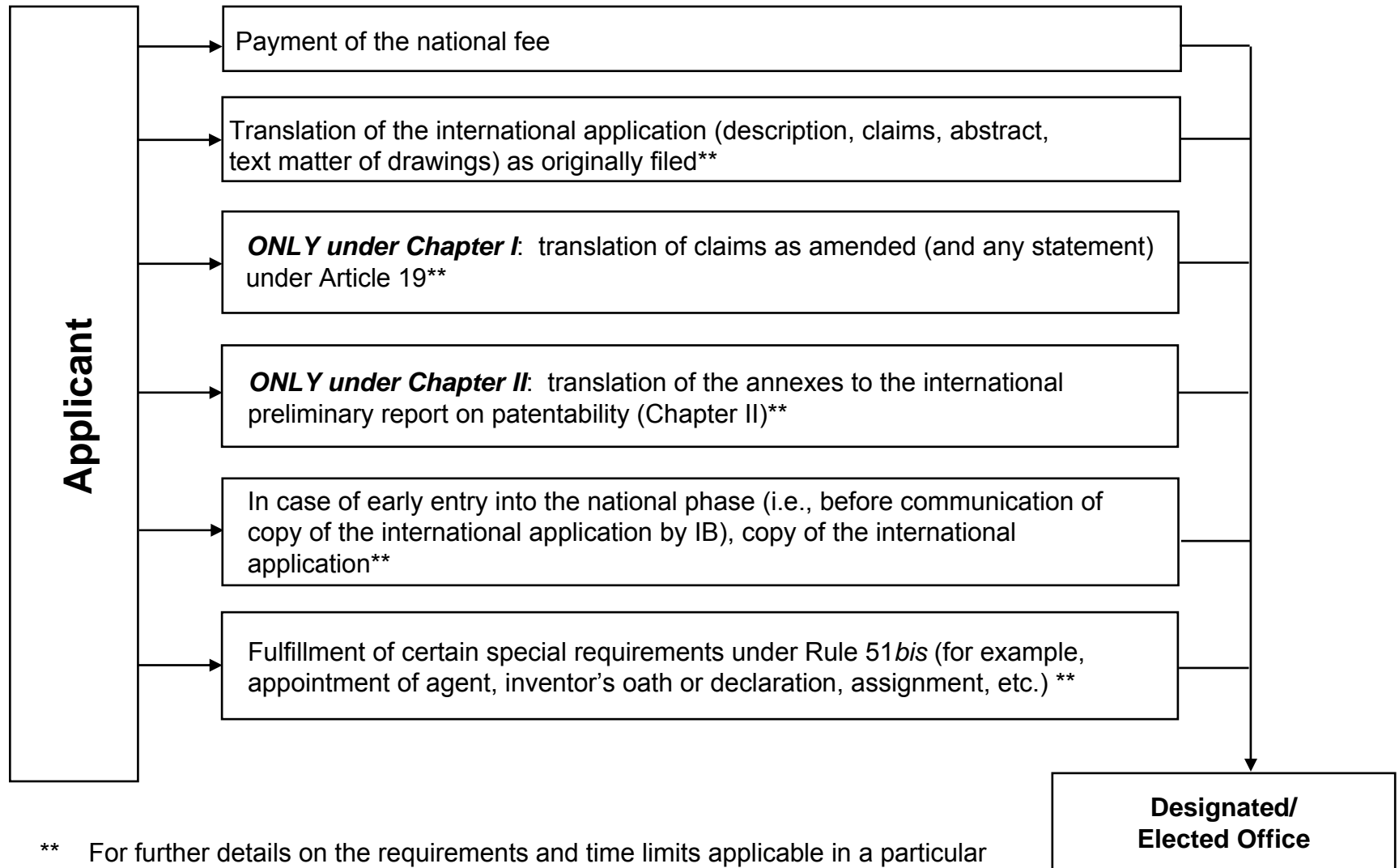
- Article 22(1) and 39(1) time limit **cannot be extended**: might be “postponed” by withdrawing the earliest priority claim ? not recommended, very risky !
- The time limit applies **irrespective** of possible **delays** during the international phase due to:
  - late international search report (ISR) 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)

# Acts to be performed by the **International Bureau**



\* Copies are sent, depending on the Office concerned, either during the international phase or, upon request from the Office to the International Bureau, after the applicant has entered the national phase

# Acts to be performed by the Applicant



\*\* For further details on the requirements and time limits applicable in a particular designated/elected Office, see the relevant national chapter in the *PCT Applicant's Guide*, National Phase

# Basic national requirements upon national phase entry

- **Warning**: No invitation to perform required actions for national phase entry is sent to the applicants prior to the expiration of the applicable time limit
- Actions required for national phase entry:
  - Furnishing a **translation**, if applicable –check language of DO vs. language of filing or publication–
  - Payment of the **national fee**
  - ?** **Copy** of international application in particular circumstances only (not required under normal circumstances)

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

- In addition to the three basic requirements mentioned earlier, **special** national requirements –limited– are allowed:
- Applicable time limit to perform special requirements (Rule 51 *bis*.3):
  - If requirements are not (already) fulfilled within the (main) time limit for national phase entry under Art. 22 or 39:
    - DO shall invite the applicant
    - Provide at least 2 months from the invitation for compliance

# 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

This rule does not apply to DO/EO/ES\*

- 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)

\* See PCT Reservations on [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

# 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

# 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

# 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
<del>JP</del>	<del>Japan*</del>	PL	Poland
KR	Republic of Korea		

- 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

\* Notification withdrawn effective 1 April 2012 (JP)  
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)

# Best practices and ways out to solve issues upon national phase entry (1)

- **! Warning**: Remember to carefully monitor time limit for entering national phase
  - they apply irrespective of delays in the international phase
- Make sure your national phase entry is considered as one and not a direct filing –except if relevant, where applicable– :
  - Eg. US national phase entry which paths is more relevant to you, depending of the specifics of your case, (i) regular national phase entry or (ii) continuation or continuation-in -part application

# Best practices and ways out to solve issues upon national phase entry (2)

- 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 filings)
- Have copies of assignment documents ready for submission, where applicable, some offices do require such copies even in cases where the IB recorded the related changes upon national phase entry (e.g. DO/CN)

# Best practices and ways out to solve issues upon national phase entry (3)

- **! Warning**: Applicants willing to postpone national phase entry by withdrawing earliest priority claim very close to expiration of national phase entry time limit : be extra careful and extra cautious, e.g. ALL signatures must be filed with the notice of withdrawal
- Missing drawing(s) not fixed during international phase: possible way out by filing amendments upon national phase – be careful vis-à-vis original disclosure–
- **! Warning**: PCT application's filing date outside 12-month priority period, but within 2 months from expiration of the priority period: national phase entry time limit is computed on the basis of the date of priority –irrespective of restoration of the right of priority outcome–



# Recent and future developments

# PCT Rule Changes Relating to the America Invents Act (AIA)

- US national law changes, which removed the requirement that the inventor has to be the applicant, had a direct impact on the PCT system
- PCT applications can now be filed in the name of an entity (e.g. corporate applicant, university, NGO) for all States
- Consequently, a statement explaining the lack of signature is no longer required (Rules 4.15(b), 53.8(b) and 90*bis*.5(b) were deleted)
- Rules 51*bis*.1 and 2 were modified accordingly in order to remove references to the national requirement that the inventor be the applicant
- Effective as from 1 January 2013 for applications filed on or after that date

# Recent Developments

- PCT Brief
- Licensing availability
- Third Party Observations
- PATENTSCOPE enhancements
- PCT and PPH

# PCT Brief

- 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 PCT Brief mailing list to be notified about updates
- <http://www.wipo.int/pct/en/brief/index.html>

# 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 request” (see Form PCT/IB/382) directly to the IB (preferably by means of ePCT)
  - 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 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

# Third Party Observations – Role of the IB

- Check 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

# Third Party Observations: Statistics

- Over 200 observations made on 190 international applications so far (currently around one per day)
- Around 70% of the observations are made on international applications filed in English
- Most observations are made on applications filed with
  - RO/US
  - RO/EP
  - RO/JP

# PCT – PPH (1)

- 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 Ch. I or II
- Conditions: at least one claim should have been determined to be patentable and ALL the claims must sufficiently correspond to the claims deemed patentable by the ISA or the IPEA, that is, they are of the same or similar scope or they are narrower in scope than the claims in the PCT application

# PCT - PPH (2)

- In 2012, 38 PCT-PPH pilots were active, with the participation of 21 Offices, including 14 International Authorities
- Participating offices are working on streamlining and simplifying the multitude of co-existing bilateral PPH arrangements, e.g., common requirements, forms, procedures, etc.

# PCT - PPH (3)

International Authority	Office of PCT National Phase Entry												Total
	US	JP	CN	EP	KR	CA	AU	RU	PH	SE	MX	ES	
Japan	427	769	181	196	96				8	5	3	1	1,686
Republic of Korea	964	12	205		49								1,230
European Patent Office	733	203											936
China	194	15			3			1					213
United States of America	129	11	14	25	15		5	9		0		1	209
Australia	104						6						110
Nordic Patent Institute	54	4											58
Canada						57							57
Sweden	41	5								0			46
Russian Federation	10		0									0	10
Austria	9												9
Finland	6	0						0				0	6
Spain	2	2						1			1		6
Israel	1												1
<b>Total</b>	<b>2,674</b>	<b>1,021</b>	<b>400</b>	<b>221</b>	<b>163</b>	<b>57</b>	<b>11</b>	<b>11</b>	<b>8</b>	<b>5</b>	<b>4</b>	<b>2</b>	<b>4,577</b>

Note: US (United States of America), JP (Japan), CN (China), EP (European Patent Office), KR (Republic of Korea), CA (Canada), AU (Australia), RU (Russian Federation), PH (Philippines), SE (Sweden), MX (Mexico), ES (Spain).

Source: WIPO, based on data from the JPO, March 2013

# PCT – PPH (4)

- Bilateral agreements on accelerated national phase processing of PCT applications with positive work products
- 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/cgi/linke.cgi?url=/torikumi\\_e/t\\_torikumi\\_e/patent\\_highway\\_e.htm](http://www.jpo.go.jp/cgi/linke.cgi?url=/torikumi_e/t_torikumi_e/patent_highway_e.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 Assembly – Sept/Oct 2013:

- 1 July 2014 PCT Rule changes: approval of the proposed amendments to the PCT Regulations relating to:
  - Mandatory top-up searches (proposed amendment of Rules 66 and 70);
  - Availability of the written opinion by the ISA as of the date of international publication (proposed deletion of Rule 44*ter* and proposed amendment of Rule 94.1)
  
- Appointed the Ukrainian IP (UA) Office as an ISA/IPEA
  - The appointment will become effective from a future date to be notified by the Office



## Where to Get Help

# 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 IB/RO	Gijsbertus Beijer	+41 22 338 92 22
	Fax	+41 22 910 06 10
PCT e-Services Help Desk	Telephone	+41 22 338 95 23
	Internet address	<a href="http://www.wipo.int/pct-safe">www.wipo.int/pct-safe</a>
	e-mail	<a href="mailto:epct@wipo.int">epct@wipo.int</a>

# 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

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e-mail

[www.wipo.int/ebookshop](http://www.wipo.int/ebookshop)  
[publications.mail@wipo.int](mailto:publications.mail@wipo.int)

WIPO Switchboard

+41 22 338 91 11

PCT Internet Site

Internet address

[www.wipo.int/pct/en/](http://www.wipo.int/pct/en/)

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