



# Best practices in the PCT international phase

## Session 2

# Correction of defects -

# your second chance....

# Correction of defects (1)

## ■ Rule 19.4 cases

- no transfer of fees already paid from RO to RO/IB

## ■ Lack or insufficient payment of fees

- Avoid such situations from the start
- React quickly to Forms PCT/RO/102 and 133

## ■ Incomplete, erroneous or missing priority claim

- Use Form PCT/IB/301 to verify if priority information is correct
- Know your time limits under Rule 26*bis*
- Rule 91 can be used in some cases

# Correction of defects (2)

- Formal defects (Rules 11 and 26)
  - React to invitations to correct (Form PCT/RO/106)
  - Time limit is extendable
  - You can correct without being invited

# Correction of defects (3)

- Incorporation by reference
  - Only if missing part or element fully contained in earlier application
  - Priority claim cannot be added for this purpose
  - Invitation from RO can extend the 2-month time limit from filing
  - Diverging practices where an incorrect set of claims and/or description have been filed

# Correction of defects (4)

- Restoration of the priority right
  - ❑ Do it now or later?
  - ❑ Respect time limit to furnish statement of reasons
  - ❑ Priority claim can be added for this purpose
  - ❑ Solid explanation required for due care (see also paragraphs 166A-P of ROGLs)

# Correction of defects (5)

- Final review: before designated Offices (Articles 24(2), 25, 26, 39(3) and 48, Rules 82*bis* and 82*ter*)
  - Time limits apply
  - Resolution depends on national law

# Other procedural issues...



# Time limits under the PCT

- How time limits are calculated
- How to deal with lack of signatures
  - File response anyway
  - Careful in the case of withdrawals
- Extension of time limits
  - Rule 26
  - Rules 80.5, 80.6, 82 and 82*quater*

# Requests for recording of changes

- 92bis requests should always be filed with IB
- Copies of assignment documents and/or powers of attorney required in some cases
- Submit request without signatures and/or proof or evidence to meet the time limit
- Check any Form PCT/IB/306 received for correctness

# International Publication

## ■ Publication

- Verify correctness and completeness of publication
- Preventing or postponing international publication
- Lack of payment of fees

# Withdrawals (1)

- Always file with IB

- Exception: withdrawals before record copy has been transmitted: file with RO

- How?

- use “ePCT action”

- or at least ePCT upload Form PCT/IB/372

- Safeguard: Use conditional language if anywhere near international publication

# Withdrawals (2)

## ■ Signatures

- All applicants signatures are required
- Submit without signatures to meet time limit?
  - will not work for 30-month time limit
  - Will, however, at least postpone publication

# Amendments under Article 19

- When they could be useful:
  - To correct errors in claims
  - To modify claims to address competitors' products
  - If ISR convincingly shows that your claims are clearly anticipated
  - Provisional protection?

# Chapter II procedure

## ■ Filing of demand

- Correctly identify application to which demand relates

- What to submit together with demand:

- Copy of Article 19 amendments
- Article 34 amendments/arguments
- Express request for an oral interview

- Lack of payment of fees

# PCT Resources/Information

**For general questions about the PCT, contact the PCT Information Service at:**

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