

Advanced Seminar on the Patent Cooperation Treaty (PCT)



Best practices during the international phase

WIPO Headquarters, Geneva

Mr. Matthias Reischle-Park
Deputy Director
PCT Legal and User Relations Division

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Preparing to file (1)

■ Decision-making process

- Leave enough time before end of priority period
- Have a clear decision-making structure in place
- Paris or PCT?
- Avoid last-day and even more so last-minute filings

■ State-of-the-art docketing system in place

- Two independent systems
- Second pair of eyes review

■ Review need for any foreign filing licenses

Preparing to file (2)

■ Choice of RO?

- What choices are available?
- Reasons not to use your home Office
- Advantages/disadvantages in using RO/IB
- Right to file with RO of choice

■ Know your RO

- filing methods available
- payment methods
- closing dates
- languages accepted

Preparing to file (3)

■ Choice of ISA?

- Whether and what choices you have depends on RO
- What choices would you have if you use RO/IB?
- If you have a choice, which factors to consider?
 - Search fee amount
 - Timeliness
 - Effect on national/regional phase
 - Quality of reports
 - PCT-PPH benefits
 - Excluded subject matter
 - Languages searched
 - National phase fee reductions

Preparing to file (4)

- Right to file

- Assignments need to have been made before filing

- Right to claim priority at the international filing date

- Assignments need to have been made before filing

- Assignment to a non-Paris applicant?

- Accession number for deposited biological material

Preparing to file (5)

- Choice of filing method: electronic beats paper
 - ❑ Use ePCT filing or similar web-based systems if you can
 - ❑ Give all your electronic files clear and distinctive names
 - ❑ Double-check that the correct files have been attached
 - ❑ Check for possible conversion errors
 - ❑ Always submit pre-converted files if accepted by RO
 - ❑ Electronic signature requirements

Preparing to file (6)

■ Preparing the request form:

□ Naming of the applicants:

- Always include one applicant who has the right to file an international application
- Check correct spelling of names
- Addresses of inventor/applicants

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

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

Preparing to file (7)

■ Preparing the request form (cont.):

- Correctly indicate all priority claims

- Only add sequence listings prepared in accordance with ST.26

- Make use of PCT declarations

■ If you are about to miss the priority period

- Always have a plan B ready

- Ways to extend the priority period

- Request restoration of the priority right

After filing (1)

- Once filed, view what you have submitted, on the date of submission, through electronic file access systems, if available
- If a mistake as been made:
 - Same day corrections
 - Incorporation by reference
 - Not a perfect solution because of notices of incompatibility

After filing (2)

- Monitor receipt of Forms PCT/RO/105 and PCT/IB/301
- Priority documents
 - Best way: ask RO to prepare and transmit in request form
 - If not possible, use DAS
 - If not possible: order paper document

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 or correct 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

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

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

- Generate a “preview” of the international publication in ePCT and check for correctness
- Or at least, verify correctness and completeness after 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

PCT Resources/Information

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

Telephone: (+41-22) 338 83 38

E-mail: pct.infoline@wipo.int

- Contact the speaker:

Matthias.Reischle@wipo.int

+41-22-338-9627

Thank you!

