

**Seminar on the Patent Cooperation Treaty (PCT)  
for Patent Administrators and Paralegals**

**The System for Worldwide Filing of Patent Applications**

**Geneva, October 17 and 18, 2011**

*Document prepared by the International Bureau*

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## PREFACE

This document has been prepared by the International Bureau of the World Intellectual Property Organization (WIPO), Geneva, Switzerland, as a support material for seminars on the Patent Cooperation Treaty (PCT).

The following words and expressions used throughout the document should be understood as follows:

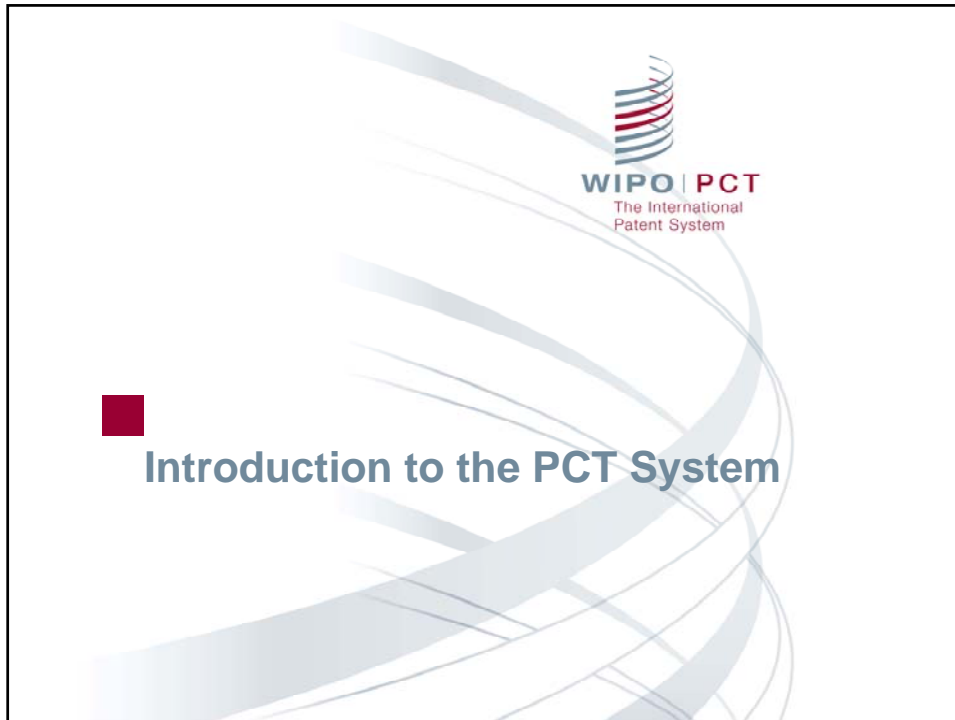
Administrative Instructions	–	the Administrative Instructions under the PCT
Article	–	an Article of the PCT
Chapter I	–	Chapter I of the PCT
Chapter II	–	Chapter II of the PCT
Contracting State	–	a State party to the PCT
Regulations	–	the Regulations under the PCT
Rule	–	a Rule of the Regulations under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

References to “national” Office or national fees, national phase, national processing, etc., should be understood to include “regional” Office (e.g., the EPO), etc.

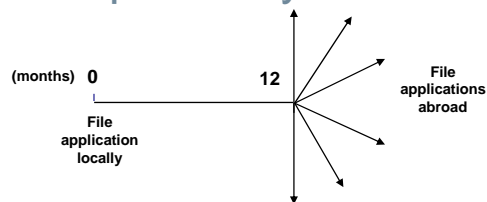
The following abbreviations should be understood as meaning:

ARIPO	–	African Regional Intellectual Property Organization
DO	–	Designated Office
EAPC	–	Eurasian Patent Convention
EAPO	–	Eurasian Patent Office
EO	–	Elected Office
EPC	–	European Patent Convention
EPO	–	European Patent Office/European Patent Organisation
Euro-PCT	–	a Euro-PCT application is an international application containing the designation “EP” irrespective of the receiving Office with which it was filed
IB	–	International Bureau (of the World Intellectual Property Organization)
IPE	–	International Preliminary Examination
IPEA	–	International Preliminary Examining Authority
IPRP (Chapter I)	–	International Preliminary Report on Patentability (Chapter I of the PCT)
IPRP (Chapter II)	–	International Preliminary Report on Patentability (Chapter II of the PCT)
ISA	–	International Searching Authority
ISR	–	International Search Report
OAPI	–	African Intellectual Property Organization
RO	–	Receiving Office
SIS	–	Supplementary International Search
SISA	–	Supplementary International Searching Authority
SISR	–	Supplementary International Search Report
WIPO	–	World Intellectual Property Organization
WO of ISA	–	Written Opinion of the International Searching Authority
WTO	–	World Trade Organization

This document is based on the requirements of the Patent Cooperation Treaty (PCT), the Regulations and the Administrative Instructions under the PCT. In case of any discrepancy between this document and those requirements, the latter are applicable.



## Traditional patent systems



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

## PCT system

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

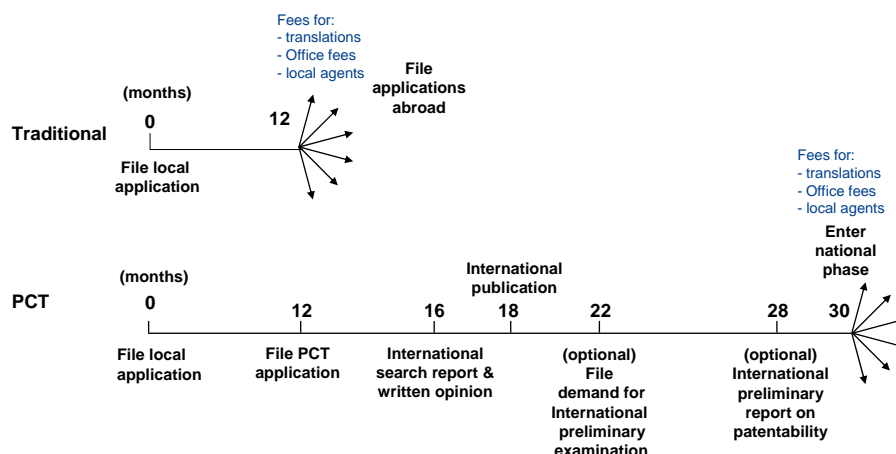
- one set of formality requirements
- international search
- international publication
- international preliminary examination
- international application can be put in order before national phase
- translations and national fees required at 30 months\*, and only if applicant wishes to proceed

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

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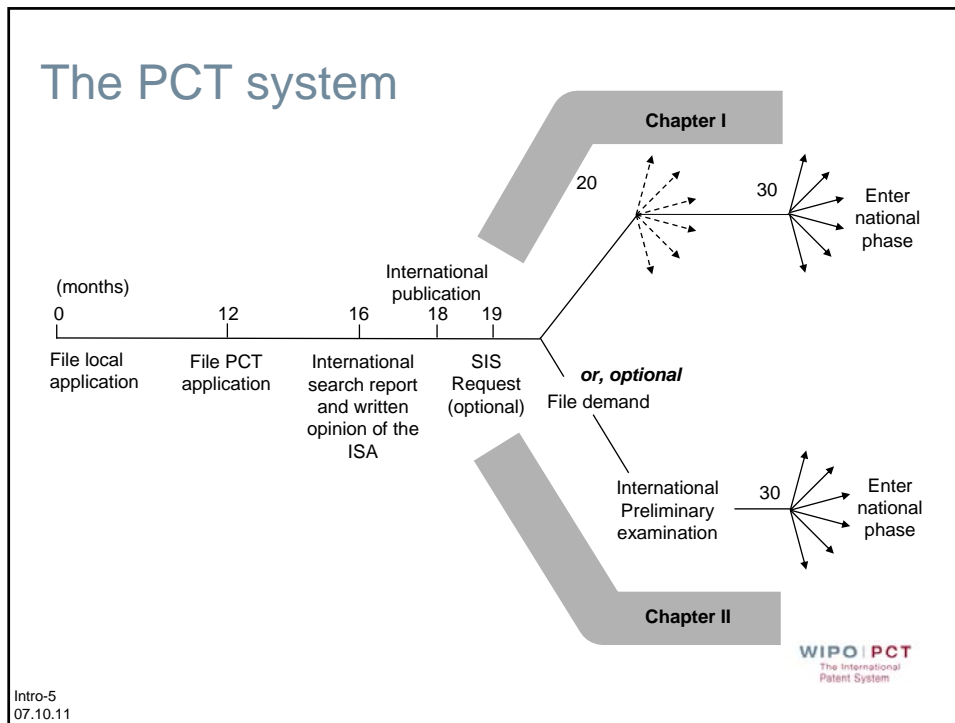
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## Traditional patent system vs. PCT system



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## General remarks on the PCT system (1)

- The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT patent”.
- The PCT system provides for
  - an international phase comprising:
    - filing of the international application
    - international search and written opinion of the ISA
    - international publication and
    - international preliminary examination
  - a national/regional phase before designated Offices
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase.

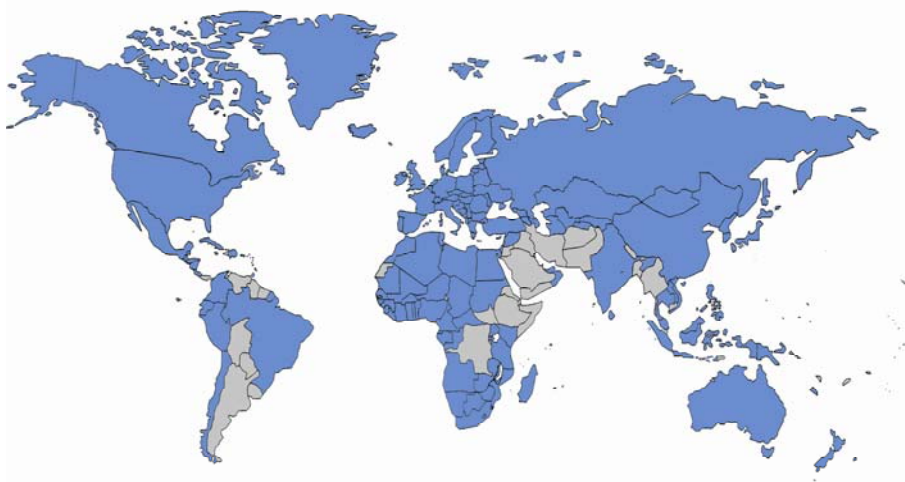
## General remarks on the PCT system (2)

- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles.
- Design and trademark protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively).
- The PCT is administered by WIPO as are other international treaties in the field of industrial property, such as the Paris Convention.

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## PCT Contracting States (144)



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## PCT Contracting States (144)

*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  
MD Republic of Moldova  
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

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

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## PCT Contracting States (144) (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

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## PCT Contracting States (144) (continued)

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

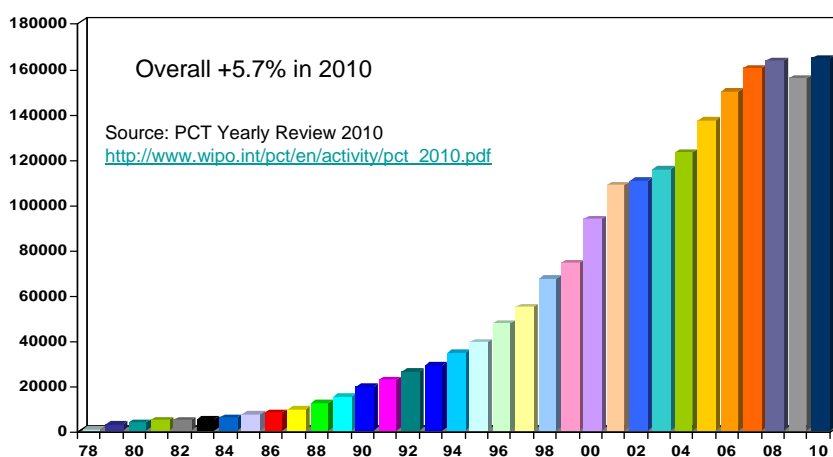
AE United Arab Emirates	HN Honduras	NZ New Zealand
AG Antigua and Barbuda	ID Indonesia	OM Oman
AO Angola	IL Israel	PE Peru
AU Australia	IN India	PG Papua New Guinea
* BA Bosnia and Herzegovina	JP Japan	PH Philippines
BB Barbados	KM Union of the Comoros	QA Qatar
BH Bahrain	KN Saint Kitts and Nevis	SC Seychelles
BR Brazil	KP Democratic People's Republic of Korea	SG Singapore
BZ Belize	KR Republic of Korea	ST Sao Tome and Principe
CA Canada	LA Lao People's Democratic Republic	SV El Salvador
CL Chile	LC Saint Lucia	SY Syrian Arab Republic
CN China	LK Sri Lanka	TH Thailand
CO Colombia	LY Libya	TN Tunisia
CR Costa Rica	MA Morocco	TT Trinidad and Tobago
CU Cuba	* ME Montenegro	UA Ukraine
DM Dominica	MG Madagascar	US United States of America
DO Dominican Republic	MN Mongolia	UZ Uzbekistan
DZ Algeria	MX Mexico	VC Saint Vincent and the Grenadines
EC Ecuador	MY Malaysia	VN Viet Nam
EG Egypt	NG Nigeria	ZA South Africa
GD Grenada	NI Nicaragua	
GE Georgia		
GT Guatemala		

\* Extension of European patent possible

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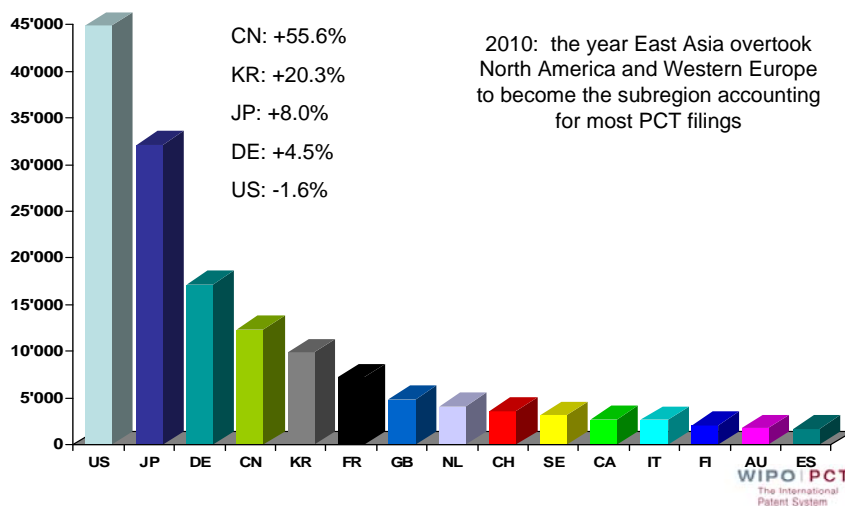
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## International applications received in 2010 by country of origin



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## Top PCT Applicants 2010

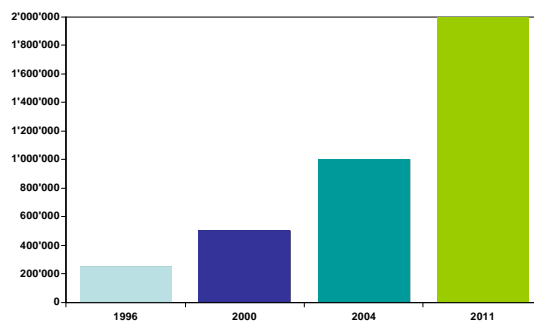
- |                             |                                  |
|-----------------------------|----------------------------------|
| 1. Panasonic—JP (2154)      | 11. Toyota—JP (1095)             |
| 2. ZTE—CN (1868)            | 12. Siemens—DE (833)             |
| 3. Qualcomm—US (1677)       | 13. BASF—DE (818)                |
| 4. Huawei—CN (1528)         | 14. Mitsubishi Electric—JP (726) |
| 5. Philips—NL (1435)        | 15. Nokia—FI (632)               |
| 6. Bosch—DE (1301)          | 16. 3M—US (586)                  |
| 7. LG Electronics—KR (1298) | 17. Samsung Electronics—KR (578) |
| 8. Sharp—JP (1286)          | 18. HP—US (564)                  |
| 9. Ericsson—SE (1149)       | 19. Fujitsu—JP (476)             |
| 10. NEC—JP (1106)           | 20. Microsoft—US (469)           |

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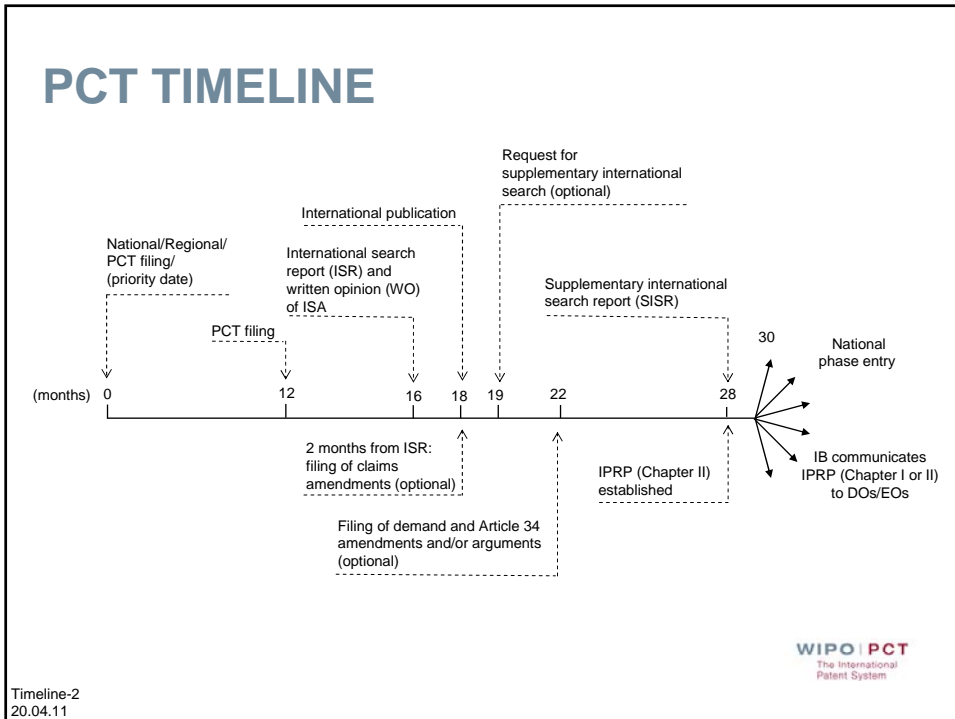
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## 2 millionth PCT application

- Qualcomm files landmark application (April 2011)
  - [http://www.wipo.int/pressroom/en/articles/2011/article\\_0013.html](http://www.wipo.int/pressroom/en/articles/2011/article_0013.html)



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## 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

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## Elements making up the international application

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

## Elements which may accompany the international application

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

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## The request

- Printed request form (Form PCT/RO/101)
  - periodically updated
  - available on Internet (<http://www.wipo.int/pct/en/forms>)
  - may be obtained free of charge from the receiving Office or the International Bureau
- Computer-generated request (Rules 3.1 and 3.4, Section 102(h))
  - layout and contents must correspond to those of the printed form (no boxes may be omitted)
  - slight adjustments are permitted
  - any text printed in italics may be omitted
- PCT-SAFE (EASY mode) request (Rule 89*ter* and Section 102*bis*)
- Electronic filing of the international application in accordance with Part 7 and Annex F of the Administrative Instructions with ROs which accept the filing of international applications in electronic form

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## Concept and operation of designation system (Rule 4.9)

- Automatic and all-inclusive designation of all PCT Contracting States
  - exceptions to the all-inclusive designation possible for DE, JP and KR (countries with particular rules on “self-designation”)
    - but only if the international application contains a priority claim to an earlier application filed in the State that is to be excluded
  - otherwise withdrawals of designations possible
- Choice of types of protection postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- “Parent” information (continuation applications, patents of addition) may be included in PCT request form for search purposes

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20.04.11

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

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

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

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

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

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## Signature of the request (2) (Rules 4.15, 26.2*bis*(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

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## 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

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## Signature of the request (4) (Rules 4.15, 26.2bis(a))

- Where the US is designated and an inventor/applicant for the US refuses to sign the request or a power of attorney, or cannot be found or reached after diligent effort, that inventor/applicant need not sign the request or a power of attorney if:
  - a statement is furnished explaining, to the satisfaction of the receiving Office, the lack of signature; and
  - the request or power of attorney is signed by at least one other applicant

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

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

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

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

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

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## Headings of the parts of the description (Rule 5 and Section 204 of the Administrative Instructions)

- Technical Field
- Background Art
- Disclosure of Invention *or* Summary of Invention
- Brief Description of Drawings
- Best Mode for Carrying Out the Invention *or, where appropriate, Mode(s) for Carrying Out the Invention*
- Industrial Applicability
- Sequence Listing
- Sequence Listing Free Text

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## 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 except
  - evidence concerning non-prejudicial disclosures or exceptions to lack of novelty
  - for Offices which made a reservation, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html) and the relevant Summaries in the national chapters of the *PCT Applicant's Guide*, National Phase

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

- All inventors need to be named in the same declaration
- Declaration must be signed and dated by all inventors (named as applicants)
- 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
- Only necessary to include prior applications filed in or for a country other than US, having a filing date earlier than the earliest priority date claimed in the PCT application

## Addition/correction of declarations (Rule 26ter)

- Applicants may correct or add any of the declarations filed under Rule 4.17
- Time limit: until the expiration of 16 months from the priority date (or even later, provided that the declaration is received by the International Bureau before the technical preparations for international publication have been completed)
- The receiving Office or International Bureau may invite the applicant to correct any declaration that is not worded as required or, in the case of the declaration of inventorship (Rule 4.17(iv)), is not signed as required

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## Publication of declarations

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

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## Declarations 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



## Fees payable to the receiving Office (RO)

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

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

## Fees payable to the International Searching Authority (ISA)

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

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

## Fees payable to the International Bureau (IB)

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

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

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

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

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

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## Fees not payable during international phase

Under the PCT, there is:

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

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## 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))

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## Time limits for payment of fees (2)

### ■ Chapter II:

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

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## Safeguards in respect of payment of fees

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

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

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

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

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

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

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## Refund of fees by the receiving Office (Rules 15.6 and 16.2)

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

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19.04.11

## Refund of fees by the IPEA

- Handling fee: full refund (Rule 57.6)
  - if demand withdrawn before having been sent by the IPEA to the IB
  - if demand considered, under Rule 54.4, not to have been submitted
- Preliminary examination fee: refund of up to 100%, depending on circumstances and IPEA
  - where demand considered as if it had not been submitted (Rule 58.3)
  - where demand withdrawn before start of international preliminary examination (Agreement between IPEA and IB of WIPO); see the *PCT Applicant's Guide*, International Phase, International Preliminary Examining Authorities (Annex E) for details

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## Warning – fraudulent requests for payment of registration fees

- PCT applicants and agents are receiving invitations to pay fees that do not come from the IB and are unrelated to the processing of international applications under the PCT
- Whatever registration services might be offered in such invitations, they bear no connection to WIPO or to any of its official publications
- The services offered do not give applicants any added value, since they are provided by the IB for no additional charge ([www.wipo.int/pctdb](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)

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## Priority Claims

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

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

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

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

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

## 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) (1)

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

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

### ■ Earlier international application:

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

## Furnishing of priority documents (1) (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)
  - within 16 months from the (earliest) priority date claimed
  - by furnishing such document directly to the receiving Office or the International Bureau (Rule 17.1(a))
  - or, but only if the earlier application was itself filed with the concerned Office acting as receiving Office, by requesting that receiving Office to prepare such document and transmit it to the International Bureau (Rule 17.1(b))
  - or, for earlier applications filed with a receiving Office participating in the Priority Document Access Service (DAS), by requesting receiving Office or the International Bureau to obtain the priority document from a digital library (Rule 17.1(b-bis))

## Furnishing of priority documents (2) (Rule 17.1)

- Where the priority document is received by the International Bureau after the expiration of the 16-month time limit but before international publication, it will be considered to have been received on the last day of the 16-month time limit (Rule 17.1(a))
- Where the priority document is not furnished within the 16-month time limit, designated Offices may not disregard the priority claim without first giving the applicant an opportunity to furnish the priority document within a reasonable time limit (Rule 17.1(c))

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## 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

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

### ■ Cases concerned:

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

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

### ■ Applicable time limit:

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

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

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

### ■ Cases concerned:

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

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

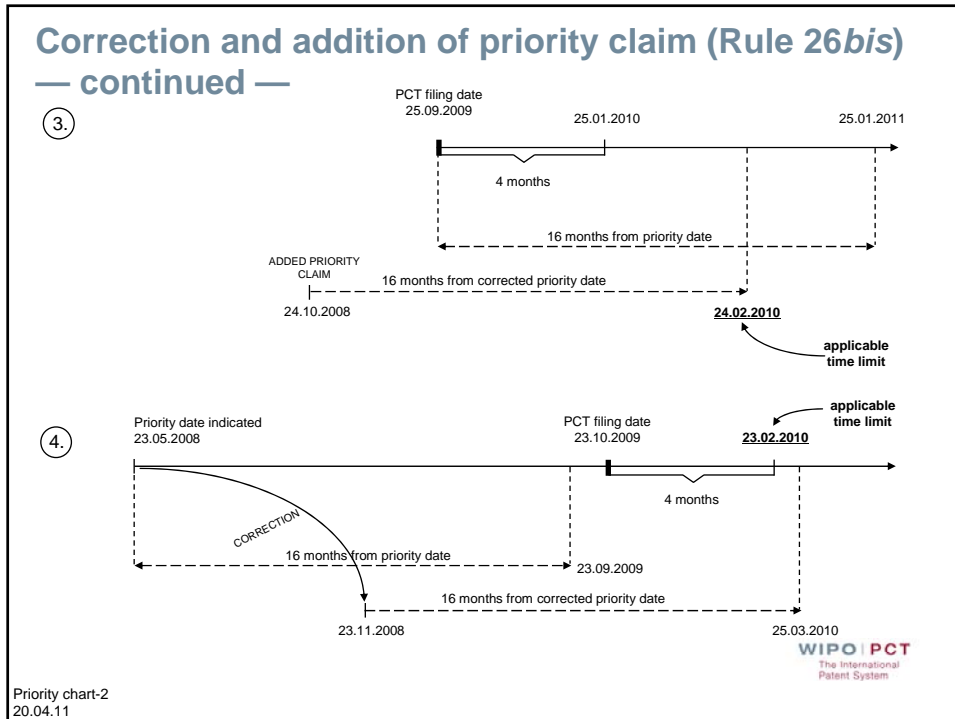
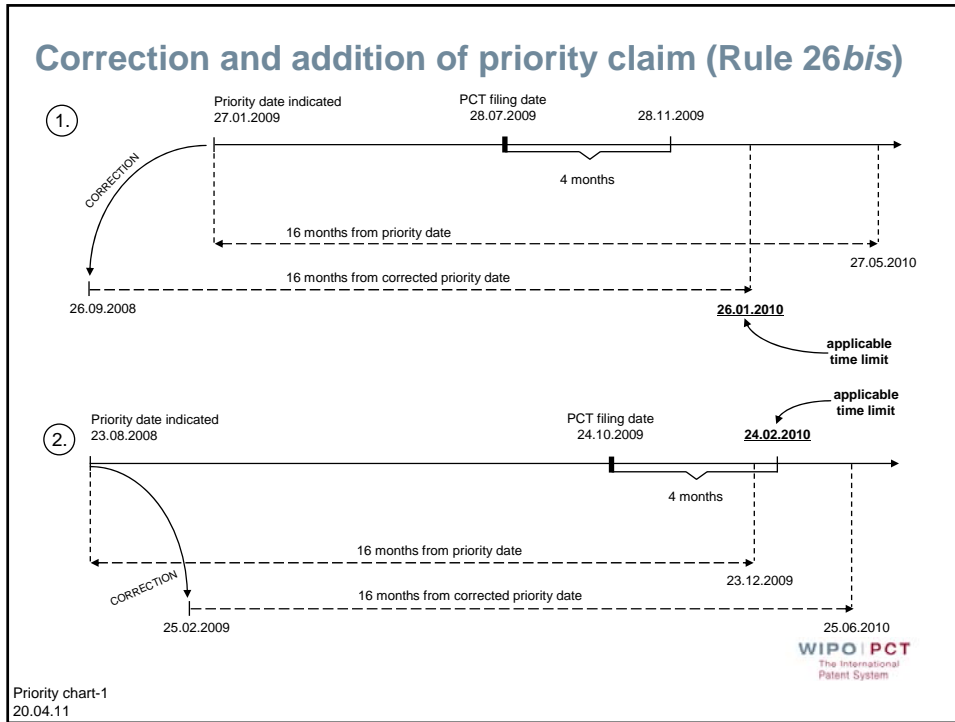
### ■ Applicable time limit:

#### Rule 26bis.1(a):

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

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

- Rule 91: within 26 months from the priority date



## Invitation to correct by RO or IB (1)

### ■ Forms:

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

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

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

## Invitation to correct by RO or IB (2)

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

## Invitation to correct by RO or IB (3)

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

## Invitation to correct by RO or IB (4)

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

## Publication related to priority claims (1)

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

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

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

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## Publication related to priority claims (2)

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

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

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

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## Restoration of the right of priority Competent authorities

### ■ Competent Authorities:

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

## Restoration of the right of priority Applicable criteria

### ■ Applicable Rules: 26*bis*.3(a) and 49*ter*.2(a)

### ■ Two possible criteria for restoration:

- failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
  
- failure to file the application within the priority period was unintentional

### ■ All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law

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

### ■ Conditions:

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

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

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

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

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

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## Reservations made by Offices

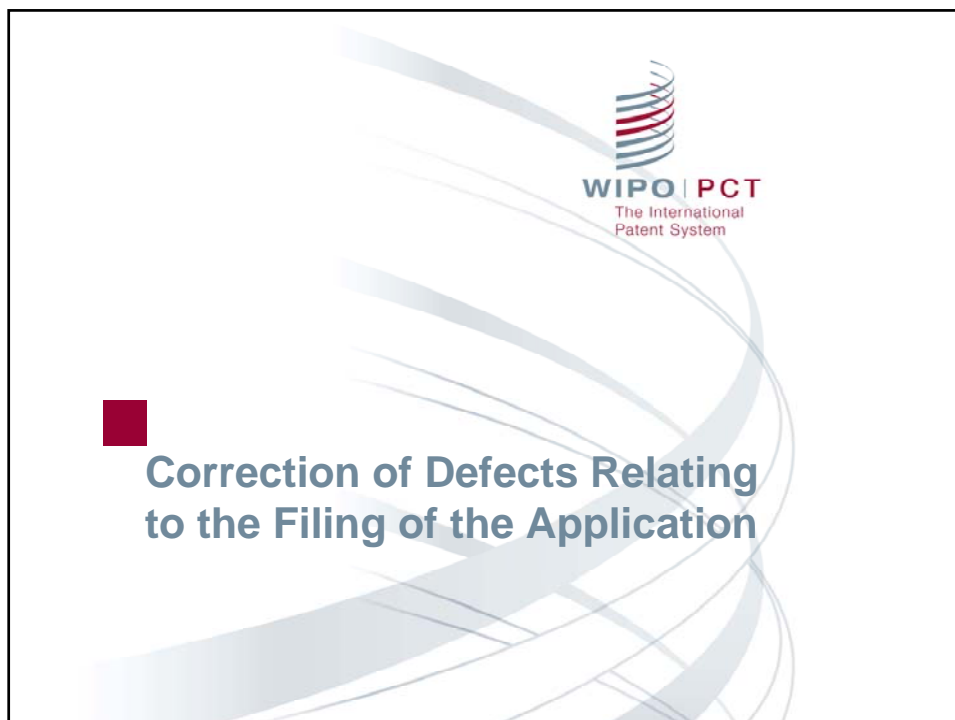
The following Offices have notified the International Bureau of the incompatibility of Rule 26bis.3(a) to (i), Rule 49ter.1(a) to (d) and/or Rule 49ter.2(a) to (g) with their national/regional law:

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

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29.08.11

\* Reservation withdrawn with effect from 21 December 2010



## Defects which can be corrected without affecting 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 26.3ter)
- Incomplete, erroneous or missing priority claim (Rule 26bis)

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

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

## 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)

- Objective: Enable inclusion of accidentally omitted elements or parts that are contained in a priority application without affecting the international filing date
  - element = all of the description or all of the claims
  - part = part of the description, part of claims or part or all of pages of drawings

## Missing elements and parts of the international application (Rule 20) (2)

- Conditions:
  - priority must have been claimed on the original filing date (Rule 4.18)
  - priority application contains the element or part (Rule 20.6(b))
  - request contains statement of (conditional) incorporation by reference (Rule 4.18)
  - timely confirmation of incorporation by reference (Rules 20.6 and 20.7)
- Competent Authority: RO

## Confirmation of incorporation by reference (Rules 20.6 and 20.7) (1)

- Time limit: two months from filing or from invitation to correct (Rule 20.7)
- Documents to be filed (Rule 20.6):
  - notice of confirmation
  - missing sheets
  - copy of the earlier application as filed unless the priority document already submitted
  - translation if not in the language of the international application
  - indication as to where in the priority document (and translation) the missing parts are contained

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## Confirmation of incorporation by reference (Rules 20.6 and 20.7) (2)

- If not all requirements for incorporation by reference are fulfilled  
(for example, if a missing element or part is not entirely contained in the earlier application):
  - the international application is assigned a later filing date (date of receipt of missing element or part),
  - applicant may request that missing part be disregarded (Rule 20.5(e))

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

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

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

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

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

Incompatibility as DO (Rule 20.8(b)):

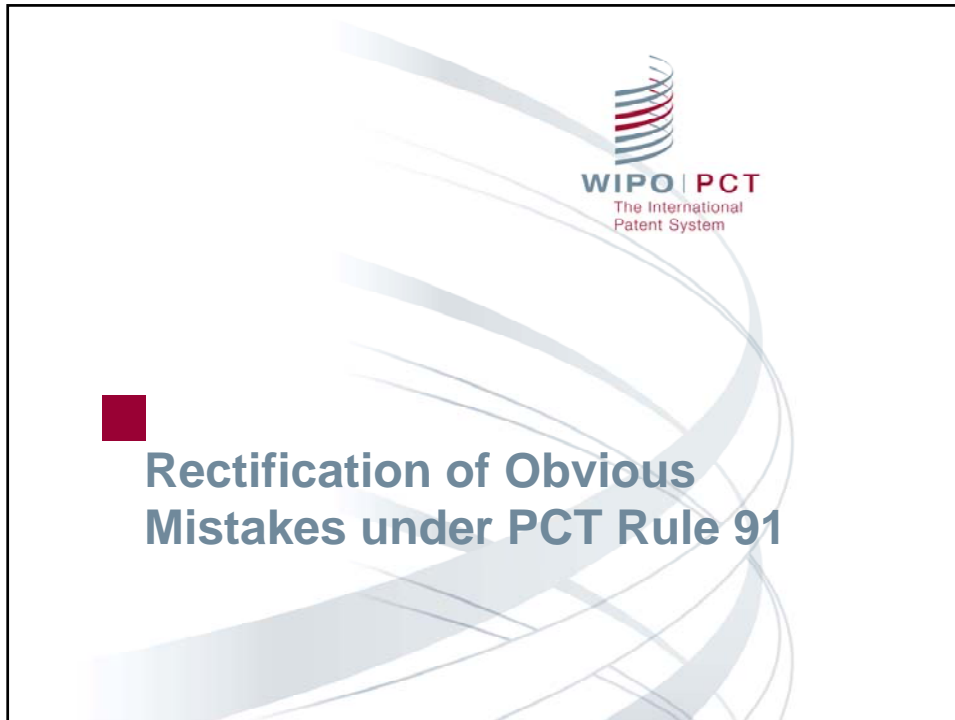
CN, CU, CZ, DE, ES\*, HU\*\*, ID, JP, KR, LT, MX, PH,TR

\* Reservation withdrawn with effect from 1 October 2010

\*\* Reservation withdrawn with effect from 28 February 2011

Defects-11  
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## 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

Obvious  
Mistakes-3  
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## 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))

Obvious  
Mistakes-4  
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## 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))

Obvious  
Mistakes-5  
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## 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

Obvious  
Mistakes-6  
27.04.11

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## 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*)

Obvious  
Mistakes-7  
27.04.11

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## 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

Obvious  
Mistakes-8  
27.04.11

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## Additional correction procedures

Review by and opportunity to correct before the designated/elected Offices:

(Articles 24(2), 25, 26, 39(3) and 48, Rules 82*bis* and 82*ter*)



## 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 requests and collects fees for supplementary international search (SIS) Reviews requests for SIS and transmits them to the ISA concerned
- Performs second formalities review of demands

## Responsibilities related to international applications (3)

- Communicates international preliminary reports on patentability (Chapter I) to designated Offices and international preliminary reports on patentability (Chapter II) to elected Offices
- Translates titles and abstracts (into English and French), international search reports (into English, if necessary) and international preliminary reports on patentability (Chapter I or II) (into English, if necessary)



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

### ■ When?

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

## Communication of published international applications (Article 20 and Rule 47)

- Paper copies of published international applications are only sent to the applicant upon specific request
- Communicated to DOs by IB
- Notice of communication of the international application sent by IB to DOs serves as conclusive evidence of receipt of the application by DOs (Rule 47.1(c-bis), Form PCT/IB/308 (First Notice) for DOs which do not yet apply modified Article 22(1) and Form PCT/IB/308 (Second and Supplementary Notice) for all other DOs)

## 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

## Form of publication

- Published international applications are available at [www.wipo.int/patentscope/search/en/structuredSearch.jsf](http://www.wipo.int/patentscope/search/en/structuredSearch.jsf)
- Official notices (PCT Gazette) are available at [www.wipo.int/pct/en/official\\_notices/index.htm](http://www.wipo.int/pct/en/official_notices/index.htm)

## Frequency of international publication

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

## Technical preparations for international publication

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

For example: if the publication date is: Thursday, 27 January 2011, technical preparations are completed on Wednesday, 12 January 2011.

Consequently, any document that reaches the International Bureau on Tuesday, 11 January 2011, is still taken into account for international publication (for example, change of name or address, amendment of the claims under Article 19, withdrawal of the international application or of a designation or of a priority claim).

- Technical preparations may be completed more than 15 days before the publication date where that publication date is not the “usual” Thursday because the International Bureau is not open for business or where there are a number of official holidays falling within that 15-day period. If in doubt, inquire at the International Bureau as to what will be the date of completion of technical preparations.

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Publn-9  
29.08.11

## Effects of international publication

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

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

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

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

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

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

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

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29.08.11

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

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

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## 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

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IB-RO-3  
21.04.11

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

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

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IB-RO-4  
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## Transmittal of international applications to RO/IB (Rule 19.4) (2)

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

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IB-RO-5  
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## Transmittal of international applications to RO/IB (Rule 19.4) (3)

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

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

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

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

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

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

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## 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*
  - 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.

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

- 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)

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## 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

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IB-RO-11  
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## Invitation to furnish required translation (Rule 12.3(c) and (e))

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

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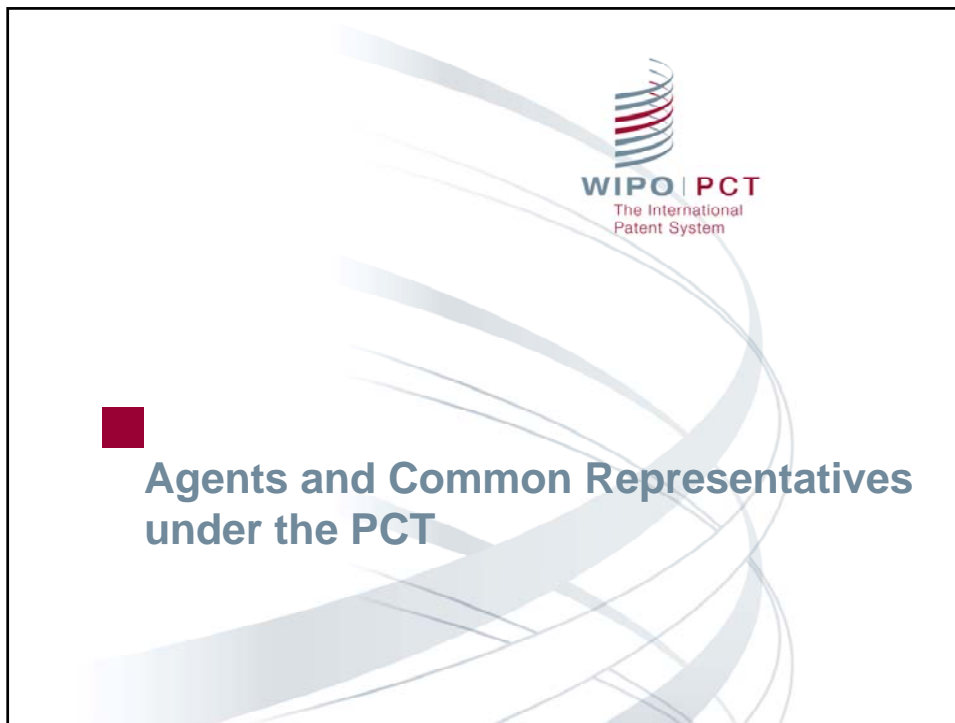
IB-RO-12  
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## Failure to furnish translation and/or pay late furnishing fee (Rule 12.3(d))

- Where the applicant has not, within the applicable time limit, furnished the required translation and/or paid, where applicable, the late furnishing fee, the international application will be considered withdrawn and RO/IB will so declare
- Any translation and any payment received by RO/IB
  - before RO/IB makes the declaration that the international application is considered withdrawn and
  - before the expiration of 15 months from the priority date

is considered to have been received before the expiration of the applicable time limit (that is, one month from the date of the invitation or two months from the date of receipt of the international application, whichever expires later)

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## 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.

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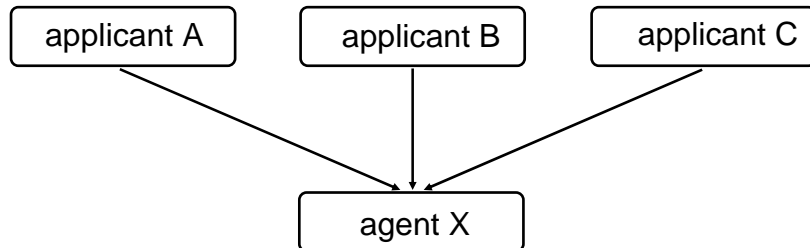
## Waiver of requirement that a power of attorney be furnished (Rules 90.4(d) and 90.5(c))

- 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)

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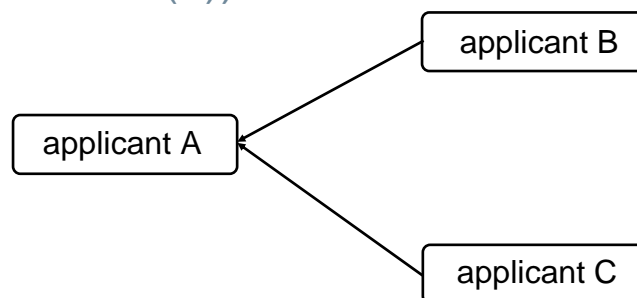
Agents-6  
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## Common agent



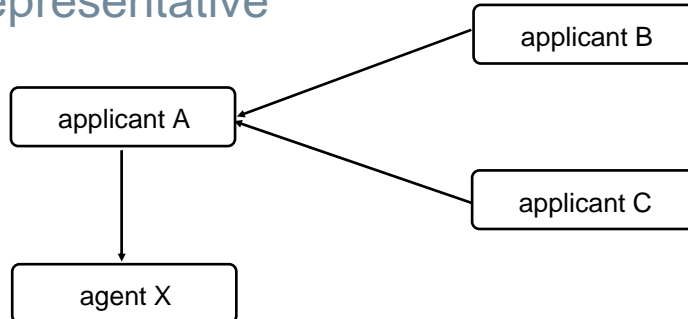
Agent X is a common agent if he has been appointed by all applicants

## Appointed common representative (Rule 90.2(a))



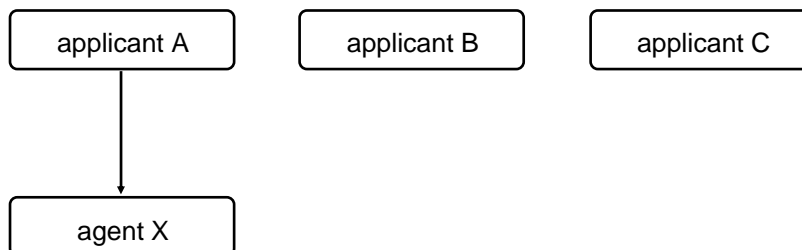
- Applicants B and C appoint applicant A as their common representative.
- A may be so appointed only if national or resident of a PCT Contracting State.

## Agent of the appointed common representative

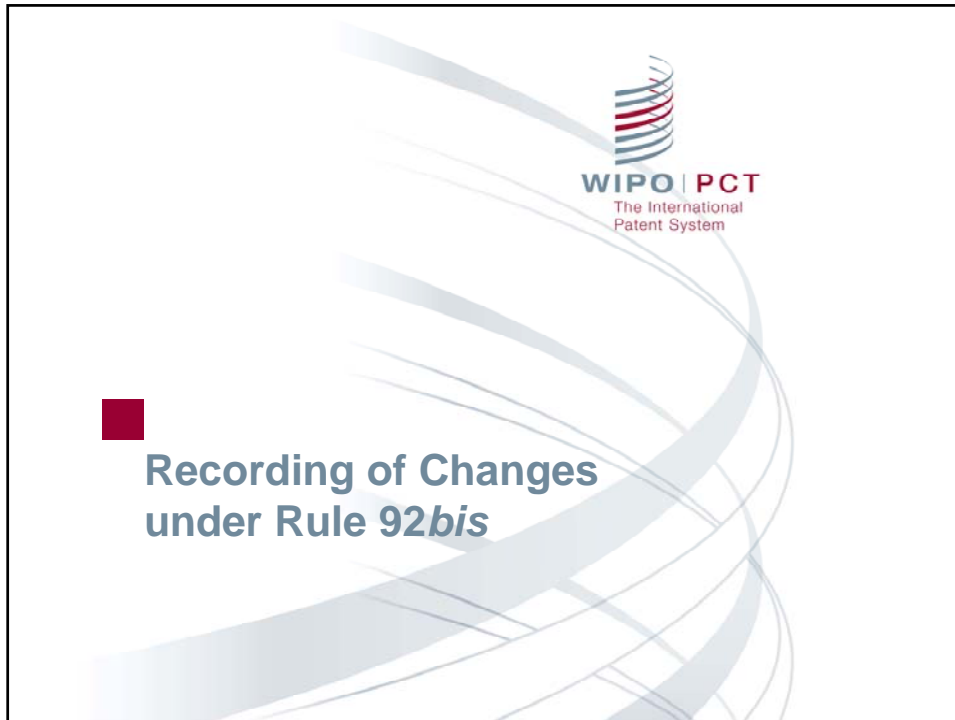


- Applicant A (e.g. corporate applicant), who has been appointed by the other applicants (e.g. applicants/inventors) as their common representative, appoints agent X.
- Agent X can, on behalf of the appointed common representative, sign all documents for all applicants including any withdrawal (Rule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

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



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



## Rule 92bis: cases covered

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

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

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

Changes-  
92bis-3  
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## Recording of a change in the person of the applicant under Rule 92bis

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

Changes-  
92bis-4  
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## 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

Changes-  
92bis-5  
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## 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.

Changes-  
92bis-6  
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## Withdrawals under Chapter I (1) (Article 24(1)(i) and Rule 90*bis*)

### ■ What?

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

### ■ When?

- before the expiration of 30 months from the priority date

### ■ How?

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

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

### ■ Effect:

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

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

### ■ What?

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

### ■ When?

- before the expiration of 30 months from the priority date

### ■ How?

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

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

### ■ Effect:

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



**PATENTSCOPE/PCT Resources**

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



## The International Searching Authority (1)

- Checks unity of invention (Rules 13 and 40)
- Checks title (Rule 37); checks abstract (Rule 38)
- Searches claimed invention (Article 15(3), Rule 33.3)
- Authorizes rectification of obvious mistakes if the mistake is:
  - in any part of the international application other than the request, (Rule 91.1(b)(ii)) or
  - in any paper submitted to that Authority (Rule 91.1(b)(iv))

## The International Searching Authority (2)

- Establishes international search report (ISR) (Rules 42 and 43) and/or declaration that no international search report will be established (Article 17(2))
- Establishes written opinion of the ISA (Rule 43*bis*): non-binding first opinion on novelty, inventive step (non-obviousness) and industrial applicability of claimed invention

## Prior art for international search (Article 15(2) and Rule 33)

- Prior art:
  - everything which has been made available to the public,
  - anywhere in the world,
  - by means of written disclosure,
  - which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step,
  - provided the making available to the public occurred prior to the international filing date.

- PCT Minimum Documentation (Rule 34)

## International Search Report (ISR) (Rules 42 and 43)

- Contains:
  - IPC (International Patent Classification) symbols
  - indications of the technical areas searched
  - indications relating to any finding of lack of unity
  - a list of the relevant prior art documents
  - indications relating to any finding that a meaningful search could not be carried out in respect of certain (but not all) claims
- Time limit to establish ISR and written opinion of the ISA:
  - 3 months from the date of receipt of the search copy by the ISA (usually within approximately 16 months from the priority date if priority is claimed); or
  - 9 months from the priority date, whichever time limit expires later

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## Cases where no international search report will be established (1)

- The application relates to a subject matter which the ISA is not required to search, and in the particular case decides not to search (Article 17(2)(a)(i) and Rule 39.1))
- The description, claims or drawings do not comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out in respect of any of the claims (Article 17(2)(a)(ii))
- The application contains the disclosure of a nucleotide and/or amino acid sequence, but:
  - no listing of that sequence is furnished,
  - the listing furnished does not comply with the Standard set out in Annex C of the Administrative Instructions or is not in electronic form (Rule 13*ter*.1(d)), or
  - the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13*ter*.1(d))

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## Cases where no international search report will be established (2)

### ■ Consequences:

- the ISA will declare that no international search report has been established and that declaration will be published as part of the published international application (Rule 48.2(a)(v))
- the application remains valid but the IPEA will not be obliged to carry out the international preliminary examination for lack of an international search report (Rule 66.1(e))

## Written opinion of the ISA (Rule 43bis) (1)

- Initial preliminary non-binding opinion on:
  - novelty (not anticipated)
  - inventive step (not obvious)
  - industrial applicability
- A written opinion will be established for all international applications at the same time as the ISR
- The written opinion is sent to applicant and the International Bureau together with the ISR

## Written opinion of the ISA (Rule 43bis) (2)

- The written opinion is NOT published together with the application
- No formal procedure for applicants to respond to written opinion of the ISA
- Possibility to submit informal comments to the International Bureau which will communicate such comments to DOs together with the IPRP (Chapter I) if and when it is sent

## Prior art for written opinion of the ISA (Rules 43bis.1(b) and 64.1)

- Prior art:
  - same as for international search purposes; BUT:
  - relevant date: everything made available to the public prior to the priority date
- The ISA may request a copy of a priority document from the International Bureau (Rule 66.7(a)); however, even if, at the time of establishment of the written opinion of the ISA, a copy cannot be made available to the ISA, the written opinion will nevertheless be established on the assumption that the priority date is the relevant prior art date, except if the applicant had failed to comply with his obligations under Rule 17.1

## 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

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## Use of the written opinion of the ISA for the purposes of the Chapter II procedure (Rule 66.1*bis*)

- If applicant files a demand for international preliminary examination:
  - written opinion of the ISA becomes written opinion of the IPEA (exception: IPEA decides not to accept written opinions by certain ISAs)
  - informal comments by applicant on written opinion of ISA will not be sent to IPEA (Article 34 amendments/arguments only)
  - if an international preliminary examination report is established, any informal comments submitted to the IB will not be sent to DOs or EOs

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## International Search Report and Written Opinion of the ISA

**PCT**

**INTERNATIONAL SEARCH REPORT**  
 (PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference VEI005PI-PCT	see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No. <b>PCT/US2008/078322</b>	(Earliest) Priority Date (day/month/year) 31 JULY 2007 (31.07.2007)
Applicant <b>OCCAM PORTFOLIO LLC et al</b>	

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.  
 It is also accompanied by a copy of each prior art document cited in this report.

- Basis of the report**
  - With regard to the language, the international search was carried out on the basis of:
    - the international application in the language in which it was filed
    - a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))
  - This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43.66is(a)).
  - With regard to any nucleotide and/or amino acid sequence disclosed in the international application, see Box No. I.
- Certain claims were found unsearchable** (See Box No. II)
- Unity of invention is lacking** (See Box No. III)
- With regard to the title,
  - the text is approved as submitted by the applicant.
  - the text has been established by this Authority to read as follows:
- With regard to the abstract,
  - the text is approved as submitted by the applicant.
  - the text has been established, according to Rule 38.2, by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.
- With regard to the drawings,
  - the figure of the drawings to be published with the abstract is Figure No. 4
    - as suggested by the applicant.
    - as selected by this Authority, because the applicant failed to suggest a figure.
    - as selected by this Authority, because this figure better characterizes the invention.
  - none of the figure is to be published with the abstract.

<b>A. CLASSIFICATION OF SUBJECT MATTER</b> <i>H01L 23/04(2006.01); H01L 23/48(2006.01);</i>		
According to International Patent Classification (IPC) or to both national classification and IPC		
<b>B. FIELDS SEARCHED</b> Minimum documentation searched (classification system followed by classification symbols) IPC8 H01L		
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched Korean Utility models and applications for Utility models since 1975 Japanese Utility models and applications for Utility models since 1975		
Electronic data base consulted during the international search (name of data base and, where practicable, search terms used) eKIPASS (KIPO internal) and keywords "semiconductor, die, package, method, substrate, adhesive, layer, printed, circuit, component, insulating, and similar terms"		
<b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b>		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	WO 2005-004200 A2 (Islam et al.) 13 January 2005 See abstract, Figures 1-11 and claims 1-20	1,4-5
A	JP 2006-005002 A (ALPS ELECTRIC CO LTD) 5 January 2006 See abstract, Figures 1-5 and claims 1-7	1-9
A	US 2006-0097380 A1 (Sato) 11 May 2006 See abstract, Figures 1-12 and claims 1-20	1-9
A	JP 2000-031335 A (DAINIPPON PRINTING CO LTD) 28 January 2002 See abstract, Figures 1-4 and claims 1-4	1-9

Further documents are listed in the continuation of Box C.  See patent family annex.

\* Special categories of cited documents:  
 "A" document defining the general state of the art which is not considered to be of particular relevance  
 "E" earlier application or patent but published on or after the international filing date  
 "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of citation or other special reason (as specified)  
 "O" document referring to an oral disclosure, use, exhibition or other means  
 "P" document published prior to the international filing date but later than the priority date claimed  
 "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention  
 "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone  
 "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art  
 "&" document member of the same patent family

Date of the actual completion of the international search 16 APRIL 2009 (16.04.2009)	Date of mailing of the international search report <b>17 APRIL 2009 (17.04.2009)</b>
Name and mailing address of the ISA/IKR Korean Intellectual Property Office Government Complex-Daegjeon, 139 Seonsa-ro, Seo-gu, Daegjeon 302-701, Republic of Korea	Authorized officer KIM, Jun Hak Telephone No. 82-42-481-5785



Date of receipt: 21 avril 2009 (21.04.2009) PCT/US2008/078322

**INTERNATIONAL SEARCH REPORT**

Information on patent family members

International application No.  
**PCT/US2008/078322**

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
WO 2005-004200 A2	13.01.2005	None	
JP 2006-005002 A	05.01.2006	None	
US 2006-0097380 A1	11.05.2006	US 7372146	13.05.2008
JP 2000-031335 A	28.01.2000	None	

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

To:  
TICHANE, David  
The IPL Group 20400 Stevens Creek Blvd. Fifth Floor  
Cupertino California 95014 USA

Date of mailing (day/month/year) 17 APRIL 2009 (17.04.2009)	
FOR FURTHER ACTION See paragraph 2 below	
Applicant's or agent's file reference VEI003P1-PCT	Priority date(day/month/year) 31 JULY 2007 (31.07.2007)
International application No. PCT/US2008/078322	International filing date (day/month/year) 30 SEPTEMBER 2008 (30.09.2008)
International Patent Classification (IPC) or both national classification and IPC H01L 23/04(2006.01); H01L 23/48(2006.01);	
Applicant OCCAM PORTFOLIO LLC et al	

1. This opinion contains indications relating to the following items:

Box No. I Basis of the opinion

Box No. II Priority

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

Box No. IV Lack of unity of invention

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

Box No. VI Certain documents cited

Box No. VII Certain defects in the international application

Box No. VIII Certain observations on the international application

2. FURTHER ACTION  
If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.  
For further options, see Form PCT/ISA.220.

3. For further details, see notes to Form PCT/ISA.220.

Name and mailing address of the ISA IPR Korean Intellectual Property Office Government Complex-Daejeon 139 Seosun-ro, Seo-sul, Daejeon 302 -701, Republic of Korea Facsimile No. 82-42-472-7140	Date of completion of this opinion 16 APRIL 2009 (16.04.2009)	Authorized officer KIM, Jun Hak Telephone No. 82-42-481-5785
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WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No.  
PCT/US2008/078322

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of:
- the international application in the language in which it was filed
- a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))
2.  This opinion has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a))
3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, this opinion has been established on the basis of:
- a. type of material
- a sequence listing
- table(s) related to the sequence listing
- b. format of material
- on paper
- in electronic form
- c. time of filing/furnishing
- contained in the international application as filed.
- filed together with the international application in electronic form.
- furnished subsequently to this Authority for the purposes of search.
4.  In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
5. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
**PCT/US2008/078322**

**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 2-3, 6-9	YES
	Claims 1, 4-5	NO
Inventive step (IS)	Claims 2-3, 6-9	YES
	Claims 1, 4-5	NO
Industrial applicability (IA)	Claims 1-9	YES
	Claims None	NO

**2. Citations and explanations :**

Reference is made in the present opinion to the following documents cited in the search report:

D1: WO 2005-004200 A2

D1 discloses that a redistributed lead frame for use in molded plastic semiconductor package is formed from an electrically conductive substrate by a sequential metal removal process. The process includes: (a) patterning a first side of an electrically conductive substrate to form an array of lands separated by channels, (b) disposing a first molding compound within these channels, (c) patterning a second side of the electrically conductive substrate to form an array of chip attach sites and routing circuits directly interconnecting the array of lands and the array of chip attached sites, (d) directly electrically interconnecting input/output pads on the at least one semiconductor device to chip attach site members of the array of chip attach sites, and (e) encapsulating the at least one semiconductor device, the array of chip attach sites and the routing circuits with a second molding compound.

**1. Novelty and Inventive Step**

1-1, Claims 1, 4-5

As an electric circuit apparatus of encapsulated electronic components, intermediate conductor, adhesive layer and printed circuit board of claim 1 corresponds to the second molded component, semiconductor device, encapsulate, and attachment of D1. As all of the features of claim 1 are disclosed in D1, this claim is anticipated by D1. Therefore, claim 1 lacks novelty under PCT Article 33(2).

The additional technical features of claim 1 (one or more leads of the at least one electrical component are in electrical communication with respective one or more leads on a printed circuit board of claim 4 and the respective one or more respective intermediate connector within the joining material of claim 5) are describes in D1 (corresponds to the chip attach sites, input/output pads on semiconductor device and the first molding compound is arrayed in land and the second molding is encapsulated over the semiconductor device). As all of the features of claims 4-5 are disclosed in D1, Continued on Supplemental Box

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
**PCT/US2008/078322**

**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.  
Continuation of :

Box V

these claims are anticipated by D1. Therefore, claims 4-5 lacks novelty under PCT Article 33(2).

1.2. Claims 2-3, 6-9

The subject matter of claims 2, 6 differs from these prior art documents in that a various electrical components of PGA, LGA, OFF, QFN are included. And it is not obvious to a skilled person in the art by the documents, take alone or in combination.

The subject matter of claim 3 differs from these prior art documents in that a component are placed by the carrier. And it is not obvious to a skilled person in the art by the documents, take alone or in combination.

The subject matter of claims 7-9 differs from these prior art documents in that encapsulating the at least one electrical component in an electrically insulating material in the process of the carrier placing and removing step. And it is not obvious to a skilled person in the art by the documents, take alone or in combination.

Therefore, claims 2-3, 6-9 meet the requirements of PCT Article 33(2) and (3) with respect to novelty and inventive step.

**2. Industrial Applicability**

Claims 1-9 are industrially applicable under PCT Article 33(4).



## Objectives

- To address PCT applicants' concerns about new prior art being found once they have already incurred significant costs and entered national phase
- To reduce this risk by introducing optional supplementary searches in the PCT international phase
- To expand the scope of search in the international phase taking into account the growing linguistic diversity in prior art

## Main Features

- An optional service for applicants,
  - it is currently offered by : AT, EP, FI, RU, SE and XN
  - more Authorities are expected to offer SIS in the future
- An applicant can request supplementary search by any Authority offering this service, except the one responsible for main international search
- Each Authority determines the scope and fees for its supplementary search
- Supplementary international search (SIS) covers only one invention – there is no option for paying additional fees

## Deciding When to Use the Service

- The main international search report is intended to be of a high quality, sufficient for normal purposes
- Consequently, this service need not be used for every international application, but to give extra information in some cases where the applicant believes that this additional expense in the international phase will be worthwhile
- Before requesting supplementary search, applicants should consider:
  - the main international search report
  - the commercial value of particular application
  - the number of disclosures relevant to the particular technical field which are known to be made in languages that are not a speciality of the main ISA

## Timing and Fees

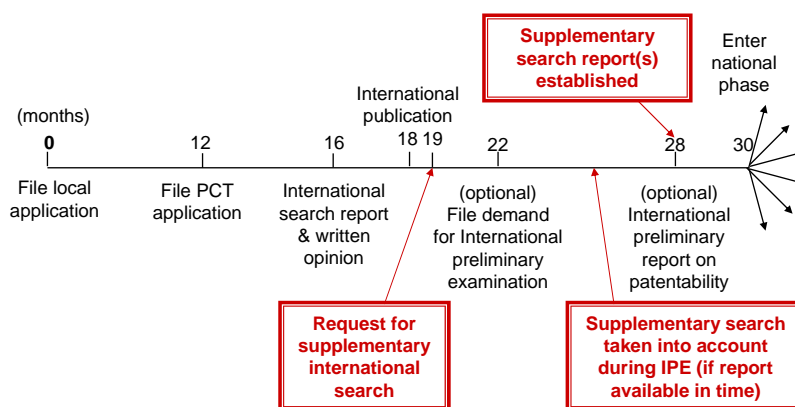
- The supplementary search request must be filed with the **International Bureau** within 19 months from the priority date
- Fees must be paid in **Swiss francs within 1 month** of filing the request:
  - supplementary search fee\*
  - supplementary search handling fee\*
- The Authority begins SIS on receipt of the request and international search report (ISR), or 22 months from the priority date, at latest, if the main ISR is late
- The SIS Report is established by 28 months from the priority date

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The International  
Patent System

SIS-5  
21.04.11

\* (see *PCT Applicant's Guide*, Annex SISA)

## SIS in the PCT System



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The International  
Patent System

SIS-6  
21.04.11

## Supplementary Search Request (1)

- The request must be filed using the supplementary search request Form PCT/IB/375, specifying
  - which Authority is to carry out the supplementary search
  - (in certain circumstances - see Unity of Invention) which claims are to be searched
  
- The request may need to be accompanied by:
  - a translation of the international application into a language accepted by the Authority\*
  - any sequence listing in electronic format\*

SIS-7  
21.04.11

\* (see *PCT Applicant's Guide*, Annex SISA)

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## Supplementary Search Request (2)

- There is no requirement that an agent be appointed to represent the applicant before the Authority specified for supplementary international search; applicants may, however, appoint an agent if they so wish
  
- A late payment fee may also apply if fees are not paid within one month and the IB issues an invitation to pay fees (Form PCT/IB/377)
  
- The request is considered withdrawn if the fees for supplementary search are not paid

SIS-8  
21.04.11

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## Unity of Invention

- Only one invention is searched – there is no option of paying additional fees for additional inventions
- Usually the first claimed invention is searched, but if the main ISA has found lack of unity of invention, the applicant may request supplementary search to focus on an invention other than the first
  - note that the Authority is not obliged to search inventions which have not been searched by the main ISA
- The Authority is not obliged to follow the views of the main ISA on unity of invention
- A review procedure is available which is similar to the “protest” procedure for the main search

## Scope of Search (1)

- Supplementary search is carried out on the claims as filed, usually on the first claimed invention (Article 19 and 34 amendments are not taken into account)
- The Authority is not required to search:
  - subject matter which it would not normally search in accordance with Article 17(2)
  - claims which have not been searched by the main ISA
  - any international application which is subject to a limitation set out in the Agreement between WIPO and the Authority defining the scope of their service (see [www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](http://www.wipo.int/pct/en/access/isa_ipea_agreements.html))
    - limitation of number of supplementary searches carried out
    - limitation of number of claims searched

## 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

## Services currently available (1)

- SISA/AT: three search options
  - search of only the German-language documentation
  - search of only the European and North American documentation
  - search of only the PCT minimum documentation
- SISA/EP: supplementary search includes the PCT minimum documentation as well as documents held in its search collection
- SISA/FI and SISA/SE: supplementary search includes the PCT minimum documentation as well as documents in Danish, Finnish, Norwegian and Swedish held by the Authority

## Services currently available (2)

- SISA/RU: two supplementary search options
  - The first includes Russian-language documentation and certain other patent documentation of the former Soviet Union and CIS States
  - The second is only available for applications where the main ISA has made an Article 17(2)(a) declaration because of subject matter referred to in Rule 39.1(iv) (methods of treatment): Includes the PCT minimum documentation, plus the above
- SISA/XN: supplementary search includes the PCT minimum documentation, as well as documents in Danish, Icelandic, Norwegian and Swedish held by the Authority

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SIS-13  
21.04.11

## 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

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SIS-14  
21.04.11

## Further Processing of Report

- The supplementary international search report is transmitted to the applicant and to the IB
- The IB makes the report publicly available (if the international application has been published)
- If the report is not in English, it will be translated into English by the IB
- The IB sends the report and translations, where appropriate, to the IPEA and designated Offices

## Refunds When No Search Is Carried Out

- If the Authority **commences** work, but **no** search is carried out:
  - for reasons equivalent to those available for the main international search (subject matter, lack of clarity or lack of sequence listing in electronic format) or
  - because the main ISA has made an Article 17(2)(a) declaration

the supplementary search fee **will not** be refunded

- because of limitations specific to the scope of the service offered by the Authority, the supplementary search request is considered not to have been submitted and

the supplementary search fee **will** be refunded



## Amendments under Article 19 (Rule 46) (1)

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

## Amendments under Article 19 (Rule 46) (2)

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

Amendments-  
Art19-3  
11.08.11

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## How to make amendments (Rule 46.5)

- Where claims are amended under Article 19, they have to be presented in the form of replacement sheets containing a complete set of claims
- In case of cancellation of certain claims, no renumbering of the remaining claims is required
- The basis for the amendments in the application as filed must be indicated
- An accompanying letter explaining what has been amended is required
- Further details: Administrative Instructions Section 205

Amendments-  
Art19-4  
11.08.11

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## Replacement sheets containing amendments under Article 19

- May not be filed with the receiving Office
- If filed under Article 19 (claims only), must be filed directly with IB in Geneva
  - If, however, they also contain rectifications of obvious mistakes (Rule 91), they must also be submitted to the ISA for authorization of rectification



## Requirement of unity of invention (Rule 13)

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

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

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

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

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Unity-3  
22.09.11

\* For further details, see OJ EPO, special edition No. 3/2007, pages 140 and 142

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

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

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Unity-4  
22.09.11

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

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

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Unity-5  
22.09.11

\* For further details, see OJ EPO, special edition No. 3/2007, pages 140 and 142

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

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

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Unity-6  
22.09.11

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

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

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The International  
Patent System

Unity-7  
22.09.11

\* For further details, see OJ EPO, special edition No. 3/2007, pages 140 and 142

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

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

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Unity-8  
22.09.11

\* For further details, see OJ EPO, special edition No. 3/2007, pages 140 and 142

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

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



## 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))

## International preliminary examination (1)

- The purpose of the international preliminary examination is to provide 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))
- Relevant prior art (Rule 64, see also Rule 33)
- Only claims relating to the invention(s) searched by the ISA will be examined by the IPEA (Rules 66.1(e) and 66.2(a)(vi))

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Patent System

IPE-3  
05.10.11

## International preliminary examination (2)

- Finding of lack of unity of invention (Rule 68)
  - same criteria as for international search (Rule 13 and paragraphs 10.20 to 10.59 of the International Search and Preliminary Examination Guidelines)
  - invitation by the IPEA to restrict the claims or to pay additional fees (which can be paid under protest)
  - applicant can select invention as “main invention” and those inventions for which additional fees are paid

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The International  
Patent System

IPE-4  
05.10.11

## 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

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05.10.11

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The International  
Patent System

## 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

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05.10.11

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Patent System

## 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)

IPE-7  
05.10.11

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Patent System

## 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 which have been used as a basis for the report
  - when referred to in the report, any sheet and letter concerning the rectification of an obvious mistake which has not been taken into account

IPE-8  
05.10.11

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The International  
Patent System

## The international preliminary report on patentability (Chapter II) (3)

- ❑ earlier amendments replaced by later amendments which
  - are considered to go beyond the disclosure in the international application or
  - are 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

## Reasons for delays in international preliminary examination (1)

### ■ On the part of the applicant:

- late payment of fee(s)
- late correction of defects in the demand
- incomplete statement, in the demand, concerning amendments
- failure to attach amendments referred to in the statement
- late furnishing of any required translation of the international application or of amendments
- late response to invitation to pay additional examination fees in case of finding of lack of unity
- late response to written opinion
- failure to file replacement sheets containing amendments

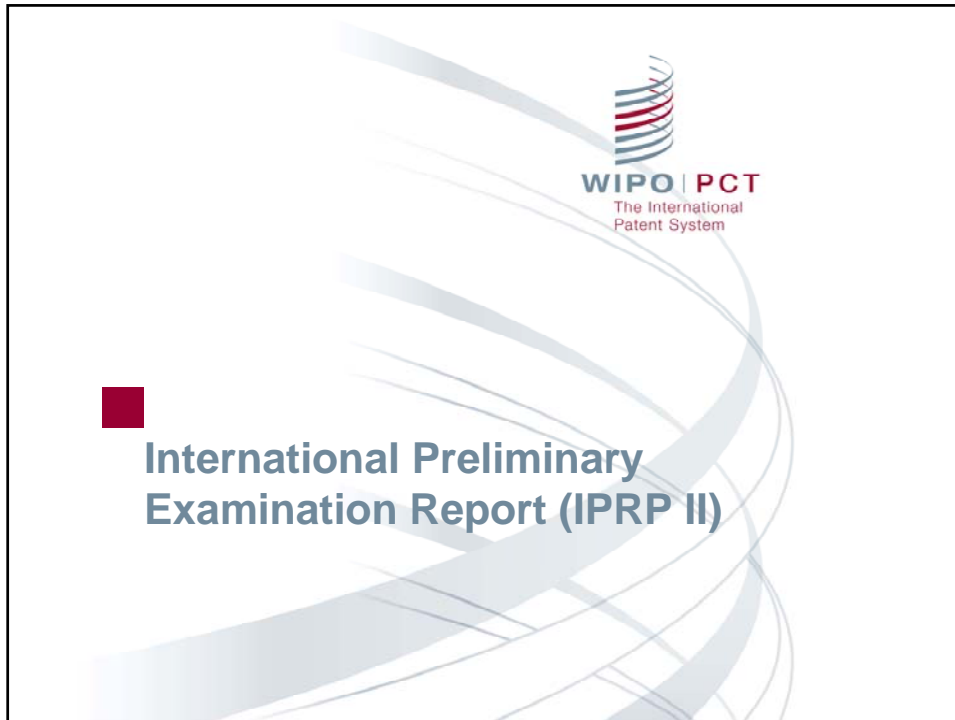
## Reasons for delays in international preliminary examination (2)

### ■ On the part of the ISA:

- late issuance of international search report

### ■ On the part of the IPEA:

- finding of lack of unity
- late issuance of written opinion



**International Preliminary  
Examination Report (IPRP II)**

**PATENT COOPERATION TREATY**  
**PCT**  
**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**  
 (Chapter II of the Patent Cooperation Treaty)  
**(PCT Article 36 and Rule 70)**

Applicant's or agent's file reference 4384-082990	<b>FOR FURTHER ACTION</b> See Form PCT/PEA416
International application No. PCT/US2008/078296	International filing date (day/month/year) 30.09.2008
International Patent Classification (IPC) or national classification and IPC INV. F16D65/04	Priority date (day/month/year) 30.11.2007

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a.  sent to the applicant and to the International Bureau a total of 1 sheets, as follows:

- sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
- sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b.  (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- Box No. I Basis of the report
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

Date of submission of the demand 2009-05-19	Date of completion of this report 09.02.2010
Name and mailing address of the international preliminary examining authority: European Patent Office D-60298 Munich Tel. +49 89 2399 - 0 Fax: +49 89 2399 - 4465	Authorized officer van Koten, Gert Telephone No. +49 89 2399-2954

**INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY**

International application No.  
PCT/US2008/078296

**Box No. I Basis of the report**

1. With regard to the language, this report is based on
- the international application in the language in which it was filed
  - a translation of the international application into , which is the language of a translation furnished for the purposes of:
    - international search (under Rules 12.3(a) and 23.1(b))
    - publication of the international application (under Rule 12.4(a))
    - international preliminary examination (under Rules 55.2(a) and/or 55.3(a))
2. With regard to the elements\* of the international application, this report is based on (replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):

**Description, Pages**

1-3 as originally filed

**Claims, Numbers**

1-6 as originally filed

**Drawings, Sheets**

1/2, 2/2 as originally filed

- a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3.  The amendments have resulted in the cancellation of:

- the description, pages
- the claims, Nos.
- the drawings, sheets/figs
- the sequence listing (specify):
- any table(s) related to sequence listing (specify):

4.  This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- the description, pages
- the claims, Nos. 1
- the drawings, sheets/figs
- the sequence listing (specify):
- any table(s) related to sequence listing (specify):

5.  This opinion has been established taking into account the rectification of an obvious mistake authorized by or notified to this Authority under Rule 91 (Rule 70.2 (e)).

6.  Supplementary international search report(s) from Authority(ies) have been received and taken into account in drawing up this report (Rule 45bis.8(b) and (c)).

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

International application No.  
PCT/US2008/078296

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (SEPARATE SHEET)**

International application No.  
PCT/US2008/078296

**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-6
Inventive step (IS)	Yes: Claims	
	No: Claims	1-6
Industrial applicability (IA)	Yes: Claims	1-6
	No: Claims	

2. Citations and explanations (Rule 70.7):  
see separate sheet

**Box No. VII Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:  
see separate sheet

**Re item I.**

1. The applicant has inserted the following feature in claim 1: "comprising a blend of abrasive materials, fillers and resin".

This feature is mentioned in the description in paragraph 3, which subject concerns the depiction of the prior art, as for instance disclosed in US-A-6 241 058. In the rest of the description of the present application, there is no reference which material is actually used for the present brake shoe. The only reference is to "a molded composite containing a plurality of reinforcing fibres".

The introduction of this feature therefore introduces subject-matter which extends beyond the content of the application as filed, contrary to Article 19(2)/Article 34(2)(b) PCT.

**Consequently, this opinion is based on the claims as originally filed.**

**Re item V.**

Reference is made to the following documents:

- D1 : FR 791 041 A (FR VULCANUS SOC) 2 December 1935 (1935-12-02)
- D2 : US 2 748 903 A (FOSTER ROBERT W) 5 June 1956 (1956-06-05)
- D3 : US 2 861 964 A (GAUGUE CHARLES L E DE JR ET AL) 25 November 1958 (1958-11-25)
- D4 : US 1 177 440 A (NICHOLS & RICHARDSON) 28 March 1916 (1916-03-28)
- D5 : US 2007/151817 A1 (KAHR JOSEPH C [US] ET AL) 5 July 2007 (2007-07-05)
- D6 : GB-A-1 249 922 (FERODO LTD) 13 October 1971 (1971-10-13)

1. Document D1 discloses (the references in parentheses applying to this document) a brake shoe formed of friction material for use without a metal backing plate, said brake shoe defined by a friction surface for bearing upon a wheel tread and an opposed back surface for being placed in contact with and secured to a brake head, said brake shoe having a reinforcing mesh (6') defining a plurality of interstices positioned along the back surface of the brake shoe embedded in a moulded friction material, there being a keyway at least partially formed of the moulded reinforced friction material extending away from the back surface of the brake shoe, the keyway being capable of extending through an opening provided

**INTERNATIONAL PRELIMINARY  
REPORT ON PATENTABILITY  
(SEPARATE SHEET)**

International application No.

PCT/US2008/078296

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THE WEBB LAW FIRM

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PCT/US 2008/078 296 - 19-05-2009

Replacement Sheet

in a brake head when the brake shoe is emplaced on the brake head.

The only difference is seen in that the material includes fibres. However, firstly this seems not to be essential to the posed problem of providing a shoe without a backing plate. The solution to this is given by the inclusion of the mesh in the shoe. Consequently, the present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.

Further, the use of fibers in the brake shoe material is known from many prior art documents, see for instance D3, D5 and D6. The inclusion of this material in the brake shoe as known from D1 would therefore not include an inventive step (Article 33(3) PCT).

2. The features of the dependent claims 2 to 6 do not include any features not already known from the prior art. The subject-matter of these claims is not new in the sense of Article 33(2) PCT.

**Re Item VII.**

1. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in the documents D1 and D2 is not mentioned in the description, nor are these documents identified therein.
2. Independent claim 1 is not in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would be appropriate, with those features known in combination from the prior art being placed in the preamble (Rule 6.3(b)(i) PCT) and with the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).

**THE INVENTION CLAIMED IS**

1. A brake shoe formed of friction material for use without a metal backing plate, said brake shoe defined by a friction surface for bearing upon a wheel tread and an opposed back surface for being placed in contact with and secured to a brake head, CHARACTERIZED IN THAT

said brake shoe having a reinforcing mesh defining a plurality of interstices positioned along the back surface of the brake shoe embedded in a molded friction material comprising a blend of abrasive materials, fillers and resin, wherein the molded friction material is reinforced with a plurality of discrete fibers, some of which extend through the interstices in the wire mesh, there being a key bridge defining a keyway at least partially formed of the molded fiber reinforced friction material extending away from the back surface of the brake shoe, the key bridge being capable of extending through an opening provided in a brake head when the brake shoe is emplaced on the brake head.

2. The brake shoe according to claim 1, wherein the keyway has a keyhole therein, the portion of the keyway behind the keyhole defining a key bridge, and wherein the reinforcing mesh extends along the back surface of the brake shoe and continues through the key bridge.

3. The brake shoe according to claim 1, wherein the reinforcing mesh extends along the back surface of the brake shoe and there being a key bridge strap partially encapsulated in the brake shoe defining a keyhole.

4. The brake shoe according to claims 1, 2 or 3, wherein the reinforcing mesh is metallic.

5. The brake shoe according to claims 1, 2 or 3 wherein the reinforcing mesh is non-metallic.

- 4 -

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AMENDED SHEET  
Received at the EPO on May 19, 2009 20:11:04. Page 11 of 12



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

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

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

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

Amendments-  
Art34-3  
11.08.11

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## How to make amendments (Rule 66.8)

- Where claims are amended under Article 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 IPER may be established as if the amendments had not been made
- In case of cancellation 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

Amendments-  
Art34-4  
11.08.11

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## Replacement sheets containing amendments under Article 34

- If filed under Article 34 (description, claims, drawings), must be filed directly with competent IPEA
  - If they also contain rectifications of obvious mistakes (Rule 91), that IPEA will also be competent to authorize rectification



## Entry into the National Phase

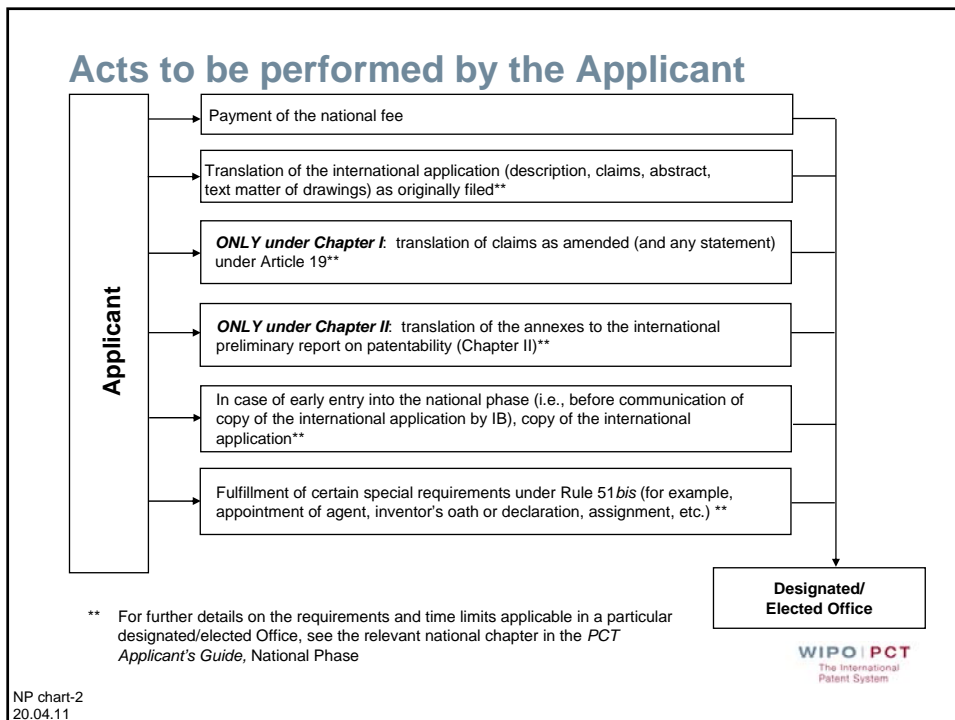
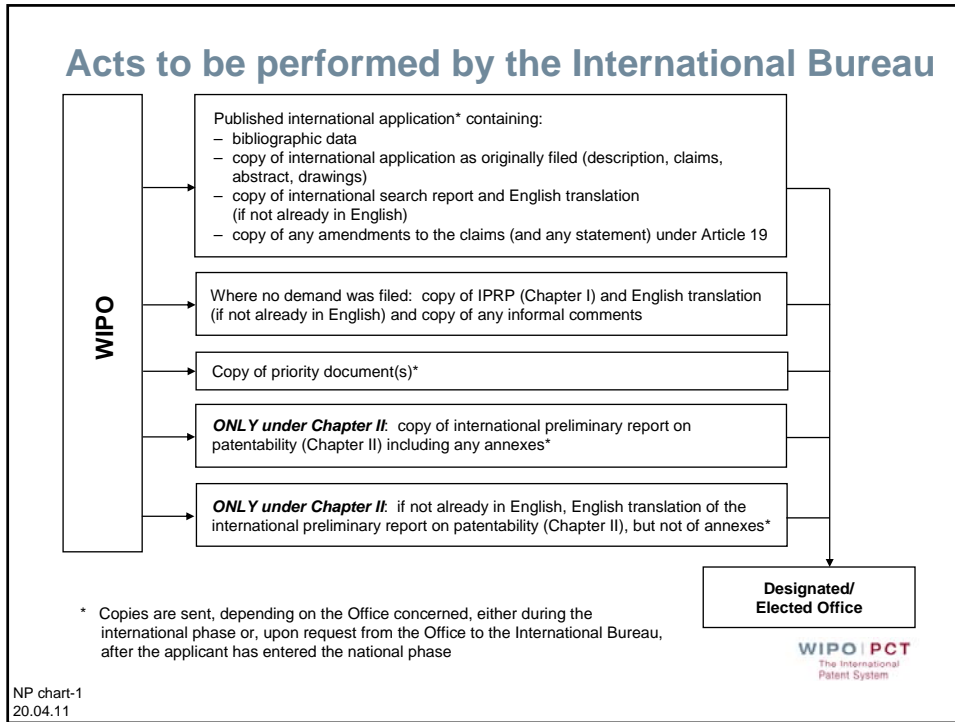
### Decisions to be taken by the applicant

- 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

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

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



## General national requirements Art. 22(1) and 39(1)(a)

- Requirements:
  - Translation, if applicable
  - Payment of national fee
  - Copy of international application in particular circumstances only
  
- Time limit under Art. 22(1): 30 months from the priority date
  - For additional time, see PCT Applicant's Guide, national phase summaries
  - For exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)
  
- Time limit under Art. 39(1)(a): 30 months from the priority date
  - For additional time, see PCT Applicant's Guide, national phase summaries

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

- Time limit under Rule 51 *bis*.3:
  - If requirements are not fulfilled within the time limit for entry into national phase under Art. 22 or 39:
    - Invitation by DO
    - At least 2 months from the invitation

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## 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

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

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

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

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

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

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

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

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

## A few further tips to remember

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

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## 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

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27.04.11

## 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 (1)

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f) (see *PCT Gazette* No. 05/2003 on 30 January 2003) (12 offices – situation as of 22 February 2008):

<del>BY</del> Belarus*	KR	Republic of Korea	
CA	Canada	LV	Latvia
CN	China	MX	Mexico
DE	Germany	NZ	New Zealand
<del>EP</del> EPO*	PH	Philippines	
<del>GB</del> United Kingdom*	PL	Poland	
<del>HR</del> Croatia*	<del>PT</del> Portugal*		
IN	India	<del>SG</del> Singapore*	
JP	Japan	<del>YU</del> Serbia and Montenegro*	

Notification withdrawn effective 1 July 2003 (PT); 1 Aug. 2003 (BY);  
1 Jan. 2004 (HR); 1 July 2004 (SG); 10 July 2004 (YU);  
1 Jan. 2005 (GB) and 13 Dec. 2007 (EP)

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## DO/EOs to which Rule 49.6 does not apply (2)

- 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

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## Additional cases of protection against loss of rights

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

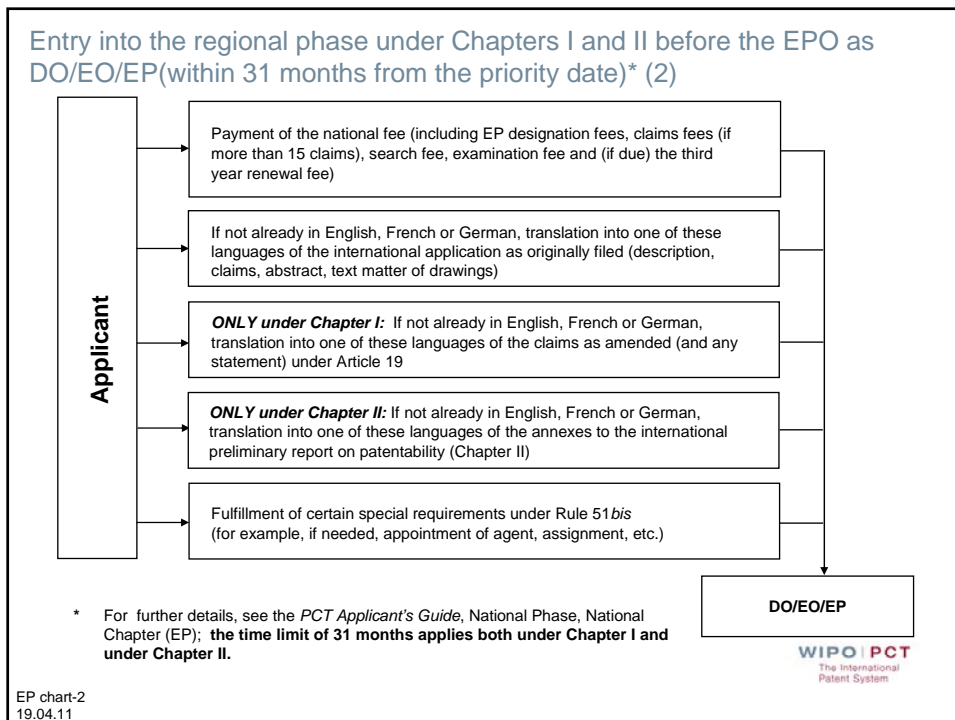
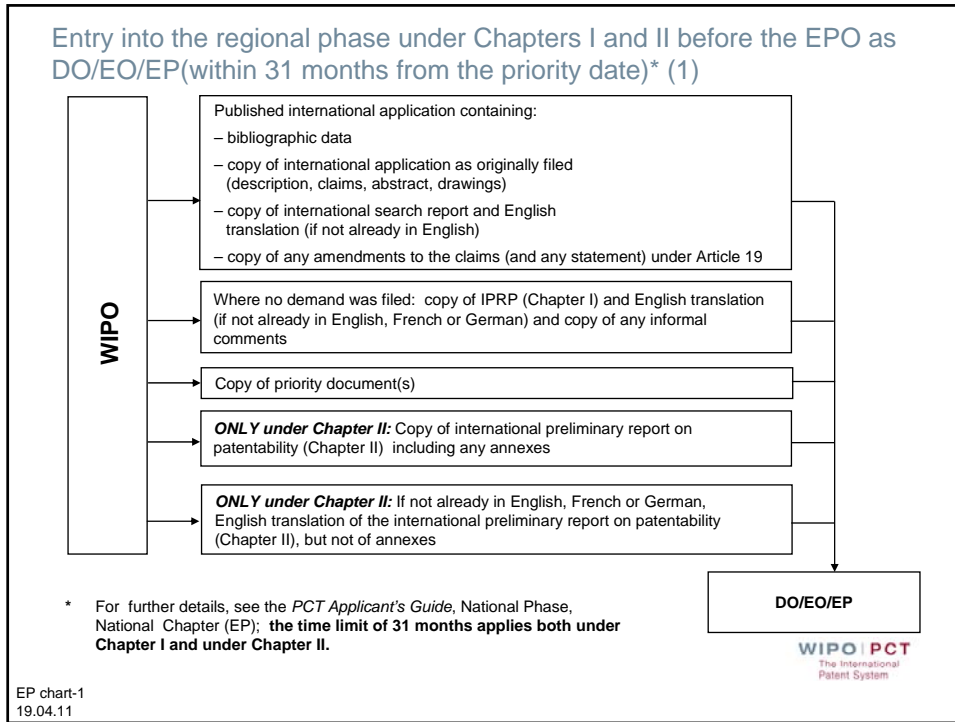


## Euro-PCT Applications

- A Euro-PCT application is an international application under the PCT which contains the designation EP for a European patent for one or more EPC Contracting States
- According to Article 11(3) PCT and Article 153(2) EPC, an international application which contains the EP designation has the effect of a regular filing of a European patent application for which the international filing date is deemed to be the actual European filing date

## General information

- Time limit:
  - 31 months from the priority date (Chapter I)
  - 31 months from the priority date (Chapter II)
- Accepted languages: English, French or German
- Language of proceedings:
  - language of international publication if published in English, French or German, or
  - language of translation



## Claiming priority

- Priority claim:
  - according to Art. 87(1) priority claims of earlier applications filed in any State party to the Paris Convention or in any member of the World Trade Organization are recognized
  - Art. 87(2) provides for exceptions if notified by the Administrative Council (bilateral agreements)

## Fees (1)

- National basic fee
  - reduced when form EP1200 filed online
- Flat rate designation fee
- Page fee (for pages in excess of 35)
- Claims fee – for each claim from the sixteenth claim
- Renewal fee for the 3rd year: to be paid if the IA was filed more than two years before the expiration of the 31 months, for ex. if no priority was claimed (Rules 51(1) and 159(1)(g))

## Fees (2)

- Search and examination fees: identical to those due for a European direct filing with the following exceptions:
  - no European search fee if ISA was EP
  - substantial reduction of the European search fee if ISA was AT, ES, FI, SE or XN
  - slight reduction of the European search fee if ISA was AU, CN, JP, KR, RU or US
  - 50% reduction of the European examination fee if IPEA was EP and if the subject matter was examined by the IPEA
  - a further 20% reduction of the examination fee, if request for examination filed in an official language of a member state which is not an EPO language and by a person who is a national of or resident in that member State

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Euro-PCT-6  
19.04.11

## National Requirements (Rule 159)

- Translation of the IA
- Request for examination
- Payment of filing fee
- Payment of at least one designation fee
- Payment of search fee
- Payment of renewal fee for 3rd year (if applicable)
- Specification of application documents to be basis for grant procedure

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19.04.11

## Consequences of non-fulfillment of certain requirements (Rule 160)

- Application is deemed withdrawn if in due time
  - translation or request for examination is not filed
  - filing fee, designation fee, page fee, search fee or examination fee is not paid
- Office issues notification of loss of rights under Rule 112(1)
- Remedy: further processing under Art. 121

## Request for further processing (Article 121 and Rule 135)

Within 2 months from the Notification of loss of rights:

- file request for further processing
- pay the prescribed fee
- complete the omitted act

## Request for re-establishment of rights (Article 122 and Rule 136)

- Does not apply to cases where further processing is available
- Must be filed within
  - two months from removal of cause of non-compliance with time limit or
  - one year from the expiry of the time limit (at the latest)
- Must state grounds and facts
- Omitted act must be completed within the applicable time limit for filing of request

Euro-PCT-10  
19.04.11

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## Extension of European patent (1)

- Available for:
  - AL Albania (for applications filed before 1 May 2010)
  - BA Bosnia and Herzegovina
  - HR Croatia (for applications filed before 1 January 2008)
  - ME Montenegro (for applications filed from 1 March 2010)
  - MK The Former Yugoslav Republic of Macedonia (for applications filed before 1 January 2009)
  - RS Serbia (for applications filed before 1 October 2010)

Euro-PCT-11  
19.04.11

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Patent System

## Extension of European patent (2)

- Conditions:
- The PCT application contains the designations of the States concerned in addition to the designation EP (*i.e. the designation of those States has not been withdrawn*)
- When to request extension:  
upon entry into the EP regional phase
- How to request extension:
  - by an indication to that effect in EP form 1200, and
  - by paying the European extension fee for each State concerned

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The International  
Patent System

Euro-PCT-12  
19.04.11

## Review by EPO under Art. 25(1) PCT (Rules 51 and 82bis PCT, Rule 159(2) EPC) (1)

- A request to review may be filed when
  - the RO refused to accord an international filing date
  - the RO declared the IA as considered withdrawn
  - the IB considered the IA withdrawn because the record copy had not been received within the prescribed time limit
  - the RO declared the designation EP considered withdrawn

WIPO | PCT  
The International  
Patent System

Euro-PCT-13  
19.04.11

## Review by EPO under Art. 25(1) PCT (Rules 51 and 82*bis* PCT, Rule 159(2) EPC) (2)

- provided applicant takes the following steps within two months from the notification by RO or IB:
  - request the IB under Art. 25(1) to send copies of documents in the file
  - pay the national fee and, where required, furnish translation

## Rectification by EPO of errors made by RO or IB (Rule 82*ter* PCT)

If rectification would be permitted under the EPC law or practice, the EPO will

- rectify the international filing date, which is incorrect due to an error made by the RO
- recognize a priority claim which had been considered by the RO or the IB as not having been made

## Accelerated examination of European patent applications (“PACE”)\*

- Available for all Euro-PCT applications, irrespective of whether the EPO acted as ISA or IPEA, regardless of the subject matter of the application
- The request for accelerated examination
  - may be filed upon entry into the European regional phase or later
  - must be made in writing
  - need not contain any specific reasons
  - is free of charge
  - is excluded from file inspection
- Applicants may file a substantive response (reasoned observations or amendments or both) on matters raised in the IPRP upon entering the regional phase without awaiting the first communication from the EPO

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\* See OJ EPO, special edition No. 3/2007, page 102

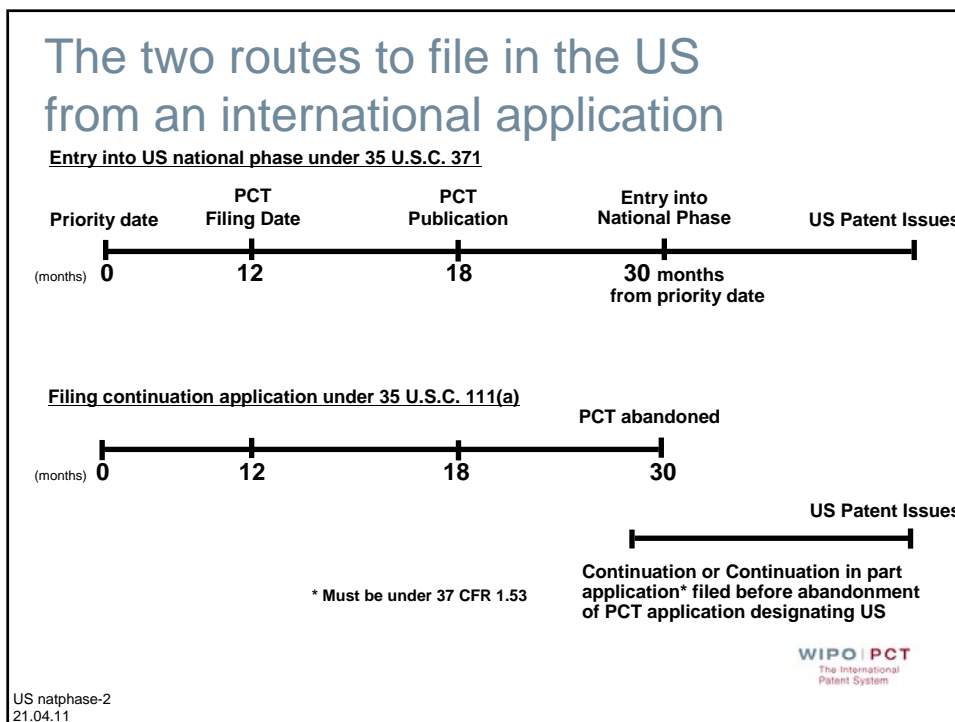
## Validation of the European Patent (Generally)

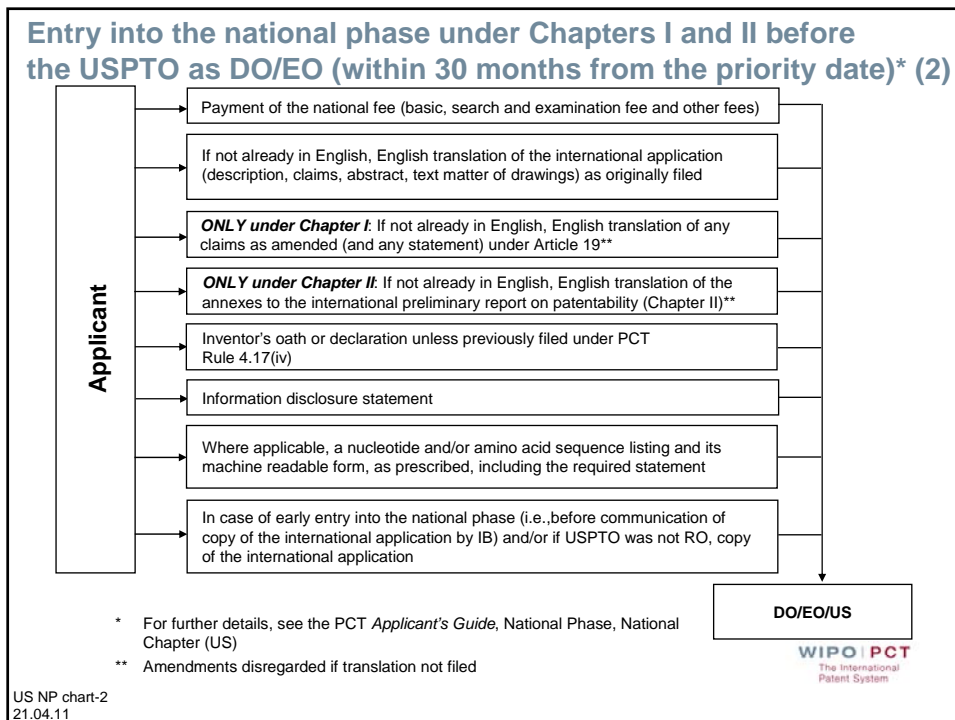
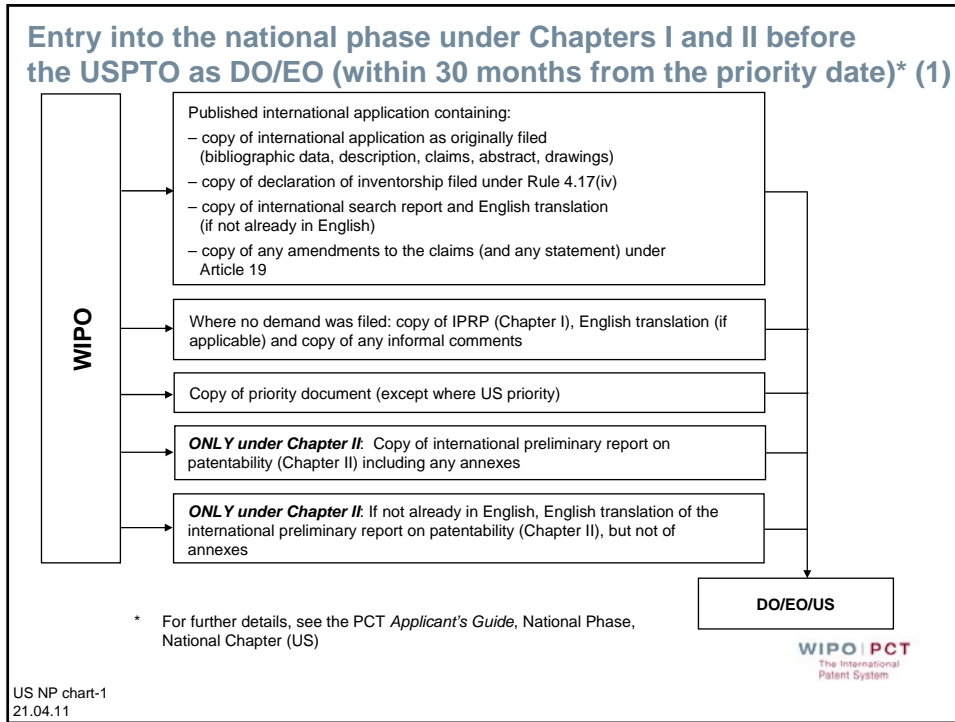
Under EPC Article 65, any Contracting State may:

- require a translation of the granted patent in (one of) its official language(s)
  - time limit: 3 months from publication in the European Patent Bulletin
- require payment of the costs of publication
- prescribe that the patent shall be deemed void in case of non-compliance with the requirements under Article 65(1) and (2)

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## Requirements for US national application and US national phase of a PCT application which are identical

- Inventor must be applicant
- Best mode of the invention must be disclosed
- Duty of disclosure within 3 months from filing US national application or fulfillment of all requirements for entry into US national phase
- 50% small entity fee reduction available on some fees
- Petition to revive abandoned application possible
- Filing date, US or PCT, used for interference purposes
- Filing of continuation or continuation-in-part application possible
- English translation required
- Complete information disclosure statement with copies of all references including those cited in the international search report

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## Entry into the US national phase under 35 USC 371 (general) (1)

Time limit: 30 months from the priority date (under Chapter I and under Chapter II)

Requirements:

- payment of the basic national, search and examination fee
- English translation of the international application
- inventor's oath or declaration (may have been executed before the PCT filing date)
- copy of the international application (only in case of early entry where it has not been communicated by IB to DO/EO/US\* or where US was not RO)

\* Only in rare instances; generally when entry takes place before international publication, then a copy of the application must be furnished within the 30-month time limit

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US natphase-4  
21.04.11

## Entry into the US national phase under 35 USC 371 (general) (2)

### IMPORTANT:

- The basic national fee MUST be paid within the 30-month time limit.
- Failure to pay will result in the abandonment of the application. If the search and examination fee is not paid with the basic national fee, DO/EO/US will invite applicant to pay the fees within a time limit fixed in the invitation.
- If the fee is paid within the time limit, but the translation and/or the oath are not filed, the DO/EO/US will issue a “Notice to File Missing Requirements” inviting the applicant to furnish them, subject to the payment of a surcharge, within a fixed time limit which is further extendable under 37 CFR 1.136

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## Entry into the US national phase under 35 USC 371 (translation requirements where the application has been amended) (1)

- Entry into the national phase under Chapter I (within 30 months):
  - The translation of Article 19 amendments must be furnished within 30 months
  - If not furnished, the amendments will be considered cancelled

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## Entry into the US national phase under 35 USC 371 (translation requirements where the application has been amended) (2)

- Entry into the national phase under Chapter II (within 30 months):
  - Translation of annexes to the international preliminary report on patentability (Chapter II) must be furnished within 30 months
  - If not furnished, the amendments will be considered cancelled
  - If the basic national fee is paid within 30 months, but the oath or the translation of the application is not furnished, the “Notice to File Missing Requirements” will also relate to the translation of the annexes

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## US national phase under 35 U.S.C. 371 (1)

- The international filing date under PCT Article 11 is the US filing date.
- Correct translation of international application required. That translation may be accompanied by a substitute specification containing an improved or rewritten text of the application where desired, together with a statement that the substitute specification contains no new matter.
- No need to file:
  - a copy of the international application if copy was communicated by IB;
  - a copy of the drawings (except where the originally filed drawings contain text matter or do not comply with PCT Rule 11);
  - another certified copy of the priority application if a certified copy was timely filed during the international phase;

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## US national phase under 35 U.S.C. 371 (2)

- The broader PCT unity of invention criteria (PCT Rule 13 and Annex B of the PCT Administrative Instructions) apply during national examination.
- Basic national fee (37 CFR 1.492(a)) must be paid within the 30-month time limit to avoid abandonment. No extension of time available. The examination and search fee can be paid later.
- Petition to revive abandoned application available in case of late (“unavoidable” and “unintentional”) entry into national phase.

## Filing a continuation or continuation-in-part under 35 U.S.C. 111(a) instead of entering the national phase - the “bypass route”- (1)

- The English translation of an international application filed in another language need not be an “exact” translation.
- Possibility to add new matter to the disclosure made in the international application by filing a continuation-in-part application.
- Retain full benefit for disclosed subject matter of:
  - foreign priority date under Paris Convention and 35 USC 119
  - US priority date under 35 USC 120 of co-pending application (i.e. PCT application designating US).
- Extension of time under 37 CFR 1.136 available for payment of basic filing fee.

## Filing a continuation or continuation-in-part under 35 U.S.C. 111(a) instead of entering the national phase - the “bypass route”- (2)

### ■ Need to file:

- a complete application (may be in non-English language but translation must follow);
- any required formal drawings;
- certified copy of any priority application;

- Unity of invention requirements are the same as for national US applications. The broader requirements of PCT Rule 13 and Annex B of the Administrative Instructions do not apply.



## Contents

This presentation will cover the following subjects:

- PCT e-Services
- Retrieval of priority documents via Priority Document Access Service (DAS)
- PCT Online Document Upload
- Further information

## PCT e-Services

- The PCT e-Services Team offers support for the following services:
  - PCT-SAFE and PCT e-filing
  - WIPO Certification Authority – digital certificate issuance and administration
  - Priority Document Access Service (DAS)
  - PCT Online Document Upload
  - ePCT (covered in a separate presentation)

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## Retrieval of priority document via DAS

- Possible to request the International Bureau to retrieve a copy of an earlier application, in electronic form, via the Priority Document Access Service (DAS) to meet PCT priority document requirements.
- Currently, the service is available for earlier filed national applications filed with AU, ES, FI, GB, JP, KR, US and international applications filed with RO/FI and RO/IB.
- The Office with which the earlier national application was filed is known as the Office of First Filing (OFF).
- The Office that retrieves the document is known as the Office of Second Filing (OSF).

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## Main steps for the use of DAS

- Request the OFF to make the earlier application available via DAS.
- DAS system sends access code to the applicant via e-mail.
- Go to the DAS portal and grant access permission to the IB to retrieve the priority document. *[this step is best taken before filing the PCT application to ensure that the IB can retrieve the document before the expiration of the 16 month time limit]*
- 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.
- The IB retrieves the priority document via DAS and sends a confirmation of retrieval to the applicant by means of the form PCT/IB/304.

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## Requesting DAS p-doc retrieval

Details of Priority Claim of Earlier Application

National  Regional  International (PCT)

Country: US United States of America

Filing date: 10 October 2009

Number: 61274,654

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

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

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

- DAS retrieval is currently possible for national applications filed with the following Offices: AU, ES, FI, GB, JP, KR and US, and for PCT applications filed with RO/FI and RO/IB only.

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## DAS – log in

- Log in to DAS by indicating the earlier application information (country code and application number), the access code and the captcha text.

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## DAS - Granting access permission

Select	Office code	State or Office of second filing	Access Granted on
<input type="checkbox"/>	JP	403 Kabunigasaki 3-chome, Chiyoda-ku, TOKYO 100-8915	
<input type="checkbox"/>	US	Commissioner for Patents, P.O.Box 1450 Alexandria VA 22313-1450	
<input type="checkbox"/>	AU	IP Australia P.O. Box 200 Viden ACT 2606	
<input type="checkbox"/>	ES	Paseo de la Castellana 75, 28020 Madrid	
<input type="checkbox"/>	KR	Government Complex-Daejeon 159 Seonsa-ro, Seo-gu Daejeon 302-701	
<input type="checkbox"/>	FI	Airkadankatu 6A FIN-00100 Helsinki	
<input checked="" type="checkbox"/>	IB	Bureau International de l'OMPI 34, chemin des Colombettes Geneve 20 12111	May 26, 2011

- Select the Office (IB) to grant permission to retrieve the priority document.

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## PCT Online Document Upload

- A service for submitting post-filing electronic documents via a web interface to the IB and RO/IB after they have started processing an application (receipt of Form PCT/IB/301 and RO/105 respectively).
- Documents that may be uploaded: e.g. general correspondence, Rule 92*bis* changes, declarations, translations.
- Only PDF documents can be uploaded via the service (sequence listings for supplementary international search purposes accepted as .zip, .txt and .app files).
- It is recommended that **PDF-text** documents be uploaded, i.e., documents created in MS Word (or other word processor) and then printed to PDF.
- The IB recommends the use of text string signatures on accompanying letters, e.g., "/John Smith/".
- **NOT** to be used for the initial filing of international applications.

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## PCT Online Document Upload

	Document Type	File Name	File Size	view/download
✗	Notice of Withdrawal	92bis.pdf	9 KB	<a href="#">view/download</a>
✗	General Correspondence	General corresp.pdf	9 KB	<a href="#">view/download</a>

- An e-mail confirming that the documents have been uploaded is sent to the address indicated at the start of the transaction.
- User Guide with full details available in the PCT Service Center.

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## Further information

- PCT-SAFE home page <http://www.wipo.int/pct-safe>
- DAS home page  
[http://www.wipo.int/patentscope/en/priority\\_documents/](http://www.wipo.int/patentscope/en/priority_documents/)
- PCT Service Center home page (for Online Document Upload and PCT e-Payment)  
[http://www.wipo.int/pct/en/service\\_center](http://www.wipo.int/pct/en/service_center)

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## Further information

- PCT e-Services Help Desk contact details:
- tel: (+41-22) 338 95 23  
fax: (+41-22) 338 80 40  
e-mail: [pctsafe.help@wipo.int](mailto:pctsafe.help@wipo.int)
- opening hours: Monday to Friday 9:00 – 18:00 CET

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## Quick recap – what is ePCT?

- A suite of secure online services built around a centralized interactive electronic archive of PCT documents and data held at the IB
- WIPO online user account required to access ePCT - a new identity management portal has been built (“WIPO Accounts” service)
- ePCT *public* services: access requires only a standard WIPO user account (Username + password) – no access to confidential documents and data
- ePCT *private* services: access requires the WIPO user account to be reinforced with a valid digital certificate

## What do ePCT *private* services offer?

- First delivery: private file inspection of the IB's electronic dossier, including before publication (international applications filed as of 1 January 2009):
  - ❑ up-to-date bibliographic data (IASR)
  - ❑ documents on file, including those not publicly available in PATENTSCOPE after publication
  - ❑ integration of existing online services (online document upload and later also PCT e-Payment)
  - ❑ online delivery of electronic notifications from the IB
  - ❑ delegation of online access rights to international applications

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## ePCT Project Stages

- **Stage 1** – Private file inspection (PFI) for international applications filed electronically at **RO/IB** with a **WIPO digital certificate** was launched in production on 2 May 2011 to a limited group of users.
- **Further stages:**
  - ❑ Extend PFI gradually to international applications filed electronically with other Receiving Offices and other digital certificates (pilot currently being extended to pilot users who file electronically at RO/EP and RO/KR)
  - ❑ Extend PFI to international applications filed on paper or physical media (targeted for end of 2011)
  - ❑ Introduction of additional online services in 2012, e.g., web filing, online actions such as Rule 92bis, withdrawals, etc.
  - ❑ Extension of ePCT to procedures before national/regional Offices in varying capacities (RO, ISA, SISA, IPEA, DO, EO) that wish to participate.

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## How can you try out ePCT?

- A fully functional ePCT **demo** environment has been established:
  - Users who submit **demo** e-filings to RO/IB and specify e-mail communication for notifications can then take “eOwnership” of those demo applications in ePCT and try out the new system.
  - ePCT instructions sent automatically after demo filing
  - Feedback welcome! Please submit comments via the “Contact Us” link on WIPO’s website and select “Patents” as the Topic and “ePCT” as the Sub-topic.



## PATENTSCOPE enhancements (1)

- Information on national phase entry for more than 40 countries
- Access to more than 25 searchable national and regional patent collections
- Cross-Lingual Information Retrieval
  - More search results thanks to the translation of the search terms (Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, Spanish)
  - [www.wipo.int/patentscope/search/clir/clir.jsp?interfaceLanguage=en](http://www.wipo.int/patentscope/search/clir/clir.jsp?interfaceLanguage=en)
- Since August 2010: translation of description and claims in all languages supported by Google Translate

## PATENTSCOPE enhancements (2)

### ■ Since May 2011:

- users can customize the PATENTSCOPE search interface allowing them to
  - Save preferred settings, such as the length of the search result list, etc.
  - Save previous searches
  - Download the result lists up to 100 records
- The creation of an account (free of charge) is required

## PCT training options

- PCT Distance learning course (basic) available in the 10 publication languages
- PCT distance learning course for advanced users under preparation
- PCT Webinars
  - providing free updates on developments in PCT procedures
  - upon request also for companies or law firms
- More information on the PCT resources website: [www.wipo.int/pct](http://www.wipo.int/pct)

## Patent Prosecution Highway (PPH) and PCT

- Accelerated examination in the national phase based on the written opinion of the ISA (WO-ISA) or the international preliminary examination report (IPER) when claims were found to be patentable/allowable
- 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
- Trilateral Offices (EP-JP-US) started a two-year pilot program on 29 January 2010
- More information on the respective websites:  
[www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100125b.html](http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100125b.html)  
[www.uspto.gov/patents/init\\_events/pph/index.jsp](http://www.uspto.gov/patents/init_events/pph/index.jsp)  
[www.jpo.go.jp/torikumi\\_e/t\\_torikumi\\_e/pph\\_pct/pct\\_e.htm](http://www.jpo.go.jp/torikumi_e/t_torikumi_e/pph_pct/pct_e.htm)



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## Patent Prosecution Highway (PPH) and PCT

- Further bilateral agreements on accelerated prosecution of PCT applications have recently been concluded
- Information on the PCT Website:  
[http://www.wipo.int/en/filing/pct\\_pph.html](http://www.wipo.int/en/filing/pct_pph.html)
- Information on procedures and forms can be found on the websites of the participating Offices:  
 AT, AU, CA, EP, ES, FI, JP, KR, MX, RU, SE, US
- The IB requests feedback on experience with PCT-PPH at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)



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## PPH MOTTAINAI

- Pilot launched on 15 July 2011 for one year
- Participating Offices: AU, CA, GB, ES, FI, JP, RU, US
- More flexible PPH requirements: applicants can make PPH requests at an Office of Later Examination (OLE) by using the examination results of an Office of Earlier Examination (OEE) provided a PPH MOTTAINAI agreement exists between the two Offices
- The Office of Earlier Examination must not be the Office of First Filing

## PCT Working Group

- Issues under discussion:
  - Implementing the Roadmap
  - Reduction of backlogs
  - Quality of search and examination procedures
  - Observations by third parties
  - Licences

## Implementing the Roadmap (1)

- Quality of PCT search and examination reports
  - Annual ISA and IPEA reports on Quality Management Systems available online ([www.wipo.int/pct/en/quality/authorities.html](http://www.wipo.int/pct/en/quality/authorities.html))
  - Establishment of quality subgroup under MIA, tasked with reporting to next MIA session on
    - effective processes and solutions for quality assurance, and
    - effective quality improvement measures
  - Third party observations
    - Consulting very soon with Offices and user groups
  - Designated/Elected office feedback mechanism to Authorities on quality of PCT search and examination

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## Implementing the Roadmap (2)

- Collaborative search
  - promising results from first pre-pilot between EPO, KIPO and USPTO which shows that collaborative search (of PCT applications) is helpful and improves quality
  - Looking forward to a broader pilot, in numbers of applications and involving also JPO and SIPO
- Timeliness
- Reconsideration of fee structure
- Urging withdrawal of incompatibility notifications
- Urging national phase incentives

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## Implementing the Roadmap (3)

- “WIPO CASE”: technology platform for sharing of search and examination results between offices in place
  - for Vancouver group (AU, CA, GB)
  - for a group of 9 Latin American countries (Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru, Suriname and Uruguay)
  - scalable in order to provide a hub for international sharing of all relevant national, regional and international search and examination reports

## Third party observations (1)

- Consultation circular to be sent soon
- Agenda item for June 2011 WG
- Mainly web-based system — integrated into the PATENTSCOPE database — for indicating prior art relevant to novelty and inventive step, and associated explanations
  - if member states agree, could be expanded to permit observations on clarity and sufficiency of disclosure
- Submission period from publication date until 28 months from priority date

## Third party observations (2)

- All submitted observations made available on PATENTSCOPE
  - third party-uploaded documents not available via PATENTSCOPE but available to IAs/DOs/EOs
- IB will moderate for spam, abuse and copyright infringement
- Applicants notified of observations, and right to respond —responses available on PATENTSCOPE
- IAs/DOs/EOs notified of observations and responses

## Availability for license

- Member states have instructed WIPO to incorporate into the system a means for applicants to indicate in their published applications that the applicant is seeking licensing deals
- It is planned to:
  - allow applicants to so indicate
  - publish this in the application bibliographic data
  - facilitate searchability in PATENTSCOPE on this criterion
- Effectively constituting a register of those applications for which the indication has been made