



**Background Reading  
on the  
Patent Cooperation Treaty (PCT)**

**December 1, 2009**

**THE PCT SYSTEM  
FOR WORLDWIDE FILING  
OF PATENT APPLICATIONS**

*Document prepared by the International Bureau of WIPO*



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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.

## Introduction to the PCT System

### The traditional patent system

1. The traditional patent system requires the filing of individual patent applications for each country for which patent protection is sought, with the exception of the regional patent systems established by international Organizations such as the African Intellectual Property Organization (Organisation africaine de la propriété intellectuelle–OAPI) system, the Harare Protocol system established in the framework of the African Regional Intellectual Property Organization (ARIPO), the Eurasian Patent Organization and the European Patent Organisation. Under the traditional Paris Convention route, the priority of an earlier application can be claimed for applications filed subsequently in foreign countries but such later applications must be filed within 12 months of the filing date of the earlier application. This involves for the applicant the preparation and filing of patent applications for all countries in which he is seeking protection for his invention within one year of the filing of the first application. This means expenses for translation, patent attorneys in the various countries and payment of fees to the patent Offices, all at a time at which the applicant often does not know whether he is likely to obtain a patent or whether there is a market for the invention.

2. Filing patent applications under the traditional system means that every single patent Office with which an application is filed has to carry out a formal examination of every application filed with it. Where patent Offices examine patent applications as to substance, each Office has to make a search to determine the state of the art in the technical field of the invention and has to carry out an examination as to patentability.

3. The principal difference between the traditional national patent system and the regional patent systems such as those mentioned above is that a regional patent is granted by one patent Office for several States. Otherwise, the procedure is the same, and the explanations given in the preceding two paragraphs are equally valid.

### History of the PCT

4. The Executive Committee of the International (Paris) Union for the Protection of Industrial Property invited, in September 1966, BIRPI (the predecessor of WIPO) to undertake a study of solutions to reduce the duplication of the effort both for applicants and national patent Offices. In 1967, a draft of an international treaty was prepared by BIRPI and presented to a Committee of Experts. In the following years, a number of meetings prepared revised drafts and a Diplomatic Conference held in Washington in June 1970 adopted a treaty called the Patent Cooperation Treaty. The Patent Cooperation Treaty or "PCT" entered into force on 24 January 1978, and became operational on 1 June 1978, with an initial 18 Contracting States. At present, more than 140 Contracting States have joined the PCT, a significant increase indicative of interest in the implementation of the Treaty.

5. The filing of international applications under the PCT commenced on 1 June 1978. See the PCT web site at [www.wipo.int/ipstats/en/statistics/pct/](http://www.wipo.int/ipstats/en/statistics/pct/) for statistics in relation to the PCT.

### What is the PCT?

6. As its name suggests, the Patent Cooperation Treaty is an agreement for international cooperation in the field of patents. It is often spoken of as being the most significant advance in international cooperation in this field since the adoption of the Paris Convention itself. It is, however, largely a treaty for rationalization and cooperation with regard to the filing, searching and examination of patent applications and the dissemination of the technical information contained therein. The PCT does not provide for the grant of "international patents": the task of and responsibility for granting patents remains exclusively in the hands of the patent Offices of, or acting for, the countries where protection is sought (the "designated Offices"). The PCT does not compete with but, in fact, complements the Paris Convention. Indeed, it is a special agreement under the Paris Convention open only to States which are also party to the Paris Convention.

## Principal objectives of the PCT

7. The principal objective of the PCT is to simplify and to render more effective and more economical—in the interests of the users of the patent system and the Offices which have responsibility for administering it—the previously established means of applying in several countries for protection for inventions.

8. Before the introduction of the PCT system, virtually the only means by which protection of an invention could be obtained in several countries was to file a separate application in each country; these applications, each being dealt with in isolation, involved repetition of filing and the work of examination in each country. To achieve its objective, the PCT:

- establishes an international system which enables the filing, with a single patent Office (the “receiving Office”), of a single application (the “international application”) in one language having effect in each of the countries party to the PCT (“designated States”);
- provides for the formal examination of the international application by a single patent Office, the receiving Office;
- subjects each international application to an international search and examination which results in a report citing the relevant prior art (mainly published patent documents relating to previous inventions) which may have to be taken into account in deciding whether the invention is patentable and an opinion as to whether the claimed invention meets certain international criteria of patentability; the report and the opinion are made available first to the applicant and the report is later published;
- provides for centralized international publication of international applications with the related international search reports, as well as their communication to the designated Offices; and
- provides the option of an international preliminary examination of the international application which gives to the Offices that have to decide whether or not to grant a patent, and to the applicant, a report containing an opinion as to whether the claimed invention meets certain international criteria for patentability.

9. The procedure described in the preceding paragraph, comparing it with the traditional procedure, is illustrated by timelines which are shown and explained in a subsequent chapter. It is commonly called the “international phase” of the PCT procedure, whereas one speaks of the “national phase” to describe the last part of the patent granting procedure which, as explained above, is the task of the designated Offices.

10. Patent Offices have been struggling for years with heavy work loads (leading to delays) and with questions of how best to allocate resources so as to ensure that the patent system yields the greatest return from the available manpower. Under the PCT system, by the time the international application reaches the designated Office, it has already been examined as to form by the receiving Office, searched by the International Searching Authority and possibly examined by an International Preliminary Examining Authority, thus providing the national patent Offices with the important benefit of reducing their work loads since they have the benefit of these international phase centralized procedures and thus need not duplicate those efforts.

11. Further main objectives of the PCT are to facilitate and accelerate access by industries and other interested sectors to technical information related to inventions and to assist developing countries in gaining access to technology.

## Filing of PCT Applications

### Filing of the International Application; Form and Contents

1. Each Contracting State determines the authorities with which its nationals and residents may, as applicants, file international applications. In the PCT terminology, these authorities are called "receiving Offices" (because they receive international applications). Where there are several applicants, any receiving Office of or acting for a Contracting State of which at least one of the applicants is a resident or national is competent to receive an international application filed by those applicants. Alternatively, at the applicant's option, the international application may be filed with the International Bureau as receiving Office, regardless of the Contracting State of which the applicant is a resident or national. If there are two or more applicants, the international application may be filed with the International Bureau as receiving Office if at least one of the applicants is a resident or national of a Contracting State. Residents or nationals of States which are party to the PCT and also to the ARIPO Harare Protocol, to the Eurasian Patent Convention, to the European Patent Convention or to the Bangui Agreement generally also have the option of filing an international application with the ARIPO Office, the Eurasian Patent Office, the European Patent Office or the OAPI Office, respectively. Compliance with any national security prescriptions applicable under the national law is the applicant's responsibility.
2. The international application must contain a request, a description, one or more claims, one or more drawings (where required) and an abstract; it must comply with the prescribed physical requirements; it must be in one of the prescribed languages; finally, the required fees must be paid. These requirements will be dealt with one by one.
3. The **request** may be made on a printed form, copies of which can be obtained free of charge from the receiving Office or from the International Bureau of WIPO. An editable request form (PCT/RO/101) may be downloaded from the PCT web site at: [www.wipo.int/pct/en/forms/request/ed\\_request.pdf](http://www.wipo.int/pct/en/forms/request/ed_request.pdf). The request may also be presented as a computer printout as prescribed by Section 102(h) of the Administrative Instructions or, alternatively, as a computer printout prepared using the PCT-EASY feature of the PCT-SAFE software, in which case it must be accompanied by a computer diskette containing a copy in electronic form of the data contained in the request and of the abstract. The request may also be presented as part of an international application filed in electronic form with the help of the PCT-SAFE software or any other software accepted for that purpose by the receiving Office.
4. The request must first of all contain a petition, that is, a request that the international application be processed according to the PCT. It must further contain the title of the invention, the necessary data concerning the applicant, the inventor and the agent representing the applicant. The filing of a request constitutes the designation of all Contracting States bound by the PCT on the international filing date for every kind of protection available by way of the designation of those States. Four Contracting States may be excluded from this automatic and all-inclusive designation if the international application contains a priority claim to an earlier national application filed in the same State that is to be excluded. The States concerned are Germany, Japan, the Republic of Korea and the Russian Federation. If the designation of any other Contracting State is not desired, its designation can only be withdrawn either at the time of filing or subsequently.
5. The request may contain optional indications, in particular, a priority claim of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization (WTO) that is not party to that Convention. The request must be signed by the applicant or his agent. If there are two or more applicants, the receiving Office will not invite the applicant to furnish any missing signature if at least one of the applicants has signed the request or, if the request is signed by an agent, a separate power of attorney (Rule 26.2*bis*(a)).
6. The **description** of the invention in the international application must disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

7. The description first repeats the title of the invention. It then specifies the technical field to which the invention relates. It indicates the so-called “background art,” that is, the technical and, in particular, patent literature, pertaining to that technical field, constituting the “prior art” or “state of the art” or known technology for the newly filed application. It discloses the invention in a way which allows the technical problem and its solution to be understood. It states the advantageous effects of the invention, if any, as compared with the known technology. It briefly describes the figures in the drawings. It sets forth the best mode contemplated by the applicant for carrying out the invention and any other mode he wants to include. Finally, it indicates the way in which the invention is capable of exploitation in industry.

8. The claims must define the subject matter of the invention for which protection is sought. They must be clear and concise and fully supported by the description.

9. With respect to the structure and drafting of claims, the PCT requirements are largely similar to what is accepted in most patent Offices.

10. The drawings are only required where they are necessary for the understanding of the invention. This will be the case for a mechanical invention. It will not be the case when an invention cannot be drawn, as is the case for a chemical product. Here again, the requirements are similar to those of most patent Offices.

11. The abstract is only intended to serve the purpose of technical information. The Treaty says clearly that it cannot be taken into account for any other purpose. This means in particular that it cannot be used for the purpose of interpreting the scope of the protection sought.

12. The abstract consists of a concise summary of the disclosure of the invention as contained in the description, claims and drawings in preferably not more than 50 to 150 words. It must be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use of the invention.

13. The international application must comply with the prescribed physical requirements. This means compliance with very detailed provisions, mainly contained in Rules 10 and 11, dealing with form and physical presentation of the international application. These requirements are largely the same as in most countries.

14. The said requirements deal, for instance, with the way in which weights, measures and temperatures are expressed. They prescribe that the presentation of all elements of the application must be such that it allows direct reproduction, for example, by photo offset. The kind of paper and the margins to be used are prescribed. Text matter must be typed or printed. Specific and detailed requirements are made for the physical execution of drawings. Where any name or address is written in characters other than those of the Latin alphabet, it must be transliterated or, in certain cases, may be translated into English.

15. The international application must be filed in the language, or one of the **languages** which the receiving Office accepts for that purpose (Rule 12.1(a)). Neither the Treaty nor the Regulations enumerate the languages in which international applications may be filed. Whether a given language can be used depends on the readiness of the receiving Office to accept international applications in that language. Each receiving Office must, however, accept at least one language for the filing of international applications which is both a language accepted by the International Searching Authority or, if applicable, by at least one International Searching Authority, competent for the international searching of international applications filed with that receiving Office and one of the languages of publication (that is, Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Spanish or Russian), so that applicants always have the option of filing the international application in a language from which no translation would be required for either international search or international publication purposes; in other words, either the international application in its original language or the translation will be sufficient for the processing by the receiving Office, for international search and for international publication.

16. If the language of filing of the international application is accepted by the receiving Office but is not accepted by the International Searching Authority, the applicant is required to furnish, within one month from the date of receipt of the application, a translation into a language which is all of the following: (i) a language accepted by the International Searching Authority that is to carry out the international search; (ii) a language of publication; and (iii) a language accepted by the receiving Office (unless the international application is filed in a language of publication) (Rule 12.3).

17. If the language of filing of the international application is accepted by the receiving Office and the International Searching Authority but is not a language of publication (at present, this is the case only where the international application is filed in Dutch or in certain Nordic languages), the international application will be published in the language of a translation furnished by the applicant and which is accepted by the receiving Office for that purpose (Rule 12.4).

18. The request must always be filed in one of the languages of publication and which is also accepted by the receiving Office for that purpose (Rule 12.1(c)).

19. The required fees must be paid. These are the transmittal fee, the international filing fee and the search fee. They must all be paid to the receiving Office.

20. The transmittal fee is for the benefit of the receiving Office. It is intended to compensate that Office for the work it must perform in connection with the international application. The amount is left to be fixed by the receiving Office.

21. The international filing fee is for the benefit of the International Bureau. It is intended to cover the cost of the work the International Bureau must perform under the PCT. The amount is fixed in the Schedule of Fees which is annexed to the Regulations.

22. The search fee is for the benefit of the International Searching Authority. It is intended to compensate that Authority for the work it must perform in connection with the establishment of the international search report.

23. All required fees must be paid within one month from the date of receipt of the international application; subject to the payment of a surcharge, the time limit to pay the fees can be extended (Rule 16*bis*).

## Functions of the Receiving Office

1. This section deals with the three main procedural steps before the receiving Office.
2. The first procedural step is that the receiving Office receives the international application from the applicant.
3. The second step is that the receiving Office checks the international application to determine whether it meets the prescribed requirements as to form and content of international applications. This check is of a formal nature only and does not go into the substance of the invention. It therefore extends only to a certain number of rather elementary requirements specified in the Treaty as forming part of that check.
4. The check is divided into two parts. The first part concerns the requirements of according an international filing date (Article 11). The second part concerns the formal and physical requirements (Article 14). That check by the receiving Office may show that the international application does not meet certain requirements as to form and content and that the fees are not, or not fully, paid. In that case, the receiving Office communicates with the applicant in order to give him an opportunity to correct any defect.
5. If, possibly after correction, the check by the receiving Office shows that the international application meets the requirements of Article 11(1) for giving the application an international filing date, the receiving Office accords the international filing date.
6. The conditions for according an international filing date are:
  - at least one of the applicants is a resident or national of the Contracting State for which the receiving Office acts, and has consequently the right to file with that receiving Office (note, however, that the international application is to be transmitted to the International Bureau as receiving Office under Rule 19.4(a)(i) if that condition is not fulfilled);
  - the international application is in the language, or one of the languages, accepted by the receiving Office for the purpose of filing international applications (note, however, that the international application is to be transmitted to the International Bureau as receiving Office under Rule 19.4(a)(ii) if that condition is not fulfilled);
  - the international application contains at least the following elements:
    - an indication that it is intended to be an international application,
    - a request which has the effect of making all possible designations under Rule 4.9(a),
    - the name of the applicant in a form allowing the applicant's identity to be established,
    - a part which on the face of it appears to be a description,
    - a part which on the face of it appears to be a claim or claims.
7. If one of these requirements is complied with only after correction under Article 11(2), the international filing date will be the date on which the correction was received. Where the whole description is missing or the application does not contain at least one claim, the applicant will be invited, within a time limit of two months from the date of the invitation,
  - to furnish the correction under Article 11(2), in which case the international filing date will be the date on which the missing element is received, or
  - to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 18, in which case the missing sheets will be included in the application and the international filing date will be the date on which papers were first received.

If not all such defects are properly corrected, the submission will not be treated as an international application.

8. If an applicant who is a resident or national of a PCT Contracting State erroneously files his international application with a national Office which acts as a receiving Office under the Treaty but which is not competent under Rule 19.1 or 19.2, having regard to the applicant's residence and nationality, to receive that international application, or if an applicant files his international application with the competent receiving Office in a language which is not accepted by that Office under Rule 12.1(a) but is in a language accepted under that Rule by the International Bureau as receiving Office, the international application will be considered to have been received by the national Office on behalf of the International Bureau as receiving Office on the date on which it was received by the national Office, and will be promptly transmitted to the International Bureau as receiving Office (unless such transmittal is prevented by national security prescriptions). The transmittal may be subjected by the national Office to the payment of a fee equal to the transmittal fee. All other fees already paid to that Office will be refunded by that Office to the applicant and the applicable fees will have to be paid to the International Bureau as receiving Office.

9. For all the other cases, non-compliance with the formal requirements does not affect the international filing date. In other words, if the applicant corrects a defect in such cases, the international filing date remains unchanged. If the applicant does not correct, or does not properly correct the defect, the international application will, however, be considered withdrawn by the receiving Office. Extension of the time limit fixed by the receiving Office for the correction of defects under Article 14 may be requested.

10. If the language of filing of the international application is accepted by the receiving Office but is not accepted by the International Searching Authority that is to carry out the international search, the applicant is required to furnish, within one month from the filing of the application, a translation into a language which is all of the following: (i) a language accepted by the International Searching Authority that is to carry out the international search; (ii) a language of publication; and (iii) a language accepted by the receiving Office (unless the international application is filed in a language of publication (Rule 12.3)). In cases where the applicant fails to furnish, within the applicable time limit, a translation for the purposes of international search, the receiving Office invites the applicant to furnish the missing translation, in certain cases subject to the payment of a late furnishing fee. A separate invitation procedure is provided for the case where the request does not comply with the applicable language requirements. Where the applicant does not furnish the missing translation within the time limit fixed in the invitation, the international application will, subject to certain safeguards for the applicant, be considered withdrawn and the receiving Office will so declare.

11. If the language of filing of the international application is accepted by the receiving Office and the International Searching Authority that is to carry out the international search but is not a language of publication, the applicant is required to furnish, within 14 months from the priority date, a translation into a language of publication accepted by the receiving Office for that purpose (Rule 12.4). If the applicant fails to furnish, within the applicable time limit, a translation for the purposes of international publication, the receiving Office invites the applicant to furnish the missing translation, in certain cases subject to the payment of a late furnishing fee, within 16 months from the priority date. Where the applicant does not furnish the missing translation within that time limit, the international application will, subject to certain safeguards for the applicant, be considered withdrawn and the receiving Office will so declare.

12. Not all the requirements of the international application must be examined by the receiving Office. For instance, the receiving Office does not deal with substantive questions such as whether the disclosure of the invention in the application is sufficient and whether the requirement of unity of invention is complied with. It also does not check all the many detailed physical requirements of the international application. Those requirements are only checked to the extent that compliance with such requirements is necessary for the purpose of reasonably uniform international publication.

13. Typical examples of defects which may be corrected without affecting the international filing date are:

- non-payment or incomplete payment of fees;
- lack of signature of the request;
- lack of a title of the invention;
- lack of an abstract;
- physical defects.

14. As stated, in all such cases lack of correction leads to the application being considered withdrawn, except where a physical defect would not prevent reasonably uniform international publication. With regard to the payment of fees, Rule 16*bis* provides that the receiving Office must invite the applicant to pay the missing fees together with a late payment fee. If the applicant still does not pay the fees within the time limit fixed in the invitation, the receiving Office will declare that the international application is being considered withdrawn. This solution protects the applicant against any loss of his application due to an erroneously delayed or incomplete payment of fees.

15. The third step in the procedure before the receiving Office is that it must transmit the "record copy" of the international application to the International Bureau and the "search copy" to the International Searching Authority. The receiving Office keeps a third copy, the "home copy." The transmittals do not take place if and as long as national prescriptions concerning national security apply. In such cases, the receiving Office will then declare that national security provisions prevent the international application from being treated as such.

16. The receiving Office must mail the record copy promptly to the International Bureau and in any case not later than five days prior to the expiration of the 13th month from the priority date. In many cases, the international application claims the priority of an earlier national application and is filed at the end of the 12-month priority period. The receiving Office has thus only a few weeks for its processing tasks.

17. The search copy is transmitted by the receiving Office to the International Searching Authority at the time of the transmittal of the record copy to the International Bureau except where the search fee has not been paid on time, in which case the transmittal of the search copy takes place after that fee has been paid.

## International Search and Written Opinion of the ISA

### General

1. This section deals with the procedure before the International Searching Authority. The first question to be considered is which of the several International Searching Authorities listed below is (are) competent:

- the Australian Patent Office,
- the Austrian Patent Office,
- the Canadian Patent Office,
- the China Intellectual Property Office,
- the European Patent Office,
- the Japan Patent Office,
- the Korean Intellectual Property Office,
- the National Board of Patents and Registration (Finland),
- the Nordic Patent Institute,
- the Russian Patent Office,
- the Spanish Patent and Trademark Office,
- the Swedish Patent Office and
- the United States Patent and Trademark Office.

2. The Brazilian Institute of Industrial Property has been appointed as an International Searching Authority and an International Preliminary Examining Authority by the PCT Assembly in October 2007 and will start operating as ISA/IPEA on 7 August 2009.

The Indian Patent Office has been appointed as an International Searching Authority and an International Preliminary Examining Authority by the PCT Assembly in October 2007, but has not started operating as ISA/IPEA yet.

3. Where a national or regional Office acts as receiving Office, that Office specifies in a unilateral declaration to the International Bureau, in accordance with the provisions of the agreement between the International Bureau of WIPO and each of the ISAs, one or more such Authorities for the purpose of searching international applications filed with it. Where the International Bureau acts as receiving Office, the competent ISAs are those which would have been competent had the international application been filed with a competent national or regional Office. Where several Authorities are competent, the applicant must choose one of them.

4. The possibilities for the receiving Offices of specifying ISAs are limited by the readiness of some Authorities to act only for applicants from certain countries. These limitations are spelled out with precision in the agreements referred to above.

### Search Procedure

5. The objective of the international search is to discover what is called “relevant prior art.” According to the PCT definition, “prior art” consists of everything which has been made available to the public anywhere in the world by means of a written disclosure (including drawings and other illustrations). The prior art is “relevant” if it is capable of being of assistance in determining whether the claimed invention is new and involves an inventive step and if it was made available to the public before the international filing date.

6. The documents in which the search is made are constituted by the so-called "PCT minimum documentation." Roughly stated, that documentation comprises the published patent documents issued since 1920 by France, Germany (until 1945) and the Federal Republic of Germany (since 1949), Japan, the Republic of Korea, the former Soviet Union and the Russian Federation, Switzerland (except documents in Italian), the United Kingdom, the United States of America, the African Regional Intellectual Property Organization (ARIPO), the African Intellectual Property Organization (OAPI), the Eurasian Patent Office and the European Patent Office. The documentation includes all international applications published by the International Bureau. It also includes patent documents published in any other country after 1920, in English, French, German or Spanish, provided no priority is claimed and the country places them at the disposal of each ISA. Furthermore, the documentation comprises non-patent literature contained in some 135 technical periodicals.

7. ISAs are obliged to consult not only the PCT minimum documentation, but also any additional documentation at their disposal. For the Authorities other than the Korean Intellectual Property Office, as far as the Korean documents are concerned, Japan Patent Office, as far as the Japanese patent documents are concerned, and other than the Russian Patent Office, as far as patent documents from the former Soviet Union and the Russian Federation and the Eurasian Patent Office are concerned, there is a special exception. For these other Authorities, the said kinds of patent documents are part of the minimum documentation only to the extent that English abstracts are generally available.

8. Where the international application is so unclear that a meaningful search cannot be carried out, the ISA will make a declaration that it will not establish a search report. The same will occur if the subject matter of the invention falls into one of six categories listed in Rule 39 which the ISA may refuse to search. Examples are scientific theories, diagnostic methods and computer programs.

9. The ISA examines whether the application complies with the requirement of unity of invention. This means that the international application must either relate to only one invention or to a group of inventions which are so linked that they form a single general inventive concept.

10. Briefly, if the ISA finds that unity of invention is lacking, it will invite the applicant to pay an additional search fee for each further invention claimed in the international application. The search report will in that case only be established for those inventions for which a search fee or an additional search fee has been paid unless the search examiner is able to make a complete search for all inventions with negligible additional work. No invitation to pay additional search fees should be issued in such a case. The decision not to ask for the payment of additional search fees, however, does not prevent any national office from raising the question of lack of unity of invention and from applying Rule 13 when deciding to grant (or refuse) a patent.

11. The international search report contains the citations of the documents considered to be relevant, the classification of the subject matter of the invention according to the International Patent Classification (IPC) and an indication of the fields searched. The international search report itself does not contain any expression of opinion, argument or explanation (see, however, written opinion of the ISA, below). It identifies the claims to which cited documents are relevant and contains also an indication of the category of the cited document, in particular, whether it is of particular relevance with respect to the novelty or inventive step of the invention.

12. In respect of every international application, the ISA will establish, at the same time that it establishes the international search report, a preliminary and non-binding written opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable, very similar in scope to the written opinion established by the IPEA during international preliminary examination.

13. The relevant date for determining prior art for the purposes of establishing the written opinion is the international filing date or, where priority of an earlier application is claimed, the priority date (Rules 43*bis*.1(b), 64.1). This date is consistent with the date used in international preliminary examination (Rule 64.1) whereas, for the international search report, the international filing date is used (Rule 33.1(a)). The written opinion of the ISA is established in the language in which the international search report is established, and will be communicated to the applicant and to the International Bureau together with the international search report.

14. The ISA must, as a rule, establish the international search report and the written opinion within three months from the receipt of the search copy sent to it by the receiving Office or within nine months from the priority date, whichever expires later.

15. Even though no special provisions are included in the Regulations providing for the applicant to comment on the written opinion of the ISA, in accordance with the decision of the PCT Assembly, applicants may submit comments on an informal basis to the International Bureau. The purpose of such informal comments is to give the applicant an opportunity to rebut the written opinion of the ISA in the event that international preliminary examination is not requested. Any formal response to the written opinion of the ISA must be submitted directly to the IPEA under Article 34 as part of the procedure under Chapter II.

16. If no international preliminary examination report has been or will be established, the written opinion of the ISA will form the basis for the issuance by the International Bureau, on behalf of the ISA, of the international preliminary report on patentability (IPRP) (Chapter I). The IPRP (Chapter I) will be communicated to all designated Offices, together with any informal comments submitted by the applicant. The IPRP (Chapter I) as well as any informal comments thereon submitted by the applicant are made available for public inspection after the expiration of 30 months from the priority date.

17. The ISA transmits copies of the international search report and of the written opinion of the ISA to the applicant and to the International Bureau. Copies of the documents cited in the international search report are enclosed by certain ISAs with the mailing of the report to the applicant. Where this is not the case, the applicant may receive them from the ISA upon request and subject to the payment of a fee.

## Functions of the International Bureau

1. In addition to its function as receiving Office for applicants from all PCT Contracting States, the International Bureau handles processing functions in respect of all international applications filed with all receiving Offices worldwide as detailed below.
2. There are five major processing functions which are carried out by the International Bureau:
  - receipt of the record copy;
  - receipt of amendments to the claims;
  - international publication;
  - communication of the application and international search report to designated Offices; and
  - communication of the international preliminary report on patentability (Chapter I or Chapter II) to designated/elected Offices.
3. Processing by the International Bureau begins when it receives the record copy of the international application from the receiving Office.
4. The International Bureau notifies the applicant, the receiving Office, the International Searching Authority and designated Offices of the receipt of the record copy (Form PCT/IB/301). The International Bureau carries out a further check of the requirements of Articles 11 and 14 (Rules 28.1 and 29.3).
5. The International Bureau is the recipient of any amendment under Article 19 to the claims of the international application. The applicant has the right to amend the claims of the international application under Article 19 after receipt of the international search report. It may be desirable to amend or limit the claims at that stage if the international search report refers to a document which clearly destroys the novelty of part of the claims in the international application. By one amendment sent to the International Bureau, the applicant may amend the claims with effect for all designated Offices. Such amendment must be filed with the International Bureau within the applicable time limit. The amended claims will then be included in the publication of the international application and serve as the basis for any provisional protection offered by designated States.
6. The International Bureau is responsible for the international publication of the international application (Article 21).
7. The International Bureau is also responsible for the communication of the international application to designated Offices (Article 20). This communication is effected on request and at the time requested by designated Offices. The applicant is informed of that communication (Forms PCT/IB/308 (First Notice) and PCT/IB/308 (Second and Supplementary Notice)).
8. The International Bureau uses the international application as published on [www.wipo.int/pctdb/en](http://www.wipo.int/pctdb/en) to effect that communication (Rule 47.2).
9. Under the Chapter I procedure, where no international preliminary examination report has been or is to be established, the International Bureau will issue a report on behalf of the International Searching Authority containing the written opinion of the ISA. This report will bear the title "international preliminary report on patentability (Chapter I)" (Form PCT/IB/373).
10. Under the Chapter II procedure, the International Bureau is responsible for the communication of the international preliminary report on patentability (IPRP) (Chapter II) which is established by the IPEA to elected Offices.
11. Where required, the International Bureau translates the IPRP (either Chapter I or Chapter II) into English and transmits a copy of that translation to the interested designated/elected Offices and to the applicant.

## International Publication

1. The International Bureau is responsible for the international publication of all international applications (Article 21). This publication takes place promptly after the expiration of 18 months from the priority date. Consequently, where the international application claims the priority of an earlier application and is filed towards the end of the priority year, the period between the filing of the international application and the publication of the international application is usually not much longer than six months. Publication may take place earlier at the express request of the applicant.
2. The international publication contains the full text of the international application as filed by the applicant. It includes a title page containing the essential bibliographic data of the international application taken from the request form. The international publication also includes the international search report and any amendments of the claims filed by the applicant under Article 19. The publication of the international application is effected exclusively in electronic form. Published international applications can be searched, viewed, downloaded and printed on WIPO's web site at the following URL: [www.wipo.int/pctdb](http://www.wipo.int/pctdb).
3. The international application is published in the language of filing if that application was filed in one of the languages of publication, that is, in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish.
4. If the international application is filed in a language other than Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish, it is published in one of those languages, which is either the language of a translation furnished by the applicant for the purposes of international search or, where no such translation for the purposes of international search is required, in the language of a translation furnished by the applicant for the purposes of international publication only.
5. Where the international application is not published in English, the English translation of the abstract and the international search report is always also included in the published international application.
6. The legal effect of the international publication depends on the national law of the designated State. Where under a national law "provisional protection" is given to national applications upon publication, the same protection must generally be given to published international applications.
7. The published international application is made publicly available at the following URL: [www.wipo.int/pctdb](http://www.wipo.int/pctdb). Weekly indexes can be generated by publication number, application number, IPC classification and applicant name. Summary information about each published or re-published international application containing bibliographical data, any drawing appearing on the front page of the published international application and the abstract, as well as notices concerning a particular international application can be displayed.
8. The International Bureau is also responsible for the communication of the international application to the designated Offices (Article 20). This communication is effected on request and at the time requested by designated Offices. The applicant is informed of that communication (Forms PCT/IB/308 (First Notice) and PCT/IB/308 (Second and Supplementary Notice)).
9. The International Bureau uses the published international application to effect communication of the international application to the designated Offices (Rule 47.2).

## International Preliminary Examination

1. Chapter II of the PCT provides applicants with the possibility of seeking an international preliminary examination of their international applications. International preliminary examination is an optional feature of the international phase. It gives the applicant the benefit, before entering the national phase, of obtaining an international preliminary examination report, that is, an international preliminary report on patentability (IPRP Chapter II) containing an assessment by an International Preliminary Examining Authority (IPEA) of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable (Article 33(1)).
2. While the IPRP (Chapter II) is not binding for the purposes of national or regional examination, it is increasingly seen by national and regional Offices as highly persuasive, and in some Offices results in a reduced examination fee in the national or regional phase. Moreover, if an applicant's request ("demand") for international preliminary examination is filed prior to 19 months from the priority date, all DOs which are bound by Chapter II must postpone commencement of the national phase as a minimum until 30 months from the priority date unless the applicant requests earlier commencement.
3. The international preliminary examination procedure thus gives the applicant the time and opportunity, before deciding whether to proceed with the national or regional phase and to incur the considerable expenses involved in translations, national fees, and representation by local agents, to assess both the commercial prospects of the invention and the likelihood of success of the application in the national or regional phase. When the international application goes ahead in the national or regional phase, its processing should be simplified by virtue of the results of the international preliminary examination.
4. **Who can make a demand; States bound by Chapter II.** A demand for international preliminary examination can only be submitted if one of the applicants is a national or a resident of one of the Contracting States bound by Chapter II and the international application was filed with the receiving Office of, or acting for a Contracting State bound by Chapter II (Article 31(2)(a), Rule 54). At present, all Contracting States are bound by Chapter II.
5. **The demand.** In the demand for international preliminary examination, the applicant automatically elects all Contracting States designated in the international application. Those States are referred to as "elected States" (Article 31(4)(a)).
6. The demand must be submitted to a competent IPEA. However, if it is erroneously filed with an IPEA which is not competent for carrying out international preliminary examination, or with a receiving Office, an International Searching Authority or the International Bureau, it will be transmitted by that Office or Authority either directly to the competent IPEA, or first to the International Bureau which will in turn transmit it to the competent IPEA, while retaining the original date of filing (Rule 59.3).
7. The demand must be made on a printed or computer generated form (Form PCT/IPEA/401) and must contain certain indications, all of which are clearly identified on the form (see also Rule 53). An editable copy of the demand form can be downloaded from [www.wipo.int/pct/en/forms/](http://www.wipo.int/pct/en/forms/).
8. **Language in which international preliminary examination is to be carried out.** If the language in which the international application was searched or the language in which it was published is not accepted by the IPEA, the applicant will be invited to furnish a translation within one month from the date of the invitation. Where the applicant does not furnish the missing translation within the time limit fixed in the invitation, the demand will be considered not to have been submitted and the IPEA will so declare.
9. **Fees.** In connection with filing the demand, two kinds of fees are due: the preliminary examination fee (Rule 58) which accrues to the IPEA, and the handling fee (Rule 57) which accrues to the International Bureau. Both fees are payable to the IPEA in a currency prescribed by it.
10. Details concerning the completion of the demand form and the payment of fees are contained in the Notes to the Demand and in the Fee Calculation Sheet and the Notes relating thereto which are attached to the demand.

11. **IPEA procedures.** Once the demand has been received by the IPEA, the latter checks whether it complies with the formal requirements and whether the fees have been paid. Where necessary, the applicant is invited to comply with the requirements or to pay any missing fee amount. The IPEA sends the original of the demand, or a copy thereof, to the International Bureau (Rule 61.1(a)), which in turn notifies elected Offices of their election and informs the applicant accordingly (Rules 61.1(b) and 61.2).

12. **Filing amendments and/or arguments.** When filing the demand, or before international preliminary examination starts, the applicant has an opportunity to amend the international application (claims, description and drawings) (Article 34(2)(b) and Rule 66.1). The international preliminary examination will be directed to the description, claims and drawings as contained in the international application at the time when the examination starts, including any amendments made previously and referred to in the statement under Rule 53.9. It is important to note that amendments may not go beyond the disclosure in the international application as filed (Article 34(2)(b)).

It should be noted that if claims are amended under Article 34, the applicant must submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed or previously amended.

13. Since in the majority of cases the written opinion of the ISA should be considered by the IPEA to be its written opinion, namely if the ISA and the IPEA are the same authority, and since most likely the applicant will not receive a “second” written opinion from the IPEA, the applicant should file any amendments under Article 34 and/or any arguments in relation to the written opinion together with the demand.

14. International preliminary examination does not usually start until after an international search report, or a declaration under Article 17, and the written opinion of the ISA have been drawn up (Rule 69.1(a)). Applicants may wait for those documents before deciding whether or not to proceed further with the international application and to demand international preliminary examination. The cost of the examination need not be incurred before it is clear, from the results of the international search report and the written opinion of the ISA, that the invention claimed in the international application is not clearly lacking novelty and inventiveness. Note that international preliminary examination may start earlier, at the request of the applicant where search and examination are done by the same Office and that Office applies the “telescope procedure” (Rule 69.1(b)); in practice, not much use is made of that possibility.

15. **Which claims will be examined?** A further condition for the start of the international preliminary examination is that it must be clear which claims the applicant wants to have examined, noting that there are various possibilities for amendment under the Treaty (Articles 19(1) and 34(2)(b)). Therefore, the demand form provides for a statement by the applicant that identifies the basis on which the international preliminary examination is to be carried out; namely, the description, the claims and the drawings as originally filed, and/or the claims as amended under Article 19, and/or the description, claims and drawings as amended under Article 34 (the latter being usually filed with the demand) (Rule 53.9). If no such statement is contained in the demand, the international preliminary examination will start when the IPEA is in possession of both the demand, either the international search report or the declaration that no international search report has been established (see Article 17(2)(a)) and the written opinion of the ISA.

16. If an applicant, after having filed a demand for international preliminary examination, files amendments to the claims under Article 19 with the International Bureau, he must send a copy of the amendments to the IPEA at the same time (Rule 62.2(a)).

17. **Criteria for international preliminary examination.** In the international preliminary examination, the IPEA provides an opinion as to whether the claims as filed or as amended comply with the three criteria mentioned above – namely, novelty, inventive step (non-obviousness), and industrial applicability – in the sense in which they are defined by the Treaty (Article 33).

18. A claimed invention is novel if it is not anticipated by the prior art (Article 33(2)). The Regulations define what, for the purposes of the international preliminary examination, constitutes “prior art” (Rule 64).

19. A claimed invention is regarded as involving an inventive step if, having regard to the prior art, it is not obvious to a person skilled in the art (Article 33(3)).

20. A claimed invention is regarded as industrially applicable if, according to its nature, it can be made or used in the technological sense in any kind of industry (Article 33(4)).

21. International preliminary examination is not limited to examining the compliance of an international application with these three basic criteria (novelty, inventive step and industrial applicability). The international preliminary examination should also reveal any other defect, such as an amendment that goes beyond the scope of the original disclosure, insufficient disclosure, lack of unity of invention, etc. (see Rule 66.2(a)(i) and (iii) to (v)).

22. In practice, novelty and inventive step are assessed in relation to the documents cited in the international search report and the written opinion of the ISA and in accordance with the PCT International Search and Preliminary Examination Guidelines. The examiner will occasionally, but not normally, cite documents in addition to those mentioned in the international search report and the written opinion of the ISA.

23. It is important to note that any elected Office is free, in the national phase, when determining the patentability of an invention claimed in an international application, to apply the criteria of its national law in respect of prior art and any other conditions of patentability not constituting requirements as to the form or contents of applications (Article 27(5)). The latter are fixed in the PCT and no national law may require compliance with requirements relating to the form or contents that are different from or additional to those provided for in the Treaty and the Regulations (Article 27(1)).

24. **Exclusions from scope of examination.** Certain kinds of subject matters are not required to be the subject of international preliminary examination (Article 34(4)(a)(i)). These are set out in Rule 67. An IPEA may decline to undertake the examination because no meaningful opinion can be formed due to manifest lack of clarity or lack of support for the claims in the description (Article 34(4)(a)(ii)).

25. **Response by applicant.** There may exceptionally be one or more additional written opinions, with an invitation to the applicant to respond, before the international preliminary examination report is drawn up (Rule 66.4 and 66.4*bis*). In that case, the applicant may present further amendments or arguments (Rule 66.3).

26. Informal communications between the IPEA and the applicant are expressly provided for (Rule 66.6). Consistent with the non-binding, preliminary nature of the international preliminary examination, there is no provision for formal review of an examiner's opinion, except on disputed findings of lack of unity of invention (Article 34(3) and Rules 13 and 68.3).

27. International preliminary examination can thus be compared to a regular patent examination in an examining patent office with one exception; namely, in that the time limits set by the examiner for the response are usually much shorter than under the normal examination procedure (Rule 66.2(d)). A prompt reaction is required from the applicant during preliminary examination in order for the international preliminary examination to be completed within the limited time available (Rule 69.2).

28. **The international preliminary report on patentability (Chapter II).** International preliminary examination ends with the drawing up of the IPRP (Chapter II). That report must be drawn up before the expiration of 28 months from the priority date, 6 months from the time provided under Rule 69.1 for the start of the international preliminary examination or 6 months from the date of receipt by the IPEA of the translation furnished under Rule 55.2, whichever time limit expires last (Rule 69.2). The general content of the report is set out in Article 35(2) and (3) and Rule 70.

29. The IPRP (Chapter II) is a non-binding opinion which essentially contains a statement, in relation to each claim, on whether the claim appears to satisfy the criteria of novelty, inventive step and industrial applicability as defined in the PCT. The statement is accompanied by the citation of the documents believed to support that conclusion. Further explanations are given where the circumstances of the case so require. No statement may be made on the question whether the invention would be patentable under the national law of any elected State. If the report is based on the international application in an amended form, a copy of all sheets containing amendments will be annexed to the report.

30. The IPEA transmits the report to the applicant and to the International Bureau (Rule 71). The report is established in the language in which the international application concerned is published or, if the international preliminary examination is carried out on the basis of a translation of the international application, in the language of the translation (Rule 70.17). The International Bureau must then, if necessary, translate the report into English to meet the language requirements of some elected Offices (Article 36(2) and Rule 73) (see also Rule 72). The translation by the International Bureau concerns only the report itself and not any annexes to it. There is no publication of the report and it is not accessible to persons other than the applicant and the elected Offices during the international phase. The transmittal of the IPRP (Chapter II) completes the international procedure under Chapter II.

31. Upon receipt of the report (at the latest, about the 28th month from the priority date (Rule 69.2)), the applicant has until the expiration of 30 months from the priority date (Articles 39 and 40) in which to evaluate it and to decide whether or not to proceed further by entering the national or regional phase before the elected Offices. If a translation of the international application must be furnished to the elected Office upon entry into the national phase, it must usually include a translation of the international application as originally filed, and of the amendments appearing in the annexes to the international preliminary examination report (Rule 74). The translation requirements of the annexes vary somewhat among the elected Offices. The national chapter relating to each elected Office in the PCT Applicant's Guide indicates the applicable requirements.

32. Further details about international preliminary examination. The preceding paragraphs outline the important features of international preliminary examination. The detailed provisions governing the procedures for international preliminary examination are found in Articles 31 to 42 and Rules 53 to 78. The other indispensable tool for understanding international preliminary examination is the PCT Applicant's Guide. Practitioners may also wish, on occasion, to refer to Part 6 of the Administrative Instructions Under the PCT, to the PCT International Search and Preliminary Examination Guidelines, and to the relevant Agreement between the International Bureau and the office or organization concerned in relation to its functioning as an IPEA ([www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.htm](http://www.wipo.int/pct/en/access/isa_ipea_agreements.htm)).

### **Some practical questions relating to international preliminary examination**

33. **Under what circumstances should a demand be filed?** Filing a demand for international preliminary examination should always be considered if the applicant wishes to gain time for those countries where the time limit for entry into the national phase is still 20 months from the priority date in order to better assess the usefulness and necessity of patent protection in various countries for the invention claimed in the international application. If a demand for international preliminary examination is filed prior to the expiration of 19 months from the priority date, the beginning of the national phase is delayed by ten months. This time enables the applicant to learn more about the technical and economic value of the invention.

34. Moreover, filing a demand should always be considered if the applicant is not sure about his chances of obtaining patent protection. References cited in the international search report may cast doubt on the novelty of the invention or on whether it involves an inventive step. The international preliminary examination report affords the applicant useful advice about whether or not it is worthwhile proceeding with the application in the national phase before elected Offices.

35. International preliminary examination should also be considered if, as a result of the international search and the written opinion of the ISA, the international application needs to be amended in order to take into consideration the references cited in those documents. During the international preliminary examination procedure, the applicant has the opportunity to amend the description, claims and drawings of the international application. The critical advice and assistance of the examiner of the IPEA helps the applicant to put the international application in good order, which will be useful during the patent granting procedures in the national phase before the elected Offices. The national patent examination procedure will usually be speeded up and carried out more smoothly and with a greater chance of success.

36. **At what time should a demand for international preliminary examination be filed?** A demand must be filed at the latest within three months from the date of transmittal to the applicant of the international search report and the written opinion of the ISA, or within 22 months from the priority date, whichever period expires later (Rule 54*bis*.1(a)). However, in order to secure the full effect of a demand, namely the postponing of the national phase from 20 to 30 months from the priority date for those countries where the time limit for entry into the national phase is still 20 months, the demand must be submitted before the expiration of 19 months from the priority date.

37. For practical purposes, however, there are two events during the international phase that are decisive in making a decision as to when a demand should best be filed.

38. The international preliminary examination does not start, in general, until the international search report and the written opinion of the ISA are in the possession of the IPEA. Applicants are therefore well advised to wait to receive these documents before filing a demand, since it may reveal prior art that completely destroys novelty or inventive step, so that it would be better to abandon the application without further expense.

39. After receipt of the international search report and the written opinion of the ISA, however, if a demand is to be filed, it should be filed as soon as possible prior to 19 months from the priority date, because the length of time available for international preliminary examination depends on the time at which the demand is filed. The international preliminary examination report must, in general, be drawn up before the expiration of 28 months from the priority date. The effect of this time limit for the drawing up of the report is that the earlier a demand is filed the earlier international preliminary examination can start, and thus the more time will be available for carrying out the examination.

40. **Who has to file and sign the demand?** The demand has to be filed by all applicants named in the international application as applicants for the designated States that are elected in the demand. If there are different applicants for different designated States, then all applicants must be named in the demand. If, however, elections are withdrawn and the only States elected are those for which only some, but not all, applicants indicated in the international application are named as applicants, then only those applicants are to be indicated in the demand.

41. The demand must be signed by all the applicants named in the demand. If the applicants are represented by an agent, the demand may be signed by the agent. In such a case, however, all the applicants named in the demand must have signed a power of attorney. If there is no agent, the demand may be signed by the common representative as defined in Rule 90.2. Nevertheless, if at least one of the applicants has signed the demand or a power of attorney, the IPEA will not invite the applicant to furnish the missing signature (Rule 60.1(a-*ter*)) except for cases of withdrawals (Rule 90*bis*.5(a)).

42. If the applicants have not until this stage been represented by an agent during the international phase, or if they want to be represented before the IPEA by a new or an additional agent, such an appointment may be made in the demand if the demand is signed by all the applicants. If the demand is signed by the new or additional agent named in the demand, a separate power of attorney signed by all the applicants, their original agent or the common representative as defined in Rule 90.2 is required. Except for cases of withdrawals (Rule 90*bis*.5(a)), a power of attorney signed by the deemed common representative could, however, be sufficient.

43. Can the international application be amended before the IPEA? The applicant can amend the claims, the description and the drawings before the international preliminary examination starts. The amendment must be filed with the IPEA. It may not go beyond the disclosure in the international application as filed. So far as the claims are concerned, this provides the second opportunity for amending them before the international preliminary examination starts (the first being by way of amendments submitted to the International Bureau under Article 19, after receipt of the international search report).

44. In practice, most applicants filing a demand for international preliminary examination do not make use of the possibility of amending the claims under Article 19. Where it is clear from the references cited in the international search report and the written opinion of the ISA that the international application requires amendments, applicants furnish their amendments to the IPEA together with the demand.

45. If, exceptionally, a second written opinion is established by the IPEA, the applicant may have additional opportunities to file amendments during the international preliminary examination. The number of opportunities for filing amendments which will be available depends very much on the time available for international preliminary examination. The international preliminary examination report must in general be drawn up not later than 28 months from the priority date. Any amendments filed by the applicant after the examiner has begun to draw up the report can no longer be taken into account.

46. Should the applicant wish to make further amendments (which can no longer be filed during the international phase), they can still be filed with elected Offices on entering the national phase. No elected Office may grant a patent or refuse the grant of a patent before the expiration of the time limit for amending the application for the purposes of the grant procedure in the national phase (Article 41 and Rule 78). Each national chapter of the PCT Applicant's Guide gives details as to when and how amendments may be filed during the national phase.

47. **How are amendments made in practice?** A replacement sheet must be established for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed (Rule 66.8). A letter explaining the difference between the replaced sheet and the replacement sheet must be filed with the amendment (Rule 66.8). Where the amendment results in the cancellation of an entire sheet, this may be communicated in a letter. Any amendment or letter must be in the language in which the international application is published, except where international preliminary examination is carried out on the basis of a translation of the international application, furnished to the IPEA for the purposes of international preliminary examination, in which case any amendment must be in the language of that translation (Rules 55.2 and 66.9).

48. **Can the demand for international preliminary examination, the election of any State or the international application be withdrawn?** The applicant may, at any time prior to the expiration of 30 months from the priority date, withdraw the demand or the election of any State by a notice addressed to the International Bureau (Article 37(1) and (2) and Rule 90*bis*.4). Moreover, the applicant may withdraw the international application at any time prior to the expiration of the 30-month time limit from the priority date. During the Chapter II procedure, such a withdrawal of the international application will in practice have the same effect as the withdrawal of the demand. It is further to be noted that in respect of those States which have notified the International Bureau of the incompatibility of Article 22(1), as in force from April 1, 2002, with their national law and for which a time limit of 20 months to enter the national phase continues to apply, the withdrawal of the demand or the election of a State after the expiration of 20 months from the priority date has the same effect as the withdrawal of the international application in respect of the elected States concerned (Article 37(4)(a)).

49. **Is the file of international preliminary examination confidential?** Neither the International Bureau nor the IPEA may, unless requested or authorized to do so by the applicant, give information on the issuance of an international preliminary examination report or on the withdrawal or non-withdrawal of the demand or of any election, except for communications or access provided to elected Offices (Article 38). Notice of the fact that a demand for international preliminary examination has been filed will be published at [www.wipo.int/pctdb/](http://www.wipo.int/pctdb/) (Rule 61.4).

50. **Access to documents in the file held by the elected Office.** For international applications filed before 1 July 1998, Rule 94 as in force before that date will continue to apply. No document in the file held by the elected Office, other than the international preliminary examination report, will be accessible to third parties without authorization by the applicant. The international preliminary examination report itself is accessible to third parties only if the national law applied by the elected Office so permits.

51. For international applications filed on or after 1 July 1998, Rule 94 as amended with effect from that date will apply. Elected Offices will be entitled to provide access to their files, including any copies of documents from the international preliminary examination file of the IPEA, to the same extent as provided by the national law for access to the files of national applications. This will be particularly the case for, although not restricted to, an elected Office which had itself carried out the international preliminary examination in its capacity as an IPEA.

52. As of 1 January 2004, the International Bureau is entitled to provide access to copies of international preliminary examination reports on patentability (Chapter II) to third parties if so requested by and on behalf of an elected Office (Rule 94.1(c)).

53. **What is the usefulness of an international preliminary examination report in the national phase?** After international preliminary examination, the application will usually be in a much better form and more easily accepted by examiners in the national phase. The international preliminary examination report is only a non-binding opinion expressed on the basis of the PCT definitions of novelty, inventive step and industrial applicability. National differences are very much the exception, however, and experience has shown that the patent grant procedure can usually be carried out much faster and more simply than for a national application not filed through the PCT. If an elected Office was also the IPEA, it will usually grant a patent more promptly on the basis of a favorable international preliminary examination report. For example, when the EPO acts as IPEA, it will not normally deviate from a favorable report during the European regional phase. The Guidelines for Examination of the EPO (Part E, Chapter IX, 6.3.3) state that: "If the international preliminary examination report has been drawn up by the EPO, it is to be regarded as an opinion for purposes of examination, and generally the first communication will only refer to the opinion expressed in the IPEA. Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further prior art documents are to be cited or if evidence is produced of unexpected effects) or where the substantive patentability requirements under the PCT and the EPC are different. Examination reports drawn up by other International Preliminary Examining Authorities must be examined carefully. If the reasons put forward in the international preliminary examination report are sound, they must not be disregarded."

54. The applicant has the opportunity to submit additional amendments or arguments to the elected Office during the course of examination in the national or regional phase, with a view to the eventual allowance of claims which were the subject of adverse comment in the international preliminary examination report.

## Entry into the National Phase

1. The national phase follows the international phase. Before processing and examination may start in the national phase in the designated or elected Offices, the applicant must perform certain acts thereby effecting “entry into the national phase.” If the applicant does not enter the national phase, namely, if he does not perform these acts within the prescribed time limit, the international application loses its effect in the designated or elected States concerned with the same consequences as the withdrawal of any national application in that State (Article 24).

### Basic requirements for entry into the national phase

2. For entry into the national phase before a designated or elected Office, it is necessary that the national fee be paid to it and, where the international application has not been filed or published in the official language, or one of the official languages, of that Office, that a translation into an official language be filed. This must be done within a certain time limit, which is different depending on the circumstances. As a general rule, the time limit for entry into the national phase, both under Chapter I and Chapter II, is at least 30 months from the priority date (Articles 22 and 39). This time limit may be longer under the relevant national law. However, it is important to note that certain States do not yet apply the modified time limit under Article 22(1) as in force from 1 April 2002. Therefore, in those States, the time limit for entry into the national phase under Chapter I is at least 20 months from the priority date (Article 22(1) as in force before 1 April 2002). But, if the applicant files a demand for international preliminary examination, that automatically elects all designated States for international preliminary examination, before the end of 19 months from the priority date, the time limit for entry into the national phase will also be at least 30 months in those States. See the *PCT Applicant's Guide, National Phase*, for further information.

3. The national fees to be paid are usually about the same as the fees required for the filing of a national or regional application. Some Offices, however, levy lower national or regional filing, search or examination fees, or refund certain fees, on account of the existence of the international search report or where an international preliminary examination report has been established. This offsets, at least partly, the costs of filing an international application.

4. Where the original drawings are of a good quality, the applicant is not required to file additional formal drawings with the designated or elected Offices, permitting substantial economies in some cases. It is therefore important to file drawings with the receiving Office that fully comply with the formal requirements of the Regulations under the PCT.

5. Where the priority of an earlier application is claimed and a certified copy of that application has been provided, it is not necessary to submit a certified copy of the priority document to each designated or elected Office. The International Bureau sends any required copies of the priority document to the Offices concerned.

### Additional special requirements

6. Apart from the payment of the national fee and, where necessary, the filing of a translation, no designated or elected Office may require compliance with further requirements within the 20- or 30-month time limit. Certain additional requirements, such as appointment of an agent, indication of an address for service of notifications, declaration of inventor, assignment documents, and the like, are allowed, but the applicant must be given the possibility of complying with those additional requirements after the expiration of the time limits mentioned above.

## **Substantive conditions of patentability**

7. The PCT leaves to each Contracting State freedom to prescribe the substantive conditions of patentability applied in the national phase. This is particularly true of what constitutes “prior art.” However, since the requirements of prior art as defined in the PCT and its Regulations for the purposes of the international phase are generally as strict as, or stricter than, those defined in any national law, there is very little likelihood of unpleasant surprises of this kind occurring in the national phase. On the other hand, the PCT does not prevent any national law from requiring the applicant to furnish, in the national phase, evidence in respect of any substantive condition of patentability prescribed by that law.

## **Correction of translation**

8. Where the translation of the international application contains an error, that error may be rectified by the applicant during the national phase before all designated Offices.

9. The scope of the translation of the inter-national application may not, however, exceed the scope of the international application in its original language. Where, for example, as a result of incorrect translation, the scope of the international application in the language of the translation is narrower than in its original language, the scope may be broadened but must not exceed the original scope. Where the scope of the translation is broader than that of the international application in its original language, the designated Office or any other competent authority of the designated State may limit accordingly the scope of the international application or of a patent resulting from it (Article 46).

## **Amendments in the national phase**

10. The PCT guarantees the applicant the opportunity to amend the description, the claims and the drawings before any designated or elected Office. Thus, in addition to any amendments made in the international phase, further amendments may be filed upon entering the national phase or within a prescribed time limit thereafter.

## **Legal remedies; protection against loss of rights**

11. Where, as a result of a mistake which was not timely corrected, an international application is considered withdrawn, the applicant may request review of that decision by each of the designated Offices. In addition to requesting review, the applicant has the opportunity to submit to each designated Office, a request for the reinstatement of his rights (Rule 49.6). In addition, and in respect of any areas not covered by Rule 49.6, the applicant may request under Article 48 and Rules 82 and 82*bis* for excuse of failure to comply with a time limit. The legal basis of, and the conditions for, such a request are to be found in the applicable national law or regional convention, which apply equally to international applications. Procedural safeguards are thus available in each designated State to PCT applicants at least in the same way as they are to applicants for national or regional applications not made via the PCT.

## Procedural Safeguards for International Applications

### Introduction

1. Several years of experience have shown that the PCT system, after its fundamental revision in 1984 and further improvements made most notably in 1992, 1994, 1998 and 2004, is safe and protects applicants well. The system is now organized in such a way that applicants receive an invitation to correct any defect or to pay any missing amount of fees within a certain time limit which is set in the invitation. Time limits for the correction of defects can be extended. Mistakes or omissions can be corrected without affecting the application or its international filing date, as long as the minimum conditions for according an international filing date under Article 11(1) have been met. Therefore, mistakes or omissions usually have no disastrous consequences. Because they can be corrected, it is extremely rare that an international application is considered withdrawn for non-compliance with PCT requirements. However, even in those few cases, there are adequate remedies. The main features of the PCT that constitute procedural safeguards are described in the following outline of what can be done in the case of a mistake or omission or in the case of failure to meet a time limit. A few other features that are of interest for applicants in certain circumstances are also explained, although they are procedural safeguards only in a broader sense, such as filing by facsimile machine or the possibility for withdrawal of an international application in order to prevent its publication.

### Transmittal of international applications to International Bureau by receiving Office in certain cases

2. If an international application is filed with an Office which acts as a receiving Office under the PCT but:

- that Office is not competent as receiving Office because of the nationality and residence of the applicant, or
- the international application is filed in a language which is not accepted by that Office but is in a language accepted for the filing of international applications by the International Bureau as receiving Office,

Rule 19.4 provides that that Office will transmit the application to the International Bureau as competent receiving Office provided that any applicable national security requirements are met, and a fee, equal to the transmittal fee, is paid where prescribed (not all Offices require such payment). The international filing date will be the date of receipt by the Office which is not competent to receive that application or which does not accept international applications in the language in which that application was filed, as the case may be, provided that the minimum requirements for according an international filing date are met. The international application will also be transmitted to the International Bureau as receiving Office, for any other reason than those mentioned above, where the receiving Office with which the international application was filed and the International Bureau agree, and with the authorization of the applicant, that the procedure under Rule 19.4 should apply.

3. All PCT filing fees will be payable to the International Bureau (in Euros, Swiss Francs or US Dollars). Any fees paid to the non-competent Office, other than a fee equal to the transmittal fee (where required), will be refunded by that Office.

### Priority claims and furnishing of priority documents (Rules 17 and 26bis)

4. The Regulations facilitate the correction of mistakes in priority claims. Broadly, they permit applicants, by a notice submitted to the receiving Office or the International Bureau, to add or correct any priority claim until 16 months from the priority date (that is, not later than 16 months from the earliest priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever expires first), provided that a notice effecting a correction or addition may, in any case, be submitted until the expiration of four months from the international filing date. Furthermore, the receiving Office or the International Bureau will invite the applicant to correct any priority claim not complying with the formal requirements set out in the Regulations.

5. If the international application is filed after the expiration of 12 months from the filing date of the earliest application of which priority is claimed, but within two months from the expiration of the priority period, the receiving Office or the International Bureau will invite the applicant to either correct the priority claim (see previous paragraph) or request restoration of the priority right under Rule 26*bis*.3(a). The time limit for such a request is two months from the date on which the priority period expired. However, if early publication under Article 21(2)(b) is requested, a request for restoration must be submitted before technical preparations for publication are completed. The rule on restoration of the priority right does not apply to Offices which notified the International Bureau that this procedure is not compatible with their national law. For a list of those Offices, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html) (Rule 26*bis*.3(j)).

6. The Regulations require the furnishing of a priority document, regardless of whether the earlier application the priority of which is claimed was a national, regional or international application, within 16 months from the (earliest) priority date. However, where the priority document is received by the International Bureau after the expiration of that 16-month time limit, if it reaches the International Bureau before the date of international publication, the document will be considered to have been received on the last day of that time limit.

7. The Regulations also give applicants the assurance that designated States will not disregard a priority claim where a priority document was not furnished within the applicable time limit during the international phase by providing that no designated Office may disregard a priority claim without first giving the applicant the opportunity to furnish the priority document, within a reasonable time limit, to the designated Office in the national phase.

### **Inclusion of later submitted sheets in the international application**

8. When sheets are missing in the application at the time of filing, it is possible to file those sheets within a time limit of two months from the international filing date or from the date of the invitation to correct by the receiving Office. Later submitted sheets will generally result in the date of receipt of those further sheets being accorded as the international filing date, unless the applicant is able to include the later submitted sheets by way of incorporation by reference under Rule 20.6. This is only possible if the missing sheets were completely contained in the earlier application of which priority is claimed and some further conditions are fulfilled. The rules on incorporation by reference do not apply to Offices which notified the International Bureau that this procedure is not compatible with their national law. For a list of those Offices, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html) (Rule 20.8(a)).

### **Rectification of obvious mistakes**

9. Under Rule 91, obvious mistakes in the international application and other documents, including mistakes that are not due to wrong transcription, may be rectified. Any such rectification is carried out free of charge. A mistake is obvious if it is due to something other than what was obviously intended being written in the international application or other paper. The rectification itself must be obvious in the sense that the competent Authority would immediately realize that nothing other than what is offered as rectification could have been intended. However, omissions of entire elements or sheets of the international application are not rectifiable, even if clearly resulting from inattention, for instance, at the stage of copying or assembling.

10. If an international authority, i.e., the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be an obvious mistake, it invites the applicant to present a request for rectification. Certain kinds of mistakes made by the applicant in the request are even corrected by the receiving Office *ex officio*. In such a case, the applicant is not formally invited to make the correction by the receiving Office; the Office merely informs him of the correction by sending him either a photocopy of the corrected sheet of the request or a notification about the correction. Such *ex officio* corrections are made where the request contains an inconsistency or a minor defect such as non-compliance with the provisions on the indication of names or addresses or names of States, etc.

11. A request for rectification by the applicant requires the express authorization:

- of the receiving Office, if the mistake is in the request or in any paper submitted to that Authority,

- of the International Searching Authority, if the mistake is in the description, claims or drawings or in a correction thereof, or in any paper submitted to that Authority,
- of the International Preliminary Examining Authority if the mistake is in the description, claims or drawings or in a correction thereof, in an amendment under Article 19 or 34, or in any paper submitted to that Authority,
- of the International Bureau if the mistake is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

12. A request for rectification must be made in writing and must be addressed to the authority which is competent to authorize it before the expiration of 26 months from the priority date. The request for rectification must be accompanied by a replacement sheet embodying the rectification, unless the rectification is in the request and is of such a nature that it can be readily transferred from the letter to the record copy without adversely affecting the clarity and the direct reproducibility of the sheet on to which the correction is to be transferred. It is recommended that, where a replacement sheet is filed, an explanation be given in the accompanying letter of the exact differences between the replaced sheet and the replacement sheet (Rules 91.2 and 26.4).

13. If the International Bureau receives an authorization of a request for rectification after completion of technical preparations for publication, a statement reflecting all the rectifications together with the sheets containing the rectification or the replacement sheets and the letter furnished under Rule 91.2 will be published together with a revised front page (Rule 48.2(i)). If a competent Authority refuses to authorize a rectification, the applicant may, within two months from the date of the refusal and against the payment of a fee, request the International Bureau to publish the refused request for rectification, the reasons for refusal and any brief comments by the applicant (Rule 91.3(d)).

14. Such publication of a request for rectification ensures that third parties reading the published international application are warned that there may be changes in the national phase, because applicants have the possibility of entering the national phase and of pursuing the request for rectification further before the designated Offices.

15. It will be recalled that the international application has the effect of a regular national application. Therefore, national provisions on rectification of mistakes apply also to an international application to the extent that it has effect in a designated State. A designated Office may disregard the rectification of an obvious mistake during the international phase if it finds that it would not have authorized the rectification under Rule 91.1 if it had been the competent Authority. It may only do so after having informed the applicant of the Office's intention and after having given the applicant the opportunity to make observations within a time limit reasonable under the circumstances. If provisions are applicable in a designated Office that would allow a rectification that could not be allowed under the provisions of the PCT, applicants may obtain authorization for a rectification in the national phase. Such provisions may exclude the rectification of certain mistakes after publication if third parties could be affected. The PCT therefore provides for the procedure of publication under Rules 48.2(i) and 91.3(d).

### **Late or insufficient payment of fees under Chapter I**

16. With regard to the payment of fees to the receiving Office, that is, the international filing fee, the transmittal fee and the search fee, there is a grace period provided for in Rule 16*bis*. If an applicant fails to pay all or part of the fees within the prescribed time limit, the receiving Office invites the applicant to pay to it any amount that was due but not paid within the prescribed time limit, together with a late payment fee, within a time limit of one month. As an additional safeguard for applicants, the Regulations provide that any payment received by the receiving Office before that Office has sent out the invitation to the applicant is considered to have been received before the expiration of the prescribed time limit.

17. If the amounts specified in the invitation are paid within that time limit, the international application will proceed. Otherwise, the receiving Office proceeds as provided under Article 14(3), namely, it declares that the international application is considered withdrawn. As an additional safeguard for applicants, the Regulations provide that any payment received by the receiving Office before that Office makes that declaration is considered to have been received before the expiration of the time limit specified in the invitation.

### **Extension of time limits by the receiving Office**

18. Where the international application contains a defect that requires correction, the receiving Office notifies the applicant of the defect and invites him to file a correction within a time limit set in the invitation (Article 14(1) and Rule 26). The time limit set in the invitation is two months from the date of the invitation.

19. The receiving Office may extend the time limit at any time before a decision is made concerning the timely and proper correction of the defect (Rule 26.2). When granting an extension of a time limit, the receiving Office takes into account the fact that corrections that may be relevant for the international search are needed by the International Searching Authority, and that all corrections must reach the International Bureau before the completion of technical preparations for international publication.

20. Extensions of time limits must be requested from the receiving Office and are normally granted if the circumstances referred to in the preceding paragraph permit the requested extension.

21. The receiving Office extends a time limit *ex officio* if it receives the correction of a defect after the expiration of a time limit but before it takes a decision on whether the defect has been properly corrected. Therefore, failure to meet a time limit by a day or two will normally be excused. Once that decision has been taken, however, no further extension will be granted. Where the international application has been considered withdrawn, the applicant may request the designated Offices to excuse the failure to meet the time limit for correction of defects, as explained in further details below.

22. It is important to note that the time limit of one month for the late payment of fees under Rule 16*bis* cannot be extended by the receiving Office.

### **Withdrawal of the international application to prevent its publication**

23. Where the applicant, for whatever reason, wants to withdraw the application in order to prevent its international publication, he can do so by means of a notice of withdrawal which must reach the International Bureau before the completion of the technical preparations for international publication, i.e., in general, not later than 15 days before the date of publication (see Rule 90*bis*.1(c)). This is a distinct advantage of the PCT since, at most national Offices, an application must be withdrawn at a much earlier date for its publication to be prevented. Furthermore, it is possible under the PCT to make the withdrawal on condition that the publication of the international application will not take place. Then the withdrawal of the international application will not be effective if the notice of withdrawal reaches the International Bureau only after the completion of the technical preparations for international publication. Thus the undesirable result of an application being withdrawn but nevertheless published is avoided.

### **Withdrawal of the priority claim to postpone international publication**

24. Where the applicant wants to postpone the international publication of the international application, he can do so by withdrawing the (earliest) priority claim, within the time limit indicated in the preceding paragraph. If the withdrawal reaches the International Bureau before the completion of the technical preparations for international publication, the 18-month time limit for that publication will be computed anew from the new priority date of the international application, that is, either the international filing date or the filing date of another earlier application the priority of which was claimed but not withdrawn.

### **Filing by facsimile machine or other means of rapid communication in order to meet time limits**

25. The PCT Applicant's Guide, General Information (Annexes B1 and B2), indicate, for each national Office or intergovernmental organization, whether it is prepared to receive all or certain kinds of documents by facsimile machine or other means of communication. To the extent that an Office is willing to receive documents by any such means, and most of them are, applicants can take advantage of the possibilities outlined below.

26. The above telecommunication means may be used by applicants for the filing of an international application. If the papers filed by facsimile machine fulfill the conditions for an international filing date to be accorded under Article 11(1), the receiving Office accords that international filing date and invites the applicant, under Article 14, to furnish the application documents in a manner that complies with the formality requirements under Rule 11. If the applicant furnishes papers complying with those requirements within the time limit set in the invitation, the international application will be perfectly in order.

27. Regarding papers sent by telecommunication means, it is important to note that any Office accepting such communication may require a confirmation within 14 days by the sending of the original papers. The originals must themselves comply with the usual formal requirements as set out in Rule 11 and must be accompanied by a signed letter identifying the international application to which they relate (see Rule 92.1(a)). Details on the requirements of each Office as to the circumstances in which originals must be furnished are given in the *PCT Applicant's Guide*, General Information (Annexes B1 and B2).

### **Delays in the mail service**

28. The PCT distinguishes between, on the one hand, delays in receipt by the applicant of documents or letters sent from a national Office or an intergovernmental organization (Rule 80.6), and, on the other hand, delays in the mailing of a document or letter from the applicant to a national Office or intergovernmental organization (Rule 82).

29. With respect to mail addressed to the applicant sent from a national Office or intergovernmental organization (Rule 80.6), it is assumed that the letter was mailed on the date it bears, and that the delivery time will not exceed seven days from that date.

30. Periods that start from the date of mailing of a document or letter will automatically be extended by any number of days that may have elapsed, in addition to the seven days after the date that it bears, before it was actually received; for instance, if a letter was received ten days after the date of mailing, this will cause the period to be extended by three days ( $10-7=3$ ).

31. An applicant who wants to claim an extension of a period because of late receipt of mail must offer evidence to the satisfaction of the Office concerned that the document or letter was received more than seven days after the date it bears. The period will then be treated as starting on the proven later date, which means that the date on which the period starts is the date of actual receipt minus seven days.

32. The receipt of a letter from the applicant after the expiration of a time limit will be excused if it is proven to the satisfaction of the Office or intergovernmental organization to which the letter was addressed that the mailing was effected by airmail not later than five days prior to the expiration of the time limit and was registered by the postal authorities. Surface mail is sufficient if the letter is mailed in a place where it normally arrives at its destination within two days of mailing (Rule 82.1). Some Offices accept evidence also if mailing was made by a delivery service other than the postal authorities (for details see the *PCT Applicant's Guide*, General Information (Annexes B1 and B2)).

33. If, owing to an interruption of the postal services, on account of a strike or for other reasons, it has not been possible to mail a letter, any interested party may offer evidence that such a situation existed on any of the ten days preceding the expiration of a time limit. If such circumstances are proven to the satisfaction of the Office concerned that is the addressee, the delay in arrival is excused provided that the mailing was effected not later than five days after the mail service was resumed (Rule 82.2).

### **Monitoring of the transmittal of the record copy to the International Bureau**

34. The PCT provides that the receiving Office must, within a certain time limit, transmit the record copy of the international application to the International Bureau. If the record copy does not reach the International Bureau within the prescribed time limit, the international application is considered withdrawn. Specific procedural safeguards have been introduced in order to avoid any risk of applicants losing an international application owing to late receipt of a record copy by the International Bureau.

35. The International Bureau monitors the receipt of the record copy and, if it has not been received within 13 months from the priority date, urges the receiving Office to transmit it. If, one month later, the record copy still has not been received, the International Bureau notifies the applicant of that fact. The applicant can then ask the receiving Office either to transmit the record copy or to issue a certified copy of the international application which he can himself transmit to the International Bureau. The notification by the International Bureau sets a time limit of three months for that purpose. It is only after the expiration of that time limit that the International Bureau may make the finding that no record copy has been received within the prescribed time limit. Thus the loss of the international application owing to non-transmittal or late transmittal of the record copy cannot occur without the applicant having been warned and offered the possibility of taking care of the transmittal of the record copy himself (Rule 22.1).

### **Transmittal of demand to competent International Preliminary Examining Authority**

36. The Regulations provide for a safeguard in respect of the filing of the demand similar to the safeguard in respect of the filing of the international application with a "non-competent" receiving Office. Where the applicant erroneously submits the demand to a receiving Office, an International Searching Authority, a non-competent International Preliminary Examining Authority or the International Bureau, that Office or Authority will either forward it to the International Bureau, which will in turn transmit it to the competent International Preliminary Examining Authority, or transmit it directly to the competent International Preliminary Examining Authority. Any demand so transmitted to the competent International Preliminary Examining Authority is considered to have been received on behalf of that Authority on the date on which it was received by the receiving Office, the International Searching Authority, the non-competent International Preliminary Examining Authority or the International Bureau (Rule 59.3).

### **Election of designated States for international preliminary examination**

37. Only States which have been designated in the international application and which are bound by Chapter II of the PCT can be elected in a demand for international preliminary examination. They are the "eligible" States. According to Rule 53.7, the filing of a demand constitutes the election of all eligible States.

### **Extension of time limits by the International Preliminary Examining Authority**

38. Where the demand for international preliminary examination contains a defect that requires correction, the International Preliminary Examining Authority notifies the applicant of the defect and invites him to file a correction within a time limit fixed in the invitation (Rule 60.1). That time limit should be reasonable and must not be less than one month.

39. The International Preliminary Examining Authority may extend the time limit at any time before a decision is taken concerning the timely and proper correction of the defect (Rule 60.1(a)).

### **Late or insufficient payment of fees under Chapter II**

40. With regard to the payment of fees to the International Preliminary Examining Authority, that is, the preliminary examination fee and the handling fee, there is a grace period provided for in Rule 58*bis*. If an applicant fails to pay all or part of the fees due within the prescribed time limit, the International Preliminary Examining Authority invites the applicant to pay to it the missing amount, together with, where applicable, a late payment fee, within a time limit of one month from the date of the invitation. As an additional safeguard for applicants, the Regulations provide that any payment received by the International Preliminary Examining Authority before that Authority sends out the invitation is considered to have been received before the expiration of the prescribed time limit.

41. If the amounts specified in the invitation are paid within the time limit fixed in the invitation, the demand will proceed. Otherwise, the International Preliminary Examining Authority proceeds as provided under Rule 58*bis*.1(b), namely, it declares that the demand is considered not to have been submitted. As an additional safeguard for applicants, the Regulations provide that any payment received by the International Preliminary Examining Authority before that Authority makes that declaration is considered to have been received before the expiration of the time limit specified in the invitation.

## Withdrawal of priority claim to postpone entry into national phase

42. Where the applicant, for whatever reason, wants to postpone the entry into the national phase, he can do so by withdrawing the priority claim if the international application claims the priority of an earlier application. Such withdrawal must be made prior to the expiration of 30 months from the priority date.

43. The notice of withdrawal of the priority claim must reach the receiving Office, the International Bureau or, where Article 39(1)(a) applies, the International Preliminary Examining Authority before the expiration of the said time limits. The effect of the withdrawal is that the time limit for entry into the national phase will be computed from the priority date resulting from the withdrawal (Rule 90*bis*.3). The withdrawal has no effect where the 30-month time limit has already expired. In the latter case remains only the possibility to request the designated or elected Office, according to the national law, where applicable, to excuse the failure to meet the time limit. See below for further details.

## Review by the designated or elected Offices

44. The PCT provides, in its Article 25, for review by the designated Offices of the following decisions that may be made during the international phase and may affect the international filing date or the international application as such:

- the refusal by the receiving Office to accord an international filing date to the international application because it contains an Article 11 defect;
- the declaration by the receiving Office that the international application is considered withdrawn (for example, because of non-payment of the prescribed fees);
- the finding by the International Bureau that the international application is considered withdrawn because that Bureau has not received the record copy within the prescribed time limit.

45. A review by the designated Offices must be requested within two months of the date of the notification of the decision to be reviewed (Rule 51.1). The International Bureau must be requested to send copies of the relevant papers in the file of the international application to the designated Offices concerned (Article 25(1)(b)). In addition, the applicant must, independently of the request addressed to the International Bureau, provide within the same two-month time limit each designated Office concerned with the facts and evidence that reveal an error or omission on the part of the receiving Office or the International Bureau, as the case may be. Also within the same time limit, the applicant must enter the national phase by paying the national fee and furnishing a translation of the international application, where required, to the same designated Offices.

46. The review by the designated Office consists of an examination to ascertain whether the receiving Office's refusal or declaration or the International Bureau's finding was the result of an error or omission on the part of the authority concerned. The designated Office makes a finding on whether the decision at issue was justified and, if it finds that it was the result of an error or omission on the part of the receiving Office or the International Bureau, it treats the international application as if that error or omission had not occurred and it maintains the effect of the international application as a regular national application as of the international filing date. If it finds that the decision at issue was not the result of an error or omission, it may nevertheless and in the light of the circumstances of a given case exercise its discretion and maintain the effect of the international application under Article 24(2). In some cases, the designated Offices are even obliged to maintain the effect of the international application even though the decision of the receiving Office or the finding by the International Bureau proved to be correct. That happens where the designated Office must, under the applicable law, excuse the delay in meeting the time limit which led to the declaration that the international application was considered withdrawn (for details, see below).

47. The designated Office will also review (under Rule 82*ter*.1) errors made by the receiving Office or by the International Bureau in according the international filing date or in considering a priority claim not to have been made. If the error is an error such that, had it been made by the designated Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error.

## Excusing of delays by the designated or elected Offices

48. For Rule 49.6, see the relevant pages in the chapter on national phase entry.

49. Article 48(2) provides that any Contracting State must, as far as it is concerned, and for reasons admitted under its national law, excuse any delay in meeting any time limit. It provides also that that Contracting State may, for reasons other than those admitted under its national law, excuse any delay in meeting any time limit. Rule 82*bis* clarifies that the reference to “any time limit” in Article 48(2) includes:

- any time limit fixed in the PCT or the Regulations under the PCT;
- any time limit fixed by the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau;
- any time limit to be applied by the receiving Office under its national law; and
- any time limit fixed by or in the national law to be applied by the designated or elected Office for the performance of any act by the applicant before that Office.

50. Rule 82*bis* makes it clear furthermore that the provisions of the national law to which the excusing by the Contracting State of any delay in meeting any time limit applies are those that relate to:

- reinstatement of rights,
- restoration,
- *restitutio in integrum*, or
- further processing in spite of non-compliance with the time limit, and
- any other provision providing for the extension of time limits or for excusing delays in meeting time limits.

51. These provisions in the PCT are the applicant’s guarantee that all provisions existing under national law and practice that permit the excusing of a delay in meeting a time limit must be applied to an international application by the designated or elected Office. The time limits concerned are those that expire during the international phase and those within which the applicant must perform certain acts for the national phase, such as the payment of the national fee and the furnishing of a translation. A great majority of the designated or elected Offices excuse delays in meeting time limits in one way or another. Details can be found in the national chapter relating to each designated or elected Office published in the *PCT Applicant’s Guide*.

52. It follows from what has been said above that the PCT applicant may take advantage of the same excuse provisions as the applicant who files direct with a certain Office. The PCT applicant benefits, in the same way as an applicant who files direct with the national Office, from all excuse provisions applicable under the national law.

53. The excusing of a delay must be requested at each of the designated Offices, under the conditions laid down by the national law and within the time limits provided by the national law for such requests. Those time limits are normally met if the request for the excusing of the delay is filed within the two-month time limit for requesting a review under Article 25 (Rule 51.1). Naturally the applicant must, within the same time limit, comply with the requirements for entry into the national phase as well as the requirement that he failed to comply with in the first place.

54. If the delay is not excused by the designated Office, there usually remains the possibility to file a petition or an appeal against the decision of the Office. The legal remedies which are available under the national law against such decision apply equally to PCT applications.