

## TABLE OF CONTENTS

<b>PCT APPLICANT'S GUIDE—NATIONAL PHASE</b>	<b>Paragraphs</b>
CHAPTER 1: HOW TO USE THE NATIONAL PHASE OF THE PCT <i>APPLICANT'S GUIDE</i> .....	1.001 – 1.006
CHAPTER 2: ENTRY INTO THE NATIONAL PHASE (GENERAL) .....	2.001 – 2.006
CHAPTER 3: TIME LIMIT FOR ENTERING THE NATIONAL PHASE .....	3.001 – 3.004
General .....	3.001 – 3.003
Request for Earlier Start of the National Phase .....	3.004
CHAPTER 4: ACTS TO BE PERFORMED FOR ENTRY INTO THE NATIONAL PHASE .....	4.001 – 4.032
General .....	4.001 – 4.004
National Fees .....	4.005 – 4.007
Translation of the International Application .....	4.008 – 4.026
Copy of the International Application .....	4.027 – 4.028
Choice of Certain Kinds of Protection .....	4.029
Naming of Inventor .....	4.030 – 4.031
Use of National Forms .....	4.032
CHAPTER 5: SPECIAL REQUIREMENTS TO BE COMPLIED WITH IN CONNECTION WITH THE NATIONAL PHASE .....	5.001 – 5.010
General .....	5.001 – 5.002
Certain Declarations Concerning the Inventor, Assignments, etc. ....	5.003 – 5.005
Representation .....	5.006 – 5.008
Priority Document: Copy and Translation .....	5.009 – 5.010
CHAPTER 6: MISCELLANEOUS QUESTIONS CONCERNING THE NATIONAL PHASE .....	6.001 – 6.033
Substantive Conditions of Patentability .....	6.001
Correction of Translation .....	6.002 – 6.003
Restoration of the Right of Priority .....	6.004 – 6.011
Incorporation by Reference of Missing or Correct Elements or Parts ..	6.012
Amendment of the International Application for the National Phase ..	6.013 – 6.017
Review in the National Phase of Certain Decisions Made During the International Phase .....	6.018 – 6.021
Excusing of Delays in Meeting Time Limits .....	6.022 – 6.027
Rectification of Errors Made by the Receiving Office or by the International Bureau .....	6.028 – 6.029
Acts to Be Performed During the National Phase .....	6.030
Correspondence with and Payments to Designated Offices .....	6.031
Deposit of Biological Material .....	6.032
Furnishing of a Nucleotide and/or Amino Acid Sequence Listing .....	6.033
Request for Accelerated Examination Procedure .....	6.034

## **NATIONAL CHAPTERS**

## CHAPTER 1: HOW TO USE THE NATIONAL PHASE OF THE PCT APPLICANT'S GUIDE

### 1.001

This part of the PCT Applicant's Guide (the Guide) contains information on the "national phase" of the PCT procedure, namely the procedure before the designated (or elected) Offices. It follows on from information on the "international phase" of the PCT procedure.

### 1.002

This part consists of two elements. First, this text which explains in detail what must be done by the applicant in connection with entry into the national phase.

### 1.003

Following this are National Chapters relating to all designated (or elected) Offices. Each National Chapter is structured as follows:

- (i) Summary of requirements for entry into the national phase - containing a listing of the specific requirements of each designated (or elected) Office which must be complied with in connection with entry into the national phase as outlined below;
- (ii) The procedure in the national phase - containing an outline of the main procedural steps before the Office concerned once the national phase has started, further details relating to certain particular requirements referred to in the Summary and information about the fees that must be paid and national forms that may or must be used by the applicant in connection with entry into the national phase or during the national phase;
- (iii) Annexes - containing a schedule of the fees referred to in the National Chapter, an explanation on how payment of fees can be made to the Office and samples or models of forms for use by the applicant in the national phase (photocopies of those forms are accepted by the Offices concerned).

### 1.004

In the text of the Guide, "Article" refers to Articles of the PCT, "Rule" refers to the PCT Regulations and "Section" refers to the PCT Administrative Instructions. Any use of those expressions in the text of the National Chapters is followed by an indication of whether they relate to the PCT or to national legislation. References to a "paragraph" relate, unless otherwise specified, to the text of the National Phase.

### 1.005

The Office that is competent for each PCT Contracting State which may be designated (or elected) is usually the national Office of the State concerned. For States party to the ARIPO Harare Protocol, the Eurasian Patent Convention or the European Patent Convention, the national phase procedure takes place before the national Office and/or the regional Office concerned (the ARIPO Office, the Eurasian Patent Office or the European Patent Office, respectively), depending on the kind of designations (for national protection and/or for a regional patent) which were made. (As to regional patent systems, refer to International Phase, paragraphs 4.022 to 4.026). For certain States party to the ARIPO Harare Protocol or the European Patent Convention which have "closed the national route," the national phase takes place exclusively before the ARIPO Office or the European Patent Office, respectively (refer to paragraph 2.002 of this part). Where the national law of a PCT Contracting State provides for patent protection through the extension of a European patent, the national phase takes place, in effect, before the European Patent Office (refer to International Phase, paragraph 5.054). For all States party to the OAPI Agreement the national phase takes place exclusively before the OAPI Office (refer to International Phase, paragraphs 4.022 to 4.026 and paragraph 2.002 below). Annexes B contain information as to the competent designated Offices for each Contracting State.

### 1.006

The draft of each Chapter dealing with an Office (national or regional) in its capacity as designated (and elected) Office has been approved by that Office. Naturally, the Chapters still may not deal with all the questions that could emerge. Moreover, practices and rules may change, and in any case, the only authentic sources are the laws, rules and regulations. While any correction, completion or updating will be effected as soon as possible, applicants are nevertheless advised to use the services of local patent attorneys or patent agents, whose expert knowledge and experience cannot be replaced by any written text.

## CHAPTER 2: ENTRY INTO THE NATIONAL PHASE (GENERAL)

### 2.001. What is the national phase?

Article 11(3), Article 23, Article 40

The national phase is the second of the two main phases of the PCT procedure. It follows the international phase and consists in the processing of the international application before each Office of or acting for a Contracting State that has been designated in the international application (refer to International Phase). In each designated State the international application has the effect of a national (or regional) application as from the international filing date, and the decision to grant protection for the invention is the task of the Office of or acting for that State (the “designated Office”). The national phase of processing the international application by the designated Office is generally delayed until the termination of the international phase on the expiration of the time limits indicated in paragraphs 3.001 and 3.002.

### 2.002. When is an Office a designated Office?

Article 2(xiii), Article 4

The national Office of a Contracting State is a “designated Office” if the State is “designated” in the international application for national protection. The filing of a request constitutes the designation of all Contracting States that are bound by the Treaty on the international filing date. However, some States may be excluded from this all-inclusive designation where they have notified the International Bureau that Rule 4.9(b) applies to them (refer to International Phase, paragraph 5.053). Where a PCT Contracting State is party to the ARIPO Harare Protocol, the Eurasian Patent Convention or the European Patent Convention and is designated for a regional (ARIPO, Eurasian or European) patent, the regional Office concerned (the ARIPO Office, the Eurasian Patent Office or the European Patent Office) is the designated Office. Where a State party to the ARIPO Harare Protocol, the Eurasian Patent Convention or the European Patent Convention is designated twice, namely both for national protection and for a regional patent, there are two designated Offices for that State - the national Office of the State itself and the regional Office concerned. However, certain States party to the ARIPO Harare Protocol or the European Patent Convention have “closed the national route” whereby patent protection can be obtained in those countries via an international application only by way of a designation for a regional (ARIPO or European) patent. If any of the States that have “closed the national route” are designated, the designated Office concerned is always the ARIPO Office or the European Patent Office, respectively (refer to International Phase, paragraphs 4.022 to 4.026). The European Patent Office is also, in effect, the designated Office where patent protection is desired for a designated State through the extension of a European patent to that State, a possibility which is only available for countries which have a corresponding agreement with the European Patent Organisation (refer to Annex B (EP) and the National Chapter (Summary) relating to the European Patent Office). Where States party to the OAPI Agreement are designated, the OAPI Office, by virtue of the provisions of that Agreement, is always the designated Office (refer to International Phase, paragraphs 4.022 to 4.026). The competent designated Office(s) for each Contracting State is (are) set out in Annexes B.

### 2.003

Article 24(1)(i), Article 24(ii), Rule 90bis.2

Where the applicant, before the expiration of the time limit for entering the national phase, voluntarily withdraws a designation, the Office of or acting for the State whose designation is withdrawn ceases to be a designated Office.

### 2.004. When is an Office an elected Office?

Article 2(xiv), Article 31

Where a demand for international preliminary examination is filed, the term “elected Office” is used - instead of the term “designated Office” - to denote the Office of or acting for a State in which the applicant intends to use the results of the international preliminary examination. Since only designated States can be elected, all elected Offices are necessarily also designated Offices.

### 2.005

Article 37, Rule 90bis.4

Where the demand is withdrawn prior to the date on which examination or processing may start in the national phase, or where the applicant fails to pay the preliminary examination fee or the handling fee and, consequently, the demand is considered as if it had not been submitted, the Office of or acting for the State which has been elected in the demand ceases to be an elected Office.

## 2.006. How does the national phase start?

Article 22(1), Article 23, Article 39(1)(a), Article 40

The national phase starts only if the applicant performs certain acts, either before the expiration of a certain time limit or together with an express request that it starts earlier. The applicant should not expect any notification inviting him/her to perform those acts; it is the applicant's own responsibility to perform them in due time. The consequences of failure to do so are fatal to the application in a number of designated States (refer to paragraphs 4.003 and 4.004). It should be noted that the acts must be performed in due time even if, for some reason, the international search report and the written opinion of the International Searching Authority or the international preliminary report on patentability (Chapter I or II of the PCT) are not yet available. Details of the acts to be performed and the applicable time limits are given in the following paragraphs.

## CHAPTER 3: TIME LIMIT FOR ENTERING THE NATIONAL PHASE

### GENERAL

3.001. What is the time limit for entering the national phase before a designated Office?

Article 2(xi), Article 22

Subject to what is said below, no designated Office may normally process or examine the international application prior to the expiration of 30 months from the priority date and any fees due to a designated Office and any translation of the international application to be furnished to a designated Office will have to be paid and furnished, respectively, only by the expiration of that 30-month period ("priority date" means, where the international application contains a priority claim, the filing date of the application whose priority is claimed, and, where it does not contain such a claim, the filing date of the international application; where the international application contains two or more claims, "priority date" means the filing date of the earliest application whose priority is claimed). In respect of certain designated Offices, the applicable time limit is 20 months, not 30 months because of the incompatibility, for the time being, of the modified PCT provision (PCT Article 22(1)) with the relevant national law; those Offices made a declaration of incompatibility which will remain in effect until it is withdrawn by the respective Offices. Furthermore, certain designated Offices have fixed time limits expiring even later than 30 months, or 20 months, as the case may be. For regular updates on these applicable time limits, refer to the relevant National Chapters; a cumulative table is also available from WIPO's website at [https://www.wipo.int/en/web/pct-system/texts/time\\_limits](https://www.wipo.int/en/web/pct-system/texts/time_limits).

3.002. What is the time limit for entering the national phase before an elected Office?

Article 2(xi), Article 39(1), Article 64(2), Rule 54bis

The time limit is normally 30 months from the priority date, the same time limit for entering the national phase as that which applies in the case of a designated Office which has not been elected (refer to paragraph 3.001). In respect of the designated Offices, for which the 20-month time limit applies (refer to paragraph 3.001), the time limit is 30 months from the priority date if the applicant files a demand for international preliminary examination prior to the expiration of 19 months from the priority date. The national law applied by each elected Office may fix a time limit which expires later than 30 months from the priority date. The National Chapter (Summary) relating to each elected Office in respect of which an extended time limit applies indicates the length of that time limit as does the table referred to in paragraph 3.001. It should be noted that some Offices apply different time limits depending on whether the applicant enters the national phase under Chapter I (Article 22) or Chapter II (Article 39(1)) (for details refer to the table referred to in paragraph 3.001). In those cases, it is recommended that applicants enter the national phase before elected Offices no later than 30 months from the priority date in order to ensure timely national phase entry.

3.003. Are reminders to enter the national phase sent to the applicant by the designated Offices? What happens if the international search report or the international preliminary examination report is late?

Designated Offices usually do not issue any reminder to applicants that the time limit for entering the national phase is about to expire (or has just expired). It is therefore the applicant's responsibility to monitor the applicable time limit(s) in order for the application not to lose its effect before the designated Offices. The applicant is responsible for timely performance of the acts required for entry into the national phase even if the international search report and the written opinion of the International Searching Authority or the international preliminary report on patentability (Chapter I or II of the PCT) have not been established by the time the applicant has to make a decision about how to proceed (refer to International Phase, paragraphs 7.023, 7.027, 7.031 and 10.074).

### REQUEST FOR EARLIER START OF THE NATIONAL PHASE

3.004. Can the national phase start before the expiration of the time limit for entering it?

Article 23, Article 40

The PCT provides, in Articles 23 and 40, that national processing may not start before the expiration of the time limits indicated in paragraphs 3.001 and 3.002 unless the applicant makes an express request to the Office concerned that it start the processing and the examination of the international application earlier. Such a request is not effective, however, unless the applicant has performed the prescribed acts indicated in the following paragraphs. The attention of applicants is drawn to the information in paragraph 4.028.

## CHAPTER 4: ACTS TO BE PERFORMED FOR ENTRY INTO THE NATIONAL PHASE

### GENERAL

4.001. What must be done by the applicant before the start of the national phase?

Article 22(1)

The following acts must be performed (if applicable):

- (i) payment of the national fee (refer to paragraphs 4.005 to 4.007);
- (ii) furnishing of a translation, if prescribed (refer to paragraphs 4.008 to 4.026);
- (iii) in exceptional cases (if a copy of the international application has not been communicated to the designated Office under Article 20), furnishing of a copy of the international application, except where not required by that Office (refer to paragraphs 4.027 and 4.028);
- (iv) in exceptional cases (if the name and address of the inventor were not given in the request when the international application was filed, but the designated Office allows them to be given at a time later than that of the filing of a national application), furnishing of the indication of the name and address of the inventor (refer to paragraphs 4.030 and 4.031).

4.002

Article 27(1), Article 27(2), Article 27(6), Article 27(7), Rule 51bis

There may be acts in addition to those described in paragraph 4.001 which must be performed for the international application to proceed in the national phase, but none of those acts, which are described further below and in the National Chapter relating to each designated Office, has to be performed within the time limit for entering the national phase.

4.003. What are the consequences of failure to perform the acts required for entry into the national phase?

Article 24(1)(iii), Article 39(2)

The consequences where, on expiration of the applicable time limit for entering the national phase, the required acts have not (all) been performed, are that the international application loses the effect of a national application and the procedure comes to an end in respect of each Office before which they have not (all) been performed. Non-performance of the required acts in respect of one Office does not alter the effect of the international application before the other Offices. The automatic loss of the effect relieves the applicant, where he/she decides not to pursue the international application in the national phase, of the need to expressly withdraw the international application or the designation or election of a certain State.

4.004

Article 48(2), Rule 49.6, Rule 82bis

Where the applicant fails to perform the required acts in time, he/she may ask the designated Office to maintain the effect of the international application and to excuse the delay (refer to paragraphs 6.022 to 6.027).

### NATIONAL FEES

4.005. What fees must be paid for entry into the national phase and when?

Article 22(1), Article 39(1)(a), Rule 49.1(a)(ii), Rule 76.5

The fees to be paid for entry into the national phase are indicated in each National Chapter (Summary and fees annex). They must be paid in the currencies and within the time limits that are also indicated there. If annual or renewal fees have become due by the time the national phase could start, they must be paid before the expiration of the time limit applicable for entering the national phase. The National Chapters set out this information.

4.006. How can payment of national fees be effected?

The fees annex to each National Chapter contains this information.

4.007. Does the applicant have the right to claim the exemption, reduction or refund of national fees?

The exemption, reduction or refund of national fees is granted by various designated Offices. Each National Chapter (Summary) contains information on whether fee exemptions, reductions or refunds can be claimed and, if so, under what circumstances and in what amounts.

## TRANSLATION OF THE INTERNATIONAL APPLICATION

### 4.008. In which case must the international application be translated?

Article 22(1), Article 39(1)(a), Rule 49.1(a)(i), Rule 76.5

A translation of the international application must be furnished if the language in which it was filed or published is not a language accepted by the designated Office.

### 4.009. What is the language into which the international application must be translated?

Rule 49.1(a)(i), Rule 76.5

The language or languages prescribed by the designated Offices are given in the National Chapter (Summary) relating to each Office. Where several languages are given, the applicant may choose the language. It should be noted that the language in which the translation of the international application is furnished is usually also the language for the whole procedure before the designated Office.

### 4.010. What must the translation comprise?

Rule 49.5(a), Rule 49.5(k)

The translation must comprise a translation of the description, including the title of the invention (where the title has been established or amended by the International Searching Authority, the translation must only contain the title as established or amended by that Authority), of the claims (refer to paragraph 4.014) and of any text matter in the drawings (refer to paragraph 4.022), as originally filed and/or as amended (refer to paragraphs 4.014 to 4.017, 4.019 and 4.020). Where pages have been accepted as incorporated by reference by the receiving Office (refer to paragraph 6.027 to 6.031 of the international phase), the translation must contain these pages. Each National Chapter (Summary) lists what the translation must comprise for the designated Office concerned. For the translation of the abstract and of the request, refer to the following paragraphs.

### 4.011. Does the abstract require translation?

Rule 49.5(a)

Normally the abstract must also be translated (where it has been amended or established by the International Searching Authority, the translation must only contain the abstract as established or amended by that Authority), but some Offices do not require a translation for the national phase. The National Chapter (Summary) relating to each Office which requires that the abstract be translated contains an indication to that effect.

### 4.012. Does the request require translation?

Rule 49.5(a)(i)

The designated Offices have the right to require a translation of the request but most of them do not require it. The National Chapter (Summary) relating to each Office which requires that the request be translated contains an indication to that effect.

### 4.013. How does the applicant prepare a translation of the request?

Rule 49.5(b)

The usual way of translating the request is to transfer the data contained in the request of the international application as filed to a request form in the language of the translation. Every designated Office that requires a translation of the request is obliged to furnish to the applicant - free of charge - a copy of the request form in the language of the translation. It should be noted that the use of the request form in the language of the translation is optional, so that applicants who do not have such a form may present the translation in a different format.

### 4.013A. Do declarations under Rule 4.17 require translation?

Rule 49.5(a)(i)

Declarations are part of the request form and therefore translation of declarations must be furnished only when the designated Office requires the applicant to furnish a translation of the request (refer to paragraphs 4.012 and 4.013).

### 4.014. Which are the claims that must be translated where the claims have been amended under Article 19?

Rule 49.5(a)(ii)

The designated Offices have the right to require a translation of the claims both as originally filed and as amended under Article 19. Each National Chapter (Summary) contains information on the applicable requirements. As to translations of the claims as amended under Article 19 in a case where the

international application has been the subject of international preliminary examination, refer to paragraph 4.019.

#### 4.015

Rule 49.5(c-bis)

Where a designated Office requires a translation of both the claims as filed and of the claims as amended under Article 19, but the applicant furnishes only one of the required two translations, the designated Office either disregards the claims of which a translation has not been furnished or invites the applicant to furnish the missing translation within a time limit which must be reasonable in the circumstances. If such an invitation is issued but the missing translation has still not been furnished within that time limit, the designated Office may either disregard the claims whose translation is missing or consider the international application withdrawn.

#### 4.016

Rule 49.5(l)

The procedures outlined in paragraph 4.015 do not apply in all designated Offices. The various National Chapters (Summary) indicate, for each designated Office which requires a translation of both the claims as filed and of the claims as amended under Article 19, whether an invitation is issued where both translations are not filed and what the consequences are if the missing claims are not furnished in response to such an invitation.

#### 4.017. Must any statement explaining amendments made to the claims under Article 19 be translated?

Rule 49.5(c)

This statement must be translated only where required by the designated Office (refer to the National Chapter (Summary)). Failure to furnish a translation of the explanatory statement has no effect on the international application itself; it can only result in the statement being disregarded by the designated Office.

#### 4.018. Must a reference to deposited biological material be translated?

Rule 49.5(h)

Where such a reference is contained in the description, its translation is part of the translation of the description. Where the reference is not contained in the description but has been furnished on the optional sheet (refer to the International Phase, paragraph 11.075) or in a later communication, a translation must be furnished together with the translation of the international application. Where the applicant fails to furnish the translation of the reference, the designated Office may invite him/her to do so if it deems necessary.

#### 4.018A. Must declarations or evidence submitted with a request for restoration of the right of priority during the international phase be translated?

Where the decision by the receiving Office to restore the right of priority is reviewed by the designated Office under Rule 49ter.1(d), that Office may require the applicant to prepare translations of any declaration or other evidence furnished to the receiving Office.

#### 4.019. What must be translated where the international application has been the subject of international preliminary examination?

Article 36(2)(b), Rule 70.16, Rule 74.1, Rule 76.5

Amendments to the description, claims or drawings under Article 34 that have been filed with the International Preliminary Examining Authority and have been taken into account for the establishment of the international preliminary report on patentability (Chapter II of the PCT) will be annexed to that report. Any amendments under Article 19 as well as replacement sheets containing rectifications of obvious mistakes authorized under Rule 91.1(b)(iii), will similarly be annexed to the report if they have been taken into account (that is, they will in general not be annexed to the report if they have been superseded by later amendments or considered as reversed by an amendment under Article 34. However, exceptionally where the International Preliminary Examining Authority considers that a superseding or reversing amendment goes beyond the disclosure in the international application as filed, the replacement sheet superseded or reversed by the most recent superseding or reversing amendment will nevertheless be annexed to the report, and the report will contain an indication of this as referred to in Rule 70.2(c)). A translation of the amendments annexed to the report must be furnished together with the translation of the international application within the applicable time limit under Article 39(1).

## 4.020

Rule 70.16, Rule 76.5(iv)

If there have been any amendments under Article 19 which are not annexed to the international preliminary report on patentability (Chapter II of the PCT), a translation of those amendments need not be furnished to most elected Offices. A few elected Offices do, however, require translations of amendments under Article 19 even if they are not annexed to the international preliminary report on patentability (Chapter II of the PCT) - refer to the various National Chapters (Summary) for details.

## 4.021. Does the translation have to contain drawings?

Rule 49.5(a)(iii), Rule 49.5(e), Rule 76.5

No applicant is required to furnish original drawings to the designated Offices together with the translation of the international application. Offices may require only the furnishing of a copy of the original drawing(s), and few actually do so. The National Chapter (Summary) relating to each designated Office indicates this information. If the copy of the drawings is not furnished within the time limit for entering the national phase, the international application does not lose its effect, but the designated Office invites the applicant to furnish the missing copy.

## 4.022. How must the translation of text matter in drawings be presented?

Rule 49.5(d), Rule 49(f), Rule 76.5

Where a drawing, a table or the like contains text matter, that text matter must be translated. There are two methods that may be used for the physical presentation of the translated text matter. One is to furnish new sheets of drawings, tables, etc., containing the translated text matter. The other is to paste the translation over the original text matter and to furnish a copy of that sheet. The latter method, however, requires the copy to be of good quality and fit for reproduction by the designated Office. If it is not, the designated Office may invite the applicant to correct the defect. The expression Fig. which is frequently used in drawings does not require translation into any language. If the translation of the text matter of the drawings is not furnished within the time limit for entering the national phase, the international application may lose the effect of a national application.

## 4.023. What are the physical requirements for the translation?

Rule 49.5(j), Rule 76.5

The translation of the international application and any copy of drawings must comply with the physical requirements prescribed by the designated Office. However, no such Office has the right to require compliance with requirements as to the form of the translation of the international application that are different from or additional to those laid down in the PCT and the Regulations for the filing of international applications. Therefore, if the papers furnished to the designated Office comply with the physical requirements for international applications, they must be accepted by that Office. For details of those physical requirements, refer to International Phase, paragraphs 5.177, 6.032 and 6.051.

## 4.024. In how many copies must the translation be furnished?

Rule 51bis.1(c), Rule 76.5

One copy of the translation is in principle sufficient for entering the national phase. There are some designated Offices, however, that require two or more copies. Where this is the case, it is mentioned in the National Chapter (Summary). If one or more copies are missing, those Offices will give the applicant an opportunity to furnish them once the national phase has started.

## 4.025. Must the translation be certified?

Rule 51bis.1(d)(ii), Rule 76.5

The translation of the international application furnished for entry into the national phase does not need to be certified by a public authority or a sworn translator. However, if later the designated Office reasonably doubts the accuracy of the translation, it may require the applicant to furnish a certification of the translation.

## 4.026. Must the translation be verified?

Rule 51bis.1(d)(i), Rule 76.5

Verification of a translation means that the translation must be accompanied by a statement signed by the applicant or by the translator, to the effect that, to the best of the signatory's knowledge, the translation is complete and faithful. There are only a few designated Offices that require verification. For each such Office, the National Chapter (Summary) contains an indication to that effect and gives further details (including forms).

## COPY OF THE INTERNATIONAL APPLICATION

4.027. Must a copy of the international application be furnished by the applicant to the designated Office for entry into the national phase?

Article 22(1), Article 39(1)(a), Rule 47.1(a), Rule 49.1(a-bis), Rule 49.1(a-ter), Rule 76.5, Rule 93bis.1

Under normal circumstances, none of the designated Offices requires a copy of the international application to be submitted by the applicant. There are only a few that do require a copy where the communication by the International Bureau of a copy of the international application under Article 20 has not, or could not yet have, taken place (for details, refer to the National Chapters (Summary)). That communication is effected by the International Bureau in accordance with Rule 93bis.1 but not prior to the international publication of the international application. The applicant is notified accordingly by means of Form PCT/IB/308 (First notice informing the applicant of the communication of the international application (to designated Offices which do not apply the 30 month time limit under Article 22(1)), and Form PCT/IB/308 (Second and supplementary notice informing the applicant of the communication of the international application (to designated Offices which apply the 30 month time limit under Article 22(1)). When the applicant receives these Forms, he/she does not have to furnish a copy of the international application to any of the designated Offices, since the notices are accepted by all of them as conclusive evidence that the communication has duly taken place on the date specified in the notice.

4.028

Article 13(2)(b), Article 22(1), Article 23(2), Article 39(1)(a), Article 40(2), Rule 47.4

On the other hand, where the applicant makes an express request for early processing of the international application (refer to paragraphs 2.006 and 3.004) before the communication of the international application has taken place, he/she must either furnish a copy of the international application, and of any amendment filed under Article 19 with the International Bureau, at the same time as making the express request for early processing to the designated Office or request the International Bureau to transmit a copy of the international application to the designated Office in accordance with Article 13(2)(b). The other acts prescribed for entering the national phase must naturally also be performed.

## CHOICE OF CERTAIN KINDS OF PROTECTION

4.029

Rule 49bis.1, Rule 76.5

The filing of a request constitutes an indication that the international application is, in respect of each designated Office to which Article 43 or 44 applies, for the grant of every kind of protection which is available by way of the designation of that State. As a result, if the applicant wishes the international application to be treated in a designated Office as an application not for the grant of a patent but for the grant of another kind of protection available for the designated Office, or for the grant of more than one kind of protection, the applicant is required to indicate a choice of protection to the designated Office when performing the acts to enter the national phase. Similarly and within the same time limits, the applicant is required to make such indications also in cases where he/she wishes the international application to be treated in a designated Office as an application for a patent of addition, a certificate of addition, inventor's certificate of addition, a utility certificate of addition or as a continuation or a continuation-in-part. Although some designated Offices may require the applicant to furnish any such indications at the time the acts referred to in Article 22 or Article 39 are performed, many designated Offices would allow the applicant to furnish such indications or, where applicable, convert from one kind of protection to another, at a later time as provided by national law.

## NAMING OF INVENTOR

4.030. In which case must the name and address of the inventor be indicated for entry into the national phase?

Article 22(1)

If the name or address of the inventor or inventors has not been indicated in the request at the time of filing, that information must be furnished to the designated Offices at the time of entry into the national phase. If such indications are required, most of the designated Offices will invite the applicant to furnish them if he/she fails to do so on entering the national phase, but some Offices will not. Details are given in the National Chapters (Summary).

#### 4.031

Article 27(2)(ii), Rule 51bis.1(a), Rule 76.5

The indication of the name and address of the inventor is to be distinguished from other declarations of or concerning the inventor or the invention, etc. The latter are considered “special requirements” (refer to paragraphs 5.001 to 5.005) which may be complied with after entry into the national phase.

#### **USE OF NATIONAL FORMS**

##### 4.032. Is the use of national forms mandatory for entry into the national phase?

Rule 49.4, Rule 76.5

No applicant may be required to use a national form to perform the acts prescribed for entry into the national phase. Several Offices do, however, keep such forms at the disposal of applicants, and their use is recommended. The National Chapters contain information about existing forms, and the annexes to the Chapters reproduce samples of them.

## CHAPTER 5: SPECIAL REQUIREMENTS TO BE COMPLIED WITH IN CONNECTION WITH THE NATIONAL PHASE

### GENERAL

#### 5.001. What is the meaning of “special requirements” and when do they have to be complied with?

Article 27(1), Article 27(2), Article 27(6), Article 27(7), Rule 51bis, Rule 76.5

No designated Office is allowed to require, before the expiration of the applicable time limit for entering the national phase, the performance of acts other than those referred to in Article 22(1), namely the payment of the national fee, the furnishing of a translation (if prescribed) and, in exceptional cases, the furnishing of a copy of the international application, and the indication of the name and address of the inventor (refer to paragraph 4.001). All other requirements of the national law, to the extent that they are admitted under Article 27, are referred to in this publication as “special requirements”. They may still be complied with after entry into the national phase. Rule 51bis indicates the most common of those requirements and provides that the applicant must be given an opportunity to comply with any such special requirement after the start of the national phase. This opportunity is usually given either by sending an invitation to comply with a certain special requirement within a time limit indicated in the invitation or by providing in the national law for a certain time limit within which the applicant must, without invitation, comply with the requirement.

#### 5.002

For each designated Office, the National Chapter (Summary) lists the special requirements, if any, which must be complied with in connection with entry into the national phase, and indicates whether the Office concerned will invite the applicant to comply or, if there is no invitation, what the time limit is for such compliance. It is highly recommended that any special requirement indicated in the National Chapter (Summary) be complied with at the time of performing the acts for entry into the national phase, because this is more economical and avoids the risk of forgetting to comply with the requirement later. The most common of the special requirements are explained in general terms in the following paragraphs. Details are given in each National Chapter (Summary).

### CERTAIN DECLARATIONS CONCERNING THE INVENTOR, ASSIGNMENTS, ETC.

#### 5.003. What must be done to prove inventorship, the right to file the application or the like?

Rule 51bis.1(a), Rule 51bis.2, Rule 51bis.3, Rule 76.5

Depending on national law and practice, some designated Offices require the applicant to furnish:

- (i) any document relating to the identity of the inventor;
- (ii) any document relating to the applicant's entitlement to apply for or be granted a patent;
- (iii) any document containing proof of the applicant's entitlement to claim priority of an earlier application where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the date on which the earlier application was filed;
- (iv) any document containing an oath or declaration of inventorship;
- (v) any evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

However, in general, a document referred to above will not be required if the applicant has furnished a declaration under Rule 4.17 (refer to paragraph 5.005). What may be required by a particular designated Office is indicated in the National Chapters (Summary). The annexes to the National Chapters contain forms that must or may be used for this purpose. Documents (other than declarations under Rule 4.17) required by designated Offices, must always be sent by the applicant to the designated Office concerned and should not be sent to the International Bureau, which, if it does receive them, keeps them in its files but does not transmit them to the designated Offices.

#### 5.004. When must requirements relating to matters such as inventorship, right to file, etc. be complied with?

In general, such requirements must be complied with within a time limit of at least two months from the date of an invitation that the designated Office must send to the applicant, in case the requirement concerned was not already complied with within the time limit for entering the national phase (refer to

paragraphs 3.001 and 3.002). Certain designated Offices have, however, informed the International Bureau that the time limit of two months was not compatible with the applicable national law (refer to the relevant National Chapters (Summary)).

5.005. What can be done in the international phase to simplify the processing of international applications in the national phase?

Rule 4.17, Rule 51bis.2

The applicant may include in Box No. VIII of the request form one or more of the following declarations under Rule 4.17:

Rule 4.17(i), Rule 51bis.1(a)(i)

— Box No. VIII(i): declaration as to the identity of the inventor (noting that such declaration need not be made in Box No. VIII(i) if the name and address of the inventor are indicated in the request, that is, usually in Boxes No. II and/or III);

Rule 4.17(ii), Rule 51bis.1(a)(ii)

— Box No. VIII(ii): declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent;

Rule 4.17(iii), Rule 51bis.1(a)(iii)

— Box No. VIII(iii): declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application;

Rule 4.17(iv), Rule 51bis.1(a)(iv)

— Box No. VIII(iv): declaration of inventorship (only for the purposes of the United States of America), noting that that declaration must be signed;

Rule 4.17(v), Rule 51bis.1(a)(v)

— Box No. VIII(v): declaration as to non-prejudicial disclosures or exceptions to lack of novelty.

Where the request contains a declaration complying with Rule 4.17(i) to (iv), a designated Office may not (except if it has informed the International Bureau to the contrary) require any document or evidence relating to the subject matter of that declaration (refer to paragraph 5.003) unless it reasonably doubts the veracity of the declaration concerned. In the case of a declaration as to non-prejudicial disclosures or exceptions to lack of novelty made under Rule 4.17(v), the designated Offices concerned are always entitled to require further documents of evidence. For further details, refer to International Phase, paragraphs 5.074 to 5.080.

## REPRESENTATION

5.006. Must the applicant be represented by an agent for the national phase?

Article 27(7), Rule 51bis.1(b), Rule 76.5

Most designated Offices require non-resident applicants to be represented by an agent; others require non-resident applicants to have an address for service in the country. The National Chapters (Summary) indicate whether an agent must be appointed or whether an address for service is required.

5.007. When and how must the agent be appointed?

Article 27(7), Rule 51bis.1(b), Rule 76.5

It is highly recommended that an agent be appointed for the performance of the acts for entry into the national phase. An address for service, where required, should also be indicated at the time of performing those acts. As for any obligation to be represented by an agent or to have an address for service, it applies only once the national phase has started. The appointment of an agent must be made in a power of attorney signed by the applicant(s). Model powers of attorney are contained in the annexes to the National Chapters and on the website at <https://www.wipo.int/en/web/pct-system/forms/pa/index>.

5.008. Who may act as an agent for the national phase?

Article 27(7)

The reply to this question is given for each designated Office in the National Chapter (Summary). Lists with names and addresses of agents may be obtained from the designated Offices, but not from the International Bureau.

**PRIORITY DOCUMENT: COPY AND TRANSLATION**

5.009. When must a copy of the priority document be furnished for the national phase?

Rule 17.2(a)

The priority document must be submitted during the international phase to the receiving Office or to the International Bureau, and the International Bureau makes it available to designated Offices (for details, refer to International Phase, paragraph 5.070). Where the priority document has been submitted within the time limit during the international phase to the receiving Office or to the International Bureau, no designated Office may require an original priority document (that is, an original certified copy of the earlier application) from the applicant. What may be required, however, is a copy of the priority document, that is, a simple photocopy of the original priority document (consisting of a copy of both the earlier application and the certificate of its filing date), together with a translation of the priority document (refer to paragraph 5.010).

5.010. When must a translation of the priority document be furnished for the national phase?

Rule 17.2(a), Rule 51bis.1(e), Rule 76.4, Rule 82ter.1(b)

A designated Office may require the applicant to furnish a translation of the priority document only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable; and for the determination of whether an element or part that has been incorporated by reference, pursuant to Rules 4.18 and 20.6, is completely contained in the priority document concerned. In addition, where a part of the description, claims or drawings was incorporated by reference, the designated Office may also require the applicant to furnish an indication as to where the given part is contained in the translation of the priority document.

## CHAPTER 6: MISCELLANEOUS QUESTIONS CONCERNING THE NATIONAL PHASE

### SUBSTANTIVE CONDITIONS OF PATENTABILITY

6.001. What is the effect of the PCT on the substantive conditions of patentability applied in the national phase?

Article 27(5), Article 27(6), Article 33(5)

The PCT leaves each Contracting State free to determine substantive conditions of patentability. This is particularly true for 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, the chances of unpleasant surprises by way of previously uncited prior art references being raised during the national phase are substantially reduced. 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 in that law.

### CORRECTION OF TRANSLATION

6.002. May the applicant correct errors in the translation of the international application?

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

6.003

Article 46

The scope of the translation of the international 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, that 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.

### RESTORATION OF THE RIGHT OF PRIORITY

6.004. What are the effects of a decision by a receiving Office to restore the right of priority on designated Offices?

Rule 49ter.1

A decision by a receiving Office to restore a right of priority based on the criterion of “due care” will, as a general rule, be effective in all designated Offices, unless the designated Office submitted a notification of incompatibility under Rule 49ter.1(g) (refer to paragraph 6.005). A decision by a receiving Office to restore a right of priority based on the criterion of “unintentionality” will be effective only in those designated States the applicable laws of which provided for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion. A decision by a receiving Office to refuse to restore the right of priority can always be reviewed by a designated Office (refer to paragraph 6.006), unless it has submitted a notification of incompatibility under Rule 49ter.1(g), such that restoration is not possible in that jurisdiction.

In addition, a review of a positive decision may be made by a designated Office in the limited situation where it reasonably doubts that one of the substantive requirements for restoration was complied with. No review is permitted on purely formal grounds, such as, for example, the ground that the relevant fee in the international phase might not have been paid.

6.005. What are the consequences of a decision by a receiving Office to restore the right of priority on a designated Office which has made a notification of incompatibility?

Rule 49ter.1(g)

Several designated Offices have notified the International Bureau under Rule 49ter.1(g) of the incompatibility of Rule 49ter.1(a) to (d) with the national law applied by that Office. As a result, these designated Offices will not be obliged to give effect to the decision by a receiving Office to restore the right of priority for the purposes of the procedure before that designated Office as outlined above. A list of Offices which have notified the International Bureau of incompatibility of their national law with Rule 49ter.1 can be found on WIPO's website at [https://www.wipo.int/en/web/pct-system/texts/reservations/res\\_incomp#R\\_49ter\\_1\\_g](https://www.wipo.int/en/web/pct-system/texts/reservations/res_incomp#R_49ter_1_g).

## 6.006. Can a request to restore the right of priority also be filed directly with a designated Office?

Rule 49ter.2

A request to restore the right of priority can also be filed directly with a designated Office once the applicant has entered the national phase before that Office. The applicant may wish to rely on this opportunity if he/she could not file a request to restore the right of priority with the receiving Office because of the operation of Rule 26bis.3(j), or obtain the restoration of the priority right on the desired criterion because of the criterion for restoration applied by the receiving Office, or because the receiving Office has refused the request to restore filed with it (refer to Rule 49ter.1(e)). Several designated Offices have, however, notified the International Bureau under Rule 49ter.2(h) of the incompatibility of Rule 49ter.2(a) to (g) with the national law applied by that Office. As a result, these designated Offices will not accept a request to restore the right of priority filed with it. A list of Offices which have notified the International Bureau of the incompatibility of their national law with Rule 49ter.2 can be found on WIPO's website at [https://www.wipo.int/en/web/pct-system/texts/reservations/res\\_incomp#R\\_49ter\\_2\\_h](https://www.wipo.int/en/web/pct-system/texts/reservations/res_incomp#R_49ter_2_h).

## 6.007. What is the applicable time limit to request restoration of the right of priority with a designated Office?

Rule 49ter.2(b)(i), Rule 49ter.2(f)

The time limit for complying with the requirements for requesting the restoration of the right of priority is at least one month from the applicable time limit under Article 22 for entering the national phase, though designated Offices are free to apply longer time limits where permitted under their national law (Rule 49ter.2(f)). Where the applicant makes an express request for entry into the national phase under Article 23(2), the time limit of one month starts from the date of receipt of that request by the designated Office. If the designated Office requires the applicant to provide a declaration or evidence in support of the statement of reasons for failure to timely file the international application, it allows the applicant a reasonable time under the circumstances to furnish such documents.

## 6.008. How should a request for the restoration of the right of priority be filed with the designated Office?

Rule 49ter.2(b), Rule 49ter.2(f)

The request to restore the right of priority must be submitted by way of a letter to the designated Office.

For the request to restore the right of priority to be successful, the following requirements must be met:

- the international application must contain a priority claim to an earlier application and the international application must have been filed within two months from the expiration of the priority period. If the international application did not contain the relevant priority claim at the time of filing, such a claim must have been added, pursuant to Rule 26bis.1(a) (refer to International Phase, paragraphs 6.038 to 6.040), before the expiration of the time limit under Rule 26bis.3(e) (Rule 26bis.3(c));
- the request to restore should state the reasons for the failure to file the international application within the priority period (refer to paragraph 6.010). The statement of reasons should be drafted in light of the restoration criterion which the applicant seeks to satisfy, from among those applied by the Office (refer to paragraph 6.009);
- the request must be accompanied by any fee for requesting restoration required by the designated Office (refer to National Chapter, Annex I for whether a particular designated Office requires such a fee);
- if required by the designated Office and subject to an invitation by the Office, a declaration or other evidence in support of the statement of reasons must be furnished (Rule 49ter.2(c)) (for the applicable time limit, refer to paragraph 6.007).

## 6.009. What are the criteria for restoration applied by the designated Office?

Rule 49ter.2(a), Rule 49ter.2(f)

There are generally two criteria for restoration: either the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or the failure to file the international application within the priority period was unintentional. All designated Offices to which these Rules are applicable (refer to paragraph 6.006) must apply at least one of these criteria, or else one more favorable from the point of view of the applicant. If a designated Office wishes, it may apply both criteria for restoration.

6.010. What needs to be included in the statement of reasons for the request to restore the right of priority?

Rule 49ter.2(b)(ii)

The statement should indicate the reasons for the failure to file the international application within the priority period. It should contain all the relevant facts and circumstances which would allow the designated Office to determine that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or was unintentional.

6.011. Will there be an opportunity to convince the designated Office that it should not refuse the request?

Rule 49ter.2(e)

If the designated Office intends to refuse the request for the restoration of the priority claim, it is required to notify the applicant of its intention. The applicant must be given an opportunity to make observations on the intended refusal within a reasonable time limit, specified in the notification of intended refusal. Note that this notification may in practice be sent to the applicant together with an invitation to file a declaration or other evidence.

## **INCORPORATION BY REFERENCE OF MISSING OR CORRECT ELEMENTS OR PARTS**

6.012. Will pages which have been accepted as incorporated by reference by the receiving Office be accepted by the designated or elected Office?

Rule 82ter.1

Designated and elected Offices may, to a limited extent, review decisions by receiving Offices which have allowed incorporation by reference (Rule 82ter.1(b)). If the designated or elected Office finds that the applicant did not comply with its obligation to furnish or arrange for the furnishing of a priority document; the statement of incorporation was missing or not submitted with the request; no written notice confirming incorporation by reference was submitted; no required translation furnished; or the element or part in question was not completely contained in the priority document, the designated or elected Office may treat the international application as if the international filing date had been accorded on the basis of the date on which the sheets containing the missing or correct element or part were submitted, but only after having given the applicant the opportunity to make observations on this outcome, in which case the applicant may request that the missing part or the correct element or part which had been furnished be disregarded, in accordance with Rule 82ter.1(d). Similarly, those designated Offices which have submitted notifications of incompatibility under Rule 20.8(b) or 20.8(b-bis) (refer to International Phase, paragraph 6.027) may, pursuant to Rule 20.8(c), also treat the international application as if the international filing date had been accorded without the benefit of the incorporation by reference but also only after having given the applicant the opportunity to make observations on this outcome, in which case the applicant may request that the missing part or the correct element or part which had been furnished be disregarded.

## **AMENDMENT OF THE INTERNATIONAL APPLICATION FOR THE NATIONAL PHASE**

6.013. May the applicant amend the international application for the national phase?

Article 19, Article 28, Article 34(2)(b), Article 41, Rule 46, Rule 52.1, Rule 66.1, Rule 78

The PCT guarantees the applicant an opportunity to amend the claims, the description and the drawings before any designated Office. Although the applicant has already had the opportunity to amend the claims in the international phase, he/she may wish to make further amendments, which may be different for the purposes of the various designated Offices, in the national phase, or he/she may wish to amend also the description or the drawings (which is not possible during the international phase unless the applicant has made a demand for international preliminary examination). All designated and elected Offices are obliged to permit such amendments for at least one month from the time when the applicant enters the national phase. That minimum time limit may be later in certain exceptional circumstances specified in Rules 52.1 and 78. In any event, most designated and elected Offices permit amendments at any time during the national examination procedure (if applicable). In certain designated or elected Offices, where examination must be specifically requested, the request for making amendments may only be made after the applicant has entered the national phase. The National Chapters give additional indications in this respect.

## 6.014. May the applicant correct obvious mistakes in the international application for the national phase?

Rule 91.3(f)

Normally, any obvious mistake in the description, claims and drawings may be corrected before the designated Office. The correction can be presented as an amendment (refer to paragraph 6.013), provided that the scope of the international application as originally filed is not thereby broadened.

## 6.015. What are the effects of the authorization of an obvious mistake on the designated and elected Offices?

Rule 91.3(e), Rule 91.3(f)

Generally, designated and elected Offices must process the international application in the national phase "as rectified", unless that designated or elected Office has already started the processing or examination of the international application before the date on which that Office is notified under Rule 91.3(a) by the International Bureau of the authorization of the rectification concerned. Otherwise, a designated or elected Office may disregard a rectification that was authorized under Rule 91.1 if it finds that it would not have authorized the rectification if it had been the competent authority (refer to Rule 91.3(f)). The designated Office may, however, only disregard any rectification that was authorized during the international phase, if it has given the applicant an opportunity to make observations, within a reasonable time limit, on the Office's intention to disregard the rectification.

## 6.016

Where the authorization of rectification has been refused during the international phase and the applicant has made a request for publication under Rule 91.3(d) (refer to the International Phase, paragraph 11.043), he/she should repeat the request for rectification before each designated Office in a language admitted by that Office.

## 6.017

The conditions for allowing the rectification of an obvious mistake depend on the national law and practice applied by the designated Offices. Applicants are advised to inquire at the Offices concerned regarding the conditions applicable.

## **REVIEW IN THE NATIONAL PHASE OF CERTAIN DECISIONS MADE DURING THE INTERNATIONAL PHASE**

### 6.018. In which case may a request for review be made?

Article 25

A review by the designated Office of the following decisions may be requested:

- (i) the receiving Office has refused to accord an international filing date to the international application because of certain defects in that application;
- (ii) the receiving Office has declared that the international application is considered withdrawn because of certain defects in that application or because of non-payment of the prescribed fees;
- (iii) the International Bureau has made a finding that the international application is considered withdrawn because it has not received the record copy within the prescribed time limit.

Article 25(2)(a)

Thus, those decisions that may have been made during the international phase and affect the international application as such are subject to review by each designated Office. 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.

### 6.019. How may the right to request a review be exercised and when?

In any of the three cases referred to in paragraph 6.018, the applicant must, if he/she wants the decision to be reviewed,

Article 25(1)(b)

- (i) request the International Bureau, under Article 25, to send to each designated Office specified by him/her a copy of any relevant document in the file; this request must be in English or French;

Article 25(2)(a), Rule 51.2

- (ii) request each of those designated Offices, separately, to review the decision affecting his/her international application, giving the facts and evidence indicating an error or omission on the part of the

receiving Office or of the International Bureau, as the case may be; in addition, and at the same time (refer to paragraph 6.020), the applicant must pay to the said designated Office the national fee for entry into the national phase, and furnish a translation of the international application where required; for details about fees and required translations, refer to the National Chapters (Summary); the request to the designated Office must be in a language accepted by that Office; where the review requested concerns the refusal to accord an international filing date, the applicant must attach to the request a copy of the notice of the refusal.

#### 6.020

Rule 51.1, Rule 51.3

Both the request to the International Bureau and the request to any designated Office together with any required translation and fee must reach the authority concerned within two months from the date of the notification informing the applicant of the unfavorable decision.

#### 6.021. What may be the result of a review by the designated Office?

Article 24(2), Article 25(2)(a), Article 48(2)

If the applicant has complied with the requirements outlined in the preceding paragraphs, the designated Office will make a finding on whether the decision was justified and, if it finds that it was the result of an error or omission, it must treat the international application as if that error or omission had not occurred, and maintain the effect of the international application as a regular national application as of the international filing date. If it finds that the decision was not the result of an error or omission, it may nevertheless maintain the effect of the international application under Article 24(2). The latter may be the case where the decision was the result of failure to meet a prescribed time limit (such as for the furnishing of corrections or the payment of fees); in such a case, the applicant is advised to request the designated Office not only to review the decision but also to excuse the delay. Details on the excusing of delays in meeting time limits are given in the following paragraphs.

### **EXCUSING OF DELAYS IN MEETING TIME LIMITS**

#### 6.022. Can a delay in meeting a time limit be excused?

Article 48(2), Rule 82bis

A delay in meeting a time limit which has resulted in the international application being considered withdrawn, during either the international phase or the national phase, may be excused under certain circumstances. The excusing of a delay is understood as any decision which has the effect of the international application being treated as if the time limit had not been exceeded. The excusing of a delay cannot be requested during the international phase, however. It may be granted only in the national phase (for delays in both the international phase and the national phase) by each designated Office individually, and only as far as that Office is concerned. The conditions laid down by the national law of each designated Office are paramount in determining whether a delay must be or may be excused. All national provisions related to the excusing of delays must be applied to international applications in the same way and under the same conditions as they are to national applications. Examples of such provisions are those that allow for the reinstatement of rights, restoration, *restitutio in integrum*, revival of abandoned applications, further processing, continuation of proceedings, and so on.

#### 6.023. In respect of which time limits may delays be excused?

Rule 82bis.1

The time limits concerned are all those fixed in the PCT (Treaty and Regulations) and also any time limit fixed by a PCT authority and any time limit either fixed by, or in the national law applicable by, the designated Office for the performance of any act by the applicant before that Office, including the time limit for entering the national phase.

#### 6.024. What must be done by an applicant who has exceeded the time limit for entering the national phase and/or who failed to perform the acts referred to in Article 22 or 39(1) within the applicable time limit?

Article 48(2), Rule 49.6, Rule 82bis.2

Contracting States are required under Rule 49.6 to provide for the possibility to reinstate the rights of the applicant with respect to an international application where the applicant failed to comply with the requirements of Article 22 or 39(1). Details of this possibility are given in Rule 49.6. Some Contracting States have notified the International Bureau, under Rule 49.6(f), of the incompatibility of this Rule with their national laws. A table of such notifications is available on WIPO's website at: [https://www.wipo.int/en/web/pct-system/texts/reservations/res\\_incomp#R\\_49\\_6\\_f](https://www.wipo.int/en/web/pct-system/texts/reservations/res_incomp#R_49_6_f). Once a State has

taken the necessary actions to amend its national law, notification of this will be published in the Official Notices (PCT Gazette) and the table will be updated. Moreover, even if a Contracting State has made a notification under Rule 49.6(f), the applicant is advised to check with the Office concerned whether a system to reinstate rights with respect to an application exists or not. Some States have made notifications only because their national laws already contain provisions for the reinstatement of rights but these provisions are not in line with the contents of Rule 49.6. Some States therefore have no procedure in place to reinstate rights with respect to an application whereas others do have such systems, either more or less favorable to the applicant than Rule 49.6.

#### 6.025. What must be done by the applicant who has exceeded a time limit?

Article 48(2), Rule 51.1, Rule 51.3

The applicant must perform all acts required for entry into the national phase (refer to paragraphs 4.001 to 4.031). The applicant must at the same time request the designated Office to excuse the delay and to maintain the effect of the international application before it. The procedure depends on the national requirements applicable, including any time limit for filing a request to excuse the delay. Those requirements are indicated in the National Chapter. Applicants can usually be sure of meeting any such time limit when the request to excuse is made and the acts for entering the national phase are performed either within two months from the date of the notification of the unfavorable decision or within two months from the date on which the time limit (such as the time limit for entering the national phase) expired.

#### 6.026

Article 24(2), Article 48(2)

The request for a delay to be excused should be made in addition to, and together with, any request for the review of a decision made by the receiving Office declaring the international application withdrawn for failure to comply with any requirement within a certain time limit (refer to paragraphs 6.018 to 6.021). Should the designated Office confirm the decision made by the receiving Office, it may nevertheless maintain the effect of the international application because, under its national law, the delay may be excused in accordance with provisions for the reinstatement of rights, the revival of an abandoned application, the continuation of proceedings or the like. It should be noted that, as outlined in the preceding paragraphs, the applicant must, before each Office concerned, fulfill all the conditions in the applicable national law, including the making of the request for a delay to be excused within any time limit prescribed by the national law.

#### 6.027. Must the late arrival of a document caused by irregularities in the mail service be excused?

Article 48(1), Rule 82

If a time limit fixed in the Treaty or the Regulations is exceeded because of the delayed arrival of a document or letter, it must be excused if it was caused by a delay in the mail or by an interruption of the mail service, provided that sufficient evidence is produced and the mailing was by mail registered with the postal authorities or with any delivery service notified by the designated Office to the International Bureau. Similarly, and under the same conditions, a new copy of a document or letter may be substituted for a document or letter lost in the mail, provided that the replacement document or letter is proved to be identical with the one lost. For details, refer to Rule 82.

### **RECTIFICATION OF ERRORS MADE BY THE RECEIVING OFFICE OR BY THE INTERNATIONAL BUREAU**

#### 6.028. Which errors made by the receiving Office or the International Bureau may be rectified?

Rule 82ter

If the receiving Office has made an error in according the international filing date or if the priority claim in the request has been erroneously considered by the receiving Office or the International Bureau not to have been made, the designated Office must rectify the error if it is one that it would have rectified in accordance with its national law or national practice had it made the error itself.

#### 6.029. What must be done to request rectification of such an error and when?

The applicant must request the designated Office to rectify the error and must prove, to the satisfaction of that Office, that the international filing date accorded by the receiving Office is incorrect owing to an error made by the receiving Office, or that a priority claim has erroneously been considered not to have been made by the receiving Office or the International Bureau. The request should be made on entering the national phase.

## ACTS TO BE PERFORMED DURING THE NATIONAL PHASE

6.030. What has to be done by the applicant once the national phase has started?

The usual national procedure applies to international applications during the national phase. What is said in the following text and in the National Chapter (Summary) concerns only the acts that must be performed for entry into the national phase and those acts that should be performed on entering the national phase but may still be performed once it has started. What has to be done thereafter-at least the main procedural steps-is outlined for each designated Office in the relevant National Chapter (Summary). Applicants who are not familiar with the patent procedure before a certain designated Office should seek professional advice even where they are not obliged to be represented before that Office by an agent.

## CORRESPONDENCE WITH AND PAYMENTS TO DESIGNATED OFFICES

6.031. How should the international application be identified?

All documents sent and all payments of fees to a designated Office (and any letter accompanying such documents or payments) should indicate - if already known - the national serial number given to the international application by the designated Office. Where the national number is not yet known (or not given), the international application number should be indicated, preferably together with the international filing date, the name of the applicant and the title of the invention.

## DEPOSIT OF BIOLOGICAL MATERIAL

6.032. What are the requirements regarding deposits of biological material?

Annex L contains details of designated Offices' requirements regarding deposits of biological material.

## FURNISHING OF A NUCLEOTIDE AND/OR AMINO ACID SEQUENCE LISTING

6.033. What requirements need to be satisfied in relation to the furnishing of a sequence listing?

Annex C of the Administrative Instructions, Rule 13ter.1(a), Rule 13ter.3, Rule 49.5(a-bis)

No designated Office may require that the applicant furnish a nucleotide and/or amino acid sequence listing in a format other than that complying with the standard provided for in Annex C of the Administrative Instructions (WIPO Standard ST.26). Where the international application contains a sequence listing which does not comply with the standard and/or the language-dependent free text is not in a language accepted by the Office, any designated Office may require the applicant to furnish a sequence listing or a translation complying with those requirements.

## REQUEST FOR ACCELERATED EXAMINATION PROCEDURE

6.034. Is an accelerated examination procedure available to all applicants in the national phase?

Where applicants have received a positive international preliminary report on patentability (under Chapter I or II) in respect of their international application, they may request fast-track examination before certain Offices which participate in the Patent Prosecution Highway or offer accelerated examination based on positive PCT work products from other Offices. For further information refer to [https://www.wipo.int/en/web/pct-system/filing/pct\\_pph](https://www.wipo.int/en/web/pct-system/filing/pct_pph).