



Best practices in the PCT international phase

Preparing to file (1)

■ Decision-making process

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

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

- Two independent systems
- Second pair of eyes review

■ Review need for any foreign filing licenses

Preparing to file (2)

■ Choice of RO?

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

■ Know your RO

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

Preparing to file (3)

■ Representation of applicants

- Requirement to appoint an agent?
- Choice between agent or common representative
- Deemed common representative
- Who can act as an agent?
- Alternatives if patent attorney does not qualify as agent before the RO?
- Powers of attorney
- Agent for the international phase and agent for the national phase

Preparing to file (4)

■ Choice of ISA?

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

Preparing to file (5)

■ Right to file

- Assignments need to have been made before filing

■ Right to claim priority at the international filing date

- Assignments need to have been made before filing

- Assignment to a non-Paris applicant?

■ Accession number for deposited biological material

Preparing to file (6)

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

Preparing to file (7)

■ Preparing the request form:

□ Naming of the applicants:

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

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

Preparing to file (8)

■ Preparing the request form (cont.):

- Correctly indicate all priority claims
- Correctly indicate your sequence listing in check list
- Sequence listing must be in XML format (ST.26 compliant)
- Make use of PCT declarations

■ If you are about to miss the priority period

- Always have a plan B ready
- Ways to extend the priority period
- Request restoration of the priority right

Color drawings (1)

- Applications containing color or greyscale content
 - Not permitted in PCT applications (Rule 11)
 - Since applications often contain color or greyscale content, the IB has included some features in ePCT
 - **ePCT-Filing** will automatically detect color or greyscale content and warn the applicant that the application content should be in black and white
 - A dedicated preview function has been made available by the IB in order to allow applicants to view the application content as it will be rendered by the IB
 - Directly available in ePCT-Filing
 - <https://pctdemo.wipo.int/DocConverter/pages/pdfValidator.xhtml>

Color drawings (2)

■ Publication of applications containing color or greyscale content

- The application will be converted into black and white format for further processing and publication by the IB
- If the application contained color or greyscale content, the front page of the published PCT application will contain a notice to that effect
- Any original color or greyscale content will be made available on PATENTSCOPE as part of the public application file

■ Attention:

- Designated Offices are not obliged to take the color or greyscale content into account, and may rely on the PCT application as published in black and white

After filing (1)

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

After filing (2)

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

Time limits under the PCT

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

International Publication

■ Publication

- Generate a “preview” of the international publication in ePCT and check for correctness
- Or at least, verify correctness and completeness after publication
- Preventing or postponing international publication
- Lack of payment of fees

Questions?

