



# Advanced Seminar on the Patent Cooperation Treaty

## Best Practices during the International Phase

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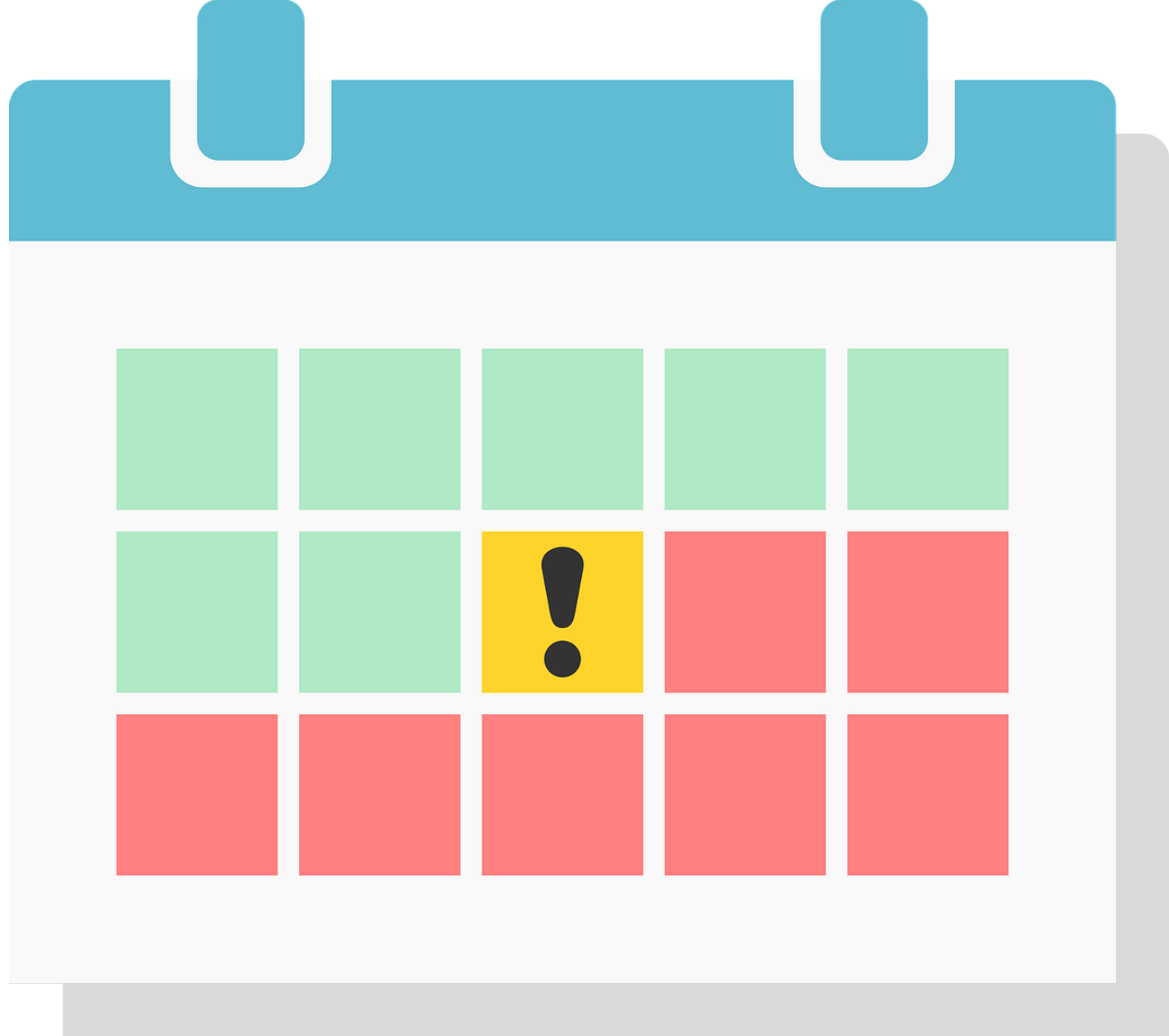
**Geneva**  
**October 2-3, 2024**





## Missed the priority deadline?





# Restoration of right of priority

## ■ Conditions

- must file the PCT application within 2 months from the priority deadline
- file request with the RO (or DO)
- well reasoned statement of reasons and evidence for failure to comply with the time limit
- fee, if required by the Office



# Restoration of right of priority

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

# Unintentional criterion

- When the priority period expired, applicant had a continuing underlying intention to file
  - did not deliberately refrain from filing

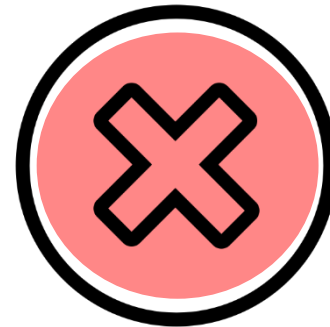


# Unintentional criterion example

Applicant failed to obtain sufficient funds to pay the filing fee before the priority period expired. The request will likely be:



Granted



Refused

# Due care criterion (1)

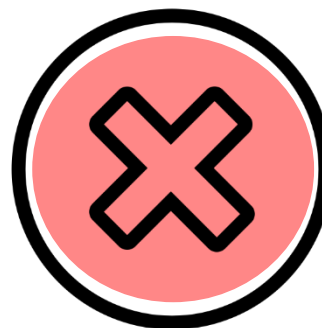
- Applicant took all measures a reasonably prudent applicant would have taken under the circumstances
  - analysis of the applicant's specific acts related to the filing of the international application up to the expiration of the priority period

# Due care criterion: example 1

Applicant timely filed a PCT application wrongly believing that a corporation from the Channel Islands (Jersey) had the right to file. Applicant asserts that it was a result of understandable confusion. The request will likely be:



Granted



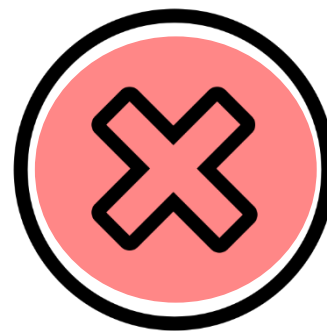
Refused

## Due care criterion: example 2

Applicant was hospitalized starting one week prior to the expiry of the priority period for three weeks and could not timely instruct the agent to file the PCT application. The request will likely be:



Granted



Refused

# Due care criterion (2)

## ■ Case-by-case factual analysis of each request

- Lack of knowledge
- Lack of financing
- Absence from office issues
- Human error by applicant/agent
- Human error by staff of applicant/agent
- Force majeure events
- Postal delivery issues
- Technical failures/IT issues
- Docketing system errors
- Miscommunications between agent and applicant

## ■ ROGL paragraphs 166J to M

<https://www.wipo.int/export/sites/www/pct/en/texts/pdf/ro.pdf>

# Considerations

- Does the RO accept restoration request?
- Applicable criteria by RO?
- Applicable criteria by interested DOs?
- Fees?
- Privacy concerns in reasoned statement?
- Likelihood of success
- Effect in national phase?

See: <https://www.wipo.int/pct/en/texts/restoration.html>

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

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

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

- RO restoration based on the “due care” criterion is effective in all DOs
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible
- RO refusal to restore is not binding on DOs

Notifications of incompatibility with national laws:

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



# Reservations made by Offices

- Incompatibility as RO (Rule 26*bis*.3(j)):  
BR, CO, CU, CZ, DE, DZ, GR, ID, IN, KR, PH
- Incompatibility of the effect of decision of RO on DO  
(Rule 49*ter*.1(g)):  
BR, ~~CN\*~~, CO, CU, CZ, DE, DZ, ID, IN, KR, LT, MX, PH
- Incompatibility as DO (Rule 49*ter*.2(h)):  
BR, CA, ~~CN\*~~, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, PH

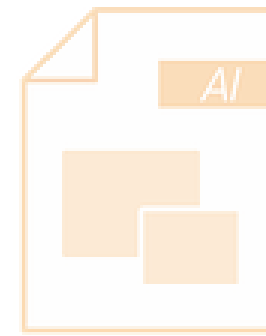
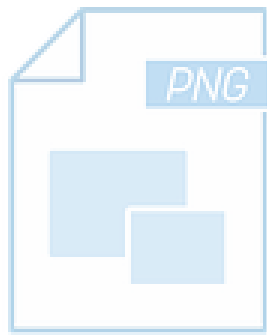
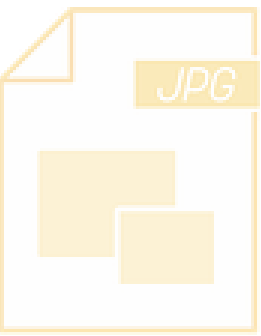
\*applicable on or after 20 January 2024

Notifications of incompatibility with national laws:  
[www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

■ **Filed with a non-competent RO?**

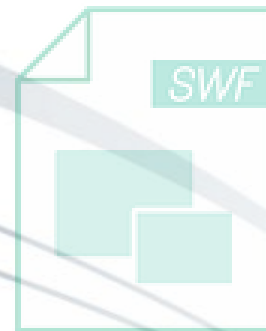
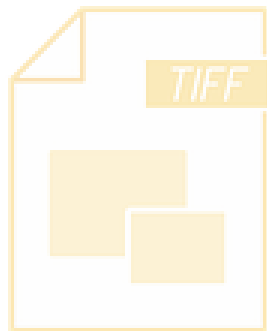
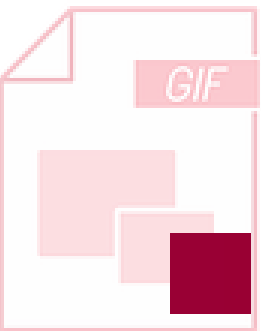
# Rule 19.4 safeguard

- Non-competent RO due to:
  - ❑ Applicant nationality/residence
  - ❑ Language not accepted by the RO
  
- Transmittal to the RO/IB under Rule 19.4
  - ❑ National security requirements checked by RO
  - ❑ Transmittal fee payment required
    - Any fees paid not transferred to RO/IB
  - ❑ Agent's right to practice?
  - ❑ Form PCT/RO/151

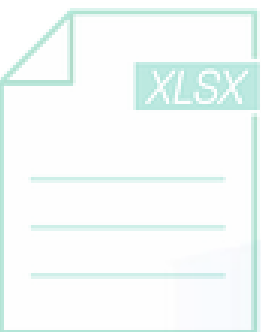


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The International  
Patent System



**Uploaded the wrong file?**



# Incomplete, erroneous or missing description, claims or drawings?

- Correct the erroneously filed elements/parts (Rule 20.5*bis*) or complete the application with missing elements/parts
  - ❑ → *Will affect filing date unless same day correction*
- Incorporation by reference → will not affect IFD
  - ❑ element/part fully contained in the priority application
  - ❑ priority claim present at filing
  - ❑ 2-month time limit from filing *or* RO invitation
  - ❑ removal not permitted
  - ❑ *incompatibility with national laws*
    - *CU; CZ; DE, ID; KR; MX; TR*



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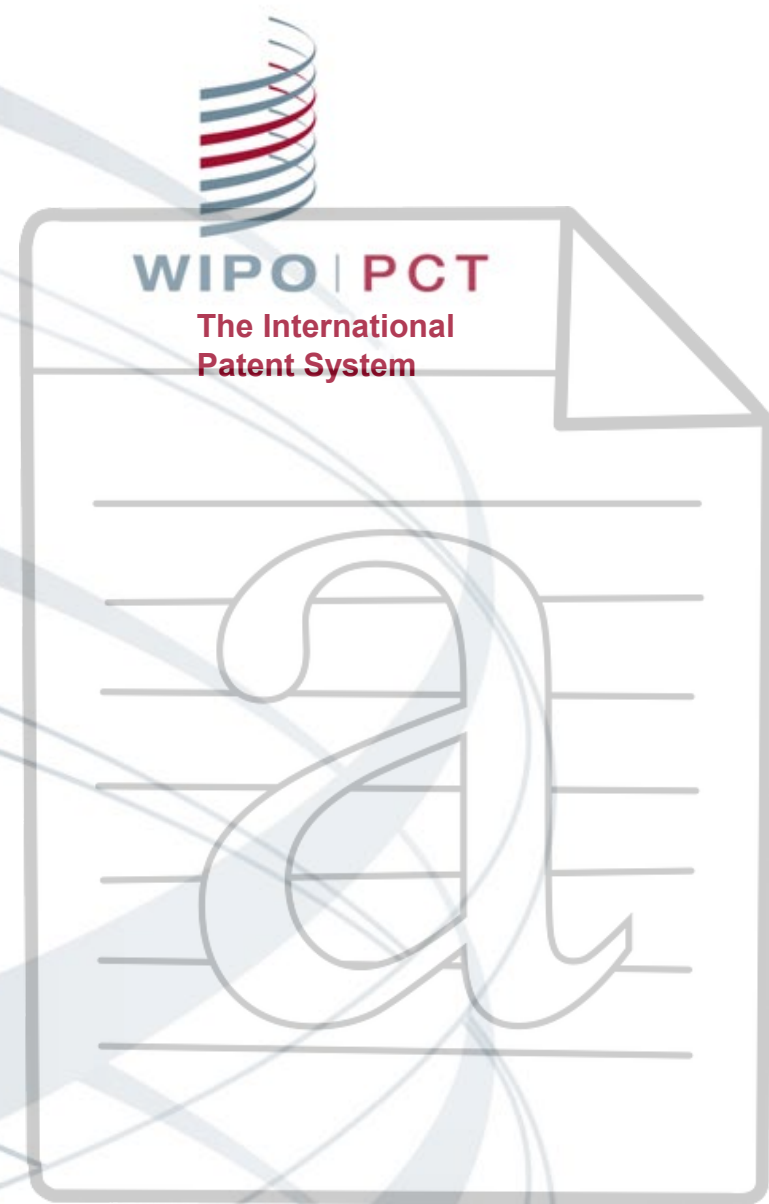


**Missing or erroneous  
priority claim?**



# Add or correct the priority claim

- Verify that priority information is correct on Form PCT/IB/301
- Know your time limits under Rule 26*bis*
  - [PCT Time limit calculator](#)
- Look out for invitation by the RO or IB
  - Form PCT/RO/110 or PCT/IB/316
- Priority document may serve as a tacit correction request
- Rule 91 Rectification available in limited cases



## Formal defects



# React to the RO invitation!

- Unpaid/insufficient fees
  - Forms PCT/RO/102, RO/133
  - 1 month from filing + 1 month with late fee
- Formal defect examples (Form PCT/RO/106)
  - Missing signature
  - Missing title or abstract
  - Missing applicant indications
  - Nonconformity to Rule 11 physical requirements
  - 2-month time limit from the date of invitation
    - Extendable by RO
  - Correctable without the RO invitation



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**Final review by DO**

# More favorable national law/practice?

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

- DO has the final say on the possible loss of effect in that State and may review:
  - RO decision refusing to accord a filing date
  - RO declaration that the international application considered withdrawn
  - Applicant's delay in meeting any time limits
- Opportunity to correct defects before the DO
  - As provided under national law



## Best practice tips

# File Rule 92*bis* change request via ePCT Action

- File with International Bureau via ePCT Action
  - Assignment document and/or power of attorney may be required
- Time limit: receipt by IB within 30 months from the priority date
  - Consider submitting without signature/evidence to meet the time limit
- Review Form PCT/IB/306

# Request withdrawal via ePCT Action

- File with International Bureau via ePCT Action
  - Exception: file with RO if record copy has not been transmitted
- Ensure power of attorney on file
- Safeguard:
  - May use conditional language, if close to publication

# PCT Resources/Information

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

Telephone: (+41-22) 338 83 38

Email: [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

- Contact the speaker:

Email: [hanna.kang@wipo.int](mailto:hanna.kang@wipo.int)