



# Entry into the National Phase

# Decisions to be taken by the applicant

## ■ Whether

- to proceed with or drop the international application ?

## ■ When

- at the end of 30 months (in some cases 31 months or more)

- under Chapter I ?\*
- under Chapter II ?

- early entry ?

## ■ Where (choice limited to designated/elected Offices)

- which national Offices
- which regional Offices

\* LU and TZ continue to apply a 20-month time limit

# Time limit for entry in the national phase

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

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

# General national requirements

## Art. 22(1) and 39(1)(a)

### ■ Requirements:

- Translation, if applicable
- Payment of national fee
- Copy of international application in particular circumstances only

### ■ Time limit under Art. 22(1): 30 months from the priority date

- For additional time, see PCT Applicant's Guide, national phase summaries
- For exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

### ■ Time limit under Art. 39(1)(a): 30 months from the priority date

- For additional time, see PCT Applicant's Guide, national phase summaries

# Examples of special requirements under Rule 51*bis*.1 (1)

- Oath or declaration by the inventor (US only):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by DO/EO/US unless that Office may reasonably doubt the veracity of the declaration

- Assignment documents (of the priority rights or of the application):

Where the corresponding declaration has been furnished during the international phase or directly to the DO/EO, no documents or evidence as to that matter may be required by the DO/EO unless that Office may reasonably doubt the veracity of the declaration

# Examples of special requirements under Rule 51*bis*.1 (2)

- Translation of the priority document may only be required (Rule 51*bis*.1(e)):
  - where the validity of the priority is relevant to the determination whether the invention is patentable
  - in cases of incorporation by reference
- Appointment of local agent and submission of power of attorney
- Translation or other documents relating to the international application in more than one copy
- Certified translation of the international application (only where the Office may reasonably doubt the accuracy of the translation)

# National requirements simplified for PCT applications (1)

## ■ Priority document

- ❑ The applicant does not need to furnish the priority document since the IB transmits copies to the DO/EOs
- ❑ If the DO/EO did not receive a copy of the priority document from the IB, it must request a copy from the IB (not from the applicant)

## ■ Drawings

- ❑ If the drawings do not contain any text matter to be translated, a simple copy of the drawings as filed is required by a few DOs
- ❑ If the drawings contain text matter to be translated, a set of drawings containing the translated text matter needs to be furnished

# National requirements simplified for PCT applications (2)

- No legalized or certified translation of the international application
  - Otherwise, a simple translation is required
  - A few Offices (such as, AU, GB, IN, NZ, SG, ZA) require a "verified" translation
- No special form required (but strongly recommended) for entry into national phase



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

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

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

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

# A few further tips to remember

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

# Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
  - unintentionally
    - or - at the option of the Office -*
  - in spite of due care required by the circumstances

# Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Applicants may submit a request for reinstatement and enter the national phase within:
    - 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
    - 12 months from the date of expiration of the time limit to enter national phase;
- whichever period expires first

# Reinstatement of rights by DO/EOs (Rule 49.6) (3)

- Longer time limits and/or further requirements may apply depending on the applicable national law
- For further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant's Guide*, National Phase

# DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f):

CA	Canada	LV	Latvia
CN	China	MX	Mexico
DE	Germany	NZ	New Zealand
IN	India	PH	Philippines
KR	Republic of Korea	PL	Poland

- The national law applicable by some of these Offices may nevertheless provide for other forms of protection against loss of rights - for further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant's Guide*, National Phase



# Entry into the National Phase before CNIPA



# Entry into the national phase of China

- What to protect: invention patent or utility model, patentable subject matter
- When: 30 months (may be extended)
- Acts to be performed:
  - Form specifying bibliographic data and other info
  - Translation of application documents
  - Applicable fees
  - Other documents where applicable
- Special issues: name of inventor; appointment of an agent; request for substantive examination

# Conditions of establishing an entry date

- Application will be given a national phase entry date and a national application number if, within time limit
  - specifying international application number and requested kind of protection
  - Chinese translation of application, and
  - relevant fees paid
- Correction of the above possible but must be completed within the time limit for national phase entry
- Correction of other acts may be done upon invitation within the time limit specified in the invitation

# Best Practices

- May consider utility model in certain cases
- Appoint a local agent (access to CNIPA's e-filing system)
- Must meet the national phase entry time limit
- Utilize the special form (*Written statement for entering the Chinese national phase*)
- Take advantage of PCT-PPH
- Request for extension of time limits beforehand
- Appreciate voluntary amendments opportunities



# Entry into the National Phase before the JPO

# National Phase entry before DO/JP

## ■ Time Limit

- 30 months from the priority date

## ■ Requirements

- Furnishing a transmittal form: Form No.53
- The national fee: JPY 14,000
- Agent is mandatory, if the applicant is not resident in Japan**
  - Who can act as agent?
    - Patent attorney, who registered to practice before the JPO
- Translation

# National Phase entry before DO/JP

- (Translation continue)
  - Description, claims, drawings (if any text matter), and abstract
  - Amended claims under Art 19 and/or Art 34
  - When Form No.53 is submitted within two months before the expiration of 30 months from the priority date, the translation may be filed within two months from the date of submission of Form No.53
- Request for examination
  - Time limit: 3 years from the IFD
- Recent amendment to the Japanese national laws



# Entry into the National Phase before the KIPO

# Entry into the KR national phase

- Types of protection: patent or utility model
- Assignment of agent
- Time limit
  - 31 months from the priority date
  - Translation of description, claims, drawings and abstract may be postponed to 32 months
- Request for Examination
  - NOT required to be made upon entry, but should be made within a certain period
  - Possible reduction of the fee



# Other considerations for KR

- Safeguards with translation
- Non-prejudicial disclosure
  - 12 months “Grace period”
- Incompatibility with PCT Regulations at DO/KR
  - Restoration of Priority Right (Rule 49*ter*)
  - Reinstatement of Rights (Rule 49.6)
  - Incorporation by Reference (Rule 20.8(b))
- Accelerated examination

# Q1: Additional Time for Entering the National Phase

- Is any additional time provided to enter the national phase before your respective DO or to respond to invitation from the DO?

## Q2: Correcting Translation Errors in the National Phase

- If there is a mistake in a translation furnished for national phase entry, can the applicant still fix that mistake during the national phase?

# Q3: Submission of Priority Document During the National Phase

- If the applicant did not furnish a priority document during the national phase entry, can they still submit it during the national phase?
- Will the applicant be invited to do so?

# Q4: Reinstatement of Withdrawn IA in the National Phase

- If an international application was declared withdrawn during the international phase, is it still possible to have it reinstated during the national phase? Are there any specific considerations before the respective DOs?

# Q5: Restoration of Priority Rights and Incorporation by Reference in National Phase

- Will your DOs accept the restoration of a priority right, and if so, under which criteria?
- What about incorporation by reference?



# Questions?

