



Best Practices for Filing a PCT Application

WIPO PCT Webinar Series

Session 1

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Preparing to file

Decision-making process

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graph TD; A[Decision-making process] --> B[Legal requirements]; B --> C[Tools for filing]; C --> D[Ready to file];
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Legal requirements

Tools for filing

Ready to file

Poll questions

Decision making

- Leave enough time before the 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

Choice of Receiving Office

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

Choice of International Searching Authority

- 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

Before filing a PCT application (1)

- State-of-the-art docketing system in place
 - Two independent systems
 - Second pair of eyes review
- Know your RO
 - filing methods available
 - payment methods
 - closing dates
 - languages accepted

Before filing a PCT application (2)

- 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

- Prepare standard-compliant sequence listing

- Review need for any foreign filing licenses

E-filing tips

- Used a web-based e-filing system like ePCT over stand-alone filing software
- Give all your electronic files clear and distinctive names
- Double-check that the correct files have been attached
- Preview drawings and know how to deal with color or greyscale
- Check for possible conversion errors
- Always submit pre-converted files if accepted by RO
- Electronic signature requirements

Preparing the Request Form (1)

- 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
- Representation: agent, common representative or address for correspondence?
- Exclusion of certain designations? Special situation of DE, JP or KR

Preparing the Request Form (2)

- Correctly indicate all priority claims
- Correctly indicate your sequence listing in check list
 - Ideally, only file one copy of a sequence listing and in .txt format
- Make use of PCT declarations
- Consider submitting a PCT Direct letter (where applicable)
- If you are about to miss the priority period
 - Always have a plan B ready
 - Try to rely on time differences and Offices' closed dates
 - Request restoration of the priority right

After filing

- Once filed, view what you have submitted, on the date of submission, through electronic file access systems, if available
- If a mistake has been made:
 - Same day corrections
 - Incorporation by reference
 - Not a perfect solution
 - Notices of incompatibility by certain Offices
- Monitor receipt of Forms PCT/RO/105 and PCT/IB/301

Poll answers

Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

E-mail: pct.infoline@wipo.int

■ Questions about ePCT

□ Contact PCT eServices Help Desk:

Telephone: +41 22 338 83 38

E-mail: pct.eservices@wipo.int

■ Subscribe to WIPO Newsletters

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