

PCT NEWSLETTER

www.wipo.int/pct/en

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Information on the functioning of the Saudi Authority for Intellectual Property (SAIP) as ISA/IPEA

Further to the announcement in the October issue of the *PCT Newsletter* No. 10/2024 that the Saudi Authority for Intellectual Property (SAIP) (two-letter code: SA) will begin operating as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) as of 15 December 2024, the Agreement between the Office and the International Bureau of the World Intellectual Property Organization in relation to the functioning of the SAIP as an ISA and IPEA, as in force from the same date, has been published in English and French at, respectively:

https://www.wipo.int/pct/en/texts/agreements/ag_sa.pdf

https://www.wipo.int/pct/fr/texts/agreements/ag_sa.pdf

Detailed information on the Office in its capacity as ISA and IPEA has been published in the *PCT Applicant's Guide* (please refer to the "Advance notice" indicating the changes that will be effective from 15 December 2024, containing the future Annexes D and E at <https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=SA&doc-lang=en>), and the fees payable to the Office have also been published in the PCT Fee Tables.

European Patent Office as ISA: CNIPA/EPO Pilot

It is recalled that, on 1 December 2020, the China National Intellectual Property Administration (CNIPA) and the European Patent Office (EPO) began a pilot to allow PCT applicants who are nationals or residents of China to select the EPO, in addition to the CNIPA, as competent International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) for international applications filed with the CNIPA or the International Bureau (IB), as receiving Office.

Pursuant to the consensus reached by the CNIPA and the EPO, with effect from 1 December 2024 applicants filing their international applications with the CNIPA as receiving Office and choosing the EPO as ISA will pay the international search fee to the CNIPA in Chinese Yuan renminbi (CNY).

Don't miss out on our upcoming PCT Seminars, Webinars, and other PCT-related events – consult the PCT Seminar Calendar in this issue!

PCT Information Update

GH Ghana (e-mail and internet addresses; time when the name and address of the inventor must be provided)

The e-mail and Internet addresses of the Registrar General's Department (Ghana) have changed, as follows:

E-mail: info@rgd.gov.gh
ip@rgd.gov.gh

Internet: <https://rgd.gov.gh/Patent.html>

The Office has also modified its requirements concerning the time when the name and address of the inventor must be provided if Ghana is designated (or elected), as follows:

The name and address of the inventor may be in the request or may be furnished later. If not already complied with within the time limit applicable under PCT Article 22 or 39(1), the Office will invite the applicant to comply with the requirement within a time limit fixed in the invitation.

(Updating of *PCT Applicant's Guide*, Annex B (GH))

IR Islamic Republic of Iran (location and mailing address; telephone number; fax number)

The location and mailing address, and the telephone and fax numbers of the Intellectual Property Center (Islamic Republic of Iran) have changed, as follows:

Location and mailing address: Mellat Building, Phayazbakhsh Ave.
Imam Khomeini Square
Tehran 1114678111
Islamic Republic of Iran

Telephone: (98-21) 6392 3361

Fax: (98-21) 6675 1799

(Updating of *PCT Applicant's Guide*, Annex B (IR))

ME Montenegro (name of Office)

The name of the Ministry of Economic Development and Tourism (Montenegro) has changed as follows:

Name of Office: Ministry of Economic Development (Montenegro)

(Updating of *PCT Applicant's Guide*, Annex B (ME))

PT Portugal (fees)

There has been a change in the amounts of the following fees, payable to the National Institute

of Industrial Property (Portugal) as receiving Office with effect from 1 July 2024:

Transmittal fee:

- online filing:.....	EUR	12.31
- paper filing:	EUR	24.60

Fee for priority document:

- electronic copy:.....	EUR	18.46
- paper copy:.....	EUR	49.19

Fee for requesting restoration of the right of priority:

- online:	EUR	184.49
- on paper:.....	EUR	368.98

The amounts of the following national fees, payable to the Office as designated (or elected) Office, have also changed with effect from the same date:

For patent:

Filing fee (includes publication and examination):

- online:	EUR	123.00
- on paper:.....	EUR	246.00

For utility model:

Filing fee (includes publication and examination):

- online:	EUR	215.24
- on paper:.....	EUR	430.48

(Updating of *PCT Applicant's Guide*, Annex C (PT) and National Chapter, Summary (PT))

RU Russian Federation (fees)

The amounts of the following fees, payable to the Federal Service for Intellectual Property (Rospatent) (Russian Federation) as receiving Office, have changed with effect from 5 October 2024:

Transmittal fee:.....	RUB	2,000
Fee for priority document:.....	RUB	3,000
Fee for requesting restoration of the right of priority:.....	RUB	2,000

There has also been a change in the amounts of the following national fees, payable to the Office as designated (or elected) Office, with effect from the same date:

For patent:

Filing fee:.....	RUB	4,000
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Examination fee¹:

- for one independent claim:.....	RUB	14,000
- for each independent claim in excess of one:	RUB	10,000
Annual fee for the sixth year.....	RUB	3,000

For a utility model:

Filing fee:	RUB	2,000
Annual fee for the sixth year.....	RUB	3,000

Furthermore, the Office has notified a change in the conditions for exemptions, reductions or refunds of national fees – the 30% reduction of the filing fee, examination fee and reinstatement fee, where the application and all required documents are filed online, is no longer applicable with effect since 5 October 2024.

(Updating of *PCT Applicant's Guide*, Annex C (RU) and National Chapter, Summary (RU))

International filing fee, search fee, supplementary search fee and handling fee (various Offices)

On 1 January 2025, there will be changes in the equivalent amounts, in certain currencies, of the international filing fee, the fee per sheet over 30, the electronic filing reductions (where applicable) listed in item 4 of the Schedule of Fees, the search fee, the supplementary search fee and the handling fee, as indicated in the PCT Fee Tables.

These changes are reflected in the following annexes of the *PCT Applicant's Guide* (<https://www.wipo.int/pct/en/guide/>):

- Annex C (receiving Offices): AM, AP, AT, AU, AZ, BA, BG, BH, BW, BY, BZ, CA, CL, CN, CR, CV, CY, CZ, DE, DJ, DK, DO, EA, EC, EE, EG, EP, ES, FI, FR, GB, GE, GH, GR, HN, HR, HU, IB, IE, IL, IN, IQ, IS, IT, JM, JO, JP, KE, KG, KH, KZ, LR, LT, LU, LV, MD, MT, MW, MX, NI, NL, NO, NZ, OM, PA, PE, PG, PH, PT, QA, RO, RS, RU, SA, SC, SE, SG, SI, SK, SV, SY, TJ, TM, TT, UA, UG, US, UZ, WS, ZA, ZM, ZW;
- Annex D (International Searching Authorities): All;
- Annex SISA (International Searching Authorities (Supplementary Search)): All; and
- Annex E (International Preliminary Examining Authorities): AT, AU, CA, CL, CN, EA, EG, EP, ES, FI, IL, IN, JP, KR, PH, RU, SA, SE, SG, UA, US, XN, XV.

Search fee and other fees relating to the international search (European Patent Office (EPO), Federal Service for Intellectual Property (Rospatent) (Russian Federation); *corrigendum*)

As from 5 October 2024, there has been a change in the amounts payable in RUB for an international search carried out by the Federal Service for Intellectual Property (Rospatent) (Russian Federation). The new amounts are indicated in Fee Table I(b). The amounts of other

¹ Where the request for substantive examination is filed upon entry into the national phase.

fees have also changed, as follows:

Additional search fee:

For a search carried out in Russian:	RUB	9,000
For a search carried out in English:.....	RUB	45,000
Protest fee:	RUB	4,000
Late furnishing fee:	RUB	5,000

See also “International filing fee, search fee, supplementary search fee and handling fee (various Offices)”, above, for information on the search fee payable with effect from 1 January 2025.

As from 1 December 2024, there will be changes in the equivalent amounts payable in the currencies specified below for international searches carried out by the following Offices:

European Patent Office (EPO)	CNY
Federal Service for Intellectual Property (Rospatent) (Russian Federation)	CHF, EUR, USD

Corrigendum: The changes in the equivalent amounts payable for international searches carried out by the Intellectual Property Office of the Philippines, with effect from 1 December 2024 which were published in *PCT Newsletter* No. 10/2024, should have read in CHF and EUR only, and not in USD.

(Updating of *PCT Applicant’s Guide*, Annex D (EP and RU))

Preliminary examination fee and other fees relating to international preliminary examination (Federal Service for Intellectual Property (Rospatent) (Russian Federation)

As from 5 October 2024, there has been a change in the amount of the preliminary examination fee, payable in RUB to the Federal Service for Intellectual Property (Rospatent) (Russian Federation) as International Preliminary Examining Authority, as indicated in Fee Table II. The amounts of other fees will also change, as follows:

Additional preliminary examination fee:

For an examination carried out in Russian:	RUB	6,000	(7,000) ²
For an examination carried out in English:	RUB	21,000	(25,000) ²
Protest fee:	RUB	4,000	
Late furnishing fee:	RUB	5,000	

(Updating of *PCT Applicant’s Guide*, Annex E (RU))

² The fee in parentheses applies where the international search report was prepared by the Federal Service for Intellectual Property (Rospatent) (Russian Federation).

Supplementary search fee (Federal Service for Intellectual Property (Rospatent) (Russian Federation))

With effect since 5 October 2024, there will be a change in the amount payable in CHF for a supplementary international search carried out by the Federal Service for Intellectual Property (Rospatent) (Russian Federation).

The new amount is indicated in Fee Table I(c).

(Updating of *PCT Applicant's Guide*, Annex SISA (RU))

Non-Working Days at the International Bureau and Publication Schedule at the End of this Year

Non-working days at the International Bureau

The non-working days at the International Bureau (IB) in December 2024 and January 2025, in addition to the weekends, will be:

Wednesday, 25 December 2024

Tuesday, 31 December 2024 and

Wednesday, 1 January 2025

The IB will therefore be open for business over the holiday period from Thursday, 26 to Friday 27 December 2024 and on Monday, 30 December 2024, and will then be open as usual from Thursday, 2 January 2025.

The dates of operation of the PCT Information Service, the PCT Operations Customer Support Section (PCT eServices) and the PCT Operations Division, as well as information on the publication schedule, are given below.

PCT Information Service

The PCT Information Service will be closed from Tuesday, 24 December 2024 to Wednesday, 1 January 2025, inclusive. It will reopen on Thursday, 2 January 2025. Please note, however, that if you call the PCT Information Service (telephone number: (41-22) 338 83 38) during the holiday period, there will be a recorded message providing a telephone number for cases requiring urgent attention.

It is recalled that the PCT Information Service answers general inquiries about the filing of international applications and the procedure to be followed during the international phase of the PCT (questions relating to specific applications should be addressed to the PCT Operations Division). For further information, please refer to:

<https://www.wipo.int/pct/en/infoline.html>

PCT eServices and PCT Operations service

The schedule for the PCT eServices and the PCT Operations service during the end-of-year holiday period will be as follows:

Wednesday, 25 December 2024: closed

Thursday, 26 December
to Monday, 30 December 2024: open as usual, from 9:00 to 18:00 CET

Tuesday, 31 December 2024
and Wednesday, 1 January 2025: closed

Thursday, 2 January 2025, onwards: open as usual, from 9:00 to 18:00 CET

It is recalled that:

- PCT eServices responds to inquiries related to services for the purpose of preparing, filing and managing applications electronically: ePCT (<https://pct.wipo.int/ePCT/>) and the WIPO Digital Access Service (DAS) (<https://www.wipo.int/en/web/das>);
- PCT Operations answers specific application-related inquiries. Please note that PCT Operations consists of 10 teams. In order to find the generic e-mail address and telephone number of the competent team, please either check Form PCT/IB/301 or refer to:

<https://pct.wipo.int/ePCTExternal/pages/TeamLookup.xhtml>

Publication schedule

During the forthcoming holiday period, PCT applications will be published, as usual, on Thursday, 26 December 2024 and on Thursday, 2 January 2025. There will be no changes to the deadlines for receipt of changes which should be taken into account for the purposes of international publication (which will be, respectively, midnight (CET) on Tuesday, 10 December 2024 and Tuesday, 17 December 2024).

Upcoming Webinars on PCT

WIPO PCT consultant Carl Oppedahl has organized a series of seven webinars that will take place between November and December 2024, on best practices and choices available when filing a PCT application.

The webinars are aimed at patent attorneys and agents, paralegals and legal assistants who handle Patent Cooperation Treaty (PCT) patent prosecution.

Registration is free and is available at:

<https://www.wipo.int/pct/en/seminar/webinars/index.html>

and at the following link, together with more detailed information:

<https://blog.oppedahl.com/pct-webinars/>

Carl will also be independently hosting an in-person PCT seminar in Aurora, Colorado from 7 to 9 January 2025 for patent attorneys, paralegals and patent agents, in private or corporate practice, who use the PCT system. The program will include 2½ days covering strategic topics relating to the PCT followed by a half-day session dedicated to PCT docketing.

World Intellectual Property Indicators 2024

The 2024 edition of the World Intellectual Property Indicators report is now available in English

at:

<https://www.wipo.int/publications/en/details.jsp?id=4759>

This authoritative annual report analyzes IP activity around the globe. Drawing on 2023 filing, registration and renewal statistics from national and regional IP offices and WIPO, it covers patents, utility models, trademarks, industrial designs, microorganisms, plant variety protection and geographical indications. The report also draws on survey data and industry sources to give a picture of activity in the creative economy.

Highlights from the World Intellectual Property Indicators have been published in Press Release PR/2024/927 in English, as well as in Arabic, Chinese, French, German, Japanese, Portuguese, Russian and Spanish at:

https://www.wipo.int/pressroom/en/articles/2024/article_0015.html

Languages other than English can be selected at the top of the page.

New/updated PCT Resources

Applicability of 90% reduction in certain PCT fees

The table showing the applicability of the 90% reduction in certain PCT fees has been updated with effect from 1 January 2025 and is available at:

http://www.wipo.int/pct/en/fees/fee_reduction.pdf

Note that the table showing the status prior to 1 January 2025 will continue to be available, in parallel, for a few months.

Materials for the European Qualifying Examination

In order to assist candidates in the preparation of materials for the European Qualifying Examination (EQE) for prospective European patent attorneys or for the European Patent Administration Certification (EPAC) for patent administrators, the International Bureau, with the agreement of the Examination Board for the EQE and the EPAC Board, has made available on the PCT website a special edition of the PCT Applicant's Guide containing individual annexes and the introductions to the "International Phase" and the "National Phase" in both English and French, as of 31 October 2024. It is recalled that the PDF files have been replaced by a searchable and comprehensive application that will be available for the EQE.

The application is available at:

<https://pctlegal.wipo.int/eGuide/eqe/documents.xhtml>

PCT International Authorities quality reports

It is recalled that the International Searching and Preliminary Examining Authorities submit annual reports on the quality management systems that have been implemented for their work

as International Authorities³. The reports for 2023 are now available at:

<https://www.wipo.int/pct/en/quality/authorities.html>

Enhancement of the *PCT Applicant's Guide*

In order to improve the readability of the various Annexes of the *PCT Applicant's Guide* and optimize the overall experience of users, the endnotes and related information in all Annexes have been integrated into the main body of the text of each Annex for all Contracting States and Offices.

This new format aims to improve data presentation and increase navigation efficiency making it easier to access relevant content. Additionally, changes and updates that are usually highlighted in blue in the Annexes and digest functionality, will now also apply to all integrated information (for more details on change highlighting in the eGuide, please refer to the 'Practical Advice' in *PCT Newsletter* No. 09/2023 at: https://www.wipo.int/pct/en/newslett/practical_advice/pa_092023.html).

We highly value your feedback and encourage all PCT users and Offices to share comments and suggestions with us at the following address: pct.guide@wipo.int. Your input is essential in helping us continually improve and provide the highest level of service.

Practical Advice

Options for action following the international search

Q: I filed my PCT application and have received the international search report and the written opinion from the International Searching Authority. I wish to address the issues raised in the written opinion and thereby hopefully increase my chances of obtaining patent protection in the national phase. What can I do to achieve this objective and how?

A: The purpose of the international search is to discover any relevant prior art. The results of the international search are set out in the international search report (ISR). The International Searching Authority (ISA) also establishes a written opinion (WOSA) providing a non-binding opinion on the question of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. By bringing relevant prior art to the attention of the applicant, the international search enables the applicant to make informed decisions on any subsequent actions to be taken, including potentially making amendments during the international phase with effect in all Contracting States before pursuing patent protection in the national phase.

In order to better understand your options at this stage of your application, and so that you can make better use of the PCT System, here are some general options you may wish to consider:

Amendments under PCT Article 19

After receiving the ISR, you may file amendments to the claims with the International Bureau (IB) (not with the receiving Office or the ISA) under PCT Article 19.

³ In accordance with the PCT International Search and Preliminary Examination Guidelines, paragraphs 21.31 and 21.32 (<https://www.wipo.int/pct/en/texts/gdlines.html>).

The filing of amended claims is free of charge. They will be published by the IB, and the ISA will not carry out a second international search. Any amended claims will only be examined in the international phase if you file a demand for international preliminary examination.

Submitting amended claims under PCT Article 19 may be useful if there is a reason to better define the scope of the claims for the purposes of provisional protection in designated States the national laws of which provide for such protection.

The amendments should not go beyond the disclosure in the international application as originally filed. The time limit for filing amendments under PCT Article 19 is, in accordance with PCT Rule 46.1, two months from the date of transmittal (that is, the date of mailing) of the ISR by the ISA, or 16 months from the priority date, whichever time limit expires later. Any such amendments received by the IB after the expiration of the applicable time limit will be considered to have been received on time if they are received before the technical preparations for international publication have been completed.

Amendments under PCT Article 19 should comprise:

- (i) a complete set of claims in replacement of the claims originally filed;
- (ii) a letter which must indicate the differences between the claims as filed and those as amended; the letter must also indicate the basis for the amendment to the claims with specific references to particular parts of the application (description, claims, drawings) as originally filed; and
- (iii) an optional statement under PCT Article 19 explaining the amendments and how they would help overcome the objections raised in the WOSA. Any such statement will also be published.

Helpful information in relation to the letter under (ii) and the statement under (iii) can be found in the 'Practical Advice' of *PCT Newsletter* No. 09/2010 available at:

https://www.wipo.int/edocs/pctndocs/en/2010/pct_news_2010_09.pdf

Demand for international preliminary examination under Chapter II of the PCT⁴

You may also consider filing a demand for international preliminary examination under Chapter II of the PCT (please refer to PCT Article 31 in connection with PCT Rule 53).

According to PCT Rule 54*bis*, the time limit for filing a Chapter II demand is three months from the date of transmittal of the international search report to the applicant or 22 months from the priority date, whichever expires later.

When filing the demand or during international preliminary examination, you may submit amendments not only to the claims, but also to the description and/or the drawings under PCT Article 34. You may also submit arguments relating to the observations raised in the written opinion. This gives you the possibility to formally respond to the written opinion.

The demand should be filed with the competent International Preliminary Examining Authority (IPEA), together with the payment of the associated fees (provided in Table II of the PCT Fee Tables at <http://www.wipo.int/export/sites/www/pct/en/fees.pdf>). The results of any international

⁴ The instrument of accession deposited by Uruguay contained a reservation that it will not be bound by Chapter II of the PCT, and so it will not be automatically elected in any demand filed in respect of an international application filed on or after 7 January 2025.

preliminary examination are reflected in an international preliminary report on patentability (IPRP II) established by the IPEA, and the IB will also receive a copy and communicate it to the elected Offices.

If you consider filing a demand, your attention is drawn to two articles in the 'Practical Advice' of the *PCT Newsletter*:

- 04/2010: "Factors to be considered when deciding whether or not to file a demand for international preliminary examination – Part 1", available at https://www.wipo.int/edocs/pctndocs/en/2010/pct_news_2010_04.pdf, pages 8 to 11; and
- 05/2010: "Factors to be considered when deciding whether or not to file a demand for international preliminary examination – Part 2", available at https://www.wipo.int/edocs/pctndocs/en/2010/pct_news_2010_05.pdf, pages 8 to 11.

Informal comments on the Written Opinion of the International Searching Authority

If you do not wish to request international preliminary examination but still want to react to the findings of the ISA on an informal basis and without any further expense, you may file informal comments on the written opinion of the ISA, again with the IB and not the ISA. However, any such comments will not be examined during the international phase. They will simply be made publicly available on WIPO's PATENTSCOPE database at 30 months from the priority date as a document on file. It is then up to the designated Offices to determine whether, and to what extent, to take the informal comments into account in the national phase. Filing informal comments on the written opinion of the ISA does not preclude you from filing a demand for international preliminary examination but you will have to submit the informal comments directly to the IPEA if you would like them to be considered during international preliminary examination.

A Practical Advice entitled "Information on submitting informal comments to address issues raised in the written opinion of the International Searching Authority" is available in *PCT Newsletter* No. 01/2015 at:

https://www.wipo.int/edocs/pctndocs/en/2015/pct_news_2015_13.pdf

Doing nothing and waiting for the entry into the national phase

After receiving the results of the international search from the ISA, you may also simply do nothing and wait until you decide to proceed with your application for the entry into the national phase. This is typically the case where the ISR and WOSA did not contain any citation challenging the patentability of your application or any negative opinion. Even where they did contain a negative citation or opinion, there is no obligation to respond to these reports.

It is also important to note that applicants have, in the national phase, a further opportunity to amend the description, claims and drawings within at least one month from the time when the steps necessary to enter the national phase are performed (in accordance with PCT Articles 28 and 41 and Rules 52 and 78, as the case may be). In some cases, it may be preferable to address any issue identified in the ISR and WOSA by filing amendments with specific designated Offices in the national phase.

