Best practices in the national phase

Session 3
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, TZ and UG continue to apply a 20-month time limit
Prepare for national phase entry

- Take relevant decisions as early as possible
- Double-check names of applicants to allow for last-minute 92bis requests
- Provide local agent with all relevant information (via ePCT?)
- Instruct local agent how to further prosecute the case
  - National phase amendments?
  - How to argue the case
  - Continue to provide local agent with information
Use of PCT-PPH?

■ Some benefits:
  - Reduces duplication of effort via patent office work-sharing
  - Increases grant rate
  - Reduces pendency and legal uncertainty
  - Streamlines prosecution
  - Reduces cost (by reducing number of office actions)

■ Procedural requirements
Time limit issues

■ The time limit to enter national phase applies irrespective of possible delays in the international phase

■ Where national phase entry time limit has been missed:

  □ Does Rule 49.6 apply?
    ▪ If yes, which criterion is applicable?
    ▪ Which time limit applies?

  □ Cases, where Rule 49.6 does not apply
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
- CN China
- DE Germany
- IN India
- KR Republic of Korea
- LV Latvia
- MX Mexico
- NZ New Zealand
- PH Philippines
- 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
Translation issues

- Most Offices require translation of international application as filed and as amended
- Translations must be accurate
- Text matter in drawings
- Defects in translations?
Amendments under national law

- PCT guarantees opportunity to amend application in the national phase
- Details of amendment practice are governed by national law
- Adapt claim drafting to national preferences
- Reduce number of claims to avoid/reduce claims fees
  - Special cases: CN, DE, IN
- Time limit
Special national requirements

- Time limit under Rule 51bis.3
- Declarations should now pay off
- Translation of the priority document (Rule 51bis.1(e))
Is your agent requiring more than he/she should?

■ Legitimate cases:
  - Original priority document where document was not furnished in time during international phase
  - Proof or evidence concerning recorded changes under Rule 92bis
  - By pass route in the US

■ Not so legitimate cases:
  - Does request come from the Office?
  - Clarify with International Bureau
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