Best practices in the PCT international phase

Session 2
Correction of defects -

your second chance....
Correction of defects (1)

- Rule 19.4 cases
  - no transfer of fees already paid from RO to RO/IB

- Lack or insufficient payment of fees
  - Avoid such situations from the start
  - React quickly to Forms PCT/RO/102 and 133

- Incomplete, erroneous or missing priority claim
  - Use Form PCT/IB/301 to verify if priority information is correct
  - Know your time limits under Rule 26bis
  - Rule 91 can be used in some cases
Correction of defects (2)

- Formal defects (Rules 11 and 26)
  - React to invitations to correct (Form PCT/RO/106)
  - Time limit is extendable
  - You can correct without being invited
Correction of defects (3)

- Incorporation by reference
  - Only if missing part or element fully contained in earlier application
  - Priority claim cannot be added for this purpose
  - Invitation from RO can extend the 2-month time limit from filing
  - Diverging practices where an incorrect set of claims and/or description have been filed
Correction of defects (4)

- Restoration of the priority right
  - Do it now or later?
  - Respect time limit to furnish statement of reasons
  - Priority claim can be added for this purpose
  - Solid explanation required for due care (see also paragraphs 166A-P of ROGLs)
Correction of defects (5)

■ Final review: before designated Offices (Articles 24(2), 25, 26, 39(3) and 48, Rules 82bis and 82ter)
  • Time limits apply
  • Resolution depends on national law
Other procedural issues...
Time limits under the PCT

- How time limits are calculated
- How to deal with lack of signatures
  - File response anyway
  - Careful in the case of withdrawals
- Extension of time limits
  - Rule 26
  - Rules 80.5, 80.6, 82 and 82quater
Requests for recording of changes

- 92bis requests should always be filed with IB

- Copies of assignment documents and/or powers of attorney required in some cases

- Submit request without signatures and/or proof or evidence to meet the time limit

- Check any Form PCT/IB/306 received for correctness
International Publication

- Publication

- Verify correctness and completeness of publication
- Preventing or postponing international publication
- Lack of payment of fees
Withdrawals (1)

- Always file with IB
  - Exception: withdrawals before record copy has been transmitted: file with RO

- How?
  - use “ePCT action”
  - or at least ePCT upload Form PCT/IB/372

- Safeguard: Use conditional language if anywhere near international publication
Withdrawals (2)

- Signatures
  - All applicants signatures are required
  - Submit without signatures to meet time limit?
    - will not work for 30-month time limit
    - Will, however, at least postpone publication
Amendments under Article 19

When they could be useful:

- To correct errors in claims
- To modify claims to address competitors’ products
- If ISR convincingly shows that your claims are clearly anticipated
- Provisional protection?
Chapter II procedure

- Filing of demand
  - Correctly identify application to which demand relates
  - What to submit together with demand:
    - Copy of Article 19 amendments
    - Article 34 amendments/arguments
    - Express request for an oral interview
  - Lack of payment of fees
PCT Resources/Information

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

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