



# Session 1: Best practices for the preparation and filing of PCT applications

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# Preparing to file (1)

## ■ Decision-making process

- Leave enough time before 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

## ■ State-of-the-art docketing system in place

- Two independent systems
- Second pair of eyes review

## ■ Review need for any foreign filing licenses

# Preparing to file (2)

## ■ Choice of RO?

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

## ■ Know your RO

- filing methods available
- payment methods
- closing dates
- languages accepted

# Preparing to file (3)

## ■ Choice of ISA?

- 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

# Preparing to file (4)

- 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

# Preparing to file (5)

- Choice of filing method: electronic beats paper
  - ❑ Ensure that your filing software is fully up-to-date (or use ePCT filing or similar web-based systems if you can...)
  - ❑ Give all your electronic files clear and distinctive names
  - ❑ Double-check that the correct files have been attached
  - ❑ Check for possible conversion errors
  - ❑ Always submit pre-converted files if accepted by RO
  - ❑ Electronic signature requirements

# Preparing to file (6)

## ■ Preparing the request form:

### □ Naming of the applicants:

- Impact of US AIA
- 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 to file (7)

- Preparing the request form (cont.):
  - 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
- If you are about to miss the priority period
  - Always have a plan B ready
  - Ways to extend the priority period
  - Request restoration of the priority right



# Claiming priority (PCT Article 8, Rule 4.10)

- The international application may contain a declaration claiming the priority of one or more earlier applications
  - filed in or, by way of a regional or international application, for any country party to the Paris Convention and/or
  - filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

# Furnishing of priority documents (Rule 17.1)

- Where the priority of an earlier national, regional or international application is claimed, the applicant must provide a priority document for each corresponding earlier application (that is, a certified copy of the earlier application)
  - by furnishing such document directly to the receiving Office or the International Bureau (Rule 17.1(a)), or
  - by requesting the receiving Office to prepare such document and transmit it to the IB (Rule 17.1(b)), if the earlier application was filed with that Office, or
  - by requesting the IB to obtain the priority document from a digital library (Rule 17.1(b-bis)) (only for Offices participating in the Digital Access Service (DAS))

# Declarations under Rule 4.17

- Purpose: possibility to anticipate certain national phase requirements during the international phase (Rule 51*bis*.2)
- Inclusion in request or subsequent filing is optional
- Declarations relate to the following matters (Rule 4.17):
  - identity of the inventor
  - applicant's entitlement to apply for and be granted a patent
  - applicant's entitlement to claim priority of an earlier application
  - declaration as to inventorship (for the US designation only)
  - non-prejudicial disclosures or exceptions to lack of novelty

# Minimum requirements for an international filing date (Article 11(1)) (1)

## ■ The application must contain at least:

- an indication that it is intended as an international application
- a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
- the name of the applicant (Rule 4.5)
- a description (Rule 5)
- a claim (Rule 6)

# Minimum requirements for an international filing date (Article 11(1)) (2)

## ■ Note that if:

- none of the applicants have the right to file with the receiving Office for reasons of residence or nationality (Rules 18 and 19); or
- the application is filed in a language not accepted by the receiving Office for that purpose (Rule 12.1),

the receiving Office will transmit the application to the receiving Office of the International Bureau for further processing (Rule 19.4)