

PCT | UPDATE & BEST PRACTICES



TUESDAY, JUNE 6 @ 11 AM ET

2023



PATENT PROSECUTION & PORTFOLIO MANAGEMENT MASTERS™ 2023

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JUNE 20-21, 2023 | IPWATCHDOG STUDIOS, ASHBURN, VA

CODE: PCT#2023



LIVE 2023

SEPTEMBER 17-19 | HYATT REGENCY DULLES

TOP THOUGHT LEADERS | TOP CONTENT



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Meet the Panelists



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President & CEO
IPWatchdog, Inc.



PCT Update and best practices

Webinar co-sponsored by WIPO's PCT Legal and User Relations Division

Mr. Matthias Reischle-Park
Deputy Director
PCT Legal and User Relations Division

June 6, 2023



PCT Contracting States and Statistics

PCT Contracting States (157)

States designated for regional protection and also, unless otherwise indicated, national protection

EA Eurasian Patent

AM Armenia
AZ Azerbaijan
BY Belarus
KG Kyrgyzstan
KZ Kazakhstan
RU Russian Federation
TJ Tajikistan
TM Turkmenistan

- Regional patent only

EP European Patent

AL Albania¹
AT Austria
* BE Belgium
BG Bulgaria
CH Switzerland
* CY Cyprus
CZ Czech Republic
DE Germany
DK Denmark
EE Estonia
ES Spain
FI Finland
* FR France
* GB United Kingdom
* GR Greece
HR Croatia¹
HU Hungary
* IE Ireland
IS Iceland

IT Italy²
LI Liechtenstein
* LT Lithuania
LU Luxembourg
* LV Latvia
• MC Monaco
* ME Montenegro³
MK North Macedonia¹
* MT Malta
* NL Netherlands
NO Norway
PL Poland
PT Portugal
RO Romania
RS Serbia¹
SE Sweden
* SI Slovenia
SK Slovakia
* SM San Marino
TR Türkiye

- 1 Extension agreement continues to apply to applications filed before 1 January 2008 (for HR), 1 January 2009 (for MK), 1 May 2010 (for AL) or 1 October 2010 (for RS)
- 2 For international applications filed on or after 1 July 2020
- 3 For international applications filed on or after 1 October 2022; extension agreement continues to apply to applications filed before 1 October 2022

PCT Contracting States (157) (continued)

States designated for regional protection and also, unless otherwise indicated, national protection

AP ARIPO Patent

BW	Botswana
CV	Cabo Verde (as of 14.10.2022)
GH	Ghana
GM	Gambia
KE	Kenya
LR	Liberia
LS	Lesotho
MW	Malawi
MZ	Mozambique
NA	Namibia
RW	Rwanda
SC	Seychelles (as of 01.01.2022)
SD	Sudan
SL	Sierra Leone
ST	Sao Tome and Principe
* SZ	Eswatini
TZ	United Republic of Tanzania
UG	Uganda
ZM	Zambia
ZW	Zimbabwe

OA OAPI Patent

* BF	Burkina Faso
* BJ	Benin
* CF	Central African Republic
* CG	Congo
* CI	Côte d'Ivoire
* CM	Cameroon
* GA	Gabon
* GN	Guinea
* GQ	Equatorial Guinea
* GW	Guinea-Bissau
* KM	Comoros
* ML	Mali
* MR	Mauritania
* NE	Niger
* SN	Senegal
* TD	Chad
* TG	Togo

* Regional patent only

PCT Contracting States (157) (continued)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	ID	Indonesia	MY	Malaysia
AG	Antigua and Barbuda	IL	Israel	NG	Nigeria
AO	Angola	IN	India	NI	Nicaragua
AU	Australia	IQ	Iraq (as of 30.04.2022)	NZ	New Zealand
* BA	Bosnia and Herzegovina	IR	Islamic Republic of Iran	OM	Oman
BB	Barbados	JM	Jamaica (as of 10.02.2022)	PA	Panama
BH	Bahrain	JO	Jordan	PE	Peru
BN	Brunei Darussalam	JP	Japan	PG	Papua New Guinea
BR	Brazil	** KH	Cambodia	PH	Philippines
BZ	Belize	KM	Union of the Comoros	QA	Qatar
CA	Canada	KN	Saint Kitts and Nevis	SA	Saudi Arabia
CL	Chile	KP	Democratic People's Republic of Korea	SG	Singapore
CN	China	KR	Republic of Korea	ST	Sao Tome and Principe
CO	Colombia	KW	Kuwait	SV	El Salvador
CR	Costa Rica	LA	Lao People's Democratic Republic	SY	Syrian Arab Republic
CU	Cuba	LC	Saint Lucia	TH	Thailand
CV	Cabo Verde (as of 06.07.22)	LK	Sri Lanka	** TN	Tunisia
DJ	Djibouti	LY	Libya	TT	Trinidad and Tobago
DM	Dominica	** MA	Morocco	UA	Ukraine
DO	Dominican Republic	** MD	Republic of Moldova	US	United States of America
DZ	Algeria	MG	Madagascar	UZ	Uzbekistan
EC	Ecuador	MN	Mongolia	VC	Saint Vincent and the Grenadines
EG	Egypt	MU	Mauritius (as of 15.03.23)	VN	Viet Nam
GD	Grenada	MX	Mexico	WS	Samoa
GE	Georgia			ZA	South Africa
GT	Guatemala				
HN	Honduras				

* Extension of European patent possible

** Validation of European patent possible

Countries not yet PCT Contracting States (36)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Democratic Republic of

Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Kiribati

Lebanon

Maldives

Marshall

Islands

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Solomon

Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

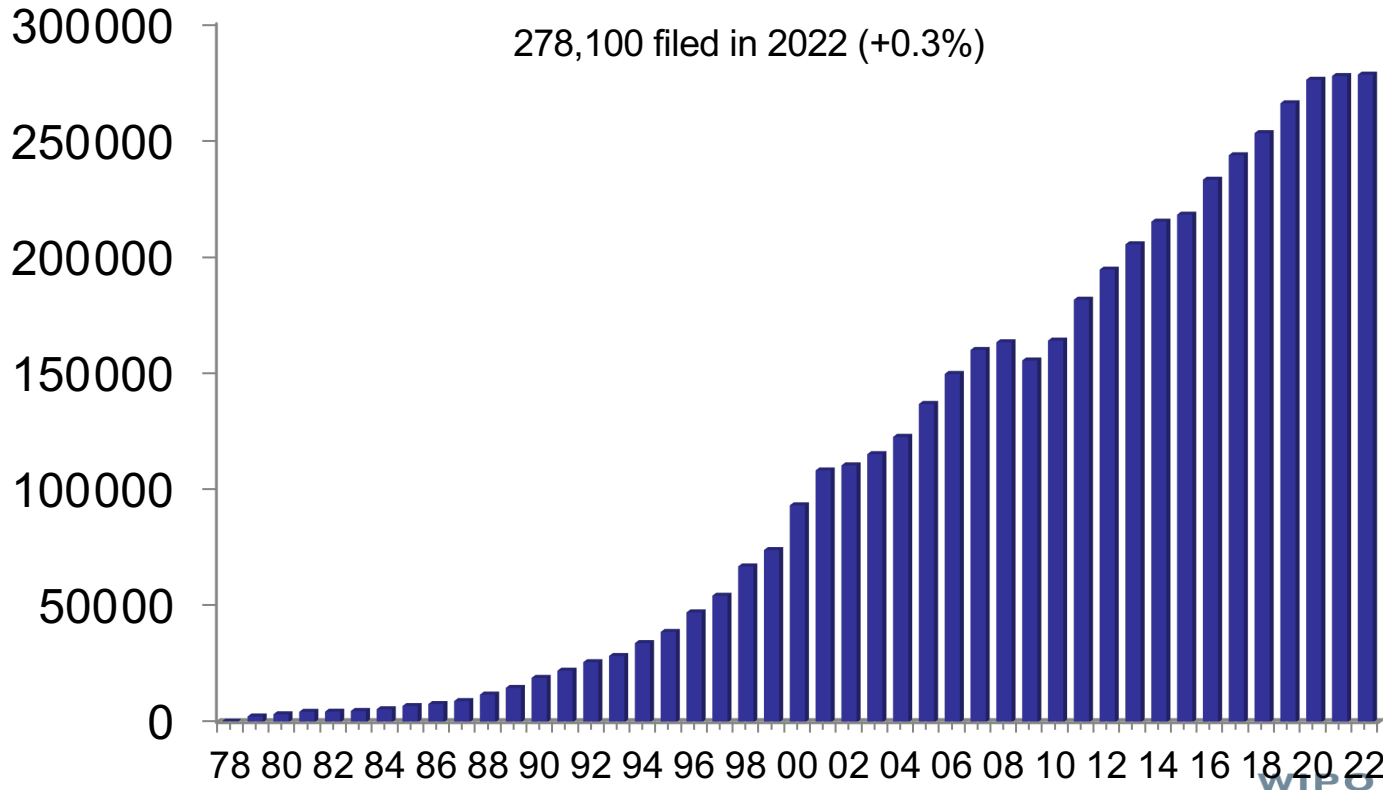
Uruguay

Vanuatu

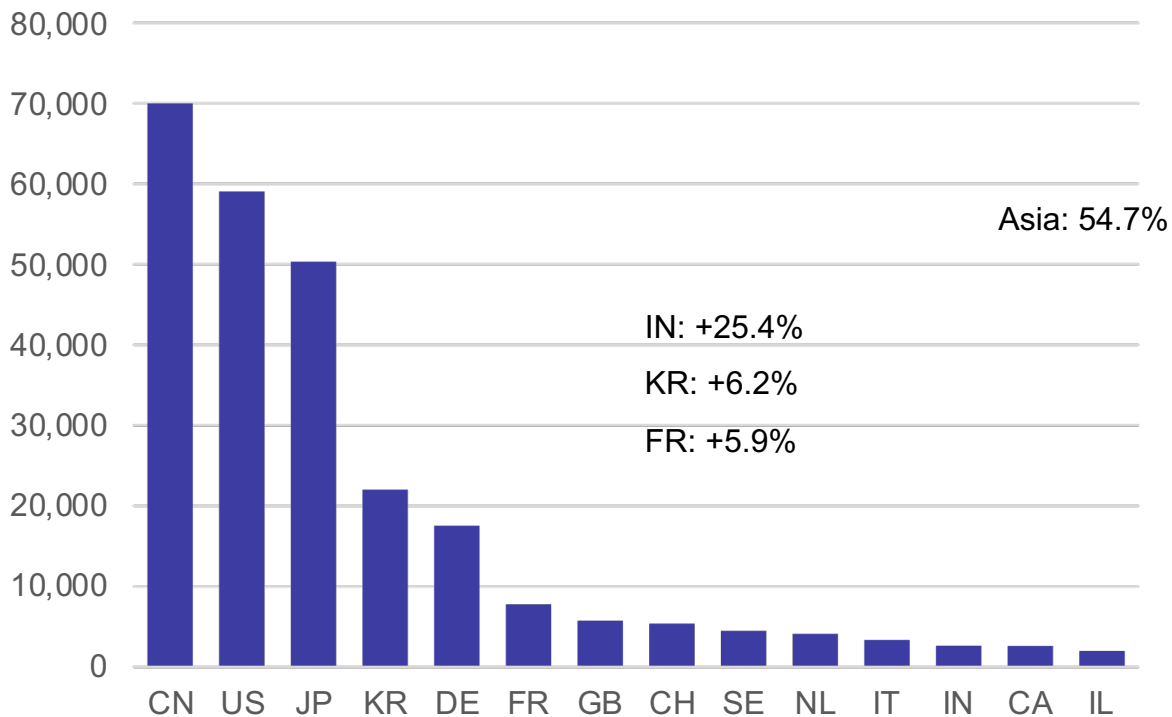
Venezuela

Yemen

Growth in PCT applications 1978-2022



International applications in 2022 by country of origin



- 25% originating in China, 21% in US, 18% in Japan
- 64% from the top 3 countries, 79% from top 5 countries, 92% of filings from top 15 countries

Top PCT applicants in 2022

1. Huawei Technologies—CN (7,689)
2. Samsung—KR (4,387)
3. Qualcomm—US (3,855)
4. Mitsubishi Electric—JP (2,320)
5. Ericsson—SE (2,158)
6. Guang Dong Oppo Mobile Telecom—CN (1,963)
7. Nippon Telegraph & Telephone—JP (1,884)
8. BOE Technology Group—CN (1,884)
9. LG Electronics—KR (1,793)
10. Panasonic—JP (1,776)
11. Vivo Mobile Communications—CN (1,515)
12. Sony—JP (1,513)
13. ZTE—CN (1,479)
14. NEC —JP (1,428)
15. Robert Bosch Corp —DE (1,290)

*() of published
PCT applications*

Top PCT University applicants in 2022

1. University of California (US)
2. Zhejiang University (CN)
3. Suzhou University (CN)
4. Stanford University(US)
5. University of Texas (US)
6. Tsinghua University (CN)
7. Massachusetts Institute of Technology (US)
8. Johns Hopkins University (US)
9. Seoul National University (KR)
10. Hanyang University (KR)
11. Yonsei University (KR)
12. Korea University (KR)
13. National University of Singapore (SG)
14. Jiangnan Universtity (CN)
15. Jiangsu University (CN)



Amendments to the PCT Regulations as from 1 July 2022

PCT Rule changes as of 1 July 2022 (1)

- Amendment of PCT Rules 5, 12, 13^{ter}, 19.4 and 49
 - ❑ ST.26 has replaced ST.25 as the standard on sequence listings
 - ❑ Revised Annex C of the Administration Instructions
 - ❑ All sequence listings must be provided in XML format
 - ❑ Language-dependent free text no longer needs to be repeated in the main part of the description
 - ❑ Free text may be filed in more than one language
 - ❑ Additional mandatory qualifier values for each sequence
 - ❑ More sequence types required to be included under ST.26

PCT Rule changes as of 1 July 2022 (2)

- Amendment of PCT Rules 5, 12, 13^{ter}, 19.4 and 49 (cont.)
 - Where the language of the free text or the electronic format is not accepted by the receiving Office, the application will be transmitted to RO/IB
- WIPO Sequence desktop tool
 - Enables applicants to author standard-compliant SLs
 - Available for download at <https://www.wipo.int/standards/en/sequence/index.html>
- Amended Rules apply to international applications filed on or after July 1, 2022
- The new Standard should also be used for the filing of national applications as of the same date

PCT Rule changes as of 1 July 2022 (3)

- Amendment of PCT Rule 82*quater*
 - “Epidemic” added as one of the emergencies listed
 - Allowing Offices to waive the requirement to provide evidence in excusing delays under Rule 82*quater*.1
 - Authorization for Offices to establish a period of extension for time limits in the case of *general disruptions*
- Amended Rule applies to time limits fixed in the Regulations that expire on or after July 1, 2022



Latest Discussions

Latest Discussions (1)

■ Mixed-Language International Applications

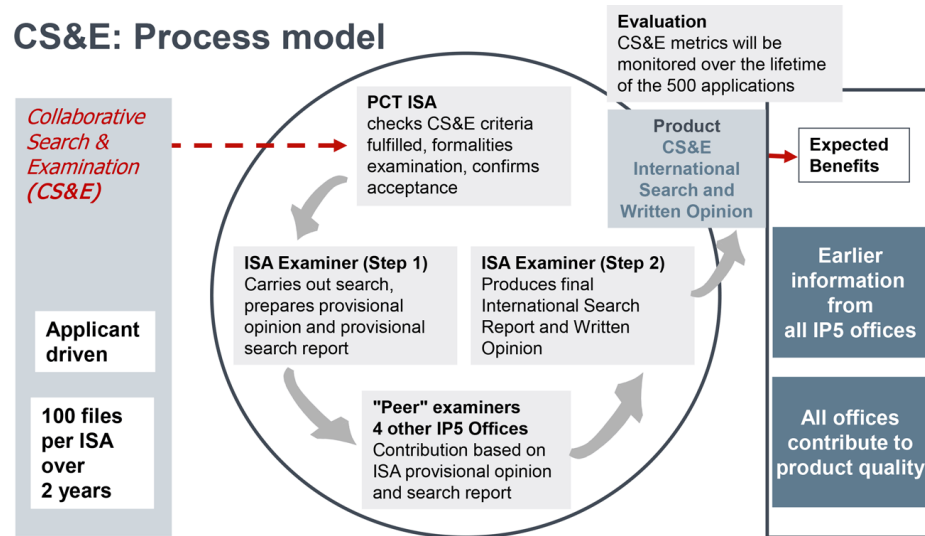
- Covers cases with more than one language and all languages are accepted by RO and selected ISA

■ New ISA:

- Appointment of Saudi Authority for Intellectual Property (SAIP) as an ISA/IPEA as the 25th ISA
- cf. the latest joined ISA was EA: Eurasian Patent Organization

Latest Discussions (2)

- The final assessment report on “IP5 Collaborative Search & Examination”
 - The pilot will conclude in June 2023
 - 100 files per Offices over the first two years



Latest Discussions (3)

■ eGUIDE: html based PCT Applicant's Guide is available

Old (PDF)

PCT Applicant's Guide – International Phase – Annex B1	
B1 Information on Contracting States	
AE UNITED ARAB EMIRATES	
General information	
Name of Office:	International Center for Patent Registration (United Arab Emirates)
Location and mailing address:	P.O. Box 3625, Sheikh Khalifa Bin Saeed Arab Emirates P.O. Box 901, Liwa Tower , Abu Dhabi, Unit
Telephone:	Dubai: (971-4) 14 15 81, 14 15 60 Abu Dhabi: (971-2) 613 14 02
Facsimile machine:	Dubai: (971-4) 385 10 77, 358 13 13 Abu Dhabi: (971-2) 626 36 34
E-mail:	icpr@economy.ae
Internet:	www.economy.gov.ae
Does the Office accept the filing	

New
(html)

AE UNITED ARAB EMIRATES
INTERNATIONAL CENTER FOR PATENT REGISTRATION, MINISTRY OF ECONOMY [UNITED ARAB EMIRATES]

Valid from **27 October 2022**

▼ **USEFUL INFORMATION**

The PCT Applicant's Guide is updated almost every week with information received by the International Bureau.
In case of question, please contact the Office or the International Bureau (icpr@wipo.int).

List of abbreviations used in this document:
Office: International Center for Patent Registration, Ministry of Economy [United Arab Emirates]
IPL: Federal Law No. 31 of 2006 Pertaining to the Industrial Regulation and Protection of Patents, Industrial D

List of currencies used in this document:
AED: UAE Dirham

List of related countries and Offices used in this document:
IB: [International Bureau of WIPO](#)
Refer to [List of WIPO Standards, Recommendations and Guidelines](#) (formerly Annex K. List of country names and two-letter code intergovernmental organizations (and their Offices) in documents relating to international applications under the PCT. The list is as set Also refer to [PCT Contracting States](#) (formerly Annex A).

Color drawings (1)

- Applications containing color or greyscale content
 - ❑ Not permitted in PCT applications (Rule 11)
 - ❑ Since applications often contain color or greyscale content, the IB has included some features in ePCT and PCT-SAFE
 - **ePCT-Filing** will automatically detect color or greyscale content and warn the applicant that the application content should be in black and white
 - **PCT-SAFE** allows applicants to indicate (checkbox) that the application contains color or greyscale content (only for filings with RO/IB)
 - ❑ A dedicated preview function has been made available by the IB in order to allow applicants to view the application content as it will be rendered by the IB
 - Directly available in ePCT-Filing
 - <https://pctdemo.wipo.int/DocConverter/pages/pdfValidator.xhtml>

Color drawings (2)

- Publication of applications containing color or greyscale content
 - The application will be converted into black and white format for further processing and publication by the IB
 - If the application contained color or greyscale content, the front page of the published PCT application will contain a notice to that effect
 - Any original color or greyscale content will be made available on PATENTSCOPE as part of the public application file
- Attention:
 - Designated Offices are not obliged to take the color or greyscale content into account, and may rely on the PCT application as published in black and white



Best practices in the PCT international phase

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 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 (3)

- 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 (4)

- 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

After filing (1)

- Once filed, view what you have submitted, on the date of submission, through electronic file access systems, if available
- If a mistake as been made:
 - Same day corrections
 - Incorporation by reference
 - Not a perfect solution
 - Diverging practices of Offices

After filing (2)

- Monitor receipt of Forms PCT/RO/105 and PCT/IB/301
- Priority documents
 - Best way: ask RO to prepare and transmit in request form
 - If not possible, use DAS
 - If not possible: order paper document

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 or erroneously filed 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
 - ❑ Negative RO/126: only ONE month to react
 - ❑ Notices of incompatibility by several Offices

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 82*bis* and 82*ter*)
 - Time limits apply
 - Resolution depends on national law

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

- Generate a “preview” of the international publication in ePCT and check for correctness
- Or at least, verify correctness and completeness after publication
- Preventing or postponing international publication
- Lack of payment of fees



Best practices in the national phase

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	LV	Latvia
CN	China	MX	Mexico
DE	Germany	NZ	New Zealand
IN	India	PH	Philippines
KR	Republic of Korea	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

PCT Resources/Information

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

Telephone: (+41-22) 338 83 38

E-mail: pct.infoline@wipo.int

- Contact the speaker:

Matthias.Reischle@wipo.int

+41-22-338-9627

Thank you!

