

Scope

The extract of the Practical Advice running from 1997-2010 is limited to those which are still assumed to be valid (*mutatis mutandis*) according to the PCT and its regulations and are considered as relevant for the EQE.

List of used abbreviations:

Art. Article, Articles of the PCT
 EQE European Qualification Examination
 IB International Bureau
 IPE International Preliminary Examination
 IPEA International Preliminary Examination Authority
 IPER International Preliminary Examination Report
 IPRP International Preliminary Report on Patentability
 ISA International Searching Authority
 ISR International Search Report
 R. Rule, Rules of the PCT

Please contact me at hansjoerg@kley.ch to report any errors, ask any questions and so forth.

Thank you in advance for your feedback!

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 edition of February 19, 2010 including
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Please observe the warning of the IB quoted below.

WARNING: Although the information which follows was correct at the time of original publication in the PCT Newsletter, some information may no longer be applicable; for example, amendments may have been made to the PCT Regulations and Administrative Instructions, as well as to PCT Forms, since the PCT Newsletter concerned was published; changes to certain fees and references to certain publications may no longer be valid. Wherever there is a reference to a PCT Rule, please check carefully whether the Rule in force at the date of publication of the advice has since been amended.

Content

SCOPE	1
CONTENT	1
1997-06	4
Lack of unity of invention: payment of additional search fees under protest; consequences of non-payment of additional search fees	4
1997-07	4
Parts of the request form missing upon filing the international application	4
1997-09	5
Different applicants for different designated States	5
1997-10	6
Adding applicants and/or inventors to the international application after the international filing date	6
1998-01	6
Appointment of common representative and agent of common representative	6
1998-02	7
Filing international applications by fax	7
1998-04	7
Submitting replacement sheets where physical requirements are not complied with	7

1998-05	8
Death of the applicant/inventor during the international phase 8	
1998-08	8
Furnishing of certified copies of earlier filed international applications as priority documents	8
1998-09	8
Requesting the addition (or correction) of a priority claim (→PCT R. 26bis.1)	8
1999-05	9
Priority claim considered not to have been made-possible remedial action by applicant	9
2000-02	10
Different applicants for different States designated for a regional patent	10
2000-03	10
Late receipt of invitation from receiving Office to correct physical defects in the international application	10
2000-11	11
Payment of fees which become due on a day on which the receiving Office is not open for business	11
2001-02	11
Filing of Declarations under new PCT R. 4.17	11
2001-03	12
Filing of declarations under new PCT R. 4.17 (second part)	12
2001-05	13
Inclusion of applicant's or agent's registration number in the request form	13
2001-08	14
Missing or defective abstracts	14
2001-09	14
Competent ISA where the international application is filed with the IB as receiving Office	14
2002-03	15
Filing a demand for international preliminary examination when the ISR is late	15
2002-04	15
Acting on behalf of the applicant when the agent of record is not available	15
2002-05	16
Time limit for requesting the recording of changes under PCT R. 92bis	16
2002-06	17
Documents to be submitted when requesting the recording of a change of applicant and/or agent	17
2002-07	17
Using an address for correspondence	17
2003-01	18
Withdrawal of priority claims to postpone entry into the national phase; effect of withdrawal of priority claim where national phase already entered before certain Offices	18

2003-02	19	2005-07	29
Documents required by the designated/ elected Office for entry into the national phase	19	Requesting the recording of changes during the international and national phases	29
2003-06	19	2005-09	30
Filing an international application in which the only applicant for one of the designated States is neither a resident nor a national of a PCT Contracting State.....	19	Reinstatement of rights after failure to pay fees for entry into the national phase.....	30
2003-11	20	2005-11	31
The non-designation of certain States in the new Request Form, applicable as from 1 January 2004	20	Determining the wording of the PCT Regulations on a particular date in the past.....	31
2004-01	20	2006-02	32
(1) Signature requirements for the withdrawal of the US designation.....	20	Maintaining the US designation where a US national application has already been filed.....	32
(2) The consequences of using an old version of the Request Form in respect of an international application filed on or after 1 January 2004	21	2006-03	32
2004-02	22	Obtaining copies of documents from the IB, in particular priority documents	32
The procedure for withdrawing designations	22	2006-04	33
2004-03	22	Withdrawal of designations of States which have special provisions concerning earlier national applications from which priority is claimed	33
Automatic designation of US: the consequences of the applicant/inventor being a resident and national of a non-PCT Contracting State	22	2006-05	34
2004-04	23	Availability of informal comments to third parties.....	34
Automatic designation of the US: indication of the inventors as “inventors only” where there is no intention to enter the national phase in the US.....	23	2006-06	34
2004-05	23	Consequence of the agent not being entitled to practice before the Office of the <i>country of residence and/or nationality of the applicant</i>	34
Automatic designation of all PCT Contracting States: alternative to withdrawing a designation where there is no intention to enter the national phase in that State.....	23	2006-08	35
2004-06	24	Requesting early entry into the national/regional phase	35
Applicability of power of attorney waivers	24	2006-11	36
2004-07	25	Information which is no longer required when submitting a declaration under PCT Rule 4.17.....	36
Requirement for the furnishing of powers of attorney under certain circumstances when submitting Article 19 amendments	25	2007-01	36
2004-09	25	Dangers of relying on failure to pay PCT fees when the applicant wants the international application to be withdrawn.....	36
PCT Forms issued in connection with the transmittal of copies of the published PCT application (PCT pamphlet).....	25	2007-04	37
2004-10	26	Restoration of the right of priority where the international application is filed more than 12 months from the filing date of the earlier application whose priority is claimed.....	37
Responses to the written opinion under Chapter I.....	26	2007-05	39
2004-12	27	Later furnishing of missing elements or parts of the international application	39
Consequences of the power of attorney waiver made by the IB	27	2007-06	41
2005-03	28	Submitting replacement drawings where no invitation to correct defects has been issued	41
Time limit for submitting a formal response to a written opinion of the ISA where a demand for international preliminary examination is being filed.....	28	2007-07	41
2005-05	29	Information available to third parties about a withdrawn priority claim.....	41
The filing of declarations of inventorship where there are several inventors	29	2007-08	43
2005-06	29	Access to the inventor’s address by third parties.....	43
The setting of fees payable during the international phase, and the establishment of the equivalent amounts of certain of those fees in various currencies	29	2007-09	44
		Late transmittal of the priority document.....	44
		2007-10	44
		The consequences of receiving a declaration of non-establishment of an international search report.....	44

2007-11	45	2009-03	57
Publication of a rectification of an obvious mistake after international publication	45	Payment of additional preliminary examination fees in case of earlier finding of lack of unity of invention by the International Searching Authority.....	57
2007-12	46	2009-05	57
Later submission of the abstract of the international application	46	Declaration of non-establishment of international search report: possible actions in the case of other related PCT applications filed later	57
2008-01	47	2009-06	58
Consequence of excluding a designation of a State under PCT Rule 4.9(b) where there is no claim of priority of an earlier national application filed in that State.....	47	International application considered withdrawn by receiving Office after having been accorded an international filing date58	
2008-02	47	2009-09	59
Filing an international application with a national receiving Office, and relying on that Office to transmit the application to the International Bureau as receiving Office under PCT Rule 19.4	47	Requesting the restoration of the right of priority under PCT Rule 26bis.3 where the receiving Office does not apply such provisions.....	59
2008-03	49	2009-10	60
Right to practice before an International Searching Authority and International Preliminary Examining Authority (where the agent is appointed for the whole of the international phase). 49		Choosing a receiving Office as a function of the criterion applied by it for restoring the right of priority	60
2008-04	49	2009-12	62
Appointing agents before the International Searching and Preliminary Examining Authority	49	Requesting the reinstatement of rights after missing the time limit for entry into the national phase	62
2008-05	50	2010-01	63
The transmittal of notifications to applicants by e-mail.....	50	Expiration of a time limit where an Office is situated in more than one locality	63
2008-06	51		
Signature requirements for withdrawals of designations.....	51		
2008-07	52		
Withdrawal of an international application after international publication but before the issuance of the ISR.....	52		
2008-08	52		
The consequences of a finding by the ISA of lack of unity of invention.....	52		
2008-10	53		
Seeking patent protection via the PCT in respect of States which have recently joined a regional patent organization....	53		
2008-11	54		
Payment of fees to the International Bureau as receiving Office when filing international applications with that Office on a regular basis.....	54		
2008-12	55		
International applications in respect of which a supplementary international search may be requested; how to request such a search.	55		
2009-01	55		
Assignment of an international application to an applicant who is neither a national nor a resident of a PCT Contracting State	55		
2009-02	56		
The appointment of agents having the right to practice before an Authority specified for supplementary international search56			

1997-06

Lack of unity of invention: payment of additional search fees under protest; consequences of non-payment of additional search fees

Q: The ISA which is carrying out the search on my international application, having found that my application contains five inventions and thus does not meet the requirement of unity of invention, has sent me an invitation to pay four additional search fees.

I agree with their finding that my application contains more than one invention, but I disagree with the number of additional search fees which I have been requested to pay.

(1) Is there any mechanism under the PCT for challenging the number of additional search fees requested?

(2) What will happen to my application if I do not pay all the additional search fees?

A: (1) Where the ISA finds that an application does not comply with the requirement of unity of invention (for details of that requirement, see PCT R. 13 and Annex B of the PCT Administrative Instructions) and invites the applicant to pay additional fees (see Art. 17(3)(a)), the applicant, if in disagreement with the finding of lack of unity of invention, may protest against that finding, or if he considers that the number of additional search fees he has been invited to pay is excessive, may protest against the number of additional search fees to be paid. To do so, the fees concerned must be paid within the time limit which the ISA fixed in the invitation to pay additional fees (Form PCT/ISA/206) (see R. 40.2(c)) and must be accompanied by a reasoned statement explaining why the applicant considers that those parts of the international application, for which he does not agree with the payment of additional search fees, comply with the requirement of unity of invention, and why, therefore, the number of additional fees required is excessive.

Where the applicant has paid additional search fees under protest, the ISA will review the justification for the invitation to pay additional fees. To the extent that the applicant's protest is found to be justified, the additional search fees will be totally or partially reimbursed. The applicant is notified of the decision on the protest by way of Form PCT/ISA/212.

Note that, where the ISA is the Chinese Patent Office or the EPO, the review procedure may consist of two levels: a prior review of the justification for the invitation to pay additional search fees, followed by a formal examination of the protest. After the prior review, the ISA may require the applicant to pay a fee for the examination of the protest (the "protest fee"), the amount of which is indicated in the PCT Applicant's Guide, Vol. I/B, Annex D. The protest fee must be paid within one month from the date of the notification to the applicant of the result of the prior review. That fee will be refunded to the applicant only where the protest is found to be entirely justified. If the protest fee is not paid, the protest will be considered withdrawn.

The applicant may request that the texts of the protest and the decision thereon be notified by the IB to the

designated Offices, together with the ISR (see R. 40.2(c)). In that case, some designated Offices may require the applicant to furnish a translation of those texts together with the translation of the international application required under Art. 22, upon entry into the national phase.

(2) If no or only some of the additional search fees requested are paid within the time limit fixed in the ISA's invitation (Form PCT/ISA/206), the ISR will contain the results of the search only for those claims in respect of which search fees have been paid. It is important to note that, if a demand for international preliminary examination is subsequently filed, the IPEA need not examine any claims relating to unsearched inventions. Non-payment of an additional search fee in respect of any claim or group of claims does not, in itself, amount to any abandonment of the claim or claims concerned during the international phase; the processing of the international application, including its communication to the designated Offices, will continue in respect of all claims.

However, the national law of any designated State may provide that, where the national Office of that State finds the invitation of the ISA to pay additional search fees justified, and where the applicant has not paid all additional fees, those parts of the international application which have not been searched will, as far as effects in that State are concerned, be considered withdrawn in the national phase, unless a special fee is paid by the applicant to the national Office of that State (see Art. 17(3)(b)). A few Offices (for example, the Swedish Patent Office) apply such provisions; for details, see the corresponding parts of the National Chapters of the PCT Applicant's Guide, Vol. II. A number of designated Offices may, instead of requesting a special fee, require the applicant to restrict the application to one invention or to divide the application into a corresponding number of divisional applications.

1997-07

Parts of the request form missing upon filing the international application

Q: What are the consequences if part of the request form is missing at the time of filing of an international application, for example, if a fax machine malfunctions and does not transmit all sheets, or if the sheets are received by the receiving Office but are only partially legible?

A: Where the applicant has attempted to transmit a document by fax, but part of the document is not received, or is received but is illegible, the document will be treated as not having been received to the extent that the received document is illegible or that the attempted transmission failed (see R. 92.4(c)). Before discussing the consequences of this in the case where the request form is sent to the receiving Office by fax, reference is made to the "Practical advice" section in PCT Newsletter No. 11/1996, which discussed the question of whether drawings which were missing from an international application could be filed later without affecting the international filing date. Similar considerations as to later filed sheets apply in the case of

missing parts of the description or claims (see R. 20.2).

As far as the request form is concerned, the situation is somewhat different: what is most important is that those parts of the request form which are actually received by the receiving Office contain sufficient information for an international filing date to be accorded. The indications which are required under PCT Art. 11 for the according of an international filing date, and which should be included in the request form, are: an indication that the application is intended to be an international application (the statement "The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty" is indicated at the top left-hand corner of the first page of the request form) (see Art. 11(1)(iii)(a) and R. 4.2); the name of the applicant (Box Nos. II and III) (see PCT Art. 11(1)(iii)(c) and R. 20.4(b)); the necessary indications of the applicant's nationality and residence, noting that at least one applicant must have the right to file the international application with the receiving Office (Box Nos. II and III) (see Art. 11(1)(i) and R. 18 and 19); the specific designation of at least one PCT Contracting State (Box No. V) (see PCT Art. 11(iii)(b) and R. 4.9(a)).

Of course, in addition to the above-mentioned requirements, the other requirements of PCT Art. 11 must also be fulfilled if an international filing date is to be accorded, notably, the application must include a description and a claim or claims and must be in an admitted language (see PCT Art. 11(1)(ii) and (iii)(d) and (e) and R. 12.1).

It is also important that any priority claim, although not necessary for the according of an international filing date, be included at the time of filing since a priority claim cannot be added later, and if a priority claim is incomplete or erroneous, there are only limited possibilities for correction (see PCT R. 4.10 (b) and (c) and PCT Newsletter Nos. 03 and 05/1994).

The following information which is also usually given in the request form can, if necessary, be furnished later, without affecting the international filing date: the title of the invention (Box No. I); the indication of (further) applicants or inventors (continuation of Box No. III); the name and address of an agent (Box No. IV); the specific designation of further States, by way of confirming precautionary designations under PCT R. 4.9(b) (provided, however, that the request as filed contained the necessary statement regarding precautionary designations as required by PCT R. 4.9(b); such statement is preprinted in Box No. V); the choice of ISA and details of any earlier search (Box No. VII); the indications in the check list (Box No. VIII); the signature of the applicant or agent (Box No. IX).

Therefore, depending on which indications are missing, it may even be possible to furnish, later, sheets of the request form which were missing in their entirety at the time of filing, provided that enough indications were present in the originally filed papers to enable an international filing date to be accorded, as explained above.

Even if certain indications required for the according of an international filing date are missing from the request

form, it can happen that they are furnished with the application in some other way (such as in an accompanying letter). In such a case, it may still be possible for a filing date to be accorded, although the applicant would then be requested to furnish properly completed pages of the request form to ensure compliance with the formal requirements of the PCT Regulations.

1997-09

Different applicants for different designated States

Q: I am the agent for an international application in which several persons are to be named as applicants.

(1) Can I name different applicants for different designated States. If so, how should this be indicated in the request?

(2) One of the applicants is to be applicant for GB for a national patent. Can another person be applicant for GB for a European patent?

(3) Where more than one type of protection (such as patent and utility model) is available for a particular Contracting State, may different persons be indicated as applicants for that State for the purposes of obtaining different types of protection?

A: (1) Yes, it is possible for different persons to be indicated as applicants for different designated States (see PCT R. 4.5(d)). First of all, all applicants should be named, as usual, in Boxes Nos. II and III of the request form. Then, for any applicant not falling into the categories of applicant for the purposes of "all designated States," "all designated States except the United States of America," or "the United States of America only," the check-box "the States indicated in the Supplemental Box" should be marked. Then, the following text should be added to the Supplemental Box on the supplemental sheet of the request form: "Continuation of Boxes Nos. II and/or III," followed by the name of each applicant, the name(s) of the designated State or States for which that person is applicant, together with, for each designated State, where applicable, an indication whether that person is applicant in respect of the State designated for the purposes of obtaining a national patent or a regional patent, or both a national and a regional patent. Note that, where different persons are indicated as inventors for different designated States (see R. 4.6(c)), the Supplemental Box can also be used to indicate the designated State or group of States in respect of which each person is inventor.

2) No, where a particular State is designated for both a national patent and a regional patent, the same applicant(s) must be indicated for both designations. Thus, the person who is indicated as applicant for GB for a national patent must also be indicated as the applicant for GB for a European patent (see Administrative Instructions under the PCT, Section 203(b)).

(3) No, even if more than one type of protection for an invention is available in a designated State (in Germany, for example, it is possible to obtain a utility model instead of or in addition to a patent), different applicants may not be indicated for different types of protection in respect of the same Contracting State. Different types of protection in the same State are

available only for the same applicant (see PCT Applicant's Guide, Vol. I/A, paragraph 59).

1997-10

Adding applicants and/or inventors to the international application after the international filing date

Q: *I am one of a team of three inventors in respect of an international application which was filed and subsequently accorded an international filing date a few weeks ago. Each of us should have been named as applicant/inventor for all designated States, but unfortunately the sheet containing the "Continuation of Box No. III" (continuation sheet of the request form), containing the details about the third applicant/inventor, was erroneously omitted from the request when filed. Is it possible to add further applicants and/or inventors after the international filing date?*

A: It is possible to add further applicants, as well as further inventors or agents, by requesting the recording of a change under PCT R. 92bis. In general, PCT R. 92bis provides for changes (whether additions, deletions or any combination thereof) in respect of the person, name, residence, nationality or address of the applicant, and in respect of the person, name or address of the agent, the common representative or the inventor.

It is important to note, however, that any applicants and/or inventors added after the international application has been filed will be considered as applicants and/or inventors only from the date on which their names are added. Certain designated/elected Offices require that the name(s) of the inventor(s) be given in the request upon filing. However, some of those Offices may permit the addition of applicants and/or inventors under certain circumstances, depending on the national law.

In order to request the addition of a further applicant and/or inventor, a request under PCT R. 92bis must be made by the applicant(s) of record (or on their behalf by their agent or common representative) in writing and may be sent either to the receiving Office or to the IB. The IB records the change if it receives the request before the expiration of 20 months or, if a demand for international preliminary examination has been filed within 19 months from the priority date, 30 months from the priority date. It should be noted that the applicable time limit is 20 or 30 months, even though a longer time limit for entering the national phase may be applicable in certain designated/ elected Offices.

If it is intended that the international publication reflect the additional applicant and/or inventor, the request for recording the change should reach the IB before the completion of technical preparations for publication (which generally takes place 15 days before the actual publication date).

Applicants who file a request for the recording of a change with the receiving Office are reminded that the decisive date is that of the IB 's receipt of the request transmitted by the receiving Office. Therefore, if the request is made shortly before the expiration of the

time limits indicated above, it is recommended that it be sent direct to the IB, preferably by fax.

For further details about which designated/elected Offices require that the name(s) of the inventor(s) be given in the request upon filing, see PCT Applicant's Guide, Vol. I/A, Annex B1.

1998-01

Appointment of common representative and agent of common representative

Q: *An international application has been filed, in respect of which there are two corporate applicants (corporation A and corporation B) and two inventors named as applicants for the US designation (applicant/inventor Y, who is employed by corporation A and applicant/inventor Z, who is employed by corporation B). Corporation A wishes to be appointed as common representative of the other applicants, and then, subsequently, to appoint L as its agent.*

(1) To achieve the above, is it possible for applicant/inventor Y to appoint corporation A as common representative and for applicant/inventor Z to appoint corporation B as common representative, then for corporation B to appoint corporation A as common representative and, subsequently, for corporation A to appoint L as its agent?

(2) What would be the consequence if the appointment of corporation A as common representative could not be effected by all applicants concerned and corporation A appoints L as its agent?

A: (1) According to PCT R. 90.2(a), where the applicants have not appointed an agent representing all of them (a "common agent"), one of the applicants who is entitled to file an international application according to PCT Art. 9 may be appointed by the other applicants as their common representative. However, since there can only be one common representative and that person must be appointed by all of the other applicants, the scenario which you describe in question (1) is not possible. If corporation A wishes to be appointed as common representative, it must be appointed as such by each of the other applicants. If corporation A, as the appointed common representative, then appoints agent L, the latter will, as agent of the appointed common representative, have full power to represent all the applicants.

(2) If there is no common agent and no appointed common representative but corporation A happens to be the "deemed" common representative (that is, under PCT R. 90.2(b), the first named applicant in the request who is entitled, under PCT R. 19, to file an international application with the receiving Office with which the international application was filed), agent L, as agent of the deemed common representative, would have more limited powers. For example, agent L could sign the demand and certain other documents for the purposes of the PCT; he could not, however, validly sign, on behalf of all the applicants, the request itself or a notice effecting withdrawal of the international application, a designation, a priority claim, the demand or an election. Such documents must (subject to PCT R. 4.15(b) and 90bis.5(b)) be signed by all applicants. Only a duly appointed agent or a duly

appointed common representative, or the agent of the latter, may validly sign on behalf of an applicant. If corporation A is not the "deemed" common representative, then agent L would be entitled to act only on behalf of corporation A (and not for the other applicants).

In all cases, agent L must, of course, have the right to practice before the Office with which the international application was filed (see PCT R. 90.1).

1998-02

Filing international applications by fax

Q: *I intend to file an international application, claiming the priority of an earlier application filed on 26 February 1997, with the IB as receiving Office. If, for some reason, I cannot file the application until the last day of the 12-month priority period (that is, 26 February 1998) and the application is sent by fax before midnight from New York, will it be considered that I filed my application within the priority period, or must the fax be sent early enough to be received by the IB by midnight in Geneva?*

A: According to PCT R. 80.4(b), the date on which any period expires is the date prevailing in the locality in which the required document must be filed or the required fee must be paid. Therefore, it is not the date and time at the place of transmittal or payment, but rather the date and time at the place of receipt of the document or of the amount paid, which determines whether a time limit has been met.

Therefore, you must be aware of the time differences which exist between the place from which you are transmitting your fax and the place to which you are transmitting your fax. Geneva, Switzerland, is, for most of the year, six hours ahead of New York, (but this may vary slightly due to regional differences in the commencement and ceasing of daylight savings time). Thus, if your fax is transmitted at 11.30 p.m., New York time, on 26 February 1998, it would be received by the IB in Geneva at about 5.30 a.m. on 27 February 1998, that is, after the expiration of 12 months from the priority date.

Some fax machines are programmed to make repeated attempts to transmit a fax if transmission fails because, for example, the fax machine at the destination is busy at the time. Care should be taken that the transmission, when it eventually succeeds, is not outside the time limit concerned.

For details about the consequences of a fax transmission being only partially received or partially legible, see PCT Newsletter No. 07/1997, page 5.

Remember that not all Offices accept the transmittal of documents by fax, and of those which do accept transmittals by fax, not all accept the filing of the international application itself by fax. Also, note that most Offices which do accept documents by fax require, depending on the nature of the transmitted document, that the original of the document be furnished, usually within 14 days, but in some cases some other period, from the date of transmission of the fax. These requirements vary from Office to Office; details appear in Annexes B1 and B2 of the PCT Applicant's Guide, Vol.

I/A, and are summarized in the table (available in Adobe PDF and MS Word 2.0 formats).

Applicants should avoid, wherever possible, filing documents at the last minute, in order to avoid missing important time limits due to unforeseeable circumstances which may arise, for example, due to technical problems with a fax machine, which may prevent a fax from being received in time.

1998-04

Submitting replacement sheets where physical requirements are not complied with

Q: *I must submit replacement sheets in relation to certain pages of the description and claims of my international application, following receipt from the receiving Office of an Invitation to correct defects in the international application (Form PCT/RO/106), which indicates that, on certain pages of the description and claims, the minimum margins are not as prescribed under PCT R. 11.6. What should my response consist of? Do I have to mark the sheets with the international application number and an indication that the sheets are replacement sheets?*

A: Where the physical requirements have not been complied with, your response to an Invitation to correct defects in the international application must include replacement sheets for all sheets which do not meet those physical requirements. You should not include on the replacement sheets themselves the international application number and the indication that the sheets are replacement sheets. Rather, the international application number and the purpose of the transmittal should be included in an accompanying letter, which should also draw attention to the difference between the replaced sheets and the replacement sheets.

It is only the receiving Office which may mark the replacement sheets with the international application number and an indication that the sheets are replacement sheets. Before it does this, however, the receiving Office must verify the identity of the contents of the replacement sheets with that of the replaced sheets. Then it must check that the defects have been corrected, that the replacement sheets comply with all the other physical requirements prescribed in PCT R. 11, and that the corrections have been received within the time limit specified in the invitation.

When all the above verifications have been made, the receiving Office stamps the sheets according to Section 325 of the Administrative Instructions under the PCT—that is, by indelibly marking in the upper right-hand corner of each replacement sheet the international application number and the date on which that sheet was received, and, in the middle of the bottom margin of each replacement sheet, the words "SUBSTITUTE SHEET (RULE 26)," or their equivalent in the language of publication of the international application.

If you do mark the replacement sheets with the words "SUBSTITUTE SHEET," or any other indication which is not permitted under the PCT, this may create ambiguity for the PCT Offices concerned.

Note that the same procedure applies if the applicant submits to the receiving Office replacement sheets embodying corrections of physical requirements, without having been invited to correct a defect.

1998-05

Death of the applicant/inventor during the international phase

Q: I have been acting as agent for a client who filed an international application, designating, amongst other States, the United States of America. My client, who was the sole applicant/inventor in the application, died recently. How should I proceed if her widower, who is her sole heir and unrestricted legal representative, wishes to proceed with the application?

A: Since the deceased applicant was also the inventor, and the United States of America—which requires that the applicant be the inventor—is designated, the legal representative or the heir of the deceased applicant/inventor (that is, in this case, her widower) must be named as applicant for the purposes of the designation of the United States of America. A request under PCT R. 92bis.1 should be made for the recording of a change in the person of the applicant, giving the following information: the widower's name, followed by an indication that he is the legal representative or heir of his deceased wife, for instance: "SMITH, John, legal representative of SMITH, Jane (deceased)," or "SMITH, John, heir of SMITH, Jane (deceased)," his residence, nationality and address, an indication that he is to be applicant for all designated States, and any other information normally included in Box No. II of the request form.

The name of the deceased applicant/inventor must remain in the request form, followed by an indication that she is deceased, for instance: "SMITH, Jane (deceased)," and the check box "inventor only" will be marked. No further indications are required concerning the inventor.

Note that if a demand for international preliminary examination has not already been filed, and the widower of the applicant/inventor is neither a resident nor a national of a PCT Contracting State which is bound by Chapter II, then, according to PCT Art. 31(2)(a), he is not entitled to file a demand, even if his wife was so entitled.

If the widower of the applicant/inventor assigns his rights to the invention to a third party, what is said in the preceding paragraph would also apply to the assignee if that assignee decided to proceed with the application.

If you are to remain the agent for the international application, a new power of attorney signed by the legal representative/heir (or by the assignee) will be required.

Note that, although documentary evidence proving the right to the application is not required during the international phase, it may be required by any designated Office for the purposes of the national phase of processing.

For further details on how to proceed if the applicant or inventor dies, see PCT Applicant's Guide, Vol. I/A, paras. 356 to 359.

1998-08

Furnishing of certified copies of earlier filed international applications as priority documents

Q: On 10 July 1998, I filed an international application, claiming priority from an earlier international application filed on 17 July 1997. Am I required to furnish a certified copy of the 1997 international application, and if so, can I request the IB to prepare that certified copy?

A: Under amended PCT R. 17.1(a) as in force from 1 July 1998, a certified copy of any earlier application, the priority of which is claimed, (the priority document) is required, regardless of whether the earlier application is a national, regional or international application. (That R. as in force prior to 1 July 1998 did not make reference to cases where the priority of an earlier international application was claimed.)

In your case, the priority document can be obtained only from the receiving Office with which the earlier (1997) international application was filed (see PCT R. 20.9). It cannot be prepared by the IB, unless, of course, the earlier application was filed with the IB acting as receiving Office. If the earlier international application was filed with the receiving Office with which you filed your subsequent international application, you may, instead of submitting the priority document, request, no later than 16 months after the priority date, that receiving Office to prepare and transmit the priority document to the IB (see PCT R. 17.1(b)). (Note that you could have done this on filing the subsequent international application by marking the corresponding check-box in Box No. VI of the request form).

Any priority document, whether it is a certified copy of a national, regional or international application, should be submitted by the applicant to the IB or the receiving Office not later than 16 months after the priority date. Under amended PCT R. 17.1(a), however, if the priority document is received by the IB after the expiration of 16 months from the priority date, it will be considered to have been received on the last day of that 16-month time limit if it reaches the IB before the date of international publication of the international application. If any priority document is not furnished to the IB before the date of international publication, and if the applicant did not request the receiving Office to prepare and transmit the priority document to the IB before the expiration of 16 months from the priority date, any designated State may disregard the priority claim. However, an additional safeguard has been introduced in amended PCT R. 17.1(c) which provides that "no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances."

1998-09

Requesting the addition (or correction) of a priority claim (→PCT R. 26bis.1)

Q: I filed an international application on 6 July 1998 with the intention of claiming the priority of national applications filed on 14 July 1997 and 11 August 1997.

Unfortunately, the priority claim based on the application filed on 14 July 1997 was inadvertently omitted from the request form. I have heard that under the amended PCT Regulations which entered into force on 1 July 1998, a priority claim may be added to the application. What is the time limit for requesting such addition and can that time limit be extended? To which Office should I submit my request, and are any fees payable?

A: Under new PCT R. 26bis.1, it is possible to add or correct a priority claim to an international application. What follows regarding the addition of priority claims applies mutatis mutandis to the correction of priority claims and also to the addition of any part of a priority claim (for example, the date on which the earlier application was filed, the number of the earlier application, or the country in which, or the Office with which, the earlier application was filed).

You may submit a notice requesting the addition of a priority claim until the expiration of four months from the international filing date. A later time limit applies, however, in the case where the earliest of the following time limits will expire later than the four-month time limit: - 16 months from the priority date, or - where the addition of the priority claim would cause a change in the priority date, 16 months from the priority date so changed.

A later time limit does, in fact, apply to your application. If we examine the dates relevant to your application:

(a) the time limit of four months from the international filing date expires on 6 November 1998;

(b) as your application stands, the priority date is 11 August 1997, therefore, the time limit of 16 months from the priority date of 11 August 1997 expires on 11 December 1998;

(c) however, while 16 months from the priority date which is to be added (14 July 1997) is earlier than 16 months from the "original" priority date, it is later than four months from the international filing date; therefore, the time limit of 16 months from the added priority date (that is, 14 November 1998) is the applicable time limit in your circumstances.

Note that, in any event, applicants always have at least four months from the international filing date to request the addition of a priority claim.

You may submit the notice requesting the addition of the priority claim to either the receiving Office or the IB (PCT R. 26bis.1(a)), at your choice. Note, however, that if you submit your notice requesting the addition of the priority claim shortly before the expiration of the applicable time limit, it may be preferable to send it by fax directly to the IB, in order to ensure that it is received by the IB prior to the completion of technical preparations for publication. This is especially important in the case where the addition of an earlier priority date results in an earlier international publication date (see below). You should, of course, ensure that the notice is signed by an authorized person, that is, by the common agent or the common representative.

No fee is payable for making a request for the addition or correction of a priority date.

Where the addition or correction of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired will be computed from the priority date as so changed (PCT R. 26bis.1(c)). For example, in your case, the time limit for furnishing the priority documents for both earlier applications will be 14 November 1998 instead of 11 December 1998, and the due date for publication will be earlier (promptly after 14 January 1999 instead of promptly after 11 February 1999). Any time limits which have already expired will not, however, be recomputed.

1999-05

Priority claim considered not to have been made-possible remedial action by applicant

Q: *My company filed an international application on 1 December 1998, indicating a priority claim with an erroneous date of 10 October 1997, instead of the correct date of 10 December 1997, in addition to a priority claim (correctly) dated 5 March 1998. The IB issued an invitation to correct the earlier priority claim because the filing date indicated for that earlier application did not fall within the period of 12 months preceding the international filing date. We prepared a response to that invitation, but unfortunately, due to an oversight, that response was sent after the expiration of the time limit for correcting the priority claim (which was 1 April 1999). Our response crossed in the post with the notification from the IB, dated 15 April 1999, that the priority claim was considered, for the purposes of the procedure under the PCT, not to have been made. We intend to request the designated Offices before which the application is to enter the national phase to reinstate the priority claim of 10 December 1997. Can I still do something within the international phase to safeguard my rights?*

A: The finding under PCT R. 26bis.2(b) that a priority claim is considered, for the purposes of the procedure under the PCT, not to have been made (for example, when a response to the invitation under PCT R. 26bis.1(a) is not received within the prescribed time limit) does not prevent any designated Office from recognizing such a priority claim for the purposes of the national procedure if so permitted or required by national law. Certain designated Offices may recognize the priority claim as far as the national phase before them is concerned; other designated Offices may refuse to recognize it.

PCT R. 26bis.2(c) provides for the possibility of publication, together with the international application, of information about the priority claim which was considered not to have been made. This would serve to alert designated Offices and third parties to the possibility that a request for correction of the priority claim may be made in the national phase. The request for such publication should be filed directly with the IB, together with the special fee payable to the IB for this service, and must be received by the IB prior to the completion of technical preparations for international publication. (The current fee is 50 Swiss francs plus 12 Swiss francs for each sheet in excess of one-see PCT Applicant's Guide, Vol. I/A, Annex B2 (IB)). Note that a

copy of the request for such publication will be included in the communication under PCT Art. 20 where a copy of the published pamphlet is not used for that communication or where the international application is not published by virtue of PCT Art. 64(3).

One very important thing to consider is that you should calculate any time limits which start from the earliest priority date as though the "corrected" priority date applied. For example: you should file a demand for international preliminary examination, if you intend to do so, within 19 months, calculated from 10 December 1997 (not from 5 March 1998); you should enter the national phase before any designated Office which you intend to ask to recognize the priority claim in question within 20 or 30 months, as applicable, from 10 December 1997 (not from 5 March 1998). You should also request the early publication of your international application so that it will take place as soon as possible after 18 months calculated from 10 December 1997 (not from 5 March 1998).

2000-02

Different applicants for different States designated for a regional patent

Q: *Two months ago I filed, on behalf of an applicant who is applicant for all designated States, an international application in which all States except US were designated. It is now my client's intention to add a second applicant to the application. Is it possible for the second applicant to be indicated as applicant for the purposes only of designating Germany for a European patent (EP), leaving the first applicant as applicant for all other States covered by the EP designation, or must the same applicant(s) be indicated in respect of all States which are covered by the designation for the European patent?*

A: Different applicants may be indicated for different States included in the same designation for a regional patent (see Section 203(a) of the Administrative Instructions under the PCT). Therefore, it is possible for you to indicate the second applicant as applicant only for the DE "part" of the EP designation, leaving the first applicant as applicant for all other States covered by that designation.

Note, however, that since DE has also been designated for a national patent, if the second applicant is to be applicant for the DE part of the EP designation, he must also be applicant for the DE designation for a national patent since, according to Section 203(b) of the Administrative Instructions under the PCT: "where a particular State has been designated for both a national and a regional patent, the same applicant or applicants shall be indicated for both designations."

When you notify the IB or the receiving Office (which will then, in turn, notify the IB), by way of a request to record a change under PCT R. 92bis, of the addition of the second applicant to the international application, you should specify that that applicant should be indicated as applicant for the DE part of the EP designation and for the DE national designation, and clarify whether or not the first applicant is to remain applicant for those designations.

You are reminded that, along with the request to record a change, you should also furnish a power of attorney signed in your favor by the second applicant, so that you will become the common agent and therefore be entitled to perform any act on behalf of both applicants.

For further details on indicating different applicants for different designated States, see PCT Newsletter No. 09/1997. For further details on requesting the addition of new applicants, see PCT Applicant's Guide, paras. 427-431, and PCT Newsletter No. 10/1997.

2000-03

Late receipt of invitation from receiving Office to correct physical defects in the international application

Q: *The receiving Office with which my international application was filed has sent me an invitation to correct defects in the drawings included in the application (Form PCT/RO/106) with a time limit for response of one month from the date of mailing of the invitation. However, by the time I had received the invitation, 12 days had passed since the date of mailing, leaving me only 18 days in which to send the corrected drawings and I am worried that I will not be able to have them ready in time. Is it possible to extend the time limit for responding to the invitation, or, bearing in mind the delay which I encountered in receiving the invitation, is there any other action that I can take to have any delay in the receipt of my drawings by the receiving Office excused?*

A: There are various actions that you could take if you receive an invitation to correct a defect at a date much later than the date of mailing of the invitation, as follows:

1) You may request the extension of the time limit fixed by the receiving Office for the correction of the defects. According to PCT R. 26.2, the receiving Office may extend the time limit for the correction of defects under PCT Art. 14(1) ex officio or at the request of the applicant at any time—even after the time limit fixed in the invitation has expired—before a decision is taken on whether the applicant has submitted the correction within the time limit and whether or not the international application so corrected is to be considered withdrawn. Whether or not an applicant is granted an extension of the time limit may depend on the circumstances of the application concerned. For example, when fixing a time limit or when granting an extension of a time limit, the receiving Office takes into account the fact that corrections that may be relevant for the international search are needed by the ISA, and that all corrections must reach the IB before the completion of technical preparations for international publication. Extensions of time limits must be requested from the receiving Office and are normally granted if the circumstances referred to in the preceding sentence so permit.

Note, however, that PCT R. 26.2 does not apply to all types of invitations, for example, it does not apply to invitations to correct defects under PCT Articles 11 or 14(2).

2) In accordance with PCT R. 80.6 (first sentence), if the invitation was mailed on a day later than the date it bears, and you can prove that fact (for example (and depending on the country and office concerned), on the basis of elements such as the date stamp affixed by the post office), the date of actual mailing will, for the purposes of computing the period, be considered by the receiving Office to be the date on which the period starts.

3) Since the invitation reached you 12 days after the date of mailing, you also have the possibility under PCT R. 80.6 (second sentence) of offering evidence which would satisfy the receiving Office that the invitation was received more than seven days after the date it bears. In such a case the receiving Office would treat the one-month period starting from the date of the invitation as expiring later by an additional number of days equal to the number of days over and above seven days from the date of the invitation which it took the invitation to reach you. Your time limit would therefore be extended by five days.

Even though the originals of the drawings are required, you are more likely to meet the time limit if you send them by fax, provided that the receiving Office accepts the filing of documents by fax (this information can be obtained from the PCT Applicant's Guide, Vol. I/A, Annex B (available in Adobe PDF format)). Note that the United States Patent and Trademark Office as receiving Office does not accept facsimile transmission of a number of documents, including drawings.

2000-11

Payment of fees which become due on a day on which the receiving Office is not open for business

Q: I am acting as agent for an applicant who filed an international application on 4 September 2000, claiming the priority of an earlier application filed on 30 December 1999, and designating all PCT Contracting States. The designation fees have not yet been paid, and I would like to know if I will be able to pay the new, lower maximum number of designation fees (six), applicable as from 1 January 2001.

A: The time limit for the payment of the designation fees in your case is, in accordance with PCT R. 15.4(b)(i), one year from the priority date (the time limit under PCT R. 15.4(b)(ii) not being applicable since one month from the date of receipt of the application did not expire later than one year from the priority date); therefore, the designation fee should be paid by 30 December 2000. Since it is the time limit under PCT R. 15.4(b)(i) that applies, the amount payable will be that which is applicable on the date of payment (PCT R. 15.4(c)), which should, in principle, be on or before 30 December 2000, and should therefore be the current higher maximum number of designation fees (eight). However, the new, lower maximum number of designation fees (six) could be applicable in respect of your international application under certain circumstances, as outlined below.

Since 30 December 2000 falls on a Saturday, a day on which most receiving Offices are not open for business, you would probably not be able to pay the

fee on that day. PCT R. 80.5 "Expiration on a Non-Working Day" covers such a situation, as follows: "If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day on which such Office or organization is not open to the public for the purposes of the transaction of official business, or on which ordinary mail is not delivered in the locality in which such Office or organization is situated, the period shall expire on the next subsequent day on which neither of the said two circumstances exists."

Therefore, if your receiving Office is not open for business on 30 December 2000, the payment would still be considered to have been received in time if it reaches the receiving Office on the next day after 30 December 2000 on which that Office is open. Bearing in mind that 31 December 2000 and 1 January 2001 (and possibly even 2 January 2001, as indeed is the case for the IB) are also non-working days in many of the PCT Contracting States, your fees may be considered to have been received in time, even if they are received on or after 1 January 2001, depending on which is the first day on which your receiving Office is open for business. If this is the case, that first day would be considered to be the date of payment and the new, lower maximum of six designation fees would be payable. If, however, the fees reach the receiving Office before 30 December 2000, the current, higher maximum of eight designation fees would be payable.

Note that if you pay the maximum of six designation fees too close to the expiration of the time limit for the payment of the designation fee, there is a risk that either your payment will reach the receiving Office before 30 December 2000 or that your payment will be received by the receiving Office later than the first working day in 2001. In the former case, you will receive from the receiving Office an invitation under PCT R. 16bis.1(b) to pay the missing amount, together with, where applicable, a late payment fee (PCT R. 16bis.2). In the latter case, according to PCT R. 16bis.1(d), if your payment is received by the receiving Office before it sends the invitation under PCT R. 16bis.1(b), your payment would be considered to have been received in time-no invitation to pay the missing fee would be sent to you and no late payment fee would be charged.

If you plan to pay your fees around the end of year holiday period, it is recommended that you find out which are the days on which your receiving Office is not going to be open for business.

For an explanation on which applications the new maximum number of designation fees will apply to, see the first Editor's Note in the Schedule of Fees as in force from 1 January 2001, which is inserted in this issue [in Adobe PDF format].

2001-02

Filing of Declarations under new PCT R. 4.17

Q: I am the agent for a corporation which frequently files PCT applications. I have just heard that it will be possible, as from 1 March 2001, to include certain declarations in the request, for the purposes of national processing before the designated/elected Offices

and would like to have the following matters clarified: (a) Am I required to submit such declarations during the international phase? (b) Should the declarations be worded in a particular way?

A: For international applications filed from 1 March 2001, it will be possible, under new PCT R. 4.17, to include in the request any of the following declarations which relate to certain matters in respect of which some designated or elected Offices may require documents or evidence under their respective national laws: (i) declaration as to the identity of the inventor (R. 4.17(i)); (ii) declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (R. 4.17(ii)); (iii) declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application (R. 4.17(iii)); (iv) declaration of inventorship (only for purposes of the designation of the United States of America) (R. 4.17(iv)); and (v) declaration as to non-prejudicial disclosures or exceptions to lack of novelty (R. 4.17(v)).

(a) You are not required to submit any of the declarations referred to in PCT R. 4.17 at the time of filing the request or during the international phase. However, the newly offered centralized procedure of filing such declaration(s) only once, for the purposes of the designated Offices concerned (see below for certain exceptions), may be more advantageous for applicants than filing different "national-type" declarations with various Offices. If you choose this new option, it is strongly recommended that you submit such declarations at the time of filing, in the request part of the international application, or during the course of the international phase (refer to R. 26ter.1 for the applicable time limit), particularly if you intend to enter the national phase before several designated (or elected) Offices whose national laws require the applicant to furnish documents or evidence relating to the matters to which the declarations relate.

In practice, you will be able to make such declarations in new optional boxes of the Request Form (as in force from 1 March 2001) one for each of the five types of declarations (Boxes Nos. VIII (i) to VIII (v)) (see page 3, above for further details).

If declarations are made as explained above, the IB will, in the case of declarations under PCT R. 4.17(i) to (iv), transmit a copy thereof to those designated Offices specified by the applicant, noting that a copy of any declaration made under PCT R. 4.17(iv) will only be sent to the United States Patent and Trademark Office as the only designated Office to which it applies. Any declaration as to non-prejudicial disclosures or exceptions to lack of novelty (referred to in PCT R. 4.17(v)) will be published as part of the PCT pamphlet. In all cases, an indication about the fact that a given declaration has been made and the list of designated Offices concerned will be included on the front page of the pamphlet and in the corresponding entry in the PCT Gazette.

Subsequently, in connection with processing of these declarations in the national phase, it is only where the designated Offices concerned may reasonably doubt the veracity of the declarations that they will be entitled

to require further documents or evidence in respect of the matters to which the declarations relate; note that such limitation will not apply in respect of the declaration as to non-prejudicial disclosures and exceptions to lack of novelty (see PCT R. 51bis.2). For those designated Offices which have informed the IB that the applicable national law is not compatible with PCT R. 51bis2(a)(i), (ii) or (iii), see "Inclusion of certain declarations in the request," above.

(b) The declarations under PCT R. 4.17 must conform to the standardized wording provided for in new Sections 211 to 215 of the Administrative Instructions (included in this issue (in Adobe PDF and MS-Word 97 formats)). The wording of the declaration under PCT R. 4.17(iv) (declaration of inventorship) is pre-printed in new Box No. VIII (iv) of the Request Form (as in force from 1 March 2001), and the standardized wording of the other declarations is included in the Notes to Boxes Nos. VIII (i) to VIII (iii) and VIII (v) of that Form, noting that the applicant will have to create in each case a declaration including only those items of the standardized wording as is necessary to explain the particular circumstances.

Note that, according to PCT R. 26ter.2(a), where the receiving Office or the IB finds that any declaration is not worded as required, that Office or the IB, as the case may be, may invite the applicant to correct the declaration within a time limit of 16 months from the priority date.

What to look out for in future issues of the PCT Newsletter: (i) applicability of the new centralized procedure to international applications filed before 1 March 2001; (ii) how to decide on which declarations to file; (iii) filing of declarations after the international application has been filed; (iv) correction of declarations; (v) access by third parties to copies of declarations.

2001-03

Filing of declarations under new PCT R. 4.17 (second part)

Q: *In connection with the new procedure whereby it is possible to include certain declarations in the request for the purposes of the designated Offices in the national phase: (a) If I forget to submit a declaration with the request, can I submit it later, and if so, when and where should I send it? (b) Is the new procedure applicable also to applications filed before 1 March 2001? (c) How do I decide which declarations I should file?*

A: It is recalled that, with effect from 1 March 2001, it is possible, under new PCT R. 4.17, to include certain declarations in the international application for the purposes of the designated/elected Offices in the national phase (see PCT Newsletter Nos. 01/2001 and 02/2001, as well as the "Practical advice" on page 8 of PCT Newsletter No. 02/2001).

(a) If you forget to submit a declaration with the request, or if you cannot submit it at the time of filing the international application for any other reason, you may add it later by way of a notice submitted to the IB (IB) before the completion of technical preparations for international publication (new PCT R. 26ter.1 actually

provides that the time limit is 16 months from the priority date, provided that any such notice received by the IB after the expiration of that time limit will be considered to have been received on the last day of that time limit if it reaches the IB before the technical preparations for international publication have been completed). Any such notice should consist of a separate sheet containing the declaration (for example, a copy of the relevant Box of the request form (Boxes Nos. VIII (i) to (v))), and an accompanying letter (see new Section 216 of the Administrative Instructions). Upon receipt of the notice, the IB will inform you, as well as the receiving Office and the ISA, that the (added) declaration has been received. The declaration will either be processed, if it is received before the expiration of the time limit under new PCT R. 26ter.1, or if it is received by the IB after the expiration of that time limit, the IB will notify you of the need to submit the declaration directly to the designated/ elected Office(s) concerned. In the case where the declaration which is furnished outside the applicable time limit is a declaration of inventorship (referred to in new PCT R. 4.17(iv)) for the purposes of the United States of America (US) designation, containing at least one signature, it will be returned to the applicant. (See new Section 419 of the Administrative Instructions). If you mistakenly submit a declaration under new PCT R. 26ter.1 to the receiving Office instead of the IB, that Office will transmit it to the IB and the declaration will be considered to have been received by the IB on the date of receipt marked by the receiving Office (see new Section 317 of the Administrative Instructions).

(b) Although it was not possible to include or add any declarations under PCT R. 4.17 to any international application before the entry into force of the new Rules on 1 March 2001, new PCT R. 26ter.1 applies to international applications filed before 1 March 2001, to the extent that you may add a declaration within the prescribed time limit to an international application filed before 1 March 2001, provided that the 16-month time limit expires on or after 1 March 2001; new PCT R. 4.17 applies in respect of any such added declaration.

(c) Your decision as to which declarations to file will depend on the States you designate and, in particular, on the States in which the application concerned is expected to enter the national phase. For this purpose, it may be useful to consult the relevant National Chapter Summaries of the PCT Applicant's Guide, Vol. II, available on the Internet at:

<http://www.wipo.int/pct/en/index.html> which indicate, for each designated Office, the special requirements under PCT R. 51bis which need to be fulfilled, through various declarations, statements or documents, for the purposes of the national phase. In the near future, you will also be able to consult a cumulative table, currently under preparation in consultation with the designated Offices, which will indicate the declarations provided under new PCT R. 4.17 and the designated Offices for the purposes of which those declarations may be submitted. However, you should be aware that some States have informed the IB of the incompatibility of certain of the new/amended Rules with their national law. A list of the designated Offices concerned, and the Rules which are incompatible with their national

laws, was included on page 2 of PCT Newsletter No. 02/2001. If such an incompatibility exists with the law applied by any of the designated Offices, however, nothing prevents you from making declarations under PCT R. 4.17 in respect of the States concerned, but the relevant Offices will not be obliged to accept them and may require further documents or evidence.

If you intend to enter the national phase in the US, the United States Patent and Trademark Office requires a declaration of inventorship signed by the inventor(s); in order to comply with this national law requirement, you may make this declaration under new PCT R. 4.17(iv) in the international phase. Note also that a declaration as to the identity of the inventor (new PCT R. 4.17(i)) (intended for the purposes of designated States other than US) need not be made if the name and address of the inventor are otherwise indicated in the request, or if a declaration as to the applicant's entitlement to apply for and be granted a patent (new PCT R. 4.17(ii)) is, in any case, to be filed. In the latter case, the declaration as to the identity of the inventor can be combined with it, in which case the corresponding statement will need to be changed (see new Section 212(b) of the Administrative Instructions).

It should be understood that the declarations under PCT R. 4.17(ii) to (iv) relate only to the situation as at the international filing date, and cannot be used to notify changes concerning the inventor or applicant which occur after the international filing date—the procedure under PCT R. 92bis should continue to be used in the case of such changes. Also, bear in mind that making a declaration under PCT R. 4.17 may not be the most ideal way of furnishing evidence if a situation regarding applicants or inventors is quite complex, such that the standardized wording of the relevant declaration is not applicable—it may be best dealt with upon entry into the national phase when you may be able to furnish a declaration more tailored to the circumstances of the international application concerned.

2001-05

Inclusion of applicant's or agent's registration number in the request form

Q: *I am going to file an international application on behalf of my client. When filling in the request form (Form PCT/RO/101) (available in Adobe PDF format), I came across a new sub-box in Box No. II entitled "Applicant's registration No. with the Office." Likewise, there is also a new sub-box entitled "Agent's registration No. with the Office" in Box No. IV. Am I required to obtain such numbers from the receiving Office with which I will be filing the international application?*

A: Certain national/regional industrial property Offices, which act under the PCT as receiving Offices, have a practice of registering applicants and/or agents, and issuing them with a number—not all receiving Offices do this though. The boxes to which you refer are for use where an applicant or agent has already been issued with a registration number by the Office which will act as receiving Office.

Note that if the applicant/agent has been assigned such a number, it is not a requirement to include it in

the request or demand, but doing so will assist the receiving Office in its internal procedures. Those numbers are not required by the IB and they will not appear in the PCT pamphlet and corresponding entry in the PCT Gazette.

It is recalled that the inclusion of registration numbers was made possible by amendment of certain Rules which had effect from 1 March 2001. PCT Rules 4.5(e) and 53.5 provide for the inclusion in the request and in the demand for international preliminary examination of a number or other indication under which the applicant is registered with the national Office acting as receiving Office or IPEA, as the case may be. PCT Rules 4.7(b) and 53.5 contain similar provisions with respect to agents. The amendments were made in order to make the PCT consistent with the new Patent Law Treaty (PLT) (which has not yet entered into force); PLT R. 10(1)(a)(iii) provides that a Contracting Party may require any communication to a national Office to contain, where the applicant, owner or other interested person is registered with the Office, the number or other indication under which he is so registered and PLT R. 10(1)(b)(iii) makes a similar provision with respect to representatives (agents).

2001-08

Missing or defective abstracts

Q: *Due to circumstances beyond my control, I recently had to file an international application at the last minute, just prior to the expiration of one year from the priority date, in order to benefit from the priority date of an earlier application. Unfortunately, I did not have enough time to shorten the abstract, which was rather long (300 words). Will I receive an invitation to correct the international application? Would it have been possible to submit the abstract at a later date, separately from the rest of the application?*

A: According to PCT R. 8.1(b), the abstract should be "as concise as the disclosure permits (preferably 50 to 150 words if it is in English or when translated into English)". The receiving Office will check whether the international application contains an abstract as provided for in PCT Art. 14(1)(a)(iv), but not whether the abstract complies with PCT R. 8 (see PCT Receiving Office Guidelines, para. 147 (available in Adobe PDF format)).

Although there is no actual "requirement" to restrict the abstract to between 50 and 150 words (PCT R. 8.1(b) uses the word "preferably"), it is important that applicants try to adhere to these parameters. Note that if the original abstract is in Chinese, French, German, Japanese, Russian or Spanish, the IB must prepare an English translation of the abstract for publication in the PCT pamphlet (published PCT application), as well as in the electronic version of the PCT Gazette and, if the original abstract is in English, or in one of above-mentioned languages other than French, it must also prepare a French translation for publication in the electronic version of the PCT Gazette. Moreover, because an abstract serves as a summary of the disclosure contained in the description, the claims and any drawings, which will be used by scientists, engineers and examiners in searching in a particular technical field, it should be kept as brief as possible so

as to help quickly assess whether there is a need to consult the description or the whole international application.

If the abstract is not filed at the same time as the international application, the late receipt of the abstract by the receiving Office does not affect the international filing date. The receiving Office may, in accordance with PCT Art. 14(1)(b), invite the applicant to furnish the missing abstract (while at the same time sending a copy of that invitation to the IB and the ISA), in which case the abstract must be sent by the applicant to the receiving Office within the time limit indicated in the invitation (see PCT Rules 26.1 and 26.2).

If the ISA does not receive a notification from the receiving Office to the effect that the applicant has been invited to furnish a missing abstract, or if a long abstract has been filed and the ISA finds that the abstract does not comply with PCT R. 8 for that or any other reason, PCT R. 38.2(a) provides for the establishment of an abstract by the ISA. The ISR indicates whether the ISA approves the abstract as submitted by the applicant; if the ISA does not approve that abstract or if an abstract has never been submitted by the applicant, the ISR is accompanied by the abstract as established by the ISA (PCT R. 44). Where the ISA establishes an abstract, comments on that abstract may be sent by the applicant within one month from the date of mailing of the ISR; those comments may or may not be taken into account by the ISA. If the ISA decides to take those comments into account and (further) amend the abstract, it will notify the IB of the final content of the abstract. (See PCT R. 38.)

2001-09

Competent ISA where the international application is filed with the IB as receiving Office

Q: *I am the agent for an international application which was recently filed with the IB as receiving Office. Since the only applicant at the time of filing was a resident and national of Canada, the ISA that was marked in Box No. VII of the Request Form was the EPO, the only one which was competent. It is now our intention to file a request under PCT R. 92bis to add to the application an applicant who is a resident and national of the United States of America. If we do this, would it be possible to change our choice of ISA to the United States Patent and Trademark Office (ISA/US)?*

A: Where an international application is filed with the IB as receiving Office (RO/IB), the competent ISA is/are, according to PCT R. 35.3, that (or those) which would have been competent if the international application had been filed with the national Office of, or acting for, a Contracting State of which the applicant is a resident or national. Therefore, in your case, since Canada was the State indicated as the only applicant's State of residence and State of nationality in Box No. II of the Request Form at the time of filing, the only competent receiving Office other than RO/IB was the Canadian Patent Office, with the effect that the only competent ISA is the EPO (the EPO being the only ISA specified by the Canadian Patent Office). Even if further applicants are added under PCT R. 92bis, it is

the state of the application vis-à-vis the applicant(s) as at the international filing date which is the decisive factor when determining the competent ISA-adding a further applicant after the filing of the application does not have a retroactive effect and therefore could not affect the ISAs which would be competent.

Note that, similarly, where the international application is filed with RO/IB, the competent IPEA is/are, according to PCT R. 59.1(b), that (or those) which would have been competent if the international application had been filed with the national Office of, or acting for, a Contracting State of which the applicant is a resident or national. In your case, as indicated earlier, the only receiving Office other than RO/IB which the international application could have been filed with was the Canadian Patent Office, therefore, the only competent IPEA is the EPO (the EPO being the only IPEA specified by the Canadian Patent Office), even if the application is assigned, before the filing of the demand, to another applicant who is a national and/or resident of a different PCT Contracting State bound by Chapter II.

It is recalled that if there is an applicant whose State of nationality is different from his State of residence, or if there are two or more applicants with different States of nationality and/or residence, this may, on the basis of PCT Rules 35.3 and 59.1(b), result in a wider choice of ISAs and IPEAs when filing with the RO/IB than when filing with the corresponding national or regional patent Offices as receiving Offices.

2002-03

Filing a demand for international preliminary examination when the ISR is late

Q: *I have filed an international application claiming the priority of an application filed in August 2000 and designating all PCT Contracting States. The 19-month time limit for filing the demand in order to benefit from the later time limit for entry into the national phase in all designated States of 30 months from the priority date will expire in one week's time, and I have not yet received the ISR relating to my application.*

Consequently, I have nothing on which to base my decision as to whether it is worthwhile filing a demand for international preliminary examination and incurring the fees required therefor. Do I still have to file my demand before that 19-month time limit and pay the fees within one month of filing the demand, even if the ISR has not yet been issued? If the ISR turns out to be negative, can I stop the international preliminary examination procedure and obtain a refund of any fees paid?

A: If you wish to benefit from the 30-month time limit for entry into the national phase under PCT Art. 39(1), you must file your demand within 19 months from the priority date, regardless of whether certain circumstances exist, such as if the ISR has not yet been issued.*

The two fees payable when filing a demand, that is the handling fee and the preliminary examination fee, are, in general, both due within one month of the date of filing the demand (see PCT Rules 57.3 and 58.1(b)). PCT R. 58bis provides for an extension of the time

limit for the payment of those fees, whereby, if the fees have not been paid within that one-month time limit from the filing of the demand, the IPEA issues an invitation to pay the missing amount within one month of that invitation; however, this may be subject to a late payment fee (see PCT R. 58bis.2).

If you receive a negative ISR before paying those fees, and you decide that you do not wish to proceed any further with the international application, you can withdraw the demand (see PCT R. 90bis.4), withdraw the international application, if that is preferred (see PCT R. 90bis.1), or you may simply choose not to pay the fees. In the latter case, shortly after one month from the date of issuance of the invitation to pay the unpaid fees, the demand will be considered by the IPEA not to have been submitted, with the result that the international preliminary examination will not be carried out on the international application and the effect of postponing the commencement of the national phase will be lost.

If, by the time the fees are due, you have still not received the ISR, you can either wait for the invitation to pay the fees—with the possibility of paying an additional fee—in which case the ISR might be issued before you actually pay the fees (and so you would be able to proceed as above in the case of a negative ISR), or you can go ahead and pay the fees in time. In the latter case, if the ISR, when it is eventually received, is negative, and you decide that you do not wish to proceed any further with the international application, you can withdraw the demand and request a refund of the fees from the IPEA concerned.

In the case of the handling fee, the IPEA will fully refund that fee to the applicant if the demand is withdrawn before it is sent by that Authority to the IB (see PCT R. 57.6(i)). The extent, if any, to which, and the conditions, if any, under which the IPEAs will refund any of the international preliminary examination fee varies depending on the IPEA concerned. In the case of many of the IPEAs, if the international application or the demand is withdrawn before the start of the international preliminary examination, there is a refund of 100%, in the case of two of the IPEAs the refund under those conditions is less than that, but in the case of one of the IPEAs, no refund will be given. For details, refer to the PCT Applicant's Guide, Vol. I/B, Annex E. It is worth noting that, if the IPEA is the same Office as the ISA, it is unlikely that international preliminary examination will start before the ISR has been issued, and, as a consequence, the likelihood of a refund is higher.

* This would also be the case after 1 April 2002, when the new time limit under PCT Art. 22(1) enters into force, since you wish to delay the entry into the national phase before all designated Offices, and the new time limit does not apply to certain Offices (for details, see PCT Newsletter No. 02/2002).

2002-04

Acting on behalf of the applicant when the agent of record is not available

Q: *I work for a firm of patent attorneys and have been appointed as the sole agent for a number of inter-*

national applications. I will soon be absent from work for a few months and would like to know whether my assistant will be permitted to file, on my behalf, amendments to the claims under PCT Art. 19 in respect of any of the international applications concerned.

A: Under PCT R. 92, any paper submitted by the applicant in the course of the international procedure must, if not itself in the form of a letter, be accompanied by a letter which must be signed by the applicant, or where the applicant has appointed an agent, by the appointed agent (PCT R. 90). Amendments to the claims under PCT Art. 19 must therefore be submitted with a letter signed by the applicant(s) or an appointed agent. Indeed, the same applies in respect of all actions which may be taken by the agent of record, such as requesting a correction of a priority claim, filing a declaration under PCT R. 4.17, requesting the recording of a change under PCT R. 92bis, filing a demand for international preliminary examination, filing a notice of withdrawal, for example, of a designation, a priority claim or an international application.

Clearly, because of the length of your absence, somebody else should be appointed to act in respect of the international applications that you are currently acting as sole agent for. Note, however, that the person(s) so appointed should have the right to practice before the receiving Office with which the international application was filed (for details, see the PCT Applicant's Guide, Vol. I/B, Annex C). Therefore, if your assistant does not have the right to practice before that Office, he or she will not be entitled to sign any correspondence that must be signed "by or on behalf of the applicant(s)" (see first sentence of answer, above), such as a letter accompanying the amendments under PCT Art. 19, which you refer to above.

The appointment of somebody who has the right to practice before the receiving Office could be made in either of the following ways:

As long as the document by which you were appointed does not limit your power, you could, as agent of record and in accordance with PCT R. 90.1(d), appoint a sub-agent or sub-agents. Such an appointment could be effected by way of a power of attorney signed by you.

The applicant(s) could appoint, by way of a power of attorney, one or more of your colleagues as additional agents for the applications concerned. To ensure that this is not treated as a revocation of the previous appointment (that is, your appointment), that power of attorney should name you, as well as your colleague(s), as agent, or should specifically indicate that the power of attorney is for the purposes of appointing an additional agent or agents (under PCT R. 90.6(b) the appointment of an agent under PCT R. 90.1(a) will, unless otherwise indicated, have the effect of revoking any earlier appointment of an agent made under that Rule).

Note that in both of the above-mentioned cases, the IB will continue to send any correspondence to you as the agent of record, unless it is specifically requested to do otherwise.

In order to avoid such later appointments of sub-agents or additional agents, it is good practice to appoint more than one agent, ideally three or four, in the first place.

For further information on agents and power of attorneys, see PCT R. 90 and PCT Applicant's Guide, Vol. I/A, paras. 78–86 and 410–423.

2002-05

Time limit for requesting the recording of changes under PCT R. 92bis

Q: *Further to the modification of the time limit under PCT Art. 22(1) from 20 to 30 months, I would like to know whether this change extends to the term for the recording of a change under PCT R. 92bis, and, if so, whether any such change requested after 20 months from the priority date will be communicated to any of the designated Offices that have notified the example, I, as agent for the applicant, have filed an international application, the priority date of which is 10 October 2000 and in respect of which a demand is not going to be filed. The international application is likely to be assigned to a new applicant in July 2002, that is, after 20 months from the priority date. Will the IB record this change, and if so, will it inform all designated States, including those for which the new 30 month time limit under PCT Art. 22(1) does not apply?*

A: According to PCT R. 92bis.1, the IB (IB) will record a change if the request for recording is received by it before the expiration of the time limit under PCT Art. 22(1), where PCT Art. 39(1) is not applicable with respect to any Contracting State, or before the expiration of the time limit under PCT Art. 39(1), where PCT Art. 39(1) is applicable with respect to at least one Contracting State.

In view of the fact that the time limit under PCT Art. 22(1) has been modified, with effect from April 1, 2002, from 20 to 30 months, the IB will now, in respect of applications for which the period of 20 months from the priority date expires on or after April 1, 2002, record all requests for changes up to the expiration of 30 months from the priority date, regardless of whether a demand for Chapter II has been filed before the expiration of 19 months from the priority date, and regardless of whether any of the Offices designated has notified the IB that the modification of PCT Art. 22(1) is incompatible with its applicable national law. The IB will also notify all designated Offices concerned via a copy of Form PCT/IB/306 of any such changes (see Section 422 of the Administrative Instructions under the PCT), regardless of whether any of those States have notified the IB that the modification of PCT Art. 22(1) is incompatible with the applicable national law. Therefore, in your example, even though you are not going to file a demand for international preliminary examination, and even if the new 30-month time limit does not apply in respect of some of the designated Offices, the IB will record the change of applicant and inform all designated Offices concerned of the change, provided your request for recording of a change is received by it on or before 10 April 2003 (that is, 30 months from the priority date).

In respect of any change under PCT R. 92bis which is recorded after 20 months from the priority date, where any of the designated Offices has notified the IB of the incompatibility of modified PCT Art. 22(1) with its national law, and in respect of which the national phase has or will be entered by the applicant, each of these Offices will decide whether or not to accept the change requested. Therefore, the legal effect of the change recorded under PCT R. 92bis.1 will vary from Office to Office. In any case, as is generally the case, Offices are entitled to require additional evidence or documents in the national phase regarding any change requested during the international phase (for information on the Offices which require additional documents in the national phase, including a new request for change specifically for the national phase before a particular Office, see PCT Applicant's Guide, Vol. II, National Chapter Summaries).

Note that even where a designated Office has informed the IB under PCT Art. 22(3) that a later time limit for entry into the national phase applies, such as 31 months from the priority date, the applicable time limit for requesting the recording of a change remains, as stated in PCT R. 92bis.1, the time limit referred to in PCT Art. 22(1), that is, 30 months, not 31 months, from the priority date.

2002-06

Documents to be submitted when requesting the recording of a change of applicant and/or agent

Q: *I have been appointed as the agent for a number of international applications, some of which will be assigned to another corporate applicant prior to entry into the national phase. Please could you clarify which documents are needed for requesting the recording of the following changes under PCT R. 92bis (apart from the letter requesting the change) under the following circumstances:*

- 1) a change of applicant, requested by the appointed agent ("agent of record") who will remain the agent of record;
- 2) a change of applicant and a change of agent, both requested by the agent of record;
- 3) a change of applicant and a change of agent, both requested by the new, as yet, unappointed agent.

A: It is recalled that requests for the recording of a change under PCT R. 92bis may be submitted to either the receiving Office or the IB. However, the change will be recorded earlier if it is sent direct to the IB, which is particularly important if the application is due to be published shortly and the change is to be reflected in the international publication, or if the request for recording of a change is being made shortly before the expiration of the time limit under PCT R. 92bis (that is, 30 months from the priority date). The following information applies where the request for the recording of a change is being sent direct to the IB:

- 1) Where there is only a change of applicant, the recording of which is being requested by the agent of record, only a power of attorney appointing the former agent of record as the new agent of record and signed

by the new applicant should be furnished. The change will nevertheless be recorded prior to the receipt of the power of attorney.

- 2) Where a change of applicant and a change of agent are requested by the agent of record, a power of attorney appointing the new agent and signed by the new applicant should be furnished. The change will nevertheless be recorded prior to the receipt of the power of attorney.

In both situations 1) and 2), it is not necessary at this stage to submit any assignment or other documentation by means of which the change of applicant was effected. The agent will simply be requested to furnish the missing power of attorney.

- 3) Where a change of applicant and a change of agent are requested by an agent not yet named in the request, in order for the changes to be recorded, a copy of an assignment (that is, the written consent of the applicant of record for the change of applicant) or other documentary evidence supporting the change of applicant must be filed with the request for change, together with a power of attorney appointing the new agent and signed by the new applicant. Note that the change cannot be recorded until those papers have been received.

It is important to be aware that if there are other applicants in situations 2) and 3), for example applicant/inventors, and all applicants are to be represented by a common agent, they should also sign a power of attorney in favor of the new agent. Otherwise, if such a power of attorney has not been furnished, the new agent will not be authorized to perform certain acts in respect of the applications concerned, for example he/she will not be able to request any withdrawals under PCT R. 90bis without the signature of those applicants.

Note that even though an assignment or other documentation by means of which the change of applicant was effected may not be required by the IB (see situations 1) and 2)), the designated Offices are nevertheless entitled under PCT R. 51bis to require, after the international application has entered the national phase, proof of ownership and transfer of ownership. Details of the requirements of the various national and regional Offices are set out in the PCT Applicant's Guide, Vol. II, National Chapter Summaries.

For further information on the procedure for requesting the recording of changes under PCT R. 92bis, see PCT Applicant's Guide, Vol. I/A, paras. 427 to 431 and PCT Newsletter No. 12/2001; for further information on the time limit for requesting the recording of a change under PCT R. 92bis, see the practical advice in last month's issue of the PCT Newsletter (No. 05/2002).

2002-07

Using an address for correspondence

Q: *I appointed a US agent while living in the United States of America (US) to act on my behalf in respect of an international application, for which I am sole applicant, that was filed with the United States Patent and Trademark Office (USPTO) as receiving Office. Recently I left the US and moved to Australia, and since it seemed impractical to have an agent in the*

US, I revoked the appointment of that agent, hoping, for the sake of convenience, to find an Australian patent agent who I could appoint to take over as agent for the international application. But now I am wondering whether it is possible for me to appoint such an agent to act before the USPTO as receiving Office?

A: According to PCT R. 90.1(a): "A person having the right to practice before the national Office with which the international application is filed [emphasis added]... may be appointed by the applicant as his agent to represent him before the receiving Office, the IB, the ISA and the IPEA." Thus, in order to be validly appointed, the agent must have the right to practice before the receiving Office, which in this case is the USPTO. That Office has specified that only patent attorneys and patent agents registered to practice before the USPTO may act as agents before it. It is therefore unlikely that there are many Australian patent agents who could be validly appointed before the USPTO, but you may nevertheless wish to check the register at the USPTO (see: <http://www.uspto.gov/web/offices/dcom/olia/oed/roster/index.html>).

From a practical viewpoint, since you are sole applicant and you have revoked the appointment of the earlier agent, there is a feature of the PCT system that you could make use of that would allow you to arrange for all correspondence to be sent to the person in Australia who you would like to help you with your application (see PCT R. 4.4(d)). To do this you should make a request for a change under PCT R. 92bis requesting that a change in your country of residence be recorded, and also that all future documents and correspondence relating to the international application be sent to the person of your choice as "an address for correspondence." That person would not, however, be entitled to act on behalf of the applicant in respect of the application and would merely receive all correspondence which would normally be addressed to you as applicant. That person would not have the right to sign any papers, including letters, on your behalf—any such papers would have to be signed by you.

If you had known at the time of filing the international application that you were going to move to another country, and you had filed the application with the IB as receiving Office (RO/IB), you could initially have appointed an agent in the US, revoked that appointment when you moved to Australia, made a request for recording a change of residence of the applicant under PCT R. 92bis, and then validly appointed an Australian agent (provided that he/she was entitled to practice before the Australian Patent Office). In this case, the new appointment would have been valid due to the fact that, according to PCT R. 83.1bis(a), any person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant is a resident or national is entitled to practice in respect of the international application before RO/IB (as opposed to a person having the right to practice before the national Office with which the international application was filed (see PCT Art. 49) in the case of other receiving Offices). (See also the practical advice in PCT

Newsletter No. 07/1996 concerning entitlement to practice before RO/IB.)

For information on who can act as agent before each receiving Office, see the PCT Applicant's Guide, Vol. I/B, Annex C.

2003-01

Withdrawal of priority claims to postpone entry into the national phase; effect of withdrawal of priority claim where national phase already entered before certain Offices

Q: I have filed, within 19 months from the priority date, a demand for international preliminary examination in respect of an international application; the time limit for entry into the national phase is therefore that which is applicable under PCT Art. 39(1) in respect of all elected Offices. I have already entered the national phase before certain elected Offices where the time limit for entry into the national phase under PCT Article 39(1)(a) was 30 months from the priority date. Is it possible to delay even further the entry into the national phase before those elected Offices for which the time limit for entry into the national phase under Article 39(1)(b) is 31 months or more from the priority date? May I do so by withdrawing the priority claim before entry into the national phase? Also, for those Offices before which the international application has already entered the national phase, does the withdrawal of the priority claim affect the validity of the priority claim before them?

A: According to PCT R. 90bis.3, the applicant may withdraw a priority claim at any time **prior to the expiration of 30 months** from the priority date; in other words, if a notice of withdrawal of a priority claim is received by the IB or the receiving Office after the expiration of 30 months from the priority date, it has no effect under PCT R. 90bis.3, neither in the international phase nor in the national phase. The fact that the applicable time limit for national phase entry is 31 months from the priority date before certain Offices, instead of 30 months, does not make any difference since the R. expressly refers to "30 months," and not to the time limit under PCT Art. 39(1). If your notice of withdrawal of the earliest priority claim had been received prior to the expiration of 30 months from the priority date, any time limit which had been computed from the original priority date and which had not already expired would, if there had been no other priority claim, be recomputed from the international filing date or, if there had been another priority claim, be recomputed from the new priority date resulting from the withdrawal of the earliest priority claim (see PCT R. 90bis.3(d)). The applicable time limit for entry into the national phase would therefore have been extended for any Office before which the national phase had not yet been entered. Note that the PCT makes no provision for the withdrawal of a priority claim only in respect of certain designated/elected Offices. However, if your notice of withdrawal had been received prior to 30 months from the priority date and the national phase had already been entered before certain designated/elected Offices earlier than the 30-month time limit, the withdrawal of the priority claim would have no effect in any Office where the

processing or examination of the international application had already started (see PCT R. 90*bis*.6(a)). Please be aware that before withdrawing any priority claim, you must consider the consequences that such withdrawal will have on the assessment of novelty and inventive step in the light of the relevant prior art, which would then include only prior art published before the international filing date or any other priority date. You may, after considering this factor, prefer to maintain your priority claim rather than to extend the time limit for entry into the national phase. Even though you cannot, in this instance, postpone entry into the national phase by withdrawing the priority claim, it is recalled that certain designated/elected Offices do allow applicants to delay entry into the national phase under certain conditions, usually upon payment of a fee. For details, see the *PCT Applicant's Guide*, Vol. II/A to D, National Chapter Summaries. For possible cases in which reinstatement of rights may be requested under new PCT R. 49.6, see *PCT Newsletter* No. 10/2002, page 3. Further information on this matter will be published in a future issue of the *PCT Newsletter*.

2003-02

Documents required by the designated/elected Office for entry into the national phase

Q: *I am the agent for a number of international applications which have entered the national phase before a particular elected Office. The person who is acting as agent for those applications before that Office for the national phase (the "national agent") has told me that the elected Office requires a copy of the international preliminary examination report (IPER), but it was my understanding that the IB sends a copy of the IPER to all elected Offices. How can I find out what is required by that Office?*

A: Elected Offices **are not entitled to require from the applicant a copy of the IPER** since the IB should have already transmitted such a copy to that Office—after the IB (IB) receives the IPER from the IPEA, the IB transmits copies of the IPER (including any annexes) to the elected Offices, and where the IPER was not established in English, it also sends a translation into English of the body of the report where that is required by any elected Office (see PCT Art. 36(1)). If, for some reason, the elected Office concerned did not receive or cannot locate a copy of such report, the IB will send, free-of-charge, another copy upon request from that Office. The elected Office may require from the applicant himself a translation of any annexes to the IPER (depending on the elected Office—see the Summary in the relevant National Chapter of Vol. II of the *PCT Applicant's Guide*). Also, the applicant may, if he wishes, address comments on the content of the IPER to the elected Office during the national phase (see *PCT Applicant's Guide*, Vol. I, para. 405), although this is by no means a requirement. concerned will invite the applicant to comply, or if there is no invitation, what the time limit is within which he must comply should he not have done so already. It is important to note that the text of each National Chapter dealing with an Office (whether it be national or regional) in its capacity as designated/elected Office is

approved by that Office, and any change which is notified to the IB by that Office is effected as soon as possible on the PCT website and will be included in the paper version in the next set of updating sheets for the *Guide*. Having said this, however, the IB cannot guarantee that the National Chapters deal with all questions that could emerge; also, some Offices may have recently changed one or more of their requirements, but have not yet informed the IB of the change(s). Generally, unless the applicant requests early entry into the national phase, certain documents should not be required for the designated/elected Office upon entry into the national phase (for example, ISR's, IPER's, priority documents); however, the national agent himself may wish to have a copy of those documents so as to have a complete file and be in a better position to advise you during the course of the national phase; you should, therefore, send him a copy of such documents if he requests them. If you have doubts as to the need to comply with any requirements, you should contact the IB for assistance. Note that, **following national phase entry**, and where required, for example in connection with substantive examination of the application, the designated/elected Office may require the applicant to furnish certain documents, such as a translation of the priority document or a certified translation of the international application (see PCT R. 51*bis*.1(e) and (d)(ii), respectively).

2003-06

Filing an international application in which the only applicant for one of the designated States is neither a resident nor a national of a PCT Contracting State

Q: *I have just been asked by my client, a US corporation, to start filing PCT applications on its behalf. One of the applications is to be filed in the name of that corporation, under its Venezuelan-based commercial establishment, as applicant for the purposes of all designated States except the US. However, the applicant for the purposes of the US designation, that is, the inventor, is a resident and national of Venezuela, which is not a PCT Contracting State. Will this cause any problems for the application or for the US designation?*

A: According to PCT R. 18.3, if there are two or more applicants, the right to file an international application exists if **at least one of them** is entitled to file an international application according to PCT Art. 9; that is, if at least one of them is a national or resident of a PCT Contracting State, regardless of the respective nationality and residence of each of the other applicants. Your application fulfills this requirement since one of the applicants (the corporate applicant) is a national of a PCT Contracting State (US). The PCT **does not require** that, for each designated State, there must an applicant indicated for the purposes of that State who is entitled to file an international application according to PCT Art. 9. It is recalled, however, that prior to 1 July 1992, there was a requirement under former PCT R. 18.4(a) that for each designated State, at least one of the applicants indicated for the purposes of that State had to be entitled to file an

international application according to PCT Art. 9(1); that is, for each designated State, at least one applicant for the purposes of that State had to be a resident or national of a PCT Contracting State. In order to relax the Rules relating to residence and nationality, the PCT Assembly decided to delete that requirement with effect from 1 July 1992 and to introduce (current) PCT R. 18.3, which entered into force as from that date. If the applicant intends to file a demand for international preliminary examination, there will not be any problems filing a demand in the name of the above-mentioned applicants since, according to PCT R. 54.2, the right to make a demand exists if the applicant making the demand or, if there are two or more applicants, at least one of them is a resident or national of a Contracting State bound by Chapter II (all PCT Contracting States are currently bound by Chapter II) and the international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II. As far as entry into the national phase is concerned, PCT Articles 22 and 39, which specify the requirements for entry into the national phase, do not include any requirements concerning the residence or nationality of the applicant(s). For information on the assignment, during the international phase, of an international application to a person who is neither a resident nor a national of a PCT Contracting State, see PCT Newsletter No. 05/1994, page 3.

2003-11

The non-designation of certain States in the new Request Form, applicable as from 1 January 2004

Q: I have heard that as from 1 January 2004, although all States will automatically be designated, it will be possible to choose not to designate Germany, the Republic of Korea and the Russian Federation. Why are those three States treated differently, and why would an applicant wish not to designate those States?

A. It is recalled that in October 2002, the PCT Assembly adopted, among others, amendments to PCT R. 4.9 giving the applicant an automatic and all-inclusive coverage of all designations under the PCT when filing a PCT request, and that PCT R. 4.9(b), as amended, contains the following transitional reservation provision: "...if, on October 1, 2002, the national law of a Contracting State provides that the filing of an international application which contains the designation of that State and claims the priority of an earlier national application having effect in that State shall have the result that the earlier national application ceases to have effect with the same consequences as the withdrawal of the earlier national application, any request may, for as long as that national law continues to so provide, contain an indication that the designation of that State is not made, provided that the designated Office informs the IB by January 1, 2003, that this paragraph shall apply in respect of designations of that State..." Germany (DE), the Republic of Korea (KR) and the Russian Federation (RU) have each made use of this transitional reservation provision given that the respective national laws of these three countries

provide for the automatic withdrawal of an earlier national application if a later international application claims priority of that earlier national application and designates the country concerned (known as "self-designation"). DE, KR and RU have accordingly notified the IB that PCT R. 4.9(b) applies to them (see PCT Newsletter No. 02/2003, page 5). Applicants will therefore be able to indicate that those States are not designated for any kind of national protection, and by doing so, will avoid the ceasing of the effect, under the respective national laws, of an earlier national application, filed in that country, from which priority is claimed. For this reason, the new Request Form, applicable with effect from 1 January 2004, contains check-boxes in Box No. V enabling applicants to exclude DE, KR and/or RU from the automatic and all-inclusive coverage of designations. Note, however, that if any of those check-boxes are marked, the designations concerned are irrevocably excluded. The designations of DE for the purposes of a European patent and of RU for the purposes of a Eurasian patent are not affected by what is said above. Note that even though no other State has notified the IB that PCT R. 4.9(b) applies to it, the consequences described above with respect to the earlier national application, the priority of which is claimed, may also apply to other States, for example, Japan (information on any such situation is under preparation for publication in the PCT Applicant's Guide, Vol. I/A, Annex B1). In such a case, however, the applicant will not be able to exclude the designation from the Request Form as in the case of DE, KR and RU, but may wish to consider submitting, separately from the request, a notice of withdrawal of the designation concerned.

2004-01

(1) Signature requirements for the withdrawal of the US designation

Q: I am just about to file an international application, in which I do not want the United States of America (US) to be designated. However, since my application will be filed after 1 January 2004, I understand that US will be automatically designated under the new regulations which entered into force as from that date. In the request I have indicated the inventors as inventors only, but it is my understanding that if US is designated, the receiving Office will make an ex officio correction so that the inventors are indicated as applicants/inventors for the US designation. Bearing in mind that any notice of withdrawal must be signed by all the applicants, will the notice of withdrawal of the US designation which I intend to submit need to be signed by the inventors?

A: Since your application will be filed after the entry into force of amended PCT R. 4.9(a), your application will automatically include the designation of US. If you wish to withdraw the US designation, you will not need the signatures of the inventors if they have not been indicated as applicants in the request. This is due to the fact that, according to the PCT Receiving Office Guidelines, as amended with effect from 1 January 2004 (see: www.wipo.int/pct/en/texts/gdlines.htm), the receiving Office should no longer make an *ex officio* correction where, for the purposes of the US designa-

tion, the inventors are named but are not also indicated as applicants for the purposes of that designation. The *ex officio* correction procedure was the subject of paragraph 92 of the previous version of the Guidelines, which continues to apply to international applications filed before 1 January 2004, but which has been deleted from the version applicable as from 1 January 2004. Instead, the receiving Office will simply notify the applicant that the application may be rejected by the United States Patent and Trademark Office as designated Office because only the inventor is qualified to file a national application in US (see paragraph 93 of the Guidelines). If the applicant intends to enter the national phase in the US, it will then be up to the applicant to respond to that notification by requesting that the inventors be indicated as applicants for the US, and that request will be treated as a request to record a change under PCT R. 92bis. Therefore, unless the applicant specifically requests the receiving Office to change the inventors to applicant/inventors, their status will remain as indicated by the applicant in the Request Form. Note also that PCT R. 90bis.5 states that any notice of withdrawal must be signed by the applicant, and paragraph 314 of the Guidelines, as amended with effect from 1 January 2004, more specifically points out that any notice of withdrawal has to be signed by, or on behalf of,

all applicants indicated as such in the international application at the time the notice of withdrawal is submitted.

Bearing this in mind, and the fact that the indication of "inventors only" will not be changed *ex officio* by the receiving Office to read "applicant and inventor" for the purposes of the US designation, the signatures of the inventors will not be required in your case when withdrawing the US designation.

For any international application in which the inventors are indicated as applicants and inventors at the time when the US designation is withdrawn, their signature would be required for the withdrawal of the US designation. For further information on the new designation system, see *PCT Newsletter* No. 11/2003, cover page, and for further information on the withdrawal of designations, see the *PCT Applicant's Guide*, paragraphs 454–459 and *PCT Newsletter* No. 08/1999.

(2) The consequences of using an old version of the Request Form in respect of an international application filed on or after 1 January 2004

Q: *My company has filed a number of international applications which were prepared at the end of 2003 using the July 2003 Request Form. However, the applications were not mailed until 2 January 2004. What will be the consequences of using an "old" Request Form for an international application filed after 1 January 2004?*

A: Under R. 4.9(a), as applicable to international applications filed on or after 1 January 2004, the filing of a request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date for the grant of every kind of protection available and, where applicable, for the

grant of both regional and national patents. Therefore, if an applicant files an international application on or after 1 January 2004 using a 2003 (or older) version of the PCT Request Form (PCT/RO/101 or PCT-EASY request form print-out), regardless of the specific designation of States made by the applicant in Box No. V of that request, **all designations possible on the international filing date are automatically made.**

Also, the text concerning the confirmation of precautionary designations, printed at the bottom of Box No. V of the old request that you submitted, no longer has any effect since former PCT R.s 4.9(b) and (c) have been deleted with effect from 1 January 2004, given that, with the operation of new PCT R. 4.9(a), all States are designated automatically. In cases where the July 2003 request has been used in respect of an international application filed on or after 1 January 2004, the receiving Office (RO) should draw the attention of the applicant to the fact that all possible designations have been made under PCT R. 4.9(a). However, in order to simplify the handling of such cases for ROs, the IB and the applicant, no *ex officio* corrections to the Request Form need to be made by the RO, and the applicant should not be invited to furnish a corrected request. The list of all designations made as of the international filing date will be included by the IB in Form PCT/IB/301, which is sent to the applicant (or his agent, as the case may be) shortly after the IB has received the record copy of the application from the RO concerned. It is recommended that the list be checked to see whether it contains all the States that the applicant thought had been designated in the application. As is the case for all international applications filed on or after 1 January 2004, if you do not wish to maintain the designation of all States, you may withdraw, under R. 90bis.2, the designation(s) of the State(s) concerned. (Note that if you had used the January 2004 version of the request, it specifically provides that the designations of DE, KR and/or RU for any kind of national protection may be excluded—for further information, see *PCT Newsletter* No. 11/2003, page 11)

Note also that, since your international application was filed after 2 January 2004, you will be subject to the payment of the fees that are applicable with effect from 1 January 2004, that is, the international filing fee, instead of the basic and designation fees, and, if applicable in respect of the applications concerned, you will be entitled to the fee reductions that are applicable with effect from that date (see *PCT Newsletter* No. 10/2003, cover page, and No. 11/2003, page 4, for further information on the changes regarding fees). For further information on the differences between the old version of the request and the current version, see *PCT Newsletter* No. 11/2003, page 5; for further information on the new designation system, see *PCT Newsletter* No. 11/2003, cover page; and for further general information on the withdrawal of designations, see the *PCT Applicant's Guide*, paragraphs 454–459 and *PCT Newsletter* No. 08/1999.

2004-02**The procedure for withdrawing designations**

Q: *Given that, with the entry into force of amended PCT R. 4.9(a), all PCT Contracting States will be automatically designated in international applications filed on or after 1 January 2004, I may wish to withdraw certain designations in respect of a number of international applications. Could you please explain the procedure for withdrawing designations—is there a special form for that purpose? Also, where should the notice of withdrawal be sent, and what is the time limit for sending such notice?*

A: You may withdraw designations either by means of a notice of withdrawal contained in a letter or by means of a new form which has recently been made available to applicants or their agents by the IB : Form PCT/IB/372 (“Notice of withdrawal”). This form can be used for the withdrawal of the international application, designations, priority claims, the demand or elections and is available in PDF format on the PCT website at: www.wipo.int/pct/en/forms/index.htm If you submit Form PCT/IB/372, you should include the following information in the corresponding boxes of the form: applicant’s or agent’s file reference, international application number, the name of the first-named applicant in the request, the international filing date and the (earliest) priority date. You should check the relevant box to indicate what is being withdrawn, and the form must be signed (see below for further information on signature requirements). If a letter is used instead of the form, it should also contain all of this information and must be signed. Even though the notice of withdrawal may be submitted to the receiving Office, or the IPEA, as the case may be (see PCT R. 90*bis*), it is advisable to send all notices of withdrawal (that is, withdrawals of international applications, designations, priority claims, demands or elections) direct to the IB (Form PCT/IB/372 is preaddressed to the IB). Sending notices of withdrawal direct to the IB will prevent any possible delay that may occur as a result of the extra administrative step that is required when such a notice is sent to a receiving Office or an IPEA, as the case may be. Note, however, that if the applicant is withdrawing a designation **at the time of filing the international application**, it is more practical for the applicant to transmit the notice of withdrawal direct to the receiving Office along with the international application; at this stage in the procedure, there is less urgency for the notice to reach the IB quickly since, unless early publication has been requested, there should be sufficient time before the completion of technical preparations for international publication (see below). Note that the fact that Form PCT/IB/372 is preaddressed to the IB does not prevent you from sending it to the receiving Office, but you are advised in such a case to cross out the address of the IB and insert the address of the receiving Office. Likewise, if you send a notice of withdrawal of a demand to the IPEA, you should insert the address of the IPEA concerned. Designations may be withdrawn at any time prior to the expiration of 30 months from the priority date (see PCT R. 90*bis*.2(a)) (this time limit also applies to the other types of withdrawals listed above). However, if it is intended that the withdrawal

be effected before international publication, the notice of withdrawal must reach the IB before the technical preparations for international publication have been completed (which is generally (but not always) by the 15th day prior to the date of publication) (see PCT R. 90*bis*.2(e)). In order for the withdrawal to be effective, the notice of withdrawal (whether it be via Form PCT/IB/372 or a letter) must be signed by all applicants, their appointed agent or the appointed common representative. Where a notice of withdrawal is signed by an agent but a power of attorney signed by all applicants has not yet been furnished, the notice of withdrawal will only be effective once the missing power of attorney has been furnished. This also applies, pursuant to PCT R. 90.4(e) and 90.5(d), where a receiving Office or IPEA has waived the requirement that a separate power of attorney and/or copy of a general power of attorney has to be furnished (PCT Rules 90.4(d) and 90.5(c)). Where the signature is that of the “deemed” common representative (under PCT Rule 90.2(b)), the notice will not be considered to be signed as required—in such a case, all the applicants must sign the notice of withdrawal (see PCT Rule 90*bis*.5)). The IB will send you Form PCT/IB/307 (“Notification of withdrawal of international application or designations”), Form PCT/IB/317 (“Notification of withdrawal of priority claim”) or Form PCT/IB/339 (“Notification of withdrawal of demand or elections”), as the case may be, upon receipt of a notice of withdrawal or a notification from the receiving Office or IPEA that the withdrawal has been effected. The form will include the date of receipt of the notice by the Office or Authority concerned. For further information on the withdrawal of international applications, designations, priority claims, demands and elections, see PCT Art. 37, PCT Rule 90*bis* and the *PCT Applicant’s Guide*, Vol. I/A, paragraphs 452 to 463. For advice about notices of withdrawal which need to be processed urgently, see *PCT Newsletter* No.03/2003, cover page, and for further information on the signature requirements for the withdrawal of the US designation, see *PCT Newsletter* No. 01/2004, page 8.

2004-03**Automatic designation of US: the consequences of the applicant/inventor being a resident and national of a non-PCT Contracting State**

Q: *I work for a company based in the United States of America (US) which files several PCT applications a year. Prior to the entry into force of the 1 January 2004 amendments to the PCT Regulations, it was our practice not to designate US in international applications, given that we always file in US first via the national route. Now that US is automatically designated in all international applications filed since 1 January 2004, our practice will be to maintain that designation, rather than withdraw it, in respect of each international application concerned. Also, given that for the purposes of the US designation the inventor(s) must be the applicant(s), we will indicate the inventors as applicants for the US designation in the request. However, the only applicant/inventor in respect of a number of international applications that are to be filed is not a national of,*

and no longer resides in, a PCT Contracting State. Will this cause any problems for the application?

A: With the automatic designation of US in all international applications filed since 1 January 2004 (see amended PCT Rule 4.9(a)), all inventors should be indicated as applicants. You are therefore correct to indicate the inventors as applicants if you are going to maintain the US designation. However, you do not need to worry about the country of residence and nationality of the inventor in the case in question because, according to PCT Rule 18.3, if there are two or more applicants, the right to file an international application exists if at least one of them is entitled to file an international application according to PCT Art. 9; that is, if **at least one of them is a resident or national of a PCT Contracting State**. Since the corporate applicant is based in a PCT Contracting State, the nationality and residence of the applicant/ inventor is of no relevance.

2004-04

Automatic designation of the US: indication of the inventors as “inventors only” where there is no intention to enter the national phase in the US

Q: *We usually file national patent applications in the United States of America (US) first before filing our PCT applications. Prior to the entry into force of the January 2004 amendments to the PCT Regulations, it was our practice not to designate the US in international applications and to indicate the inventors as “inventors only” in the request. Now that the US is automatically designated, and bearing in mind that it is still our intention not to enter the national phase in the US, we would like to know whether we are obliged to indicate the inventors as applicants for the US designation. This would create unwanted additional paperwork, for example, because of the need to furnish the signatures of the inventors if they are also applicants.*

A: If you are sure that you have no intention of entering the national phase in the US, there is no obligation to indicate inventors as applicants and obtain their signatures. If you indicate the inventors as “inventors only,” this will not prevent the international application from proceeding in the international phase and, provided that you do not attempt to enter the national phase in the US, will be of no consequence to your application later on. If you proceed in this way, there will be no applicant for the purposes of the US designation, but, as indicated in the “Practical Advice” in PCT Newsletter No. 01/2004, the receiving Office will no longer make an *ex officio* correction from “inventor only” to “applicant and inventor” for the purposes of the US designation. You will, however, receive a notification warning you of the potential consequences of not indicating the inventor as applicant (see the Receiving Office Guidelines, paragraph 93). If, after having received this message, you still do not intend to enter the national phase in the US, there is no need to reply to that notification. (You only need to reply to it if you change your mind and decide that you do wish to enter the national phase in the US, in which case you should request that the inventors be indicated as applicants for the US designation, and the receiving Office would

treat that request as a request to record a change under PCT Rule 92bis.) Note also that, if you are filing your international application using the PCT-SAFE software, and you indicate the inventors as “inventors only” when entering the bibliographic data, you will receive a (yellow) warning message to alert you to the fact that the inventor should be indicated as applicant/ inventor for the purposes of the US designation. This warning will not prevent you from proceeding with your application. It is important to stress that you should only indicate the inventors as “inventors only” if you are sure that you will not wish to enter the US national phase, or that you do not wish to take advantage of having a co-pending “US application” until 30 months from the priority date. If you are at all uncertain about your intentions, it is safer to keep your options open and indicate the inventors as applicants.

2004-05

Automatic designation of all PCT Contracting States: alternative to withdrawing a designation where there is no intention to enter the national phase in that State

Q: *In the context of the new all-inclusive designation system, I read your recent “practical advice” articles on the signature requirements for withdrawals of designations (in PCT Newsletter Nos. 01 and 02/2004).*

Wishing to avoid unnecessary paperwork, I would like to know whether it is necessary to withdraw a designation if there is no intention to enter the national phase in a particular State, and what the consequences are of not withdrawing the designation?

A: There is no obligation to formally withdraw a designation if you do not intend to enter the national phase in the State concerned. By not performing the acts necessary under PCT Art. 22 (or 39(1)) within the applicable time limit for entry into the national phase in that State, your international application will simply cease to have any effect in that State with the same consequences as the withdrawal of a national application in that State (PCT Art. 24(1)(iii)). By simply not taking any action to enter the national phase within the prescribed time limit, you will avoid having to send a notice of withdrawal, and you will also avoid having to furnish the signatures of all the applicants which will be required to make such a withdrawal (unless they have previously appointed the agent or common representative submitting the withdrawal). Also, by not withdrawing the designation, you will be keeping your options open, in case you change your mind, to enter the national phase in the State concerned before the expiration of the time limit under PCT Art. 22 or 39(1) (whichever is applicable). Once a designation has been withdrawn, the effect of the international application in that State ceases (see PCT Art. 24(1)(i)), and, although it would depend on the national law of the State concerned, you would normally not be able to enter the national phase in that State. Note that under certain circumstances it may be advisable to withdraw certain designations. It is recalled that the national laws of certain States provide for automatic withdrawal of an earlier national application if a later international application claims priority of that earlier national application and designates the country con-

cerned. The earlier national application will therefore be withdrawn if the designations concerned are not withdrawn from the international application (see the "practical advice" in *PCT Newsletter* No. 11/2003). Germany, the Republic of Korea and the Russian Federation have notified WIPO under PCT Rule 4.9(b) that this situation applies to them. In the case of these three States, a special check-box has been made available in Box No. V of the Request Form enabling applicants to exclude those States from the automatic and allinclusive coverage of designations without having to specifically withdraw them. The designation of any other States which have a similar provision under their national law, for example, Japan, cannot however be excluded in the Request Form, and so in such a case, you may wish to consider submitting (preferably at the same time as submitting the request) a separate notice of withdrawal of the designation concerned in order to avoid the automatic withdrawal of the earlier filed national application (in the case of Japan, the withdrawal should be made before the expiration of 15 months from the priority date). Information on any such situation is published in *PCT Applicant's Guide*, Annex B1. For further information on the withdrawal of designations, see the *PCT Newsletter* No. 02/2004, page 6. Note also that by not withdrawing a particular designation before technical preparations for the international publication of the international application have been completed, the published application will reflect the fact that the State concerned was designated in the international application.

2004-06

Applicability of power of attorney waivers

Q: *I refer to the recent amendments to the PCT Regulations which introduced the possibility for receiving Offices to waive the requirement that powers of attorney be submitted. Does this mean that, if the receiving Office with which the international application is filed has made such a waiver, the applicants no longer need to sign the request or a power of attorney appointing the agent (or common representative) who has signed the request?*

A: Under new PCT Rule 90.4(d), any receiving Office (RO), ISA, IPEA and the IB may waive the requirement under PCT R. 90.4(b) that a separate power of attorney appointing an agent or a common representative be submitted to it. Similarly, under new PCT R. 90.5(c) any RO, ISA or IPEA may waive the requirement under PCT Rule 90.5(a)(ii) that a copy of the general power of attorney be attached to the request, the demand or the separate notice, as the case may be. Therefore, if a receiving Office has waived the requirements under PCT Rule 90.4(b) and/or 90.5(a)(ii), the request can be signed by an agent without the need for a power of attorney to be furnished for the purposes of the filing of the international application.

However, according to Sections 336(c), 433(b), 517(c) and 617(c) of the Administrative Instructions, applicable since 1 January 2004, an Office may require a separate power of attorney or a copy of a general power of attorney in particular instances, even if it has

waived the requirement in general. Indeed, many of the Offices which have waived the requirement that a power of attorney be submitted have indicated particular instances in which a separate power of attorney or a copy of a general power of attorney will be required. For example, several offices have indicated that a power of attorney would be required upon appointment of, or for any paper submitted by, an agent or a common representative who was not indicated in the Request Form at the time of filing. Information about any power of attorney waivers and about any particular instances in which a separate power of attorney or a copy of a general power of attorney will be required is published in the PCT Newsletter as and when the waivers are made (see Nos. 01 to 05/2004), and will be included in a consolidated table in the July 2004 issue of the PCT Newsletter. The relevant information on waivers that have been made can also be found, for each Office concerned, in Annex C of the PCT Applicant's Guide at:

www.wipo.int/pct/guide/en/index.html

Note, in particular, that in all cases where an Office has, under PCT R. 90.4(d) and/or PCT R. 90.5(c), waived the requirement to submit a power of attorney, the waiver does not apply in the case where a notice of withdrawal has been signed by an agent or common representative who has not been appointed by all (other) applicants (see PCT R. 90.4(e) and 90.5(d))—in this case, powers of attorney (whether they be separate powers of attorney or copies of general powers of attorney), signed by all applicants, would be required in order for the withdrawal to be acted upon. In other words, if a power of attorney has not previously been submitted, a notice of withdrawal must either be signed by all applicants or must be signed by the agent or common representative and be accompanied by powers of attorney signed by all (other) applicants.

As far as the signature of the request is concerned, there is an alternative to submitting a power of attorney, signed by all applicants, appointing the agent, and this applies even where a receiving Office has not waived the requirement under PCT R. 90.4(b) and 90.5(a)(ii). The alternative is for at least one of the applicants to sign the request—it is recalled that under new PCT Rule 26.2bis(a), if the request is signed by one of the applicants, the receiving Office will no longer invite correction, and, consequently, the international application may no longer be considered withdrawn under PCT Art. 14(1) for failure to respond to an invitation to provide signatures (however, in accordance with PCT R. 51bis.1(a)(vi), designated Offices are permitted to require any missing signatures in the national phase). Please note that, if only one of the applicants has signed the request, any notice of withdrawal must be signed either by all of the applicants or by an agent or common representative who has been appointed by all (other) applicants.

Even though the requirement to submit a power of attorney may have been waived by the receiving Office, and even though it is acceptable for only one of several applicants to sign the request in satisfaction of the application's signature requirement, agents or common representatives should carefully consider whether they should in any case obtain the signatures

of all applicants, either by way of signing a power of attorney or by way of signing the request. By obtaining those signatures, any withdrawal, which requires the signatures of all of the applicants or a power of attorney signed by all of the applicants, could be dealt with by the relevant office/authority immediately, and delays caused by waiting for signatures would not be incurred. Even if those signatures are not actually submitted by the agent/common representative, but are merely kept in the file of the agent/common representative, at least they would be available if they were needed later.

Note that the IB has not made any waiver of powers of attorney, as distinct from the receiving Office of the IB (RO/IB), which has made conditional waivers of the requirement to submit a separate power of attorney and/or a copy of a general power of attorney (see PCT Newsletter No. 01/2004, page 3). A power of attorney, signed by at least the deemed common representative (that is, the first-named applicant who is entitled to file with the competent receiving Office) would therefore still be required, for example, where the agent requests the IB to record any changes under PCT Rule 92bis, submits amendments under PCT Art. 19, and/or requests the correction of priority claims.

2004-07

Requirement for the furnishing of powers of attorney under certain circumstances when submitting Article 19 amendments

Q: I am the agent for an international application filed on behalf of a US corporate applicant; several inventors are also named in the application as applicants for the purposes of the US designation. The application was filed with the United States Patent and Trademark Office as receiving Office, and since that Office has waived the requirement under PCT Rule 90.4(b) and 90.5(a)(ii) to furnish powers of attorney, I have not yet furnished any powers of attorney. Having recently received the ISR, I now wish to file amendments to the claims under PCT Art. 19 with the IB. However, I understand that the IB (as distinct from the IB in its capacity as receiving Office) has not waived the requirement to furnish powers of attorney. Do I need to submit a power of attorney together with the amendments?

A: As you correctly state, the IB has not waived the requirement to furnish powers of attorney (although the IB in its capacity as receiving Office has made conditional waivers of the requirement to submit a separate power of attorney and/or a copy of a general power of attorney (see PCT Newsletter No. 01/2004, page 3)). Whether a power of attorney should be submitted to the IB together with the amendments to the claims under PCT Art. 19 ("Article 19 amendments") is a function of:

- (1) who signed the request; and
- (2) who signs the letter which must be submitted together with the replacement sheets containing the amended claims (see PCT R. 46.5).

Four possible scenarios are described below, only the last one of which requires the furnishing of a power of

attorney. In all four scenarios, the agent was indicated as being appointed in Box No. IV of the request.

(1) If the request was signed by the deemed common representative (the first-named applicant who is entitled to file with the competent receiving Office, which in your case is presumably the corporate applicant) and the letter is also signed by the deemed common representative: no power of attorney would be required by the IB since Art. 19 amendments can be submitted directly by the deemed common representative;

(2) If the request was signed by the deemed common representative and the letter is signed by the agent indicated in Box IV: no power of attorney would be required by the IB. This is because the signature of the deemed common representative on the request completes the appointment of the agent, at least as the agent of the deemed common representative, and thus removes the need for a power of attorney;

(3) If the request was signed by the agent indicated in Box IV and the letter is signed by the deemed common representative: no power of attorney would be required, again because Art. 19 amendments can be submitted directly by the deemed common representative;

Therefore, if, as in scenarios (1) and (3), the deemed common representative signs the letter accompanying the Art. 19 amendments, or if, as in scenario (2), the deemed common representative has signed the request, a power of attorney would not be required. However:

(4) If both the request and the letter are signed by the agent indicated in Box IV, a power of attorney would be required by the IB in order to complete the appointment of the agent under the PCT and thus for the IB to act on the submitted Art. 19 amendments. That power of attorney would require the signature of only one of the applicants, that is, the deemed common representative.

The above would also apply, for example, in cases where requests for recording changes under PCT R. 92bis or requests for the correction of priority claims under PCT R. 26bis are submitted to the IB.

However, it is recalled that any notice of withdrawal under PCT Rule 90bis would have to be signed by all applicants or must be signed by the agent or common representative and be accompanied by powers of attorney signed by all applicants, even if the Office with which the notice is filed has waived the power of attorney requirement.

For information on filing Art. 19 amendments, see PCT Rule 46 and the PCT Applicant's Guide, paragraphs 296 to 303. For information on power of attorney waivers in general, see PCT Newsletter No. 06/2004, page 5. For a list of Offices which have made such waivers, see pages 8 and 9.

2004-09

PCT Forms issued in connection with the transmittal of copies of the published PCT application (PCT pamphlet)

Q: I am the agent for a number of international applications which have recently been published. Usually, Form PCT/IB/308, which notifies us that the application

has been forwarded to the various designated Offices, is attached to the PCT pamphlet. However, in the case of the PCT pamphlets concerned, a different form was attached to them which I have never seen before, namely, Form PCT/IB/311 "Notification concerning transmittal of copy of international application as published or republished." Could you explain why I have received this form, why I did not receive Form PCT/IB/308, and also confirm that the copies of the PCT pamphlets concerned were nevertheless forwarded to those designated Offices which should normally receive them.

A: Form PCT/IB/308 is no longer issued together with the PCT pamphlet in respect of international applications filed on or after 1 January 2004. Instead, you have received the PCT pamphlet together with Form PCT/IB/311, a new and simple PCT form which acts merely as a cover sheet stating the nature of the attachment.

Nevertheless, you will continue to receive, separately, Form PCT/IB/308, which informs the applicant of the Offices to which the communication under PCT Article 20 (that is, a copy of the published international application, the ISR and, where applicable, Art. 19 amendments) has been effected, and the date of that communication. The use of this form is provided for under PCT R. 47.1(c), as amended with effect from 1 January 2004. You will receive two different versions of the form in respect of international applications filed on or after 1 January 2004, as follows:

a first notice, sent promptly after the expiration of 19 months from the priority date, which informs applicants of the communication of the international application to designated Offices which do not apply the 30-month time limit under PCT Article 22(1);

a second and supplementary notice, sent promptly after the expiration of 28 months from the priority date, which informs applicants of the communication of the international application to designated Offices which do apply the 30-month time limit under PCT Art. 22(1). Note that, should the situation arise whereby, at the expiration of 19 months from the priority date, the designations of all States that do not apply the 30-month time limit have been withdrawn, Form PCT/IB/308 (first notice) will not be sent and applicants will receive only Form PCT/IB/308 (second and supplementary notice).

Note also that the first notice is currently being sent in accordance with a transitional arrangement (see Note 3 of the transitional arrangements annexed to the Regulations under the PCT) only until such time as all Offices apply the 30-month time limit. When this happens, Form PCT/IB/308 will only be sent once, promptly after the expiration of 28 months from the priority date.

Form PCT/IB/308, in accordance with new R. 47.1(c-bis), will serve as conclusive evidence either that:

- the communication under PCT Article 20 has been effected (in the case of designated Offices which have requested that the communication provided for in PCT Article 20 be effected under PCT R. 93bis.1 at the time the form is issued); or that
- the designated Offices do not require the furnishing

by the applicant, under Art. 22, of a copy of the international application when entering the national phase (in the case of designated Offices which have not requested that the communication provided for in Art. 20 be effected under R. 93bis.1 at the time the form is issued).

In the latter case, once an applicant has entered the national phase before an Office, that Office should always ask the IB (IB) (and not the applicant) for a copy of the international application, which will be sent to them in the form of the PCT pamphlet. In either case, once you have received Form PCT/IB/308, you can rest assured that you will not have to furnish a copy of the international application to the designated Offices.

If a designated Office does request the applicant to furnish a copy of an international application, the applicant should remind that Office that the copy should be requested from the IB. In case of any problems in this respect, you may contact the IB, which will take the matter up with the designated Office concerned.

2004-10

Responses to the written opinion under Chapter I

Q: Now that a written opinion is issued in addition to the ISR by the ISA during the Chapter I procedure, we are filing fewer demands for international preliminary examination than we used to do. Under the Chapter II procedure it is possible to respond to the written opinion of the IPEA—is it possible to respond to the written opinion of the ISA? If so, where should that response be sent, and what is the time limit for submitting a response?

A: All international applications filed on or after 1 January 2004 are subject to the new enhanced international search and preliminary examination system in which a written opinion is incorporated into the international search procedure under Chapter I. The PCT does not provide for any form of dialogue between the applicant and the examiner at the ISA. Such dialogue is provided for only under the Chapter II procedure.

In accordance with a decision of the PCT Assembly it is possible, if the applicant wishes to do so, to submit written comments to the IB (IB) on an informal basis. Those informal comments allow the applicant to address the issues raised in the written opinion of the ISA in the international phase if a demand is not filed. Although there are no express provisions in the PCT Regulations for the submission of such "informal comments," the applicant should be aware of the following points:

They should be submitted to the IB, and not to the ISA or the IPEA.

The informal comments should be clearly marked as "informal comments." If they are not marked as such, the purpose of the document may be unclear to the IB.

They may be submitted independently of, and in addition to, any amendments under PCT Article 19, and there is no requirement to refer in the amendments to the informal comments where both are filed. If the informal comments are filed at the same time as the amendments under PCT Article 19, they must be

submitted on separate pages, noting that, although amendments under Article 19 will be published with the international application, informal comments will not be published.

The IB will send an acknowledgment of receipt of the informal comments to the applicant.

Although there is no time limit for submitting informal comments, the earliest time for submission is after the issuance of the written opinion of the ISA, and it is recommended that applicants send them no later than 28 months from the priority date so that the IB is in a position to communicate them to the designated Offices together with the international preliminary report on patentability (Chapter I of the PCT).

If no demand has been filed, the IB will forward the informal comments to the designated Offices together with the IPRP Chapter I after the expiration of 30 months from the priority date (see PCT R. 44bis.2) (note that the IB will not forward the informal comments to the ISA, and where a demand is filed, it will not forward them to the IPEA).

The informal comments will be open to public inspection as part of the file of an international application at the IB but not before the expiration of 30 months from the priority date (PCT R. 44ter.1 and 94.1). Depending on the applicable national law, the designated Offices may also make the informal comments available to the public.

It is up to the designated Offices to decide whether and to what extent to take the informal comments into account in the national phase.

The designated Offices are free to require a translation of the informal comments.

Note that if the applicant decides to file a demand and wishes the IPEA to take into consideration the content of the informal comments, it is possible to simply use the previously filed informal comments rather than drafting new comments for the IPEA, not forgetting to remove the title "informal comments," as such a title may lead to confusion to the IPEA. Applicants should rather indicate that it is a response for the purposes of the Chapter II procedure. The formal procedure for submitting responses to written opinions under Chapter II, whereby the applicant can submit one or more amendments or arguments to the IPEA, and also has the possibility to communicate orally with the IPEA, has not changed (see PCT R. 66.2 to 66.4).

For further information on the international search and preliminary examination procedures applicable since 1 January 2004, see PCT Newsletter No. 12/2003, and for further information on the written opinion of the ISA, see PCT Applicant's Guide, paragraphs 292A to F.

2004-12

Consequences of the power of attorney waiver made by the IB

Q: Now that the IB has, with effect from 1 January 2005, waived the requirement under PCT Rule 90.4(b) that a separate power of attorney be submitted to it, which applications will be affected by the waiver and what are the consequences of the waiver?

A: The waiver by the IB (IB) of the above-mentioned requirement to submit a separate power of attorney, which was announced in Section IV of *PCT Gazette* No. 48/2004 and is also announced on the cover page of this issue, will hopefully simplify procedures for applicants and agents.

The waiver by the IB will apply to any document or request submitted to the IB on or after 1 January 2005, provided that the international filing date of the underlying application is on or after 1 January 2004. The reason for this limitation is that amended PCT Rule 90.4 which enacts the waiver possibility only applies to international applications filed on or after 1 January 2004. The waiver will apply only in respect of an agent or common representative who has been indicated in Box No. IV of the Request Form.

The agent is now permitted to file various papers with the IB throughout the international phase without the need to submit a power of attorney signed by the applicant(s). For example, the agent can now submit the following papers to the IB without the need to submit a power of attorney:

- PCT Article 19 amendments;
- corrections of priority claims;
- informal comments on the written opinion;
- requests for recording of changes in certain indications in the request or the demand (PCT Rule 92bis) for all changes except for a change of agent where the request for change is signed by the new agent (see below).

Note, however, that a power of attorney will still have to be furnished in the following situations:

- any notice of withdrawal under PCT Rule 90bis—the notice must be signed by all applicants or by the agent or common representative and be accompanied by powers of attorney signed by all applicants (if the Request Form was not signed by all applicants), even if the Office with which the notice is filed has waived the power of attorney requirement. This is the case whichever PCT Office or Authority the notice of withdrawal has been submitted to;
- upon appointment of, or for any paper submitted by, an agent or common representative who was not indicated in the Request Form—the IB has announced under Section 433 of the Administrative Instructions that it will require a separate power of attorney upon appointment of, or for any paper submitted by, an agent or a common representative who was not indicated in the Request Form at the time of filing. For example, if a request for the recording of a change of agent and/or applicant under PCT Rule 92bis is signed by the new agent and is submitted to the IB, a power of attorney signed by the applicant would continue to be required. Similarly, if a new agent is appointed by way of a corresponding indication in the Demand Form, the IB would continue to require a power of attorney before it could record the new agent under PCT Rule 92bis. Note, however, that in respect of any action requested via the IPEA, whether a power of attorney is required would depend also on whether the IPEA has

waived the requirement that a power of attorney be submitted;

- where the receiving Office has not made a waiver and the document or request is filed directly with that Office, for example, where a request for recording a change under PCT Rule 92*bis* or a request for correction of a priority claim is filed directly with the receiving Office.

Even though the requirement to submit a separate power of attorney may have been waived by the IB, agents or common representatives should carefully consider whether they should in any case obtain the signatures of all applicants, either by way of signing a power of attorney or by way of signing the request. By obtaining those signatures, any withdrawal, which requires the signatures of all of the applicants or a power of attorney signed by all of the applicants, could be dealt with immediately, and delays caused by the need to obtain missing signatures would be avoided. Even if those signatures are not actually submitted by the agent/common representative to the IB, but are merely kept in the file of the agent/common representative, at least they would be available if they were needed later. For further information on the applicability of power of attorney waivers, see the "Practical Advice" in *PCT Newsletter* No. 06/2004, on page 5.

2005-03

Time limit for submitting a formal response to a written opinion of the ISA where a demand for international preliminary examination is being filed

*Q: I intend to file a demand for international preliminary examination, as well as a response to the written opinion of the ISA (in the form of arguments), including amendments under Art. 34. I will file the demand within the new time limit under PCT R. 54*bis* for filing a demand.* However, that time limit will expire very shortly and the response to the written opinion is not ready yet. Does the response to the written opinion have to be filed at the same time as the demand, or can it be filed later, and if so, what is the time limit for doing so? Can the time limit for filing the response be extended? What happens if the response is submitted late?*

A: At the earliest, a formal response to the written opinion of the ISA and/or amendments under PCT Art. 34 may be submitted by the applicant to the IPEA together with the demand. At the latest, such responses may be submitted until the time when the examiner at the IPEA starts to draw up the IPR on patentability (Chapter II of the PCT) (IPRP (Chapter II)) (R. 66.4*bis*). The time when the IPEA starts to draw up the IPRP (Chapter II) depends on the inner workings of the IPEA and is therefore difficult to monitor for applicants; at the earliest, it should not normally be before the time limit under PCT R. 54*bis*.1(a) for filing the demand (that is, within 3 months from the date of transmittal of the ISR and of the written opinion of the ISA, or within 22 months from the priority date, whichever expires later) (see PCT R. 69.1). It is more likely to occur very shortly after the expiration of that time limit where the

first written opinion (established by the ISA) is used by the IPEA as its own first opinion (PCT R. 66.1*bis*(a)). One rather exceptional situation which may result in the IPRP (Chapter II) being drawn up before the expiration of that time limit would be if both the demand is filed early, before the international search has started, and if the ISA also acts as IPEA, in which case the international preliminary examination may start at the same time as the international search (see PCT R. 69.1(b)).

Note that if the IPEA is not the same as the ISA, and the IPEA has notified the IB under PCT R. 66.1*bis*(b) that the written opinion of the ISA will not be considered by the IPEA as its own written opinion (the EPO is the only Office which has made such a notification—see *PCT Newsletter* No. 01/2004, page 4), you will receive an additional written opinion established by the IPEA (Form PCT/IPEA/408), and will therefore be given an additional opportunity to respond to the written opinion within a time limit fixed by the IPEA. That time limit may be extended upon request (see PCT Rule 66.2(e)). If the IPEA does consider the written opinion of the ISA to be its own written opinion (PCT R. 66.1*bis*(a)), and you intend to file a response to that written opinion with the intention that it be considered by the IPEA, but are not in a position to submit it with the demand, and especially if you are in danger of missing the time limit under PCT R. 54*bis*.1(a), you could try and delay the establishment of the IPRP (Chapter II) until your response has been received by the IPEA by:

- 1) asking the IPEA to wait until a formal response has been received before it starts to draw up the IPRP (Chapter II), either by a letter filed with the demand, or by phone with the examiner in charge of your case (but bear in mind that, if the time limit under PCT R. 54*bis*.1(a) has expired, it will be at the discretion of the IPEA whether it will wait for your formal response); or
- 2) checking Box No. IV, item (1), on the Demand Form to indicate that you wish the international preliminary examination to start on the basis of the description, claims or drawings as amended under PCT Art. 34. If you do not submit such amendments with the demand, the IPEA will invite you to submit the amendments within a time limit fixed in the invitation (see PCT R. 60.1(g)) and should not start the IPE before it has received the amendments or before the time limit fixed in the invitation has expired, whichever occurs first (see PCT R. 69.1(e)). Note that, apart from the situation where the IPEA issues its own written opinion (see third paragraph of this answer), this is the only situation in which the IPEA will invite the applicant to submit the amendments—it will not issue any reminders otherwise.

In order to be certain that your amendments and arguments will be taken into account by the IPEA, it is therefore in your best interest, wherever possible, to respond as soon as possible to the written opinion of the ISA, preferably, at the time of filing the demand, or at least not later than at the expiration of the time limit under PCT Rule 54*bis*.1(a). When this is not possible, however, your best option is to follow one of the two alternatives mentioned above.

Note that this item relates specifically to **formal responses** under Chapter II to the written opinion of the ISA, and that **informal comments** under Chapter I on the written opinion of the ISA are dealt with separately in the "Practical Advice" in *PCT Newsletter* No.

10/2004. For further information on responses under Chapter II to the written opinion of the ISA, see *PCT Applicant's Guide*, paragraphs 393 to 394. For general information on the new search and examination system, see the "Practical Advice" in *PCT Newsletter* No. 12/2003.

* The demand must still be filed within 19 months from the priority date where the applicant wishes to enter the national phase (rather than the regional phase) in those States which have not withdrawn their notifications of incompatibility of PCT Art. 22(1).

2005-05

The filing of declarations of inventorship where there are several inventors

Q: I wish to file a declaration of inventorship in respect of the four inventors named in an international application. However, since there is only space provided for two persons on the pre-printed declaration sheet, how should I add extra inventors? Also, given that the inventors do not reside in the same area, is it possible for the inventors to each sign separate copies of the declaration?

A: In addition to containing the text of the declaration itself, the declaration of inventorship under PCT R. 4.17(iv) (that is, Box No. VIII(iv) of the Request Form) gives space for the inclusion of information relating to two inventors. If more than two inventors are to be included in the declaration, the continuation sheet for declarations ("Continuation of Box No. VIII(l) to (v)") should be given the title "Continuation of Box No. VIII(iv)", and should be used to furnish the information in respect of the other inventors (that is, the name, residence, address and citizenship of the inventor) in the same manner as in the declaration sheet itself. In such a case, the "complete declaration" comprises Box No. VIII(iv) and the continuation sheet. The continuation box does not need to contain the actual text of the declaration. Note that if a continuation box is also required for other types of declarations, a separate continuation box should be used for each different declaration. All inventors must sign and date the declaration* (see Section 214(b) of the Administrative Instructions under the PCT), and any inventors identified on the continuation sheet should sign and date that sheet. The signatures do not have to appear on the same piece of paper – they may appear on different copies of the same declaration, provided that each copy contains the complete declaration, that is, contains the details regarding **all** the inventors. In other words, you may send photocopies of the filled-in declaration **and** continuation sheet to each of the four inventors for signing and dating, and when they have been returned to you, submit all four copies to the IB. By doing this, all inventors will have provided their signature for the purposes of the declaration even if the four signatures do not physically appear on the same piece of paper, and they will have all signed a declaration which correctly lists the names of all coinventors. Note that if

you submit the declaration separately from the Request Form, you should remember to indicate the PCT application number within the text of Box No. VIII(iv).

* **Important:** Applicants are advised to include the signature(s) of the inventor(s) on the declaration itself. It is recalled that, under current practice, the signature of an inventor is not required on the declaration if that inventor has signed the Request Form, and if the declaration is submitted together with the Request Form. Note however that, following a suggestion made by the United States Patent and Trademark Office, a proposal is under discussion to no longer provide for the possibility for inventors to sign Box No. X of the Request Form instead of the declaration itself.

For further information on the filing of declarations under PCT R. 4.17, see the *PCT Applicant's Guide*, Vol. I/A, paragraphs 102A to J and 250A to G, the Notes to Boxes Nos. VIII(i) to (v) of the Request Form.

2005-06

The setting of fees payable during the international phase, and the establishment of the equivalent amounts of certain of those fees in various currencies

Q: I am a patent administrator and I deal, in particular, with the payment of patent-related fees. I would like to know more about who establishes the various PCT fees payable during the international phase. Also, the "PCT Information Update" section of the PCT Newsletter often notifies changes in "equivalent amounts" of certain fees – please could you explain to me under what conditions such equivalent amounts change?

A: not quoted here, of minor interest concerning the EQE.

2005-07

Requesting the recording of changes during the international and national phases

Q: I am an agent acting on behalf of an applicant who has filed several international applications which are at various stages of the international or national phase. I wish to request the recording of a change of address for the applicant. Where should I send my request to? Can I group my request in one single letter sent in respect of all international applications concerned?

A: First of all, you mention that some of your applications have entered the national phase. One important thing that you should be aware of is that the time limit for requesting the recording of changes* is, according to PCT R. 92bis.1(b), 30 months from the priority date. Any such requests received after the expiration of that time limit in respect of a particular international application will not be recorded in respect of that application. Therefore, for those international applications that have already entered the national phase, that time limit has probably already expired. Changes to applications which fall into that category will not be recorded by the IB and you (or the competent agent in the national phase) will have to inform, separately, each designated or elected Office of the change direct. For those international applications for which the time limit of 30 months from the priority date has not yet expired, you should, preferably, send your request for recording the change direct to the IB. Although letters requesting

the recording of changes can be sent via the receiving Office, it is preferable to send the letter direct to the IB, as the receiving Office will in any case forward the request for recording a change to the IB, but it is the date of receipt **at the IB** of that request that will determine whether or not the change will be recorded under PCT R. 92bis. It is better if the request for recording the change arrives at the IB as early as possible, particularly if the above-mentioned time limit of 30 months from the priority date is close to expiration in respect of any of the applications. Also, if any of the applications concerned are due to be published shortly and you wish the change to be reflected in the international publication, the letter should reach the IB before the technical preparations of the international publication have been completed, which usually takes place 15 days before the date of the international publication. In the latter two cases, it is particularly advisable to send the request for recording the change by fax to the general PCT fax number: +41-22 338 82 70. The IB (including the IB as RO) will accept a single letter requesting a change concerning multiple applications provided that the letter contains a list of each international application number affected by the change. Note, however, that not all receiving Offices may be prepared to accept a request for recording a change in such a form, and may require multiple letters (another reason for sending your request direct to the IB). Rest assured that, whoever the letter is sent to, the IB will, provided that the request for recording the change is received within the applicable time limit, notify all PCT Offices and Authorities interested in the change accordingly, including, in the case where a demand for international preliminary examination has been filed and the international preliminary examination report has not yet been established, the International Preliminary Examining Authority. Do not be worried if you do not receive confirmation of the recording of the change in respect of all international applications concerned at the same time – at the IB different international applications are dealt with by different formality examiners, and so you may receive more than one confirmation if several applications are concerned. Note that even though this subject has been dealt with already in earlier issues – see the “Practical Advice” in PCT Newsletter Nos. 08/ 2000**, 05/2002 and 08/2002 – we felt that it is useful to remind applicants about some of the procedure as some applicants have experienced problems because their letters have not been received by the IB until after the time limit under PCT R. 92bis – they should be aware that it is more efficient to submit their requests for recording of a change direct to the IB.

* Changes which may be recorded under PCT R. 92bis are: changes in the person, name or address of the applicant, agent, common representative or inventor, or in the residence or nationality of the applicant.

** Note that the time limit under PCT R. 92bis.1(b) has changed since the publication of this practical advice, but other information remains relevant.

2005-09

Reinstatement of rights after failure to pay fees for entry into the national phase

Q: I am the agent for an international application in respect of which I intend to enter the national phase before several designated Offices. Unfortunately, although the necessary translations were submitted on time, due to an oversight, the national fees were not paid until six weeks after the expiration of the time limit for entry into the national phase under PCT Art. 22(1). It is my understanding that the international application will therefore have ceased to have effect in the designated States concerned. Is there any action that I can take to reinstate the application?

A: According to Art. 24(1)(iii), if the applicant fails to perform the acts referred to in Art. 22 within the applicable time limit, the international application will cease to have effect in any designated State with the same consequences as the withdrawal of any national application in that State.

If the national law of a designated State provides for excuse of delays in respect of national applications, it will be possible, under Art. 48(2), for the Office to excuse, for reasons admitted under its national law, any delay in meeting any time limit also in respect of international applications. In other words, if a procedure for reinstatement of rights is in place in any of the designated States in which you wish to enter the national phase, it must be applied to international applications which have ceased to have effect in those designated States because the time limit to enter the national phase was missed. The relevant National Chapters of the *PCT Applicant's Guide*, Volume II, give information on whether the national law of a Contracting States provides for such procedures for the excuse of delays. You may also be able to reinstate your application in certain designated Offices by using R. 49(6), which entered into force on 1 January 2003. Under this rule, the majority of the designated Offices* are required to provide the possibility to reinstate the rights of the applicant with respect to an international application where the applicant failed to comply with the requirements under Art. 22 or 39(1). The Offices concerned will, upon request of the applicant, reinstate the rights of the applicant in respect of that international application if they find that:

- • the delay in meeting the time limit was unintentional,
- or, at the option of the designated Office:
- • the delay occurred in spite of due care required by the circumstances having been taken.

According to R. 49(6)(b) and (c), the request to reinstate your rights, which should state the reasons for failure to comply with the applicable time limit under Art. 22**, should be submitted to each designated Office concerned, and the acts referred to in Art. 22 should be performed (in your case, this is the payment of the necessary fee(s), which you have already done) within whichever of the following periods expires first:

- two months from the date of removal of the cause of the failure to meet the applicable time limit under Art. 22; or

- 12 months from the date of the expiration of the applicable time limit under Art. 22;

unless the national law applicable by the designated Office permits the applicant to submit it later.

Certain designated Offices require the payment of a fee in respect of this request, and some may require a declaration or other supporting evidence. Details of the requirements of each Office, including the criteria for reinstating the international application will be published in the relevant National Chapters of the *PCT Applicant's Guide*, Volume II, as soon as those details have been received at the IB. Otherwise, you are advised to check directly with the Offices concerned.

Note that R. 49(6) applies to both designated Offices (where the national phase is entered under Chapter I) and, by virtue of R. 76(5), to elected Offices (where the national phase is entered under Chapter II of the PCT).

It is important to note that some designated Offices have notified the IB under Rule 49(6)(f) that R. 49(6) is incompatible with their national law and thus that **they are not obliged to reinstate rights under PCT Rule 49(6)(a) to (e)**. Any reinstatement request sent to such an Office will be dealt with in accordance with the applicable national law, which may be more or less favorable than the provisions of R. 49(6). The Offices which have notified the IB of such incompatibility are as follows:

Canadian Intellectual Property Office
 China Intellectual Property Office
 Croatian Intellectual Property Office
 European Patent Office
 German Patent and Trade Mark Office
 Intellectual Property Office of New Zealand
 Intellectual Property Office (Philippines)
 Japan Patent Office
 Korean Intellectual Property Office
 Latvian Patent Office
 Mexican Institute of Industrial Property
 Patent Office (India)
 Polish Patent Office
 United Kingdom Patent Office

If any of the above Offices withdraws its notification of incompatibility, that withdrawal will be notified in the *PCT Newsletter*, and the above list of Offices will be updated at:

www.wipo.int/pct/en/texts/reservations/res_incomp.pdf

Designated Offices are, of course, free to implement provisions which are even more favorable than those provided by R. 49(6), this Rule being in the nature of a **minimum** obligation, and, notably, most of the designated Offices listed above have national procedures in place for excusing delays, and have filed reservations because their laws are more permissive than R. 49(6) (as indicated above, see the relevant National Chapters in *PCT Applicant's Guide*, Volume II, for further details). For further information on the excusing of delays in meeting time limits in general, see the *PCT Applicant's Guide*, Vol. II, paragraphs 67 to 70. For cases where the time limit is not met due to irregularities in the mail service (delay or loss in mail, or interruption in the mail service), see Art. 48(1) and R. 82, and the "Practical advice" in *PCT Newsletter* No. 06/1999.

* See the exceptions listed below.

** Note that some Offices that apply the "unintentional" standard simply require a statement explaining that the failure to meet the time limit was unintentional

2005-11

Determining the wording of the PCT Regulations on a particular date in the past

Q: I am the agent for an international application which is the subject of litigation. I need to be familiar with the PCT Regulations that were in force at the time of filing the application, that is, in February 2002. However, the PCT Regulations that are on the PCT website are those which entered into force on 1 April 2005. Since we now work principally with electronic publications, we do not have the paper version of the PCT and Regulations from that period. How can I find the wording of the PCT Regulations that was in force at that time?

A: Since the application was filed in February 2002, various amendments to the PCT Regulations have been made which entered into force on:

- 1 April 2002
- 1 January 2003
- 1 January 2004
- 1 April 2005

(Note that these dates do not take into account amendments which have been made to the PCT Schedule of Fees which is annexed to the PCT Regulations.)

The easiest way to find out if particular PCT Regulations have changed since February 2002, and the manner in which they have changed, is to consult the *History of the PCT Regulations*, available in PDF format from the PCT website at:

www.wipo.int/pct/en/texts/pdf/pct_regulations_history.pdf

The *History of the PCT Regulations* shows the chronological order (the dates in the margin indicate the period during which the respective provisions were in force), the Regulations as current Regulations, as in force since 1 April 2005, and any intervening provisions that have been superseded. For example, page 10 reproduces the text of PCT Rule 4.9 (concerning the designation of States, kinds of protection and national and regional patents) as in force from 19 June 1970 until 30 June 1992, from 1 July 1992 to 31 December 2003, and since 1 January 2004. The publication is fully bookmarked enabling direct navigation to a specific Rule. Alternatively, if you want to search a particular topic, for example "priority claim", you could perform a word search in PDF using the "find" button in the tool bar. The History of the PCT Regulations was originally published in *The First Twenty-Five Years of the Patent Cooperation Treaty (PCT) 1970 - 1995*. It was then updated and made available on the PCT website in June 2004, and was recently updated to include all amendments up to April 2005, that is, those which are currently in force. It will continue to be updated to incorporate further amendments to the PCT Regulations; it is recalled that the first set are due to enter into force on 1 April 2006.

2006-02

Maintaining the US designation where a US national application has already been filed

Q: Last year I filed a national application in the United States of America. I now wish to file an international application for that same invention, however, since I will be continuing with the US national application, I do not think that I will be proceeding into the US national phase in respect of the international application. Should I maintain the designation of US or withdraw it?

A: It is recalled that with the automatic designation, under PCT R. 4.9(a), of all PCT Contracting States for all kinds of protection possible, it is no longer possible to exclude any designations from the Request Form (with the exceptions of Germany, the Republic of Korea and the Russian Federation, and as from 1 April 2006, Japan – if the international application claims the priority of an earlier national application having effect in any of those States (see PCT Newsletter No. 01/2006, cover page)). Therefore, if you do not wish to proceed with your international application in any particular State, you have the option of maintaining the designation of that State and simply not taking any action to enter the national phase within the time limit under PCT Art. 22 or 39(1), or of withdrawing the designation in the international phase.

The safest option is probably to maintain the US designation, as in this way, you will be keeping your options open in case you change your mind and decide to enter the national phase in the US after all. Also, if any earlier filed US application has already been granted, maintaining the US designation will give you the benefit of a co-pending US case until the expiration of 30 months, leaving you with more options. Withdrawals of designations should only be made when you are absolutely sure that you do not wish to enter the national phase in that State as, once you have withdrawn a designation, the effect of the international application in that State will cease (see PCT Art. 24(1)(i)) and you would not normally be able to enter the national phase in that State (certain exceptions may exist under the national law of the State concerned).

Maintaining the designation is also the easiest option as you will not have the extra paperwork of sending a notice of withdrawal and furnishing the signatures of the applicants. It is important to be aware that if you do later decide to enter the national phase in the US with the international application, the inventors must have been indicated as applicants upon filing the international application. If you do include the inventors as applicants, note that under PCT R. 26.2bis(a), the signature of one applicant is sufficient – it is only in the case of any kind of withdrawal under PCT Rule 90bis that the signature of all applicants would be required (see PCT R. 90bis.5).

Apart from the cases of Germany, Japan (as from 1 April 2006), the Republic of Korea and the Russian Federation, the safest and easiest option is therefore to maintain a designation rather than withdraw it, and in the case of the US designation, to include the inventor(s) as applicants in case you should decide to enter the US national phase.

Further information about the issues arising from the designation system is included in the following “practical advice” articles:

- The non-designation of certain States in the new Request form, applicable as from 1 January 2004 – PCT Newsletter No. 11/2003;
- Signature requirements for the withdrawal of the US designation – PCT Newsletter No. 01/2004;
- The procedure for withdrawing designations – PCT Newsletter No. 02/2004;
- Automatic designation of the US: the consequences of the applicant/inventor being a resident and national of a non-PCT Contracting State – PCT Newsletter No. 03/2004;
- Automatic designation of the US: indication of the inventors as “inventors only” where there is no intention to enter the US national phase – PCT Newsletter No. 04/2004;
- Automatic designation of all PCT Contracting States: alternative to withdrawing a designation – PCT Newsletter No. 05/2004.

2006-03

Obtaining copies of documents from the IB, in particular priority documents

Q: How do I obtain copies of priority documents in connection with international applications filed by other applicants?

A: Under R. 17.2(c), the IB will furnish to third parties copies of priority documents after international publication of the international application concerned, unless the international application was withdrawn before publication, the priority claim concerned was withdrawn or considered, under R. 26bis.2(b), not to have been made before publication, or unless the priority document has not yet been received by the IB. Priority documents, as well as other documents related to the international application, can be obtained either from the WIPO web site via the PCT Online File Inspection System or by sending a written request to WIPO, as explained below.

(1) PCT Online File Inspection System

With the introduction of the PCT Online File Inspection System on WIPO's PatentScope web site, it is now possible to access and print out, free of charge, priority documents from the Internet in respect of priorities claimed in international applications whose international filing dates are from January 2001 onwards. To access the priority document, you should go to:

www.wipo.int/pctdb/

and then carry out a search for the international application concerned. Three search systems are available for this purpose:

- simple
- advanced
- structured

The simple search and the advanced search will allow you to type in key words which will help you find the application; the advanced search, however, may save time as it will permit you to sort the results either by relevance or chronologically. The structured search is

much more useful if you know some of the details of the international application. For example, you can perform a search by the following criteria: international application number, priority number, title of the invention, applicant's name, inventor's name, publication date and/or international classification. When you find the relevant international application, click on "documents". You will see a list of documents that are available for the international application concerned. To view each document, click on the format of the file that you wish to view the document in. Note that by selecting PDF as your format, you will be able to view and print the whole document out in a single consolidated file. Other types of documents are also available from the PCT Online File Inspection System. The complete list of types of documents and dates from which those documents have been made available on the system is published in a table entitled "Content of the PCT Online File Inspection" at:

www.wipo.int/pctdb/en/content.html

The content-related information may be subject to periodical change as more documents are added to the system. Note that limitations as to the availability of certain documents exist due to changes which have been made to the PCT Regulations in respect of access to the file (see below).

(2) Written requests to WIPO

Requests for access to documents in the file held by the IB which are not available from the PCT Online File Inspection System, and which would be permitted to be furnished according

to R. 94.1, should be made in writing, addressed to the PCT Legal Division and sent to the following fax number:

(41-22) 910 00 30

If only copies of priority documents are required, requests for these should be addressed to the PCT Operations Division, and sent to the following fax number:

(41-22) 338 82 70

Depending on what documents are requested, the IB will make copies of the documents in the file of the international application. An invoice for payment for this service will be sent under separate cover, once the documents have been mailed. For the fees payable to the IB for this service, see the *PCT Applicant's Guide*, Annex B2 (IB). For documents in the file of the IB in general, it is important to be aware that there are certain limitations with regard to the type of document that can be accessed, both via the PCT Online File Inspection System and by writing to the IB, depending on when the international application was filed, as the PCT Regulations have been amended on several occasions to facilitate access to the file of the international application. For further information on access to the file, see R. 17 and 94, the *History of the PCT Regulations* (if you want to see earlier texts of these Rules, which may apply to earlier-filed international applications), and the *PCT Applicant's Guide*, "Introduction to the International Phase", paragraphs 474-476.

2006-04

Withdrawal of designations of States which have special provisions concerning earlier national applications from which priority is claimed

Q: I have filed an international application claiming the priority of an earlier application filed in Germany. Unfortunately, I forgot to tick the relevant box in Box No. V of the Request Form in order that Germany would be excluded from the automatic and all-inclusive designations. Bearing in mind that my earlier application could be withdrawn if the designation of Germany exists in a later filed corresponding international application, is it possible to safeguard the earlier application by withdrawing the designation, and if so, by when must this be done?

A: The national law of DE, as well as those of JP, KR and RU, provides for automatic withdrawal, at a certain moment, of an earlier national application if a later filed international application claims the priority of that earlier national application and designates that State. This means that if the designation concerned is not withdrawn from the international application considered withdrawn at a time defined in the national law. In connection with this, the abovementioned four States have notified WIPO that PCT Rule 4.9(b), as amended with effect from 1 April 2006, applies in respect of the designation of each of those States.

The fact that the designation of any of those States is not excluded from the international application on filing is not generally a problem, except in one particular case concerning KR, as explained below. The reason for including the special boxes in Box V of the Request Form is to simplify matters for applicants, who can still, in most cases, withdraw the designations after filing with the same effect as excluding the designations on filing. It is, however, recommended that such withdrawal be effected as soon as possible to avoid the withdrawal of the earlier application. The special provisions concerning earlier national applications from which priority is claimed, including the time limit within which the earlier applications are considered withdrawn, are different for each State, as discussed below. In the case of the designation of Germany, as well as the designation of RU, the applicant has more time in which to withdraw the designation in order to safeguard the earlier filed national application, as the designation can be withdrawn at any time prior to the entry into the national phase. Note, however, that, in the case of DE, the earlier national application will only be deemed withdrawn if:

- both the applications relate to the same kind of protection;
- the international application has been filed in de with the DPMA as receiving Office; and
- DE has been designated in the international application.

It is however, recommended to withdraw the designation of DE and RU as early as possible before national phase entry, in particular in the case of DE where national phase entry is automatic where the abovementioned conditions are met.

In the case of JP, the earlier filed national application will be lost if, by the expiration of 15 months from the filing date of the earlier application, the designation of Japan is still valid. Thus, the designation of JP must be withdrawn before the expiration of 15 months from the filing date of the earlier application.

As far as KR is concerned, if the earlier application, the priority of which is claimed in the international application, is an application for a patent, that earlier application will be lost if the designation is not withdrawn before the expiration of 15 months from the priority date. It is very important to note, however, that if the earlier application is an application for a utility model, that earlier application will be considered withdrawn if the international application contains the designation of KR on filing. The designation must, therefore, be excluded upon filing the international application in order to safeguard the earlier filed utility model application. Further information about the designation system in general is included in the following "practical advice" articles:

- The non-designation of certain States in the new Request form, applicable as from 1 January 2004 – PCT Newsletter No. 11/2003;
- Signature requirements for the withdrawal of the US designation – PCT Newsletter No. 01/2004;
- The procedure for withdrawing designations – PCT Newsletter No. 02/2004;
- Automatic designation of the US: the consequences of the applicant/inventor being a resident and national of a non-PCT Contracting State – PCT Newsletter No. 03/2004;
- Automatic designation of the US: indication of the inventors as "inventors only" where there is no intention to enter the US national phase – PCT Newsletter No. 04/2004;
- Automatic designation of all PCT Contracting States: alternative to withdrawing a designation – PCT Newsletter No. 05/2004.
- Maintaining the US designation where a US national application has already been filed – PCT Newsletter No. 02/2006.

2006-05

Availability of informal comments to third parties

Q: Are the informal comments on the written opinion of the International Searching Authority, which may be submitted by applicants to the IB, published as part of the international application? Are they available to third parties?

A: It is recalled that it is possible, if the applicant wishes to do so, to submit written comments on the written opinion of the ISA to the IB on an informal basis, addressing the issues raised in the written opinion in the event that a demand for international preliminary examination is not filed. Note that informal comments are not to be confused with amendments under Art. 19, under which applicants are entitled, after having received the ISR, to one opportunity to amend the claims of the international application by filing amendments with the IB within the prescribed time

limit under PCT R. 46.1. Any informal comments made on a written opinion of the ISA (hereinafter: "informal comments"), as well as the written opinion itself, **will not be published**, but will remain in the file of the international application held at the IB throughout the international phase. Note that the informal comments will at no point be transmitted to the ISA, nor to the IPE, should the applicant decide to file a demand, but might later be transmitted to the designated Offices (see below).

Nevertheless, at the expiration of 30 months from the priority date, and irrespective of whether or not a demand has been filed, the informal comments, as well as the written opinion of the ISA, will be open to public inspection. It is recalled that, in general, under PCT R. 94.1(b), for international applications filed on or after 1 July 1998, the IB will furnish to any person copies of any document contained in its files, provided the international application has been published, and subject to the restrictions under PCT Art. 38 and R. 44ter.1. This means that third parties can obtain documents indicated in PCT R. 44ter.1, which includes the written opinion of the ISA, **only after 30 months from the priority date**. Informal comments would also be subjected to this restriction, as per the decision of the PCT Assembly at its thirty-first session in October 2002. Note that copies of the informal comments are currently only available to third parties if they specifically request access to the file under PCT R. 94.1 from the PCT Legal Division at WIPO, as they are not yet available through "Search International Patent Applications" (see list of documents available via PatentScope at:

www.wipo.int/pctdb/en/content.html). If no demand has been filed and/or no international preliminary examination report is established, the informal comments will be forwarded by the IB to the designated Offices together with the international preliminary report on patentability (IPRP Chapter I)* after the expiration of 30 months from the priority date (see PCT R. 44bis.2 and document PCT/A/31/10, paragraph 47). Depending on the applicable national law, the designated Offices may then also make the informal comments available to the public. If an applicant submits informal comments, then later submits a demand, the informal comments will not be forwarded to designated Offices, but they will nonetheless be available to the public from the IB under PCT R. 94.1(b) after the expiration of 30 months from the priority date. For further information on submitting informal comments, including the time limit for submitting them, see the "practical advice" in PCT Newsletter No. 10/2004.

* This document has the same content as the written opinion of the ISA, but is issued by the IB on behalf of the ISA.

2006-06

Consequence of the agent not being entitled to practice before the Office of the country of residence and/or nationality of the applicant.

Q: I am a newly qualified patent agent based in Spain and am entitled to practice before the Spanish Patent and Trademark Office. I have a client who is a national of Canada who until recently lived in Spain but has

now moved back to Canada. He would like me to file a PCT application on his behalf as sole applicant. I know that I am not entitled to practice before the Canadian Intellectual Property Office, so would it be possible for me to act as agent if I file a PCT application on my client's behalf with the International Bureau as receiving Office? If so, would I be able to choose the Spanish Patent and Trademark Office as International Searching Authority and International Preliminary Examining Authority?

A: If an international application is filed with the IB (RO/IB), the RO/IB does not require that the applicant be represented by an agent. However, if an agent is appointed, that agent must be a person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant (or, if there are two or more applicants, any of the applicants) is a resident or national (see PCT Rule 83.1bis(a) and the *PCT Applicant's Guide* Annex C(CA) and (IB)). In the case of your client, since he is a resident and national of Canada, the agent must be a person who has the right to practice before the Canadian Intellectual Property Office. Since you do not have the right to practice before the Canadian Intellectual Property Office as receiving Office, you do not have the right to represent the applicant before RO/IB.

It is possible, however, under PCT Rule 4.4(d), to include your name and address in Box IV of the request as an "address for correspondence", ensuring that you also check the necessary "address for correspondence" box. If you do this, although you would not be entitled to act on behalf of the applicant in respect of the application, you would receive all correspondence which would normally be addressed to the applicant or his agent, and you would be able to make payments on behalf of the applicant. You would not have the right to sign any papers, including letters, on behalf of the applicant – these would have to be signed by the applicant himself. This should be borne in mind particularly in the case where urgent documents are to be transmitted, for example, a notice of withdrawal which is sent near to the time of completion of technical preparations for publication. If a person indicates in the request that he/she is an agent, and he/she does not have the right to practice for the applicant concerned, the RO/IB will, in any case, change that indication *ex officio* to an address for correspondence (see paragraph 117 of the PCT Receiving Office Guidelines).

This would not prevent the international application from obtaining an international filing date, but the request would then need to be signed by the applicant (or where there is more than one applicant, at least one of the applicants) (if not done so already), which can be done after filing. As far as the competent ISA and IPEA for the international application is concerned, this is the Authority which would have been competent if the international application had been filed with the national Office of, or acting for, the Contracting State of which the applicant is a resident or national, which in the case of your client, is the Canadian Intellectual Property Office (see *PCT Applicant's Guide*, Annex C (CA)). The applicant would not, therefore, be able to

choose the Spanish Patent and Trademark Office as ISA and/or IPEA, and you would not be able to represent the applicant under PCT Rule 90.1(b) specifically for the international search and preliminary examination procedure. We would like to draw your attention to the fact that if an applicant who is a national or resident of Spain were to be included in the request at the time of filing as co-applicant for any designated State except the United States of America, you could be appointed as agent, and would be able to sign all papers on behalf of the applicant (including withdrawals, provided both applicants sign the request or a power of attorney appointing you). It would also be possible to file the application with RO/IB or with the Spanish Patent and Trademark Office as receiving Office, and to choose the Spanish Patent and Trademark Office as ISA and/or IPEA. The co-applicant would not necessarily have to remain co-applicant in the international application once the international application has been filed.

2006-08

Requesting early entry into the national/regional phase

Q: Is it possible to enter the national (or regional) phase early before a particular designated or elected Office, for example, prior to the international publication of the international application, and for that Office to process and examine the application early?

A: According to PCT Article 23(1), designated Offices may not normally process or examine the international application prior to the expiration of the applicable time limit for entry into the national phase under PCT Article 22. *, **

However, according to PCT Articles 23(2) and 40(2), designated/elected Offices may start the processing and examination of the international application earlier if the applicant makes an express request to the Office(s) concerned. In order for that request to be effective, the applicant must have performed, or must perform at the same time, the acts necessary for entry into the national phase. It is recalled that those acts which must be performed, if applicable, by the applicant before the start of the national phase are as follows:

- Payment of the national fee;
- Furnishing of a translation, if prescribed;
- Exceptionally, furnishing a copy of the international application, if the international application has not yet been made available to the designated Offices under PCT Article 20, and if required by the Office concerned (the applicant may, in accordance with PCT Article 13(2)(b), request the International Bureau to furnish a copy of the international application to the designated Office(s), although this is subject to a fee under PCT Rule 31.1(b) to cover the costs of preparing and mailing the copy – see the *PCT Applicant's Guide*, Annex B (IB) at: www.wipo.int/pct/guide/en/; note that, depending on the designated Office concerned, that Office may also ask the IB to forward a copy of the international application directly to it);
- And, as is applicable only in very few cases: the furnishing of the indication of the name and address of

the inventor if they were not given in the request when the international application was filed, but the designated Office allows them to be given at a time later than that of the filing of the national application. If the applicant has filed amendments to the claims under PCT Article 19, and they have not yet been made available to the designated Office, the applicant should also furnish, at the same time as the request for early processing of the international application, a copy of those amendments if he wishes to have them taken into account, together with any necessary translation. Note that if an express request to enter the national phase is made before a particular Office, it is up to the national Office in question to act in accordance with the applicable national law. Also, if such a request is made only in respect of certain designated/elected Offices, the international phase of that international application will continue in respect of all the other designated/elected States.

* Similarly, according to PCT Article 40(1), in cases where a demand has been filed prior to the expiration of the 19th month from the priority date, the elected Office will not proceed to the examination and other processing of the international application prior to the expiration of the applicable time limit under PCT Article 39.

** For the applicable time limits for entry into the national phase in respect of each designated/elected Office, see the table of time limits for entry into the national phase at:
www.wipo.int/pct/en/texts/pdf/time_limits.pdf

2006-11

Information which is no longer required when submitting a declaration under PCT Rule 4.17

Q: After a brief professional break, I am about to file an international application which will include a declaration under PCT Rule 4.17(ii) ("Declaration as to the applicant's entitlement to apply for and be granted a patent"). I seem to recall that last time I submitted a declaration under PCT Rule 4.17 I had to indicate the designated States to which the declaration applied. However, I have noticed that the standard text of the declaration, as reproduced in the notes to the Request Form, no longer provides for the indication of this information. Please could you clarify whether I need to indicate the designated States to which the declaration, or any other declaration under PCT Rule 4.17, applies.

A: Since 1 April 2006, the date as of which all international applications are published in electronic form only, it is no longer necessary to indicate the designated States to which a declaration made under PCT Rule 4.17 applies, and the front page of the published international application no longer contains an indication of the designations in respect of which each declaration was made (see *PCT Newsletter* No. 03/2006, page 3).

Information on the designated States to which declarations applied used to be required in respect of all declarations except the "declaration of inventorship" under PCT Rule 4.17(iv), which already indicates in

the title of the pre-printed box that it is for the purposes of the designation of the United States of America only. Such information was required because copies of all declarations under PCT Rule 4.17 (except the "declaration as to non-prejudicial disclosures or exceptions to lack of novelty" under PCT Rule 4.17(v) which was sent to the designated Offices together with the paper copy of the published international application) were sent separately by the International Bureau to the designated Offices concerned. It was therefore necessary for applicants to specify in the Request Form the designated Offices to which the declaration(s) applied.

In October 2005, the PCT Assembly adopted amendments to the PCT Regulations, with effect from 1 April 2006, to provide for the publication of all types of declarations under PCT Rule 4.17 electronically, together with the international application. This means that any declaration made by the applicant is automatically made available to all designated Offices via the Internet. It is therefore no longer necessary for the applicant to indicate the designated Office(s) to which the declaration applies, and it is no longer necessary for the International Bureau to send each declaration to the designated Office(s) concerned. This change saves the applicant time when preparing the declaration, as well as removing a potential source of error.

For general information on submitting declarations under PCT Rule 4.17, see the *PCT Applicant's Guide*, Volume I, paragraph 102A to 102J at:
www.wipo.int/pct/guide/en/
and the notes to the Request Form.

2007-01

Dangers of relying on failure to pay PCT fees when the applicant wants the international application to be withdrawn

Q: If I decide not to proceed with an international application shortly after filing it, is it an option for me to simply not pay the fees to the receiving Office? If I do this, the receiving Office will consider the application withdrawn, dispensing with the need for me to take any action by sending a notice of withdrawal of the application.

A: By not paying the fees related to the filing of the international application within the time limit prescribed, your application should, in theory, be considered withdrawn by the receiving Office. According to PCT Rule 16bis, where the transmittal fee, the international filing fee and the search fee have not been paid within one month from the date of receipt of the international application (see PCT Rules 14.1(c), 15.4 and 16.1(f)), the receiving Office invites the applicant under PCT Rule 16bis.1(a) to pay to it the amount required to cover those fees, together with, where applicable, the late payment fee under PCT Rule 16bis.2, within a time limit of one month from the date of the invitation. Where the applicant does not, within the time limit set in the invitation, pay in full the amount due, the receiving Office declares the international application withdrawn (PCT Article

14(3)(a) and PCT Rules 16*bis*.1(c) and 29.1) and informs the applicant accordingly.

Note, however, that it is not advisable to proceed in this way if you wish to withdraw the international application, as there are risks associated with such a "passive" form of withdrawal. The following are examples of what can occur (and has occurred) when applicants have relied on failure to pay fees to effect the application's withdrawal:

- the receiving Office sent the invitation to pay the fees, but failed to follow up on that invitation by declaring that the application was considered withdrawn;
- the receiving Office failed to notify the International Bureau (IB) that the international application was considered withdrawn; or
- the receiving Office did notify the IB that the international application was considered withdrawn, but the notice failed to reach the IB in time to prevent international publication of the international application. It is much safer to actively send a notice of withdrawal if you want the international application to be withdrawn. It is recommended, although not compulsory, that applicants use Form PCT/IB/372 for this, which should be duly signed and preferably faxed to the fax number indicated on that form. Withdrawals received on this fax machine are monitored from Monday to Friday until 6.00 pm, Geneva time, and processed immediately. It is recalled that any notice of withdrawal should be signed by all applicants (PCT Rule 90*bis*.5) or by the duly appointed agent. If the notice has been signed by the agent and a power of attorney has not been submitted because the receiving Office has waived the requirement to submit powers of attorney, the necessary power(s) of attorney should be submitted together with the notice of withdrawal. For further information on withdrawing the international application, see *PCT Applicant's Guide*, paragraph 452, and PCT Rule 90*bis*. The withdrawal itself is free of charge, and by actively withdrawing the application, you still do not have to pay the fees payable on filing, and you are assured that your international application will be withdrawn. You should, nevertheless, check that your withdrawal is confirmed by the authority with which the withdrawal was made.

2007-04

Restoration of the right of priority where the international application is filed more than 12 months from the filing date of the earlier application whose priority is claimed.

Q: I am just about to file an international application in which the priority of an earlier national application is claimed. Unfortunately, however, I have missed the 12-month priority period as the earlier application was filed 12 months and two weeks ago. Is it possible to restore the right of priority, and if so, how do I do this?

A: Amendments to the PCT Regulations have been made, with effect from 1 April 2007, to enable the applicant to restore the right of priority of an earlier filed application if the international application is filed outside the priority period (that is, after the expiration

of 12 months from the filing date of the earlier application whose priority is claimed (PCT Rule 2.4)), provided that the international application is filed within two months from the date on which the priority period expired. For example, if your earlier application had been filed on 1 March 2006, the priority period would have expired on 1 March 2007, and, provided your international application is filed by 1 May 2007, it may still be possible for you to request the restoration of the right of priority.

If you include the priority claim and you do not request the restoration of the right of priority, the receiving Office, provided that that Office has not notified the International Bureau (IB) of the incompatibility of PCT Rule 26*bis*.3 with its national law (for a list of such Offices, see:

www.wipo.int/pct/en/texts/reservations/res_incomp.pdf), may notify you of the possibility of submitting to the receiving Office a request to restore the right of priority by way of revised Form PCT/RO/110 ("Invitation to Correct Priority Claim and/or Notification of Possibility to Request Restoration of the Right of Priority").

Such a request for the restoration of the right of priority may be made, subject to certain conditions, during the international phase before the receiving Office (PCT Rule 26*bis*.3), or later, during the national phase, before the designated Office (PCT Rule 49*ter*.2). The conditions and procedures applicable before each authority are discussed, separately, below.

(A) Request for the restoration of the right of priority during the international phase PCT Rule 26*bis*.3 "Restoration of the Right of Priority by Receiving Office"

It may be more beneficial for applicants to request the restoration of the right of priority initially during the international phase with the receiving Office, as the decision of the receiving Office may have effect in many of the designated Offices. Note, however, that ***it is not possible to restore the priority claim before the receiving Office in all situations, and it is not possible to do so before all receiving Offices*** - there are several conditions which must be met, and actions that must be taken, as described below:

(1) The international application must be filed on or after 1 April 2007 (the date of entry into force of the new rule).

(2) The receiving Office with which the international application is filed should be one which has not filed a notice under PCT Rule 26*bis*.3(j) of the incompatibility of PCT Rule 26*bis*.3(a) to (i) with its national law - requests for the restoration of the right of priority should not be made before the receiving Offices of the States and intergovernmental organization that have notified the IB of such incompatibility¹. If the receiving Office with which you normally file is one of these Offices, you have the usual option of filing your international application with the IB as receiving Office (RO/IB), which does allow for the restoration of the right of priority. Notwithstanding, if you do file an application with a receiving Office which has notified the IB of such incompatibility, the receiving Office may apply the procedure under PCT Rule 19.4(a)(iii) whereby it will transmit the application to RO/IB.

Furthermore, even if a receiving Office has notified the IB of the incompatibility of PCT Rule 26*bis*.3 with its national law, PCT Rule 26*bis*.2(c)(iii), which is applicable in respect of **all** receiving Offices, provides that a priority claim shall not be considered void if the international filing date is within two months from the date on which the priority period expired. Also, the date of the earlier application will serve as a basis to calculate time limits during the international phase.

(3) Depending on the criteria applied by the receiving Office², one of the following criteria for restoration must be satisfied:

- a) the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken; or
- b) the failure to file the international application within the priority period was unintentional.

Note that some receiving Offices will, if the applicant so requests, apply both criteria - first "due care" and then the more lenient "unintentional".

If conditions (1) and (2) are met and you think that the applicable criterion for restoration of the right of priority under (3) can be satisfied, the following actions must be taken, where applicable:

(4) The request for restoration of the right of priority (hereinafter: "request for restoration") must be filed with the receiving Office within the time limit of two months from the expiration of the priority period; if made at the time of filing the international application, it should preferably be made by using the Section provided for this purpose in Box No. VI "Priority Claim" of the request form dated 1 April 2007. If filed separately, it can be submitted in a letter (there is no specific form for this).

(5) The request for restoration must be supplemented by a statement explaining the reasons for failure to file the international application within the priority period. That statement should indicate, for each earlier application concerned, the filing date, the earlier application number and the name or two-letter code of the country, Member of the World Trade Organization, regional Office or receiving Office. Then, for each earlier application concerned, the applicant should state the reasons for the failure to file the international application within the priority period (PCT Rules 26*bis*.3(a) and 26*bis*.3(b)(ii)).

(6) Some receiving Offices² may require the payment of a fee, which should be paid within the time limit of two months from the expiration of the priority period (PCT Rule 26*bis*.3(e)).

(7) Some receiving Offices² may require the furnishing, within a reasonable time limit, of a declaration or other evidence in support of the statement of reasons (PCT Rule 26*bis*.3(f)). This should preferably be submitted to the receiving Office together with the request for restoration.

Note that the time limit for submitting the request for restoration and/or, if applicable, the fee payable therefor, may be less than two months from the expiration of the priority period where the applicant makes a request for early publication under PCT Article 21(2)(b), in which case they should be

submitted before the completion of technical preparations for publication (PCT Rule 26*bis*.3(e)).

For the restoration of the right of priority to be effective, the receiving Office must find that the criterion applied by it has been satisfied. When the receiving Office has made a decision on the request for restoration, it will notify the applicant and the International Bureau of its decision and of the criterion for restoration upon which the decision was based (PCT Rule 26*bis*.3(h)(iii)). It is important to note that even if the receiving Office restores the priority claim, the validity of the priority claim in the national phase cannot be assured (see further details about the designated office, below).

Rule 49*ter*.1 "Effect of Restoration of Right of Priority by Receiving Office" on designated Office
(1) Where the right of priority has been restored by the receiving Office:

The restoration of the right of priority by the receiving Office is, in principle, binding on the designated Office, but a limited review by the latter is possible. Whether the designated Office accepts the decision of the receiving Office will depend on:

(a) whether the designated Office has notified the IB of the incompatibility of PCT Rule 49*ter*.1 with its national law - if it is one of the Offices of the States or intergovernmental organization which has notified the IB of such incompatibility³ it does not have to accept that decision;

(b) for all other designated Offices, it will depend on the criterion/criteria for restoration used by the receiving Office:

- any right of priority which has been restored using the "in spite of due care" criterion is effective, subject to PCT Rule 49*ter*.1(c) and (d), in all such designated Offices;

- any right of priority which has been restored using the "unintentional" criterion is effective, subject to PCT Rule 49*ter*.1(c) and (d), in all such designated Offices which, under their applicable national law, apply that criterion or a criterion which, from the viewpoint of the applicant, is more favorable.

(2) Where the request for restoration of the right of priority has been refused by the receiving Office:

No designated State is bound by the decision of the receiving Office; any designated Office may consider the request for restoration submitted to the receiving Office to be a request for restoration submitted to it as designated Office under PCT Rule 49*ter*.2(a). It is recalled that even if the receiving Office refused to restore the right of priority, the priority claim will not be considered void during the international phase (see PCT Rule 26*bis*.2(c)(iii)).

(B) Request for the restoration of the right of priority during the national phase

Rule 49*ter*.2 "Restoration of Right of Priority by Designated Office"

According to PCT Rule 49*ter*.2, where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office will, on the request of the applicant,

restore the right of priority if the Office finds that a criterion for restoration applied by it is satisfied. You may want to request the restoration of the right of priority in the national phase, rather than in the international phase, in the following situations:

- if the receiving Office was one of those which have declared that PCT Rule 26bis.3 is incompatible with its national law, and the international application was not transmitted to the IB as receiving Office under PCT Rule 19.4;
- if the receiving Office refused the request for restoration; or
- if you simply did not request the restoration of the right of priority during the international phase.

If you request the restoration of the priority right before the designated Office, there are several conditions which must be met and actions that must be taken, as described below:

(1) The international application must be filed on or after 1 April 2007, or, if the international application was filed before 1 April 2007, the acts referred to in PCT Article 22(1) must be performed on or after 1 April 2007.

(2) The request for restoration must be filed within a time limit of one month from the applicable time limit under PCT Article 22. As was indicated above, even where the receiving Office has refused to restore the right of priority, the priority claim remains in the application and time limits will be calculated from the filing date of the priority claim which has not been restored, including the time limit under PCT Article 22.

(3) That request should state the reasons for the failure to file the international application within the priority period and, where applicable before the designated Office concerned², be accompanied by any declaration or other evidence required and a fee.

(4) The designated Office will restore the right of priority if it finds that the criterion for restoration applied by it² is satisfied.

(5) It may not be possible to restore the right of priority before a designated Office if it is the Office of one of the States or intergovernmental organization which has notified the IB of the incompatibility of PCT Rule 49ter.2 with its national law³.

A table showing information furnished to the IB by receiving Offices and designated Offices on the criterion/criteria applied by them, and on whether a fee is payable and/or whether other evidence is required in support of the request for restoration is under preparation and will be published shortly on the PCT Resources page of PatentScope. Information on the criteria applied by, and the requirements of the Offices will also be published shortly in the *PCT Applicant's Guide*, Annex C, and will be notified in the *PCT Newsletter* and the *Official Notices (PCT Gazette)* as and when the IB is notified of those requirements or of any changes to them.

Footnotes to practical advice:

1. The Offices of the following States and intergovernmental organization have notified the IB of the incompatibility of PCT Rule 26bis.3 with the national law applied by them: Algeria, Belgium, Brazil,

Colombia, Cuba, Czech Republic, European Patent Office, France, Germany, Greece, Hungary, India, Indonesia, Italy, Japan, Norway, Philippines, Portugal, Republic of Korea, Singapore, Spain (situation on 1 April 2007).

2. See last paragraph for further information.

3. The Offices of the following States and intergovernmental organization have notified the IB of the incompatibility of PCT Rule 49ter.1 and 2 with the national law applied by them: Algeria, Brazil, Canada, China, Colombia, Cuba, Czech Republic, European Patent Office, Germany, Hungary, India, Indonesia, Japan, Lithuania, Mexico, Norway, Philippines, Portugal, Republic of Korea, Singapore, Spain, Sweden, Turkey, United States of America (situation on 1 April 2007).

2007-05

Later furnishing of missing elements or parts of the international application

Q: I recently filed an international application in which a number of pages of the description were inadvertently omitted. The application claimed the priority of an earlier national application filed on 25 April 2006. Is it possible to submit those missing pages without affecting the international filing date which was originally accorded (4 April 2007), and if so, what must I do?

A: Following the recent entry into force of amendments to the PCT Regulations concerning the incorporation by reference of missing elements or parts of the international application, it is possible for you to submit the missing pages of the description without affecting your international filing date, provided that certain conditions are met (further details follow). Amended PCT Rule 20 enables the inclusion of accidentally omitted *elements* of the international application referred to in PCT Article 11(1)(iii)(d) or (e) (that is, the whole of the description or the whole of the claims) or *parts* of the international application (that is, part of the description, part of the claims or part or all of the pages of drawings) that were completely contained in an earlier filed application, the priority of which is claimed in the international application, without affecting the international filing date. Those amendments entered into force on 1 April 2007 and are applicable in respect of international applications filed on or after that date (hence they will not apply to international applications in respect of which one or more elements referred to in PCT Article 11(1)(iii) were first received by the receiving Office before 1 April 2007).

In order to make use of this new incorporation by reference procedure, the following requirements must be met:

- (1) the priority of the earlier filed application must have been claimed in the international application;
- (2) the missing element or part must be completely contained in the earlier application concerned (PCT Rule 20.6(b));
- (3) the request must contain the statement of incorporation by reference under PCT Rule 4.18, which is preprinted in the request form dated 1 April

20071 or, if that version of the request form was not used, a separate statement of incorporation by reference must have been filed together with the international application;

(4) confirmation of the incorporation by a written notice submitted to the receiving Office, stating that the element or part is incorporated by reference in the international application. The time limit for doing this is two months from the date on which one or more elements referred to in PCT Article 11(1)(iii) were first received by the receiving Office, or, where the receiving Office has issued an invitation to correct the application, two months from the date of that invitation (see PCT Rule 20.7)2. The notice of confirmation should be accompanied by:

(a) the missing sheet or sheets which contain the element or part as contained in the priority application;

(b) a (simple) copy of the earlier application as filed, unless such copy has already been submitted in the form of the priority document under Rule 17.1(a), (b) or (b-bis);

(c) a translation of the earlier application, if required (see PCT Rule 20.6(a)(iii)); and

(d) in the case of a missing part, an indication as to where in the earlier application (and, if applicable, where in the translation) the missing part is contained.

Note that if the applicant does not realize that an element or part of the international application is missing but the receiving Office does so when determining whether the application fulfills the requirements of Article 11(1) and/or when checking whether the international application complies with the formality requirements of the PCT, it will invite the applicant either:

(1) in the case of a missing element:

(a) to furnish the missing element as a correction under PCT Article 11(2), in which case the international filing date will be the date of receipt by the receiving Office of the missing element (assuming that all other Article 11(1) requirements are fulfilled) (see Rule 20.3(b)(i)); or, alternatively,

(b) to confirm in accordance with Rule 20.6 the incorporation by reference of the missing element, in which case the missing element will be considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received, and the international filing date will be the date on which all of the requirements of Article 11(1) are fulfilled (see Rule 20.3(b)(ii)); or

(2) in the case of a missing part:

(a) to complete the international application by furnishing the missing part, in which case:

(i) if no international filing date has yet been accorded, the missing part will be included in the international application and the international filing date will be the date on which all requirements of Article 11(1) are fulfilled (see Rule 20.5(b)); or

(ii) if an international filing date has already been accorded, the missing part will be included in the international application and the international filing date corrected to the date on which the missing part

was received by the receiving Office (see Rule 20.5(c)); in this case, the applicant has the option, however, of maintaining the original filing date by requesting that the missing part be disregarded (see PCT Rule 20.5(e));

(b) to confirm in accordance with Rule 20.6 the incorporation by reference of the missing part, in which case the missing part will be considered to have been contained in the international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received, and the international filing date will be the date on which all of the requirements of Article 11(1) are fulfilled (see Rule 20.5(d)).

Designated (and elected) Offices may, to a limited extent, review the decisions by receiving Offices to allow incorporation by reference (see PCT Rule 82^{ter}.1(b) to (d)).

It is important to note that a number of receiving Offices³ and designated Offices⁴ have notified the International Bureau (IB) of the incompatibility of certain PCT Rules relating to incorporation by reference of missing elements or parts with the national law applied by those Offices. Consequently, those receiving Offices which have so notified the IB will not apply the Regulations concerning incorporation by reference but instead, in the case of the later furnishing of a missing element or part:

(a) accord a later international filing date; or

(b) in the case of a missing part, correct the international filing date so that it is the date of receipt of the missing part, leaving the applicant the option, however, of maintaining the original filing date by requesting that the missing part be disregarded (PCT Rule 20.5(e)).

Similarly, those designated Offices which have so notified the IB may treat the international application, in the case of the later furnishing of a missing element or part:

(c) as if the international application had been accorded a later international filing date under Rule 20.3(b)(i) or 20.5(b); or

(d) in the case of a missing part, as if the international filing date had been corrected under Rule 20.5(c), in which case the designated (or elected) Office must, however, give the applicant the opportunity to maintain the original filing date by requesting that the missing part be disregarded (PCT Rule 82^{ter}.1(d)).

Footnotes to Practical Advice:

1. If you filed your international application in electronic form, you should check with your receiving Office whether the software you used at the time of filing had been updated to include that statement.

2. If a notice confirming the incorporation by reference of an element is received by the receiving Office after the expiration of the applicable time limit under PCT Rule 20.7(a) but before that Office notifies the applicant under PCT Rule 20.4(i) that the application will not be treated as an international application, that applicant's notice will be considered to have been received within that time limit (PCT Rule 20.7(b)).

3. The receiving Offices of the following States and intergovernmental organization have notified the IB

under PCT Rule 20.8(a) of the incompatibility of PCT Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d) and 20.6 with the national law applied by them: Belgium, Cuba, Czech Republic, Germany, Hungary, Indonesia, Italy, Japan, Mexico, the Philippines, the Republic of Korea, Spain and the European Patent Office.

4. The designated Offices of the following States and intergovernmental organization have notified the IB under PCT Rule 20.8(b) of the incompatibility of PCT Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d) and 20.6 with the national law applied by them: China, Cuba, Czech Republic, Germany, Hungary, Indonesia, Japan, Lithuania, Mexico, the Philippines, the Republic of Korea, Spain, Turkey and the European Patent Office.

2007-06

Submitting replacement drawings where no invitation to correct defects has been issued

Q: Upon filing an international application, I submitted drawings which had been drawn up hastily, and which I do not think were good enough quality. However, I have not yet received an invitation by the receiving Office to submit replacement drawings of better quality. Is it possible to file replacement drawings even if an invitation to correct defects (Form PCT/RO/106) has not yet been issued by the receiving Office? If so, what is the time limit for doing this? Also, if they are received by the International Bureau after international publication, will they be forwarded to the designated Offices?

A: If the quality of the drawings you have submitted is poor, you do not need to wait for the receiving Office to issue an invitation to correct defects in the international application because substitute sheets under PCT Rule 26 may be submitted to correct formal defects in the drawings, **on the applicant's own initiative** (see PCT Receiving Office Guidelines, paragraph 209, at: www.wipo.int/pct/en/texts/pdf/ro.pdf). The ability to submit replacement sheets without invitation by the receiving Office is not limited to drawings – it applies equally to the text matter of the international application. As far as your drawings are concerned, it may even be the case that the receiving Office does not intend to invite correction. You should bear in mind, however, that the omission by the receiving Office to invite correction does not prevent the designated (or elected) Offices from inviting the applicant to comply with the requirements under PCT Rule 11 in the national phase.

In order to assess whether the quality of any drawings or text matter filed in paper form is sufficient, you should bear in mind that the sheets will be scanned by the International Bureau (IB) for publication purposes. Furthermore, certain receiving Offices which do not require applications to be filed in more than one copy may prepare a copy of the application themselves for search purposes (whether by photocopying or scanning), and you should be aware that that a bad reproduction of the drawings might even affect the quality of the search.

It is recalled that replacement sheets should be sent directly to the receiving Office, and not to the IB – it is

the receiving Office which forwards the sheets to the IB for international publication. Where there has been no invitation from the receiving Office to correct defects, there is no fixed time limit for sending the replacement sheets to the receiving Office. However, they must be sent early enough so that the receiving Office can transmit them to the IB before the completion of technical preparations for publication (normally 15 days prior to the publication date). If they are received in time, they will be published as part of the international application.

If the formal drawings are received late by the IB and are not published, they will not be forwarded to the designated Offices, and you would need to furnish the replacement sheets separately to each designated Office concerned later, during the national phase. Nor would the formal drawings be available on the database of International Patent Applications (PatentScope) published on the WIPO website. They would, nevertheless become part of the file held by the IB, and would be available as follows:

- under PCT Rule 94.1(a) they would be available, at any time, to anyone authorized by the applicant, subject to the reimbursement of the cost of the service; and
- under PCT Rule 94.1(b) they would be available to third parties after international publication of the international application, subject to the reimbursement of the cost of the service.

It is therefore recommended that the replacement drawings be submitted as soon as possible in the PCT procedure, even if you have not received an invitation to correct defects from the receiving Office, particularly if the originally filed sheets are such that if they are reproduced, the clarity and sufficiency of the disclosure might suffer.

For information on the formality requirements for drawings, see paragraphs 143 to 178 of Volume I of the *PCT Applicant's Guide*:

www.wipo.int/pct/guide/en/

See also the "Practical Advice" in *PCT Newsletter* No. 01/2005, page 7, for information on the importance of correcting defects in drawings.

2007-07

Information available to third parties about a withdrawn priority claim

Q: After filing an international application claiming the priority of an earlier filed national application, I realized that the earlier application contained information that was not contained in the international application, and which should never have been disclosed in the earlier application in the first place. I would like to know what my options are, if any, for the information contained in the earlier application not to be made available to the public. Will it be sufficient for me to withdraw the priority claim so that neither the priority document nor information about the priority claim will be available to third parties?

A: If you withdraw a priority claim under the PCT, the extent to which the priority document itself and information about that priority claim are available to third parties in respect of the PCT application depends

on the time at which you withdraw the priority claim, as explained below under item (1), noting that the options available to you under the PCT system cannot be considered in isolation from the status of your earlier national application or any other application you may have filed outside the PCT system (see item (2), below).

(1)(a) Withdrawal of a priority claim before completion of technical preparations for publication

If your notice of withdrawal of the priority claim is received by the International Bureau (IB) before the completion of technical preparations for international publication, that is, before 15 days prior to the date of publication (if the notice of withdrawal is sent to the receiving Office, it will have to be sent even earlier, as the receiving Office must then be able to notify the IB of the withdrawal before completion of technical preparations for publication):

- the priority document will not be available to third parties (in accordance with PCT Rule 17.2(c)(ii)), either via the IB's PatentScope search service (www.wipo.int/pctdb/en/) or upon specific request addressed to the IB; and
- information concerning that priority claim will not be included in the bibliographic data on the front page of the published international application.

Having said that, it is very important to note that third parties may obtain information about the priority claim concerned if they request the IB to furnish copies of certain documents contained in its file, in particular the request form (priority claim(s) will appear in Box No. VI) or subsequent correspondence relating to priority claims (such as a declaration correcting or adding a priority claim or a notice of withdrawal of a priority claim). It is recalled that access to such documents by third parties is governed by PCT Rule 94.1(b), which provides that a third party can, after international publication of the international application, request the IB to furnish copies of any document contained in its file (subject to PCT Article 38 and PCT Rule 44ter.1 and subject to the reimbursement of the cost of the service).

(b) Withdrawal of a priority claim after completion of technical preparations for publication but before international publication of the international application

If your notice of withdrawal of the priority claim is received by the IB during the 15 days between the date of completion of technical preparations for international publication and the actual publication date:

- the priority document will not be available to third parties (in accordance with PCT Rule 17.2(c)(ii)), either via the PatentScope search service or upon specific request addressed to the IB;
- but:
- it will be too late for the IB to omit the information concerning the priority claim from the front page of the published international application;
 - the IB will publish a separate notice on the PatentScope search service (under the "notices" tab of

the international application concerned) announcing the withdrawal of the priority claim after completion of technical preparations for publication (PCT Rule 48.6(c)); and

- the PatentScope search service will include an indication on the bibliographical data screen (under the tab "biblio. data") that the priority claim has been withdrawn.

Third parties will therefore be aware that the priority claim had been made and subsequently withdrawn, but will not have access to the priority document itself.

(c) Withdrawal of a priority claim after international publication of the international application

If your notice of withdrawal of the priority claim is received by the IB after the international application has been published:

- the priority document will be available to third parties both via the PatentScope search service and upon specific request addressed to the IB (PCT Rule 17.2(c));
- information concerning the priority claim will have already been included on the front page of the published international application; and
- the IB will publish a separate notice on the PatentScope search service (under the "notices" tab of the international application concerned) announcing the withdrawal of the priority claim after international publication (PCT Rule 48.6(c)); and
- the PatentScope search service will include an indication on the bibliographical data screen (under the tab "biblio. data") that the priority claim has been withdrawn.

(2) Withdrawal of the national application, or any other subsequent applications claiming priority of that application

On the assumption that you are able to withdraw the priority claim before completion of the technical preparations for international publication (see item (1)(a)), you must also withdraw the earlier national application itself so that it is not published under the applicable national law. Similarly, if other applications have been filed outside the PCT system, you must ensure that they are also withdrawn. In other words, attending only to the withdrawal of the priority claim in the PCT application to prevent access to the priority document, or publication of information about the priority claim, does not have any effect on the access to that document and related information as far as the priority application and other related applications are concerned.

On the assumption that you are not able to withdraw the priority claim before completion of technical preparations for international publication (see items (1)(b) and (c) above), information about the priority claim (and possibly also the priority document itself) will be accessible to third parties under the PCT system, but you may be able to limit the extent to which information may become available in respect of the priority application itself or other applications filed outside the PCT system. It may be that under the circumstances, limiting access is the best you can achieve, rather than preventing access altogether. You

must then take action under each applicable national law as a matter of urgency.

(3) Information on withdrawing priority claims under the PCT

It is recalled that you can withdraw a priority claim at any time prior to the expiration of 30 months from the priority date (PCT Rule 90*bis*.3(a)) and that, where the withdrawal of a priority claim causes a change in the priority date, any time limit which had been computed from the original (earliest) priority date and which has not already expired will be recomputed from the priority date resulting from that change (that is, recomputed from the international filing date or, if there is another priority claim, the new priority date resulting from the withdrawal of the earliest priority claim) (PCT Rule 90*bis*.3(d)). It is recommended that you always submit withdrawals of priority claims, as well as any other types of withdrawal under PCT Rule 90*bis*, to the IB, and that you use Form PCT/IB/372 (Notice of Withdrawal), ensuring that you mark the box which enables you to make the withdrawal conditional on its being received by the IB in time to prevent international publication.

Please be aware that before withdrawing any priority claim, you must consider the consequences that such withdrawal will have on the assessment of novelty and inventive step in the light of the relevant prior art, which would then include prior art published before the international filing date or any other priority date.

For information on the withdrawal of priority claims see *PCT Applicant's Guide*, paragraphs 460-461, and for information on the withdrawal of priority claims in order to postpone entry into the national phase, see *PCT Newsletter* No. 01/2003, page 11.

2007-08

Access to the inventor's address by third parties

Q: I am going to file, on behalf of a client, an international application, the subject matter of which is fairly sensitive. The inventor is worried about having his address made available to the public by way of the published international application. Is there any way that the information concerning the inventor can be excluded from the published international application, or even from the file of the international application so that it will not be made publicly available?

A: The request should, in accordance with PCT Article 4(v) and Rules 4.1(a)(iv) and 4.6(a), contain the name and address of the inventor where the national law of at least one of the designated (or elected) States requires that the name and address of the inventor be furnished at the time of filing a national application. It is recalled that, for the purposes of the designation of the United States of America, the inventor(s) must also be named as applicant(s) in the international application*.

Any information included in the request form regarding the applicant and inventor will be automatically published on the front page (in the bibliographical data) of the published international application (PCT Rule 48.2(b)(i)) (note that it is not possible under the PCT to request that certain information be excluded

from publication). The bibliographic screen of the Patentscope Search Service will also contain the address of the inventor as indicated in the request as well as any changes recorded under Rule 92*bis* after international publication. Furthermore, access to the file may be requested under Rule 94.1(b) to certain other documents in the file of the International Bureau that may contain the inventor's address.

Note, however, that ***there is no requirement under the PCT that the address indicated in the request form be the inventor's "home" address*** (PCT Rule 4.4(c)) – it is normally possible to use the address of the inventor's employer instead. If this is not possible or desired for any particular reason, it would be a matter for the applicants/inventors (and a matter of the national law of the relevant designated Offices) as to what address could be indicated). In any event, for the purposes of the international phase, the International Bureau would not object to the use of an address which is not the inventor's home address.

Another option would be to simply not indicate any address in the request form, in which case the receiving Office may bring to your attention the fact that the address of the inventor (or the applicant/inventor) is not indicated. If you choose to leave out the address, and do not reply to any invitation to correct issued by the receiving Office, the processing of the application would simply continue, and the application would be published without the address of the inventor concerned. The consequences of any such defect would then be a matter for the national phase.

While some designated Offices require the inclusion of the inventor's name and address in the request form, some Offices allow that information to be furnished later, in the national phase, and the designated Offices of Austria, China, Israel and Spain do not require the address of the inventor at all. Annexes B1 and B2 of the *PCT Applicant's Guide*

(www.wipo.int/pct/guide/en/) give information on the requirements of the designated Offices regarding the furnishing of the name and address of the inventor, noting that in the case of many of those Offices, even though it is a requirement of the Office to include that information in the request form, if the information is missing from the request at the expiration of the applicable time limit 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.

If you intend to file a declaration of inventorship, which must include the inventor's address, during the international phase, that declaration will, provided the declaration is received prior to the completion of technical preparations for publication, be published.

Note that in view of the fact that it is the law of the United States of America which governs the contents of that declaration and which provides for consequences of non-compliance with requirements of the US national law, it would be advisable to contact the United States Patent and Trademark Office for questions regarding the US law and practice regarding the inventor's address. It is recalled that you always have the option of filing the declaration of inventorship in the national phase.

As far as the indication of the inventor's address in the request is concerned, it is recommended that, in order to avoid any problems in the national phase, applicants always include the address of the inventor in the request unless there are special reasons for not doing so, recalling what was said above about the fact that the address does not necessarily have to be the inventor's home address.

* Note that, although under Rules 4.5(a)(ii) and 4.6(a) the request form should contain the address of the applicants and/or inventors, Rule 26.2bis(b) provides that if there is more than one applicant and the address has been given in respect of at least one applicant who is entitled to file the application with the receiving Office, this is considered sufficient and the receiving Office is not required to invite the applicant to furnish any missing address in respect of any other applicant/inventor.

2007-09

Late transmittal of the priority document

Q: I have filed, on behalf of my client, an international application claiming the priority of an earlier filed national application. Since the applicant lived in a different country when he filed the earlier application, the receiving Office with which the international application was filed is not the same as the Office with which the earlier application was filed. I was therefore unable to make use of the facility in the request form for requesting the receiving Office to prepare and transmit to the International Bureau a certified copy of the earlier application. The time limit for transmitting the certified copy to the International Bureau of 16 months from the priority date has nearly expired and I have still not received it from the national Office in question. What will be the consequences for the priority claim if I am unable to submit the certified copy to the International Bureau in time?

A: In general, the priority document (copy of an earlier application certified by the authority with which it was filed) must be furnished to the International Bureau (IB) within 16 months from the priority date (PCT Rule 17.1). However, if you are unable to transmit it to the IB before the expiration of that time limit, you may in fact have more time as the IB will consider the priority document to have been received by it on the last day of that 16-month period if it reaches it before the date of international publication of the international application (which is, according to PCT Article 21(2)(a), usually as soon as possible after the expiration of 18 months from the priority date, unless you have requested early publication under PCT Article 21(2)(b)). Although PCT Rule 17.1 states that the priority document should be submitted by the applicant to the IB or to the receiving Office, when it is transmitted after the filing of the international application, it is advisable to send it **directly to the IB**. If the IB does receive the priority document in time, or for cases where the applicant is in a position to request the receiving Office to furnish the priority document to the IB under PCT Rule 17.1(b)*, the IB furnishes, at the specific request of a designated Office (but only

after the international publication of the international application) a copy of the priority document to that Office, together with information about when the priority document was received (or considered received, as the case may be). In such cases, no designated Office may ask the applicant himself to furnish it with a copy (PCT Rule 17.2(a)).

You should make every effort to ensure that the IB receives the priority document in time in order to avoid any extra work in the national phase. Even if the priority document is not submitted to the IB within the time limit under PCT Rule 17.1(a) (and PCT Rule 17.1(b) is not complied with*), please note the following:

- the IB will still transmit the priority document to the designated Offices but with an indication that it was received outside the applicable time limit – any designated Office may, nevertheless, request a new certified copy from the applicant;
- no designated Office should disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a reasonable time limit (PCT Rule 17.1(c)); and
- no designated Office should disregard the priority claim if the earlier application was filed with it in its capacity as national Office (PCT Rule 17.1(d)).

Note that in 2004, PCT Rule 17.1(b-bis) was adopted to enable applicants to request receiving Offices or the IB to obtain the priority document from digital libraries. Although this new Rule is not yet in operation, priority documents will in the future be made available, in accordance with the Administrative Instructions under the PCT (as yet to be modified accordingly), to the receiving Office or to the IB from a digital library. Thus, instead of submitting the priority document, you will be able to request the authority concerned, not later than 16 months after the priority date, to obtain the priority document from that digital library, and, in the case of the receiving Office, request it to transmit it to the IB. Furthermore, no designated Office will be able to disregard the priority claim if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library (PCT Rule 17(d)).

* It is recalled that where the Office with which the earlier application was filed is the same Office as the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office, before the expiration of 16 months from the priority date, to prepare and transmit the priority document to the IB, preferably by checking the "Transmit certified copy" box under Box No. VI "Priority claim" of the request form (PCT/RO/101), or, if using the PCT-SAFE software, by checking the corresponding box on the Priority page.

2007-10

The consequences of receiving a declaration of non-establishment of an international search report

Q: I have received Form PCT/ISA/203 declaring that no international search report will be established on my international application because it relates to a

subject matter on which my chosen International Searching Authority (ISA) will not carry out searches. What is the consequence of this for the international application? Also, as my receiving Office has specified several authorities as competent ISAs, is it possible to request that another search now be carried out by another ISA that will carry out searches on that particular subject matter?

A: A declaration of non-establishment of an international search report (ISR) (Form PCT/ISA/203) can be made if the ISA considers that a meaningful search could not be carried out because the international application relates to a subject matter which, under the PCT Regulations, the ISA is not required to search and, in the particular case, decides not to search (see PCT Article 17(2)(a)). ISAs often search only subject matter encompassed by the national/regional patent granting procedure under the provisions of their applicable national/regional law. A list of the subject matters which the ISA can decide not to search is provided in PCT Rule 39.1; information relating to the subject matters which will not be searched by a particular ISA can be found on the relevant page of the *PCT Applicant's Guide*, Annex D; however, for full details, it is preferable to contact the ISA concerned direct. It is recommended that before filing the international application applicants inform themselves about which subject matters the ISA they intend to choose will not search.

Note that a declaration of non-establishment of an ISR can also be made if the ISA considers:

- that the description, the claims, or the drawings do not comply with the prescribed requirements; or
 - that a nucleotide and/or amino acid sequence listing and/or tables related thereto are not furnished in accordance with the prescribed standard and technical requirements or in an electronic form
- to such an extent that a meaningful search could not be carried out.

Where no ISR has been established, this does not in itself have any influence on the validity of the international application, the processing of which will continue, including its publication and communication to the designated (or elected) Offices. Note, however, that if no ISR has been established, it will not be possible to file amendments to the claims under PCT Article 19, and, although you may in principle file a demand and amendments to the international application under PCT Article 34, the International Preliminary Examining Authority is not obliged to examine the claims concerned (see PCT Rule 66.1(e)). Upon entry into the national phase, however, you will be given the opportunity to amend the application before the Office concerned under PCT Article 28(1) or 41(1). Note, however, that any amendments must not go beyond what was originally disclosed in the international application.

Where a declaration of non-establishment of an ISR under PCT Article 17(2)(a) is made, there would normally still be, as a formal matter, a written opinion (Form PCT/ISA/237) in accordance with PCT Rule 43bis.1(a), but it would not normally contain any opinion of substance, but rather a corresponding

observation would be made by the ISA in Box No. III of the form that no meaningful opinion could be established since no ISR had been established. The International Bureau would make a similar observation on the International Preliminary Report on Patentability (IPRP Chapter I of the PCT) (Form PCT/IB/373). If the International Bureau receives any informal comments from the applicant following the ISA's notification on Form PCT/ISA/237, it would simply communicate them to the designated Offices (for further information on informal comments, see the Practical Advice in *PCT Newsletter* No. 10/2004, page 7).

As far as your ability to request a further international search by another ISA is concerned, under the current PCT Regulations, you are not permitted to do this. Notwithstanding, this will probably change in the near future, once the newly adopted regulations enter into force which provide for the supplementary international search system, and once at least one ISA has announced that it is prepared to carry out such supplementary international search reports (see cover page for further details). Even when this new system does become operational, however, where the first ISA has made the declaration referred to in Article 17(2)(a) and that declaration is available to the Authority specified for supplementary search before it starts the search, that Authority may decide not to establish a supplementary international search report, in which case it shall so declare and promptly notify the applicant and the International Bureau accordingly (see new PCT Rule 45bis.5 (e)). If you cannot obtain an ISR, it may be possible for you to request a private prior art search of the application.

Without an ISR, you will be in less of a position to make an informed evaluation about whether you are likely to obtain a patent in the national phase, noting however, that since this is a decision to be taken by the designated (or elected) Offices, and since the national/regional law applied by those Offices varies as to what subject matter is patentable, the fact that no ISR was established might have different consequences on the further patent granting procedure before the various Offices.

For further information on the refusal of the ISA to search certain subject matter, see the *PCT Applicant's Guide*, International Phase, paragraph 279.

2007-11

Publication of a rectification of an obvious mistake after international publication

Q: I filed an international application on 16 April 2007, claiming priority of an earlier application filed on 25 April 2006. It was only after my international application was published recently that I noticed that there was a mistake in the description of the invention. I therefore immediately submitted to the International Searching Authority (ISA) a request for rectification of an obvious mistake. If that request for rectification is authorized by the ISA, will the international application be republished with the corrected text? If it is not authorized, can the request for rectification itself be published so that designated Offices and third parties can be made aware of that mistake?

A: Since your international application was filed after 1 April 2007, PCT Rule 91, as amended with effect from that date, applies (it is important to note that for international applications filed before 1 April 2007, PCT Rule 91 as applicable prior to that date applies*).

It is recalled that under new PCT Rule 91.2, the applicant may request the competent authority to authorize a rectification of an obvious mistake within 26 months from the priority date (note that depending on the part of the international application concerned, or depending on the stage in the proceedings during the international phase, authorities other than the ISA (the receiving Office, the International Bureau (IB) or the International Preliminary Examining Authority) may be competent to authorize the rectification – see PCT Rule 91.1(b) for details). The authority will authorize the rectification if it is obvious to that authority that, as at the international filing date (or other applicable date under PCT Rule 91.1(f)), something else was intended than what appears in the document concerned and nothing else could have been intended than the proposed rectification (PCT Rule 91.1(c)).

If your request for rectification of an obvious mistake in the description is authorized by the ISA, the IB will, in accordance with PCT Rule 48.2(i), publish the following as soon as possible, free of charge:

- a revised version of the front page of the published international application;
- the replacement sheets (marked with the words “RECTIFIED SHEET (RULE 91)”); and
- a statement reflecting the rectification and/or the applicant’s letter requesting rectification.

The documents concerned will be available under the “Documents” tab of the relevant published international application at: www.wipo.int/pctdb/en/

Designated (or elected) Offices (as well as the receiving Office and international authorities, as required) will be aware of the rectification through its publication on PatentScope. Generally, a designated Office must process the international application in the national phase “as rectified”, unless the Office:

- has already started the processing or examination

2007-12

Later submission of the abstract of the international application

Q: I recently filed an international application with which I inadvertently omitted to include the abstract. Would such omission be covered by the provisions of PCT Rule 20 concerning missing elements or parts? If not, what are the consequences of a later submission of the abstract?

A: A missing abstract is not covered by PCT Rule 20, as amended on 1 April 2007, which enables the inclusion of accidentally omitted elements of the international application referred to in PCT Article 11(1)(iii)(d) or (e) (that is, the whole of the **description** or the whole of the **claims** (see PCT Rule 20.3)) or parts of the international application (that is, part of the **description**, part of the **claims** or part or all of the pages of **drawings** (see PCT Rule 20.5)), the furnishing of which would normally

result in the according of a later international filing date (for further details, see the “Practical Advice” in *PCT Newsletter* No. 05/2007).

A missing abstract is a defect under PCT Article 14 which may be corrected after the filing of the international application without affecting the international filing date. If the abstract is missing, the receiving Office invites the applicant, in accordance with PCT Article 14(1)(b), to furnish the missing abstract within the time limit of two months from the date of that invitation (see PCT Rules 26.1 and 26.2). A copy of the invitation will be sent to the International Bureau (IB) and the International Searching Authority (ISA). Upon receipt of that invitation, the ISA will proceed with the international search (PCT Rule 38.1). As with other defects under PCT Article 14, a lack of compliance with the requirement to furnish the abstract can theoretically result in the withdrawal of the international application (see PCT Article 14(1)(b)). Although the time limit fixed in the above-mentioned invitation for furnishing the abstract may be extended by the receiving Office upon request, note that, for the purposes of international publication, if the original abstract is in Chinese, French, German, Japanese, Russian or Spanish, the IB must prepare an English translation of the abstract, and if the original abstract is in English, or in one of above-mentioned languages other than French, it must also prepare a French translation. The abstract should therefore preferably be submitted as soon as possible to allow sufficient time for translation.

If you file the international application using the PCT-EASY functionality of the PCT-SAFE software, the software draws your attention to the missing abstract by way of a yellow light and a validation message. If you proceed, nevertheless, without including the abstract, you will not be entitled to the reduction under Item 3(a) of the Schedule of Fees annexed to the PCT Regulations. This is because the PCT-EASY physical medium which is filed with the paper application must contain a copy in electronic form of the data contained in the abstract, as well as the request (see Section 102*bis* of the *Administrative Instructions under the PCT*). Any later submission of the abstract in this case must be made on paper.

However, in the case of international applications filed fully electronically using the PCT-SAFE software, even though, as in the case with PCT-EASY functionality, a later-filed abstract would have to be filed on paper, the applicable fee reduction would not be affected.

If the international application does not contain an abstract and the ISA does not receive a notification from the receiving Office to the effect that the applicant has been invited to furnish a missing abstract (or if an abstract has been filed and the ISA finds that the abstract does not comply with PCT Rule 8), PCT Rule 38.2 provides for the establishment of an abstract by the ISA. If the abstract has been prepared by the ISA, the international search report (ISR) will be accompanied by the abstract as established by the ISA (PCT Rule 44.2). Where the ISA establishes the abstract, comments on that abstract may be sent by the applicant within one month from the date of mailing of the ISR; those comments may or may not be taken

into account by the ISA. If the ISA decides to take those comments into account and (further) amend the abstract, it will notify the IB of the final content of the abstract (see PCT Rule 38.3).

For information on how to draft the abstract, see PCT Rule 8 and the *PCT Applicant's Guide*, International Phase, paragraph 179.

2008-01

Consequence of excluding a designation of a State under PCT Rule 4.9(b) where there is no claim of priority of an earlier national application filed in that State

Q: I filed a number of international applications claiming the priority of earlier applications filed in Germany. In those applications, the relevant check-box in Box No. V of the request form was marked, in accordance with the provisions of PCT Rule 4.9(b), to exclude the designation of Germany. I subsequently filed another international application in which that box was marked, even though the international application did not claim the priority of an earlier application filed in Germany (it claimed the priority of an application filed in Austria). What will be the consequence of the box being checked? Is it still possible to designate Germany?

A: It is recalled that PCT Rule 4.9(b) was adopted to accommodate the situation where the national law of certain countries (at the time of writing this: Germany, Japan, the Republic of Korea and the Russian Federation) provides for automatic withdrawal of an earlier national application if a later-filed international application claims the priority of that earlier national application and designates that State; in such cases, the applicant can exclude the State concerned from the automatic and all-inclusive designation of all PCT Contracting States under PCT Rule 4.9(a), thereby maintaining the priority application.

Even though you have excluded the designation of Germany, under PCT Rule 4.9(b) you may only exclude the designation of such a State in Box No. V **if the priority of an earlier national application filed in that State is claimed in Box No. VI**. Therefore, if, on the date of filing, the request part of your international application contains an indication under Rule 4.9(b) that the designation of Germany is not made, but does not contain a priority claim to an earlier national application filed in that State, you should be notified by the receiving Office, and your attention drawn to Rule 26*bis* ("Correction or Addition of Priority Claim") to give you the opportunity to add any missing priority claim, in case the lack of priority claim is due to an omission on your behalf. In accordance with Section 319 of the Administrative Instructions under the PCT, if, by the expiration of the time limit under Rule 26*bis*.1(a), the receiving Office has not received any notice correcting or adding a priority claim to an earlier national application filed in Germany, it will cancel ex officio the indication in Box No. V, and the designation of Germany would thereby be reinstated. The receiving Office would then notify you and the International Bureau, by way of PCT Form PCT/RO/146, that it had

cancelled ex officio the indication in Box No. V. It would therefore not be necessary for you to take any action in this situation.

Notwithstanding, there would be nothing to prevent you from notifying the receiving Office as soon as you realize that the designation of Germany has been erroneously excluded, and confirming to them that the international application does not claim the priority of an earlier national application filed in Germany. This would streamline the correction procedure (the receiving Office would not have to issue the first notice referred to in the preceding paragraph) and ensure that the receiving Office applied Section 319(b) of the Administrative Instructions directly.

Note that the above would equally apply should a similar situation arise where the designations of Japan, the Republic of Korea or the Russian Federation have been erroneously excluded.

For further information on the implications of PCT Rule 4.9(b), see the Practical Advice published in PCT Newsletter Nos. 11/2003 and 04/2006.

2008-02

Filing an international application with a national receiving Office, and relying on that Office to transmit the application to the International Bureau as receiving Office under PCT Rule 19.4

Q: I am a US agent and have been asked by my client, who is resident in US and is a national of Mexico, to file an international application (which does not claim the priority of an earlier national application). The description and claims of the application are in Spanish, but the United States Patent and Trademark Office as receiving Office (RO/US) only accepts international applications filed in English. Since we do not wish to incur the expense of translating the international application into English at this stage of the procedure, I will be filing it with the International Bureau as receiving Office (RO/IB), which accepts international applications in any language. Can I nevertheless file the international application with RO/US on the presumption that it will, in any case, transmit the application to RO/IB under PCT Rule 19.4, or should I file directly with RO/IB?

A: Where an international application is filed with a national (or regional) Office that acts as a PCT receiving Office but the application is not in a language accepted under Rule 12.1(a) by that Office, the safeguard procedure under PCT Rule 19.4 applies. Under this procedure the national Office transmits the international application to RO/IB unless prescriptions concerning national security prevent the international application from being so transmitted. Filing with RO/IB gives applicants more flexibility as it accepts international applications filed in any language (noting that in some cases a translation may have to be furnished for the purposes of international search, depending on the competent International Searching Authority (ISA) and the language(s) accepted by the ISA concerned) and nationals and residents of any PCT Contracting State may file an international application with it. If the international application is filed

with a national Office and is then transmitted to RO/IB under PCT Rule 19.4, the application is considered to have been received by the national Office concerned on behalf of RO/IB and the date of receipt of the international application by the national Office is considered to be the date of receipt for the purposes of the international filing date (PCT Rule 19.4(b)). The same procedure applies where an international application is filed with a PCT receiving Office which is not competent on account of the nationality and residence of the applicant(s) under Rule 19.1 or 19.2, or in cases where the national Office and the IB agree, for any reason other than those specified above, and with the authorization of the applicant, that the procedure under Rule 19.4 should apply.

If you file your international application with a national receiving Office, and that Office transmits the application to RO/IB under PCT Rule 19.4, you may have to pay the equivalent of two transmittal fees – one to RO/IB, and also the national receiving Office may require the applicant to pay a fee equal to the transmittal fee charged by that Office under PCT Rule 14 (see PCT Rule 19.4(b)). At the time of writing, the United States Patent and Trademark Office (USPTO) charges this fee. If the applicant has already paid the international filing fee and international search fee to the national Office, those fees will be refunded to the applicant, who will then have to pay them, together with the (second) transmittal fee, to RO/IB. Note that, for the calculation of the time limit for payment of fees, the date of receipt of the international application will be considered to be the date on which the international application was actually received at RO/IB and not the date on which it was received by the national Office. If you file with a national receiving Office, it will be in a position, where applicable, to check the application for compliance with national security prescriptions before transmitting it to RO/IB (see below for information in this respect if the international application is filed directly with RO/IB).

If you know that the national receiving Office cannot accept your international application (for example, for language reasons), it is recommended that you file it directly with RO/IB rather than relying on it being processed under PCT Rule 19.4. If you file directly, you will only pay one transmittal fee. Also, by filing directly, time will be saved in the processing of the international application: there are fewer administrative steps involved, for example, the issuing of a notification to the applicant informing him/her that the application is being transmitted to RO/IB under PCT Rule 19.4 (Form PCT/RO/151), the refunding of fees paid to the national Office, and although the national receiving Office should transmit the international application to RO/IB promptly, there is a risk that there may be a delay in such transmittal. However, it is the applicant's responsibility to comply with any national security provisions before filing an international application with RO/IB, since RO/IB will not check for such compliance. Before filing the international application, you should therefore check with the national Office(s) that is (are) competent on account of the nationality and residence of the applicant.

In addition, please note the following about filing with RO/IB in general:

- Although RO/IB does not require the applicant to be represented by an agent, if any agent is appointed, he or she must be a person who has the right to practice before the national Office of, or acting for, a Contracting State of which the applicant (or, if there are two or more applicants, any of the applicants) is a resident or national. (You would meet these requirements since, presumably, you have the right to practice before the Office of the country of residence of the applicant, the USPTO.)
- The International Searching Authority(ies) and International Preliminary Examining Authority(ies) which would be competent for searching/examining the international application are those which would have been competent if the international application had been filed with any other receiving Office of, or acting for, the PCT Contracting State of which the applicant is (or applicants are) a resident or national. In your case, the applicant is a resident of US and a national of Mexico; the competent ISAs and IPEAs for the USPTO are: the USPTO, the European Patent Office (subject to certain restrictions) or the Korean Intellectual Property Office. Those competent for the Mexican Institute of Industrial Property are: the European Patent Office, the Spanish Patent and Trademark Office, the Swedish Patent and Registration Office or the USPTO. The only one of the aforementioned ISAs and IPEAs which will search and examine applications in Spanish is the Spanish Patent and Trademark Office. If you want to choose another ISA and/or IPEA, you would have to translate the international application into another language accepted by your chosen Authority. Information on the competence of the various ISAs and IPEAs and languages accepted by those authorities can be found in Annexes C, D and E of the *PCT Applicant's Guide* (www.wipo.int/pct/guide/en/).

Note that, being a national of Mexico, the applicant would also be entitled to file an international application in Spanish with the Mexican Institute of Industrial Property, however, you would not be entitled to act as agent before that Office (it requires that the agent be resident in or a national of Mexico), but rather, you would be considered as an address for correspondence (for further details on this kind of situation, see the "Practical Advice" published in *PCT Newsletter* No. 06/2006 entitled: "Consequence of the agent not being entitled to practice before the Office of the country of residence and/or nationality of the applicant").

Information on filing with RO/IB, in particular: accepted modes of filing, fees payable, accepted currencies and modes of payment, special features of filing with RO/IB, and contact details of the PCT Receiving and Processing Team (for example, to check receipt and status of payment of a PCT application) can be found by going to the link entitled "Direct filing at WIPO" on the PCT Resources page of Patentscope® at: www.wipo.int/pct/en/filing/filing.htm

2008-03

Right to practice before an International Searching Authority and International Preliminary Examining Authority (where the agent is appointed for the whole of the international phase)

Q: I read in the "Practical Advice" in the February 2008 issue of the PCT Newsletter about a situation where a US agent was going to file, on behalf of an applicant who is a resident of the United States of America and a national of Mexico, an international application with the RO/IB. As a result of the applicant's Mexican nationality, it was possible to choose the Spanish Patent and Trademark Office as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) (which has been specified as a competent ISA/IPEA by the Mexican Institute of Industrial Property in its capacity as receiving Office). Would the US agent have the right to practice before the Spanish Patent and Trademark Office in its capacity as ISA and IPEA?

A: If the US agent is being appointed for the whole of the international phase, he is also entitled to represent the applicant before the Spanish Patent and Trademark Office as ISA and IPEA (see PCT Rules 90.1(a) and 83.1bis(a) and (b)).

In principle, the question of who is entitled to represent the applicant(s) for a specific international application during the whole of the international phase is linked to the receiving Office with which the application was filed, and not to the Office which acts as ISA and/or IPEA. Each receiving Office determines who may practice before that Office. According to PCT Rule 90.1(a), a person having the right to practice before the national (or regional) Office with which the international application is filed may be appointed by the applicant as agent to represent him/her before the receiving Office (RO), the International Bureau (IB), the ISA and the IPEA.

As far as international applications filed with the IB as receiving Office (RO/IB) are concerned, any person who has the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant is a resident or national may be appointed as agent in respect of the international application before RO/IB, the IB in any other capacity, and before the competent ISA and IPEA (see PCT Rule 83.1bis(b)).

Thus, in the case referred to in last month's "Practical Advice" where the international application was to be filed with RO/IB, the applicant would have been able to appoint as agent any person who has the right to practice before the Mexican Institute of Industrial Property or the United States Patent and Trademark Office as receiving Office, and that person would automatically be entitled to act before the IB, the ISA and/or IPEA, whichever Authority is chosen.

Notwithstanding, it is possible to appoint a second agent to represent the applicant specifically before the ISA and/or IPEA, although in such a case, the right to practice would no longer be determined by the receiving Office, but rather, would be determined by the rules applicable in the national or regional Office

acting as ISA or IPEA (see PCT Rule 90.1(b) and (c)). For information on the right to practice before national Offices, see the relevant National Chapter Summary of the *PCT Applicant's Guide* (www.wipo.int/pct/guide/en/index.html). In case of uncertainty, the Authority in question should be contacted directly.

Further information on the appointment of agents specifically before the ISA and IPEA will be published in another "Practical Advice" soon.

2008-04

Appointing agents before the International Searching and Preliminary Examining Authority

Q: The firm of European patent attorneys with which I work erroneously filed an international application, for which the only applicant was neither a resident nor a national of a member State of the European Patent Convention, with the European Patent Office (EPO) as receiving Office. The application was subsequently transmitted by the EPO to the International Bureau as receiving Office (RO/IB) under PCT Rule 19.4(a)(i). Is it possible for my firm to act as agent for the applicant before RO/IB, or will the applicant have to appoint an agent from his country of nationality or residence? If we cannot act as agent before RO/IB, can we be appointed as agent before the EPO in its capacity as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA), specifically for the purposes of international search and preliminary examination? (The EPO is a competent ISA and IPEA for this application.)

A: It is recalled that, under PCT Rule 83.1bis(a), in order to be able to represent the applicant before RO/IB, the agent must have the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant is a resident or national. It is unlikely that your firm of patent attorneys would be entitled to represent the applicant unless there is somebody who is a patent attorney or patent agent registered before the Office concerned (see under the relevant receiving Office in the *PCT Applicant's Guide*, Receiving Offices, Annex C) (www.wipo.int/pct/guide/en/index.html), and so if the applicant is going to appoint an agent, it must be one who fulfils that requirement.

You do, however, have the option of being appointed, under PCT Rule 90.1(b) and (c), as agent specifically for the purposes of search and examination before an ISA and IPEA. Any agent may be so appointed, irrespective of the receiving Office with which the application was filed and irrespective of any agent who is entitled to act for the application concerned under PCT Rule 90.1(a) for the entire international phase, provided that he/she has the right to practice before the national Office or intergovernmental organization which acts as ISA/IPEA (for information on who has the right to practice before a national or regional Office, see the relevant National Chapter (Summary) of the *PCT Applicant's Guide*, or contact the Office concerned). In your case, since you have the right to practice before the EPO in its capacity as ISA and

IPEA, the applicant could appoint you as agent specifically before the EPO.

In practice, it is not absolutely necessary to appoint an agent specifically for the purposes of international search since there is no dialogue with the ISA during the search procedure and an agent would not normally file any document directly with the ISA (amendments under PCT Article 19 are filed with the IB by the applicant or the agent entitled to act before the receiving Office). Such an agent would simply receive the international search report and the written opinion of the ISA. During the international preliminary examination procedure, however, the agent may need to respond to the written opinion of the IPEA or have a dialogue with the examiner. In the case where an additional person is appointed specifically for the procedure before the IPEA, all notifications issued by the IPEA will be addressed only to that additional person, and not to any agent appointed in general for the purposes of the international phase. Note, however, that such an agent would only be able to take action concerning the international preliminary examination procedure, and would not be entitled, for example, to withdraw the international application.

In order for you to be appointed in this way, a separate power of attorney would normally have to be submitted directly to the ISA and/or IPEA, as the case may be (see PCT Rule 90.4(b)). Note, however, that a power of attorney may not be required where the ISA/IPEA has waived the requirement to furnish a power of attorney (PCT Rule 90.4(d))—see the table entitled “Waivers: Powers of Attorney” at:

www.wipo.int/export/sites/www/pct/en/texts/pdf/p_a_waivers.pdf

For further information on the particular instances in which a power of attorney is required by the EPO, see the *Official Journal of the EPO*, No. 5/2004, page 305, at:

www.european-patent-office.org/epo/pubs/oj004/05_04/05_3054a.pdf

Instead of submitting a power of attorney to appoint an agent before the IPEA, the appointment can also be made simply by way of the applicant signing the demand for international preliminary examination (Form PCT/IPEA/401) in which the agent is named in Box No. III as “agent specifically for the procedure before the IPEA”.

2008-05 The transmittal of notifications to applicants by e-mail

Q: I am going to file a number of international applications on behalf of several applicants in the next few months. Later in the year, I will have to spend a few months away on business, and am worried about whether being away from my office will hinder my ability to properly follow-up the progress of the applications concerned. Is there any way that I can request that correspondence relating to the international application be sent to my e-mail address, and that I can deal with any follow-up matters by e-mail?

A: Until now, it has not been possible for the International Bureau (IB) to use e-mail as a form of communication in respect of specific international applications.

However, **as of 1 July 2008**, the request form (PCT/RO/101) will contain a new field in Boxes Nos. II and IV that will allow applicants or agents to include an e-mail address with their international applications. Next to that field will be a check-box, which, if marked, will authorize any PCT Authority (the receiving Office (RO), the IB, the International Searching Authority (ISA) and the International Preliminary Examining Authority (IPEA)) to send by e-mail, if they so wish, advance copies of notifications in respect of the international application to the applicant or agent. This authorization will also be added to the request form which is completed when using the PCT-SAFE software. Upon receipt of such an authorization, the IB would be in a position to send you such advance copies of any notifications or invitations by e-mail. Whether other PCT Authorities will also do so will depend on the PCT Authority concerned. The IB will notify PCT users which Authorities have announced their willingness to participate in this form of advance communication, to the extent that it is informed of this.

Note that if the checkbox referred to above is not marked, or the applicant or agent's express authorization is not given in some other way, for example, in a separate letter, the e-mail address can only be used for communications for which telephones or fax would otherwise have been used (for example, rapid informal communications with applicants (see PCT Rule 4.4(c), third sentence).

Such advance e-mail communications will not replace paper notifications sent by mail as usual, which will remain the legal copy of the notifications. The e-mail communication will be an additional service to the applicant, which will, in effect, serve as an advance warning of any possible action to be taken, and will help to reduce the effects of delays in the dispatching and delivery of the paper notification to the recipient. It may also give the applicant extra time in view of the fact that the time limit given for responding to an invitation is calculated from the date of mailing of the paper version of the communication.

The IB is planning to send such advance communications only to a single e-mail address (per international application). This means that, where the e-mail authorization is given in respect of both an applicant and an agent, the IB will send e-mail communications only to the appointed agent (or common representative where no agent has been appointed). The recipient of the e-mail will be responsible for forwarding the contents of that e-mail to any other person who may need to receive it.

It is very important to note that, for the moment, it will not be possible for you, as agent (or the applicant) to reply by e-mail to the IB, and any such e-mail received by the IB would not be accepted by it. For the time being, you will be obliged to continue to reply by mail, or where accepted by the Authority concerned, by fax. Information on the forms of telecommunication, if any, by which PCT Offices and Authorities are prepared to

receive documents, is published in the *PCT Applicants Guide*, Annex B (General Information) at:

www.wipo.int/pct/guide/en/index.html

Please also note that, for technical reasons, the IB will begin by only sending certain forms by advance e-mail. Some of the forms which you can expect to receive in this way initially are: Forms PCT/IB/301, PCT/IB/306, PCT/IB/307 and PCT/IB/345.

Progressively, additional forms will be added towards the end of the year, for example, Forms PCT/IB/304, PCT/IB/308 and PCT/IB/311.

For any international applications filed before 1 July 2008, it will be possible, **on or after 1 July 2008 only**, to submit to the IB an e-mail address for that application, together with an express authorization for the RO, the ISA, the IB and IPEA to use the e-mail address to send advance copies of notifications in respect of the international application. The addition of the e-mail address can be requested under PCT Rule 92*bis* (recording of changes in certain indications in the request or the demand). If the e-mail address is to be registered for multiple cases, you may wish to send a single letter to the IB listing each international application concerned, noting that a separate letter should be written for each appointed agent (unless a group of agents has been appointed together). Similarly, if you wish later to change the e-mail address already given in the request form, it will be possible to do this by requesting the IB to record a change under PCT Rule 92*bis*. For further information on requesting the recording of a change under PCT Rule 92*bis*, see the *PCT Applicant's Guide*, paragraphs 427 to 431

(www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf), and the "Practical Advice" in *PCT Newsletter* Nos. 05/2002, 08/2002, and 07/2005

(www.wipo.int/pct/en/newslett/year.jsp).

This new advance notification service is, in effect, a precursor to a new system that WIPO is in the process of developing whereby PCT applicants will be able to securely log in to a private file inspection system, which will allow them to inspect the file of their international application and obtain correspondence in this way, prompted by an e-mail notifying them that such correspondence has been issued. Further information on this private file inspection system will be given later, when it is at a more advanced stage of its development.

2008-06

Signature requirements for withdrawals of designations

Q: When I, as agent, filed an international application two months ago, claiming the priority of a national application filed in Japan (JP), I forgot to check the box under Box No. V "Designations" to the effect that JP is not designated for any kind of national protection, which I should have done in order to avoid the ceasing of the effect, under the national law, of the earlier application. I must therefore withdraw the designation of JP within 15 months from the earlier filing date, which leaves me very little time to do this. Bearing in mind that the only applicant for the purposes of the

designation of JP is the corporate applicant, I presume that, for the purposes of the signature of the notice of withdrawal, it is not also necessary to obtain the signatures of the applicant/inventors who are only applicants for the designation of the United States of America (US)? Is my presumption correct, according to the PCT? (Note that the request form was not signed by the applicants and, in view of the fact that the receiving Office has made a waiver of the requirement to furnish a power of attorney, a power of attorney has not been furnished.)

A: According to PCT Rule 90*bis*.5(a), any notice of withdrawal, including the withdrawal of a designation, must be signed by the applicant or, if there are two or more applicants, **by all of them**. The notice of withdrawal of the JP designation would therefore require the signature of all applicants, regardless of the fact that the applicant/inventors are only applicants for the US designation, and are not also applicants for the JP designation. Even if the corporate applicant is considered to be the common representative under PCT Rule 90.2(b) (the "deemed common representative"), it cannot sign a notice of withdrawal on behalf of the other applicants.

Note that even though a waiver has been made by the Japan Patent Office in its capacity as receiving Office, a waiver never applies in respect of any notice of withdrawal under PCT Rules 90*bis*.1 to 90*bis*.4 (see PCT Rule 90.4(e)); if a notice of withdrawal is not signed by all applicants, a power of attorney is required, signed by all applicants.

The only exception to the requirement that the applicant/inventors must sign the notice of withdrawal of the designation mentioned above is as follows: according to PCT Rule 90*bis*.5(b), where the applicant/inventors concerned had designated a State whose national law requires that national applications be filed by the inventor (namely, the US), and where the applicant for that designated State who is an inventor could not be found or reached after diligent effort, the notice of withdrawal under PCT Rule 90*bis*.2 need not be signed by that applicant if it is signed by at least one applicant, and

- a statement is furnished explaining, to the satisfaction of the receiving Office or the International Bureau, as the case may be, the lack of signature of the applicant concerned; or
- if the request was signed by at least one applicant and a statement was furnished explaining, to the satisfaction of the receiving Office, the lack of signature of the request.

Even though the requirement to submit a power of attorney may have been waived by the receiving Office, and even though it is acceptable for only one of several applicants to sign the request to satisfy the signature requirement (see PCT Rules 4.15(a) and 26.2*bis*(a)), agents or common representatives should carefully consider whether they should in any case obtain the signatures of all applicants, either by way of signing a power of attorney or by way of signing the request. By obtaining those signatures in advance, any withdrawal, which requires the signatures of all of the applicants or a power of attorney signed by all of the

applicants, could be dealt with by the relevant office/authority immediately, and delays caused by waiting for signatures would not be incurred. Even if those signatures are not actually submitted by the agent/common representative, but are merely kept in the file of the agent/common representative, at least they would be available if they were needed later.

For further information on withdrawals in general, see the *PCT Applicant's Guide*, paragraphs 452 to 463 at: www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf and for further information on the withdrawal of designations, see the "Practical advice" in *PCT Newsletter* No. 2/2004:

www.wipo.int/edocs/pctndocs/en/2004/pct_news_2004_2.pdf

2008-07

Withdrawal of an international application after international publication but before the issuance of the ISR.

Q: I recently tried to withdraw an international application before it was published, but, unfortunately, my notice of withdrawal was received by the International Bureau (IB) too late to prevent its publication. Since the International Searching Authority (ISA) had not yet issued the international search report (ISR) when the international application was published, it was published without the ISR. Given that international applications published prior to the issuance of the ISR are normally republished later with the ISR, would it be possible, in my case, to prevent publication of the ISR in view of the fact that the international application has been withdrawn?

A: Once your international application has been published, you cannot prevent the later publication of the ISR – the ISR must, according to PCT Rule 48.2(a)(v), form part of the published international application, regardless of whether there has been an intervening notice of withdrawal of the application. Your international application will have been published with an annotation to the effect that the ISR (or declaration by the ISA to the effect that no ISR will be established) was not available at the time of completion of technical preparations for publication, and the ISR (or declaration) will be published separately after it has been received by the IB (PCT Rule 48.2(g)).

The only way in which you could have been certain of stopping the publication of the ISR, as well as the publication of the rest of the international application, would have been to ensure that your notice of withdrawal reached the IB before the completion of technical preparations for international publication (PCT Rule 90bis.1(c)). It is recalled that this is normally 15 calendar days before the actual publication date. (For a good indication of the earliest potential date for international publication for a given application – which, in accordance with PCT Article 21.1(a), is normally promptly after the expiration of 18 months from the priority date – refer to the PCT Time Limit Calculator at: www.wipo.int/pct/en/calculator/pct-calculator.html). It is always recommended that applicants notify the IB of

any withdrawal as early as possible before completion of technical preparations for publication, preferably by using Form PCT/IB/372 "Notice of withdrawal" and sending it by fax, making sure that the notice of withdrawal is signed by all applicants, or if signed by the agent, that the agent has been duly appointed by all applicants.

Notwithstanding, when the ISA is informed by the IB that the international application has been withdrawn (Form PCT/IB/307), the ISA is entitled to immediately discontinue the processing of the application and is no longer obliged to establish an ISR. In such a situation, if the ISA does not establish an ISR, the IB would not request the ISA to do so, and no republication of the international application would take place. There is no guarantee that this would be the outcome in any given case, however. (For information on refunds, where applicable, of the search fee where the international application has been withdrawn before the start of the international search, see the relevant part of Annex D of the *PCT Applicant's Guide*.)

Note that a withdrawal of an international application can be made on the condition that it is to be effective only if the notice of withdrawal is received by the IB before completion of the technical preparations for international publication, and therefore in time to stop international publication of the application (see *PCT Applicant's Guide*, International Phase, paragraph 453) – Form PCT/IB/372 contains a special check box for this purpose.

For further information on the publication and withdrawal of international applications, see the *PCT Applicant's Guide*, International Phase, paragraphs 304 to 318B and 452 to 463, respectively.

2008-08

The consequences of a finding by the ISA of lack of unity of invention

Q: I have received Form PCT/ISA/206 ("Invitation to pay additional fees and, where applicable, protest fee") from the International Searching Authority (ISA) in respect of an international application, stating that there are three inventions claimed in the application. I have therefore been invited to pay two additional search fees to cover each additional invention. I do not agree with the finding by the ISA of lack of unity of invention. What will happen if I fail to pay the additional search fees? If I pay only one additional fee, can I choose which additional invention I wish to be searched? Is it possible to protest against the ISA's finding of lack of unity?

A: According to PCT Rule 13.1, the international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). The search fee is intended to cover the cost for the ISA to carry out an international search on the international application, but only to the extent that the international application meets the requirement of "unity of invention". Therefore, if that requirement is not met, the ISA is entitled to request the applicant to pay an additional search fee for each invention beyond the first which is to be searched (see PCT Rule 40.1).

Further details on the requirement of unity of invention can be found in the Administrative Instructions under the PCT, [Annex B](#), at:

www.wipo.int/pct/en/texts/ai/annex_b.html

as well as in the *PCT Applicant's Guide*, International Phase, [paragraphs 129–138](#) at:

www.wipo.int/pct/guide/en/index.html

Consequence of the failure to pay the additional search fees

As in your case, ISAs will invite the applicant to pay additional search fees by way of Form [PCT/ISA/206](#). Some ISAs will attach to that invitation the results of a “partial” international search (this is not to be confused with the international search report (ISR)), limited to the invention first mentioned in the claims (the “main invention”) (see [PCT Article 17\(3\)\(a\)](#)).

If you fail to pay the additional search fees within one month from the date of mailing of the invitation (note that this time limit cannot be extended), no searches of additional inventions will be made and the ISR, when it is established, will only cover the first claimed invention (where a partial search was furnished to the applicant, the results of that partial search only will be included in the ISR). If you do not pay all requested additional search fees, the ISA will only search the number of inventions covered by the payment — upon payment, it should be possible for you to specify to the ISA which claims you wish to be searched. If you pay all the additional fees within the applicable time limit, the ISR will include the results of the search of all inventions in the application.

If you disagree with the ISA's finding under [PCT Rule 40](#) of lack of unity of invention (or, in the number of additional search fees that you have been invited to pay), you may, under [PCT Rule 40.2\(c\)](#), protest against that finding, as explained below.

Protest procedure and, where applicable, protest fee

In order to initiate the protest procedure, you must pay the additional search fees within the time limit fixed by the ISA in Form [PCT/ISA/206](#) (one month) for all inventions in respect of which you are still interested in receiving an ISR, and send a reasoned statement explaining why you consider that unity of invention has been complied with, or that the number of additional fees required is excessive. After payment of the fees, your protest will then be examined by a review body constituted in the framework of the ISA, which, if it finds your protest justified, would order the total or partial reimbursement to you of the additional fees.

In accordance with [PCT Rule 40.2\(e\)](#), such a protest may also be subjected by the ISA to the payment of a “protest fee” (currently, only five International Searching and Preliminary Examining Authorities charge such a fee. For details, consult the [PCT Applicant's Guide](#), Annex D, for the ISA concerned). Note however that, although an additional search fee is required for each separate invention, only one protest fee is payable, where applicable, regardless of the number of additional search fees that you have been invited to pay. The protest fee is refunded if the review finds that the protest was fully justified. If you fail to pay the protest fee within the applicable time

limit, the ISA will declare that the protest has been considered not to have been made.

2008-10

Seeking patent protection via the PCT in respect of States which have recently joined a regional patent organization

Q: On 5 December 2007, I filed an international application claiming the priority of an earlier application filed on 15 December 2006. I will be entering the national phase in the various States that interest me before 15 June 2009. In view of the fact that Norway, which was designated in my application for a national patent, became a member State of the European Patent Organisation on 1 January 2008, is it possible to obtain a European patent for Norway, instead of entering the Norwegian national phase separately before the Norwegian Industrial Property Office?

A: Under [PCT Rule 4.9\(a\)](#), the filing of the request constitutes the designation of all Contracting States that are bound by the PCT on the international filing date, for the grant of each kind of protection available, and for the grant of both regional and national patents. Since your international application was filed on 5 December 2007, a regional designation for a European patent (“EP designation”) and a national designation for Norway will have been included; the EP designation does not, however, include Norway as it was not a member State of the European Patent Organisation at that time. Although Norway became a member of the European Patent Organisation on 1 January 2008, before the date on which you will enter the national phase under [PCT Article 22\(1\)](#) (or [39\(1\)](#)), it is the international filing date which determines which States are designated, which type(s) of protection is/are being sought, and which national or regional patents are being sought ([PCT Rule 4.9\(a\)](#)). An EP designation is, in effect, the designation of those States that are, at the date of filing of the PCT application, members of both the European Patent Organisation and the PCT – it is not possible to add a State to a regional designation after the international filing date of the application concerned (in the same way that it is not possible to add a designation for the purposes of obtaining a national patent).

If you wish to obtain patent protection in Norway on the basis of your PCT application, it will be necessary to pursue a national patent by entering the national phase directly before the Norwegian Industrial Property Office^[1].

Any PCT application filed on or after 1 January 2008, the date on which Norway became a member of the European Patent Organisation, will automatically include the designation of Norway for the purposes of obtaining a European patent as well as a national patent, and applicants of those applications have the choice of whether to enter the national phase in Norway or whether to seek protection in that State via a European patent.

It is important that applicants and their agents be vigilant as to which Contracting States are covered by a regional patent when they enter the national phase, to ensure that they do not make the mistake of

presuming that they will be able to obtain a regional patent in a particular State, when they should in fact be taking the necessary steps to enter the national phase in that State directly with the national Office concerned.

2008-11

Payment of fees to the International Bureau as receiving Office when filing international applications with that Office on a regular basis

Q: The company I work for files several international applications a month, and since our usual receiving Office does not accept international applications filed electronically, we have decided to start filing our international applications electronically with the International Bureau as receiving Office; by doing this, we will be able to benefit from the fee reductions associated with filing applications electronically. Given that we will have to pay fees to the International Bureau as receiving Office on a regular basis, is it possible to open an account with the International Bureau for that purpose, and would that account serve for the payment of other fees to WIPO?

A: It is possible to open a current account in Swiss francs with WIPO, and to authorize the charging of that account when paying fees to the International Bureau as receiving Office (RO/IB), and may be worthwhile to do so if you file international applications on a regular basis with the RO/IB. Please be aware that the holding of an account at another receiving Office is not sufficient to enable payments to be made to the RO/IB – you must hold an account with WIPO.

One advantage of having a current account with WIPO is that it facilitates fee payments as there is a section on the fee calculation sheet annexed to the request form specifically for authorizing the receiving Office to charge the applicant's account at WIPO. If the filing is made using the PCT-SAFE software, whether filing in fully electronic form or on paper with the request in PCT-EASY format, the PCT-SAFE software also allows applicants to authorize the charging of their WIPO account (see the "Payment" page of the Electronic Request).

Furthermore, if you have a WIPO current account and have marked the appropriate check-box of the fee calculation sheet (the second check-box in the authorization section) or selected the appropriate box in the above-mentioned payment page of the PCT-SAFE software, and there is a mistake in the calculation of the fees due upon filing, the receiving Office will be authorized to charge any deficiency (or credit any overpayment, as the case may be) in the fees you have calculated, without the need for it to invite you to pay the extra amount, and for you to arrange for a second payment. This saves time and effort for both parties, and reduces the risk of loss of rights for the applicant. Each time fees have been charged to your account, you will receive confirmation of payment by way of Form PCT/RO/102.

Note that, although current accounts at WIPO are held in Swiss francs only, deposits are accepted in other currencies, provided that that currency is freely

convertible into Swiss francs – the amount of that deposit would then be converted into Swiss francs according to the prevailing rate of exchange.

If you hold a current account, you must ensure that you have adequate funds to cover all charged fees. Thus, the amount that you credit to the account will need to be sufficient to cover international filing and search fees.

A current account at WIPO can also be used for other purposes, for example:

- the payment of other RO/IB fees, such as the fee for the establishment of a priority document by that Office (PCT Rule 21.2);
- the payment of fees to the IB other than in its capacity as receiving Office, such as the early publication fee (PCT Rule 48.4(a));
- the payment of fees related to other forms of intellectual property protection, for example the registration of marks under the Madrid System or the registration of industrial designs under the Hague System; or
- the purchase of WIPO publications.

If you wish to make use of your WIPO current account to pay fees other than those which are due upon filing a PCT application (and are therefore not making use of the authorization boxes on the fee calculation sheet or in the PCT-SAFE software), a written authorization must be made which should clearly identify the purpose of the payment, the number of your WIPO current account, and, where applicable, any particulars necessary to identify the application in respect of which payment is being made, namely: the name of the applicant, the file reference or, if known, the international application number.

Note that the following modes of payment to WIPO are also possible:

- by bank transfer to WIPO's bank account (for payments in Swiss francs, US dollars or euro);
- by credit card (in the case of PCT applications filed with the RO/IB, using Form PCT/RO/197; if using the PCT-SAFE software, that software provides for a secure means for furnishing the credit card details to the RO/IB);
- by transfer to WIPO's postal account (for payments in Swiss francs only);
- by check made payable to the World Intellectual Property Organization (for payments in Swiss francs, US dollars or euro) (consideration is currently being given to the elimination of this payment method).

For further details on how to pay using the above-mentioned modes of payment, see:

<http://www.wipo.int/pct/en/filing/modes.htm>

and for information specifically about the opening of a current account at WIPO, see:

<http://www.wipo.int/pct/en/filing/account.htm>

or contact our finance department by e-mail at: income.accounts@wipo.int.

2008-12

International applications in respect of which a supplementary international search may be requested; how to request such a search.

Q: I have filed an international application claiming the priority of an earlier application filed on 11 June 2007.

Will it be possible for me to take advantage of the new supplementary international search service that will start up on 1 January 2009, or is it only available for international applications filed on or after that date? If I am eligible to request a supplementary search, please could you tell me how to do this?

A: The new supplementary international search service will be available not only to international applications filed on or after 1 January 2009, but also to existing international applications where the time limit for requesting supplementary international search (SIS) has not yet expired (PCT Rule 45bis.1(a)). The time limit for requesting SIS is 19 months from the priority date (or international filing date, if the application does not claim the priority of an earlier-filed application). Therefore, this new service will be available for any international application with a priority date on or after 1 June 2007.

It is expected that requests for SIS will normally be made after the applicant has received and assessed the main international search report, but this does not necessarily have to be the case (and will, unfortunately, sometimes not be possible where the main international search report is issued late). You should request SIS using Form PCT/IB/375, which should be filed with the IB and not sent directly to any of the Authorities specified for SIS. Form PCT/IB/375 is now available, in editable PDF format, on the PCT Resources page at:

http://www.wipo.int/pct/en/forms/2009/ed_ib375.pdf

When completing the supplementary search request form, you should select the International Searching Authority (ISA) which is to carry out the SIS, noting that this must be one of the three ISAs which are offering the SIS service from 1 January 2009, and that it cannot be the ISA which has carried out the "main search" under PCT Article 16(1). It is possible to have more than one SIS carried out on the same application (PCT Rule 45bis.1(a)), however, if you want to do this, a separate supplementary search request should be submitted for each SIS requested.

The fees for SIS, the supplementary search fee and the supplementary search handling fee, should be paid to the IB, in Swiss francs, within one month from the date on which the supplementary search request is received by the IB.

This request may need to be accompanied by:

- a translation of the international application into a language accepted by the Authority if the international application is not in such a language and the receiving Office has not yet forwarded a translation under PCT Rule 12.3 or 12.4; and/or

- a copy of any sequence listing in an acceptable electronic form if such a listing was not originally provided in the international application.

In accordance with PCT Rule 92.2(d), you must file the supplementary search request in English or French.

If your supplementary search request is received by the IB after the expiration of the applicable time limit, it will be considered not to have been submitted and there are no provisions for extending this time limit.

For further information, see:

- the item entitled: "New PCT Service: Supplementary International Search" in this issue

- Form PCT/IB/375 and in particular the Notes to that form, available at:

http://www.wipo.int/pct/en/forms/2009/ed_ib375.pdf

2009-01

Assignment of an international application to an applicant who is neither a national nor a resident of a PCT Contracting State

Q: I have filed an international application on behalf of a corporate applicant, which is a national and resident of Spain. The company now wishes to assign the rights to the invention to another company which is a national and resident of Uruguay. There are also two applicant/inventors named in the international application for the purposes of the US designation, but they are not nationals or residents of a PCT Contracting State either. Will the PCT application still be valid if there are no longer any applicants who are nationals or residents of a PCT Contracting State? If so, which corporate applicant will appear in the published international application?

A: A PCT application can be assigned at any time during the international phase, to anyone, including residents and nationals of States which are not bound by the PCT. The requirement under PCT Article 9 that the applicant must be a resident or national of a PCT Contracting State only needs to be complied with on the international filing date. Later changes have no influence on the validity of the international application itself.

An assignment to a resident or national of a State which is not bound by the PCT may, however, have consequences on the right to file a demand for international preliminary examination under Chapter II if the demand is filed after the recording of the change in the person of the applicant under PCT Rule 92bis. A demand may only be filed if the applicant (or at least one of the applicants, if there are more than one) is a resident or national of a PCT Contracting State bound by Chapter II and the international application was filed with the receiving Office of or acting for such a State (see PCT Article 31(2)(a) and Rules 54.1 and 54.2). Since the new applicant would be neither a resident nor a national of a PCT Contracting State, it would not be entitled to file a demand for international preliminary examination under Chapter II. Therefore, in order for a demand to be validly filed, it would have to be filed in the name of the Spanish applicant, before the recording of the change in the person of the applicant under PCT Rule 92bis; any subsequent assignment of the international application would have no consequence on the validity of the demand.

Note that if you are going to represent the new applicant, that applicant should sign a power of

attorney appointing you. Ideally, this should be submitted together with the request for recording of the change of applicant. The International Bureau (IB) will record any such requested change provided it is received by it before the expiration of 30 months from the priority date.

As far as the publication of information concerning the applicant is concerned, if the request for the recording of a change of applicant is made and recorded at the IB prior to completion of technical preparations for publication, the name of the new applicant will be included on the front page of the published international application in the PATENTSCOPE® search service

(<http://www.wipo.int/pctdb/en/index.jsp>); if it is received by the IB after completion of the technical preparations for international publication, the published international application will include the name of the original applicant. In both cases, however, the bibliographical data will include (or be updated to include, as the case may be) the name of the new applicant (under the “Biblio. Data” tab of the international application concerned). The request as filed (Form PCT/RO/101), which includes the name of the original applicant, and the IB’s “Notification of the Recording of a Change” (Form PCT/IB/306) concerning this change will, in accordance with PCT Rule 94.1(b), be accessible to third parties after international publication. These documents are available in the PATENTSCOPE® search service (under the “Documents” tab) for all international applications whose filing date is on or after 1 January 2006. For earlier filed international applications, a quick comparison between the applicant’s name under the “Biblio. Data” tab and the one which appears under the “Documents” tab, allows third parties to see if a request under PCT Rule 92bis was recorded by the IB.

2009-02

The appointment of agents having the right to practice before an Authority specified for supplementary international search

Q: I am the agent in respect of an international application, and have appointed a sub-agent to act specifically for the purposes of the procedure before the International Searching Authority (ISA), and will be appointing that same agent to act specifically for the procedure before the International Preliminary Examining Authority (IPEA), which will be the same Office as the ISA. Because of the nature of the technology and the potential importance of the invention, I feel that the international application would benefit from a supplementary international search, and would therefore like to know whether the above-mentioned sub-agent can also act as agent for the purposes of the procedure before the Authority specified for supplementary international search?

A: Although it is not really necessary to appoint an agent specifically for the purpose of supplementary international search (SIS) (there would not normally be any dialogue between that Authority and an agent, and only a limited number of documents, if any, may need to be submitted to that Authority (for example, where required, a copy of any sequence listing in electronic

form or a translation into a language accepted by the Authority which is to carry out the SIS)), you do have the option of appointing such a sub-agent, and may wish to, especially if you have already appointed such a sub-agent for the purposes of international search and preliminary examination.

Note, however, that according to PCT Rule 90.1(d)(ii), you may only appoint a sub-agent to act as agent specifically for the purposes of the procedure before the Authority specified for supplementary international search (SIS) if that sub-agent has the right to practice before the national Office or the intergovernmental organization (henceforth referred to as “Office”) which acts in that capacity. If this is the case, you will be able to widen the scope of the existing sub-agent’s appointment to cover the procedure before the Authority specified for SIS. To do this, you should mark the third check-box under Box No. III of the supplementary search request form (PCT/IB/375) and fill in that agent’s details in that Box.

If the existing sub-agent does not have the right to practice before the Office which acts as an Authority specified for SIS, you would be able to act as general agent for the purposes of the procedure before that Authority (as, unless otherwise specified by the applicant, you have the right to practice in respect of the whole of the international procedure), since, according to PCT Rule 90.1, a person having the right to practice before the Office with which the international application is filed (or, where the international application is filed with the International Bureau (IB), having the right to practice in respect of the international application before the IB (see PCT Rule 83.1bis)), may be appointed by the applicant as his agent to represent him before the receiving Office, the IB, the International Searching Authority, any Authority specified for SIS and the International Preliminary Examining Authority. In this situation, you would mark the first check-box under Box No. III of the supplementary search request and fill in the necessary parts of that Box.

If you wish, you also have the option of appointing a further sub-agent who has the right to practice before the Office or organization which acts as the Authority specified for SIS (PCT Rule 90.1(d)(ii)), in which case you should mark the third check-box under Box No. III of the supplementary search request and provide the necessary details of that new agent. Since you, as appointed agent of the international application, would be appointing the sub-agent, the signature of the applicant would not be required. Note that the sub-agent would only be able to take action concerning the SIS procedure, and would not be entitled to take action on any other matters.

For information on who has the right to practice before a national or regional Office, see the relevant National Chapter (Summary) of the *PCT Applicant’s Guide* (<http://www.wipo.int/pct/guide/en/index.html>) or contact the Office concerned; for further information on the appointment of sub-agents, see *PCT Applicant’s Guide*, International Phase, paragraphs 81 and 413; and for further information on the new SIS service, see PCT Rule 45bis and *PCT Newsletter No. 12/2008*, pages 1-3 and 14-15.

2009-03

Payment of additional preliminary examination fees in case of earlier finding of lack of unity of invention by the International Searching Authority

Q: The International Searching Authority (ISA) considered that an international application for which I am acting as agent did not comply with the requirement of unity of invention as it contained two separate inventions, and invited me to pay an additional search fee to cover the cost of carrying out a search in respect of the second invention. I therefore paid the additional fee and had all the claims searched. In view of the above, do I automatically have to pay an additional preliminary examination fee to the International Preliminary Examining Authority (IPEA) if I decide to file a demand for international preliminary examination?

A: It is recalled that, according to PCT Rule 13.1, the international application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where the ISA finds lack of unity of invention, the IPEA may also find lack of unity of invention, especially if the IPEA is the same Office as the ISA.

Even though it is likely, therefore, that the IPEA will also invite you, in accordance with PCT Rule 68.2, to pay an additional fee for the second invention in the context of international preliminary examination (or otherwise, to restrict the claims), there is a chance, especially if the IPEA is not the same Office as the ISA, that the IPEA may come to a different conclusion concerning the lack of unity, and may not require payment of additional fees. You therefore do not need to automatically pay the additional preliminary examination fee, as the IPEA may not necessarily invite you to pay that fee.

Another reason why you need not pay that fee automatically is that, under PCT Rule 68.1, the examiner has the option of examining any further inventions without inviting restriction of the claims or payment of additional fees where, for example, compared with the procedure of inviting the applicant, no or little additional effort is involved in establishing the international preliminary report on patentability (Chapter II of the Patent Cooperation Treaty) (hereinafter: report) for the entire application. The examiner may draw this conclusion in view of the fact that the majority of the work in creating a written opinion on the additional inventions will have been done by the search examiner, and the Chapter II examiner will in any case have already reviewed at least the independent claims in order to confirm the view on unity of invention. Whether or not the examiner invites payment of additional fees may also depend on the extent and complexity of any amendments which need to be taken into account for the international preliminary examination. Where the examiner proceeds with the preliminary examination without requesting any additional fees, he establishes the report on the entire international application, but indicates in the report his opinion that the requirement

of unity of invention is not fulfilled and the reasons therefor.

In any case, if the IPEA is not prepared to examine all claims of the application without the payment of additional fees, it will invite you under PCT Rule 68.2, by way of Form PCT/IPEA/405, to either restrict the claims or pay such fees before establishing the report. If you fail to take either of these two actions, the report will only cover the first invention.

Therefore, in the case you describe, you may wish to wait and see whether you are going to be invited to pay additional fees also during international preliminary examination, or, as a practical matter, to save time you may wish to raise the matter with the IPEA examiner at the time of filing the demand. As stated above, whether or not you will be invited to pay an additional fee will be closely linked to whether or not the IPEA is the same as the ISA, and/or to the scope of amendments made when filing the demand for preliminary examination.

For further information, see paragraph 10.76 of the International Search and Examination Guidelines at:

<http://www.wipo.int/pct/en/texts/pdf/ispe.pdf>

the *PCT Applicant's Guide*, International Phase, paragraph 398 at:

<http://www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf> and the "Practical Advice" in *PCT Newsletter* Nos. 08 and 09/2008.

2009-05

Declaration of non-establishment of international search report: possible actions in the case of other related PCT applications filed later

Q: I have filed several PCT applications relating to similar inventions, in respect of which I have chosen the same International Searching Authority (ISA) to carry out the search. I have just received from the ISA, in respect of the first of these applications filed, a declaration that no international search report (ISR) will be established for the application due to the fact that it concerns a subject which the ISA will not search. Is it possible to obtain a refund of the search fee for that application? Also, since I fear that I will not be able to get an ISR in respect of the other related applications, is it possible to amend the claims in such a way that the subject matter claimed will change, or failing that, to change the ISA that I initially selected to carry out the international search for one which will search the subject matter concerned?

A: A declaration under PCT Article 17(2)(a) that no ISR will be established can be made if the ISA considers that a meaningful search cannot be carried out because the international application relates to a subject matter which, under the PCT Regulations, the ISA is not required to search and, in the particular case, decides not to search (see PCT Article 17(2)(a)). ISAs often search only subject matter encompassed by the national/regional patent granting procedure under the provisions of their applicable national/regional law. A list of the subject matters which the ISA can decide not to search is provided in

PCT Rule 39.1; information relating to the subject matters which will not be searched by a particular ISA can be found on the relevant page of the *PCT Applicant's Guide*, Annex D; however, for full details, it is preferable to contact the ISA concerned directly. It is recommended that before filing the international application, applicants inform themselves as to which subject matters will not be searched by the ISA they intend to choose.

As far as a refund of the search fee is concerned, the non-establishment of an ISR would not be a reason for an ISA to refund any search fees. The only cases for which a refund of the search fee is provided for are listed under PCT Rule 16.2. For information relating to the applicable conditions for refund for each ISA, refer to the relevant part of Annex D of the *PCT Applicant's Guide*.

The lack of ISR from the chosen ISA due to the fact that it does not search a particular subject matter does not prevent you from requesting a supplementary international search by one of the ISAs specified for that purpose. Note, however, that where the ISA has made a declaration that no ISR will be established, and that declaration is available to the Authority specified for supplementary international search before it starts its search, it may decide not to establish the supplementary international search report (see PCT Rule 45bis.5(e)). For further information on requesting a supplementary international search, see *PCT Newsletter* No. 12/2008, cover page and page 14.

It will not be possible to resolve this issue by amending the claims under PCT Article 19 as it is not possible to file such amendments if no ISR has been established. Also, although you would be entitled to amend the claims under PCT Article 34(2)(b) if you file a demand for international preliminary examination, the International Preliminary Examining Authority is only required to examine the claims which have been searched (see PCT Rule 66.1(e)). You will be given the opportunity to amend the application before each designated or elected Office under PCT Article 28(1) or 41(1), although any amendments must not go beyond what was originally disclosed in the international application.

As far as the other PCT applications are concerned, you cannot amend the claims under PCT Article 19 prior to the receipt of the ISR, and if the ISA issues a declaration that no ISR will be established, you will not be able to file such amendments in respect of those applications either. Also, although the PCT does not specifically provide for a change of choice of ISA, paragraph 115 of the *PCT Receiving Office Guidelines* states that, provided that more than one ISA is competent to carry out the international search, the applicant may make a change to the choice of Authority where the search copy has not yet been transmitted to the ISA.

Note that the lack of an ISR does not, in itself, have any influence on the validity of the international application, the processing of which, including its publication and communication to the designated Offices, continues. For further information on the

consequences of the non-establishment of an ISR, see the "Practical Advice" in *PCT Newsletter* No. 10/2007.

2009-06

International application considered withdrawn by receiving Office after having been accorded an international filing date

Q: I was notified six weeks ago of the receipt of an international application by the receiving Office, and of the according of an international filing date for that application. However, I have just received from that Office a notification under PCT Rule 29.4 that it now intends, in accordance with PCT Article 14(4), to declare the international application withdrawn due to its non-compliance with PCT Article 11(1)(i) (namely, because the applicants do not have the right to file an international application since they are neither nationals nor residents of a PCT Contracting State). If, within one month from the invitation, I cannot find arguments which are accepted by the receiving Office that the applicants have the right to file, the international application will be considered withdrawn. Should this check not have been carried out by the receiving Office before it accorded the international filing date? Can an international filing date once accorded subsequently be taken away so long after the filing of the international application?

A: At the time of receipt of the international application, the receiving Office should indeed check whether the requirements for according an international filing date are fulfilled, including whether the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office (see PCT Article 11(1)(i) and PCT Receiving Office Guidelines, paragraphs 39 and 40). There may, however, be rare cases where the Office concerned fails to detect this defect, or any other defect under PCT Article 11(1), at the time of receipt, and thus erroneously accords an international filing date to the application. Under PCT Article 14(4), the receiving Office is entitled to later declare that the application should be considered withdrawn. Note that, under PCT Rule 29.3, if the receiving Office fails to detect the defect, but the International Bureau or the International Searching Authority does detect the defect and therefore considers that the receiving Office should have made a finding under PCT Article 14(4), it will bring the relevant facts to the attention of the receiving Office.

The receiving Office has up to four months from the international filing date to find that any of the requirements listed in items (i) to (iii) of PCT Article 11(1) was not complied with at the international filing date (PCT Rule 30). After the expiration of this four-month period, the receiving Office may no longer raise this issue.

Before issuing any declaration that the international application is considered withdrawn, the receiving Office notifies the applicant of its intention to issue such a declaration and of the reasons therefor (see

PCT Article 14(1)(b)). Under the PCT Regulations currently in force, this permits the applicant to submit arguments within one month from the notification (see PCT Rule 29.4). As from 1 July 2009, however, the time limit given to the applicants for submitting arguments will increase from one month to two months from the date of the notification of the receiving Office's intention to make the above-mentioned declaration (see PCT Rule 29.4, new subparagraph (a)).

2009-09

Requesting the restoration of the right of priority under PCT Rule 26bis.3 where the receiving Office does not apply such provisions

Q: I filed an international application, which, due to unavoidable circumstances, was received by the receiving Office one year and five days after the date of the only priority claim in the application. In order to safeguard my priority claim, I would have liked to have taken advantage of the provisions under PCT Rule 26bis.3 by requesting the receiving Office to restore the right of priority, however, the receiving Office with which the application was filed has notified under PCT Rule 26bis.3(j) that the above-mentioned rule is incompatible with the national law applied by it. Is there any other way of safeguarding the priority claim?

A: Even if a receiving Office has notified the International Bureau (IB) of the incompatibility of PCT Rule 26bis.3 with its national law, PCT Rule 26bis.2(c)(iii), which is applicable to **all** receiving Offices, provides that a priority claim is not to be considered void for the purposes of the international phase if the international filing date is within two months from the date on which the priority period expired; therefore, the date of the earlier application will still serve as a basis to calculate time limits during the international phase. However, the fact that the priority claim is retained in the international application does not mean in any way that the validity of such a priority claim is assured in the national phase, and by taking no action at this stage, the actions required to remedy the situation before the designated Offices upon entering the national phase may be more cumbersome than those that would be required if you take action now, by requesting the restoration of the right of priority during the international phase before a receiving Office.

To do this, you could request your receiving Office, in accordance with PCT Rule 19.4(a)(iii), to transmit your international application to the International Bureau as receiving Office (RO/IB), it being a competent receiving Office for nationals and residents of all PCT Contracting States. Since the RO/IB has not made a reservation under PCT Rule 26bis.3(j), you would then be able to request the IB, in its capacity as receiving Office, to restore the right of priority, provided that you do this within the time limit of two months from the date on which the 12-month priority period expired.

Note that if you had already submitted a request to restore the right of priority to your national receiving

Office, that Office, as an Office which does not apply PCT Rule 26bis.3, would then, subject to your approval, have requested the RO/IB to agree to the transmittal of the international application to it for further processing (see the PCT Receiving Office Guidelines, paragraph 166A). Any such request would be considered as having been received by the RO/IB in time, provided that it had reached the national receiving Office before the expiration of the applicable time limit under PCT Rule 26bis.3(e).

If the national receiving Office transmits your international application to the RO/IB (whether it be upon your request or otherwise), such transmittal may be subjected to the payment to the national receiving Office of a fee equal to the transmittal fee (see PCT Rule 19.4(b)); other fees paid (for example, the international filing fee and the search fee) will be refunded by the national receiving Office and you will be required to pay the applicable fees (for example, the transmittal fee, the international filing fee and the search fee) to the RO/IB. Note, however, that, although some receiving Offices charge a fee for requesting restoration of the right of priority (PCT Rule 26bis.3(d)), the RO/IB does not charge such a fee. It is recalled that where the national receiving Office transmits an international application to the RO/IB for further processing, that application is considered to have been received by the RO/IB on the date of receipt of the international application by the national receiving Office (see PCT Rule 19.4(b)), although for the purposes of payment of the necessary fees which are due upon filing the international application, the date on which the application was actually received by the RO/IB is considered to be the date of receipt of the international application (see PCT Rule 19.4(c)).

Since, in your case, the request for restoration of a priority claim would be made after the filing of the international application, you should make your request by way of a letter to the RO/IB. Your request for restoration should preferably be accompanied by any declaration or other evidence which may be necessary in support of the statement of reasons for the failure to file the international application within the priority period (see PCT Rule 26bis.3(f)). (Note that if a request for restoration is made at the time of filing, with either the RO/IB or another receiving Office the national law of which is compatible with PCT Rule 26bis.3, there is a special box under Box No. VI of the request form for making such a request – for further information, see the Notes to Box No. VI.) Provided that your request for restoration meets the necessary criteria (the RO/IB applies the “due care” and the “unintentional” criterion to such requests), the RO/IB will notify you of its decision and the criterion for restoration upon which the decision was based.

Please bear in mind, however, that even if the receiving Office restores the priority claim, the validity of that claim cannot be assured in the national phase, notably where the designated Office has notified the International Bureau of the incompatibility of PCT Rule 49ter.1 with its national law, but it may also depend on whether the designated Office applies the same criterion as the receiving Office. Where the

receiving Office has made a finding that the failure to file that international application within the priority period occurred in spite of “due care” having been taken, that restoration is effective in each State (PCT Rule 49ter.1). However, where the receiving Office has restored a right of priority under PCT Rule 26bis.3 based on a finding that the failure to file that international application within the priority period was “unintentional”, the restoration will only be effective in designated States whose applicable national law provides for restoration based on that criterion, or on a criterion which is more favorable than that criterion (PCT Rule 49ter.1(b)).

Another option which is available to you, other than requesting the restoration of the right of priority during the international phase, is to request the restoration of the right of priority before each designated Office (PCT Rule 49ter.2). In accordance with PCT Rule 49ter.2(b)(i), such a request should be made within one month from the time limit under PCT Article 22. Such request will not, however, be accepted by designated Offices which have made a reservation under PCT Rule 49ter.2(h).

For information on which Offices have made reservations in relation to PCT Rules 26bis.3(j) (“Restoration of Right of Priority by Receiving Office”), 49ter.1(g) (“Effect of Restoration of Right of Priority by Receiving Office [in Designated State]”) and 49ter.2(h) (“Restoration of Right of Priority by Designated Office”), see the table at:

<http://www.wipo.int/pct/en/texts/restoration.html>

For further information on requesting the restoration of the right of priority, see the “Practical Advice” published in *PCT Newsletter* No. 04/2007, the *PCT Applicant’s Guide*, International Phase, paragraphs 98A to H, and the part of the “Frequently Asked Questions: Amendments to the PCT Regulations (April 1, 2007)” concerning the restoration of the right of priority at:

http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration

2009-10

Choosing a receiving Office as a function of the criterion applied by it for restoring the right of priority

Q: I am about to file an international application; however, having just missed the 12-month priority period, I intend to request the restoration of the right of priority under PCT Rule 26bis.3. Since I have the possibility of filing the application with the United Kingdom Intellectual Property Office (an operating name of the Patent Office) (RO/GB), the European Patent Office (RO/EP), or the International Bureau (RO/IB) as receiving Office, and PCT Rule 26bis.3 applies in respect of each of those Offices, what factors should I take into account in deciding where to file the application and the accompanying request for restoration of the right of priority?

A: Essentially, you need to consider whether the Offices before which you are considering entering the national phase will recognize a restoration of the right of priority which is made by the receiving Office (RO)

with which you intend to file your international application, and whether it will be easier to pursue the matter before the RO, or upon national phase entry before the designated Office (DO).

Most fundamentally, a significant number of DOs do not recognize restoration of the right of priority at all, or else not in the form envisaged by the PCT. A list of Offices which have made notifications under Rule 49ter.1(g) of the incompatibility of the relevant rules with their national law can be found at:

http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

If all the Offices before which you are interested in entering the national phase are on this list, there is probably no point in seeking restoration of the right of priority at all. You will need to consider carefully whether your application is likely to be valid without the priority claim, or else whether there are any other specific national provisions which could save it in the Offices where you are interested in obtaining protection.

Where at least one of the Offices allows for recognizing the restoration of the right of priority in principle, it is desirable to seek the easiest process which is likely to be recognized without further actions being required in the national phase. The main consideration comes from the fact that the PCT leaves it to individual Offices to determine which of two criteria should be used in deciding whether to approve the restoration. This applies both in terms of their actions as an RO and (subject to the possibility of having alternative, easier, criteria) in terms of their actions as a DO. Whether the DO will recognize the restoration will generally depend on whether the RO made its decision based on a sufficiently stringent basis. If not, then further individual requests for restoration may be needed in some of the national phases.

All ROs in respect of which PCT Rule 26bis.3 is applicable (all except 17 ROs) must apply at least one of the following criteria when deciding on a request by an applicant for the restoration of the right of priority:

- failure to file the application within the priority period occurred ***in spite of due care required by the circumstances having been taken***;
- failure to file the application within the priority period was ***unintentional***.

In the case of your choice of ROs, the RO/GB has notified that it will apply only the “unintentional” criterion, the RO/EP has notified that it will apply only the “due care” criterion and the RO/IB will apply both criteria. It is recalled that a table entitled “Restoration of the right of priority by receiving Offices (RO) and designated Offices (DO) under PCT Rules 26bis.3 and 49ter.2” showing, where applicable, the criteria applied by the various ROs and DOs under the PCT, is available on the PCT Resources page at:

<http://www.wipo.int/pct/en/texts/restoration.html>

An RO may, if it wishes, apply both criteria for restoration and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Provided that it is prepared to apply both criteria, an RO is free to apply, upon request by the

applicant or at its own initiative, first the "due care" criterion and then, if it finds that that criterion is not satisfied, the "unintentionality" criterion. This is what is done by the RO/IB.

Meeting the due care criterion, which is applied by both the RO/EP and RO/IB will give the most widely effective result as it is stricter than the unintentionality criterion, and the decision by an RO to restore the right of priority based on due care will, as a general rule¹, be effective in all DOs (PCT Rule 49ter.1(a)) except those which have submitted a notification of incompatibility under PCT Rule 49ter.1(g). Thus, it is in the applicant's interest to, if at all possible, meet this criterion.

The unintentionality criterion is much less strict, and if the RO does restore a right of priority based on that criterion, that decision will be effective only in those designated States whose applicable national laws provide for restoration of the right of priority based on that criterion, or on a criterion which, from the viewpoint of applicants, is more favorable than that criterion (PCT Rule 49ter.1(b)). On the other hand, if you are sure that all of the DOs before which you are interested in entering the national phase fall into that category, it may be easier, and in some cases cheaper, to demonstrate that you have met that criterion.

If you wish to file your international application with an Office which applies the due care criterion, it is important to consider the circumstances behind your failure to file the application within the priority period, and the likelihood of successfully meeting that criterion in the particular circumstances of that case. When requesting the restoration of the right of priority, you should state the reasons for the failure to file the international application in time, providing a summary of the facts or circumstances surrounding the failure to file the international application in time, including, where applicable, actions that were taken to prepare and file the international application. The RO may require that the statement of reasons be substantiated by a declaration or evidence which would enable it to determine whether the failure to file the international application within the priority period occurred in spite of due care, that is, if all reasonable care was taken under the circumstances to ensure that the priority period would not be missed (see the PCT Receiving Office Guidelines, paragraphs 166F and 166G).

Individual cases will be examined on a case by case basis. If the RO concerned only applies the due care criterion, which is the case of the RO/EP, and if you cannot provide convincing evidence that the failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken, your priority claim will not be restored at all at this stage. Note, however, that even if you do file your application and request restoration of the right of priority with the RO/EP and it finds that the due care criterion has not been met and does not restore the right of priority, that negative decision can always be reviewed by a DO, unless it has submitted a notification of incompatibility under PCT Rule 49ter.1(g).

If you do not believe that the RO will restore the priority claim based on due care, you could file your international application with the RO/GB, which is more likely to restore the right of priority under the criterion of unintentionality as, for this criterion, it should generally be sufficient to simply furnish a statement indicating that the failure to comply with the priority period was not intentional (if that is indeed the case) (see PCT Receiving Office Guidelines, paragraph 166G). Furthermore, if you file with the RO/IB, it will automatically review the application first under the due care criterion and then under the unintentional criterion.

You may also wish to consider the financial aspects of your choice of RO, and the amounts charged (if any) for the transmittal fee and for the fee for requesting a restoration of the right of priority before each Office – for the transmittal fee, the RO/EP currently charges 110 euro (EUR), the RO/GB charges 55 pounds sterling (GBP) and the RO/IB charges EUR 64; for the request for restoration of the right of priority, the RO/EP charges EUR 550, whereas the RO/GB and RO/IB do not charge any fee.

Applicants are always strongly advised to file **well before the end of the 12-month priority period** in order to avoid the problems caused by last-minute delays, and being in a position where restoration of the right of priority has to be requested, and might not be effective in all the Offices where protection is sought anyway.

For further information on the restoration of the right of priority, see the "Practical Advice" in *PCT Newsletter* Nos. 09/2009 and 04/2007, the *PCT Applicant's Guide*, International Phase, paragraphs 98A to H, and the part of the "Frequently Asked Questions: Amendments to the PCT Regulations (April 1, 2007)" concerning the restoration of the right of priority at:

http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration

Additional information concerning the practical advice published in PCT Newsletter No. 10/2009

Reference is made to the above-mentioned "Practical Advice" entitled "Choosing a receiving Office as a function of the criterion applied by it for restoring the right of priority". It was explained that, in the case of a request for restoration of the right of priority under the criterion of unintentionality, it should generally be sufficient to furnish a statement indicating that the failure to comply with the priority period was not intentional, as stated in the PCT Receiving Office Guidelines, paragraph 166G.

The main message of the practical advice was that "unintentionality" is an easier test to meet than "due care". It should be noted as well that, as stated in the first sentence of paragraph 166G, the receiving Office may require that a declaration or other evidence in support of the statement of reasons be furnished or, if some evidence has already been provided, that additional evidence be furnished. As an example, the United Kingdom Intellectual Property Office (an operating name of the Patent Office) (RO/GB), a receiving Office which applies only the "unintentionality" criterion, has notified the International

Bureau that, in considering whether the unintentional criterion has been met, it takes the same approach as it does for equivalent requests under its national law, and requires reasons and evidence to be provided to allow it to determine why the priority period was not met, and thus to establish whether the failure was unintentional.

Applicants are advised to check with their respective Offices what kind of evidence, if any, is required in support of their requests for restoration of the right of priority.

¹ A review of a positive decision may be made by a DO in the rare situation where it may reasonably doubt that one of the requirements for restoration was complied with.

2009-12 Requesting the reinstatement of rights after missing the time limit for entry into the national phase

Q: I filed an international application on 10 August 2007, a few days after the expiration of the 12 months priority period (priority date: 4 August 2006). I was notified by my receiving Office that I had the possibility of submitting a request to restore the right of priority under PCT Rule 26bis.3, but decided not to take any action. By doing so, I presumed that my priority claim would be disregarded, and that this would effectively give me more time to prepare my application for entry into the national phase. However, when I was preparing the file for national phase entry during the month of November 2009, I noticed that the priority date of 4 August 2006 was indicated on the forms which had been sent to me by the receiving Office and the International Bureau. Upon contacting the receiving Office about this, they confirmed to me that even though the international filing date was more than 12 months after the priority date, the priority date had not been considered void and that all PCT time limits would be calculated from that date. It was then that I realized that I had missed the time limit for entry into the national phase, which expired on 4 February 2009. Is it possible to withdraw the priority claim so that the date for entry into the national phase can be recalculated to 10 February 2010, or is there anything else that I can do to reinstate my application before the Offices concerned?

A: PCT Rule 26bis.2(c)(iii) provides that a priority claim will not be considered void only because the international filing date is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date. This is why the date of your earlier application still served as a basis to calculate the time limit for entry into the national phase, and, by failing to perform the acts referred to in PCT Article 22 within the applicable time limit, your application will, in accordance with PCT Article 24(1)(iii), have ceased to have effect before the designated (or elected) Offices. If you had wanted the time limits to be calculated as from the international filing date, you would have had to withdraw the priority claim. However, it is too late to

do this now because the applicable time limit for withdrawing the priority claim (30 months from the priority date (see PCT Rule 90bis.3)) has also expired. Furthermore, as already stated above, PCT Rule 26bis.2(c)(iii) prohibits the receiving Office and the International Bureau (IB) from declaring the priority claim as void.

It may, however, be possible for you to make a request under PCT Rule 49.6 ("Reinstatement of Rights after Failure to Perform the Acts Referred to in Article 22"), before the designated Offices. Such a request should be submitted either two months from the date of removal of the cause of the failure to meet the time limit for entry into the national phase or 12 months from the date of expiration of the applicable time limit under PCT Article 22, whichever expires first. The day when you realized that the priority claim had not been considered void should probably be considered as the time at which the removal of the cause of the failure to meet the time limit took place, thus you would have two months from that date (this time limit will expire before the time limit of 12 months from the expiration of the time limit for entering the national phase). You may even be able to submit the request later, if so permitted by the national law applicable by the designated Office concerned. It is, however, recommended that you submit your request for reinstatement as soon as possible.

Designated Offices are, subject to certain exceptions, obliged to allow reinstatement of rights with respect to a particular international application where the applicant has failed to enter the national phase within the applicable time limit, provided that the requirements under PCT Rule 49.6 are met, namely, that you can show that you missed the time limit to enter the national phase either unintentionally or in spite of due care, depending on the criteria applied by the Office. Note, however, that certain Offices have made a reservation in this respect – for a list of those Offices which have informed the IB that PCT Rule 49.6 is not compatible with the national law applied by them (at the time of writing, there are 12 Offices which have made such a reservation), see under "PCT Rule 49.6(f)" in the table of "Reservations and Incompatibilities" at:

http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

Please note that even if an Office is on that list, reinstatement might still be possible under the applicable national law of the State concerned, and in some cases, this may be more permissive than under PCT Rule 49.6. In such a case, the Office will apply its own national law standards, and not PCT Rule 49.6.

The possibility of making a request under PCT Rule 49.6 should be pursued before each designated Office individually, and only as far as that Office is concerned. If you make such a request before any of the designated Offices, it should state the reasons for the failure to comply with the applicable time limit under PCT Article 22 (or 39(1), as the case may be) (PCT Rule 49.6(c)), and the national law applicable by the designated Office may require that a fee be paid (PCT Rule 49.6(d)(i)), and that a declaration or other

evidence in support of the reasons referred to above be filed (PCT Rule 49.6(d)(ii)). Note that, at the same time as requesting the reinstatement of your application, you must perform all acts required for entry into the national phase.

Information as to any possibilities of reinstatement where the time limit for national phase entry was missed, as well as details of the applicable requirements of the various designated Offices can be found, for each PCT Contracting State, in the corresponding National Chapter of the *PCT Applicant's Guide*, under the heading "Excuse of delays in meeting time limits". It is, nevertheless, recommended that you seek assistance from local patent attorneys who will be familiar with the various national laws applicable in such situations.

2010-01

Expiration of a time limit where an Office is situated in more than one locality

Q: I filed a demand for international preliminary examination with the European Patent Office (EPO) in Munich on 7 January 2010. I would normally have filed it with the EPO in The Hague, but, since I had just missed the time limit for filing the demand, which expired on 6 January 2010, I filed it by fax with the Munich Office, which was not open for business on 6 January. By doing this, I knew that, given that the Munich Office was closed on that day, the time limit would be extended by a day, to 7 January, and my demand would be considered to have been received on time. I wondered whether my demand would have been considered as filed after the applicable time limit if it had been filed with the EPO at The Hague, which was not closed on 6 January, or whether it would have been considered as having being received on time?

A: Any time limits for the filing of a document with, or for the payment of a fee to, the EPO, which would normally have expired on 6 January 2010, will have been extended to 7 January, irrespective of whether the demand was filed with the Office in Munich, The Hague or Berlin. Therefore, even if you had filed your demand at the Office at The Hague, it would have been considered as having being received within the applicable time limit.¹

This situation is covered by PCT Rule 80.5(iii), and also by the European Patent Convention. Since you filed with the Munich Office (that is, the Office which was actually closed), the time limit will have been extended in accordance with PCT Rule 80.5(i), which states that if the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day on which such Office or organization is not open to the public for the purposes of the transaction of official business, the period shall expire on the next day on which none of the circumstances mentioned in PCT Rule 80.5 exist. However, if you had filed with one of the Offices in The Hague or Berlin, this would have fallen under the provisions of PCT Rule 80.5(iii), which states that if the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day which, where such Office or organization is situated in more than one locality, is an

official holiday in at least one of the localities in which such Office or organization is situated, **and in circumstances where the national law applicable by that Office or organization provides**, in respect of such national applications, that, in such a case, such period shall expire on a subsequent day, the period shall expire on the next day on which none of the circumstances mentioned in PCT Rule 80.5 exist.

In the case of the EPO, the relevant national law is Rule 134(1) of the European Patent Convention, which states that where a time limit expires on a day on which one of the filing offices of the EPO is not open for receipt of documents, the time limit is extended until the first day thereafter on which all the filing offices are open for receipt of documents.

Note that where a Contracting State has more than one Office or address for correspondence, PCT Rule 80.5(iv) may apply where there is an official holiday in part of that Contracting State, as long as the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day. For example, as far as Canada is concerned, the Canadian Intellectual Property Office (CIPO) itself is in the province of Quebec, but there are various designated establishments in other parts of the country which receive correspondence addressed to the Commissioner of Patents. One such establishment is Industry Canada in Toronto, which is in the province of Ontario; this may have different official holidays from the province of Quebec, where CIPO is located. PCT Rule 80.5(iv) may therefore be applied at times when designated establishments have different official holidays from CIPO. For specific information about the meeting of time limits which expire on a day on which a statutory holiday falls in Canada, see:

<http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00823.html>

It is recalled that annual lists of closing dates of industrial property Offices, wherever they have been made available to the International Bureau, have been published on the WIPO website at:

<http://www.wipo.int/pct/en/closeddates/index.html>

Where available, the dates for any separate branch Offices are also given.

¹ The time limit for filing a demand is three months from the date of transmittal to the applicant of the international search report (or the declaration referred to in PCT Article 17(2)(a)) and of the written opinion established under PCT Rule 43*bis*.1, or 22 months from the priority date, whichever expires later (PCT Rule 54*bis*.1(a)). However, if the applicant wishes to benefit from the time limit for entry into the national phase under PCT Article 39(1) in certain States for which the 30-month time limit under PCT Article 22(1) is not applicable, the demand should be filed prior to the expiration of the 19th month from the priority date.