

PCT Distance Learning Course Introduction to the Patent Cooperation Treaty

Preface

This Distance Learning Course on the Patent Cooperation Treaty (PCT) provides you with an overview of this international treaty administered by the World Intellectual Property Organization (WIPO).

This course was developed by WIPO specialists on the PCT and includes some multiple-choice tests to measure your understanding and progress. In addition to the course material, you will find links to specific reference documents, such as legal texts and other official WIPO documents. By the end of this course you should have a better understanding of the PCT system and the reasons it should form part of your overall patent strategy.

This course is available online without any time restrictions.

Resources - PCT Glossary

The [PCT Glossary](#) is a reference tool containing definitions of commonly-used PCT terminology and is intended to help users better understand the PCT system. Those involved in drafting and/or translating PCT documentation may find it particularly useful.

References to “Articles” are to those of the PCT, to “Rules” are to those of the Regulations under the PCT. For complete information, we recommend that you consult the [official texts](#), particularly the PCT itself and the Regulations under the PCT. In case of any inconsistency with the Glossary, it is those texts which apply. All terms are defined or explained in the context of the PCT.

Contact Information

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Module 1: What is the PCT?

The PCT is an international treaty which provides a system for filing patent applications and assists you in seeking patents in multiple countries around the world on the basis of a single patent application.

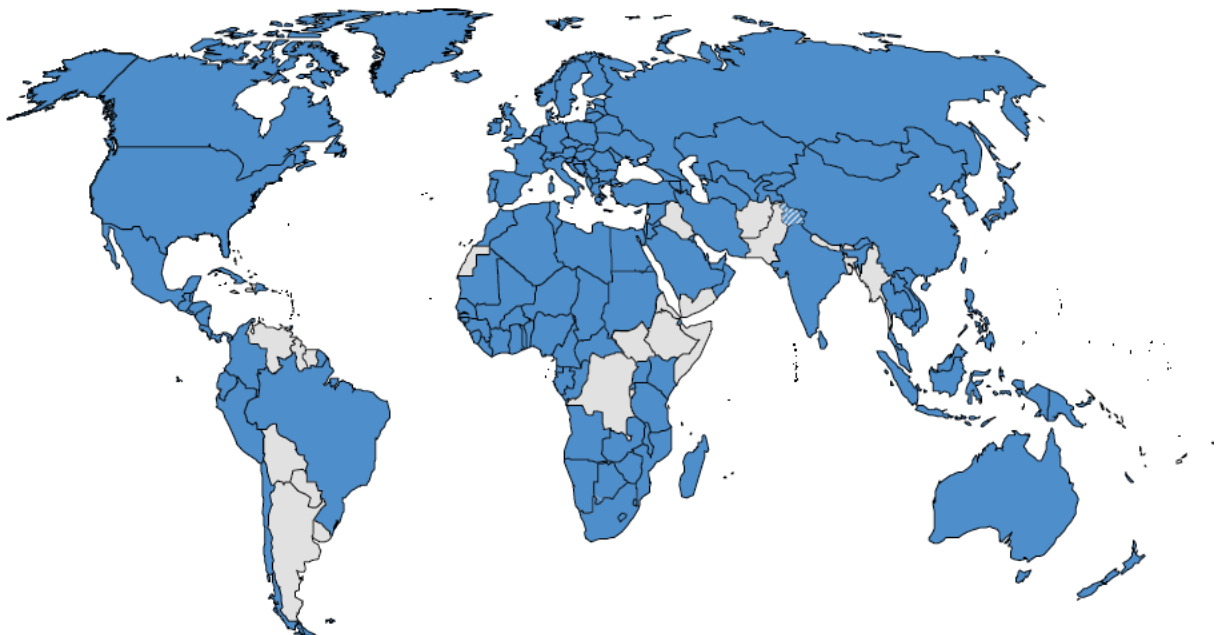
The PCT simplifies the procedure for seeking patent protection in many countries, making it more efficient and economical for:

- (1) Users of the patent system (applicants and inventors); and
- (2) National Offices.

While the PCT simplifies patent application filing and processing for you, the ultimate decision to grant a patent rests exclusively with each [national or regional patent Office](#).

1.1 PCT Contracting States

The PCT was signed in June 1970, in Washington, D.C., and became operational in June 1978 with 18 Contracting States. The terms PCT country and PCT Contracting State are both used interchangeably to identify countries which are party to the PCT system. The PCT now has 152 Contracting States, providing you with near worldwide patent filing coverage. Please consult the website for an updated list of [Contracting States](#).



1.2 Role of the International Bureau of WIPO

The staff of WIPO, generally referred to in the PCT context as the International Bureau, is responsible for the international coordination and management of the PCT system. This includes the review, communication, processing and publication of PCT applications and associated documents received by WIPO. In addition to these responsibilities, WIPO also provides regular advice and assistance to PCT Contracting States, applicants and other interested parties on the advantages and operation of the PCT system. Module 2 will cover these advantages in detail.

A wide variety of reference tools, guides and other publications on the PCT system are available on the [PCT Resources](#) page of the WIPO website.

WIPO regularly promotes and raises awareness of the PCT with a wide range of users, for example, national and regional IP Offices, universities, private sector companies, research institutions, and attorneys through seminars, training courses and similar events on the PCT system around the world.

1.3 The PCT – Overview of the Process

The PCT process is comprised of the following main steps:

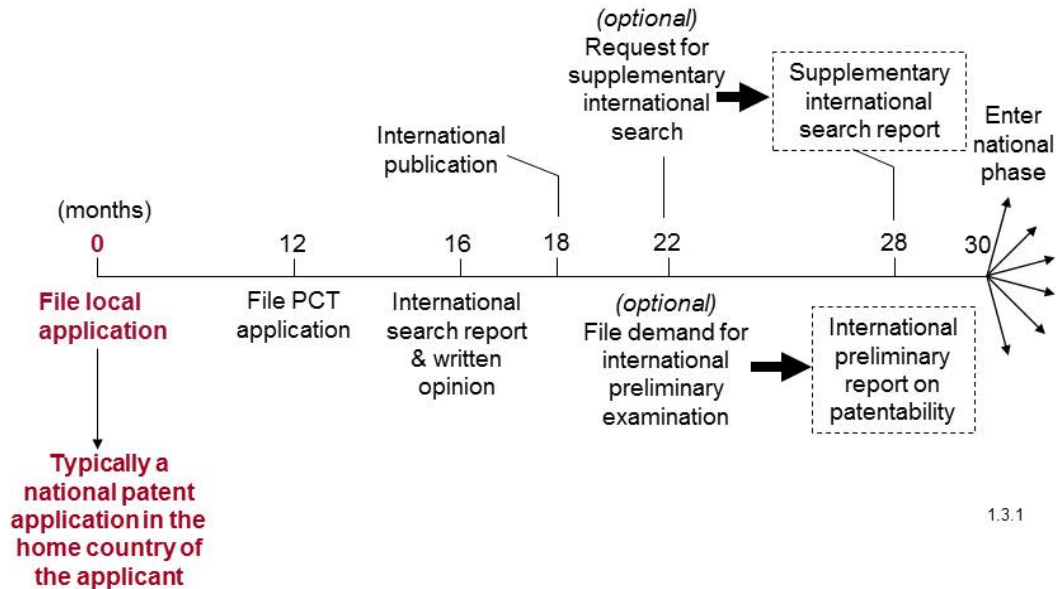
International Phase

- (1) Filing of a PCT application
- (2) International search
- (3) International publication
- (4) Supplementary international search (optional)
- (5) International preliminary examination (optional)

National Phase

- (6) Processing of the PCT application before national and/or regional patent Offices

1.3.1 Filing of a Local (First) Patent Application

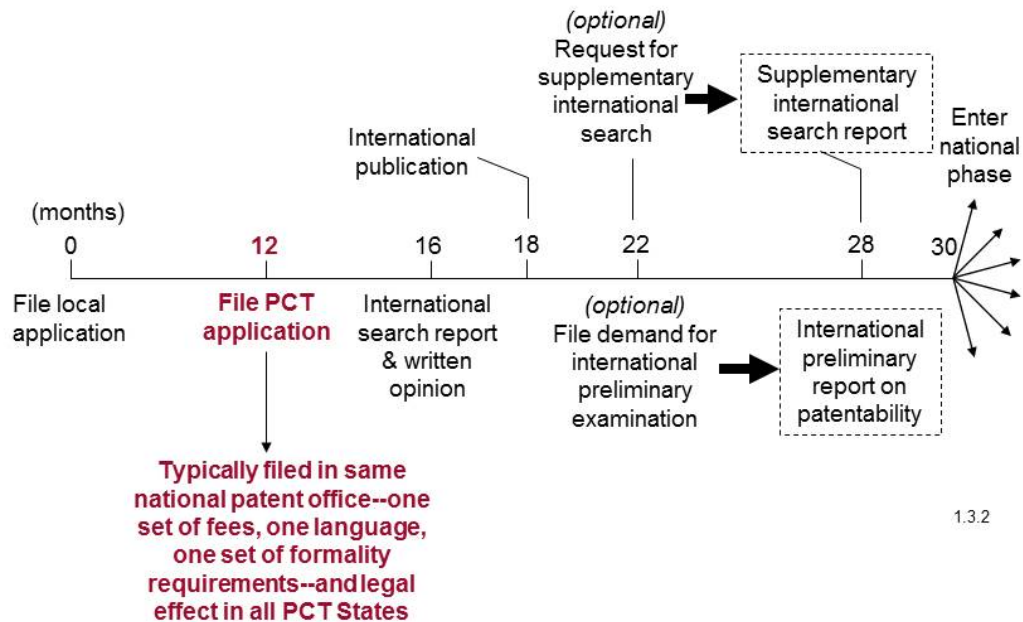


The timeline provides you with a graphical representation of the PCT procedure and sequence. Each description is linked to the red highlighted sequence of events.

Typically, you would prepare your first patent application and file it with your national or regional patent Office. This patent application is commonly referred to as your local application and when in completed form, normally contains the following elements:

- (1) A request (or petition)
- (2) A description (also referred to as specification)
- (3) One or more claims
- (4) An abstract
- (5) One or more drawings (where necessary)

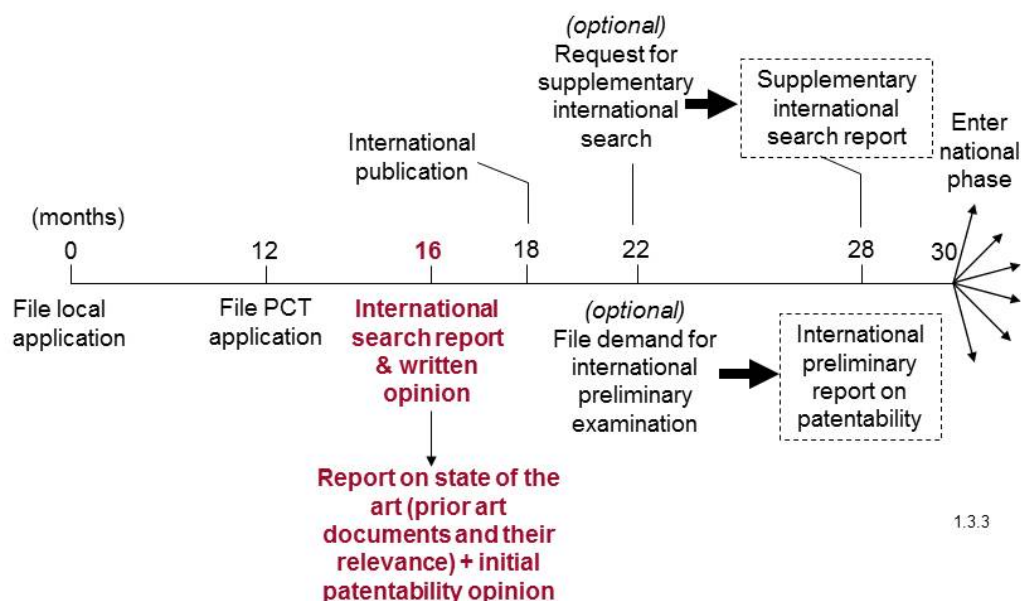
1.3.2 Filing of a PCT Application



1.3.2

Based on the contents of your local (first) patent application you would then prepare and file your PCT application. You have up to 12 months from the filing date of your local (first) application to file your PCT application with the receiving Office (see Module 4 Section 4.1) of your national or regional patent Office. You may also file your PCT application directly with the receiving Office of WIPO if permitted by the national security provisions in your national law. As of its international filing date (see Module 4), your PCT application has the same effect as a separate application filed in each PCT country.

1.3.3 International Search Report (ISR) and Written Opinion of the ISA



Each PCT Contracting State has selected at least one International Searching Authority (ISA) to perform international searches and to establish written opinions for its applicants, referred to in PCT terms as the “competent” International Searching Authority. You will receive, at around 16 months from the filing date of your local application, an international search report (ISR) and a written opinion from a national or regional patent Office that has been appointed as an ISA (see Module 7) under the PCT, and selected by the applicant if there is more than one competent authority.

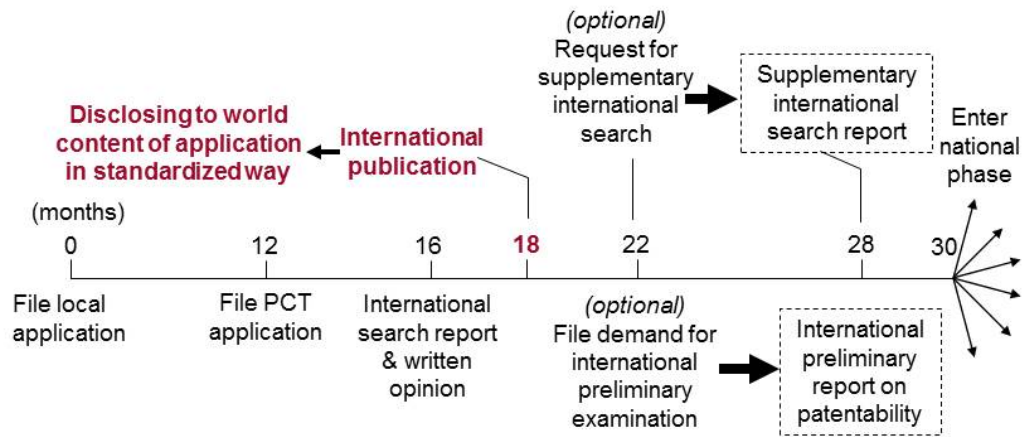
The ISR will contain citations of patent documents and other technological references relevant to the potential patentability of your invention. The written opinion complements the ISR by providing a preliminary non-binding patentability assessment of your invention taking into consideration the references contained in the ISR.

1.3.3.1 International Preliminary Report on Patentability (Chapter I)

After having considered the written opinion of the ISA, you may decide not to file a demand for international preliminary examination. In this case, WIPO will attach a cover sheet to this written opinion effectively converting it into the international preliminary report on patentability (Chapter I). The international preliminary report on patentability (Chapter I) is available for public inspection 30 months after the [priority date](#) of your PCT application (the date of your first-filed local patent application).

Chapter I is a technical reference to the portion of the PCT Treaty containing the legal basis for the basic steps in the PCT procedure, including the issuance of the international preliminary report on patentability.

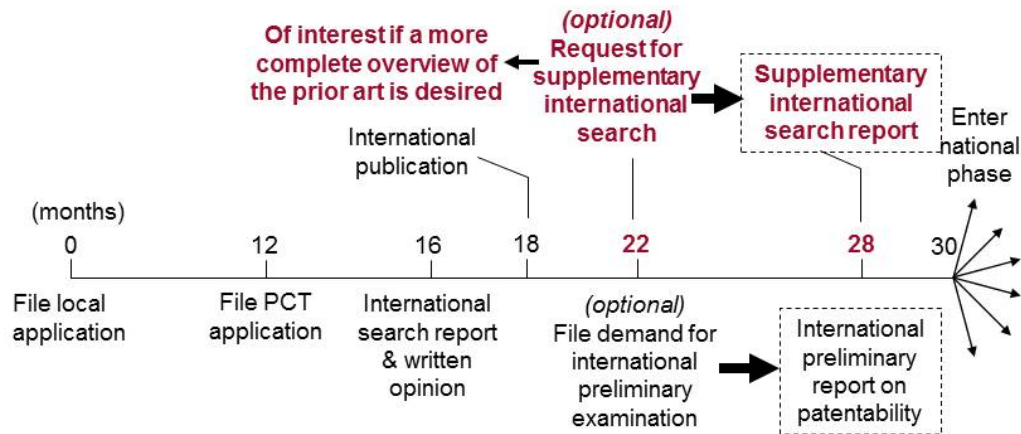
1.3.4 International Publication



1.3.4

The International Bureau of WIPO publishes your PCT application in the [PATENTSCOPE](#) database shortly after 18 months from the [priority date](#) of your PCT application. Publication serves to provide technical disclosure of your invention which helps fuel greater technological progress and development.

1.3.5 (optional) - Supplementary International Search



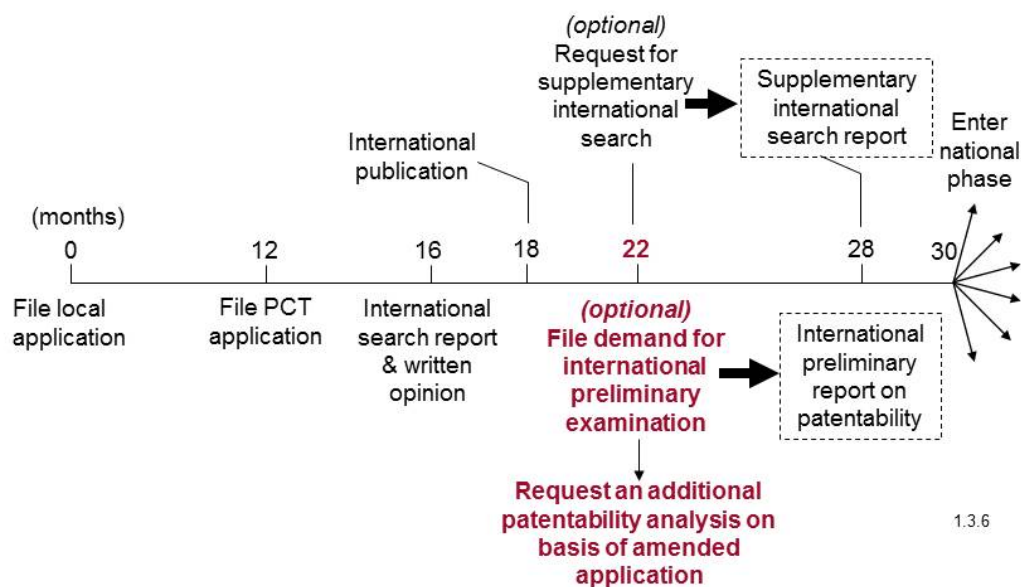
1.3.5

You also have the option of requesting that a supplementary international search be conducted on your PCT application (which is an additional search carried out by another ISA). The request for supplementary international search may be filed at any time prior to the expiry of 22 months from the [priority date](#). The supplementary search is completely optional but may be of interest in cases where a more complete overview of the prior art is desired, particularly in respect of specific languages.

The supplementary international search service is not available across all International Searching Authorities. Those offering this service do so against the payment of a fee.

The supplementary international search report prepared by the International Searching Authority should be available by 28 months from the [priority date](#).

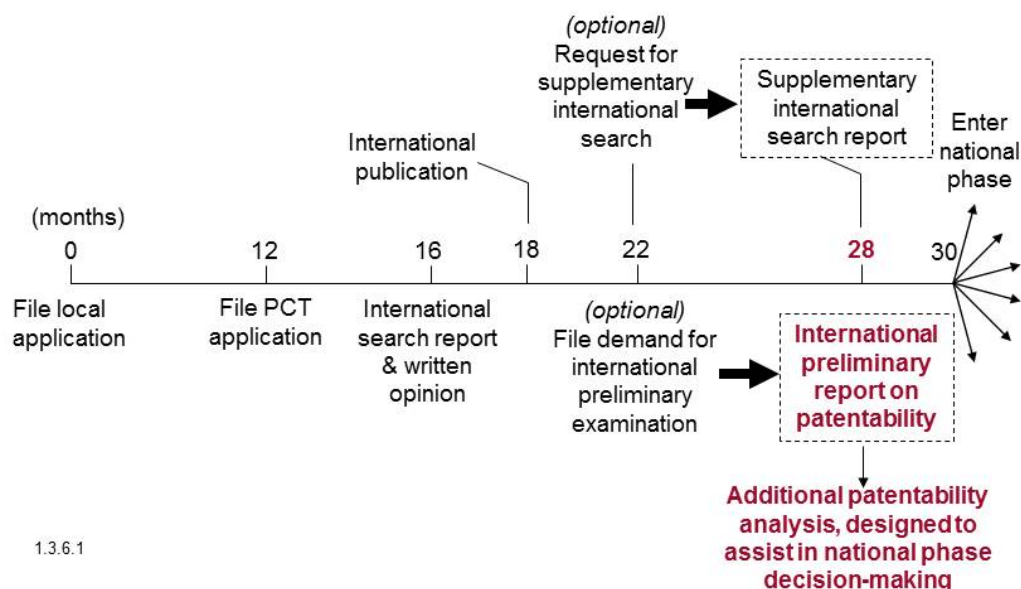
1.3.6 (optional) - Filing of a Demand for International Preliminary Examination (Chapter II)



This part of the PCT procedure is optional. If you wish to amend your PCT application in light of the content of the search report and written opinion and to have a second patentability assessment carried out on your as-amended application, you may decide to file a demand for international preliminary examination with a national or regional patent Office that has been appointed as an International Preliminary Examining Authority (IPEA) under the PCT. Each PCT Contracting State has appointed at least one IPEA to perform international preliminary examinations for its applicants, referred to in PCT terms as the “competent” IPEA.

You have at least 22 months from the [priority date](#) of your PCT application to file your demand with the competent IPEA.

1.3.6.1 International Preliminary Report on Patentability (Chapter II)

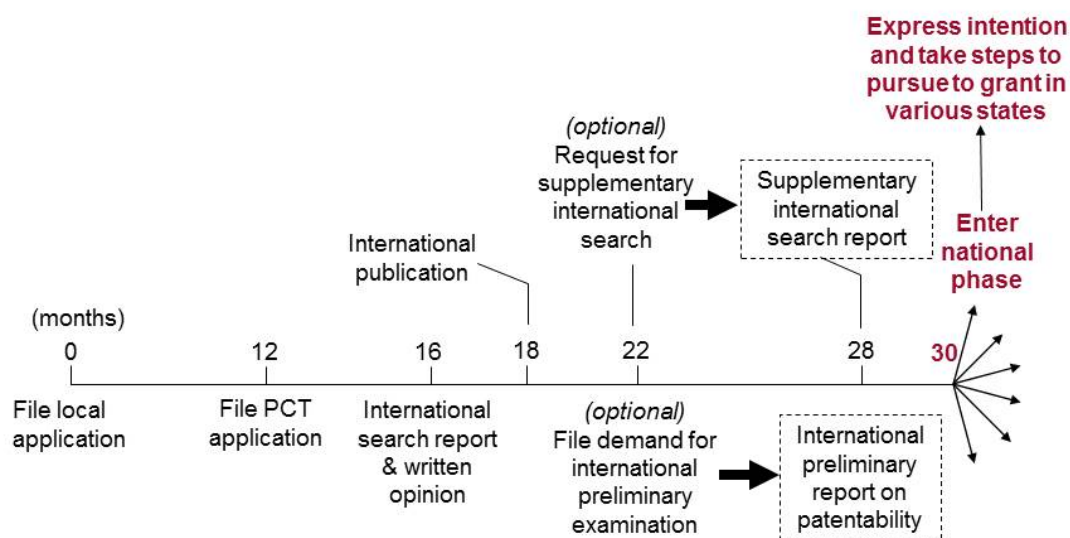


1.3.6.1

At about 28 months from the [priority date](#), the IPEA will send you an international preliminary report on patentability (Chapter II) containing the opinion of the IPEA for national or regional Offices to use in assessing the patentability of your invention, as contained in your (usually) amended application. This report is a non-binding opinion on patentability and is only provided to applicants who have filed a demand for international preliminary examination as described in 1.3.6 above.

Chapter II is a reference to the portion of the PCT which deals with the international preliminary examination procedure.

1.3.7 Entry into the National Phase



1.3.7

Entry into the national phase represents the end of the international phase of the PCT procedure and the beginning of the national patent procedure. The international preliminary report on patentability (either under Chapter I or Chapter II), which you received during the international phase, will help you evaluate your chances of obtaining a patent in the countries of interest to you. The report also assists the national and regional patent Offices in their evaluation of whether a patent should be granted for your invention.

Once in the national phase, your patent application is subject to the patent laws, regulations and practices of each country. Rejections on the basis of failure to comply with national or regional form and content requirements may not be raised by national phase offices if you have met the PCT requirements.

Module 1 - End of Module Test

1. Under the PCT system, you can obtain a single patent with worldwide coverage.

- a) True
- b) *False*

Feedback: see Module 1 introduction

2. The applicant has to file a demand for International Preliminary Examination during the international phase.

- a) True
- b) *False*

Feedback: see Section 1.3.6

Module 2: Why Use the PCT?

Now that you have an overview of the PCT, let us look at the main advantages to the users of the system (national and regional IP Offices, universities, private sector companies, research institutions, attorneys, and the general public).

The PCT is the cornerstone of the international patent system. It provides you with a worldwide system for the simplified filing of patent applications that:

- brings the world within reach;
- postpones major costs and provides you with additional time to consider your various patenting options;
- provides a strong basis for patenting decisions; and
- is used by the world's major corporations, universities and research institutions when they seek international patent protection.

2.1 Brings the World within Reach



A single PCT application has the same legal effect as a national patent application in each of the PCT Contracting States. Without the PCT, you would have to file a separate patent application in each country of interest to you.

2.2 Cost and Time Advantages

A major feature of the PCT system is that it delays (and in some cases saves) various costs associated with seeking patents in multiple countries.

In addition to delaying costs, you also benefit from additional time to:

- further develop or market your invention;
- consider and explore your various patenting options;
- find investors, partners and secure funding; and
- investigate the commercial possibilities of your invention.



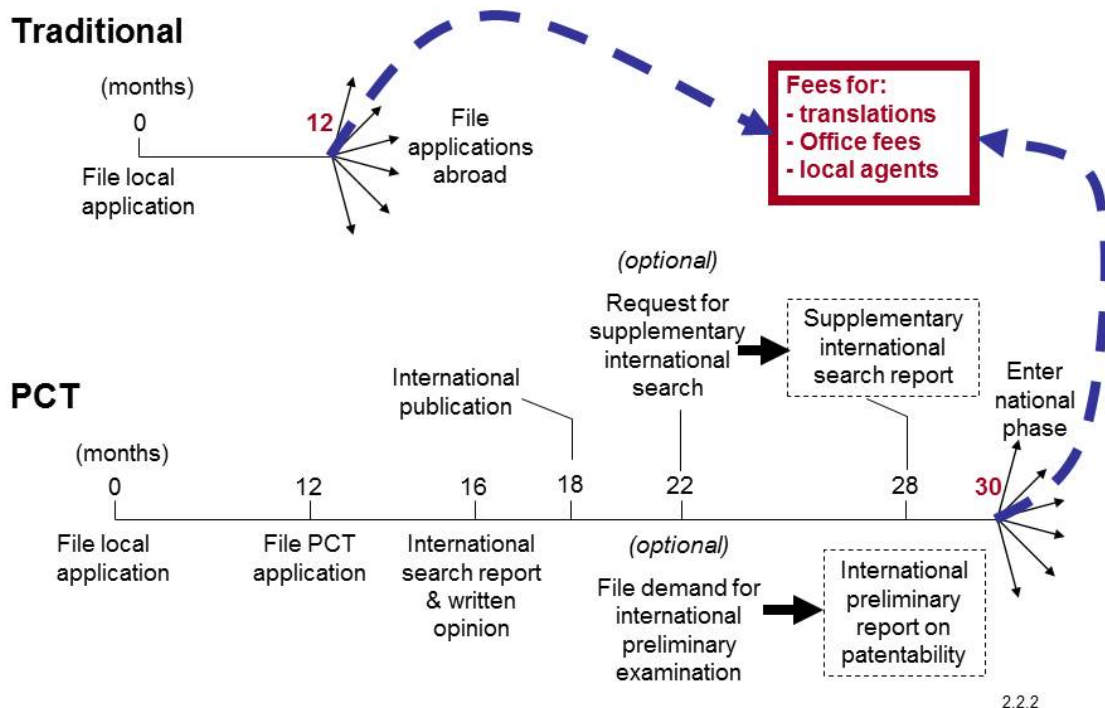
2.2.1 Translations, National Fees, Agent/Attorney Fees

The patent-related costs which the PCT defers are:

- translations of the patent application (which are highly technical documents) into various national languages;
- official fees charged by national or regional patent Offices; and
- fees for the services of local patent agents or attorneys.

2.2.2 Cost Deferral Compared to the Traditional Patent System

Traditional Patent System vs PCT System



In the above figure, the traditional patent system (local application followed within 12 months by multiple foreign applications claiming priority under Paris Convention for the Protection of Industrial Property) and the PCT system are contrasted.

If you were to use the traditional patent system, that is to say, by filing separate patent applications in each country of interest to you, you would incur a significant portion of your patenting costs within 12 months from the date you filed your local (first) patent application.

In contrast, under the PCT, you have up to 30 months from the [priority date](#) before having to decide whether to incur those costs, thus 18 months of additional time when compared to the traditional patent system.

2.3 Strong Basis for Patenting Decisions

Of course the PCT does more than just postpone costs. It is also the information that you receive during the PCT procedure on the potential patentability of your invention that can be of great value to you. This information could save you costs as you may decide to enter the national phase in fewer countries than originally intended or to forego national phase entry completely.

2.3.1 International Search Report (ISR) and Written Opinion of the ISA

Example: content of the international search report (ISR)

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27	7-9, 11
X	GB 392415 A (JONES) 18 May 1933 (18.05.33) Fig. 1 Page 3, lines 5-7 Fig. 5, support 36	1-3
Y		4, 10
A		11-12
X	GB 2174500 A (STC) 5 November 1986 (05.11.86) page 1, lines 5-15, 22-34, 46-80; Fig. 1	1-3
Y		4, 10
A	US 4322752 A (BIXTY) 30 March 1982 (30.03.82) claim 1	1
A	GREEN, J.P. Integrated Circuit and Electronics Compass, IBM Technical Disclosure Bulletin, October 1975, Vol. 17, No. 6, pages 1344 and 1345	1-5

Symbols indicating which aspect of patentability the document cited is relevant to (for example, novelty, inventive step, etc.)
Documents relevant to whether or not your invention may be patentable
The claim numbers in your application to which the document is relevant

Before the international publication of your PCT application (which takes place promptly after 18 months from the [priority date](#)), you will receive an international search report (ISR) containing information about documents which have been published which might have an effect on whether your invention is patentable. The ISR will categorize and provide details of each document, and indicate the claims in your application to which each document is relevant.

Example: content of the written opinion of the ISA

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>Claim(s) 3-5</u>	YES
	Claims <u>Claim(s) 16</u>	NO
Inventive step (IS)	Claims <u>Claim(s) 8, 10-12</u>	YES
	Claims <u>Claim(s) 3, 7, 9, 14-16</u>	NO
Industrial applicability (IA)	Claims <u>Claim(s) 3-16</u>	YES
	Claims _____	NO

2. Citations and explanations:

INDEPENDENT CLAIM 3

Document US-A-5 332 238, which is considered to represent the most relevant state of the art, discloses (cf. relevant passages indicated in the ISR) a device from which the subject-matter of INDEPENDENT CLAIM 3 differs in [...]

Patentability assessment of claims

Reasoning supporting the assessment

Together with the ISR, you will receive the written opinion established by the ISA, which provides a detailed explanation of the relevance of the references, analyzing how they affect the potential patentability of your invention. Patentability is assessed against the internationally accepted criteria of novelty, inventive step and industrial applicability.

Once you receive the ISR and the written opinion from the ISA, you will be able to decide on the course of action to take which may include the filing of a demand for international preliminary examination with the IPEA in order to be able to amend the application in light of the documents cited (see Module 9).

If you do not file a demand for international preliminary examination, WIPO will attach a cover page to the written opinion effectively converting it into an international preliminary report on patentability under Chapter I of the PCT – IPRP (Chapter I).

2.3.2 International Preliminary Report on Patentability (Chapter II)

Example: content of the international preliminary report on patentability (Ch. II)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY	International application No.									
Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement										
<div style="margin-bottom: 10px;"> 1. Statement </div> <table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 35%; vertical-align: top;"> Novelty (N) </td> <td style="width: 45%;"> Claims <u>Claim(s) 4, 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3</u> NO </td> <td style="width: 20%;"></td> </tr> <tr> <td style="vertical-align: top;"> Inventive step (IS) </td> <td> Claims <u>Claim(s) 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3, 4</u> NO </td> <td></td> </tr> <tr> <td style="vertical-align: top;"> Industrial applicability (IA) </td> <td> Claims <u>Claim(s) 3-10</u> YES Claims _____ NO </td> <td></td> </tr> </table>		Novelty (N)	Claims <u>Claim(s) 4, 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3</u> NO		Inventive step (IS)	Claims <u>Claim(s) 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3, 4</u> NO		Industrial applicability (IA)	Claims <u>Claim(s) 3-10</u> YES Claims _____ NO	
Novelty (N)	Claims <u>Claim(s) 4, 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3</u> NO									
Inventive step (IS)	Claims <u>Claim(s) 5, 6-8, 9-10</u> YES Claims <u>Claim(s) 3, 4</u> NO									
Industrial applicability (IA)	Claims <u>Claim(s) 3-10</u> YES Claims _____ NO									
<div style="margin-bottom: 10px;"> 2. Citations and explanations (Rule 70.7) </div> <p>A surgical knife for use in making incisions is disclosed in US-A-9 999 999 (hereinafter referred to as document 1) comprising the following features: A, B, C – see column 1, lines 20-55 and Figures 2.3. D, E – see column 3, lines 70-110 and Figure 4. The subject-matter of Claim 3 does not therefore meet the requirements of Article 33 (2) of the PCT.</p>										
Patentability assessment of claims (usually, as amended)										
Reasoning supporting the assessment										

If in reaction to the findings in the ISR and written opinion you wish to amend your PCT application, you may file a demand for international preliminary examination, the result of which will be a second patentability analysis on the amended version of your PCT application.

2.3.3 Considerations for Entering the National Phase

You have up to 30 months from the [priority date](#) (and even more with some Offices) to decide on the countries where you wish to seek a patent. During this time, you may have further developed your invention, secured funding, and investigated various commercialization possibilities. You will also have had an opportunity to review and consider your international preliminary report on patentability containing the patentability assessment of your invention.

The information you have acquired together with the PCT's patentability information will provide you with a well-informed basis on which to make the decision about entry in the national phase – the countries where you pursue the national procedures for seeking patent protection. To enter the national phase, you would furnish to the national Office of the countries of interest to you any translation of the application which may be required, and pay the required fees.

Once in the national phase, the examination and grant of your patent is subject to the patent laws and practices applied by that national Office.

Module 2 - End of Module Test

1. A single PCT application has the same legal effect as if a national patent application had been filed in each of the PCT Contracting States.

- a) *True*
- b) *False*

Feedback: see Module 2.1

2. You have to file a demand for international preliminary examination in order to receive an international preliminary report on patentability.

- a) *True*
- b) *False*

Feedback: see Section 2.3.1

3. You are obliged to enter the national phase before at least one designated Office.

- a) *True*
- b) *False*

Feedback: see Section 2.3.3

Module 3: Preparing the PCT Application

This Section will guide you through the various parts of a PCT application and how they should be prepared in accordance with the PCT.

Note: PCT application PCT/US2003/018612, published as WO 03/106241, has been used to provide an illustrative example of the different parts of a PCT application. This PCT application has been edited for form and presentation purposes.

3.1 Form and Contents

As we saw in the previous module, your PCT application must contain a request, a description, one or more claims, an abstract, and one or more drawings (where required for the better understanding of the invention). It must be prepared in a language accepted by the receiving Office in accordance with [PCT physical requirements](#) such as paper size, margins, etc.

3.1.1 The Request

The PCT application must contain a part called the “request”. The request form contains details and information on your PCT application and a petition for your application to be processed according to the PCT.

The designation of States is the indication of Contracting States in or for which you may seek protection for your invention. The filing of a PCT request form is considered to be an automatic “designation” of all PCT Contracting States and an indication that you are seeking a patent and every other kind of protection which is available through the PCT in each PCT Contracting State.

For PCT applications filed electronically, the PCT request form is generated automatically.

3.1.1.1 Declarations

To facilitate the processing of your PCT application during the national phase, you have the option of including certain declarations in your request form which allow you to comply at the time of filing the PCT application with specific national law requirements.

Box No. VIII DECLARATIONS		
The following declarations are contained in Boxes Nos. VIII (i) to (v) (<i>mark the applicable check-boxes below and indicate in the right column the number of each type of declaration</i>):		Number of declarations
<input type="checkbox"/>	Box No. VIII (i) Declaration as to the identity of the inventor	:
<input type="checkbox"/>	Box No. VIII (ii) Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent	:
<input type="checkbox"/>	Box No. VIII (iii) Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application	:
<input type="checkbox"/>	Box No. VIII (iv) Declaration of inventorship (only for the purposes of the designation of the United States of America)	:
<input type="checkbox"/>	Box No. VIII (v) Declaration as to non-prejudicial disclosures or exceptions to lack of novelty	:

The declarations that you may make are the following:

- identity of the inventor;
- applicant's entitlement to apply for and be granted a patent;
- applicant's entitlement to claim priority of an earlier application;
- declaration as to inventorship (only for the United States of America); and

- non-prejudicial disclosures or exceptions to lack of novelty.

If you have not included any declaration at the time of filing, or if you wish to add a declaration, you may submit the missing or additional declarations subsequently to the International Bureau, provided that you do so before the technical preparations for international publication have been completed.

If you have submitted one of these declarations, in the vast majority of cases you will not have to submit other supporting documents or evidence on the matter declared at the time of national phase entry (there are a few very limited exceptions).

3.1.1.2 Signatures

As a general rule, the request form has to be signed by all persons (legal entity or natural persons) indicated as “applicant” or “applicant and inventor” or by the duly appointed agent. However, if only one of the applicants signs the request, the PCT application will not be considered defective.

3.1.2 The Abstract

The abstract is a technical summary of your invention and is used for information purposes only. The abstract must clearly explain the technical problem at hand, how the problem is solved by the invention, and how the invention will be principally used. As the abstract is a concise summary of the disclosure of the invention (description, claims and drawings), its text should preferably be between 50 and 150 words and include reference signs.

Example:

“A snowboard scooter formed of a one-piece platform (12) wide enough to accommodate the width of two feet, with side-by-side, offset foot grips (18, 20) in the form of straps, as on a snowboard, requiring the user to place his or her feet in predetermined positions, a fixable post (14) and a handlebar (16), and a brake system (22) actuated either at the handlebar or by direct contact with one of the user’s feet. Preferably a hydraulic brake system is used to drive a rear flange (40) into the snow to stop the snowboard.” [WO 03/106241]

3.1.3 The Description

As opposed to the Abstract, which is a technical summary of your invention, the description is the part of the PCT application which contains a full and complete textual explanation of the invention. The invention has to be explained in such a way that it can be understood and put into practice by someone who is sufficiently familiar with the technology – “a person skilled in the art.”

(a) The description starts with the title of the invention and then specifies the field to which the invention relates.

“SNOWBOARD SCOOTER

FIELD OF THE INVENTION

The field of the invention comprises snowboards and scooters.”

[WO 03/106241]

(b) You would then provide background information on the technology and field of invention by making reference as much as possible to patents and/or other relevant documents. This background information comprises what is commonly referred to as the “prior art” or “state of the art” of the technology to which your invention pertains.

See below an example of background information.

“BACKGROUND OF THE INVENTION

Downhill skiing is a popular sport in which there have been a number of important developments bringing greater excitement, fun, and safety. Untethered, spring-loaded brakes, improved materials, and innovative ski designs, such as parabolic skis, have enabled all skill levels to enjoy the sport. Snowboarding has brought increased excitement to downhill skiing, but has generally been limited to those with greater athletic ability and flexibility.

Safety can be easily compromised, not only for the snowboarders, but for skiers in the area endangered by out-of-control snowboarders. Over many decades, a wide variety of devices have been suggested to “improve” the skiing experience or to make it safer or easier for those without athletic ability or acquired skills. Many of these devices have taken the form of a scooter, for example, in Shores U. S. Patent No. 3,529, 847, where a mono-ski is fitted with a handlebar carried on a post connected to a single ski wherein the skier places his feet aligned one in back of the other. The post can be vertically tilted by a control on the handlebar. “Brakes” are spring loaded to maintain the post in a chosen rotational position and can be released to change the rotational position by means of a cable connected a lever pivotally attached to the handlebar. Little U. S. Patent 4,606, 548 discloses a device having a handlebar carried on a bendable mechanism connected to a single ski.”

[WO 03/106241]

(c) After you have explained the prior art, you would provide details on the technical problem which previously existed and how it was solved by your invention.

“None of the foregoing devices and proposed designs are believed to provide the user with a full skiing experience. With both skis and snowboards, a great part of the enjoyment comes from the movement or tilting of one’s body to control direction and speed, providing so called “body English”, yet the purpose of many of the above-described devices is, essentially, to remove or compromise the need for such body English. Other devices attempt to provide safety by braking mechanisms that are awkward to use or which require unnecessary coordination to operate satisfactorily. A need exists for a device that will allow a user to experience the exhilaration and enjoyment of snowboarding without loss of control, without the need for great athleticism, yet retaining the feel that comes from the use of body English to turn and to check speed, while enabling the user to quickly stop in a safe, easy manner.”

[WO 03/106241]

(d) Following the details and solutions to the technical problem, you would include an explanation of the best mode of putting your invention into practice and any other mode you may wish to include.

“The present invention satisfies the foregoing needs by providing a scooter like snowboard that enables a user to experience snowboarding without requiring great athleticism and with a significant level of safety. This is accomplished by providing a one-piece platform wide enough to accommodate the width of two feet, with laterally disposed but offset foot grips in the form of straps, as on a snowboard, requiring the user to place his or her feet in predetermined positions, fitting the one-piece platform with a fixable upright post and a handlebar, and providing a brake system actuated either at the handlebar or by direct contact with one of the user’s feet. More particularly, a rear brake is provided located on the longitudinal axis of the board so as to better enable the user to maintain control when slowing or stopping the scooter. The brake is located on the rear edge of the scooter for optimal control. While it can be operated by a rear foot pedal, it is preferably operated at the handlebar. In one embodiment, a cable is connected from the handlebar to the rear foot pedal. In a preferred embodiment, a hydraulic brake system is used to drive the rear foot pedal into the snow. A brake lever acts on a push rod connected to the piston in a master cylinder fitted with a brake fluid reservoir, transmitting force through a hydraulic brake fluid line to a pair of pistons, connected by a tee, which then push the foot pedal into the snow.”

[WO 03/106241]

(e) The description should indicate the way in which the invention is capable of being used or exploited in industry.

“The snowboard makes full contact with the snow substantially along its length and width (with a leading edge angled upwardly as on skis and snowboards), so that it is used in the same manner as a snowboard, but allows the user to hold onto the handlebar. The angle the post makes with the snowboard is adjustable, but then secured so that it doesn’t change while in use. By combining a snowboard with an upright post having handlebars on which hydraulics are used for braking, one obtains a snowboard scooter providing an unprecedented safe skiing experience.”

[WO 03/106241]

(f) If your application contains drawings, they should be briefly introduced in the description part.

“BRIEF DESCRIPTION OF THE DRAWINGS

Figure 1 is a front perspective front view of the snowboard scooter in accordance with one embodiment of the present invention in which cable operated brakes are provided; Figure 2 is a front view of the snowboard scooter; Figure 3 is a rear view of the snowboard scooter; Figure 4 is an elevational view of the left side of the snowboard scooter; Figure 5 is an elevational view of the right side of the snowboard scooter; Figure 6 is a top plan view of the snowboard scooter; Figure 7 is a bottom plan view of the snowboard scooter; Figure 8 is a front perspective front view of the snowboard scooter in accordance with a second embodiment of the present invention in which hydraulic brakes are provided; and Figure 9 is schematic view of the operating parts of the hydraulic brake system of Figure 8.”

[WO 03/106241]

So to summarize, the description should contain the following elements in this order:

- a. title of the invention and the field to which the invention relates;
- b. background information on the technology and field of invention making reference as much as possible to patents and/or other relevant documents. This background information forms what is commonly referred to as the “prior art” or “state of the art” of the technology to which your invention pertains;
- c. details on the technical problem which previously existed and how it was solved by your invention;
- d. an explanation of the best mode of putting your invention into practice and any other mode you may wish to include;
- e. an indication of the way in which the invention is capable of being used or exploited in industry; and
- f. a brief introduction of the drawings (if included in your PCT application).

3.1.4 The Claims

The claims define your invention. They must be clear, concise and fully supported by the description. If your application contains several claims, they should be numbered consecutively in Arabic numerals (e.g. 1, 2, 3, etc.).

Since the claims set out the scope of protection to which you are entitled, it is important that they be drafted broadly enough to protect you against potential infringers, while at the same time, specific enough as to be distinguished from all prior inventions.

“THE CLAIMS

1. A snowboard scooter for use on snow, comprising: a one-piece platform wide enough to accommodate the width of two feet; laterally disposed offset foot grips in predetermined positions on the platform; a fixable post extending upwardly from the platform; and a handlebar on the post.

2. The snowboard of claim 1 in which the platform is continuous.

3. The snowboard of claim 1 in which the platform is formed with a leading edge angled upwardly.

4. The snowboard of claim 1 including a brake arranged for interacting with snow.

5. The snowboard of claim 4 in which said brake is located on the longitudinal axis of the platform, on the rear edge thereof.

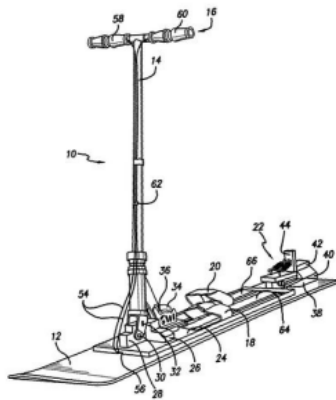
[...]”

[WO 03/106241]

3.1.5 The Drawings

Drawings are only required where they are necessary for the understanding of the invention. This will be the case for a mechanical invention or electrical invention. It will probably not be the case when an invention cannot be drawn, as is the case for a chemical product.

In each of the figures, you would provide reference signs or numerals for the various elements contained in the drawings, and provide corresponding explanations of their function and operation in the description.



"Referring first to Figures 1-7, in one embodiment of the invention, the snowboard scooter 10 of this invention is built on a snowboard 12 to which is fixed a post 14 carrying a handlebar 16 at its top end. A pair of left and right boot grips in the form of foot straps 18 and 20 are secured to the snowboard 12, and a brake assembly 22 is located at the rear of the snowboard 12. The snowboard 12 is of commercial construction, i.e., it can be a regular commercially available snowboard formed with a leading edge angled upwardly, modified to be fitted with the post 14 and brake assembly 22. In this embodiment, a platform 24 is preferably provided to secure the post 14 and foot straps 18 and 20 to the top of the snowboard 12, and provides certain advantages as will be described, but in its broader concept, the post 14, and foot straps 18 and 20 can be secured directly to the snowboard. The platform 24 is secured by strong adhesive, and/or by bolts (not shown) to the top surface of the snowboard 12 in such a way that no bolts extend below the bottom surface of the snowboard 12."

[WO 03/106241]

3.2 Other Formal Requirements

Lastly, the PCT application has to be prepared according to certain physical requirements (Rules [10](#) and [11](#)). These requirements deal, for instance, with the way in which weights, measures and temperatures are expressed, the kind of paper and the margins to be used, the manner in which text matter is to appear (printed or typed), the manner in which drawings are to be presented, etc.

Now that we have covered the elements that must be contained in a PCT application, the next module will look at the filing of that application.

Summary

Here is how [the entire application](#) looks when published.

Module 3 – End of Module Test

1. PCT applications must always be filed together with declarations in order to comply with national phase requirements.

- a) True
- b) *False*

Feedback: see Section 3.1.1.1

2. Information on “Prior Art” is not necessary as it will only dilute the chances of patent protection.

- a) True
- b) *False*

Feedback: see Section 3.1.3(b)

3. Which part of the application identifies the specific patent protection the applicant is seeking?

- a) the Request
- b) the Description
- c) *the Claims*
- d) the Drawings

Feedback: see Section 3.1.4

Module 4: Filing the PCT application

As we saw in the previous module, you can file a PCT application with your local or national patent Office, or directly with the International Bureau of WIPO if permitted by the national security provisions in your national law. Both the national patent Office and the International Bureau of WIPO (RO/IB) act as PCT “receiving Offices” because they receive PCT applications. If there is more than one applicant, the PCT application may be filed with the receiving Office that is competent for any of the applicants.

If you are a national or resident of a country which is a member of a regional patent treaty (the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention or the OAPI Bangui Agreement), you may also file your PCT application with the regional receiving Office, if this option is permitted under the applicable law.

4.1 The Receiving Office

The receiving Office receives your PCT application and the associated fees, and checks whether your application complies with the PCT's formal requirements. The check conducted by the receiving Office is of a formal nature only and does not go into the substance of the invention.

4.2 Checking for Defects

The receiving Office's check is divided into two parts. The first part concerns the requirements of according an international filing date as set out in [Article 11](#) and the second part concerns the formal and physical requirements as set out in [Article 14](#).

4.2.1 Minimum Requirements to Obtain an International Filing Date

In order to receive an international filing date (which is what gives rise to the multinational legal effect of the PCT application), the following conditions must be fulfilled:

- at least one of the applicants is a resident or national of a PCT Contracting State;
- the PCT application contains at least the following elements:
 - (a) an indication that it is intended to be a PCT application;
 - (b) the name of at least one applicant;
 - (c) a description; and
 - (d) a claim or claims.

If any of these requirements is not complied with, the receiving Office will invite the applicant to correct the defect and the international filing date will be the date on which the correction is received. If not all such defects are properly corrected, the application will not be treated as a PCT application.

However, in respect of the later furnishing of certain elements of the application, which would constitute a defect under [Article 11](#), or the later furnishing of certain parts of the application, remedies are available to correct defects without affecting the international filing date, as explained in the next Section.

4.2.2 Later Furnishing of Certain Elements or Parts of the PCT Application

At the time of filing, you may have forgotten to include certain elements or parts of the application. An “element” is the entire portion of the PCT application containing the description, or the entire portion containing the claims. A “part” refers to a portion within an element, for example, a portion of the description or a portion of the claims. A “part” also refers to part or all of the pages of drawings.

You may be able to submit missing elements and/or parts after the original filing of your PCT application and preserve the international filing date, provided that the missing elements and/or parts are fully contained in the priority document, subject to certain conditions being met.

This procedure is referred to as “incorporation by reference” and is also found in some national patent systems.

Detailed information on the procedure relating to the later furnishing of certain elements or parts of the PCT application and its effect on the international filing date may be found in the PCT Applicant’s Guide (paragraphs [6.026-6.031](#)).

4.2.3 Compliance with Physical Requirements and Payment of Fees

If the receiving Office determines that the PCT application contains certain formality defects, i.e. physical requirements not met, or finds that you have not paid all the required fees, the receiving Office will provide you with an opportunity to correct any defect which may exist. Correction of these defects and payment of the required fees within the applicable time limits under the PCT will not affect the international filing date.

4.3 Claiming Priority

Generally, patent applicants who wish to protect their invention in more than one country first file a national or regional patent application with their national or regional patent Office. Applicants then have 12 months from the filing date of that first application (a time limit set in the Paris Convention for the Protection of Industrial Property), to file subsequent applications for the same invention in foreign countries in which they would like to have patent protection. All subsequent applications filed in this manner are considered, for the purposes explained below, as if they had been filed on the same day as the first application.

The main benefit from claiming priority is that the filing date of the earliest filed application is used to determine the state of the art, giving you valuable rights and benefits. By using the earliest filing date possible, only technology that is known before this date may be used as a reference against your patent application. Claiming priority also gives your application precedence over other applications for the same invention which may have been filed after the earliest filing date of your application. You may also claim priority to an earlier-filed PCT application.

4.3.1 Restoration of the Right of Priority

If you have missed the 12-month priority period, i.e. if the PCT application is filed after the expiration of 12 months from the filing date of the earlier application whose priority is claimed, that would normally mean that you would no longer be able to validly claim the priority of the earlier application. However, under the PCT you may request the “restoration of the right of priority” of an earlier-filed application, provided that the PCT application is filed within two months from the date on which the priority period expired (so effectively within 14

months from the priority date). In respect of such a priority claim, a request for the restoration of the right of priority could be made, subject to certain conditions prescribed under [Rule 26bis.3](#), during the international phase with the receiving Office.

A request for restoration of the right of priority should be accompanied by a statement of reasons explaining the circumstances which prevented the filing of the PCT application within the priority period. If restoration is requested under the “unintentional” criterion, a short simple statement such as “I forgot to file” is usually sufficient. If, however, restoration is requested under the stricter due care criterion (which ends up being more advantageous for applicants in the national phase), the applicant is required to demonstrate that he has taken all measures that a prudent applicant would have taken. The receiving Office generally forwards all documents in relation to a restoration request to the International Bureau, unless they contain sensitive information.

Irrespective of whether the restoration of the right of priority is requested, accepted or refused by the receiving Office, any priority claim to an earlier application filed less than 14 months before the international filing date will remain in the PCT application, and will serve as a basis to calculate all time limits during the international phase, provided that the priority in question is the only or the earliest priority claim in the PCT application. However, the fact that the priority claim is retained in the PCT application does not mean that the validity of such a priority claim is assured in the national phase. Detailed information on the procedure relating to the restoration of the right of priority may be found in the PCT Applicant’s Guide (paragraphs [5.062-5.069](#) and paragraphs [6.041-6.044](#)).

4.3.2 Addition or Correction of the Priority Claim

If you wish to correct or add a priority claim in relation to a previously filed PCT application, a notice to this effect is to be submitted to the receiving Office or the International Bureau within the prescribed time limit under [Rule 26bis.1\(a\)](#). If the correction or addition of a priority claim causes a change in the [priority date](#), all PCT time limits that have not already expired will be recalculated to reflect the change in the [priority date](#).

4.4 Priority Document

A certified copy of the earlier-filed application (“[priority document](#)”) has to be submitted either to the International Bureau or to the receiving Office within 16 months from the priority date—a copy of this document will be forwarded to the designated Offices in the national phase so that they can determine the validity of the priority claim. If the earlier application (of which priority is claimed) was filed with the same national or regional office which is now the receiving Office for your PCT application, it is recommended that you request the receiving Office, within the 16-month time limit, to prepare and transmit the priority document directly to the International Bureau on your behalf. If the [priority document](#) is received after the 16-month time limit but before international publication has taken place, it will be considered as timely received.

The [priority document](#) may also be available from a digital library that is accessible by the International Bureau. Should this be the case, you may request that the [priority document](#) be obtained directly from the digital library before the date of international publication.

4.5 Language of the PCT Application

If the language in which you file your PCT application is accepted by the receiving Office, but is not accepted by the ISA that is to carry out the international search, you will be required to furnish, within one month from the filing of the application, a translation into a language which

is all of the following:

- (i) a language accepted by the ISA that is to carry out the international search;
- (ii) a language of publication (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, or Spanish); and
- (iii) a language accepted by the receiving Office (unless the PCT application is filed in a language of publication).

If you do not furnish a translation for the international search within the applicable time limit, the receiving Office will invite you to furnish the missing translation. This may be the subject of a late furnishing fee in certain instances. If you do not submit the missing translation in time, your PCT application, subject to certain safeguards, will be considered and declared withdrawn by the receiving Office.

If the language in which you filed your PCT application is accepted by both the receiving Office and the ISA that is to carry out the international search, but is not a language of publication, you will be required to furnish, within a specified time limit a translation into a language of publication accepted by the receiving Office for that purpose. If you fail to furnish this translation in time, the PCT application, subject to certain safeguards, will be considered and declared withdrawn by the receiving Office.

If the PCT application is filed in a language which is not accepted by the receiving Office, the application will be transmitted to the International Bureau, unless this is prevented by national security prescriptions. In fact, the International Bureau as receiving Office accepts PCT applications filed in any language. In such a case, the PCT application is considered to have been received by the receiving Office on behalf of the International Bureau.

4.6 Fees Payable

The following fees associated with the filing of your PCT application are payable to the receiving Office (the fees in *italics* are only payable in certain circumstances):

- transmittal fee (which is intended to compensate the receiving Office for its work in carrying out the formality examination of the application);
- international filing fee* (which is intended to cover the costs of the international processing carried out by WIPO on each PCT application);
- search fee** (which goes to the ISA for its work in carrying out the international search);
- *supplement per sheet in excess of 30 sheets**
- *fee for priority document*
- *late payment fee*
- *late furnishing fee (translation of PCT application)*
- *fee for requesting restoration of the right of priority*
- *fee for copies of documents*

* collected by the receiving Office for the International Bureau

** collected by the receiving Office for the International Searching Authority

Generally, you have up to one month from the date that the receiving Office receives your PCT application to pay the transmittal fee, international filing fee, and search fee.

If you do not pay your fees on time, the receiving Office will invite you to pay the missing fees within one month from the date of that invitation. The receiving Office may require a late payment fee of 50% of the missing amount. If the fees remain unpaid, your application will be considered and declared withdrawn by the receiving Office.

The PCT also provides a 90% reduction in the international filing fee for PCT applications from least developed countries and a number of other countries [<https://www.wipo.int/export/sites/www/pct/en/fees.pdf>].

The PCT also provides reductions in the international filing fee for PCT applications filed in electronic form (see Module 5).

Module 4 - End of Module Test

1. The receiving Office checks the formal requirements and NOT the substance of your PCT application.

- a) *True*
- b) *False*

Feedback: see Section 4.1

2. If the receiving Office finds that certain formal requirements are not met, does the applicant have the opportunity to correct these defects?

- a) *Yes*
- b) *No*

Feedback: see Section 4.2.3

3. Applicants have _____ from the filing date of their first application to file subsequent applications (claiming priority from the first application) in foreign countries.

- a) *2 months*
- b) *3 months*
- c) *12 months*
- d) *24 months*

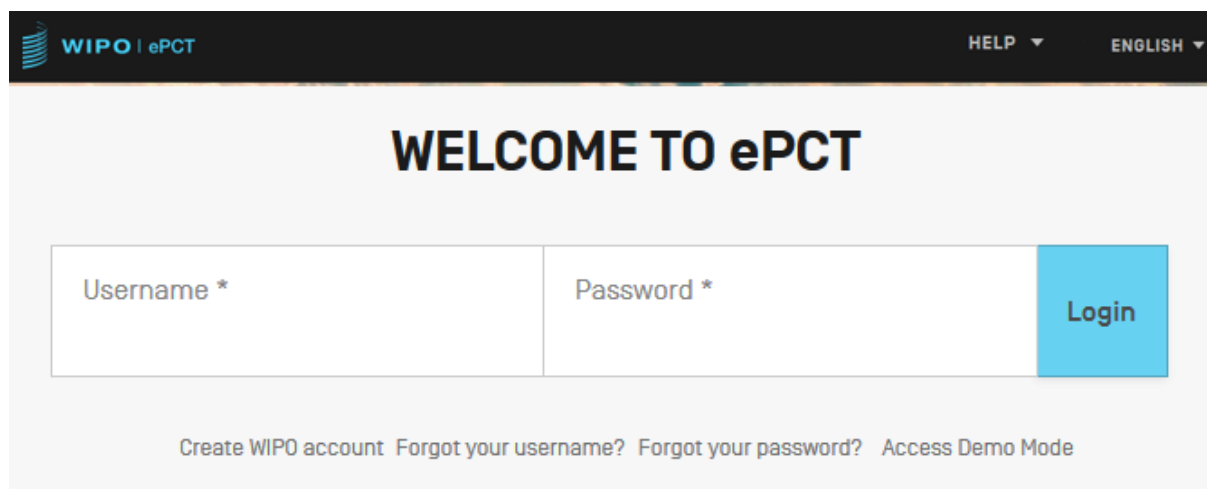
Feedback: see Section 4.3

Module 5: PCT Electronic Services

This module provides background information on various electronic tools that can be used to prepare, file and manage PCT applications. It also provides information on how to conduct searches and retrieve patent information using [PATENTSCOPE](#), WIPO's central repository for PCT applications and a number of national document collections.

You should be aware that receiving Offices may offer other means of preparing, filing or managing PCT applications electronically instead of or in addition to [ePCT](#) and [PCT-SAFE](#). However, the two electronic systems provided by WIPO are discussed in further detail below.

5.1 ePCT



[ePCT](#) is WIPO's online portal for the filing, management, and monitoring of PCT applications.

In ePCT, you are able to view the contents of the PCT application file maintained by the International Bureau. The PCT application file in ePCT contains all related documents and the most current bibliographic information. Transactions may be conducted in ePCT either by submitting certain actions or by uploading documents to the International Bureau or participating Offices and Authorities.

Applicants and other authorized individuals are able to monitor the status of PCT applications and make modifications as necessary in real-time. It is also possible to communicate informally with PCT examiners at the International Bureau in any of the ten PCT publication languages using a secure interface. PCT deadlines may be tracked and monitored using the integrated graphical timeline. In addition, ePCT automatically generates notifications and reminders when specific actions need to be taken, or when important time limits are close to expiring.

Access to PCT applications is managed by a system of differentiated access rights. These rights can be assigned to multiple individuals as required, namely, "eOwner", "eEditor", and "eViewer."

These differentiated access rights are summarized as follows:

- **eOwner** has complete control over the PCT application, can assign and modify access rights, and can conduct PCT transactions;
- **eEditor** can conduct PCT transactions but cannot assign or modify access rights; and

- **eViewer** can only view the contents of the PCT application file.

All PCT transactions must contain the signature of the applicant or agent in the appropriate signature field.

5.1.1 ePCT authentication options

App for one-time password

Digital certificate

Text message (SMS) with one-time password

No thanks, sign in without strong authentication

Authentication method *

OK

In order to access the full range of features and functions in ePCT, you must connect with strong authentication using one of the following options:

- app with One-Time Password (OTP) which requires the installation of an authenticator app (e.g. Google Authenticator) on a smartphone;
- [digital certificate](#); or
- SMS text message with One-Time Password (OTP).

Instructions on how to configure ePCT strong authentication are available from the PCT eServices Support/Help page www.wipo.int/pct/en/epct/support.html.

5.1.2 ePCT-Filing

ePCT-Filing of PCT applications is available to all PCT applicants. PCT applications may be filed using ePCT-Filing with the receiving Office of the International Bureau (RO/IB) and with a number of other participating Offices.

ePCT-Filing is a web-based system that uses a browser-based user interface. Such a web-based system has many advantages for PCT users as it requires no software installation, is always up-to-date with the latest information and fees, and can be used on a variety of different operating systems. In addition, ePCT-Filing includes real-time validation checks on the data that was entered by the applicant against the database of the International Bureau. The system provides immediate feedback if any errors have been detected which limits the possibility of additional defects being detected at a later stage.

If you file the PCT application using ePCT-Filing, you will benefit from a fee reduction on the international filing fee of either CHF 200 or CHF 300, depending on the filing format selected. When filing with RO/IB, PCT applications can be filed in any language with the exception of the request form which has to be in a language of publication.

Another advantage of using ePCT-Filing is that you are automatically given eOwner access rights (“eOwnership”) at the time of filing. This gives you immediate access to the file of the PCT application including the full range of management options.

5.2 Electronic Filing Using PCT-SAFE

WIPO’s electronic filing software, [PCT-SAFE](#) (Secure Applications Filed Electronically), offers an alternative software tool for preparing and filing PCT applications electronically. It is WIPO’s intention to be able to eventually phase out [PCT-SAFE](#) in favor of ePCT-Filing.. [PCT-SAFE](#) can be used to file applications using a secure on-line transmission or via physical media such as CD-ROM or DVD, depending on the electronic filing options accepted by the receiving Office.

5.2.1 The Different PCT-SAFE Modes

The [PCT-SAFE](#) software may be operated in two different modes:

(a) Fully Electronic

The entire application is prepared in electronic form (image or character-coded).

(b) PCT-SAFE for EFS-Web filing

This mode is used exclusively for electronic filings with the receiving Office of the United States (RO/US): the PCT-SAFE mode is used to prepare a zip file that is then uploaded to a PCT electronic filing in EFS-Web, along with the application documents. The zip file contains the request form, abstract, and fee data.

5.2.2 PCT-SAFE Fee Incentives

As mentioned earlier in Chapter 5.1.2 ePCT-Filing, the same fee reductions also apply to applications filed via PCT-SAFE.

5.3 PATENTSCOPE

[PATENTSCOPE](#) is a free WIPO database that provides access to the technical information contained in published PCT applications and in patent documents from a large number of national patent collections. The PCT and national patent documents contained in [PATENTSCOPE](#) are full-text searchable. For published PCT applications filed on or after January 1, 2009, complete access to the public file is also provided. The PATENTSCOPE search system is available in the ten PCT publication languages.

[PATENTSCOPE](#) is available on the internet at:
[\[https://patentscope.wipo.int/search/en/search.jsf\]](https://patentscope.wipo.int/search/en/search.jsf)

The content may be searched by entering keywords, names of applicants, international patent classification and many other search criteria in multiple languages. User-friendly functionalities make it easy to search patent documents contained in the database. Complete documents may be printed or downloaded, free of charge, search results can be visualized through graphical analysis tools, and technology developments in specific areas can be tracked through RSS feeds.

The [PATENTSCOPE](#) search system is multilingual and includes state-of-the art language tools to facilitate patent search, e.g. synonym matching (Cross Lingual Expansion). In addition, free machine translation tools have been integrated allowing users to translate titles and abstracts and to view the descriptions of patent documents in the preferred language. It also includes a multilingual terminology portal, [WIPO Pearl](#), which gives access to scientific and technical terms derived from patent documents developed by PCT language experts in all ten PCT publication languages.

[PATENTSCOPE](#) also includes the following additional features:

- information from a [number of countries](#) on national phase entry of PCT applications, including status information, such as patent grant, withdrawal or refusal;
- information on PCT applications that are available for licensing; and
- a system for providing third party observations.

Module 5 - End of Module Test

1. PCT applications may be filed electronically.

- a) *True*
- b) *False*

Feedback: see Section 5.1

2. Only the PCT-SAFE software may be used to file an electronic application.

- a) *True*
- b) *False*

Feedback: see Sections 5.1, 5.1.1, and 5.2

3. To file a fully electronic PCT application, you need strong authentication.

- a) *True*
- b) *False*

Feedback: see Sections 5.1.2 and 5.2.

4. ePCT can only be used with a digital certificate.

- a) *True*
- b) *False*

Feedback: see Section 5.1

5. PATENTSCOPE is a search database that only contains PCT applications.

- a) *True*
- b) *False*

Feedback: see Section 5.3

Module 6: Patent Agents and Common Representatives

6.1 Agents

Agents are patent specialists who can assist you with all aspects of the PCT procedure, ranging from preparing your application to performing various acts on your behalf during the international and subsequently the national phase procedures before the national or regional patent Office.

An agent is, in most situations, an attorney or patent agent who has been qualified to practice before a national patent Office. Agents who are entitled to practice before a national patent Office can also practice before the International Bureau, the ISA and the IPEA, provided that they are expressly appointed by the applicant.

An agent appointed by all the applicants is referred to as a “common agent.”

6.2 Common Representatives

One of the applicants, who is entitled to file a PCT application (i.e., who is a resident or national of a PCT Contracting State), may be appointed by all the other applicants as the common representative in order to be the primary contact point for the PCT application.

In situations where neither an agent nor a common representative has been appointed, the first-named applicant in the request who is entitled to file a PCT application with the receiving Office concerned is automatically “deemed” to be the common representative.

The “deemed” common representative receives all the correspondence and may perform most of the acts on behalf of the other applicants, except for withdrawals (of the PCT application itself, designations, priority claims, demand or elections, withdrawals will be covered in Module 11 Special international phase procedures). For withdrawals, the signatures of all applicants are required. A agent or common representative appointed by all applicants may sign a notice of withdrawal.

6.3 Appointment of Agents and Common Representatives

Agents and common representatives may be appointed in the following ways:

- in the PCT request form [Form PCT/RO/101 Box No. IV] or, under Chapter II, in the demand (the “demand” will be explained in Module 9 The International Preliminary Examination);
- in a “separate” power of attorney (form can be found at [https://www.wipo.int/export/sites/www/pct/en/forms/pa/editable/ed_power.pdf]) relating to a given PCT application; or
- in a “general” power of attorney (form can be found at [https://www.wipo.int/export/sites/www/pct/en/forms/pa/editable/ed_genpower.pdf]) relating to all PCT applications filed in the name of the applicant.

Where there are more than two applicants, it is sufficient that the request, the demand or a separate power of attorney is signed by at least one applicant. Any appointment of an agent

or common representative may also be revoked by a notice addressed to either the receiving Office or the International Bureau.

6.4 Powers of Attorney

A power of attorney is a legal document that gives another person the power to act for you. In the PCT context, the power of attorney permits another person to perform various tasks of the patent procedure on your behalf. Powers of attorney are to be filed with the receiving Office, or where applicable, with the International Bureau, ISA or IPEA.

The applicant or agent may attach a separate power of attorney to the file of a PCT application or may deposit a general power of attorney for multiple PCT applications with the applicable Office or Authority. That said, certain receiving Offices, ISAs, IPEAs and the International Bureau have waived the requirement that separate and general powers of attorney be furnished (power of attorney waiver), which reduces the administrative burden for applicants and Offices. Details of such waivers can be found on the WIPO website at [\[https://www.wipo.int/pct/en/texts/waivers.html\]](https://www.wipo.int/pct/en/texts/waivers.html).

It is important to note that the power of attorney waiver does not apply in respect of any notice of withdrawal. If no power of attorney was submitted at the time of filing, the notice of withdrawal needs to be signed by either all the applicants, the common agent, or the common representative. If signed by the common agent or common representative, the notice of withdrawal must also be accompanied with a properly executed (signed by all the applicants) separate or general power of attorney. Applicants are therefore well advised to have all the required powers of attorney readily available for a last minute withdrawal to have effect, in particular, if the withdrawal notice is intended to postpone or prevent international publication of the PCT application (see Module 11 Section 11.1).

Module 6 - End of Module Test

1. A “common agent” must be appointed by all the applicants.

- a) *True*
- b) *False*

Feedback: see Module 6 introduction

2. A “deemed” common representative may perform all of the tasks of the patent procedure on behalf of all the applicants.

- a) *True*
- b) *False*

Feedback: see Section 6.1

3. An applicant can only be appointed as common representative if this person is entitled to file the PCT application with the receiving Office concerned.

- a) *True*
- b) *False*

Feedback: see Section 6.2

Module 7: International Search Report and Written Opinion of the ISA

This Module deals with the procedure before the International Searching Authority (ISA). As part of the PCT procedure, you will in virtually every case receive an international search report (ISR) and a written opinion from one of the following 23 ISAs which has been appointed by the PCT Contracting States:

- Australian Patent Office
- Austrian Patent Office
- Brazilian National Institute of Industrial Property
- Canadian Intellectual Property Office
- Egyptian Patent Office
- European Patent Office
- Federal Service for Intellectual Property (Rospatent) (Russian Federation)
- Finnish Patent and Registration Office
- Indian Patent Office
- Intellectual Property Office of Singapore
- Israel Patent Office
- Japan Patent Office
- Korean Intellectual Property Office
- National Institute of Industrial Property (Chile)
- National Patent Office of Ukraine
- Nordic Patent Institute
- Spanish Patent and Trademark Office
- National Intellectual Property Administration, PRC (CNIPA)
- Swedish Patent and Registration Office
- Turkish Patent and Trademark Office (Turkpatent)
- United States Patent and Trademark Office
- Visegrad Patent Institute

The Intellectual Property Office of the Philippines holds an appointment as an ISA but is not yet operating as such.

The receiving Office decides which ISA is “competent” to perform the international search and establish the written opinion. If your receiving Office has appointed more than one competent ISA, you can choose between them, taking into account differing requirements relating to language, fees, etc.

7.1 Search Procedure

The objective of the international search is to discover what is referred to as “relevant prior art.” According to the PCT definition, “prior art” consists of everything which has been made available to the public anywhere in the world by means of a written disclosure (including drawings and other illustrations). The prior art is “relevant” if it is capable of being of assistance in determining whether the claimed invention is new, involves an inventive step, and if it was made available to the public before the international filing date.

The documents in which the search is made are constituted by the so-called “PCT minimum documentation.” In general terms, the PCT minimum documentation comprises the published patent documents issued since 1920 by the People’s Republic of China, France, Germany (until 1945) and the Federal Republic of Germany (since 1949), Japan, the Republic of Korea, the former Soviet Union and the Russian Federation, Switzerland (except documents in Italian), the United Kingdom, the United States of America, the African

Regional Industrial Property Organization, the African Intellectual Property Organization, the Eurasian Patent Office and the European Patent Office. The PCT minimum documentation also includes all PCT applications published by the International Bureau, as well as patent documents published in any other country after 1920, in English, French, German or Spanish, provided no priority is claimed and the country places them at the disposal of each ISA. Finally, the documentation comprises non-patent literature contained in some 145 technical periodicals.

ISAs are obliged to consult not only the PCT minimum documentation, but also any additional documentation at their disposal. For the Authorities which do not have Chinese, Japanese, Korean, Russian or Spanish as an official language, there is a special exception under which these Authorities are only required to search documents in those languages to the extent that English abstracts are generally available.

Where the PCT application is so unclear that a meaningful search cannot be carried out, the ISA will make a declaration that it will not establish a search report. The same will occur if the invention contains subject matter excluded from international search as defined under the PCT and enumerated below.

7.1.1 Subject Matter Excluded from International Search

The ISA may refuse to carry out a search if the invention in your PCT application falls into one of the following six categories:

- (i) scientific and mathematical theories,
- (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
- (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
- (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods,
- (v) mere presentations of information, or
- (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs.

The ISA may only refuse to conduct a search on the above excluded subject matter if the same exclusion applies to applications filed nationally.

7.1.2 Unity of Invention and Protest Procedure

The ISA examines whether your PCT application complies with the requirement of unity of invention, which means that your PCT application must either relate to only one invention or to a group of inventions which share a common technical feature so as to form a single general inventive concept.

If the ISA finds that unity of invention is lacking, it will invite you to pay an additional search fee for each additional invention claimed in the PCT application. You may pay the additional fees under protest. Your protest will be examined by a review body that may authorize the

full or partial reimbursement of the additional fees. The ISA will only establish a search report for those inventions for which a search fee or additional search fee has been paid.

7.1.3. Results of Earlier Search

The applicant may request the ISA to take into account in carrying out the international search, the results of an earlier international search, international-type search or national search carried out either by the same ISA, by another ISA or by any national (regional) Office. Upon request, the receiving Office will forward those earlier search results to the ISA.

Independent from any request that is made to the ISA that an earlier search be taken into account, the receiving Office, as a general rule, will forward search and classification results from earlier applications to the ISA where the receiving Office has conducted the earlier search itself or has otherwise access to the search and classification results.

7.2 International Search Report

The ISA will establish an international search report (ISR) (Form [PCT/ISA/210](#)) containing the citations of documents considered to be relevant, the classification of the subject matter of your invention according to the [International Patent Classification](#) (IPC), an indication of the fields of technology and the electronic databases which were searched.

It identifies the claims to which cited documents are relevant and also contains an indication of the category of the cited document and its relevance with respect to assessment of novelty or inventive step.

Citations of documents which were made available to the public before the international filing date of your application are considered as prior art.

7.3 Written Opinion

The ISA will establish, at the same time as the ISR, a preliminary and non-binding written opinion on the patentability of your invention. This patentability opinion will be based on an assessment of your invention against the criteria of novelty, inventive step (non-obviousness) and industrial applicability.

For the purposes of the written opinion, the relevant prior art date is the [priority date](#). It is recalled that the prior art date for the ISR is different and is the international filing date (see Module 4 Section 4.2.1 and Module 7 Section 7.2).

The written opinion of the ISA is established in the same language as the ISR, and is communicated to the applicant and to the International Bureau together with the ISR. The ISR and the written opinion are typically available to the applicant at 16 months from the [priority date](#).

The written opinion is made publicly available on [PATENTSCOPE](#) in its original language at the same time that the ISR is published. However, the IPRP Chapter I and its translation are only established at 30 months from the priority date (see Module 7.6 below).

7.4 Informal Comments

There are no special PCT provisions under which you can comment on the written opinion of the ISA. However, it is possible to make comments on the written opinion on an informal basis. You may wish to make informal comments if you are not entirely satisfied with the

written opinion of the ISA and wish to place on file any comments, arguments or observations.

Informal comments are to be sent directly to the International Bureau and not to the ISA. Any informal comments received by the International Bureau are made publicly available on [PATENTSCOPE](#) at the same time as the written opinion.

If no demand for international preliminary examination (explained in Module 9) is filed, the International Bureau communicates the informal comments to all national Offices together with the international preliminary report on patentability (IPRP (Chapter I)) after the expiration of 30 months from the [priority date](#) (see Section 7.6 below). Some national Offices may require a translation of the informal comments.

7.5 Amendment of the Claims before the International Bureau (Article 19)

After receipt of the ISR and written opinion of the ISA, you may choose to amend the claims of your PCT application (Form [PCT/ISA/220](#)). During the procedure under Chapter I of the Treaty, i.e. if you do not intend to file a demand for international preliminary examination (see Module 9) you only have one opportunity to amend the claims, which must not go beyond the disclosure of the PCT application as filed. You may also, at the same time, file a brief statement explaining the amendments and any impact that they may have on the description and drawings. The amendment of the claims in this manner is commonly referred to as Article 19 amendments.

Your Article 19 amendments must normally be filed within two months from the date of transmittal of the ISR and written opinion of the ISA or 16 months from the [priority date](#), whichever expires later. Article 19 amendments are to be filed directly with the International Bureau and not the ISA. They are published as part of the PCT application at 18 months from the [priority date](#), together with the claims as originally filed.

Article 19 amendments are typically used to better define provisional protection that may be accorded to your PCT application in certain jurisdictions upon international publication which will be covered in Module 8.

7.6 The International Preliminary Report on Patentability (Chapter I)

If you do not file a demand for international preliminary examination (see Module 9), the written opinion of the ISA will be converted by the International Bureau (RO/IB) into an international preliminary report on patentability (IPRP) (Chapter I) ([Form PCT/IB/373](#)). The IPRP (Chapter I) is communicated to all national Offices, together with any informal comments, after the expiration of 30 months from the [priority date](#).

7.7 Supplementary International Search

The applicant has the option of requesting, in addition to the “main” international search, one or more supplementary international searches to be carried out by other International Searching Authorities (Form [PCT/IB/375](#)).

The intent of supplementary international search is to provide for a more complete overview of the prior art particularly in situations where specific language coverage is desired, e.g. a language not typically searched by the International Searching Authority conducting the main international search.

The request for supplementary international search must be filed with the International Bureau within 22 months from the [priority date](#). The relevant fees must be paid within one month of submitting the request.

The International Searching Authority selected for supplementary international search (Supplementary International Searching Authority (SISA)) conducts a search on the PCT application as filed, taking into account the ISR and the written opinion established by the ISA, should these documents be available before the start of the supplementary international search.

The supplementary international search service is not offered by all International Searching Authorities. Information on which International Authorities provide supplementary international search, and under what conditions, is contained in the [PCT Applicant's Guide, Annex SISA](#).

7.7.1 Supplementary International Search Report

The SISA is to establish a supplementary international search report (SISR) ([PCT/SISA/501](#)) within 28 months from the [priority date](#). The report has essentially the same content as the main international search report.

The SISR is not accompanied by a written opinion but may include certain explanations with regard to the citations and the scope of the search which might otherwise have been included in a written opinion.

The SISR is made available as part of the file of the PCT application on [PATENTSCOPE](#) once it becomes available.

7.7.2 Fees Payable

In connection with a supplementary search request, two kinds of fees are due: the supplementary search handling fee for the benefit of the International Bureau and the supplementary search fee set by each Authority offering the service. Applicants from certain States may be eligible for a 90% reduction in the supplementary search handling fee. You can find information about PCT fees on the WIPO website at [\[https://www.wipo.int/pct/en/fees/index.html\]](https://www.wipo.int/pct/en/fees/index.html).

Module 7 - End of Module Test

1. As part of the PCT procedure, you will receive an international search report and written opinion from:

- a) all competent International Searching Authorities
- b) all competent International Searching Authorities in your region
- c) *a competent International Searching Authority specified by the receiving Office with which you filed your application*
- d) the International Bureau of WIPO

Feedback: see Module 7 introduction

2. The main objective of the international search is to:

- a) search all published patent documents
- b) check for subject matter which may be excluded
- c) *discover "relevant prior art"*
- d) search only those documents that have English abstracts available

Feedback: see Section 7.1

3. The "competent" International Searching Authority **MUST** establish a search report.

- a) True
- b) *False*

Feedback: see Sections 7.1 and 7.1.1

4. The written opinion of the International Search Authority is binding for designated Offices in the national phase.

- a) True
- b) *False*

Feedback: see Section 7.3

5. The International Search Report and written opinion are typically available at:

- a) 12 months from the priority date
- b) *16 months from the priority date*
- c) 18 months from the priority date
- d) 30 months from the priority date

Feedback: see Section 7.3

6. Amendments to the claims under Article 19 are to be filed directly with:

- a) *the International Bureau*
- b) the International Searching Authority
- c) your national receiving Office

Feedback: see Section 7.5

7. A supplementary international search is performed on every PCT application.

- a) True
- b) *False*

Feedback: see Section 7.7

8. The request for supplementary international search must be filed with:

- a) the receiving Office
- b) the International Searching Authority that you wish to conduct the supplementary international search
- c) *the International Bureau*

Feedback: see Section 7.7

Module 8: International Publication

The International Bureau is responsible for the international publication of all PCT applications, and carries out that publication shortly after the expiration of 18 months from the [priority date](#). If you claim the priority of an earlier filed application, and you file your PCT application close to the end of the 12-month priority period (see Module 4 Section 4.3), international publication will usually take place as soon as possible after the expiration of 6 months from the international filing date.

International publication can also take place earlier if you so request.

8.1 Effects of International Publication

International publication entitles you to provisional protection in PCT countries if such protection is granted for published applications. Provisional protection provides the applicant in some countries with certain rights (usually monetary damages for use of the invention in that country) back to the point when the application was published. This provisional protection may be made conditional on:

- the furnishing of a translation (which may be of the claims only);
- receipt by the designated Office of a copy of the PCT application as published under the PCT; and/or
- expiration of 18 months from the [priority date](#) (if the PCT application was published early).

A PCT application becomes prior art as of its international publication date.

All published PCT applications are available on [PATENTSCOPE](#) for consultation and review by third parties. Third parties have an opportunity to submit prior art observations that they believe may be relevant to the determination of novelty and inventive step for a particular PCT application. Applicants may respond to any such third party observations should they so choose.

8.2 Content of the International Publication

The PCT application is published electronically with the full text of the application as filed by the applicant. It is published together with a title page containing bibliographic data of the PCT application taken from the request form. The international publication also includes the international search report (ISR), and any amendments of the claims filed by the applicant under Article 19, if timely filed [see 8.4.2 below]. The written opinion of the International Searching Authority (ISA) is not part of the publication of the PCT application, but is made publicly available on [PATENTSCOPE](#) at the same time that the ISR is published.

Provided that the necessary requirements have been met, you may request the International Bureau to omit from international publication certain sensitive information contained in the PCT application.

On the same date that the PCT application is published, data about the application (including bibliographic data, the title of the invention, the abstract and a representative drawing (if any)) are also made available on the WIPO website as part of the *PCT Gazette*.

8.3 Language of Publication

If the PCT application is filed in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish (“languages of publication”), it is published in one of those languages. Where the PCT application is not published in English, the title of the invention, the abstract and the international search report are translated into and published in English by the International Bureau.

If the PCT application is not filed in a language of publication, it is published in the language of the translation provided by the applicant either for international search or international publication.

8.4 The Gazette (“PCT Gazette”)

The PCT Gazette is published electronically on the WIPO website in English and French (see [PCT Resources](#)). It contains not only notices and indexes relating to the publication of individual PCT applications, but also other general information concerning the PCT.

8.4.1 Frequency of Publication

Publication takes place every week, usually on Thursday.

8.4.2 Technical Preparations for Publication

The technical preparations for international publication are completed by the 15th calendar day before the actual publication date. Amendments of the claims under Article 19, submitted within the applicable time limit but after completion of the technical preparations for publication, will be published promptly after receipt by the International Bureau.

Technical preparations may be completed more than 15 days before the publication date where that publication date is not the “usual” Thursday because the International Bureau is not open for business or where there are a number of official holidays falling within that 15-day period. These changes in publication dates are announced in the [PCT Newsletter](#).

8.5 Preventing Publication

There may be certain situations where you would want to prevent the publication of your PCT application. The only way to prevent publication is by withdrawing the PCT application before the International Bureau has completed the technical preparations for publication.

You can make the withdrawal conditional on the international publication not taking place, thus making the withdrawal of the PCT application only effective if the notice of withdrawal reaches the International Bureau before the completion of the technical preparations for international publication. Thus, the undesirable result of an application being withdrawn but nevertheless published is avoided.

8.6 Postponing Publication

If you wish to postpone publication, you can do so by withdrawing the (earliest) priority claim. The withdrawal procedure is explained in detail in Module 11.1.

You can make your withdrawal conditional on the timely receipt of the notice by the International Bureau. This allows you to ensure that the priority claim is withdrawn only if the International Bureau receives the withdrawal notice in time.

If a priority claim is withdrawn, all time limits computed on the basis of the [priority date](#) which have not yet expired are recalculated on the basis of any remaining [priority date](#) or the international filing date, in particular, for:

- international publication;
- filing of a demand; and
- entry into the national phase.

It is important to note that before withdrawing a priority claim, you should consider the potential impact that the withdrawal of the priority claim may have on the patentability of your invention, since you will no longer have the benefit of an earlier filing date.

Module 8 - End of Module Test

1. Publication of your PCT application can ONLY take place 18 months after the priority date.

- a) *True*
- b) *False*

Feedback: see Module 8 introduction

2. PCT applications are published:

- a) *every day*
- b) *every week*
- c) *every two weeks*
- d) *once per month*

Feedback: see Section 8.4.1

3. Publication of your PCT application may be prevented or postponed.

- a) *True*
- b) *False*

Feedback: see Sections 8.5 and 8.6

Module 9: International Preliminary Examination

International preliminary examination is an optional feature within the international phase available under Chapter II of the PCT. It is undertaken by an International Preliminary Examining Authority (IPEA), one of the Offices which are also International Searching Authorities (ISAs) (see Module 7). The receiving Office with which you filed your PCT application has appointed the IPEA which is “competent” to perform international preliminary examination. If your receiving Office has appointed more than one competent IPEA, you can choose between them, taking into account differing requirements relating to search, such as language, fees, etc.

The international preliminary examination gives you the benefit, before entering the national phase, of an additional assessment from an IPEA on whether your invention appears to be novel, involves an inventive step (non-obvious), and is industrially applicable. This may provide you with greater certainty on your chances of obtaining a patent.

You may consider international preliminary examination if, as a result of the prior art identified in the international search and the written opinion of the ISA, you wish to amend your PCT application. During the international preliminary examination procedure, you can amend the description, claims and drawings of your PCT application. This enables you to further refine your PCT application, which may be useful during the patent granting procedures in the national phase.

While international preliminary examination is not binding for the purposes of national or regional examination, it is increasingly seen by national and regional Offices as persuasive. It may, in some Offices, result in a reduced examination fee in the national or regional phase.

9.1 The Demand

The “demand” is a PCT term that is used to describe the request for international preliminary examination. The demand automatically indicates that you intend to use the results of international preliminary examination in all PCT countries. The Offices of the countries where the international preliminary examination results will be used are referred to as “elected” Offices.

The demand ([Form PCT/IPEA/401](#)) is to be submitted to a competent IPEA within three months from the date of transmittal to the applicant of the ISR and the written opinion of the ISA, or within 22 months from the [priority date](#), whichever period expires later.

If the demand is filed with an IPEA which is not competent for carrying out international preliminary examination, or with a receiving Office, an ISA or the International Bureau, it will be transmitted by that Office or Authority either directly to the competent IPEA, or first to the International Bureau which will in turn transmit it to the competent IPEA. Generally, the original filing date of the demand will be retained.

If the language in which your PCT application was searched or the language in which it was published is not accepted by the IPEA, you will be invited to furnish a translation within one month from the date of the invitation. If you do not furnish the missing translation in time, the IPEA will consider the demand not to have been submitted.

9.2 Amendment of the Description, Claims, Drawings

When you file the demand, or before the start of international preliminary examination, you have the opportunity to amend your PCT application (description, claims, and drawings). These amendments are commonly referred to as Article 34 amendments. Any amendments that you make may not go beyond the disclosure of your PCT application as originally filed.

As far as the claims are concerned, this is a second opportunity for amending them before the international preliminary examination starts (the first being by way of Article 19 amendments submitted to the International Bureau after receipt of the international search report). In practice, most applicants filing a demand for international preliminary examination do not make use of the possibility of amending the claims under Article 19, unless publication of the amendments is desired (see Module 8 Section 8.2). Where it is clear from the references cited in the ISR and the written opinion of the ISA that the PCT application requires amendments, applicants typically furnish their amendments to the IPEA together with the demand.

9.3 Written Opinion of the IPEA

The written opinion of the ISA is generally used as the first written opinion of the IPEA, particularly if the ISA and the IPEA are the same office. In this case, you will most likely not receive a “second” written opinion from the IPEA. You should therefore file any Article 34 amendments and/or any arguments in relation to the written opinion of the ISA together with the demand.

The IPEA will conduct a mandatory “top-up” search. The top-up search is a quality measure that seeks to identify additional relevant documents, in particular, “secret” prior art, which had become available after the date on which the ISR was established. The term “secret prior art” is used to describe patent documents which were published after the establishment date of the ISR but which have an earlier [priority date](#). The identification of potentially new prior art documents provides the applicant with an opportunity to amend the PCT application during the Chapter II procedure in order to overcome possible objections over novelty and inventive step prior to entry into the national phase.

International preliminary examination does not usually start until after the ISA has drawn up the ISR and the written opinion. You may wait for these documents before deciding whether to proceed further with the PCT application by filing a demand for international preliminary examination. The cost of the examination need not be incurred before it is clear, from the results of the ISR and the written opinion of the ISA, that the invention claimed in the PCT application is not clearly lacking novelty and inventiveness.

If, exceptionally, a second written opinion is established by the IPEA, you may have additional opportunities to file amendments during the international preliminary examination. The number of opportunities for filing amendments which will be available depends very much on the time available for international preliminary examination. The international preliminary examination report must in general be drawn up not later than 28 months from the [priority date](#). Any amendments you file after the examiner has begun to draw up the report can no longer be taken into account.

Should you wish to make further amendments (which can no longer be filed during the international phase), they can still be submitted to the elected Offices on entering the national phase. No elected Office may grant or refuse a patent before the expiration of the time limit for amending the application for the purposes of the grant procedure in the national phase. Each national chapter of the [PCT Applicant's Guide](#) gives details as to when and how amendments may be filed during the national phase (see Module 10).

9.3.1 Response to the Written Opinion of the IPEA

Exceptionally, you may receive an additional written opinion from the IPEA (Form [PCT/IPEA/408](#)) with an invitation to respond, before the International Preliminary Report on Patentability (Chapter II) is drawn up. In such a case, you may present further amendments or arguments.

Informal communications between the IPEA and the applicant are expressly provided for under the PCT. Consistent with the non-binding, preliminary nature of the international preliminary examination, there is no provision for a formal review of an examiner's opinion, except on disputed findings of lack of unity of invention (see Module 7 Section 7.1.2).

International preliminary examination can thus be compared to a regular patent examination in an examining patent Office with one exception; namely, in that the time limits set by the examiner for the response are usually much shorter than under the normal examination procedure. A prompt reaction is required from you during preliminary examination in order for the international preliminary examination to be completed within the limited time available.

9.4 The International Preliminary Report on Patentability (Chapter II)

International preliminary examination ends with the drawing up of an International Preliminary Report on Patentability (Chapter II) as prescribed under Chapter II of the PCT – commonly referred to as an IPRP (Chapter II) (Form [PCT/IPEA/409](#)). The IPRP Chapter II is typically drawn up before the expiration of 28 months from the [priority date](#).

The IPRP (Chapter II) is a non-binding opinion, which essentially contains a statement, in relation to each claim, on whether it appears to satisfy the criteria of novelty, inventive step and industrial applicability as defined in the PCT. The statement is accompanied by the citation of the documents believed to support that conclusion. Further explanations are given where the circumstances of the case so require. No statement may be made on the question whether the invention would be patentable under the national law of any elected State. If the report is based on the PCT application in an amended form, a copy of all sheets containing amendments will be annexed to the report.

The IPEA transmits the IPRP (Chapter II) to the applicant and to the International Bureau. The report is established in the language in which the PCT application concerned is published or, if the international preliminary examination is carried out on the basis of a translation of the PCT application, in the language of the translation. The International Bureau must then translate, if necessary, the report into English to meet the language requirements of some elected Offices. Only the IPRP (Chapter II) is translated, not the annexes. The transmittal of the IPRP (Chapter II) completes the international procedure under Chapter II.

The IPRP (Chapter II) is not accessible to persons other than the applicant and the elected Offices during the international phase. Neither the International Bureau nor the IPEA may, unless requested or authorized to do so by the applicant, give information on the issuance of

an IPRP (Chapter II) or on the withdrawal or non-withdrawal of the demand or of any election, except for communications or access provided to elected Offices.

Upon receipt of the IPRP (Chapter II) (at the latest, at about the 28th month from the [priority date](#)), you have until the expiration of 30 months from the [priority date](#) in which to evaluate it and to decide whether to proceed further by entering the national or regional phase before the elected Offices. If a translation of the PCT application must be furnished to the elected Office upon entry into the national phase, it must usually include a translation of the PCT application as originally filed, and of the amendments appearing in the annexes to the IPRP (Chapter II). The translation requirements of the annexes vary somewhat among the elected Offices. The national chapter relating to each elected Office in the *PCT Applicant's Guide* indicates the applicable requirements.

9.5 Fees Payable

In connection with filing the demand, two kinds of fees are due: the preliminary examination fee for the IPEA, and the handling fee for the International Bureau. Both fees are paid to the IPEA in a currency prescribed by it. You can find information about PCT fees on the WIPO website at [<https://www.wipo.int/pct/en/fees/index.html>]. In respect of the preliminary examination fee and the handling fee, see Table II.

Module 9 - End of Module Test

1. International preliminary examination is a compulsory step and is legally binding for the purposes of national or regional examination.

- a) True
- b) *False*

Feedback: see Module 9 introduction

2. International preliminary examination may be carried out by:

- a) The International Bureau of WIPO
- b) The competent International Searching Authority (ISA)
- c) *The competent International Preliminary Examining Authority (IPEA)*
- d) Any of the above

Feedback: see Module 9 introduction

3. Filing of a demand for international preliminary examination provides the applicant with an opportunity to amend the description, claims and drawings of the PCT application.

- a) *True*
- b) False

Feedback: see Section 9.2

4. If you file a demand for international preliminary examination amendments to the description, claims and drawings of the PCT application are typically referred to as:

- a) Article 19 amendments
- b) *Article 34 amendments*
- c) Supplementary amendments
- d) Voluntary amendments

Feedback: see Section 9.2

5. The international preliminary examination report on patentability (Ch. II) should generally be drawn up:

- a) not later than 18 months from the priority date
- b) not later than 22 months from the priority date
- c) *not later than 28 months from the priority date*
- d) not later than 30 months from the priority date

Feedback: see Section 9.4

6. The international preliminary examination report on patentability (Ch. II) contains a statement indicating whether the invention would be patentable under the national law of any elected State.

- a) True
- b) *False*

Feedback: see Section 9.4

Module 10: Entry into the National Phase

The national phase follows the international phase. During the international phase, you received an international preliminary report on patentability (IPRP) under Chapter I or II of the PCT. This report contained a patentability opinion on your invention providing you with valuable information on your chances of obtaining a patent during the national phase. On the basis of this information, you are in a better position to decide on whether you wish to continue with the patent process.

10.1 Basic Requirements

Before processing and examination may start in the national phase, you must perform certain acts in order to enter the national phase in respect of the national Office of each country that is of interest to you. You must perform these acts within the time limits set by the patent Office, otherwise, your PCT application will be considered as withdrawn. In particular, you have to pay the required national fees and, if your application is not in a language accepted by a national Office, furnish them with any translations that are required.

As a general rule, the time limit for entry into the national phase, both under Chapter I and Chapter II, is at least 30 months from the [priority date](#).

The national fees to be paid are usually about the same as the regular fees required for the filing of a national or regional application. Some Offices may have lower fees for PCT applications, which, in effect, takes into consideration the work already performed by either the International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA).

Apart from the payment of national fees and, where necessary, the filing of a translation, no national Office may require you to comply with any additional requirements in order to validly enter the national phase. Some requirements, such as the appointment of an agent, indication of an address for service of notifications, declaration of inventor, assignment documents, and the like, are permitted, but you are not required to comply with them within the 30-month time limit for national phase entry.

The national chapters of the *PCT Applicant's Guide* give specific information on the requirements for entry into the national phase.

10.2 Considerations

During the international procedure, your PCT application will have been searched and examined by an ISA and/or IPEA, and you will have had an opportunity to amend your application.

The reports established by the ISA and/or IPEA are non-binding on national Offices and are based on the PCT definitions of novelty, inventive step and industrial applicability. Although patent standards and practices may be different at the national level, a fully positive international search or international preliminary examination report may accelerate the national patent procedure.

10.2.1 Whether, When, Where

You have up to 30 months to enter the national phase. There may be situations where you would wish to enter earlier, particularly if your invention is already commercially successful

and want to protect yourself from local competitors. If you are entering the national phase early you need to take into account the time limits applicable to specific actions.

Since all PCT countries were automatically designated at the time of filing, you have available to you a wide range of options when seeking patent protection. The payment of national Office fees, which were delayed by up to 30 months due to the filing of your PCT application, are payable in order to enter national phase. You will also have to consider the costs of local patent agents, translations and other fees associated with obtaining patents and maintaining them at the national level.

10.3 Amendments upon Entry in the National Phase

During the national phase, you may submit additional amendments or arguments to the local patent office to address comments or overcome objections raised during the international procedure. You may amend any part of your PCT application including the description, the claims and the drawings. You may also make corrections due to errors in translation. These amendments are in addition to any which you may have made in the international phase.

You may not make any amendments that would broaden the scope of the invention as contained in the PCT application as originally filed, unless specifically permitted under the applicable national law.

10.4 Application of National Law

Each PCT country has established its own substantive conditions of patentability. This includes the definition of prior art, and the application of the patentability criteria of novelty, utility and inventive step. You may be required, in some countries, to provide evidence in respect of any substantive condition of patentability under the relevant national law.

Module 10 - End of Module Test

1. The time limit for entry into the national phase is generally:

- a) at least 18 months from the priority date
- b) at least 22 months from the priority date
- c) *at least 30 months from the priority date*
- d) at least 36 months from the priority date

Feedback: see Section 10.1

2. The reports established by the International Searching Authority (ISA) and/or the International Preliminary Examining Authority (IPEA) are binding on the national Offices.

- a) True
- b) *False*

Feedback: see Section 10.2

3. You may make further amendments to your PCT application once you have entered the national phase.

- a) *True*
- b) False

Feedback: see Section 10.3

Module 11: Special International Phase Procedures

There may be instances where, after having started the PCT procedure, you wish to correct your application or communicate changes related to the applicant, inventor or agent. You may also decide to make use of the various withdrawal options available to you under the PCT. The most efficient means of conducting these transactions is by using [ePCT](#).

11.1 Withdrawals (Rule 90*bis*)

The PCT permits you to make several types of withdrawals, i.e. withdrawal of the PCT application, any designation, priority claim, supplementary search request, demand or any election.

The notice of withdrawal must be made in writing and be signed by all the applicants or on their behalf (by the appointed common agent or the appointed common representative).

In order to ensure timely and safe receipt of notices of withdrawal, these should be submitted using ePCT.

11.1.1 PCT Application

You may wish, based on financial, commercial or other factors, to withdraw your PCT application. There will be no international publication if you withdraw your PCT application before the International Bureau has completed technical preparations for international publication (see Module 8 Section 8.4.2). If you are close to the 18-month publication, you may want to make the withdrawal conditional on the notice being received before the International Bureau has completed technical preparations for international publication (see Module 8 Section 8.5).

It is important to note that the withdrawal of a PCT application has significant consequences, and that any patent rights associated with the PCT application will be forfeited.

The time limit for withdrawing a PCT application is 30 months from the [priority date](#). Notices of withdrawal of the application should only be submitted directly to the International Bureau.

11.1.2 Designations

Your PCT application contains an automatic designation of all PCT countries. There may be situations where you may want to withdraw a designation for a particular country. From a practical standpoint, the withdrawal of a designation is not necessary since you can always choose simply to not enter the national phase in a particular country.

Certain countries, however, may require the formal withdrawal of a designation so that the PCT application does not conflict, under certain conditions, with an earlier-filed national application. Countries which have such a requirement are Germany, Japan and the Republic of Korea. For these countries, the exclusion of the designation may be made directly on the PCT request form at the time of filing.

The withdrawal of a designation has significant consequences and loss of potential patent rights in the countries where the designation has been withdrawn.

The time limit for withdrawing a designation is 30 months from the [priority date](#).

11.1.3 Priority Claims

You have the possibility of withdrawing any priority claim from your PCT application. If you withdraw a priority claim, any non-expired time limits will be recalculated on the basis of the newly applicable [priority date](#), if any, or from the international filing date. The withdrawal of a priority claim has significant consequences and could result in the loss of potential patent rights in the countries where the priority claim has been withdrawn.

The time limit for withdrawing a priority claim is 30 months from the [priority date](#).

11.1.4 Supplementary Search Request

A request for supplementary international search may be withdrawn at any time prior to the issuance of either the supplementary international search report or the declaration by the SISA that no report will be established. As long as the International Bureau has not yet transmitted the request for supplementary international search to the Authority in question, both the supplementary search handling fee and the supplementary search fee will be refunded to the applicant.

11.1.5 Demand or Elections

As with designations, all PCT countries are automatically elected should you choose to file a demand for international preliminary examination. In practical terms, the withdrawal of a demand or election has no implications on your PCT application. Your PCT application will remain in good standing and all potential patent rights are maintained.

The time limit for withdrawing a demand or election is 30 months from the [priority date](#).

11.2 Rectification of Obvious Mistakes (Rule 91)

You have the opportunity to correct any obvious mistakes, which may exist in your PCT application. Approval for corrections will have to be obtained from the competent Authority, and the rectification will be authorized if the competent authority finds it obvious that something else was intended than what appears in the document concerned, and that nothing else could have been intended than the proposed rectification.

More particularly, no corrections of obvious mistakes may be made without the express authorization:

- Of the **receiving Office** if the mistake is in the request or in any correction thereof;
- Of the **International Searching Authority (ISA)** if the mistake is in the description, the claims or the drawings or in any correction thereof;
- Of the **International Preliminary Examining Authority (IPEA)** if the mistake is in the description, the claims or the drawings or in any correction thereof, or in any amendment to the claims under Article 19 or 34, if a demand for international preliminary examination has been made; or
- Of the **receiving Office, Authority** or the **International Bureau** if the mistake is in any document other than the documents referred to above and other than a mistake in the abstract or in an amendment under Article 19.

Requests for rectification must be addressed to the authority competent to authorize the rectification and must be filed within 26 months from the [priority date](#).

11.3 Recording of Changes Relating to the Applicant, Agent or Inventor (Rule 92*bis*)

During the international phase, you may request the International Bureau to record changes in the following indications appearing in the request or demand:

person, name, address	for changes related to the applicant, agent, common representative, inventor
residence, nationality	for changes to the applicant only

Requests for 92*bis* changes should be made directly with the International Bureau in ePCT using an online action. Alternatively, request for changes may be made in writing or by uploading the request in ePCT. In any event, it is to be noted that all requests for changes must reach the International Bureau before the expiration of 30 months from the [priority date](#). Requests which do not reach the International Bureau in time will not be processed during the international phase and will have to be filed directly with each national Office during the national phase.

If you wish that a particular change be taken into account for publication of your PCT application, the request for recording of that change must reach the International Bureau before the completion of technical preparations for international publication. This is typically at least 15 days before the actual date of publication.

The International Bureau will inform the applicant that requested changes have been recorded using Form [PCT/IB/306](#) which appears automatically in ePCT once the change has been processed.

11.4 Licensing Availability Request

You may request the International Bureau to publish information on PATENTSCOPE concerning your willingness to make their invention available to interested parties through licensing. This service is free of charge. When submitting your licensing availability request, you can, if you wish:

- specify that you are willing to license the claimed invention or inventions (hereinafter: invention) in all PCT Contracting States, or you can specify the Contracting States in which you wish to license the claimed invention;
- clarify whether you are willing to license the claimed invention for exclusive or non-exclusive use by the licensee; and
- include any additional licensing terms.

The licensing availability request may be sent to the International Bureau at any time from the date of filing of the PCT application until the expiration of 30 months from the priority date. The licensing availability request should be made directly in ePCT using the relevant ePCT Action. You can file multiple licensing requests or modify those already filed until the expiration of 30 months from the priority date. You can also request the International Bureau to remove the licensing indications from the “PCT Bibliographical data” tab in PATENTSCOPE at any time during the international, or even during the national phase. Once removed, the licensing request and the correspondence will, however, remain part of the file history available on PATENTSCOPE.

Licensing indications are reflected in the bibliographic data relating to the particular application (under the “Bibliographic data” tab on PATENTSCOPE) but will not be part of the published PCT application itself. This is linked to the content of the licensing availability request itself, allowing third parties to directly access its content. The licensing availability request is also available under the “Documents” tab on PATENTSCOPE as a separate document.

Potential licensees wishing to identify PCT applications in relation to which applicants have expressed their interest in licensing the claimed invention can do this by going to the “Field Combination” search on PATENTSCOPE and ticking the “Licensing availability box” provided. The search criterion can also be used in combination/multi-field searches, so third parties can search for PCT applications containing licensing information where the claimed invention relates to a particular field of technology.

Module 11 - End of Module Test

1. Withdrawal of your PCT application may be made conditional on the notice being received before the International Bureau has completed technical preparations for international publication.

- a) *True*
- b) *False*

Feedback: see Section 11.1.1

2. The withdrawal of a designation does not result in loss of potential patent rights in that country.

- a) *True*
- b) *False*

Feedback: see Section 11.1.2

3. Requests for rectification of obvious mistakes which may exist in your PCT application must be filed within _____ of the priority date:

- a) 12 months
- b) 16 months
- c) 22 months
- d) *26 months*

Feedback: see Section 11.2

4. A request for indication of availability for licensing purposes can only be submitted within 30 months from the priority date.

- a) *True*
- b) *False*

Feedback: see Section 11.4

5. You can request that the International Bureau to remove the licensing indications from the "PCT Bibliographical data" tab in PATENTSCOPE at any time during the international or national phase.

- a) *True*
- b) *False*

Feedback: see Section 11.4

Module 12: Procedures for Inventions in the Field of Biotechnology

This chapter deals with nucleotide and/or amino acid sequence listings and deposits of biological material.

12.1 Nucleotide and/or Amino Acid Sequence Listings

Nucleotide and amino acid sequence listings relate to inventions in the field of biotechnology. Sequence listings present particular challenges for both the PCT system and national Offices because of their technical complexity, and the fact that the sequence listings themselves, if reproduced on paper, may be in excess of hundreds and sometimes thousands of pages.

PCT applications containing nucleotide and/or amino acid sequence listings have to be presented in accordance with the standard contained in Annex C of the PCT Administrative Instructions “STANDARD FOR THE PRESENTATION OF NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS IN INTERNATIONAL PATENT APPLICATIONS UNDER THE PCT” [https://www.wipo.int/pct/en/texts/ai/annex_c.html].

In order to facilitate the processing, searching and examination of PCT applications containing sequence listings, most International Searching Authorities and national Offices require that nucleotide and/or amino acid sequence listings be submitted in electronic form, in compliance with the prescribed standards (see [Section 208](#) and [Annex C](#) of Administrative Instructions).

Therefore, if your PCT applications contains nucleotide and/or amino acid sequence listings, your application should be filed in electronic form and the sequence listing forming part of the international application should comply with the sequence listing standard. In that case, no page fees arise for the sequence listings. The receiving Office of the International Bureau accepts international applications filed in electronic form. If you file the international application in electronic form, but the sequence listing is filed in image format, or the international application containing the sequence listing is filed on paper, full page fees are payable for the sequence listings.

12.2 Biological Material Deposits

If your application makes reference to biological material, you may be required in some PCT countries to make a deposit with a recognized depositary institution, such as a laboratory, for the purposes of patent disclosure.

Full disclosure of the invention is a requirement for the grant of patents. Normally, the disclosure is contained in the written description. However, where an invention involves biological material, such as a microorganism or the use of a microorganism, disclosure is not always possible in writing but can only be effected by the deposit, with a specialized institution, of a sample of the microorganism.

The Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, eliminates the need to make a deposit in each country in which protection is sought. All Contracting Parties of the Budapest Treaty will recognize a deposit made with any of the recognized depositary institutions (see [<https://www.wipo.int/treaties/en/registration/budapest/>]), whether or not they are PCT Contracting States.

References to biological material and/or to its deposit with a depositary institution are made in the description of a PCT application. If not contained in the description, they may be given

on a separate sheet. Form [PCT/RO/134](#) should preferably be used for that purpose. The Form can also be used to provide further details and information in connection with the deposit of biological material.

Module 12 - End of Module Test

1. Nucleotide and/or amino acid sequence listings must in most instances be submitted in electronic form.

- a) *True*
- b) *False*

Feedback: see Section 12.1

2. The Budapest Treaty of the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure requires the applicant to make a deposit in each country where protection is sought for purposes of patent disclosure.

- a) *True*
- b) *False*

Feedback: see Section 12.2

Module 13: Access by Third Parties to the File of a PCT Application

All documents held in the file of your PCT application are freely accessible to the public after 30 months from the [priority date](#), provided that the PCT application has been published. Before the 30 months, only certain documents are publicly available.

If you want the contents of the file to remain secret, you can withdraw the earliest priority claim from your PCT application, or withdraw the PCT application completely. Withdrawal of the earliest priority claim will only postpone international publication and subsequent access to the documents contained in the file of your PCT application (see Module 8, Section 8.6). If you withdraw the PCT application completely before the International Bureau has completed the technical preparations for publication, all documents will remain secret but you will have forfeited all potential patent rights associated with your PCT application (see Module 8, Section 8.5).

13.1 General Principles

The following are general principles governing third party access to the file of a PCT application:

- all documents contained in the file of the PCT application remain secret until publication;
- applicant or anyone authorized by the applicant always has access to the file of the PCT application;
- all documents in the file are available after 30 months from the [priority date](#), provided that the PCT application was published;
- before 30 months, national Offices have access to the files held by the International Bureau and the International Searching Authority (ISA);
- the file of the International Preliminary Examining Authority (IPEA) is available to other national Offices once the international preliminary report on patentability (IPRP Chapter II) has been established; and
- certain sensitive information may be omitted from public file access.

13.2 Information Published by the International Bureau

The following information is usually available upon publication of the PCT application at 18 months:

- front page of the PCT application with bibliographic data, abstract and representative drawing;
- title of the invention;
- abstract;
- description, claims and drawings;
- any declaration made relating to national requirements referred to in [Rule 51 bis.1\(a\)\(i\) to \(iv\)](#);
- any amendments to the claims (and/or any statement) under Article 19; and
- international search report (ISR).

13.3 Priority Documents

Priority documents are publicly available on [PATENTSCOPE](#) once the PCT application is published. Paper copies may be furnished by the International Bureau to any person upon request and subject to the payment of a fee. Copies of the priority document will not be made available if the PCT application is withdrawn, the priority claim is withdrawn, or if the priority claim is considered not to have been made. This is not the case if the PCT application has already been published.

13.4 File Held by the International Bureau

For PCT applications filed before July 1, 1998, no access to the file by third parties is possible.

Documents contained in the file of PCT applications filed after July 1, 1998 may be accessed with the exception of the IPRP (Chapters I and II) and its translation which remain confidential for 30 months from the [priority date](#).

The written opinion of the ISA and any informal comments submitted by the applicant will be made publicly available on [PATENTSCOPE](#) in their original language as of the publication date.

The file held by the International Bureau may be accessed by applicants and other authorized persons in ePCT. The general public and third parties may consult the public PCT file in [PATENTSCOPE](#).

The International Bureau will not provide access to any sensitive information contained in the file of the PCT application that has been omitted from publication at the request of the applicant.

In a small number of instances, the electronic file of the PCT application is not available in [ePCT](#) or on [PATENTSCOPE](#). In these situations, a specific request must be made to the International Bureau to retrieve documents contained in the file. Documents will be provided against the payment of a fee.

13.5 Files of National Offices/International Authorities

In addition to the general principles set out above (Section 13.1) the files of PCT Offices/Authorities are accessible to third parties to the extent provided for under national law.

No access will be provided to sensitive information that was omitted by the International Bureau from publication or public file access at the request of the applicant.

Most national Offices only receive communications or other documents on a request basis, and as a consequence, their file may be incomplete. Any communications or other documents missing from the file of national Offices may be obtained from the International Bureau.

Module 13 - End of Module Test

1. All documents held in the file of your PCT application are freely available after 30 months from the priority date regardless of whether the application has been published or not.

- a) True
- b) *False*

Feedback: see Module 13 introduction

2. As a general rule, all documents contained in the file of the PCT application remain secret until publication.

- a) *True*
- b) False

Feedback: see Section 13.1

3. Copies of the priority document will NOT be made available if:

- a) the PCT application is withdrawn before its publication
- b) the priority claim is withdrawn before publication of the PCT application
- c) the priority claim is considered not to have been made
- d) *all of the above*

Feedback: see Section 13.3

4. The file of the PCT application held by the International Bureau may only be consulted in ePCT.

- a) True
- b) *False*

Feedback: see Section 13.4

Module 14: PCT Outlook

This module provides you with some background information on other aspects of the PCT system.

14.1 Strategies for Effective Use of the PCT

Patenting a single invention in multiple countries requires significant investment. Financial resources are limited and should be managed efficiently in order to obtain the greatest return on investment. The PCT is a valuable tool which provides valuable information on the potential patentability of your invention. It leverages your patent investments by helping identify inventions worth patenting. It also accelerates in many cases the national processing of your patent application, saving you time and money in the long run.

Several users of the PCT system have shared with WIPO their PCT experiences and strategies, in addition to the range of external factors such as economic trends, country profiles, national legal systems, etc., that they consider throughout the entire patent process. Examples of these experiences and strategies are:

- using the PCT to accelerate and add value to national processing;
- prioritizing inventions and selecting countries for patent protection;
- enhancing the patentability assessment by having the search and examination performed by two separate international authorities;
- exploring partnerships and licensing arrangements to reduce costs and expand market opportunities; and
- preserving patent options by maximizing the time delay options available under the PCT.

This collection of PCT user strategies (see www.wipo.int/pct/en/pct_strategies/) is a valuable resource that you can use to determine how and when to use the PCT, and how it can best be utilized and incorporated into your business strategy.

14.2 Continuous Improvement of the PCT System

It is important that the PCT system remain relevant to the needs of applicants and national Offices. Legal enhancements have been made over the years in order to further streamline and simplify the operations of the PCT system. Information technology solutions such as [ePCT](#) have been introduced, creating efficiency gains and reduced costs for applicants, national Offices and the International Bureau of WIPO.

The operations and performance of the PCT system are regularly monitored and assessed against the business needs and experiences of applicants, national Offices and the International Bureau of WIPO.

14.3 Conclusion

Since its adoption in Washington in 1970, the PCT has enjoyed great success and continued growth. It has a wide membership, and both applicants and offices benefit from its existence and expansion.

The PCT has revolutionized the way in which patents are sought multi-nationally. The search and examination reports, cornerstones of the PCT system, provide you with valuable information on which you can base your business and patenting decisions. The time delay

feature of the PCT preserves your patent options, delays costs, giving you additional time to obtain financing and assess commercial, licensing and partnership opportunities.

The PCT helps you seek patents for your inventions.

14.4 Comments and Feedback

Your comments and feedback on this PCT Distance Learning course are welcome and may be sent to:

PCT Distance Learning Course Administrator
PCT Legal and User Support Section
PCT Legal and User Relations Division
World Intellectual Property Organization
E-mail: pct.training@wipo.int