



Lecture  
Notes

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# Paper F Notes

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# Contents

<b>Chapter 1</b>	<b>Introduction to the Patent Cooperation Treaty — PCT</b>	<b>Page 3</b>
1.1	Historical Notes and Some Quick Facts	3
1.2	The Paris Convention for the Protection of Industrial Property	4
<b>Chapter 2</b>	<b>Fillun Homework Questions</b>	<b>Page 8</b>
2.1	September 22, 2025	8

# Chapter 1

## Introduction to the Patent Cooperation Treaty — PCT

### 1.1 Historical Notes and Some Quick Facts

The **Patent Cooperation Treaty** (PCT) is an international patent law treaty, concluded in 1970. It provides a unified procedure for filing patent applications to protect inventions in each of its contracting states.

☞ Signed on June 19, 1970 in Washington D.C.. Entered into force on January 24, 1978. The first application was filed on June 1, 1978.

☞ A patent application filed under the PCT is called an international application, or **PCT application**.

☞ No case law. No appeal body – with exception of questions relating to unity of invention.

☞ Rules have to cover all situations that might occur – therefore are very detailed.

☞ Contracting States have agreed to accept international filing date and the form and content of an international application having the effect of a national application, but they **have not limited the freedom to grant patents** to an **International Authority (IA)**. This runs in contrast to the EPC — for example — where that freedom has been ceded.

☞ The international phase includes filing + search + publication + (optional) non-binding examination. No decision to grant.

#### Definition

“National phase” for the purposes of PCT should be understood to mean “national” or “regional phase.”

☞ Any signatory of the Paris Convention may accede to the PCT.

☞ The national office (NO) must approve form and content of the application as approved in the international phase.

☞ The cost of entering national phase is similar to a direct national application. Further search + examination may be carried out in the national phase, but the use of the **international search report (ISR)** and examination may result in a fee reduction at national phase.

☞ NO will grant patent on initial application with the same effect as on a direct national application.

☞ PCT is administered by the World Intellectual Property Organization (WIPO), which is a UN agency. The International Bureau (IB) of WIPO carries out admin for the International Patent Cooperation Union that the Contracting States make up.

☞ The international phase is carried out before International Authorities. There are > 120 of them and > 20 can act as **International Search Authorities (ISAs)** or **International Preliminary Examination Authorities (IPEAs)**.

☞ After the international phase, all NOs act as so-called **designated Offices (dO)** or **elected Offices (eO)** [the latter in *Chapter II*.]

## 1.2 The Paris Convention for the Protection of Industrial Property

[Full Text](#)

☞ Signed on March 20, 1883.



Figure 1.1: — PCT Hierarchy

☞ Agreement between countries for mutual recognition of IP rights. Nationals of Signatory Countries enjoy the same rights in other States as nationals of those other States.

☞ It secured **the right of priority** of a first filing in one State for subsequent applications in other States.

☞ A **priority right** is a time-limited right triggered by the **first filing** of an application for a patent, industrial design, or trademark. It allows the applicant to file a **subsequent application** in another country that is effectively treated as if filed on the date of the first application, known as the **priority date**. To use this right, the applicant

(or **their successor in title**) must **claim priority** in the subsequent application.

☞ The priority period is **12 months** for patents and utility models (the **priority year**) and **6 months** for industrial designs and trademarks. In the original Paris Convention it was 6 months and 3 months, respectively.

☞ For patents, this right is crucial because **novelty** and **inventive step** are assessed against prior art that was made public **before the priority date**, not the actual (later) filing date of the subsequent application.

#### Rationale

*according to the EPO: “(...) basic purpose [of the right of priority] is to safeguard, for a limited period, the interests of a patent applicant in his endeavour to obtain international protection for his invention, thereby alleviating the negative consequences of the principle of territoriality in patent law.”*

☞ § **Art. 19** of the Paris Convention allows for special agreements between Signatory Countries. The Paris Convention takes precedence over laws of the Countries and over such special agreements.

☞ EPC is a “regional patent treaty” in the sense of **Art. 19** of the Paris Convention, e.g., under **Art. 45 PCT**, a PCT applicant can obtain an EP patent by filing an initial international application.

#### Definition

$$\begin{cases} \text{Patent in a state} & = \text{national} \\ \text{Patent for a state} & = \text{regional} \end{cases}$$

☞ Under **Art. 45 PCT**, a PCT Applicant can obtain a European patent by filing a PCTa.

☞ In case of conflict between PCT and EPC/national provisions, the PCT takes precedence.

☞ A “Euro-PCT” application is a PCT application with EPO as dO or eO.

☞ The PCT timeline for a PCTa claiming priority from a national application:



Figure 1.2: — PCT Timeline

☞ The international phase includes: international search, publication and (optionally) international preliminary examination. The international phase has a Chapter I (**Art. 3–30; R. 3–52**) and a Chapter II (**Art. 31–42; R. 53–78**). These correspond to search + pub and IPE.

☞ Each nO has a time limit for entering national phase (usually 30 or 31 months from the priority date). A PCTa can be simultaneously in the international phase and in the national phase for some jurisdictions.

### Chapter I

**Stage 1:** filing, accordance of date, fees, formal requirements.

**Stage 2:** ISR with written opinion on Novelty, IS and industrial applicability.

**Stage 3:** publication of PCTa + ISR @18 months after priority date.

### Chapter II

**Stage 1:** filing a **demand**, i.e., a request for an IPE — typically @22 months after priority date.

**Stage 2:** can amend claims and discuss Novelty, IS with Examiner.

**Stage 3:** receipt of the IPRP II typically @28 months from priority date.

☞ Applicant can pay for a Supplementary ISR carried out by a SISA (can be different to ISA of Chapter I, e.g., in order to find prior art in a specific language.)

☞ If no IPE demanded, written opinion from ISR is converted into the International Preliminary Report on Patentability I (IPRP I) with an English translation thereof + documents are communicated to the dO. Usually happens @30 months after priority date.

☞ IPRP is not binding on the dO but is made available to the dO. dO then becomes the eO.

☞ Only about 3% of applications ever enter Chapter II.

☞ LU is a notable exception for entering national phase – 20 months.

☞ PCT advantages over direct national application include:

- cost reduction,
- 30-month delay to check market developments, own product developments, etc.,
- patentability opinion to inform later actions,
- delay of formalities/payments right away.

☞ If no priority claim, then **the priority date is the PCTa filing date**.

☞ “Agent” is “professional representative” in EPC terminology.

☞ Terminology for document copies:

- Home copy — stays with rO.
- Record copy — sent to IB.
- Search copy — sent to ISA.

## Chapter 2

# Fillun Homework Questions

### 2.1 September 22, 2025

**Question 1** Two applicants wish to appoint an agent to file their international application.

- (a) Who can be appointed to act as an agent?
- (b) How must the agent be appointed?
- (c) Do all receiving Offices require the filing of a separate power of attorney?
- (d) Does the EPO require the filing of a separate power of attorney?

The applicants always work via the same patent attorney office for which a general power of attorney has been prepared.

- (e) Is it necessary to attach a copy of the general power of attorney to the Request [PCT/RO/101]?
- (f) Does the EPO require filing a copy of the general power of attorney?

**Question 2** An international application is filed at the Japanese National Office. The applicant first mentioned in the Request [PCT/RO/101] is a Taiwanese national resident in Taiwan. The second applicant is a Korean national resident in Korea and the third applicant is a Japanese national resident in Japan. The three applicants have not appointed a common agent or a common representative.

- (a) Who will be considered to be the common representative of the applicants?
- (b) Would your answer to question (a) have been different if the international application had been filed at the International Bureau?
- (c) Which acts may not be performed by the representative in question (a)?
- (d) Which acts may not be performed by an agent appointed by the representative in question (a)?

**Question 3** Today, 16 March 2020, the applicant discovers an obvious mistake in the description of his international application filed on Friday 9 March 2018 as a first filing.

- (a) Can this obvious mistake be corrected? If so, what are the conditions?
- (b) Who is competent to rectify the obvious mistake? What if the mistake is only detected after a demand for international preliminary examination has been made?
- (c) What parts of the international application are taken into account upon correcting the mistake?
- (d) When at the latest can a request for rectification be filed?
- (e) Would your answer have been different if the applicant had discovered an obvious mistake in the abstract of his international application?

**Question 4** Is it possible to file third party observations in relation to an international application during the international phase? If so, where and how can these be filed?



**Question 5** A Danish applicant filed an international application PCT-DK as a first filing on 25 May 2025 with the EPO as receiving Office. Due to cash-flow problems, no fees were paid upon filing. On 30 June 2025, the EPO issues an invitation to pay the missing fees together with a late-payment surcharge.

Indicate True/False:

- (a) If the applicant has, in fact, paid the fees due at filing on 27 June 2025, the payment will be considered in time.
- (b) The time limit to pay the missing fees together with late-payment surcharge expires on 1 September 2025.
- (c) If the applicant pays the missing fees + surcharge one day after the time limit to do so has expired, this is too late and the EPO is obliged to declare under Art. 14(3) that PCT-DK is considered withdrawn.

**Question 6** What happens if the applicant is a resident or national of one of the PCT Contracting States but files the international application with a "non-competent" receiving Office? What are the consequences for according the international filing date for such an application? Must an additional fee be paid?

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**Answer 1** Two applicants wish to appoint an agent to file their international application.

- (a) Under **R. 90**: a person having the right to practice before the national Office with which the PCTa is filed or having the right to practice before the IB as rO. The latter is governed by **Rule 83**, i.e., the agent must have a right to practice before the nO of the Contracting State of which the Applicant is a resident or national.
- (b) Applicant enters and signs the name **and** address of the agent in the request or the demand or in a separate power of attorney (applicable to a **specific** PCTa) or by a general power of attorney (applicable to **any** PCTa).
- (c) No.
- (d) No.
- (e) Yes. It says so on the [PCT/RO/101] form.
- (f) No. Waiver under **Rule 90.5(c)**. Two exceptions relating to suspicions as to the nature of the person performing acts apply.

**Answer 2** An international application is filed at the Japanese National Office. The applicant first mentioned in the Request [PCT/RO/101] is a Taiwanese national resident in Taiwan. The second applicant is a Korean national resident in Korea and the third applicant is a Japanese national resident in Japan. The three applicants have not appointed a common agent or a common representative.

- (a) According to **Rule 90**, the first Applicant named in the Request entitled to file a PCTa with an rO will become the common representative. In this case, this should be the Korean national.
- (b) No?
- (c) The common representative may not sign any notice of withdrawal [under **R. 90bis**], i.e.: withdrawal of application, designation, priority claim, supplementary search request, demand or election. Also, **not sure**, but it seems like he cannot perform an act in relation to only one Applicant or a subset of Applicants when there are multiple Applicants.
- (d) The common agent may not file a PCTa without signature of the Applicant/s [**R. 4.15**] and cannot make declarations as to entitlement on behalf of the Applicant/s [**R. 4.17**].

**Answer 3** Today, 16 March 2020, the applicant discovers an obvious mistake in the description of his international application filed on Friday 9 March 2018 as a first filing.

- (a) Yes — under **Rule 91.2**, there is a 26 month-deadline for correction of obvious mistakes. In this case, we have 24 months + 7 days.

- (b) The Applicant (or his agent) are competent. After demand, the IPEA is the Competent Authority to be addressed. Notably, the dO/eO need not take rectification into account if processing/examination started prior to the notification [R. 91.3(e)] and the dO/eO may disregard an authorized notification if it finds it would not have authorized it itself had it been the Competent Authority [R. 91.1(f)].
- (c) For mistakes in the claims, description or drawings (or corrections thereof), only the claims, description and drawings (and corrections thereof) will be taken into account [R. 91.1(d)]. For mistakes in the Request (or corrections thereof), the contents of the whole PCTa including priority documents, corrections, etc., will be taken into account [R. 91.1(e)].
- (d) 26 months after the priority date.
- (e) Yes. Abstract mistakes may not be corrected under **Rule 91.1(g)**. They may be corrected under [R. 38.3] within **1 month** after the date of mailing of ISR by submission of corrections to the ISA.

**Answer 4** Is it possible to file third party observations in relation to an international application during the international phase? If so, where and how can these be filed?

Third party observations may be submitted at any time **after the date of publication** of the international application **and before the expiration of 28 months from the priority date**, provided that the application is not withdrawn or considered withdrawn.

They can be submitted through ePCT at no cost (you need a WIPO account). Each observation must include at least one citation that refers to a document published before the international filing date, or a patent document having a priority date before the international filing date, together with a brief explanation of how each document is considered to be relevant to the questions of novelty and/or inventive step of the claimed invention. Observations should preferably be accompanied by a copy of each cited document. They should be submitted in a language of publication (copies of prior art may be in any language). A single party may only submit a single observation for any PCTa, with a cap of ten observations (generally existing) per PCTa.

**Answer 5** A Danish applicant filed an international application PCT-DK as a first filing on 25 May 2025 with the EPO as receiving Office. Due to cash-flow problems, no fees were paid upon filing. On 30 June 2025, the EPO issues an invitation to pay the missing fees together with a late-payment surcharge.

Indicate True/False:

- (a) **True** — any payment received by rO before invitation to pay fees is considered to have been received before the time limit.
- (b) **False** — *1 month* from the date of the invitation is the time limit. So it should be 30 July 2025.
- (c) **False** — any payment received before this declaration by the rO shall be considered to have been received before the expiration of the time limit.

**Answer 6** What happens if the applicant is a resident or national of one of the PCT Contracting States but files the international application with a "non-competent" receiving Office? What are the consequences for according the international filing date for such an application? Must an additional fee be paid?