



**CIPA Informals Lecture**  
**PCT**  
April 2024

**C/M/S'**  
Law · Tax

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## What is the PCT?

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**WIPO**  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

Patent Cooperation Treaty  
(150+ contracting states)

A filing procedure  
(no granted patents)

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## 157 Contracting States

YES	NO
EPO	Argentina
UK	Taiwan
US	



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## Advantages

- Defer costs and buy time:
  - *"university technologies are generally very early stage. The PCT is critical for these early stage technologies because it gives us the opportunity to protect our patents globally while allowing the market and the technology to mature further before determining which countries might be most valuable to commercial partners."*
  - Professor Nakamura (2014 Nobel Prize for Physics for LEDs)
- File one application in one place
- One language
- Some idea of patentability before large costs incurred
- Opportunity to advance prosecution with a single official action response

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## Disadvantages

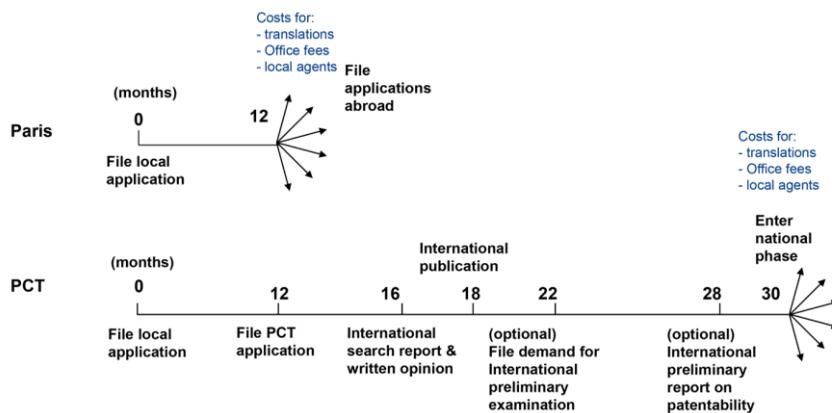
- Slows down prosecution
- Patentability opinion (Written Opinion) will be published with application
- More complex procedure for applicants to follow
- Patent term in all states begins on PCT filing

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## Direct v Paris Convention v PCT



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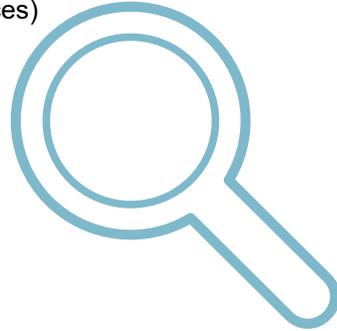
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## Four parts

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- 1 The overall process
- 2 The nuts and bolts (with legal references)
- 3 PCT Patent Prosecution Highway
- 4 Useful materials



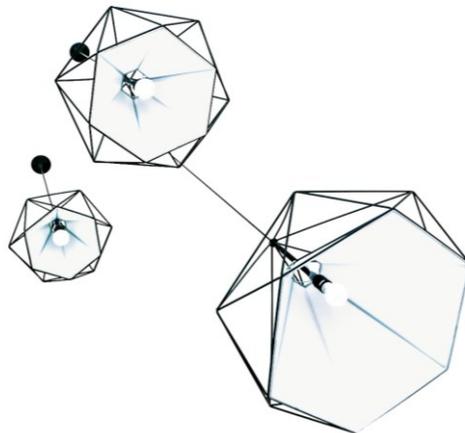
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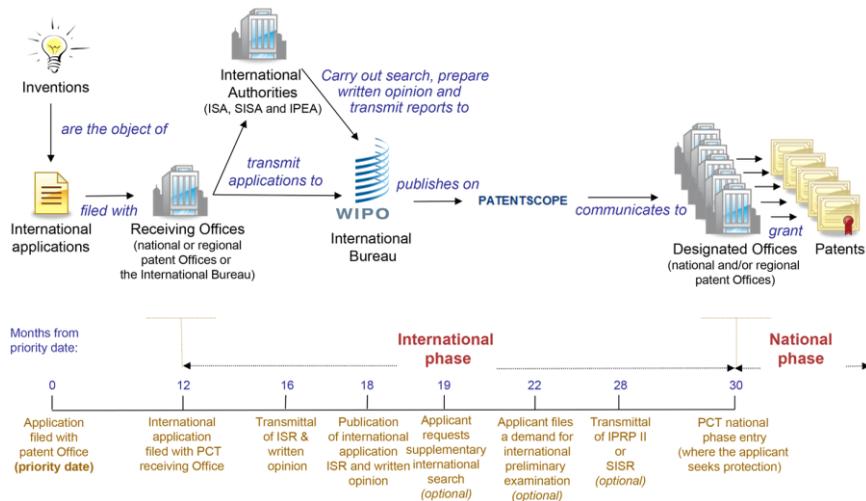


### Part 1 : The Process

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## PCT Process Overview



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## Acronyms

- WIPO = World Intellectual Property Organisation
- RO = Receiving Office
- ISA = International Search Authority
- IPEA = International Preliminary Examination Authority
- IPER = International Preliminary Examination Report
- IB = International Bureau
- IPRP = International Preliminary Report on Patentability

<https://www.wipo.int/pct/en/texts/glossary.html>

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## International phase

- Two legally distinct parts to the PCT
- Filing the International application and international search (Chapter I)
- Possibility of International Preliminary Examination (Chapter II) if requested by filing a 'demand'
- Significant procedural changes in the PCT process over time, but these concepts remain intact



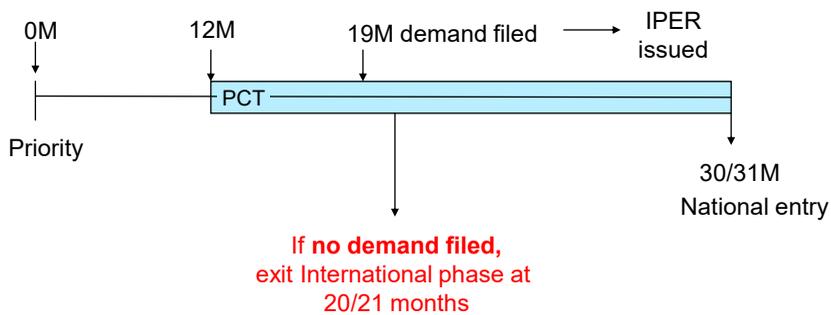
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## 'Original system'

(now only Luxembourg and Tanzania only)  
[https://www.wipo.int/pct/en/texts/time\\_limits.html](https://www.wipo.int/pct/en/texts/time_limits.html)



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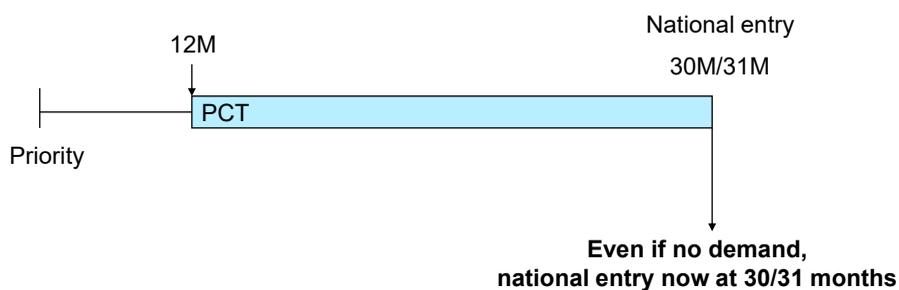
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## From 2002

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(most states)



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## Enhanced International search and preliminary examination

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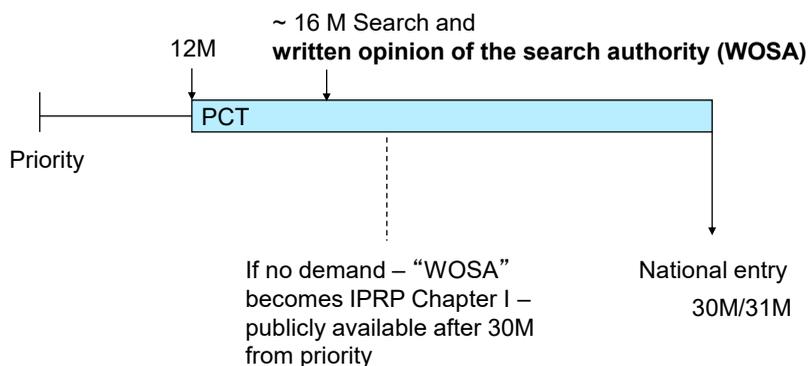
- In Chapter I, you receive a search together with a written opinion of the Search Authority (WOSA)
- No dialogue with the examiner before issuance
- Search report published with the application (published on national/regional entry)
- Applicant may submit comments on WOSA to IB
- If no demand is filed then WOSA issues as "IPRP Chapter I" and the IPRP will be made publicly available after 30 months

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## Chapter I – no demand filed



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## Chapter II – demand

- A demand for International examination is optional
- Rule 54bis PCT: time Limit for filing a demand is essentially the later of:
  - 3 months from the date of transmittal to the applicant of the international search report and the written opinion; or
  - 22 months from the priority date
- Written opinion of International search authority generally becomes written opinion of IPEA (International Preliminary Examination Authority)
- International examination procedure - respond to objections and possible telephone call with examiner
- International preliminary examination report finalised
- IPRP (Chapter II) is sent to elected Offices and made publicly available by IB not before the expiration of 30 months from the priority date

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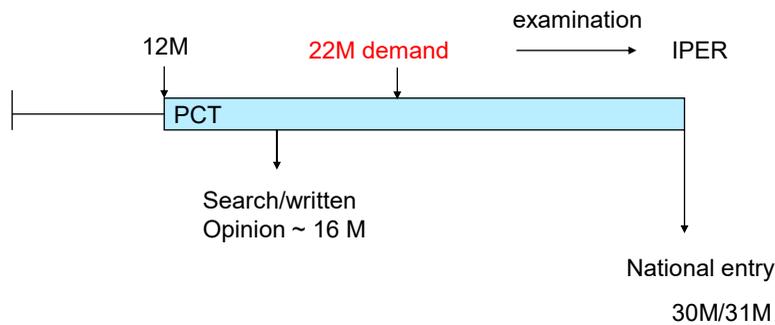
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## Chapter II (cont'd)

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## Practice points

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- Positive WOSA - do you need to file demand?
- Negative WOSA - consequence of inaction = negative IPRP Chapter I
- Negative WOSA - file demand and argue [If you want to amend the claims or spec and provide arguments then submit these with the demand]
- Advantages of a positive IPRP
- Choosing ISA/IPEA is strategic – different fees apply and there are different levels of prior art search ‘thoroughness’

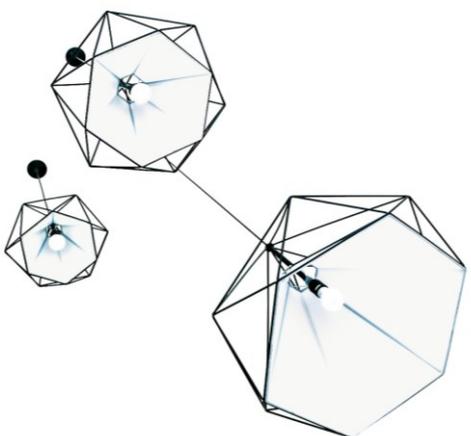
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**Part 2: The Nuts and Bolts**

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## Chapter I

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Who may apply?

- A national or resident of a PCT Contracting State (Art. 9 PCT)
  - a national may be a legal entity
  - residence means real and effective commercial interest (Rule 18.1b PCT)
- Different applicants may be designated for different Contracting States

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## Rule 19 PCT - Where?

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- A competent Receiving Office (RO)
  - (an office of a Contracting State in which at least one of the applicants is a resident or national)

OR

- the International Bureau of WIPO in Geneva
  - Rule 19, NB Rule 19.4 back-up: if you file at the wrong receiving Office it is not fatal

[As representatives authorised to act before the UKIPO and EPO, we can file on behalf of our clients at the UKIPO, EPO or International Bureau]

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## In what language? (Rule 12 PCT)

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- An international application can be filed in any language which the Receiving Office accepts.
- The Receiving Office has to accept at least one language which is both
  - (i) accepted by a competent ISA (for that receiving Office) and
  - (ii) a language of publication.
- The request form has to be filed in a language of publication accepted by the Receiving Office (Rule 12.1(c) PCT).
  - UKIPO - accepts applications in English or Welsh but the request must be in English. If filed in Welsh a translation will need to be provided for the ISA
  - EPO - accepts applications and requests in English, French and German

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## What is a language of publication? [Rule 48(3) PCT]

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The PCT languages of publication are:

- Chinese, English, French, German, Japanese, Russian, Spanish, Arabic, Korean and Portuguese
- If application filed in one of these languages then publication is in the same language - with title, abstract and search report also published in English (prepared by ISA)
- If application not filed in one of these languages, publication is in the language of the translation [Rule 48.3(b) PCT]

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## Designation of states [Rule 4.9 PCT]

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- Automatic coverage of all designations. Make 'choice' on national phase entry
- Application form provides for *exceptions* for designation of DE, KR, JP (these countries have rules that may invalidate e.g. a DE priority filing in favour of the PCT DE designation)
- Withdrawal of other designations is possible
- Different types of protection:  
<https://www.wipo.int/pct/en/texts/typesprotection.html>

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## Minimum filing requirements [Art 11 PCT]

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To get international filing date, you need:

- Right to file (residence/nationality)
- Application in prescribed language including '5 elements':
  - a) indication that application is intended as international application .
  - b) designation of at least one Contracting State
  - c) name of the applicant allowing identification
  - d) part which appears to be a description
  - e) part which appears to be a claim or claims (any number; no excess claims fees)

*No fees, abstract, signature etc required initially*

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## Fees

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- 3 kinds of initial fee (collected by RO)
  1. Transmittal fee (for RO) - Rule 14 PCT
  2. International filing fee (for WIPO) - Rule 15 PCT
  3. Search fee (for ISA) - Rule 16 PCT
- Payable within 1 month of date of receipt of International Application
- *Non-payment of any fees not immediately fatal - invitation to pay with fine issued – [Rule 16bis PCT]*
- Fees associated with Chapter II if 'demand' filed ("handling fee; "preliminary examination fee" to IPEA)
- National fees are paid to national offices when entering national phase

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## Search

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- Receiving Office specifies which ISA(s) are competent
- For applications filed with IB, the competent ISA is the ISA which would have been competent if the application had been filed with a national (or regional) Office as Receiving Office [Rule 35.3 PCT]

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## Unity of invention

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- Claims may not be searched if lack of unity is alleged
- Applicant invited to pay additional search fee(s)
- Applicant may pay the fees under protest - plus possible 'protest fee' [Rule 40.2 (c) PCT]

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## Don't forget to claim priority

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- Date, state and number [Rule 4.10 PCT]
- Rule 17 PCT: Certified copy to be provided to International Bureau within 16 months from priority
  - If you are late you can still meet the deadline if the copy is filed before international publication
- Even then no designated Office shall disregard priority claim without giving the applicant an opportunity to furnish the priority document [Rule 17.1(c) PCT]
- See also Rule 26bis for correction or addition of a priority claim (16 months from priority date or four months from filing date, whichever is later)

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## Amendment of claims under Chapter I (Article 19 PCT)

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- An applicant can **amend claims** up to 16 months from priority (or 2 months from transmittal of search report if later)
- File at International Bureau only
- But even after that amendments can be accepted up until technical preparations for publication have been completed (Rule 46.1 PCT)

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## Publication

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- Takes place 'promptly' after 18 months from priority and can be delayed by withdrawing priority claim
- Publication will not take place if application withdrawn before technical preparation complete
- Electronic publication: [www.wipo.int/pctdb](http://www.wipo.int/pctdb)

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## Filing a demand?

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- Submit to the competent International Preliminary Examining Authority (IPEA)
  - 22 months from priority or 3 months from date of the ISR [Rule 54bis PCT]
- Competent IPEA depends on the Receiving Office (applicant may have choice) or if filed at the International Bureau what the competent IPEA would have been if the application had been filed at a competent Receiving Office (if more than one possibility, applicant may choose) [Rule 59 PCT]

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## International Preliminary Examination

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- Starts once IPEA has the demand, fees and written opinion - earliest is 22 months from priority (Rule 54 bis) but can request earlier under (Rule 69 PCT)
- Amendments filed in Chapter II (claims, description, drawings) under Article 34 PCT sent to IPEA
- Applicant has a right to have a 'personal interview' with the examiner (Rule 66.6 PCT)
- Issue of IPRP Chapter II (the IPER) normally occurs by 28 months from priority (Rule 69.2 PCT)

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## Finally ...

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- Third party observations - via patentscope  
<https://www.wipo.int/patentscope/en/>
- Applicants can indicate the availability of an invention for license in PCT applications on patentscope

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## National Phase entry

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- At 30 / 31 months from the earliest priority date, the national phase of the PCT application begins and the International phase ends
  - US is at 30 months
  - EPO and UK are at 31 months
- At this time, the applicant must engage with national patent offices where they wish to continue the International patent application
  - More fees payable and translations may be required
- The national phase deadlines can be extended in certain territories, e.g. further processing can be used at the EPO

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## Useful rules

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Read PCT Rules 79-83, 90-96

- Time limits (Rules 79-81)
- Representation (Rule 90)
- Withdrawal (Rule 90*bis*)
- Access to files (Rule 94)



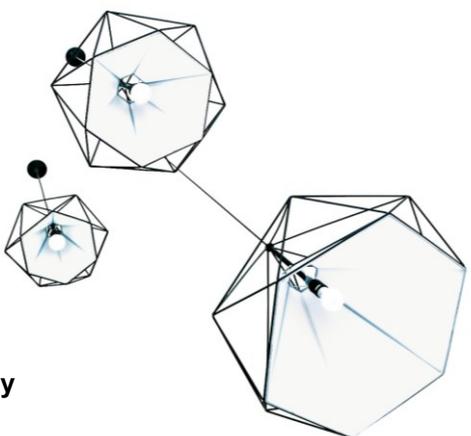
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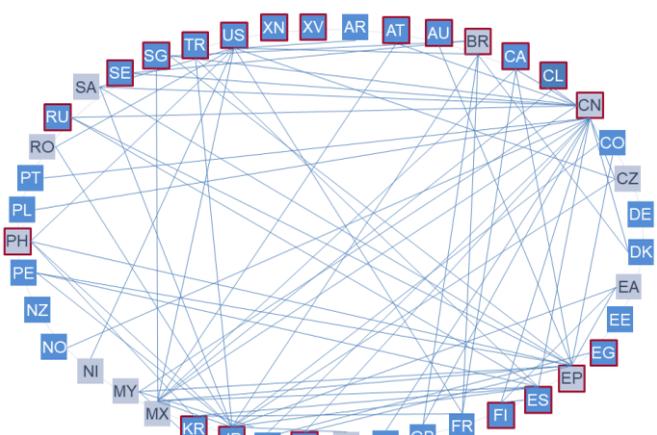


**Part 3:  
PCT Patent Prosecution Highway**

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Patent Prosecution Highway (PPH)



■ Office part of Global PPH  
■ Office acts as International Searching Authority and International Preliminary Examining Authority

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## Recap - Key Considerations / Strategy

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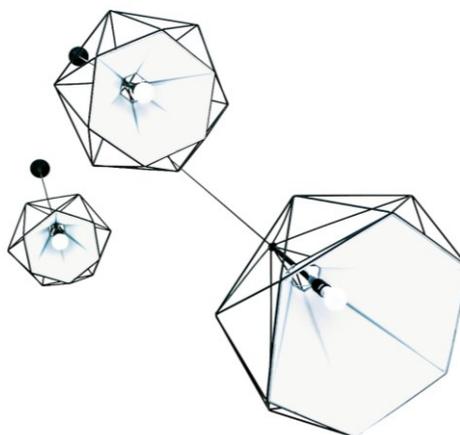
- Consider how many territories are desired, and whether extra time (PCT) or faster prosecution (Direct Filing/Paris Convention) is higher priority  
[https://www.wipo.int/pct/en/paris\\_non\\_pct.html](https://www.wipo.int/pct/en/paris_non_pct.html) (e.g. Argentina)
- Consider which Receiving Office to use, where a choice is possible
- Consider which ISA/IPEA to choose; bearing in mind PPH, fees, 'thoroughness' of prior art search
- Consider whether a demand for preliminary examination should be filed

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### Part 4: Useful materials

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## Useful materials

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WIPO website

<https://www.wipo.int/portal/en/>

PCT Applicant's Guide

<https://www.wipo.int/pct/en/guide/>

Law

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

PCT Newsletter – excellent Q/A every month (and by email)

<http://www.wipo.int/pct/en/newslett/>

Limited file inspection

<https://patentscope.wipo.int/search/en/search.jsf>

PCT information service

– Telephone: +41 22 338 83 38

– E-mail: [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

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## PCT Time Limit Calculator

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The Calculator assists applicants in the computing of essential PCT time limits and provides full explanations of all the time limits, as well as references to relevant PCT Articles or Rules. By clicking on “summary”, all the calculated time limits are shown together on one page – a useful page to print out.

<https://pct.wipo.int/ePCTExternal/pages/PctTimeline.xhtml>

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## Questions from 2022

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1. With a Euro-PCT application if you deselected DE is it still available for the designation of the European application? (re slide page 24) Yes
2. Are the priority applications available to the RO through DAS? Yes  
<https://www.wipo.int/das/en/>
3. Is there any way to accelerate the International phase? (similar to acceleration of examination and publication at UK IPO or PACE request at EPO) There is no International 'PACE' request, but:  
[https://www.wipo.int/pct/en/newslett/practical\\_advice/pa\\_052011.html](https://www.wipo.int/pct/en/newslett/practical_advice/pa_052011.html)

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