



Best practices in the national phase

Session 3

Decisions to be taken by the applicant

■ Whether

- to proceed with or drop the international application ?

■ When

- at the end of 30 months (in some cases 31 months or more)

- under Chapter I ?*
- under Chapter II ?

- early entry ?

■ Where (choice limited to designated/elected Offices)

- which national Offices
- which regional Offices

* LU, TZ and UG continue to apply a 20-month time limit

Prepare for national phase entry

- Take relevant decisions as early as possible
- Double-check names of applicants to allow for last-minute *92bis* requests
- Provide local agent with all relevant information (via ePCT?)
- Instruct local agent how to further prosecute the case
 - National phase amendments?
 - How to argue the case
 - Continue to provide local agent with information

Use of PCT-PPH?

■ Some benefits:

- Reduces duplication of effort via patent office work-sharing
- Increases grant rate
- Reduces pendency and legal uncertainty
- Streamlines prosecution
- Reduces cost (by reducing number of office actions)

■ Procedural requirements

Time limit issues

- The time limit to enter national phase applies irrespective of possible delays in the international phase
- Where national phase entry time limit has been missed:
 - Does Rule 49.6 apply?
 - If yes, which criterion is applicable?
 - Which time limit applies?
 - Cases, where Rule 49.6 does not apply

DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f):

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

- The national law applicable by some of these Offices may nevertheless provide for other forms of protection against loss of rights - for further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant's Guide*, National Phase

Translation issues

- Most Offices require translation of international application as filed and as amended
- Translations must be accurate
- Text matter in drawings
- Defects in translations?

Amendments under national law

- PCT guarantees opportunity to amend application in the national phase
- Details of amendment practice are governed by national law
- Adapt claim drafting to national preferences
- Reduce number of claims to avoid/reduce claims fees
 - Special cases: CN, DE, IN
- Time limit

Special national requirements

- Time limit under Rule 51*bis*.3
- Declarations should now pay off
- Translation of the priority document (Rule 51*bis*.1(e))

Is your agent requiring more than he/she should?

■ Legitimate cases:

- Original priority document where document was not furnished in time during international phase
- Proof or evidence concerning recorded changes under Rule 92*bis*
- By pass route in the US

■ Not so legitimate cases:

- Does request come from the Office?
- Clarify with International Bureau

PCT Resources/Information

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