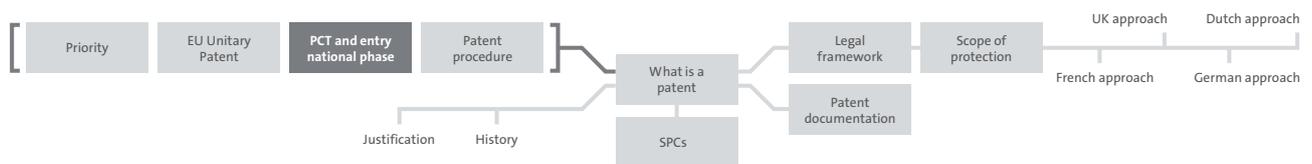


# The PCT and entry into the national phase

## Essentials: The PCT



## The Patent Cooperation Treaty

The Patent Cooperation Treaty (PCT) was signed in Washington DC on 19 June 1970. It entered into force on 24 January 1978 and became operational when the first international application was filed on 1 June 1978.

Article 1(1) PCT: “The States party to this Treaty [...] constitute a **Union for cooperation** in the **filing, searching, and examination, of applications for the protection of inventions**, and for rendering special technical services.”

The PCT makes it possible to file international patent applications in accordance with a single procedure.

It does not provide for the grant of “international patents”. The patent offices of the contracting states for which protection is sought remain in charge of granting regional or national patents in the light of the results produced according to the PCT filing procedure.

### PCT

[www.wipo.int/export/sites/www/pct/en/texts/pdf/pct.pdf](http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct.pdf)

### PCT contracting states

[www.wipo.int/pct/en/pct\\_contracting\\_states.html](http://www.wipo.int/pct/en/pct_contracting_states.html)

### WIPO website

[www.wipo.int/pct/en/](http://www.wipo.int/pct/en/)

### Preliminary examination

The preliminary examination provides an optional, non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable as defined in Article 33 PCT.

### Relationship to Paris Convention

The PCT is a “special agreement” according to Article 19 of the Paris Convention:

### Article 19 Paris Convention Special Agreements

It is understood that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.

Hence, only member states of the Paris Convention may be contracting states to the PCT.

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## How it works

The PCT system is composed of two main phases: a single, international phase, followed by one or more national phases.

The international phase consists of up to five stages:

- The filing of the international application with, and its processing by, the receiving Office.
- The establishment of an international search report by an International Searching Authority.
- The publication of the international application by the International Bureau of WIPO.
- The (optional) establishment of a supplementary international search report by an authority specified for supplementary international search.
- The (optional) establishment of a preliminary examination report by an International Preliminary Examining Authority.

The national phase starts, upon completion of the international phase, if the applicant decides to continue processing the application before the regional or national patent offices with the aim of obtaining regional or national protection.

### Article 2 PCT

#### Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(i) “application” means an application for the protection of an invention; references to an “application” shall be construed as references to applications for patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;

(ii) references to a “patent” shall be construed as references to patents for inventions, inventors’ certificates, utility certificates, utility models, patents or certificates of addition, inventors’ certificates of addition, and utility certificates of addition;

(iii) “national patent” means a patent granted by a national authority;

(iv) “regional patent” means a patent granted by a national or an intergovernmental authority having the power to grant patents effective in more than one State;

(v) “regional application” means an application for a regional patent;

(vi) references to a “national application” shall be construed as references to applications for national patents and regional patents, other than applications filed under this Treaty;

[...]

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## Applying for a patent under the PCT

Any resident or national of a PCT contracting state may file an international application.

International applications have to be filed with a competent receiving Office. The applicant can choose from:

- The **national office** of the PCT contracting state of which the applicant is a resident or national, or with the office acting for that state.
- The **International Bureau** of the World Intellectual Property Organization (**WIPO**), irrespective of the PCT contracting state of which the applicant is a resident or national.
- The competent regional office, e.g. the **European Patent Office (EPO)** (provided that at least one applicant is a national or resident of a contracting state to the European Patent Convention (EPC)).

### Article 9 PCT The applicant

- (1) Any resident or national of a Contracting State may file an international application.
- (2) The Assembly may decide to allow the residents and the nationals of any country party to the Paris Convention for the Protection of Industrial Property which is not party to this Treaty to file international applications.
- (3) The concepts of residence and nationality, and the application of those concepts in cases where there are several applicants or where the applicants are not the same for all the designated States, are defined in the Regulations.

**Article 9 PCT**  
**The applicant**  
→ see below

### Receiving Office Article 2 PCT Definitions

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

(xv) “receiving Office” means the national Office or the intergovernmental organization with which the international application has been filed;

### EPO member states

[www.epo.org/about-us/organisation/member-states.html](http://www.epo.org/about-us/organisation/member-states.html)

When the EPO acts as receiving Office it processes the application in accordance with the relevant provisions of the PCT. The provisions of the PCT and its Regulations are supplemented by the provisions of the EPC.

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## What are the elements of an international application?

International applications must contain the following elements:

- PCT request (Article 4 PCT)
- Description (Article 5 PCT)
- Claim(s) (Article 6 PCT)
- Drawing(s) (where required) (Article 7 PCT)
- Abstract (Article 3(3) PCT).

### Article 3 PCT

#### The international application

[...]

(2) An international application shall contain, as specified in this Treaty and the Regulations, a request, a description, one or more claims, one or more drawings (where required), and an abstract.

[...]

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## The PCT request

PCT requests must contain:

- A petition to the effect that the international application is to be processed according to the PCT.
- The designation of the contracting state(s) in which protection is sought, indicating if national or, where available, regional patents are desired.
- The name of, and other prescribed data concerning, the applicant and the agent (if any).
- The title of the invention.
- The name of, and other prescribed data concerning, the inventor according to the legal requirements of the designated states.

**Article 4 PCT**  
**The request**  
→ see below

### Article 4 PCT The request

(1) The request shall contain:

- (i) a petition to the effect that the international application be processed according to this Treaty;
- (ii) the designation of the Contracting State or States in which protection for the invention is desired on the basis of the international application ("designated States"); if for any designated State a regional patent is available and the applicant wishes to obtain a regional patent rather than a national patent, the request shall so indicate; if, under a treaty concerning a regional patent, the applicant cannot limit his application to certain of the States party to that treaty, designation of one of those States and the indication of the wish to obtain the regional patent shall be treated as designation of all the States party to that treaty; if, under the national law of the designated State, the designation of that State has the effect of an application for a regional patent, the designation of the said State shall be treated as an indication of the wish to obtain the regional patent; [...]

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## Description, claims and abstract

**Article 5 PCT (The description):** "The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art."

**Article 6 PCT (The claims):** "The claim or claims shall define the matter for which protection is sought. Claims shall be clear and concise. They shall be fully supported by the description."

**Article 3(3) PCT:** "The abstract merely serves the purpose of technical information and cannot be taken into account for any other purpose, particularly not for the purpose of interpreting the scope of the protection sought."

Drawings are only required "when they are necessary for the understanding of the invention" (**Article 7(1) PCT**).

### Article 7 PCT The drawings

(1) Subject to the provisions of paragraph (2)(ii), drawings shall be required when they are necessary for the understanding of the invention.

(2) Where, without being necessary for the understanding of the invention, the nature of the invention admits of illustration by drawings:

- (i) the applicant may include such drawings in the international application when filed,
- (ii) any designated Office may require that the applicant file such drawings with it within the prescribed time limit.

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## The international filing date

The international filing date of an international application is the date of receipt of the application by the receiving Office, provided that the requirements in **Article 11(1) PCT** are fulfilled. These requirements are as follows:

- (i) The applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office.
- (ii) The international application is in the prescribed language.
- (iii) The international application contains at least the following elements:
  - (a) an indication that it is intended as an international application,
  - (b) the designation of at least one contracting state,
  - (c) the name of the applicant, as prescribed,
  - (d) a part which on the face of it appears to be a description,
  - (e) a part which on the face of it appears to be a claim or claims.

The international filing date of an application filed with the EPO as receiving Office is the date on which the application is received at one of the EPO's filing offices or, in exceptional cases, at a national patent office of an EPC contracting state acting as filing office on behalf of the EPO.

The term "international filing date" refers simply to the fact that the application concerned was filed as an application under the PCT.

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## The international search

For each international application, an international search is carried out by an **International Searching Authority** (ISA, e.g. the EPO), resulting in an **international search report** (ISR) and a **written opinion** (WO).

The objective of the international search is to discover relevant prior art.

The **international search report** contains (among other things):

- The citations of the prior art documents considered relevant.
- The classification of the subject-matter of the invention.
- The identification of the fields searched.

The international search report is published by the International Bureau of WIPO (**Article 21(3) PCT**).

### Article 15 PCT

#### The international search

(1) Each international application shall be the subject of international search.

(2) The objective of the international search is to discover relevant prior art.

(3) International search shall be made on the basis of the claims, with due regard to the description and the drawings (if any).

[...]

### Article 16 PCT

The International Searching Authority  
→ see below

### Article 21 PCT

#### International publication

[...]

(3) The international search report or the declaration referred to in Article 17(2)(a) shall be published as prescribed in the Regulations.

[...]

#### Article 16 PCT

##### The International Searching Authority

- (1) International search shall be carried out by an International Searching Authority, which may be either a national Office or an intergovernmental organization, such as the International Patent Institute, whose tasks include the establishing of documentary search reports on prior art with respect to inventions which are the subject of applications.
- (2) If, pending the establishment of a single International Searching Authority, there are several International Searching Authorities, each receiving Office shall, in accordance with the provisions of the applicable agreement referred to in paragraph (3)(b), specify the International Searching Authority or Authorities competent for the searching of international applications filed with such Office. [...]

## The written opinion of the ISA

The **written opinion of the International Searching Authority** provides the applicant with a preliminary, non-binding opinion on the question of whether the claimed invention appears to:

- be novel
- involve an inventive step and
- be industrially applicable.

It allows the applicant to assess, at an early stage, whether to proceed to the national/regional phase.

#### Rule 43bis PCT

##### Written Opinion of the International Searching Authority

→ see below

#### Rule 43bis PCT

##### Written Opinion of the International Searching Authority

###### 43bis.1 Written Opinion

- (a) Subject to Rule 69.1(b-bis), the International Searching Authority shall, at the same time as it establishes the international search report or the declaration referred to in Article 17(2)(a), establish a written opinion as to:
  - (i) whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable;
  - (ii) whether the international application complies with the requirements of the Treaty and these Regulations in so far as checked by the International Searching Authority.The written opinion shall also be accompanied by such other observations as these Regulations provide for.
- (b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and (3) and Rules 43.4, 43.6bis, 64, 65, 66.1(e), 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.
- (c) The written opinion shall contain a notification informing the applicant that, if a demand for international preliminary examination is made, the written opinion shall, under Rule 66.1bis(a) but subject to Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority for the purposes of Rule 66.2(a), in which case the applicant is invited to submit to that Authority, before the expiration of the time limit under Rule 54bis.1(a), a written reply together, where appropriate, with amendments.

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## The supplementary international search

Rule 45bis PCT  
Supplementary International Searches  
→ see below

Upon request by the applicant, an optional **supplementary international search** is performed by an international authority other than the International Searching Authority responsible for the establishment of the international search report. The international search report will be the main search, but applicants may be interested in requesting one or more supplementary international searches to expand the linguistic scope of the search. Unlike the international search report, the supplementary international search report is not accompanied by a written opinion.

### Rule 45bis PCT Supplementary International Searches

The supplementary international search permits the applicant to request, in addition to the international search carried out under Article 15 PCT (the “main international search”), one or more supplementary international searches, each to be carried out by an international authority other than the International Searching Authority that carried out the main international search.

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## International publication

Article 29 PCT  
Effects of the international publication  
→ see below

The publication of the international application by the International Bureau (WIPO) takes place promptly after the expiration of 18 months from the priority date.

### Article 29 PCT Effects of the international publication

(1) As far as the protection of any rights of the applicant in a designated State is concerned, the effects, in that State, of the international publication of an international application shall, subject to the provisions of paragraphs (2) to (4), be the same as those which the national law of the designated State provides for the compulsory national publication of unexamined national applications as such. [...]

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## Languages

Rule 48(3) PCT  
Languages of publication  
→ see below

Whether an international application may be filed in a specific language depends on the languages accepted by the receiving Office concerned for the filing of international applications. The EPO acting as receiving Office only accepts international applications filed in English, French or German.

The language of publication of the international application is not always the language in which the international application was filed. The current languages of publication are Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian and Spanish.

#### Rule 48.3 PCT

##### Languages of publication

(a) If the international application is filed in Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish ("languages of publication"), that application shall be published in the language in which it was filed.

(b) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

(c) If the international application is published in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations, if not furnished by the applicant under Rule 12.3, shall be prepared under the responsibility of the International Bureau.

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## Third-party observations

During the international phase, third parties may file observations on an international application.

The observations may be filed anonymously. No fee is due for filing such observations.

Administrative instructions under the PCT,  
Section 801

Third party observation system

→ see below

#### Administrative instructions under the PCT, Section 801

##### Third party observation system

(a) The International Bureau shall provide an electronic system for third parties to make observations referring to prior art which they believe to be relevant to the question of whether the invention claimed in the international application is new and/or involves an inventive step ("third party observation system").

(b) The third party observation system:

- (i) shall provide a third party with the option to remain anonymous;
- (ii) shall allow observations to include a brief explanation of the relevance of each prior art document referred to in the observation and to include a copy of the prior art document;
- (iii) may limit the number of prior art documents which may be referred to in one observation; and
- (iv) may limit the number of observations permitted to be made in relation to one international application, per third party and in total.

(c) The International Bureau shall take technical steps to prevent abuse of the third party observation system.

(d) The International Bureau may temporarily or indefinitely suspend the use of the third party observation system if it considers it necessary to do so.

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## The international preliminary examination

Applicants may optionally file a demand requesting the **international preliminary examination** of an international application to obtain a preliminary and non-binding opinion on whether the claimed invention appears to meet the patentability requirements.

The usefulness of this optional procedure depends on the outcome of the international search. International preliminary examination will, in general, have no added value unless amendments and/or arguments under Article 34 PCT are filed for the International Preliminary Examining Authority to take into account.

**Article 32 PCT**  
**The International Preliminary Examining Authority**  
→ see below

**Article 33 PCT**  
**The International Preliminary Examination**  
→ see below

### **Article 32 PCT** **The International Preliminary Examining Authority**

- (1) International preliminary examination shall be carried out by the International Preliminary Examining Authority.
- (2) In the case of demands referred to in Article 31(2)(a), the receiving Office, and, in the case of demands referred to in Article 31(2)(b), the Assembly, shall, in accordance with the applicable agreement between the interested International Preliminary Examining Authority or Authorities and the International Bureau, specify the International Preliminary Examining Authority or Authorities competent for the preliminary examination.
- (3) The provisions of Article 16(3) shall apply, mutatis mutandis, in respect of International Preliminary Examining Authorities.

### **Article 33 PCT** **The International Preliminary Examination**

- (1) The objective of the international preliminary examination is to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), and to be industrially applicable.
- (2) For the purposes of the international preliminary examination, a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.
- (3) For the purposes of the international preliminary examination, a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.
- (4) For the purposes of the international preliminary examination, a claimed invention shall be considered industrially applicable if, according to its nature, it can be made or used (in the technological sense) in any kind of industry. "Industry" shall be understood in its broadest sense, as in the Paris Convention for the Protection of Industrial Property.
- (5) The criteria described above merely serve the purposes of international preliminary examination. Any Contracting State may apply additional or different criteria for the purpose of deciding whether, in that State, the claimed invention is patentable or not.
- (6) The international preliminary examination shall take into consideration all the documents cited in the international search report. It may take into consideration any additional documents considered to be relevant in the particular case.

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## The national/regional phase

At the end of the international phase (at the latest), the applicant must decide whether and where he wants to proceed with the international application and, if so, enter into the national/regional phase before the respective designated or elected offices.

The applicant will then need to fulfill the specific national/regional requirements, such as the payment of fees and the filing of translations. The standard time limit for compliance with these requirements is 30 months from the priority date (**Article 22 PCT**).

If the applicant wishes to obtain a European patent, he must enter into the “European phase” with the EPO. The requirements in **Rule 159 EPC** must be fulfilled. At the EPO, the time limit for performing the required acts for entry into the regional phase is **31 months** from the priority date.

When deciding whether to grant the patent, the regional or national office is bound solely by its national law. However the international search report and the written opinion, as well as the optional international preliminary examination report, provide a strong basis for a decision.

**Article 22 PCT**  
**Copy, Translation, and Fee, to Designated Offices**  
→ see below

**Article 27(5) PCT**  
**National requirements**  
→ see below

**Article 39 PCT**  
**Copy, translation, and fee, to elected Offices**  
→ see below

**Article 45(2) PCT**  
**Regional patent treaties**  
[...]  
(2) The national law of the said designated or elected State may provide that any designation or election of such State in the international application shall have the effect of an indication of the wish to obtain a regional patent under the regional patent treaty.

**Rule 159 EPC**  
**The European Patent Office as a designated or elected Office – Requirements for entry into the European phase**  
→ see below

### **Article 22 PCT** **Copy, Translation, and Fee, to Designated Offices**

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30 months from the priority date. [...]

### **Article 27(5) PCT** **National requirements**

[...] (5) Nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.

## Article 39 PCT

### Copy, translation, and fee, to elected Offices

- (1) (a) If the election of any Contracting State has been effected prior to the expiration of the 19th month from the priority date, the provisions of Article 22 shall not apply to such State and the applicant shall furnish a copy of the international application (unless the communication under Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each elected Office not later than at the expiration of 30 months from the priority date.
  - (b) Any national law may, for performing the acts referred to in subparagraph (a), fix time limits which expire later than the time limit provided for in that subparagraph.
- (2) The effect provided for in Article 11(3) shall cease in the elected State with the same consequences as the withdrawal of any national application in that State if the applicant fails to perform the acts referred to in paragraph (1)(a) within the time limit applicable under paragraph (1)(a) or (b).
- (3) Any elected Office may maintain the effect provided for in Article 11(3) even where the applicant does not comply with the requirements provided for in paragraph (1)(a) or (b).

## Rule 159 EPC

### The European Patent Office as a designated or elected Office – Requirements for entry into the European phase

- (1) In respect of an international application under Article 153, the applicant shall perform the following acts within thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:
  - (a) supply, where applicable, the translation of the international application required under Article 153, paragraph 4; [...]

## Applying for a patent under the PCT

