Benefits Resulting from Using the PCT

11. Designation fees must be paid before the end of the priority year or within one month after filing, whichever time limit expires later. If no priority is claimed and designation of all Contracting States has been made in the international application, the option is kept open—at no cost—for 12 months to select designations and pay designation fees only for those countries where the applicant wants the international application to remain in effect.

12. Only one designation fee must be paid under the PCT for a regional patent (such as an ARIPO patent or a European patent) independent of the number of States party to the regional patent treaty which are designated or for a Eurasian patent or an OAPI patent during the international phase. It is advisable to designate in the international application all States party to the regional patent treaty at the time of filing and make the selection of individual European States at the start of the European regional phase (i.e., 21 months from the priority date, or 31 if Chapter II applies) when payment of the European designation fee for each individual State is required. The same observation applies to the designation of States for the purpose of an ARIPO patent.

13. A maximum designation fee under the PCT (which corresponds to 11 designation fees) permits the designation of all Contracting States. Each designation in excess of 11 is free of charge. This makes it possible to designate all Contracting States at reasonable cost at the time of filing and to thereby keep the option for a foreign patent open in any Contracting State until 20 months from the priority date, or 30 if Chapter II applies.

14. Failure to pay fees or underpayment of fees can be corrected under Rule 16*bis*. An invitation to pay missing amounts will be issued by the receiving Office. Payment can be made later, together with a late payment fee.

15. **Priority.** Only one certified copy is required of each priority application, within 16 months from the priority date; no copies for each designated Office are needed. The copies for the designated Offices are prepared—at no additional cost to the applicant—by the International Bureau. It should be noted, however, that only one country, Brazil, requires a photocopy (not certified) of the priority document in addition to the certified translation of that priority document upon entry into the national phase.

16. Transmittal of the priority document need not be monitored if a request for transmittal by the receiving Office to the International Bureau of an application filed with that receiving Office was made in the Request form and the applicable fee for a priority document was paid to the receiving Office.

17. **International search.** A high quality international search report is established by the International Searching Authority.

18. If the international application did not claim any priority, the international search report is available within 9 months from the international filing date, which is before the payment of designation fees becomes due. If priority is claimed, that report is available usually during the 16th month from the priority date.

19. Even where priority is claimed, the international search report is normally available in time before publication of the international application. This allows time for the applicant to withdraw the application before publication, if desired.

20. **Withdrawal.** An international application can be withdrawn at any time during the international phase. Where the intent of the withdrawal is to prevent publication, the notice of withdrawal must reach the International Bureau before technical preparations for international publication have been completed (i.e., not later than 15 days before the date of publication).

21. A notice of withdrawal of an international application can be made with the condition that the withdrawal be effective only if the international publication can still be prevented.

22. **Amendments.** The claims can be adjusted to the results of the international search report by amending them once (under Article 19) with effect in all designated States. Such amendments save costs for preparation of different sets of amendments and for local agents filing such amendments before designated Offices, and guarantee better provisional protection and patents in registration countries. Individual amendments before each designated Office are also permitted

Entry into the national phase

27. Final decision as to entering the national phase before designated Offices need not be made until prior to the expiration of 20 or 30 months from the priority date (before some national Offices even later). This gives the applicant 8 or 18 additional months, respectively, to make such decisions and incur such costs as compared to the traditional Paris Convention route.

28. The applicant has at this later time a better understanding as to:

(i) the technical and economical development of the invention (in particular, when its development was not completed at the end of the priority year);

(ii) the chances of obtaining strong patents in view of the prior art,

(iii) possible licensing agreements,

(iv) marketing prospects and strategies.

29. Only at this time must expenses be incurred in each designated or elected Office for translations (where required), national fees, and local agent fees.

Savings

30. **Fee savings.** National fees are reduced or completely dispensed with for the procedure before some Offices which provides considerable savings, for example:

European Patent Office (EPO):
- European search fee waived if international search report by AT, EP, ES, SE;
- 20% reduction of European search fee if search report by AU, CN, JP, RU, US;
- 50% reduction of European examination fee if international preliminary examination report by EP.

German Patent Office:
- filing fee waived if the Office was the receiving Office;
- examination fee reduced if international search report.

Hungarian Patent Office:
- filing fee waived if the Office was the receiving Office;
- 50% reduction of the national fee if the applicant is the inventor.

Japanese Patent Office:
- approximately 80% reduction of examination fee if international search report established by JPO;
- approximately 20% reduction of examination fee if international search report established by ISA other than JPO.

United Kingdom Patent Office: refund of part of preliminary examination and search fee.

31. **Time savings.** Processing time in the national phase before designated or elected Offices is reduced in many cases because:

- the application fulfills the formal requirements,
- the application has already been subjected to a novelty search,
- the claims are adapted to the references cited in the international search report,
- the designated or elected Offices save time in searching and examination,
- there is less correspondence with the designated or elected Offices,
- there are usually fewer prior art references cited by various Offices.

32. **Other savings.** The postponement of all national expenses by up to one and a half years results in important interest savings. Further savings can be made because no drawings need be furnished to the designated Offices in the national phase if the originals were of a good quality. Other savings result from processing only one priority document and from claiming priority only once. Together these savings offset already, in most

Benefits from using the PCT: a unique procedure

1. One application, in one language, filed with one Office, replaces multiple foreign filings until entry into the national phase
2. Permits last minute foreign filing (before expiration of priority year)
3. International filing date has the effect of national filing date in all designated Offices
4. Uniform formal requirements accepted by all designated Offices
5. Greater home control of the prosecution
6. Decision on foreign filings can be postponed up to 30 months from the priority date at minimal cost
7. Enables assessment of economic value of the invention and the chances of obtaining a patent before entering national phase

Benefits from using the PCT: greater flexibility

1. Keep options open by making multiple designations
2. Various possibilities for withdrawal
3. International publication can be prevented or postponed until as late as 15 days before the actual publication date – conditional withdrawal possible
4. Further expenses can be avoided simply by no longer prosecuting the application or not entering the national phase
5. Amendments made during the international phase have effect in all designated/elected States
6. More time for better quality translation for the national phase
7. Better planning of the expenditures for the national phase

Benefits from using the PCT: further features

1. Postponing national filings costs earns interest on capital
2. Fee reductions in national phase in certain national Offices
3. More straightforward and rapid national patent granting
4. Less restrictive unity of invention requirements permit a reduced number of applications in the US
5. Provisional protection after publication at 18 months from the priority date (in countries which afford such protection)
6. 75% reduction in PCT fees for applicants from certain Contracting States

cases, a good part of the cost of an international application.

33. The greatest savings, however, have been made if, as the result of a re-evaluation at the time of entry into the national phase, the decision is taken to abandon the application or not to enter the national phase in some designated or elected Offices.

Further Advantages

34. Using the PCT permits:

(i) greater flexibility in reaching decisions on filing in foreign countries, and, where Chapter II applies, this decision needs to be made only prior to the expiration of 30 months from the priority date;

(ii) the filing of an application claiming priority of an earlier application on the last day of the priority year with the effect of a regular national filing in all designated States ("last-minute filing");

(iii) the consideration of all technical and economic experience obtained after filing but before the incurring of considerable expenses during the national phase;

(iv) the consideration of the state of the art of the invention as established in the international search report before making final decisions;

(v) the patent attorney who prepared and filed the application to remain in exclusive control until the entry into the national phase 20 or 30 months from the priority date;

(vi) collecting the necessary funds for foreign granting procedures after filing.

35. Where renewal or maintenance fees become due only after publication of the examined application (e.g., Austria, Japan, the Republic of Korea) or after the granting of the patent (e.g., the Russian Federation, the United Kingdom and the United States of America) they may be payable at later dates due to later start of the national procedure.

in the national phase and all parts of the application can be amended (under Article 34(2)) during the international preliminary examination procedure under Chapter II (see below).

23. **Monitoring of time limits.** Easy supervision and monitoring of only a few time limits and events is required by applicants, namely:

(i) monitor the receipt of the confirmation of receipt of the international application by the receiving Office;

(ii) monitor the time limits for payment of fees;

(iii) check the notification from the International Bureau confirming the receipt of the record copy (Form PCT/IB/301) for correctness of the designations indicated on the Form and if needed, confirm precautionary designations within 15 months from the priority date;

(iv) decide, after receipt of the international search report, whether or not to file a demand for international preliminary examination (which must be filed prior to the expiration of 19 months from the priority date in order to delay entry into the national phase until 30 months from the priority date);

(v) decide, after receipt of the international search report, whether or not to file amended claims under Article 19, within the applicable time limit; this will usually be considered only if no demand for international preliminary examination is filed;

(vi) monitor the receipt, during the 19th month from priority date, of the notice from the International Bureau (Form PCT/IB/308) that communication of the international application to the designated Offices (Article 20) has been effected;

(vii) enter into the national phase before the expiration of 20 months from the priority date, or 30 if Chapter II applies, (in some designated or elected Offices, even later), by paying the national fees and furnishing (if required) a translation of the international application.

24. The international application, after its publication, benefits from provisional protection in designated States if the national law thereof provides for such protection for national applications.

Chapter II (International Preliminary Examination)

25. The use of Chapter II:

(i) is optional for the applicant;

(ii) provides, in addition to the international search report, an international preliminary examination report containing an opinion on the usual criteria of patentability before expenses are incurred for the national phase (for translation, fees and foreign agents);

(iii) helps the applicant to adapt the international application to the results of the international search report;

(iv) allows with effect for all elected Offices the amending of all parts of the international application (description, claims and drawings) during international preliminary examination;

(v) defers until 30 months from the priority date the entry into the national phase if the demand is filed within 19 months from the priority date.

26. If Chapter II is used, the international preliminary examination indicates the probability of obtaining a strong patent for minimal cost:

(i) necessary amendments will have been made in cooperation with the examiner and the application will be more or less ready for acceptance by the elected Offices;

(ii) if the report is negative and the applicant decides to abandon the application, he has saved all the expenses otherwise incurred before the elected Offices for the payment of national fees, the preparation of translations and the appointment of local agents.

XX.2

Main benefits

1. The PCT provides a system which facilitates the obtaining of patent protection in several countries through the filing of one single international application with the effect of regular national filings in each State designated in the application.

2. This chapter contains, in a summarized form, a listing of the most important features of the PCT procedure and the major benefits for applicants.

Preparation of patent applications

3. Any patent application, drafted in accordance with the requirements of the PCT, allows a maximum of flexibility and benefit from the advantages of the PCT:

(i) the same application documents can then be used for filing national and/or international applications,

(ii) no adaptation of the original application is required inasmuch as the PCT format is valid for all designated Offices (including the EPO, the Japanese Patent Office and the United States Patent and Trademark Office).

Filing and processing of an international application

4. Filing of patent applications for foreign countries is possible with the national patent Office or with regional Offices (such as ARIPO and the EPO) or the International Bureau which act as receiving Offices for international applications provided that at least one applicant is a resident or national of a Contracting State for which the receiving Office acts.

5. A copy of an earlier national application can be used for obtaining an international filing date. If any formality requirement has not been observed when preparing the application, it can be corrected after filing, without the international filing date being affected. The receiving Office will invite the applicant to correct. Extensions of time for correction can be requested.

6. The international filing date accorded by the receiving Office is considered to be the actual filing date in each designated State.

7. The processing during the international phase, of only one application, in one language, before the international authorities instead of different applications with different national Offices, languages and agents allows substantial savings.

8. Any application drafted in accordance with the PCT is valid for all designated States, provided that:

(i) the advantageous effects of the invention known to the applicant have been stated (Rule 5.1(a)(iii));

(ii) the best mode for carrying out the invention has been set forth (Rule 5.1(a)(v));

(iii) multiple dependent claims refer to other multiple dependent claims in the alternative only and do not serve as a basis for other multiple dependent claims (Rule 6.4(a)); the latter applies only if the United States of America has been designated and, if not complied with, the defect can be corrected in the national phase by amending the claims accordingly.

9. The broad unity of invention concept under Rule 13 allows the grouping of inventions in one application provided they form a single general inventive concept. It applies equally before all designated Offices. No such Office may apply to international applications more restrictive unity of invention requirements. Therefore, the United States Patent and Trademark Office applies a unity of invention standard to international applications which is broader than the standard applied to national US applications.

10. **Fees.** International application filing fees can be paid in the national currency and to one Office, the receiving Office. They may all be paid within one month after filing (for the designation fee, however, see next paragraph).