

Patent Cooperation Treaty (PCT) Working Group

Eighteenth Session
Geneva, February 18 to 20, 2025

FILING MEDIUM FOR ENTERING THE NATIONAL PHASE BEFORE DESIGNATED OFFICES

Document prepared by the International Bureau

This document replaces document PCT/WG/18/4. Following informal comments made in advance of the session, this revised document contains alternative draft amendments to Rules 49.4 and 82.2 compared to those in document PCT/WG/18/4, aimed at:

- (i) clarifying that the proposed requirements for means of supplying data need not apply to all such means, as long as at least one means is available and is easily usable by the applicant;*
- (ii) ensuring that applicants have a means available for national phase entry that does not require them to provide more information or take more actions than are required under Article 22(1);*
- (iii) providing for notifications of any requirements that an Office may prescribe for national phase entry;*
- (iv) making the proposed requirements of safeguards less specific and clarifying that it is only necessary to provide the safeguard in Rule 82.2(a) in the case where the electronic means of transmission is the only permitted route, recognizing that Article 48 requires separate safeguards in the case of mailing of documents and that it is nevertheless desirable to offer safeguards more wide-ranging than the minimum required; and*
- (v) aligning the terminology closer to that of Article 22.*

SUMMARY

1. The present document studies the issues concerning electronic-only entry into the national phase. If the Working Group agrees that designated Offices can limit national phase entries to electronic means, the document proposes an amendment of the Regulations under the Patent Cooperation Treaty to clarify this possibility. The document also proposes a provision to provide safeguards to applicants where such electronic means is not available, as exists for irregularities in the mail service.

BACKGROUND

2. At the fifteenth session of the Working Group in October 2022, Brazil presented a proposal to amend Rule 89*bis*.1 and Rule 89*bis*.2 to allow receiving Offices to require that the filing of international applications, the submission of subsequently filed documents and entry into the national phase be performed only in electronic form and not on paper (see document PCT/WG/15/13). Revised proposed amendments to Rule 89*bis* concerning the filing of international applications and the submission of subsequent-filed documents were discussed at the seventeenth session of the PCT Working Group in February 2024 (see document PCT/WG/17/15) and adopted by the PCT Assembly in July 2024 (see document PCT/A/56/3). The Working Group invited the International Bureau to study the issues concerning electronic-only entry into the national phase (see paragraph 39(ii) of the Summary by the Chair, document PCT/WG/15/19).

STUDY ON ELECTRONIC-ONLY NATIONAL PHASE ENTRY

INTRODUCTION

3. Looking further into issues around electronic-only entry into the national phase, the International Bureau considered two questions. First, whether a requirement by designated Offices to accept national phase entries only by electronic means would be contrary to the PCT. Second, if the existing legal framework does not prevent a designated Office requiring electronic-only national phase entry, whether any limitations to imposing such a requirement would or should apply.

COMPATIBILITY WITH CURRENT PCT LEGAL FRAMEWORK

4. The acts required by an applicant to enter the national phase at a designated Office are set out in Article 22(1):

Article 22 **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 the expiration of 30¹ 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 the expiration of 30 months from the priority date

5. Rule 49.4 clarifies that no applicant shall be required to use a national form when performing the acts referred to Article 22.

¹ A 20-month time period in Article 22(1) applies to Luxembourg and the United Republic of Tanzania.

6. Not surprisingly, the issue of electronic-only national phase entry was not yet on anyone's mind when the PCT was adopted in 1978 or when Rule 49.4 was added in 1985 and thus this issue was not specifically addressed. These provisions focus on the content of what designated Offices may or may not require, not on how this data is to be transmitted.

7. The absence of any provisions on how the international application should be transmitted does not suggest that designated Offices cannot regulate the kind of delivery mechanisms they would be willing to accept. Even before the availability of electronic submissions, certain choices in this regard would seem to have been available to Offices, such as whether to accept certain delivery services other than postal mail, hand delivery, etc. Similarly, in the absence of explicit requirements of ways to pay any national fee required under Article 22(1), it has always been accepted that a designated Office can freely decide on the manner in which national fees are to be paid and thus to limit payment options. Given that the means of transmission of the required content for entering the national phase is not specifically regulated by the relevant PCT provisions, the International Bureau considers that it is left to the designated Offices to decide which means of transmission they are willing to accept.

Relationship With the Patent Law Treaty (PLT)

8. For a detailed discussion on the issue of consistency between the provisions of the PLT and those of the PCT, reference is made to document PCT/WG/17/15.

LIMITATIONS ON REQUIRING ELECTRONIC-ONLY NATIONAL PHASE ENTRIES

9. On the basis that designated Offices can, in principle, regulate the means of transmission of the required elements under Article 22(1), it is necessary to consider what limitations may exist on the extent to which a designated Office can exercise this regulation. These limitations as to what may be required would apply equally to paper and electronic national phase entries.

Historical Background to Adoption of Rule 49.4

10. It is interesting in this regard to recall the discussions that led to the adoption of Rule 49.4 with effect from January 1, 1985. In the preparatory document for the eleventh session (7th extraordinary) of the PCT Assembly, held from January 30 to February 3, 1984 (document PCT/A/XI/5), the paragraphs below seem particularly relevant:

"2. Ad Rule 49.4 and 49.5 (in general). The provisions of Article 22(1) list exhaustively the acts that must be performed as a condition for entering the national phase. That the said listing is exhaustive follows also from Article 24(1)(iii), which cites only the acts referred to in Article 22 as acts whose non-performance within the time limit for entering the national phase may result in the loss of the effect of the international application in the designated States ("may" because Article 24(2) enables the designated Office to maintain the effect notwithstanding such non-performance).

"3. The applicant who files an international application is entitled to expect especially having regard to the provisions of Article 24(1)(iii) that nothing more is required of him prior to the time limit applicable under Article 22 than to pay the national fee, to provide any necessary translation of his application as well as, in certain cases, a copy of that application, and to furnish certain indications concerning the inventor unless they were contained in the request, and he is entitled to expect that he cannot lose his rights if he complies with those conditions.

"4. The International Bureau has learned from its discussions with the national Offices in connection with its publication of Volume II of the PCT Applicant's Guide (which deals with the procedure before them as designated and elected Offices) and from letters it receives from users of the PCT that some designated Offices ask, for the entering of the national phase, for compliance with conditions additional to those permitted by the PCT

and the Regulations. Furthermore, the requirements in respect of the translation of the international application are different in most of the designated Offices, and clarification is urgently needed.

“5. The first point concerns the use of a special national form for entering the national phase. Such requirement is contrary to Article 22(1) in the sense that it would oblige the applicant to perform an act namely, to use a special national form which is not comprised in the exhaustive listing, set forth by that Article, of the acts to be performed for entering the national phase. Naturally, when the applicant wishes to initiate a certain action during the national phase, he may be required to use a special national form for that purpose, as prescribed by the national law, but such a requirement cannot be imposed upon him for the entry into the national phase. In order to clarify the matter, it is proposed to expressly negate such requirement for the entry into the national phase in what would be a new Rule, namely, Rule 49.4. That Rule would not prevent any designated Office from issuing a special national form which could be used for the entry into the national phase. However, the use of such form would be optional and not mandatory.

[...]

“10. [...] It is proposed that a new Rule—Rule 49.5(a)—specify the parts that have to be translated. Those would be all the parts of the international application except the request. Requiring translation of the request creates difficulties for the applicant, particularly where no version of the request form exists in the language of the translation. Even where such a version exists, it may not be easily at the disposal of the applicant. [...]”

11. It seems apparent from the above document which led to the adoption of Rule 49.4, that PCT Contracting States viewed Rule 49.4 only as a clarification of what Article 22(1) already contains, namely, an exhaustive list of requirements that designated Offices can ask applicants to comply with to enter the national phase. Nothing more may be asked for by designated Offices, in particular not the use of a specific form.

12. Given that missing the time limit to enter the national phase would likely lead to a loss of rights for applicants, it appears that the Contracting States at the time wanted the barrier to meet the time limit to be kept low, allowing applicants from around the world to enter the national phase reasonably easily in any Contracting State. While further national requirements could subsequently be imposed in line with Article 27 and Rule 51 *bis*, the requirements to meet the time limit at each designated Office were purposefully kept to a minimum.

Reasonable Limitations

13. Applying the above principle concerning limitations to any required means of transmission to effect national phase entry would avoid the purpose of the Articles and Rules being circumvented through measures that would have a similar effect to imposing further requirements not stipulated in Article 22(1). In other words, the particular means to enter the national phase provided by a designated Office must make it reasonably practical for applicants from around the world to meet the 30-month time limit on short notice and the applicant should be able to enter the national phase without needing to rely on local counsel. Barriers that would make it difficult to enter the national phase on short notice and/or without the help of a local agent or having local residence would be contrary to the intent and purpose of Articles 22 and 27, as well as Rules 49.4 and 51 *bis*.

14. Considering the above findings, in the view of the International Bureau, the only limitations preventing designated Offices from requiring applicants to exclusively use an electronic system to enter the national phase are:

- (a) the interpretation of Rule 49.4, which could be taken to exclude the possibility of any on screen form as a sole means of national phase entry, even if it simply collects the minimum information to identify the application; and
- (b) the prohibition on the need to use a local agent for the action of national phase entry, which means that any system should be practically usable by non-residents.

15. Whereas the possibility of restricting options for filing international applications and corresponding with the receiving Office affects mainly the nationals and residents of the State of the receiving Office, restrictions on national phase entry will also affect nationals and residents of other Contracting States. Consequently, it is particularly important to ensure a common understanding of the options and to consider not only whether legal barriers to such restrictions currently exist, but also whether safeguards should be created in order to protect applicants' rights.

16. In the view of the International Bureau, the main issue to be considered as a matter of policy is whether an applicant can easily make a national phase entry at short notice. This has different aspects to it:

- (a) Is the system reliably available at the necessary time and, if not, is there adequate protection for applicants affected by outages?
- (b) Is the system realistically usable by applicants?

Safeguards to Protect Applicants

17. Electronic systems will occasionally be unavailable. The time limit for national phase entry is fixed by Article 22 or 39(1) and consequently would not normally be subject to exceptions made under the Regulations. However, Article 48(1) explicitly requires a time limit that is not met due to interruption in the mail service to be deemed to be met, subject to proof and conditions prescribed in the Regulations. Consequently, designated Offices are required to accept late national phase entries in situations set out in Rule 82.1 due to irregularities in the mail service (and may also be required to offer additional possibilities for extensions under Article 48(2) and Rule 82*bis*). Adopting a purposive construction of Article 48 as covering the only effective means of transmitting documents over long distances at the time the provision was adopted, it should be acceptable to extend the scope of Rule 82 to cover failures to meet these time limits as a result of failures of electronic communication systems, whether the fault is at the Office or due to general inaccessibility of services affecting the region of the applicant.

18. Certainty that such a safeguard exists is important. It would be desirable if an even broader safeguard applied, similar to that provided in Rule 82*quater*. However, while it is open to Contracting States to provide such safeguards, the Treaty does not appear to give the power to require a broad exception to the time limits set in Articles 22 and 39(1). Applicants may also be able to request reinstatement of rights under Rule 49.6 where this applies. However, this is not available in every Contracting State² and may require a fee and evidence of due care by the applicant. To oblige applicants to rely on Rule 49.6 in instances where the electronic systems are unavailable places an unfair burden on applicants for situations for which the applicant is not responsible.

Usability of the System

19. There must be no practical barriers to access an electronic-only national phase entry system, particularly for an applicant who is not a national or resident in the State of the

² The designated Offices where this provision does not apply due to incompatibility with the national law applied by the designated Office are listed on the WIPO website at https://www.wipo.int/pct/en/texts/reservations/res_incomp.html.

designated Office. Notably, if it is necessary to create an account with the Office in order to effect the national phase entry, it must be possible for this to be done at short notice by someone who is not a national or resident. Consequently, there must be no mandatory data requirements that cannot be met by non-residents and the process should be self-service with no long delays while manual checking is performed.

20. While Rule 49.4 precludes the use of a mandatory national form for national phase entry, national forms are commonly used and greatly assist efficient processing. An electronic national phase entry system could be seen to be contrary to Rule 49.4 if there were no other means of national phase entry available, even if the electronic form within that system required no more than the entry of the relevant international application number. However, this cannot be the intended meaning. The purpose of the Rule appears to be to ensure that Offices do not require more information for national phase entry than is referred to in Article 22 and that national phase entry is not prevented because of a lack of access to copies of the required form in times when physical copies of forms would be needed.

21. Consequently, it is desirable to clarify that the use of an electronic form for national phase entry is permitted, provided that either its mandatory contents are limited to the data required to perform the acts referred to in Article 22, or that a suitable alternative means of national phase entry is also available.

CONCLUSION

22. In the view of the International Bureau, a designated Office may require an applicant to use an electronic system as the only means to effect a national phase entry provided that:

- (a) the electronic system does not require the applicant to provide more information or take more actions than the acts referred to in Article 22(1);
- (b) the system is easily usable by both resident and non-resident applicants without the need to employ a local agent; and
- (c) that safeguards are in place at least covering the case where a failure to meet the time limit for national phase entry is due to an inability to use the electronic service, equivalent to an "interruption in the mail service".

PROPOSAL

23. While the International Bureau believes that the current PCT legal framework does not prevent a designated Office from requiring an applicant to enter the national phase by use of an electronic system provided that the conditions referred to in paragraph 22, above, are met, a clarification could be made to Rule 49 to this effect, in a similar way to the provision expressly stating that an applicant could not be required to use a national form.

24. To protect applicants from missing the time limit under Article 22 or 39(1) due to the unavailability of electronic systems where no alternative is available, it is further proposed to add a new Rule extending the scope of delays and loss in the mail to cover situations where electronic communications systems are not available to meet the time limit to enter national phase.

25. The Annex contains proposed amendments to Rule 49.4 and a proposed new Rule 82.2. Whereas Rule 82.1 applies both to actions taken in the international phase and national phase entry, proposed Rule 82.2 is specific to the time limits for national phase entry, since other delays are already more completely covered by existing Rule 82*quater*. While the main thrust to propose Rule 49.4(b) is to clarify certain limitations on requiring electronic transmission of data to enter the national phase, the proposed Rule would equally apply to paper transmission. Although the latter has not been controversial in practice, it would appear more coherent to

clarify the limitations on any means of transmission, especially since current Rule 49.4 was drafted with paper submissions in mind.

FURTHER WORK

26. At present, the International Bureau provides only limited technical support for national phase entry. The WIPO Industrial Property Administration System (IPAS) provides national phase support for some national Offices. The ePCT system allows the secure sharing of international phase documents and data between the international phase agent and agents appointed for national phase purposes. Furthermore, ePCT and PATENTSCOPE offer designated Offices access to documents and data through a browser or using web services for automations. Some national Offices have used the web services to create interactive services, prefilling information in applicant forms in real time, based on data entry from the applicant.

27. The International Bureau has in the past created proof of concept services to demonstrate possibilities for assisting collaboration between attorneys in different countries and designated Offices. These have resulted in improvements to data supply and the ePCT access management arrangements but have not developed into services to assist national phase entry directly. The International Bureau is open to discussion with designated Offices of what improvements to centralized services could be useful to help them provide a high-quality service to applicants entering the national phase electronically.

28. *The Working Group is invited:*

(i) to note the study on electronic only national phase entry in paragraphs 3 to 22 of this document;

(ii) to consider the proposed amendments to the PCT Regulations discussed in paragraphs 23 to 25 and set out in the Annex to this document; and

(iii) to comment on the further work discussed in paragraphs 26 and 27 of this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS³

Rule 49 Copy, Translation and Fee under Article 22	2
49.1 to 49.3 <i>[No change]</i>	2
49.4 <i>Means of Transmittal to Perform the Acts Referred to in Article 22</i> <i>Use of National Form</i>	2
49.5 and 49.6 <i>[No change]</i>	2
Rule 82 Irregularities in the Mail Service or Electronic Means of Transmittal	3
82.1 <i>[No change]</i>	3
82.2 <i>Unavailability of Electronic Means of Transmittal</i>	3

³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 49

Copy, Translation and Fee under Article 22

49.1 to 49.3 *[No change]*

49.4 Means of Transmittal to Perform the Acts Referred to in Article 22 ~~Use of National Form~~

(a) Subject to paragraph (b), ~~No~~ applicant shall be required to use a national form when performing the acts referred to in Article 22.

(b) Any designated Office may prescribe requirements for the means of transmittal to perform the acts referred to in Article 22, provided that at least one of the means is easily usable by the applicant without the need to:

(i) have a residence or address in the State of the designated Office;

(ii) appoint an agent having the right to practice before that Office; or

(iii) provide any data beyond the minimum required to identify the international application and communicate with the applicant.

(c) Each designated Office shall notify the International Bureau of any prescribed requirements referred to in paragraph (b). The International Bureau shall publish any notification in the Gazette. Any requirements shall take effect no earlier than two months from their date of publication in the Gazette.

49.5 and 49.6 *[No change]*

Rule 82

Irregularities in the Mail Service or Electronic Means of Transmittal

82.1 *[No change]*

82.2 Unavailability of Electronic Means of Transmittal

(a) Any interested party may offer evidence that he has tried to furnish a document in order to meet the time limit of Article 22 or 39(1) by an electronic means of transmittal prescribed under Rule 49.4(b) but that the transmittal was unsuccessful due to the unavailability of that means for a significant period of time on the last day prior to the expiration of the time limit under Article 22 or 39(1) and no other means prescribed by the designated Office was available during the relevant period of time.

(b) If the attempted furnishing of a document in accordance with paragraph (a) is proven to the satisfaction of the national Office or intergovernmental organization, the time limit under Article 22 or 39(1) shall be deemed to have been met, provided that the document was furnished on the next working day on which the said electronic means of transmittal was available. No submission of proof is required if the unavailability of the electronic means of transmittal was or should have been known to the national Office or intergovernmental organization.

[End of Annex and of document]