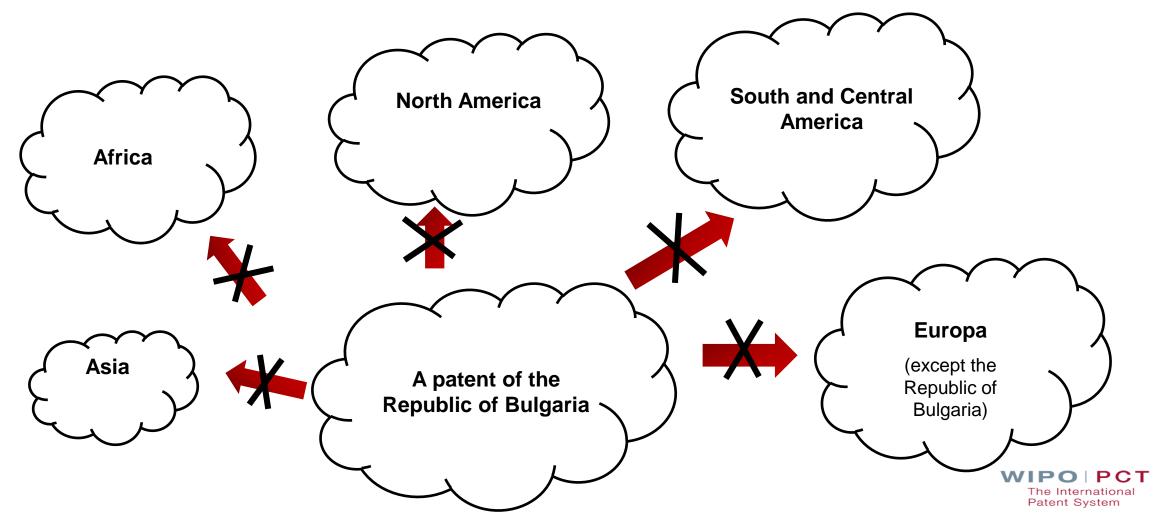


Understanding the PCT Treaty and the International Phase of PCT Applications

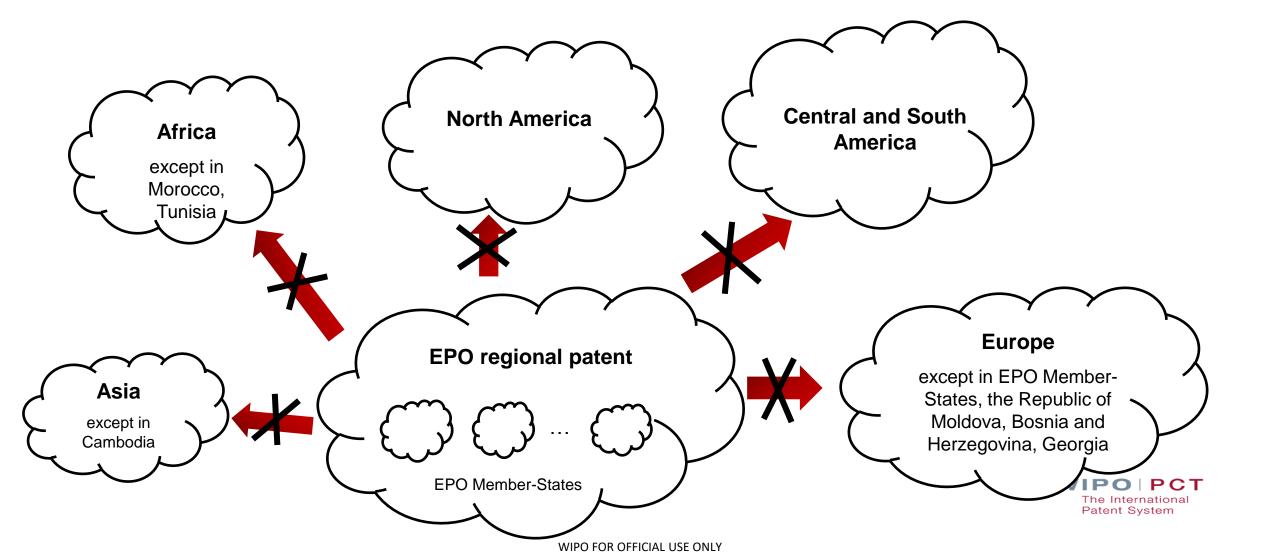
Webinar on the Patent Cooperation Treaty (PCT) Marking Bulgaria's 40th Anniversary of Membership

Olga KRYSANOVA Program Officer Online Sofia, October 21, 2024

A patent is valid in a country where it was granted



Regional patent is valid in countries member-states of the Regional Patent Office



Two popular abroad patenting systems

Traditional patenting system under the Parise Convention

PCT system under the Patent Cooperation Treaty

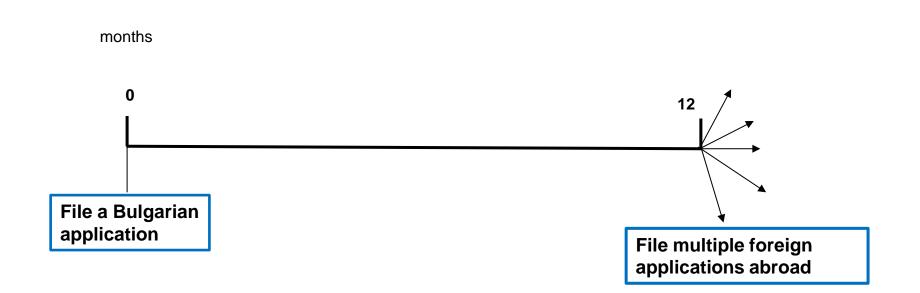
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Traditional Patenting System

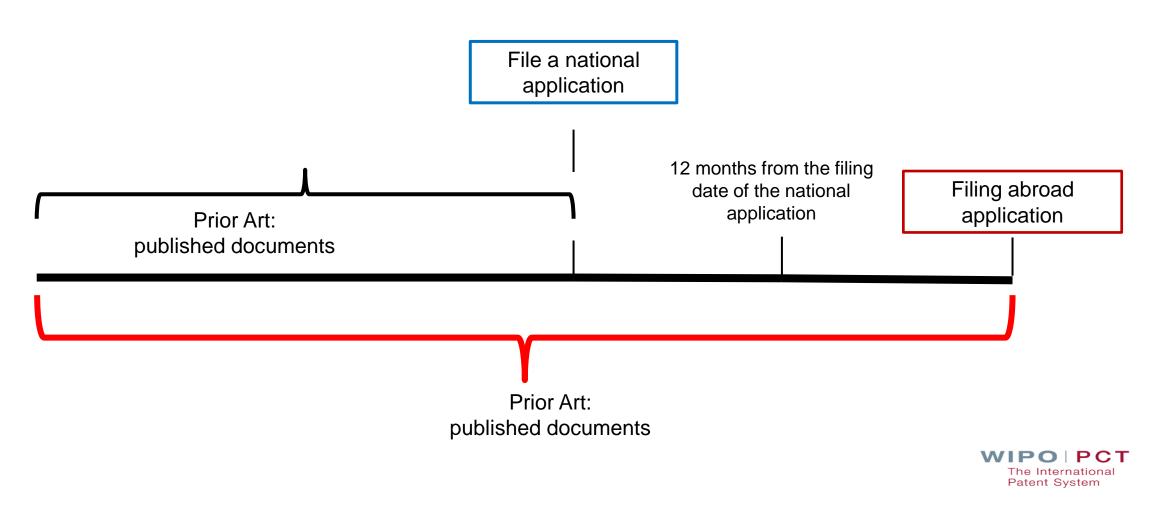


5

Traditional Patenting System (1)



Why is it important to file an application in 12 months?



Traditional Patenting System (2)

Disadvantages:

- □ No extension or restoring the 12-month limit for filing abroad applications
- □ It is necessary to prepare and file multiple applications abroad within 12 months from the filing date of the national/regional application:
 - multiple translations in languages applied in each Country
 - multiple formal requirements
 - national fees at 12 months
- Some rationalization because of regional arrangements, but regional Offices do not include all countries

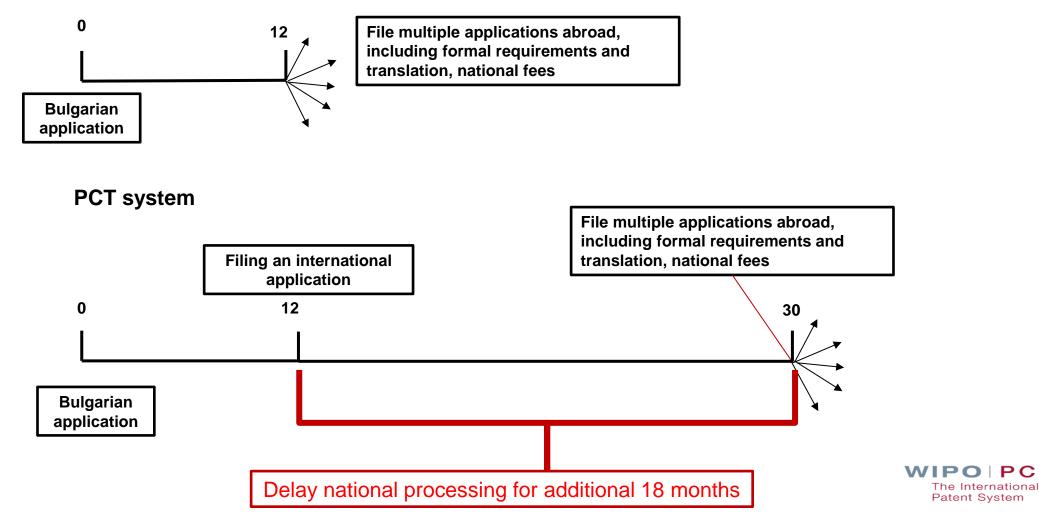
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PCT System



Traditional patent system vs. PCT system

Traditional patent system



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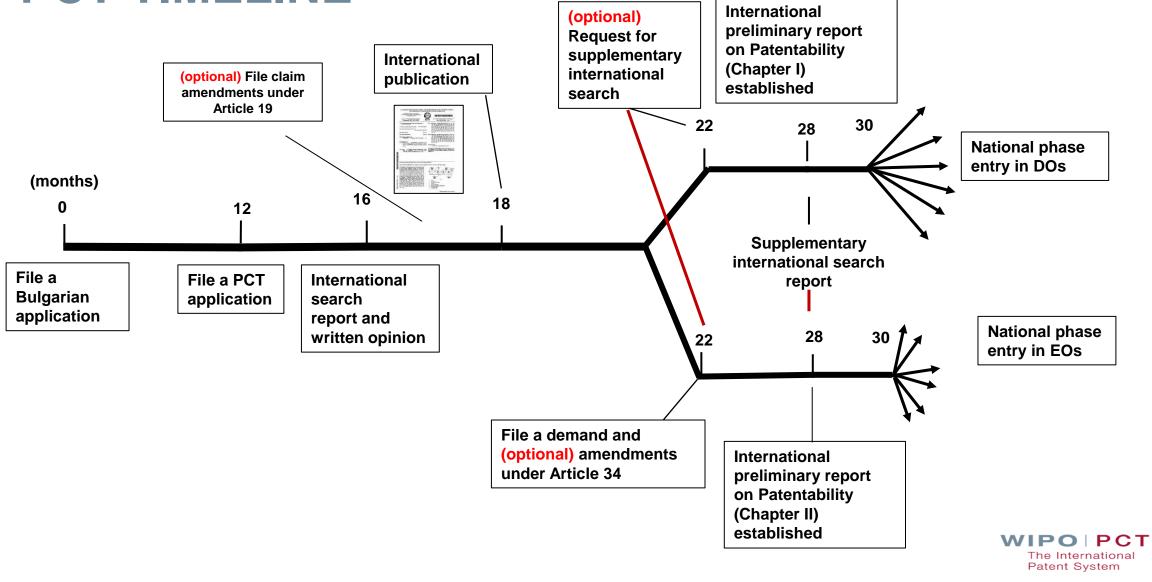
PCT

PCT system: Main stages

- The PCT system provides for:
 - **an international phase** comprising:
 - filing of the international application into **RO** (receiving Office)
 - international search and written opinion of the ISA (International Searching Authority)
 - international publication
 - (optional) supplementary international search which is provided by SISA (Supplementary International Searching Authority), and/or
 - (optional) international preliminary examination(IPE) which is provided by IPEA (International Preliminary Examining Authority)
 - **an national/regional phase at DOs/EOs** (designated/elected Offices)

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PCT TIMELINE



Advantages of the PCT System (1)

The PCT system's advantages:

- only one application filed, containing, by default, the designation of all States (for every kind of protection available) and usual priority claim(s)
- □ filed with one Office
- □ filed in **one language**
- one set of formality requirements

Advantages of the PCT System (2)

- Has the effect of a regular national filing (including establishment of a priority date) in each designated State:
 - the international filing date is the filing date in each designated State
- Delays national processing until 30 months from the priority date (please, find the information about the period for each country: <u>https://www.wipo.int/pct/en/texts/time_limits.html</u>)
 - Having the result of an international search on the international phase, an applicant can decide whether the PCT application will enter the national phase to DOs/EOs

Does an "international patent" exist?

- An "international patent" or "PCT patent" does not exist
 - patents are granted by only national or regional patent Offices
- WIPO only administers the PCT and doesn't grant patents
- Only inventions and utility models can be protected via the PCT
 - At entering the national phase, please, remember utility models are not protected in some countries

Can an international application be filed with saving the priority claim when the 12-month limit has expired? (1) (Rule 26*bis*.3)

- When 2 months, from the date of expiring the 12th month period, has not expired yet (a *total of 14 months from the priority date*), a PCT application can be filed by saving the priority claim
- An applicant needs to request a receiving Office to restore the priority right based on one of the criteria of restoration
 - **Criteria of restoration applied in the Bulgarian Patent Office:**
 - > the failure to file the international application within the priority period:
 - occurred in spite of <u>due</u> <u>care</u> required by the circumstances having been taken;
 - was <u>unintentional</u>

PCT

Patent System

Can an international application be filed with saving the priority claim when the 12-month limit has expired? (2) (Rule 26*bis*.3)

The request should:

state the reasons for the failure to file the international application within the priority period and

□ preferably be accompanied by any declarations or other evidence required

A special PCT fee for filing the request can be requested to pay

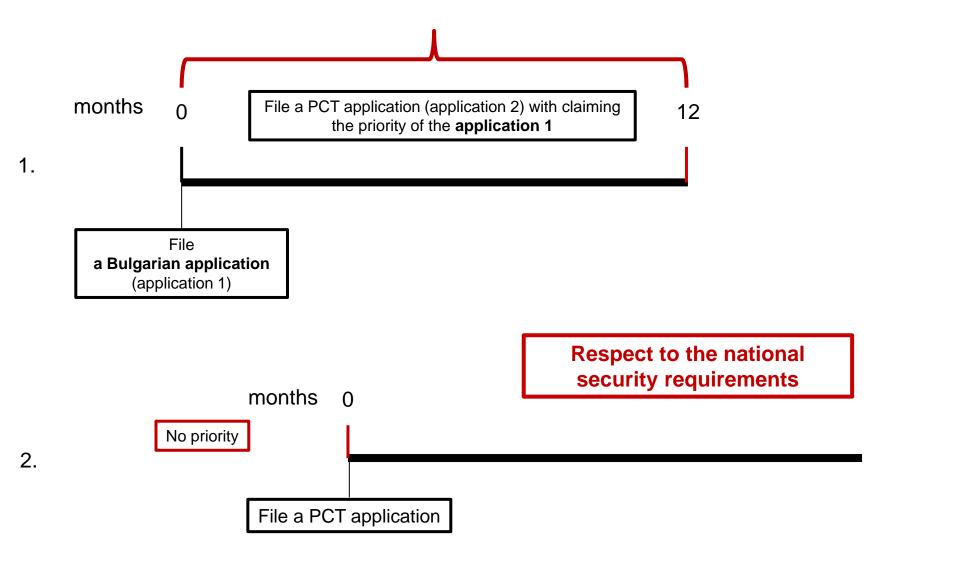
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PCT Fee for Restoration of priority rights

RO	PCT fee for restoration
RO/BG	Not applicable
RO/EP	740 EUR
RO/IB	Not applicable

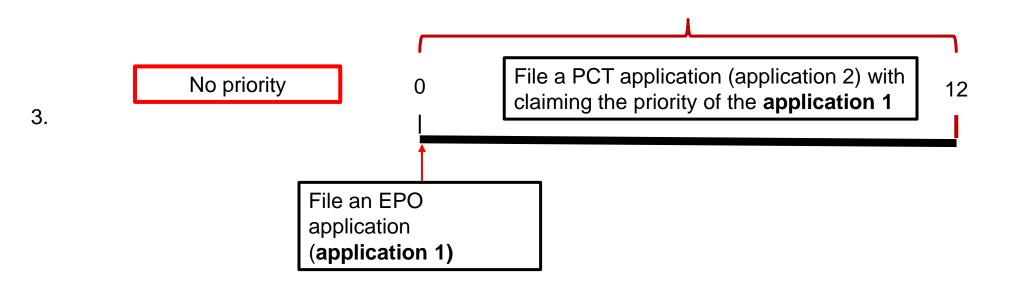
The International Patent System

Examples of filing a PCT application (1)



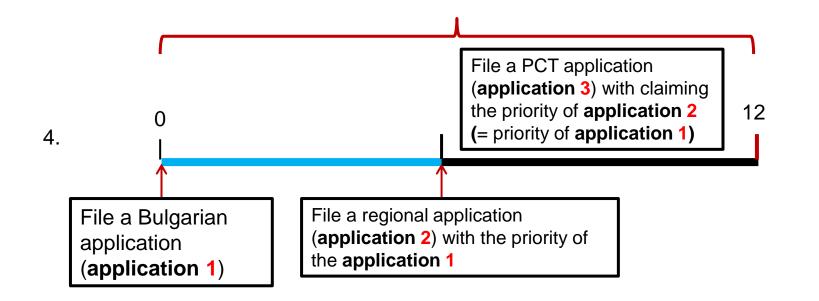
WIPO | PCT The International Patent System

Examples of filing a PCT application (2)



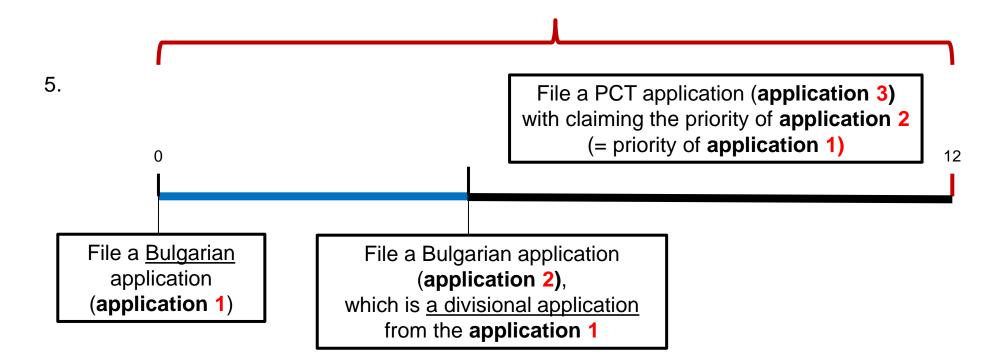
The International Patent System

Examples of filing a PCT application (3)



The International Patent System

Examples of filing a PCT application (4)



The International Patent System 22

PCT Member-States: 157 +1 (from January 2025)

=PCT

United Arab Emirates (AE) Antigua and Barbuda (AG) Albania (AL) Armenia (AM) Angola (AO) Austria (AT) Australia (AU) Azerbaijan (AZ) Bosnia and Herzegovina (BA) Barbados (BB) Belgium (BE) Burkina Faso (BF) Bulgaria (BG) Bahrain (BH) Benin (BJ) Brunei Darussalam (BN) Brazil (BR) Botswana (BW) Belarus (BY) Belize (BZ) Canada (CA Central African Republic (CF) Congo (CG) Switzerland (CH) Côte d'Ivoire (CI) Chile (CL) Cameroon (CM) China (CN) Colombia (CO) Costa Rica (CR) Cuba (CU)

Cyprus (CY) Czechia (CZ) Germany (GE) Djibouti (DJ) Denmark (DK) Dominica (DM) Dominican Republic (DO) Algeria (DZ) Ecuador (EC) Estonia (EE) Egypt (EG) Spain (ES) Finland (FI) France (FR) Gabon (GA) United Kinadom (GB) Grenada (GD) Georgia (GE) Ghana (GH) Gambia (GM) Guinea (GN) Equatorial Guinea (GQ) Greece (GR) Guatemala (GT) Guinea-Bissau (GW) Honduras (HN) Croatia (HR) Hungary (HU) Indonesia (ID) Ireland (IE) Israel (IL) India (IN)

Iran (Islamic Republic of) (IR) Iceland (IS) Italy (IT) Jordan (JO) Japan (JP) Kenya (KE) Kyrgyzstan (KG) Cambodia (KH) Comoros (KM) Saint Kitts and Nevis (KN) Democratic People's Republic of Korea (KP) Republic of Korea (KR) Kuwait (KW) Kazakhstan (KZ) Lao People's Democratic Republic (LA) Saint Lucia (LC) Liechtenstein (LI) Sri Lanka (LK) Liberia (LR) Lesotho (LS) Lithuania (LT) Luxemboura (LU) Latvia (LV) Libya (LY) Morocco (MA) Monaco (MC) Republic of Moldova (MD) Montenegro (ME)

Madagascar (MG) North Macedonia (MK) Mali (ML) Mongolia (MN) Mauritania (MR) Malta (MT) Malawi (MW) Mexico (MX) Malaysia (MY) Mozambique (MZ) Namibia (NA) Niger (NE) Nigeria (NG) Nicaragua (NI) Netherlands (Kingdom of the) (NL) Norway (NO) New Zealand (NZ) Oman (OM) Panama (PA) Peru (PE) Papua New Guinea (PG) Philippines (PH) Poland (PL) Portugal (PT) Qatar (QA) Romania (RO) Serbia (RS) Russian Federation (RU) Rwanda (RW)

Saudi Arabia (SA) Sevchelles (SC) Sudan (SD) Sweden (SE) Singapore (SG) Slovenia (SI) Slovakia (SK) Sierra Leone (SL) San Marino (SM) Senegal (SN) Sao Tome and Principe (ST) El Salvador (SV) Syrian Arab Republic (SY) Eswatini (SZ) Chad (TD) Togo (TG) Thailand (TH) Tajikistan (TJ) Turkmenistan (TM) Tunisia (TN) Türkive (TR) Trinidad and Tobago (TT) United Republic of Tanzania (TZ) Ukraine (UA) Uganda (UG) United States of America (US)

Uzbekistan (UZ) Saint Vincent and the Grenadines (VC) Viet Nam (VN) Samoa (WS) South Africa (ZA) Zambia (ZM) Zimbabwe (ZW) Jamaica (JM) Iraq (IQ) Cabo Verde (CV) Mauritius (MU) Uruguay (from 07.01.2025, not applies Chapter II)

> **WIPO | PCT** The International Patent System

PCT Regional Offices (1)

|--|

<u>(EA):</u>

- AM Armenia
- AZ Azerbaijan
- BY Belarus
- KG Kyrgyzstan
- KZ Kazakhstan
- RU Russian Federation
- TJ Tajikistan
- TM Turkmenistan



* Only regional patents

European Patent Office (EPC

<u>(EP):</u>

- AL Albania
- AT Austria
- BE Belgium*
- BG Bulgaria
- CH Switzerland
- CY Cyprus*
- CZ Czech Republic
- DE Germany
- DK Denmark
- EE Estonia
- ES Spain
- FI Finland
- FR France*
- GB United Kingdom
- GR Greece*
- HR Croatia
- HU Hungary
- IE Ireland*
- IS Iceland
- IT Italy

- LI Liechtenstein
- LT Lithuania*
- LU Luxembourg
- LV Latvia*
- MC Monaco*
- MK North Macedonia
- MT Malta*
- NL Netherlands*
- NO Norway
- PL Poland
- PT Portugal
- RO Romania
- RS Serbia
- SE Sweden
- SI Slovenia*
- SK Slovakia
- SM San Marino*
- TR Türkiye
- ME Montenegro*





PCT Regional Offices (2)

<u>AP African Regional Intellectual Property Organization</u> (ARIPO):

- BW Botswana
- GH Ghana
- GM Gambia
- KE Kenya
- LR Liberia
- LS Lesotho
- MW Malawi

- MZ Mozambique
- NA Namibia
- RW Rwanda
- SD Sudan
- SL Sierra Leone
- ST Sao Tome and Principe
- SZ Eswatini*
- TZ United Republic of Tanzania
- UG Uganda
- ZM Zambia
- ZW Zimbabwe

* only regional patents

OA African Intellectual Property Organization (OAPI)

- BF Burkina Faso*
- BJ Benin*
- CF Central African Republic*
- CG Congo*
- CI Côte d'Ivoire*
- CM Cameroon*
- GA Gabon*
- GN Guinea*
- GQ Equatorial Guinea*
- GW Guinea-Bissau*
- KM Comoros*
- ML Mali*
- MR Mauritania*
- NE Niger*
- SN Senegal*
- TD Chad*
- TG Togo*





Countries not yet PCT Contracting States (36 countries)

Afghanistan Andorra Argentina Bahamas Bangladesh Bhutan Bolivia Burundi Democratic Republic of Congo Fritrea Ethiopia Fiji Guyana Haiti

Kiribati Lebanon Maldives Marshall Islands Micronesia Myanmar Nauru Nepal Pakistan Palau Paraguay Solomon Islands Somalia South

Sudan Suriname Timor-Leste Tonga Tuvalu Vanuatu Vanuatu Venezuela Yemen **Uruguay (until January 7, 2025)**



Legal documents

Patent Cooperation Treaty (please, find

https://www.wipo.int/pct/en/texts/articles/atoc.html)

Regulations under the PCT (as in force from July 1, 2024, please, find:

https://www.wipo.int/pct/en/texts/rules/rtoc1.html)

PCT Administrative Instructions (as in force from July 1, 2024, please, find:

https://www.wipo.int/pct/en/texts/ai/ai_index.html)

Patent System

Guidelines for Authorities and Offices

PCT Receiving Office Guidelines (as in force from July 1, 2024, please, find: <u>https://www.wipo.int/pct/en/texts/ro/index.html</u>)

PCT International Search and Preliminary Examination Guidelines (as in force from July 1, 2022, please, find:

https://www.wipo.int/pct/en/texts/ispe/index.html

Documents for PCT applicants (1)

- The PCT Applicant's Guide (please, find: <u>https://www.wipo.int/pct/en/guide/</u>) consists of:
 - Introduction to the International Phase (please, find: <u>https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=pctip&doc-lang=en&doc-type=guide;</u>
 - Introduction to the National Phase (please, find: https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=pctnp&doc-

lang=en&doc-type=guide;

		G H I J	K L M	N O P Q	R S T U V	w x z			
International Phase							National	National Phase	
Two-Letter Code plus Country or Organization		Country or Information Offices		International Searching (Sup Authorities (ISA)	ISA (Supplementary Search)	International Preliminary Examining Authorities	Deposits of Biological Material	National Chapter	Code
		Annex B	Annex C	Annex D	Annex SISA	Annex E	Annex L	Annex	
AE	United Arab Emirates	×	×					×	AE
AG	Antigua and Barbuda	×	×					×	AG
AL	Albania	×	×				×	×	AL
AM	Armenia	×	×					×	AM

Documents for PCT applicants (2)

PCT Applicant's Guide (continue):

□ The list of PCT Contracting States (please, find

https://www.wipo.int/pct/en/pct_contracting_states.html)

EQE Candidates (special version of eGuide) (please, find <u>https://pctlegal.wipo.int/eGuide/eqe/documents.xhtml</u>)

Forms (please, find <u>https://www.wipo.int/pct/en/forms/index.html</u>)

Competent ROs for Bulgarian Applicants (Rule 19)

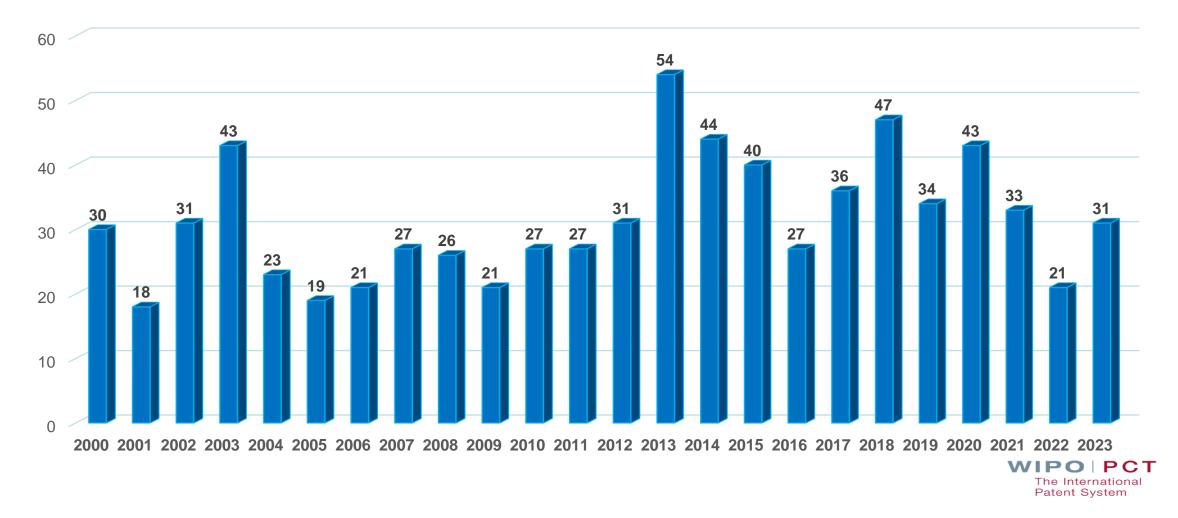
A PCT application shall be filed with a receiving Office (RO)

Competent ROs for Bulgarian Applicants:
 Patent Office of the Republic of Bulgaria
 EPO
 IB (International Bureau)

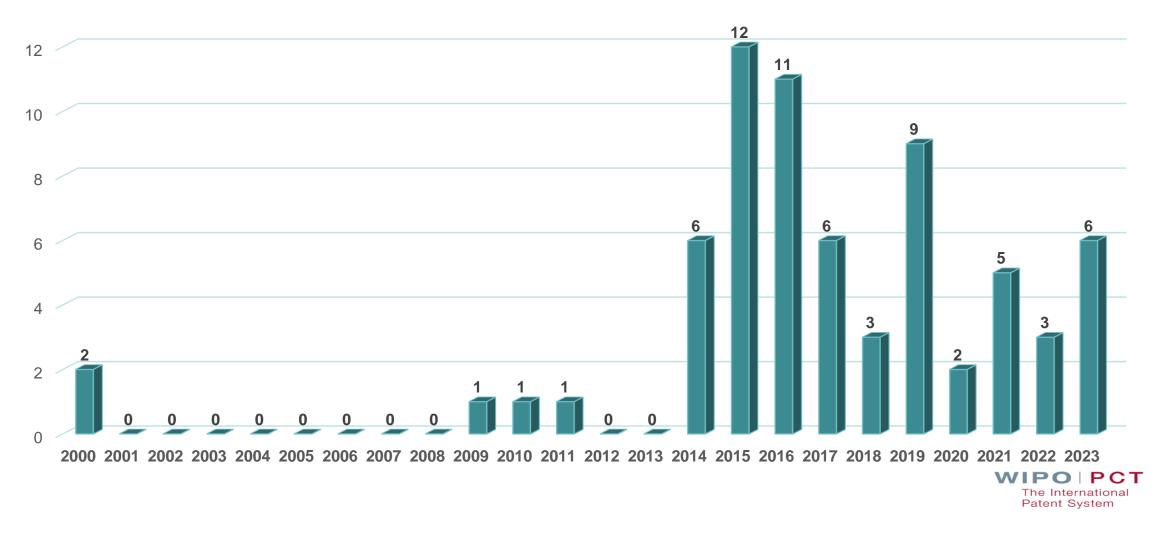
(please, find Annex C, PCT Applicant's Guide - https://www.wipo.int/pct/en/guide/)

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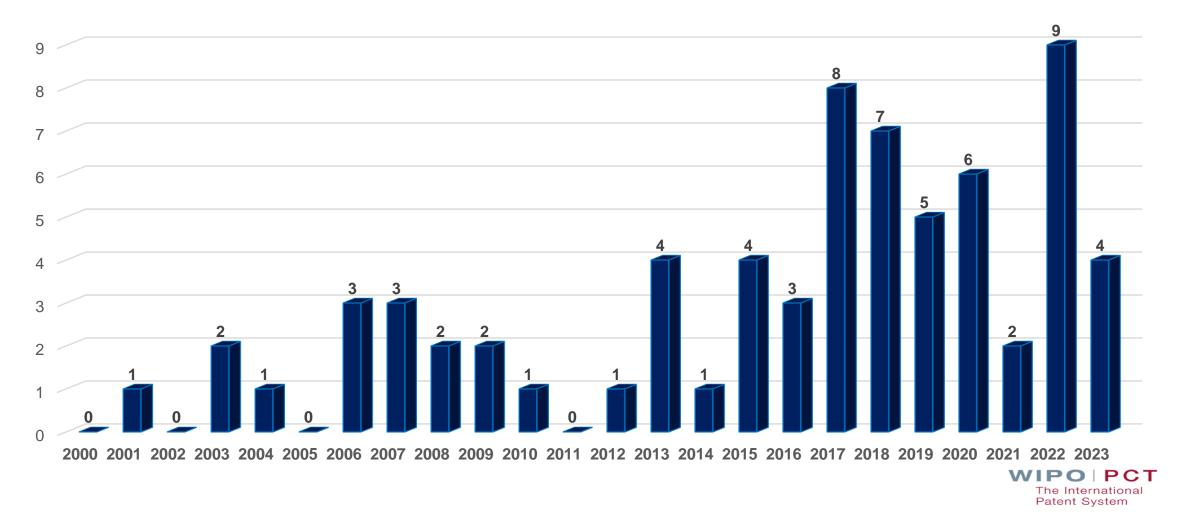
PCT Filing by Bulgarian applicants to RO/BG



PCT Filing by Bulgarian applicants to RO/EP



PCT Filing by Bulgarian applicants to RO/IB



How to choose RO?

Choosing the competent RO, an applicant can consider:

- □ filing languages
- amount of PCT fees
- choice of ISAs/IPEAs
- electronic filing
- possibility to incorporate by reference
- Criteria for restoration of the priority right and fee to be paid
 - RO/BG and IB apply both criteria for restoration
 - RO/EP applies the criterion "due care"

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Patent System

Filing languages of a PCT application (Rule 12)

- An international application should be filed in any language which the RO accepts for that purpose
 - ☐ for more details on applied languages for each RO, please, find, Annex C, PCT Applicant's Guide https://www.wipo.int/pct/en/guide/index.html

List of accepted languages in competent ROs (1)

Patent Office of Bulgaria

(please, find <u>https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=BG&doc-lang=en#RO</u>):

Language in which international applications may be filed: If the language in which the international application is filed is not accepted by the International Searching Authority (refer to Annex D), the applicant will have to furnish a translation (PCT Rule 12.3). Bulgarian, English, Russian

Language accepted for language-dependent free text in the sequence listing: Same language as the international application (Bulgarian, English or Russian)

Language in which the request may be filed:

English, Russian

EPO

(please, find https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=EP&doc-lang=en#RO):

Language in which international applications may be filed:	
English, French, German	
Language accepted for language-dependent free text in the sequence listing: English or the same language as the international application (French or German); or English and any other language	
Language in which the request may be filed:	
English, French, German	P
	The Internatio Patent System

РСТ

International

List of accepted languages in competent ROs (2)

IB: any languages

- A language in which the request may be filed: any language of publication: 10 languages which are:
 - Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish

Translation of a PCT application (1) (Rule 12)

- Where the language in which the international application is filed is not a language of publication and/or a language accepted by ISA, but this is the language accepted by RO, the applicant shall, furnish to the receiving Office a translation of the international application into any language of publication and/or one of language accepted by ISA. The language of translation should be, also, accepted by the receiving Office
 - Time period from the priority date of furnishing the translation is:
 - > 14 months for purpose of international search
 - 16 months for purpose of publication

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Translation of a PCT application (2)

Example:

A PCT application is filed in Bulgarian to the Bulgarian receiving Office

Bulgarian is not one of languages for the purposes of international publication and one of languages for searching purpose

For purpose of publication and international search, the applicant should furnish to RO the translation of the PCT application on English or Russian

What will happen with the PCT application when filed in non-accepted language?

- Where an international application is filed with RO, but that international application is not in a language accepted or the language-dependent free text contained within the sequence listing part of the description is not in a language accepted by this RO but is in a language accepted by RO/IB:
 That RO transmits to IB the PCT application
 - the applicant can be requested to pay the transmittal fee

PCT Fees paid when filing a PCT application (1) (Rules 14, 16. and 15)

Fees should be paid:

□ the international filing fee

□ the transmittal fee

□ the search fee

All these fees are paid to only RO

PCT fees paid under specific circumstances

PCT fees paid under specific circumstances:

□ Fee per sheet in excess of 30 (paragraph 1, Annex "SCHEDULE OF FEES", PCT Regulations)

□ fee for priority document

□ late payment fee (Rule 16bis.2)

List of PCT Fees

RO	Filing fee	Transmittal fee	Fee per sheet in excess of 30	Fee for priority document
Patent Office of Bulgaria	1,381 EUR	None	16 EUR	None
EPO	1,381 EUR	150 EUR	16 EUR	120 EUR (no fee: DAS)
IB	1,381 EUR	104 EUR	16 EUR	52 EUR (no fee: DAS)

How can a PCT application be filed?

- A PCT application can be filed in:
 - **Electronic form** (preferably) (Rule 89*bis*),
 - ePCT is provided by WIPO as a part of the WIPO IP Portal, please, find:

https://www3.wipo.int/authpage/signin.xhtml?goto=https://ww w.wipo.int/portal/en/index.html

Paper form

WIPO <u>doesn't receive</u> PCT applications or its documents <u>by fax</u> In case of technical problems with ePCT an applicant can use the ePCT Business Continuity Service (please, find <u>https://pctcs.wipo.int/ePCTFiling/</u>)

What is ePCT?

- The user interface is available in all PCT publication languages
 Provides secure and direct interaction with PCT applications maintained by the International Bureau
- ePCT allows applicants to do various PCT actions (communications) with the IB and other participating Offices

ePCT filing: Benefits

- Only one copy of the PCT application is filed. RO, IB, ISA, and IPEA will get access to the application in ePCT
- ePCT checks some formal requirements for the PCT application in ePCT before filing the application
- The international filing fee is reduced when the international application is filed in electronic form (paragraph 4, Annex "SCHEDULE OF FEES", PCT Applicant's Guide):
- 200 CHF: only the request form and a list of sequences are in the charactercoded format (XML) and the description, claims and abstract are in PDF format
- **300 CHF:** the whole application is in XML format

Reduction some PCT fees for applicants from some countries (1)

- The international filing fee, the supplementary search handling fee and the handling fee are reduced by 90% if the international application is filed by:
 - an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capital gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau (please, find paragraph 5(a), Annex "SCHEDULE OF FEES", PCT Applicant's Guide:

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https://www.wipo.int/pct/en/texts/rules/rtax.html#_S

Patent System

Reduction some PCT fees for applicants from some countries (2)

- The international filing fee, the supplementary search handling fee and the handling fee are reduced by 90% (continue)
 - provided that, at the time of filing of the international application, there are no beneficial owners of the international application who would not satisfy the criteria above (please, find

https://www.wipo.int/pct/en/fees/2017_fee.html)

□ if there are several applicants, each should satisfy the criteria above

Bulgaria is on the list of countries

the list of countries: <u>https://www.wipo.int/export/sites/www/pct/en/docs/fees.pdf</u>

Is the 90% reduction applied at electronic filing via ePCT?

Yes. 90% reduction is applied additionally to the reduction for electronic filing of a PCT application

Example:

The applicant who is a natural person from Bulgaria files a PCT application via ePCT, the format of the PCT application is an XML format (or DOCX for transmitting to XML): **1381** € (a filing fee) – **311** € (a reduction for electronic filing in the XML format) = **1070** \$ **1070** € – **963** € (a 90% reduction) = **107** €

Standard ST.26

- The new Standard ST.26 is applied from July 1, 2022
- The standard provides the requirements for presenting nucleotide and/or amino acid sequences in patent and PCT applications.
 - more detailed information:

https://www.wipo.int/pct/en/news/2022/news_0039.html

- WIPO Sequence Suite is a global software tool that enables patent applicants to prepare amino acid and nucleotide sequence listings compliant with WIPO Standard ST.26 as part of a national or international patent application: <u>https://www.wipo.int/standards/en/sequence/index.html</u>
- A User Manual: <u>https://www.wipo.int/export/sites/www/standards/en/pdf/wipo-sequence-manual.pdf</u>

International publication (1)

When?

promptly after 18 months from the priority date on:

- the Internet PATENTSCOPE database <u>https://patentscope.wipo.int</u>
- Official notices (PCT Gazette) are available at <u>www.wipo.int/pct/en/official_notices</u>
- Contents of published international application:
 - □ front page with bibliographic data and abstract
 - description, claims, and drawings, if any
 - International search report and a written opinion of ISA (only in PATENTSCOPE)

International publication (2)

Contents of published international application (continue):

- > where applicable:
 - amended claims (and any statement) under Article 19
 - any declaration referred to in Rule 4.17 (Rule 48.2(a)(x))
 - any relevant data concerning deposited biological material furnished under Rule 13*bis* (Rule 48.2(a)(viii))
 - information regarding requests for restoration of the right of priority (Rule 48.2(a)(xi))
 - statement concerning authorized requests for rectification of obvious mistakes received after publication (Rule 48.2(i))
 - information about a priority claim considered not to have been made (Rule 26bis.2(d))

International publication (3) (Article 21 and Rule 48)

Upon applicant's request:

information about the applicant's wish to correct or add a priority claim after the expiration of the time limit under Rule 26bis.1(a) (Rule 26bis.2(e))

□ refused a request for rectification of an obvious mistake (Rule 91.3(d))

Early publication is upon express request by the applicant
A special fee is required (Article 21(2)(b) and Rule 48.4(a)):

Fees = 200 CHF

✓ If an international search report is available, no fee is required

Handling changes and corrections

Changes and corrections of the PCT application can be done:

- **by the applicant**
 - international phase
 - national phase
- upon the invitation from RO, ISA, IPEA, IB
- Changes and corrections are:
 - correction of defects relating to the filing of the application
 - □ recording of changes under Rule 92*bis*
 - □ amendments:
 - under Article 19 (only claims; filing in 2 months from the date of transmittal of the international search report to IB and the applicant by ISA or <u>16 months</u> from the priority date, whichever time limit expires later)
 - under Article 34 (description, claims, drawings; filing simultaneously with a demand or separately before the examiner starts the report under Chapter II)

Correction of defects relating to the filing of the PCT application (1)

- Office not competent because of the applicant's nationality or residence (Article 11(1)(i), Rule 19.4(a)(i))
- International application filed in a language not accepted by the receiving Office (Rule 19.4(a)(ii))
- Errors in the indication of the applicant's nationality and/or residence (Section 329 of the Administrative Instructions)
- Non-admitted language for the request, abstract, text matter in drawings (Rule 26.3ter)
- Incomplete, erroneous or missing priority claim (Rule 26bis)
- Correction/addition of any indications referred to in Rule 4.11 (Rule 26quater)

Correction of defects relating to the filing of the application (2)

- Unpaid or not fully paid fees (Rule 16bis)
- Missing signature in the request (Rule 4.15)
- Incomplete, erroneous or missing declarations under Rule 4.17 (Rule 26ter)
- Formal defects (Rules 11 and 26)
- Missing title of the invention (Rule 37)
- Missing abstract (Rule 38)
- Obvious mistakes (Rule 91)

International Search and International Preliminary Examination. General information

- The competent ISA(s) and IPEA(s) are specified by the RO. The applicant's choice is limited by the list of ISAs and IPEAs specified by RO where the PCT application is filed
- The applicant should specify ISA in the request form PCT/RO/101 (Box No. VII)
 The objective of the international search is to discover a relevant prior art and receive an opinion on the patentability of the invention
 - it can help an applicant evaluate the reasonableness of entering the national phase
- One of the objectives of the international preliminary examination is to receive a positive opinion on the patentability of the invention in additionally to the ISA's written opinion

Recommendations for choosing ISAs/IPEAs

The applicant can consider:

□ language(s) accepted by the ISA/IPEA

translation of application can be required for the purpose of the international search

amount of the search fee/ the examination fee

 more detailed information about the search fees for each ISA can be found in Annex D and Annex E, the PCT Applicant's Guide (<u>https://www.wipo.int/pct/en/guide/</u>) and the PCT Fee Tables (<u>https://www.wipo.int/export/sites/www/pct/en/docs/fees.pdf</u>)

Competent ISAs and IPEAs for Bulgarian Applicants

Competent International Searching Authority: EP, <u>RU</u>
Competent International Preliminary Examining Authority: <u>RU</u> <u>EP</u> The Office is competent only if the international search is or has been carried out by that Office.

*Please, find Annex C, the PCT applicant's Guide – <u>https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=BG&doc-lang=en#RO</u>

PCT Fees: ISA/EP

es payable to the ISA:	
arch fee (PCT Rule 16): This fee is payable to the receiving Office in the currency or one of the currencies accepted by it. The fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person a State classified by the World Bank as low-income or lower-middle-income economy. For the list of States to which this reduction applies, refer to: <u>https://www.epo.org/applying/fees/international-fees/information.html</u> .	
This fee is also reduced by 75% where the applicant, or if there are two or more applicants, each applicant is a natural or legal person who, within the meaning of Rule 18 of the Patent Cooperation Treaty, is a national or a validation agreement with the European Patent Organisation is in force. For further information refer to the decision of the EPO's Administrative Council of 12 December 2019 (OJ EPO 2020, A4): https://www.epo.org/law-practice/legal-texts/official-journal/2020/01/a4.html and OJ EPO 2021, A58.	of and resident in a state in which
	1,751 CHF
	13,750 DKK
	1.845 EUR
	1,570 GBP
	715,100 HUF
	274,600 ISK
	297,100 JPY
ay under special circumstances	20,880 NOK
	3,253 NZD
	20,750 SEK
	2,675 SGD 1,989 USD
	37,470 ZAR
	57,470 244
ditional search fee (PCT Rule 40.2): This fee is payable to the International Searching Authority and only in particular circumstances.	
	1,845 EUR
Iditional search fee in relation to PCT Rule 20.5 <i>bis</i> (PCT Rule 40 <i>bis</i>): For further information, refer to the "Notice from the European Patent Office dated 14 June 2020 concerning the applicability of new Rule 20.5 <i>bis</i> PCT on the correction of erroneous filings in proceedings before the Official Notices (PCT Gazette) dated 30 April 2020, page 83.	EPO" (OJ EPO 2020, A81) and the
This fee is payable to the International Searching Authority and only in particular circumstances.	1.945 5110
	1,845 EUR
otest fee (PCT Rule 40.2(e)): The applicable procedure since 1 July 2010 is as set out in OJ EPO 5/2010, page 322.	
The applicable procedure since F july 2010 is as set out III OJ EFO 3/2010, page 322.	1,020 EUR
	1,020 2014
te furnishing fee (PCT Rule 13 <i>ter</i> .1(c)):	265 EUR

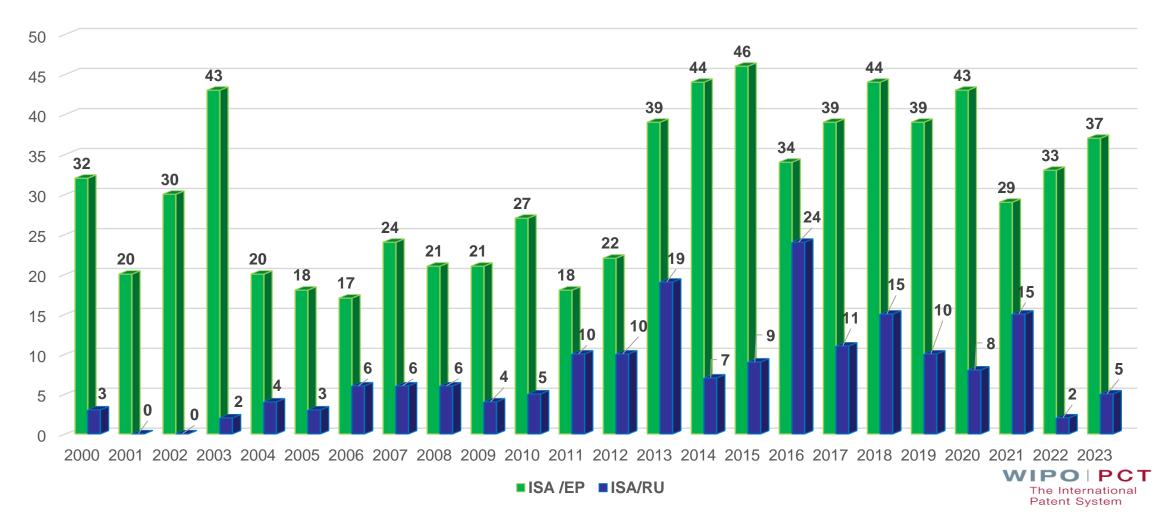
Please, find Annex C, the PCT applicant's Guide: <u>https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=EP&doc-lang=en#ISA</u>

PCT Fees: ISA/RU

Fees payable to the ISA:		
Search fee (PCT Rule 16): This fee is payable to the receiving Office in the currency or one of the currencies accepted by it.		
— This fee applies to searches carried out in Russian		
	83 CHF	
	86 EUR	
	8,500 RUB	
	94 USD	
- This fee applies to searches carried out in English	391 CHF	
	406 EUR	
Pay under special circumstances	40,000 RUB	
	441 USD	
This fee is payable to the International Searching Authority and only in particular circumstances. For further details, refer to"How can payment of fees be effected" at https://www1.fips.ru/wps/wcm/connect/content_en/e — This fee applies to searches carried out in Russian	8.500 RUB	
	8,500 RUB	
— This fee applies to searches carried out in English	40,000 RUB	
	40,000 KOB	
Fee for copies of documents cited in the international search report (PCT Rule 44.3): This fee is payable to the Authority. For further details, refer to <u>http://new.fips.ru/vse-uslugi/uslugi-predostavlyaemye-fips-na-platnoy-osnovephp</u> (paragraph 14.6) and <u>http://new.fips.ru/vse-uslugi/rekvizity-fips-dlya-o</u> na-platnoy-osnove.php.	<u>platy-uslug-fips-okazyvaemykh-</u>	
— for a patent document		
	per page 24 RUB	
— for a non-patent document	per page 60 RUB	
- for a non-patent document Please, find Annex C, the Applicant's Guide, https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=RU&doc-lang=en#ISA	per page 60 RUB	

WIPO FOR OFFICIAL USE ONLY

ISAs selected by Bulgarian applicants



WIPO FOR OFFICIAL USE ONLY

Cases where <u>no</u> international search report and a report on patentability under Chapter II will be carried out (Rules 39.1 and 67.1) (1)

- The application relates to a subject matter which the ISA is not required to search (Article 17(2)(a)(i) and Rule 39.1):
 - (i) scientific and mathematical theories,
 - (ii) plant or animal varieties or essentially biological processes for the production of plants and animals, other than microbiological processes and the products of such processes,
 - (iii) schemes, rules or methods of doing business, performing purely mental acts or playing games,
 - (iv) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (EPO does not carry out the report on this subject matter, but the Rospatent carries out the report on this subject matter)
 - (v) mere presentations of information,
 - (vi) computer programs to the extent that the International Searching Authority is not equipped to search prior art concerning such programs

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Cases where <u>no</u> international search report and a report on patentability under Chapter II will be carried out (Articles 17.1(II) and 34.4(a)(ii)) (2)

The description, claims or drawings do not comply with the prescribed requirements to such an extent that a meaningful search cannot be carried out in respect of any of the claims



Cases where <u>no</u> international search report and a report on patentability under Chapter II will be carried out (Rule 13*ter*) (3)

- The application contains the disclosure of a nucleotide and/or amino acid sequence, but:
 - no listing of that sequence is furnished
 - the listing furnished does not comply with the Standard set out in Annex C of the Administrative Instructions or is not in electronic form, or
 - ❑ the fee for late furnishing of the sequence listing has not been paid within the applicable time limit (Rule 13ter.1(d))
 - ISA will conduct a limited international search without the sequence listing
 - in some cases, it is not possible to carry out the search report

Consequences of lack of an international search report (Rules 48.2(a)(v) and 66.1(e))

Consequences:

- the ISA will declare that no international search report has been established and that declaration will be published as part of the published international application
- □ the application remains valid but
 - the IPEA will not be obliged to carry out the international preliminary examination for lack of the international search report

International Preliminary Examination

- International Preliminary Examination is <u>an optional procedure</u> that provides for continued examination of the PCT application before an International Preliminary Examining Authority (IPEA)
- The International Preliminary examination under Chapter II of the PCT starts <u>only</u> on a demand filed by the applicant
- Filing a demand constitutes the automatic "election" of all designated PCT Contracting States
- Choice of IPEA should be indicated in the demand
 - EPO provide the examination only when this Office has carried out the international search(please, find

https://www.wipo.int/export/sites/www/pct/guide/en/gdvol1/annexes/annexe/ax_e _ep.pdf)

Time limits for making a demand (Rule 54bis.1)

- A demand may be made at any time prior to the expiration of whichever of the following periods expires later:
 - □ 3 months from the date of transmittal to the applicant of the international search report or the declaration referred to in Article 17(2)(a), and of the written opinion established under Rule 43*bis*.1; or
 - **22 months** from the priority date



Why file a demand?

- Provide an opportunity to postpone the national phase
- Provide an opportunity during the international preliminary examination to make some amendments to the description, claims and drawings
- Submit arguments to address patentability objections raised by the ISA
- International preliminary examination is the final opportunity to obtain a more positive patentability assessment during the international phase
 - likelihood of more favorable treatment in the national phase based on a positive patentability report

РСТ

Patent System

Who is entitled to make a demand? (Article 31(2)(a) and Rule 54.2)

- The applicant, or if there are two or more applicants, at least one of them:
 - □ who is a resident or national of a PCT Contracting State, and
 - whose international application has been filed with a receiving Office of or acting for a Contracting State (currently all States)

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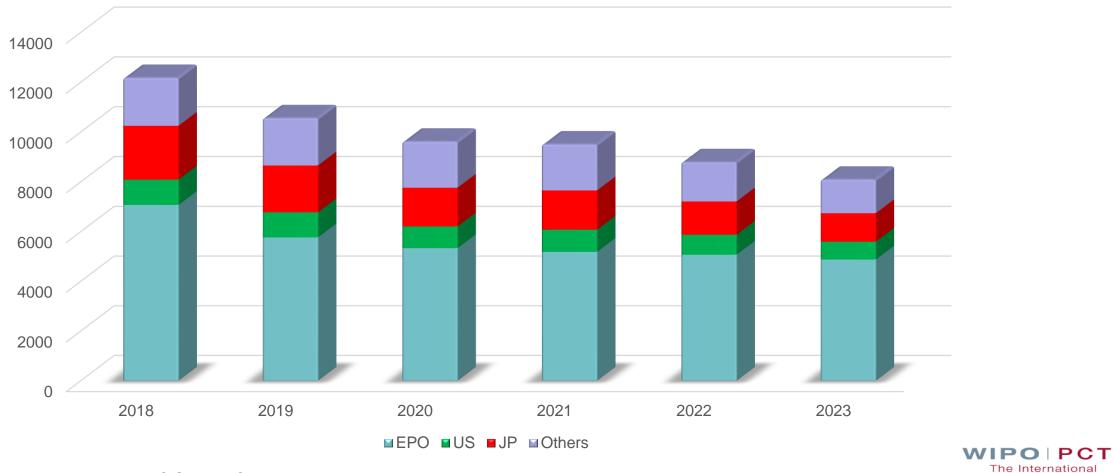
Preliminary examination fees: IPEA/EP

Fees payable to the IPEA:	
Preliminary examination fee (PCT Rule 58):	
This fee is payable to the International Preliminary Examining Authority.	
This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State classified by the World Bank as low-income or lower-middle-income econom list of States to which this reduction applies, refer to: <u>https://www.epo.org/applying/fees/international-fees/information.html</u> .	ny. For the
This fee is also reduced by 75% where the applicant, or if there are two or more applicants, each applicant is a natural or legal person who, within the meaning of Rule 18 of the Patent Cooperation Treaty, is a national of and resident in a stat a validation agreement with the European Patent Organisation is in force. For further information refer to the decision of the EPO's Administrative Council of 12 December 2019 (OJ EPO 2020, A4): https://www.epo.org/law-practice/legal-texts/official-journal/2020/01/a4.html.	te in which
The late payment fee, equal to 50% of the amount of the unpaid fees, is payable to the International Preliminary Examining Authority. Refer to OJ EPO 5/1998, page 282.	
	1,915 EUR
Additional evolution for (DCT Dule 60 2)	
Additional preliminary examination fee (PCT Rule 68.3): This fee is payable to the International Preliminary Examining Authority and only in particular circumstances.	
	1.915 EUR
	.,
Handling fee (PCT Rule 57.1):	
The late payment fee, equal to 50% of the amount of the unpaid fees, is payable to the International Preliminary Examining Authority. Refer to OJ EPO 5/1998, page 282.	
This fee is payable to the International Preliminary Examining Authority. It is reduced by 90% if certain conditions apply (refer to Annex C(IB)).	
	208 EUR
Protest fee (PCT Rule 68.3(e)):	
	1,020 EUR
Late furniching fee (PCT Pule 12ter 2)	
Late furnishing fee (PCT Rule 13 <i>ter</i> .2):	265 EUR
	200 200

Preliminary examination fees: IPEA/RU

Preliminary examination fee (PCT Rule 58): This fee is payable to the International Preliminary Examining Authority. For further details, refer to "How can payment of fees be effected" at: <u>http://www1.fips.ru/wps/wcm/connect/content_en/en/inter/</u> .	
— examination carried out in:	Russian 6,750 RUB English 24,000 RUB
Where the international search report was prepared by the Federal Service for Intellectual Property (Rospatent) (Russian Federation)	
— examination carried out in:	Russian 4,500 RUB
	English 16,000 RUB
Additional preliminary examination fee (PCT Rule 68.3): This fee is payable to the International Preliminary Examining Authority and only in particular circumstances. For further details, refer to "How can payment of fees be effected" at: http://www1.fips.ru/wps/wcm/connect/content_en/en/inter/.	
— examination carried out in:	Russian 6,000 RUB
	English 23,500 RUB
Where the international search report was prepared by the Federal Service for Intellectual Property (Rospatent) (Russian Federation)	
— examination carried out in:	Russian 5,000 RUB
	English 19,500 RUB
Handling fee (PCT Rule 57.1): This fee is payable to the International Preliminary Examining Authority. It is reduced by 90% if certain conditions apply (refer to Annex C(IB)). For further details, refer to "How can payment of fees be effected" at: <u>http://www1.fips.ru/wps/wcm/connect/content_en/en/inter/</u> .	219 USD
Fee for copies of documents cited in the international preliminary examination report (PCT Rule 71.2): This fee is payable to the Authority. For further details, refer to http://new.fips.ru/vse-uslugi/rekvizity-fips-dlya-oplaty-uslug-fips-okazyvaemykh-na-platnoy-osnove.php	219 030
— for a patent document	per page 24 RUB
— for a non-patent document	per page 24 Kob
	per page 60 RUB
How to obtain copies: The applicant receives, together with the international preliminary examination report a copy of each document containing non-patent literature not cited in the international search report, free of charge Applicants and elected Offices can request copies by e-mail at: pct-peo@rupto.ru	
Fee for copies of documents contained in the file of the international application (PCT Rule 94.2):	
This fee is payable to the Authority. For further details, refer to http://new.fips.ru/vse-uslugi/uslugi-predostavlyaemye-fips-na-platnoy-osnovephp (paragraph 14.6) and http://new.fips.ru/vse-uslugi/rekvizity-fips-dlya-oplaty-uslug-fips-okazyvaemykh-na-platnoy-osnove.php.	per page 96 RUB
Protest fee (PCT Rule 68.3(e)): This fee is payable to the International Preliminary Examining Authority and only in particular circumstances. For further details, refer to "How can payment of fees be effected" at: http://www1.fips.ru/wps/wcm/connect/content_en/en/inter/.	
This tee is payable to the international relations of continuing Additions and only in particular circumstances, ron torther details, refer to now can payment or rees be energed as a <u>http://wwwi.ips.to/wps/wdit/contec</u>	3,500 RUB
	e International
	tent System

Filing demands for international preliminary examination from 2018 to 2023*



*According to the WIPO Statistic Center: https://www3.wipo.int/ipstats/pmh-search/pct The International

Patent System

Supplementary International Search. Main Features

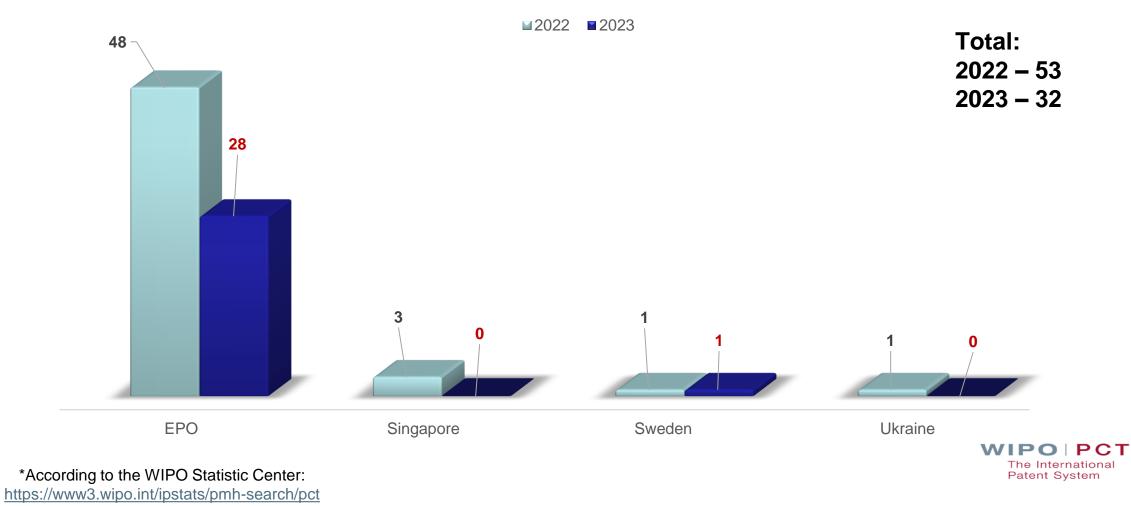
- An optional service for applicants
 - it is currently offered by:

Austria, EPO, Finland, Russian Federation, Sweden, Singapore, Türkiye, Ukraine, Nordic Patent Institute and Visegrad Patent Institute

- An applicant can request the supplementary search by any Authority offering this service, except the one responsible for the main international search
- Each Authority determines the scope and fees for its supplementary search
- Supplementary international search (SIS) covers only one invention or group of inventions
 - □ there is no option for paying additional fees

Patent System

Dynamics of filing requests for additional international search in 2022 and 2023*



Entry into the National Phase (1)

When?

□ at the end of 30 months (or 31 months)

- under Chapter I?
- under Chapter II?
- early entry

Time limit under Art. 22(1) (Chapter I) and Art. 39(1)(a) (Chapter II): 30 months from the priority date (please, find Annex "National Chapter", the PCT Applicant's Guide, or table of time limits on <u>https://www.wipo.int/pct/en/texts/time_limits.html</u>)

for exceptions for some countries, please, find <u>www.wipo.int/pct/en/texts/reservations/res_incomp.html</u>

Entry into the National Phase (2)

Where?

- National Offices
- Regional Offices

For more detailed information about the time limit, please, find https://www.wipo.int/pct/en/texts/time_limits.html



Time limit for entry in the national phase

- The time limit applies irrespective of possible delays in the international phase due to:
 - □ late international search report and written opinion of the ISA
 - international preliminary examination delayed
 - □ late international preliminary report on patentability (Chapter II)
 - Iate translation of an international preliminary report on patentability (Chapter II)

General national requirements Art. 22(1) and 39(1)(a), Rule 51 bis

Requirements:

□ translation, if applicable

- payment of national fee
- copy of the international application in particular circumstances
- No legalized or certified translation of the international application: a simple translation is required

- □ A few Offices require a "verified" translation
 - Australia (under request), India, Cambodia, Costa-Rica (under request), Cuba, Malawi (under request), New Zealand, Singapore, and South Africa (please, find Annex "National Chapter", the PCT Applicant's Guide,)

Recommendations for entering the national phase (1)

- Leave sufficient time, where necessary, to prepare the translation of the international application
- Send to your local agent copies of the (relevant) documents on file:
 - □ the published international application,
 - □ the international search report,
 - written opinion by the ISA,
 - the international preliminary examination report when the examination was demanded,
 - priority documents;
 - note that none of these documents are required to be filed by the local agent at the local patent office

Recommendations for entering the national phase (2)

- Where you would prefer to avoid paying additional claims fees or other fees that are applicable under any particular national law, prepare the application, and any amendments thereof, according to the national practice
- Even though several DOs/EOs provide for longer time limits, it is preferable to docket the 30-month time limits for all Offices



Licensing availability (1)

Applicants interested in concluding license agreements in relation to their international application may request the International Bureau to make this information available in PATENTSCOPE:

How?

- Applicants should submit a "Licensing Availability Request" to the IB using an ePCT "Action"
 - > alternatively, Form **PCT/IB/382**
- **When**?
 - At the time of filing or within 30 months from the priority date
- **Free of charge**
- Applicants can file multiple licensing requests or update previously submitted ones (within 30 months from the priority date)
- Please, find more details in paragraphs 11.102 11.108 of the PCT Applicant's Guide: <u>https://pctlegal.wipo.int/eGuide/view-doc.xhtml?doc-code=pctip&doc-lang=en&doc-type=guide</u>

The International Patent System

Licensing availability (2)

- Licensing indications will be made publicly available after international publication of the application
 - □ The licensing indications will be visible on PATENTSCOPE under the "Bibliographic data" tab with a link to the submitted licensing request itself
 - International applications containing licensing information can be searched in PATENTSCOPE
 - The licensing indication displayed under the "Bibliographic data" tab may be revoked by the applicant at any time, that is, also after 30 months from the priority date

Patent System

PCT Success Stories

WIPO | PCT

PCT – The International Patent System

Statement of Provisions Potentially Applicable to WIPO Global IP Services Regarding Ukraine and the Russian Federation

The Patent Cooperation Treaty (PCT) assists applicants in seeking patent protection internationally for their inventions, helps patent offices with their patent granting decisions, and facilitates public access to a wealth of technical information relating to those inventions.

By filing one international patent application under the PCT, applicants can simultaneously seek protection for an invention in a large number of countries.

Biotechnology Practice Area Update: Are You Ready for WIPO Standard ST.26?

Do you have a PCT success story you would like to share?



The PCT: Seeking Patent Protection Beyond Borders

Submit a Success Story:

https://cswipo.formstack.com/forms/ pct_success_story_en

Structural and electrical system for vertical axis wind turbine

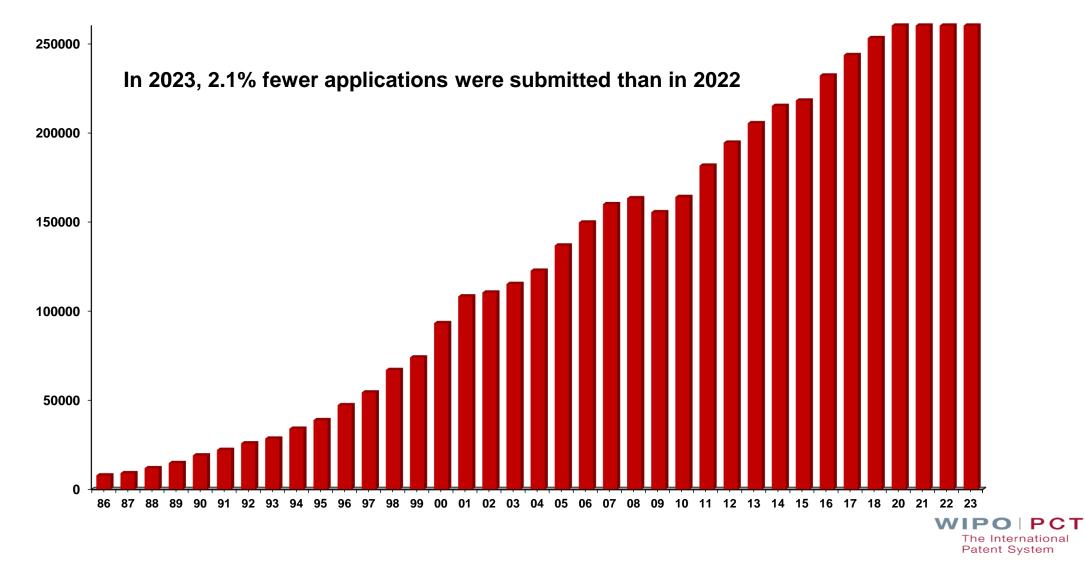
"What makes PCT attractive to me is the time you gain for finding interested parties for your invention. The PCT timeframes were useful for trying to find stakeholders and convincing them of the benefits of investing in an invention based on the representation contained in the PCT application....."

Enhancing driving enthusiasm by steering wheel haptics

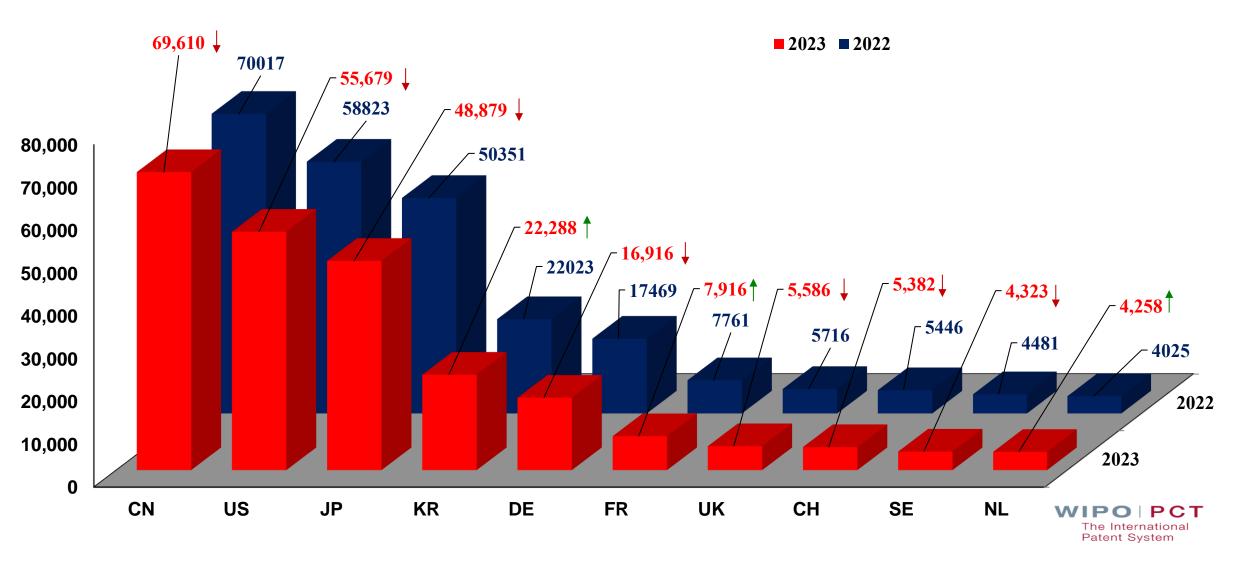
"For an independent inventor like me, going through the PCT route has been very helpful. The first and most helpful part of PCT is the extended timelines for filing patents in different countries....."



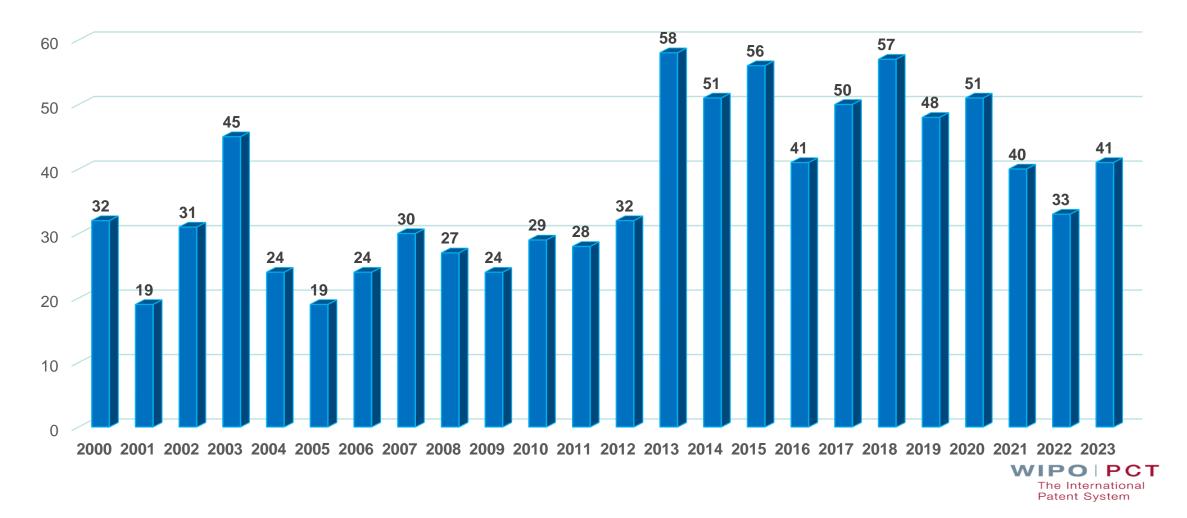
PCT filing



PCT application by countries in 2023 and 2022



PCT Filing by Bulgarian applicants



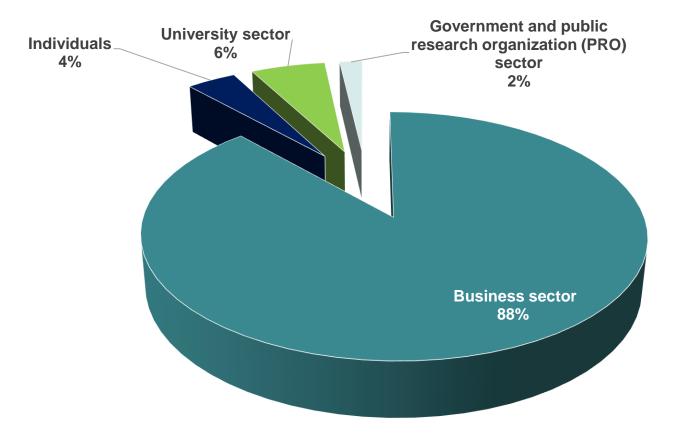
Top PCT applications by technologies in 2023

Technical field	Number of applications
Computer technology	27 276 †
Digital communication	25 124 ↑
Electrical machinery, apparatus, energy	21 059 ↑
Medical technology	17 868 ↓
Pharmaceuticals	12 425 †
Measurements	11 827 🕇
Transport	10 863 ↓
Biotechnology	9 690 ↓

Top PCT applicants in 2023

N	Companies	Number of PCT filed applications
1	Huawei Technologies (China)	6 494 🕇
2	Samsung Electronics Co., LTD (Republic of Korea)	3 924 ↑
3	Qualcomm Incorporated (USA)	3 410 ↓
4	Mitsubishi Electric Corporation (Japan)	2 152 ↑
5	BOE Technology Group Co., Ltd (China)	1 988 🕇
6	LG Electronics Inc. (Republic of Korea)	1 887 🛉
7	Telefonaktiebolaget LM Erricsson (Sweeden)	1 863 🛉
8	Contemporary Amperex Technology Co., Limited (China)	1 799 \downarrow
9	Guang Dong Oppo Mobile Telecommunications Corp., Ltd (China)	1 793 \downarrow
10	NIPPON TELEGRAPH AND TELEPHONE CORPORATION (Japan)	1 760 [†]

Distribution of PCT applications by field of activity among applicants for 2023



The International Patent System

Where to get help (1)

- The PCT information available on the Internet: <u>https://www.wipo.int/pct/en/</u>
- The webpage for new users: <u>https://www.wipo.int/pct/en/users/index.html</u>
- Frequently Asked Questions: <u>https://www.wipo.int/pct/en/faqs/index.html</u>
- Training Videos Series on "How to file your International Application": <u>https://www.wipo.int/pct/en/training/index.html</u>
- ePCT Video Tutorials for Applicants: <u>https://www.wipo.int/pct/en/epct/tutorials.html</u>
- PCT webinars: <u>https://www.wipo.int/pct/en/seminar/webinars/index.html</u>

Where to get help (2)

PCT Infoline (general questions about the PCT): Telephone: +41 22 338 83 38 e-mail: pct.infoline@wipo.int

RO/IB Telephone: +41 22 338 92 22 e-mail: ro.ib@wipo.int

PCT eServices Help Desk: Telephone: +41 22 338 95 23 Internet address: www.wipo.int e-mail: pct.eservices@wipo.int

Search for contact details of the team in charge of your PCT application https://pct.wipo.int/ePCTExternal/pages/TeamLookup.xhtml

Thank you for your attention!

