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Chapter 22

Patent Cooperation Treaty (PCT)

22.01 **General description of the PCT**

The PCT is a multilateral treaty among States, concluded in 1970 and entered into force on January 24, 1978. Canada became bound by the PCT on January 2, 1990.

The PCT establishes a system of international cooperation under which an applicant can initiate patent protection procedures in several countries by filing **one** "international application". The PCT is a patent filing procedure only and does not provide for the granting of patents. The granting of patents is the responsibility of each individual member countries (Contracting States).

Under PCT, Canadians seeking patent protection in several countries can file an international application, in a standardized format in either French or English, in the Patent Office. Filing an international application has the same effect as if a regular national application was filed in each member countries where the applicant desires patent protection.

As of January 1st, 2004, PCT had 123 Contracting States.

A list of the Contracting States is available from the World Intellectual Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct/guide/en/>

Further useful material is contained in the Treaty itself, in the PCT Applicant's Guide, in the PCT Receiving Office Guidelines, PCT Search Guidelines and PCT Preliminary Examination Guidelines, and in the Administrative Instructions. The PCT Applicant's Guide may be consulted in the CIPO library. All these publications are available from the World Intellectual Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct/en/index.html>

The PCT Applicant's Guide can be found under "PCT Filing (Forms, Fees, etc.)". The PCT Treaty, Regulations, Administrative Instructions, PCT Receiving Office Guidelines, PCT International Search Guidelines and PCT International Preliminary Examination Guidelines can be found under "PCT Legal Texts".

22.01.01 PCT definitions

The following terms frequently used in the PCT text are defined as follows:

- a) **Receiving Office** means the office where the nationals or residents of a PCT contracting state can file international applications. For Canadian nationals, applications may be filed with the Patent Office or the International Bureau;
- b) **International Bureau (IB)** means the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva;
- c) **Contracting States** means the states party to the PCT which include almost every industrialized country of the world;
- d) **Designated Office** means the national office designated by an applicant under Chapter I;
- e) **Elected Office** means the national office elected by an applicant under Chapter II;
- f) **International Searching Authority (ISA)** means one of the offices responsible for establishing International Search Reports (ISR) and the first written opinion on patentability by the ISA; and
- g) **International Preliminary Examining Authority (IPEA)** means the office that carries out the international preliminary examination and the preparation of International Preliminary Reports on Patentability (IPRP [Chapter II]) under Chapter II.

A list of the ISA and IPEA States is available from the World Intellectual Property Organization (WIPO) Web site at ("X" in columns D and E):

<http://www.wipo.int/pct/guide/en/>

22.02 Usefulness of the PCT for applicants

Under the PCT, an applicant files a single application which designates a number of states or regions where protection is sought. The effect of filing an international application is equivalent to filing a separate application in each of the designated states/regions. Additionally, the PCT provides an International Search Report (ISR) and International Preliminary Report on Patentability (IPRP) for each international application. The ISR and IPRP provide the applicant with invaluable information to evaluate the likelihood of obtaining patents in the designated states or regions.

If an applicant decides to continue the international application to obtain national (or regional) patents, he or she can wait until the end of the 30th month (31st month in some states or regions) after the filing of the international application (or of an earlier application for which priority is claimed). The following states are exceptions (as of July 2004):

Table 22.1: Transitional Reservation Countries under PCT Article 22

State	Time limit for National Phase Entry under PCT Article 22(1)	Regional patent alternative
CH – Switzerland	20 months	EPO – 31 months
FI – Finland	20 months	EPO – 31 months
LU – Luxembourg	20 months	EPO – 31 months
SE – Sweden	20 months	EPO – 31 months
TZ – United Republic of Tanzania	21 months	ARIPO – 30 months
UG – Uganda	21 months	ARIPO – 30 months
ZM – Zambia	20 months	ARIPO – 30 months

Updated information regarding this list of exceptions, is available from the World Intellectual Property Organization (WIPO) Web site at:

http://www.wipo.int/pct/en/texts/reservations/res_incomp.pdf

Notwithstanding the above noted list of countries in table 22.1, it is noted that all those remaining states are covered by a regional designation, i.e. either under an African or European regional designation. Therefore, although these countries are the only

remaining designated Offices that have not withdrawn their notification of incompatibility, in effect, applicants in these remaining countries can always enter the regional phase within the time limit of 31 months under PCT Article 22 (3). That is to say, the thirty-month (or 31 month) time limit for entry into the national or regional phase is now possible in respect to ALL PCT contracting states.

The applicant may optionally request an international preliminary examination resulting in an International Preliminary Report on Patentability by the IPEA (IPRP [Chapter II]). If the international preliminary examination is requested before the end of 19 months after the filing of the international application or of an earlier application for which priority is claimed, the applicant may delay the national phase of patent prosecution for the Transitional Reservation Countries (see Table 22.1 above) by 10 months.

The deferral of the entry into the National Phase gives applicants time to consider the patentability opinion obtained in the International Preliminary Report on Patentability (IPRP) and to decide whether to start costly patent granting procedures in foreign countries. The translation into other languages, payment fees in foreign currencies, and the appointment of foreign patent agents, all costs associated with filing separate applications, is postponed. It also provides the applicant with more time to find a licensee or a partner before entering in the costly national/regional phases.

A table of Chapter I and II time limits for each state/region is available from the World Intellectual Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct/en/index.html>

Follow the link on “Time Limits for Entering National/Regional Phase Under PCT Chapters I and II...”

When the international preliminary examination is demanded, a written opinion during the international examination process can be drafted from the first written opinion by the ISA, if the IPEA considers that it is still relevant.

22.03 The international phase for processing an international patent application

International Phase

- i) **Filing of the international application:** The applicant files a single international application in a single language accepted by a Receiving Office and pays the prescribed fees to this Receiving Office. That application has the effect of a regular national application in all designated states (PCT Contracting States) where protection is sought.

- ii) **International Search Report:** After conducting a prior art search, the ISA must establish an International Search Report and a first written opinion before the expiry of 16 months from either the priority date of the international application, or the international filing date if no priority is requested.

- iii) **Publication of international applications:** The IB publishes the international application, any amendments, and the search report on the "publishing Tuesday" (WIPO publishes applications on alternate Tuesdays) following the expiry of the 18-month period from either the priority date of the international application, or the international filing date, if no priority is requested.

- v) **International Preliminary Report on Patentability (IPRP):** The applicant has the option to demand an international preliminary examination under Chapter II of the Treaty (which postpones the entry to the national phase, before the elected Offices for the Transitional Reservation Countries listed in table 22.1 of MOPOP, which results in an International Preliminary Report on Patentability prepared by the IPEA (IPRP [Chapter II]). When the international preliminary examination is not demanded, the Internal Bureau issues an International Preliminary Report on Patentability based on the first written opinion on patentability by the ISA (IPRP [Chapter I]) and optionally with comments on this opinion by the applicant. While the designated or elected offices are not bound to follow the conclusion of the IPEA or ISA, the report contains a good indication of the chances of obtaining the desired protection for the invention.

22.04 Processing by the Receiving Office

The Receiving Office carries out the following functions:

- a) receives the international application and the related fees and notifies the applicant of the receipt of the international application indicating the date of actual receipt and the international application number e.g., PCT/CA2004/123456 (see PCT Rule 20.5(c) and PCT Gazette No. 47/2001, November 22, 2001, pp. 21585 and 21586).
- b) checks the international application to determine whether it meets the requirements prescribed by the PCT (Article 11 and Rule 11 of the PCT) as to form and content (the checks performed by the Receiving Office are of a formal nature and do not consider the substance of the invention);
- c) communicates with the applicant in order to obtain corrections where the international application does not meet certain requirements as to fees, form and content;
- d) accords the international filing date, where possible; and
- e) transmits copies of the international application and other related documents to the ISA and to the IB.

22.04.01 Requirements to obtain an international filing date

For a PCT application filed in Canada, the Receiving Office (CIPO) must accord as the "international filing date" the date of receipt of the international application provided that at the time of receipt:

- a) at least one of the applicants is a resident or national of Canada;
- b) the international application is in English or French (only one copy is necessary);
and
- c) the international application contains at least the following elements:

- (i) an indication that it is intended as an international application;
- (ii) the name of the applicant;
- (iii) a part which appears to be a description; and
- (iv) a part which appears to be a claim or claims (Article 11(1) of PCT).

When none of the applicants is a resident or national of Canada, the international application is forwarded to the IB, and the international filing date will be the date the Canadian Receiving Office had received the international application provided that the material originally submitted, according to the IB, satisfies the mandatory requirements to obtain an international filing date,

The filing forms are available from the World Intellectual Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct/en/forms/index.htm>

A software created to assist the applicant in filing the PCT forms and for filing the application electronically, along with the supporting documentation are available from the World Intellectual Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct-safe/en/index.htm>

Since January 2nd, 2004, the Patent Office, as a receiving office, will accept Request forms created with the pct-safe software. Applicant should consult periodically CIPO's What's new website at:

http://strategis.gc.ca/sc_mrksv/cipo/new/new-e.html

for further notice regarding international patent application filing.

When an international application does not, at the time of receipt, fulfill the above requirements, the Receiving Office invites the applicant to file the required correction and fixes a reasonable time limit. If the correction is made within the time limit, the date of receipt of the required correction becomes the international filing date.

When an application refers to drawings in the description but the drawings are not

included, the Receiving Office notifies the applicant. In this situation, the international filing date which will be accorded to the application is the date on which the missing drawings are received (Article 14(2) of PCT).

For purposes of the Paris Convention, the filing of an international application has the effect of filing a regular national application in each designated State. Priority rights, for example, may be based on an international application (Article 11(4) of PCT).

22.04.02 Fees associated with filing an international application

Four types of fees are payable to a Receiving Office when an applicant files an international application:

1. Transmittal fee (PCT Rule 14)
The transmittal fee is retained by the Receiving Office for receiving and checking the international application, and for transmitting copies of it to the IB and the ISA.
2. International filing fees (PCT Rule 15)
The international filing fee accrues to the IB for doing the central docketing and for publishing the international application. There is a supplementary charge for each page over 30 pages in the application.
3. Search fee (PCT Rule 16)
The search fee accrues to the ISA for carrying out the search and issuing an International Search Report.
4. Fee for priority document (PCT Rule 17.1 (b))
The fee for priority document accrues to receiving Office for the service of transmitting certified copy of earlier application the priority of which is claimed.

All fees, with the exception of fee for priority document, should be paid when the international application is filed, but are payable within one month after filing in order to maintain the original filing date. Fees for priority document can be paid at the latest before the expiration of 16 months from the priority date, after which the receiving Office may consider the request under PCT Rule 17.1 (b) as not having been made.

The search and international filing fee which accrue to the ISA and IB respectively may change as exchange rates fluctuate. A schedule of fees applicable to the PCT is published as item 13 in the CPOR and is available from the CIPO Web site at:

[http://napoleon.ic.gc.ca/cipo/patgazarc.nsf/v_currentedition_e/notice/\\$File/notice.pdf?OpenElement](http://napoleon.ic.gc.ca/cipo/patgazarc.nsf/v_currentedition_e/notice/$File/notice.pdf?OpenElement)

22.04.03 Elements of an international application

The structure of an international application is governed by the Treaty and particularly the Treaty Regulations. The Patent Office is bound by the PCT provisions and cannot require the correction of non-compliance to formalities not expressly provided for in the Treaty.

Under Article 3, the Treaty specifies that an international application must be in a prescribed language (PCT Rule 12); therefore, international applications filed in Canada as a Receiving Office must be submitted either in English or in French. The international application must also comply with the prescribed physical requirements (PCT Rule 11) and the unity of invention requirements (PCT Rule 13). It is also subject to prescribed fees.

The international application must contain a

- request (PCT Rule 4)
- a description (PCT Rule 5) with, when required, sequence listing(s) (PCT Rule 5.2)
- claim(s) (PCT Rule 6)
- drawing(s) (PCT Rule 7) (when required), and
- an abstract (PCT Rule 8).

22.04.04 Designation of countries and its effect (PCT Rule 4.9)

The filing of an international application along with the request, constitutes the designation of all Contracting States that are bound by PCT on the international filing date (Rule 4.9(a) of PCT). Furthermore, this full designation is an indication that the international application is, for some designed states (see Article 43 and 44 of the PCT), for the grant of every kind of protection which is available by way of the designation of that state, such as inventor's certificates, utility certificates or models,

patents or certificates of addition, inventor's certificate of addition, or utility certificate of addition.

The designation of some Contracting States (currently, Germany, South Korea and Russia) can be waived in view of some national laws restrictions. The applicant can unselect such state by checking the appropriate box in Box No. V of the PCT Request ([Request Form](#)).

This full designation postpones the final decision on which States will be retained for patent protection until the end of the international phase. This procedure gives the applicant more time to consider the various deadlines (formal national phase deadline, translation, power of attorney...) dictating the entry into the national phases. The selection of the Contracting States to be covered is effected by entering in the national phase in the countries or region of interest for the applicant. However, the applicant has to consider to elect the Transitional Reservation Countries (table 22.1) by filing a Chapter II demand, before the expiration of 19 months of the priority date (transitional measure), to enter into National phase in these countries at the end of 30 or 31 months, otherwise the applicant will have to enter into National phase at the end of 20 or 21 months.

22.05 Processing by the International Bureau

The IB administers the Treaty. The main procedural steps that an international application goes through at the IB are the following:

- a) the IB monitors and keeps the "record copy" of international applications and all papers filed by applicants;
- b) the applicant may amend the claims of the international application under Article 19 by means of communications addressed to the IB;
- c) the IB communicates the international application only upon request and at the time specified by the designated and elected Offices (PCT Rule 93*bis*);
- d) the IB publishes the international application and International Search Report with a publication number (e.g. WO2004/654321) which shall be different from the

international application number (e.g. PCT/CA2004/123456); and

e) If a demand for international preliminary examination is filed, the IB furnishes the international preliminary report on patentability (IPRP [Chapter II]) upon request to an elected Office (PCT Rule 94), and makes a translation of that report into English when required. The IB also notifies the Transitional Reservation Countries (Table 22.1) of their election.

If no demand for international preliminary examination is filed, the IB issues an International Preliminary Report on Patentability by the ISA (IPRP [Chapter I]), and makes publicly available this report 30 months from the earliest priority date of the international application. An informal procedure is provided for the applicant to submit comments on the ISA written opinion on patentability. These comments are made publicly available along with the IPRP [Chapter I].

22.05.01 Amendment of claims before the International Bureau (Article 19)

After receiving the International Search Report (see MOPOP 22.03.11), the applicant has the right under PCT Chapter I (PCT Article 19 and PCT Rule 46) to amend the claims, and only the claims, once. The time limit for making an amendment is normally 2 months after the search report is transmitted to the applicant, but may be extended to 3 months if the report is transmitted before 14 months from the priority date. Any such amendment must be filed with the IB.

The amendments shall not go beyond the description in the international application as filed i.e., no new matter may be added. Amendments may be made either by cancelling one or more entire claims, by adding one or more new claims and/or by amending the text of one or more of the claims as filed. Where a claim is cancelled, no renumbering of the other claims is required.

If the applicant wishes to amend the claims by changing the existing claims or cancelling entire sheets of claims, he or she must supply replacement sheets and a letter drawing attention to the differences between the replaced sheets and the replacement sheets. The applicant may, at the same time, file a brief statement under Article 19 of the PCT, explaining the amendments and indicating any impact that such amendments might have on the description and the drawings.

22.05.02 International publication

The IB publishes the international application, any amendments, and the International Search Report in the form of a pamphlet (PCT Rule 48.1(a)) as soon as possible after 18 months from the priority date of the application. However, an applicant may ask the IB to publish the international application earlier (PCT Rule 48.4). When the international application is withdrawn by the applicant before the completion of the technical preparations for publication, the international publication can be prevented (PCT Rule 90*bis*(c)).

If the International Search Report and any amendment under Article 19 are not available at the time of publication, they are published separately after they have been received by the IB. The pamphlet is printed in one of the seven following languages: English, French, Chinese, German, Japanese, Russian or Spanish. The abstract, title and search report always appear in English.

22.06 Processing by the International Searching Authority (ISA)

Every international patent application is subjected to an international search by an ISA. The objective of the international search is to discover relevant prior art for the purpose of assessing novelty and inventive step.

The international standards are prescribed in the PCT for the [minimum documentation](#) to be consulted.

The ISA carries out the following functions:

- a) conducts search of claimed inventions;
- b) checks for unity of invention and requests additional fees if unity is lacking;
- c) establishes the International Search Report;
- d) establishes a first written opinion on patentability;

- e) establishes a title and an abstract if either is missing or is inadequate; and
- f) transmits copies of the International Search Report to the IB and the applicant.

Presently, the Commissioner of Patents is the ISA for PCT international patent applications filed by Canadian residents or nationals in Canada or with the International Bureau. For international patent applications filed prior to July 26, 2004, the European Patent Office (EPO) was and remains the ISA for the application. Articles 15 to 18 of the PCT and PCT Rules 25 and 33 - 45 concern the competent ISA and its responsibilities.

22.06.01 Excluded subject matter and unity of invention

An ISA is not required to search an international application if the subject matter of the claims constitutes an excluded subject as specified under PCT Rule 39. The excluded subject matter are:

- a) scientific and mathematical theories;
- b) plant or animal varieties or essential biological processes for the production of plants and animals, other than microbiological processes and the products of such processes;
- c) schemes, rules or methods of doing business, performing purely mental acts or playing games;
- d) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods;
- e) mere presentations of information; and
- f) computer programs to the extent that the ISA is not equipped to search prior art concerning such programs.

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. The ISA is

responsible for reviewing the claims for unity of invention (Article 17(3)(b) and PCT Rules 13 and 40). If the ISA finds unity of invention is lacking, it invites the applicant to pay additional fees. This request for additional fees produces one of the following three results:

- a) The applicant willingly pays the additional fees and the ISA establishes a search report for all claims.
- b) The applicant pays the additional fees under protest. A special ISA board will review the protest and this review can result in a total or partial reimbursement of the additional fee, or in a rejection of the protest. Depending on the outcome of the review, a search report will be established for the appropriate claims.
- c) The applicant does not pay the additional fees. The ISA establishes a search report with respect to the main invention only.

22.06.02 International Search Report (ISR)

The results of the international search are recorded in the International Search Report, which is transmitted to the applicant and to the IB for publication (Article 18 of the PCT). The International Search Report must be established within three months from the receipt of the search copy by the ISA or nine months from the priority date, whichever time limit expires later (Rule 42 of the PCT). Presently, the International Search Report for international applications filed in Canada is established by the EPO in either English or French, depending upon the language used in the application. As of July 26, 2004, the Commissioner of Patents is the ISA for PCT international patent applications filed in Canada or filed in the International Bureau by Canadian nationals or residents on or after that date.

The report identifies the application concerned by its number, the name of the applicant, the international filing date, the priority date (if any), the date of the report, the international patent classification, the fields searched, and the documents constituting the relevant prior art (Rule 43 of the PCT).

The documents are cited against claims to which they are relevant. The report indicates subject matter not searched because of lack of unity of invention, and applicant's failure

to pay additional search fees.

The report also contains a copy of any title or abstract that may have been either revised or established by the ISA.

The International Search Report is always translated into English unless it was originally established in English (Rule 45 of the PCT).

22.07 Processing by the International Preliminary Examining Authority (IPEA)

International preliminary examination of an international application may be requested under Chapter II of the PCT to obtain an international preliminary examination. During this procedure, at least one written opinion is issued by the IPEA. Several written opinions may be issued by the IPEA if sufficient time is available. The applicant will have the opportunity to file amendments to the description, the drawings and the claims and to provide arguments for each of the written opinions.

The international preliminary examination starts according to the schedule provided in PCT Rule 69.1

69.1 Start of International Preliminary Examination

- (a) *Subject to paragraphs (b) to (e), the International Preliminary Examining Authority shall start the international preliminary examination when it is in possession of all of the following:*
- (i) *the demand;*
 - (ii) *the amount due (in full) for the handling fee and the preliminary examination fee, including, where applicable, the late payment fee under Rule 58bis.2; and*
 - (iii) *either the international search report and the written opinion established under Rule 43bis.1 or a notice of the declaration by the International Searching Authority under Article 17(2)(a) that no international search report will be established;*
- provided that the International Preliminary Examining Authority shall not start the*

- international preliminary examination before the expiration of the applicable time limit under Rule 54bis.1(a) unless the applicant expressly requests an earlier start.*
- (d) *If the national Office or intergovernmental organization that acts as International Searching Authority also acts as International Preliminary Examining Authority, the international preliminary examination may, if that national Office or intergovernmental organization so wishes and subject to paragraphs (d) and (e), start at the same time as the international search.*
- (b-bis) *Where, in accordance with paragraph (b), the national Office or intergovernmental organization that acts as both International Searching Authority and International Preliminary Examining Authority wishes to start the international preliminary examination at the same time as the international search and considers that all of the conditions referred to in Article 34(2)(c)(i) to (iii) are fulfilled, that national Office or intergovernmental organization need not, in its capacity as International Searching Authority, establish a written opinion under Rule 43bis.1.*
- (e) *Where the statement concerning amendments contains an indication that amendments under Article 19 are to be taken into account (Rule 53.9(a)(i)), the International Preliminary Examining Authority shall not start the international preliminary examination before it has received a copy of the amendments concerned.*
- (f) *Where the statement concerning amendments contains an indication that the start of the international preliminary examination is to be postponed (Rule 53.9(b)), the International Preliminary Examining Authority shall not start the international preliminary examination before whichever of the following occurs first:*
- (i) it has received a copy of any amendments made under Article 19;*
 - (ii) it has received a notice from the applicant that he does not wish to make amendments under Article 19; or*
 - (iii) the expiration of the applicable time limit under Rule 54bis.1(a).*
- (e) *Where the statement concerning amendments contains an indication that amendments under Article 34 are submitted with the demand (Rule 53.9(c)) but no such amendments are, in fact, submitted, the International Preliminary Examining Authority shall not start the international preliminary examination before it has received the amendments or before the time limit fixed in the invitation referred to in Rule 60.1(g) has expired, whichever occurs first.*

An applicant who is a resident or national of a Contracting State bound by Chapter II of the Treaty may make a demand ([Demand Form](#)) for international preliminary examination (Rule 53 of the PCT). The demand must be submitted directly with the International Preliminary Examining Authority (IPEA) (IB or Receiving Office). The demand comprises the election of all Contracting States which are designated and bound by Chapter II of the Treaty (Rule 53.7 of the PCT).

The IPEA carries out the following functions:

- a) receives the demand for international preliminary examination;
- b) receives both handling and preliminary examination fees;
- c) checks the demand for non-compliance to formalities (conformance with Rules 53, 54 and 55 of the PCT on format of the demand, applicant entitlement and language requirement) and verifies the payment of fees;
- d) sends the original copy of the demand, and handling fees to the IB.
- e) examines the international application for sufficiency of description, unity of invention, support of claims by the original description, and for patentability of claims in accordance with PCT criteria;
- f) issues written opinions to which the applicant may respond with amendments or arguments. Unless advised otherwise by the IPEA (PCT Rules 66.1 *bis*) the first written opinion by the ISA is to be considered as a written opinion of the IPEA for the purposes of PCT Rule 66.2(a);
- g) prepares the International Preliminary Report on Patentability [Chapter II]; and
- h) transmits the report to the IB and the applicant.

Presently, the Commissioner of Patents is the IPEA for PCT international patent applications filed in Canadian residents or nationals in Canada or with the International Bureau. For international patent applications filed prior to July 26, 2004, the European Patent Office (EPO) was and remains the IPEA for the application. Articles 31 - 42 and

Rules 53 - 78 of the PCT concern the IPEA and its responsibilities.

22.07.01 Fees associated with international examination

There are two kinds of fees which have to be paid in connection with a demand for an international preliminary examination:

1. The preliminary examination fee
This fee accrues to the IPEA, mainly for carrying out the international preliminary examination and for establishing the report.
2. The handling fee
This fee accrues to the IB for carrying out various tasks.

Where the IPEA finds that insufficient handling or preliminary examination fee have been paid, the IPEA invites the applicant to pay the amount required to cover the insufficient fee, together with, where applicable, a late payment fee under Rule 58*bis*.2 of the PCT, within a time limit of one month from the date of the invitation.

22.07.02 Amendments before the IPEA (Article 34)

Any applicant contemplating making a demand for preliminary examination may choose not to amend the claims after receiving the International Search Report under the provisions of Article 19 of the PCT. The applicant may rather choose to wait and submit amendments to the IPEA together with the demand, and/or amend the application after receiving a written opinion from the IPEA. At this stage, the applicant may amend not only the claims, but other parts of the application as well (Article 34 and Rule 66 of the PCT). The amendments may not go beyond the description of the international application as filed i.e., no new matter may be added.

The applicant may have several opportunities to amend the international application during the preliminary examination process, depending on the time available. The limiting factor is the PCT requirement that the IPEA complete the international preliminary examination report before the expiry of 28 months from the priority date, or 28 months from the international filing date, if there is no priority date.

Amendments are made by providing replacement sheets, accompanied by a letter of explanation. The amendment(s) and letter(s) must be in the language in which the international application was filed (Rule 66 of the PCT).

22.07.03 Excluded subject matter and unity of invention

Claims relating to inventions in respect of which no International Search Report has been established, because the claims relate to excluded subject matter or do not meet the requirements for unity of invention, will not be the subject of international preliminary examination. This will be indicated in any written opinion as well as in the international preliminary examination report.

When the IPEA considers that the international application does not comply with the requirements of unity of invention (Article 34(3) and Rule 68 of the PCT), it may choose between two courses of action:

- 1) it may carry out the international preliminary examination on the entire international application and express its views on the lack of unity of invention in the report; or
- 2) it may invite the applicant to restrict the claims so as to comply with the requirement or pay additional fees. The request for additional fees produces one of the following four results:
 - a) The applicant restricts the claims as required, in which case the examination is carried out on the claims as restricted;
 - b) The applicant willingly pays the additional fees and the international examination is carried out on the claims for the main invention and on the claims in respect of which additional fees have been paid (Rule 68.2 of the PCT);
 - c) The applicant pays the additional fees under protest; in this case, a special IPEA Board will review the protest. This review can result in a total or partial reimbursement of the additional fees, or in a rejection of the protest. Depending on the outcome of the review, an examination report

will be established for the appropriate claims (Rule 68.3 of the PCT);

- d) The applicant neither restricts the claims nor pays additional fees, in which case, the examination is carried out on the main invention as identified by the IPEA or the applicant (Article 34(C) of the PCT).

22.07.04 International Preliminary Report on Patentability [Chapter II]

Following the international preliminary examination procedure, an International Preliminary Report on Patentability (IPRP [Chapter II]) is issued at whichever of the following periods expires last (Rule 69.2 of the PCT):

- (i) 28 months from the priority date;
- (ii) six months from the time provided under Rule 69.1 (see MOPOP 22.07) for the start of the international preliminary examination; or
- (iii) six months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

The international preliminary examination report is a *non-binding opinion* on the patentability of the claims. Under PCT Rule 70, the international preliminary examination report includes:

- a) identification of the IPEA and the applicant;
- b) the applicable dates;
- c) the basis of the report;
- d) a simple yes or no statement with respect to each claim indicating whether the claims are thought to satisfy the criteria of patentability (novelty, inventive step and industrial applicability) and including an explanation and citation of references to support the conclusion contained in the statement;
- e) the citation of certain published documents comprising applications or patents published after the international filing date but filed prior to the international filing date (prior art effect);

- f) mention of certain defects under Article 34(4) and Rule 66.2 of the PCT;
- g) remarks concerning unity of invention; and
- h) an annex of any amendments filed during the examination process.

The report will express no opinion as to whether the claims are patentable under the national law of any elected country.

22.08 The national phase for processing an international application

On completion of the international phase, further action is required in order to obtain patent protection in the various countries designated in the international application at the time of filing. The applicant has to enter the "**national phase**", that is, initiate patent granting procedures in each designated or elected country according to the laws, rules and jurisprudence thereof.

22.08.01 Entry into the national phase in Canada

In order to obtain patent protection in the various countries designated in the international application at the time of filing, the applicant has to enter the national phase, that is, initiate patent granting procedures in each designated country and pay the prescribed national fees.

Applicants must comply with the terms of the PCT and the regulations under the PCT as well as Part II of the Canadian Rules respecting the Patent Act. The national phase starts only if the applicant fulfills certain requirements, either before the expiration of a certain time limit or together with an expressed request that it starts earlier. The applicant should not expect any notification inviting him to fulfill those requirements. He has the sole responsibility for fulfilling them in due time¹.

Part II of the Canadian Rules respecting the *Patent Act* provides a connection between the Patent Cooperation Treaty and the Canadian *Patent Act*. It covers such items as time limits, language of applications, fees and terms and conditions relating to the national phase.

The effective filing date of a PCT national phase application is the international filing date, and not the date on which the PCT application enters the national phase in Canada.

To enter the national phase in Canada, an applicant must take steps to do so within 30 months from the priority date of the international application, or 30 months from the international filing date if no priority is claimed (paragraph 58(3)(a) of the *Patent Rules*).

When an international application becomes a PCT national application, the application shall thereafter be deemed to be an application filed in Canada² and the *Patent Act* and the *Patent Rules* shall thereafter apply in respect of that application (section 59 of the *Patent Rules*).

For the purposes of a citation under section 28.2(1)(c) and (d) of the *Patent Act* in the prosecution of another application, a PCT application will benefit from its filing date or priority date only after it has entered the national phase.

Under section 61 of the *Patent Rules*, the requirement that an application contain a petition does not apply to PCT national phase applications. The first page of the pamphlet published by the IB includes all the required information to enter the national phase.

22.08.02 Late entry into the national phase in Canada

Under subsection 58(3)(b) of the *Patent Rules*, where an applicant fails to enter the national phase within 30 months after the priority date, but pays the additional fee for late payment and the required maintenance fees (set out in Schedule II, item 11 of the *Patent Rules*), he/she may enter the national phase up to 42 months after the priority date.

22.08.03 Content of PCT national phase application entering under Chapter I in Canada

When an international application becomes a PCT national phase application by entering the national phase in Canada under Chapter I of PCT, i.e., when no demand under Chapter II has been filed (IPRP [Chapter II]), the Patent Office creates an

examiner's file comprising:

- a) a copy of the applicant's international application as communicated to the Patent Office by the IB;
- b) a copy of the International Search Report or, alternatively, a statement by the ISA that no search report will be established (Article 17(2)(a) of the PCT);
- c) a copy of any amendment to the claims, and any statement made by the applicant under PCT Article 19 in light of the international search; and
- d) a copy of the IPRP [Chapter I]

If the international application was published by the IB in a language other than English or French, the examiner's file must include the translation into either French or English which should have been provided by the applicant upon entering the national phase in Canada. The translation must correspond to the international application as filed or as amended during the international phase. If the translation corresponds to the application as filed, a translation of any amendments submitted during the international phase can be filed separately or incorporated in the translation of the Canadian application.

If the Commissioner has reasonable grounds to believe that the translation is not accurate, the Commissioner shall requisition the applicant to provide a statement by the translator to the effect that, to the best of the translator's knowledge, the translation is complete and faithful (subsection 58(4) of the *Patent Rules*).

22.08.04 Content of PCT national phase application entering under Chapter II in Canada

When an international application becomes a PCT national phase application by entering the national phase in Canada under Chapter II of the PCT, the examiner's file should include the following:

- a) a copy of the applicant's international application as communicated to the Patent Office by the IB;

- b) a copy of the International Search Report or, alternatively, a statement by the ISA that no search report will be established (Article 17(2)(a) of the PCT);
- c) a copy of any amendment to the claims, and any statement made by the applicant under PCT Article 19 in light of the international search;
- d) a copy of the IPRP [Chapter II]; and
- e) a copy of replacement sheets containing amendments, if any.

All of the above items must be presented in either French or English.

If an applicant believes that he/she is entitled to claim status as a “small entity” as defined under section 2 of the *Patent Rules*, a formal declaration of the status as small entity at the international filing date, has to be provided at the National Entry.

Furthermore, if the applicant enters the national phase in Canada more than two years after the international filing date, the applicant must also pay the first maintenance fee at the time of entry (subsection 58(2) of the *Patent Rules*).

22.08.05 Other amendments provided on or after national entry in Canada

Under the terms of PCT, the applicant may amend the description, the claims and the drawings before national entry into any designated or elected Office (Articles 19 and 41 of the PCT).

However, once a PCT application enters the national phase in Canada, it is treated in exactly the same manner as any other application filed in Canada. Therefore, when a PCT national phase application includes voluntary amendments on entering the national phase which were not considered during the international phase, it must be accompanied by a written statement under section 34 of the *Patent Rules*. Moreover, voluntary amendments that are filed after the national entry on a PCT national phase application, must be accompanied by a written statement explaining the nature of the amendment and its purpose.

It is strongly suggested to use a heading such as, VOLUNTARY AMENDMENT FOLLOWING PCT NATIONAL ENTRY, on the written statement.

22.08.06 Completion requirements in the national phase in Canada

An application which has entered the national phase in Canada according to the provisions of subsection 58(1) or (2) of the *Patent Rules* may still be incomplete. To provide a complete application, subsection 62(1) of the *Patent Rules* specifies the following documents and information that must be provided to avoid abandonment under subsection 73(2) of the *Patent Act*.

- a) the name and address of the inventor where that information has not already been provided;
- b) c) Paragraphs 62(1)(b) and 62(1)(c) of the *Patent Rules* are repealed as of 30 March, 2004 (SOR/2004-67). Where a sequence listing is required by paragraph 111(a) of the *Patent Rules*, a copy of sequence listing in computer readable form complying with section 131 of the *Patent Rules* is mandatory unless the description contains a sequence listing complying with the standard provided for in the PCT Administrative Instructions (PCT Rule 13~~ter~~.2 of the Regulations under the PCT). However, the sequence listing portion filed electronically may not appear with the rest of the description. At laid open, a note on the cover page of the PCT publication would indicate that the sequence listing is available separately in electronic form. Applicant can provide the copy of sequence listing complying with section 131 of the *Patent Rules* at national entry, as a voluntary submission or following a notification, with the opportunity to comply within a prescribed period of time, by the Patent Office. Abandonment of the application by not complying to section 131 of the *Patent Rules* will occur only following the requisition under subsection 30(2) of the *Patent Rules* by the Patent Office, provided that the prescribed fee for the Request for examination under subsection 35(1) of the *Patent Act* has been paid. When prescribed fee for the Request for examination is not paid and the application does not comply to section 131 of the *Patent Rules*, a courtesy letter with a three (3) months delay will be sent. Failure to respond to the courtesy letter may result in a formal request, under subsection 35(2) of the *Patent Act*, by the Commissioner to the applicant to make a request for examination pursuant to subsection 35(1) of the *Patent Act*.

More information about sequence listings is available from the World Intellectual

Property Organization (WIPO) Web site at:

<http://www.wipo.int/pct/en/sequences/index.htm>

- d) an appointment of a patent agent, where required by section 20 of the *Patent Rules*;
- e) an appointment of an associate patent agent, where required by section 21 of the *Patent Rules*; and
- f) an appointment of a representative, where required by section 29 of the *Patent Act*.

The date by which the information and documents referred to in subsection 62(1) of the *Patent Rules* must be submitted is the expiry of the latest of:

- a) the 36-month period after the priority date; and
- b) the six-month period after the applicant complies with the requirements of subsection 58(1) and, where applicable, subsection 58(2) of the *Patent Rules*.

No extension of the time limits given in paragraphs a), b) and c) above is permitted (subsection 62(3) of the *Patent Rules*).

The Commissioner may, at the request of the applicant, reinstate the international application which is deemed to have been abandoned if, within 12 months after the date on which it was deemed to have been abandoned, the applicant complies with the above requirements and pays the reinstatement fee (section 98(1) of the *Patent Rules*)³.

22.08.07 Application of Canadian Legislation

Section 59 of the *Patent Rules* provides that when an international application becomes a PCT national phase application, the application is considered from that moment on as an application filed in Canada. The PCT national phase application is examined for its conformity to the *Patent Act* and *Rules*, which includes any substantive conditions of

patentability, such as any question in respect of prior art, new matter, clarity and/or ambiguity (Article 27(5) of the PCT). The *Patent Act* and *Rules* cannot require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in the PCT Treaty and Regulations (Article 27(1) of the PCT).

The authority regarding unity of invention for all patent applications filed in Canada, including PCT application in national phase is found in section 36 of the *Patent Act*. Since the requirements under section 36 of the *Patent Act* have the same scope as those prescribed under PCT Rule 13, these requirements are not different from or additional to PCT Rule 13.1, and therefore compliant with Article 27(1) of the PCT.

Under section 38.2 of the *Patent Act*, any new matter added in a PCT national phase application after the international filing date which is not reasonably to be inferred from the originally-filed specification and drawings must be removed. Since several amendments may have been made to a PCT national phase application prior to the examiner's consideration, the examiner's report will refer to the specific matter considered as new matter and the date of introduction of this matter.

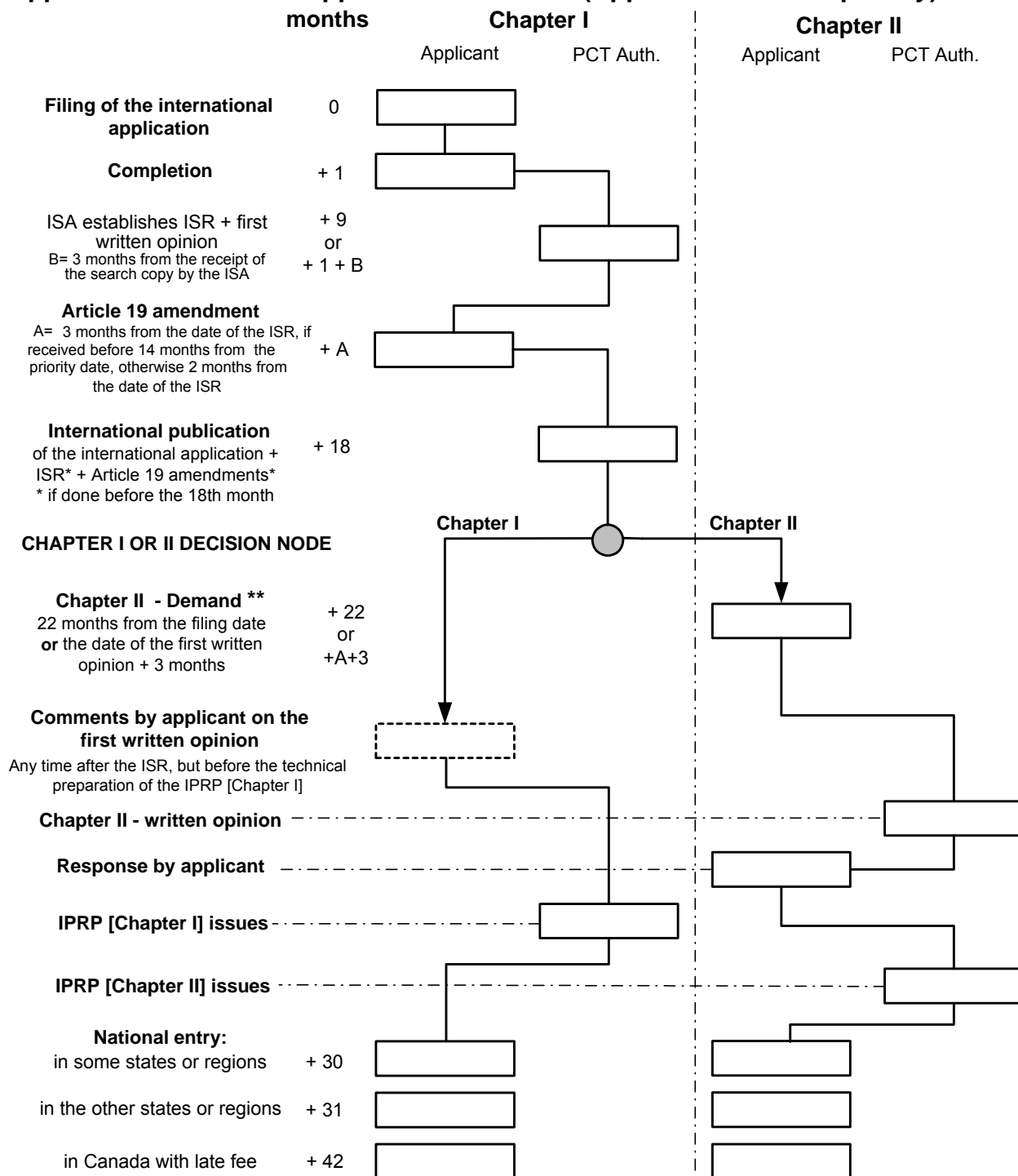
22.09 Access to the file of an international application

In addition to the international publication, which includes the international application and the International Search Report (sometimes published at a later date), third parties can access the first written opinion by the ISA, the IPRP [Chapter I] (and/or any translation thereof), or the IPRP [Chapter II] to the Canadian national phase application originating from the international application under the provision of section 10 of the *Patent Act*, but after the expiration of 30 months from the priority date (PCT Rules 44*ter* and 94).

Endnotes for Chapter 22

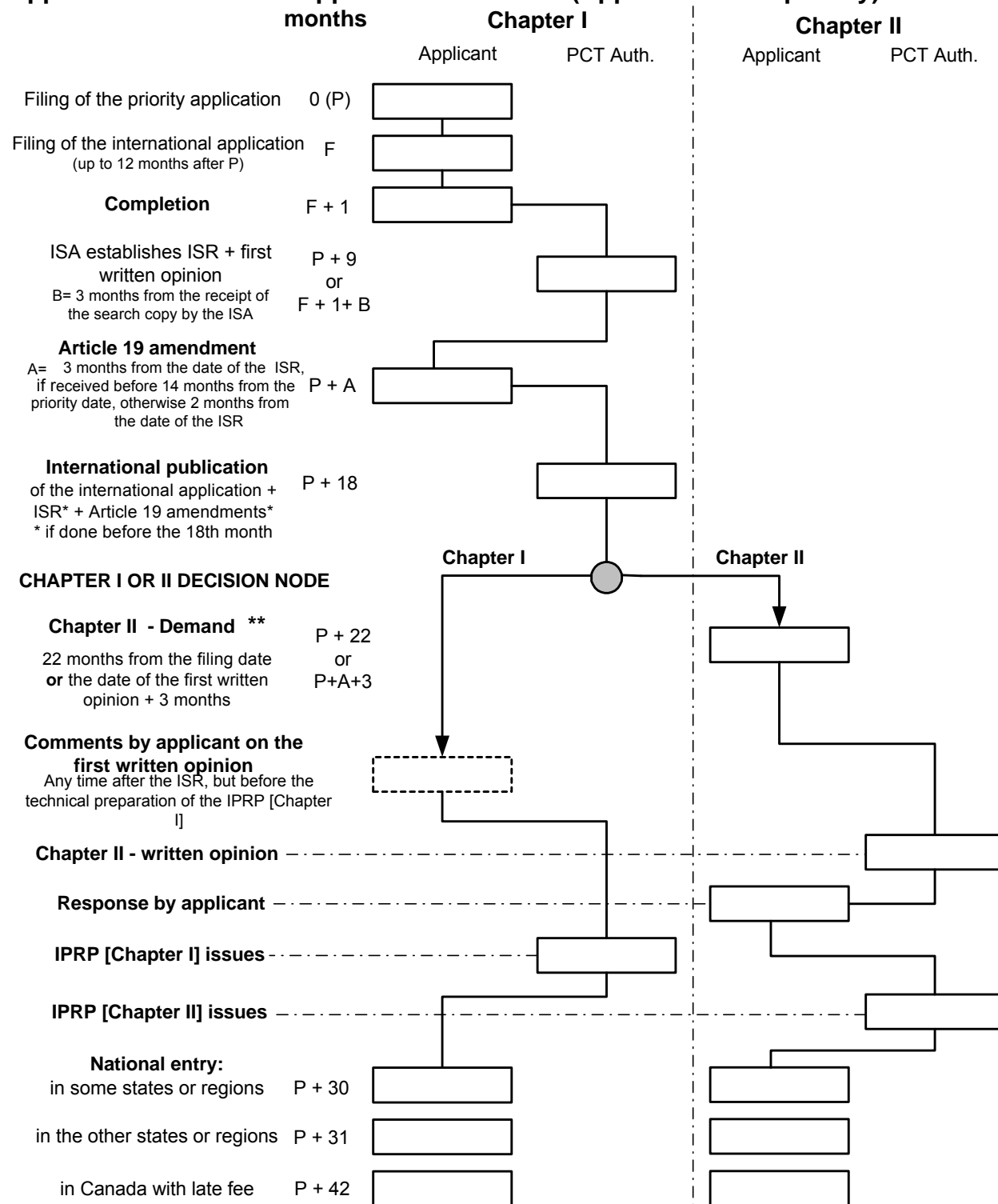
- 1 PCT Applicant's Guide Volume II, Chapter 2, Paragraph 12
First Green Park Pty. v. Canada (Attorney General) (1997) 72 C.P.R. (3d) 327 at 332-333
- 2 Celltech Ltd. v. Canada (Commissioner of Patents) (1993) 46 C.P.R. (3d) 424 at 437, affirmed 55 C.P.R. (3d) 59. "Since this was not done [designation of Canada], the Application was not to be dealt with under the law applicable to international applications in Canada"
- 3 First Green Park Pty. Ltd v. Canada (Attorney General) (1998) 84 C.P.R. (3d) 46 at 51, affirmed (2000) 6 C.P.R. (4th) 234

Appendix 22.1: PCT Application Deadlines (Application without priority)



** + 19 for international examination and transitional reservation countries, 10-month extension (Table 22.1 of MOPOP)

Appendix 22.2: PCT Application Deadlines (Application with priority)



** P + 19 for international examination and transitional reservation countries, 10-month extension (Table 22.1 of MOPOP)