

INTERNATIONAL (PCT) PATENT APPLICATIONS

PCT Applications - Chapter II Demand

This sheet deals with a very specific topic, namely filing a Chapter II Demand. For a more general discussion of PCT applications, and the PCT process, please refer to our information sheet entitled PCT Applications.

IN BRIEF

All PCT applications are automatically subject to examination. The examination may be **without** interaction between the applicant and the Examiner (under Chapter I) or **with** interaction between the applicant and the Examiner (under Chapter II, that is, if a Demand is filed).

Briefly, filing a Demand (along with amendments and/or arguments) is a way of addressing one or more objections expressed in a negative WOISA, in an effort to obtain a more positive IPRP.

Deciding on whether or not to file a Demand

By default, all PCT applications are automatically subject to examination, and an International Preliminary Report on Patentability (IPRP) is issued for all PCT applications.

The IPRP is a non-binding opinion on the core patentability requirements: novelty, inventiveness and industrial applicability. The IPRP, like the WOISA that is issued before it, sets out, in detail, the reasons and the basis for its (negative or positive) finding. If necessary for the examination process, the examiner may also include comments on other issues such as form, content, clarity etc. The IPRP is often helpful when deciding in which countries/regions to enter the National/Regional Phase.

The examination may be **without** interaction between the applicant and the Examiner (under Chapter I) or **with** interaction between the applicant and the Examiner (under Chapter II, that is, if a Demand is filed). Thus, the filing of a Demand is entirely optional.

Filing a Demand ("a Demand for further International Preliminary Examination (IPE) under Chapter II of the Patent Cooperation Treaty (PCT)") involves filing certain forms and paying certain fees, including a PCT examination fee.

The deadline for filing the Demand is the later of: 22 months from the priority date, and 3 months from the issuance of the Written Opinion of the International Search Authority (WOISA). Any amendments and/or arguments addressing the objections

Also, filing a Demand permits central prosecution of the application before a single patent office, and can be used to reduce the number of objections that will need to be addressed later, during the National/Regional Phase, before individual patent offices. This is especially true for the European Regional Phase, where further examination essentially continues from where the international examination stopped.

raised in the WOISA must be filed by the same deadline, and are usually filed at the same time as the Demand.

If a Demand is not filed, then the WOISA is reissued without change as the IPRP/Chapter I. Therefore, if the WOISA is positive, you may choose not to file a Demand, and instead allow the WOISA to be reissued as a (positive) IPRP/Chapter I.

If a Demand is filed, the Examiner reconsiders the WOISA, in view of any amendments and/or arguments that have been filed by the Demand deadline, and prepares the IPRP/Chapter II.

Note that a negative IPRP does not result in any loss of rights. However, it may influence the opinion of individual patent offices during the National/Regional Phase, and any outstanding objections may need to be addressed at that time.

Thus, filing a Demand (along with amendments and/or arguments) is a way of addressing any objections expressed in a negative WOISA, in an effort to obtain a more positive IPRP.

Also, filing a Demand permits central prosecution of the application before a single patent office, and can be used to reduce the number of objections that will need to be addressed later, during the National/Regional Phase, before individual patent offices. This is especially true for the European Regional phase, where further examination essentially continues from where the international examination stopped.

“Reservation” countries

Before April 2002, the deadline for entering the National/Regional Phase was 20 months from the priority date, unless a Chapter II Demand was filed by 19 months from the priority date, in which case the deadline for entering the National/Regional Phase was extended to 30 months from the priority date. Thus, until April 2002, one reason to file a Demand was to delay the decision and associated costs of entering the National/Regional Phase.

In April 2002, the PCT was amended so that the deadline for entering the National/Regional Phase is 30 months from the priority date, whether or not a Demand has been filed by 19 months from the priority date. However, some “reservation” countries gave formal notification that their national laws were not compatible with the amended PCT and that the old deadline would continue to apply in their country.

Most of these countries have since withdrawn their reservations. As at 1st December 2008, there are only three reservation countries: Luxembourg, Tanzania and Uganda. However, each of these countries can be reached via “Regional Phase” patent applications filed via the European Patent Office (EPO) and the African Regional Property Organisation (ARIPO) by the normal (30 or 31 month) deadline.

Consequently, if the “Regional Phase” route is employed, then it is not necessary to file a Demand in order to delay the National/Regional Phase deadline from 20 to 30 months.

However, if you wish to enter the **National Phase** in any of these countries (rather than the corresponding Regional Phase), then it is necessary to file a Demand by 19 months from the priority date if you wish to delay the National Phase deadline from 20 to 30 months.

In summary, by filing a Demand by 19 months from the priority date, the National/Regional Phase deadline is extended from 20 to 30 months in *all* jurisdictions, including the reservation countries. This is only necessary if you wish to enter the **National Phase** in one or more of the remaining reservation countries (rather than the corresponding Regional Phase), and you wish to delay the National Phase deadline from 20 to 30 months.

Filing a Demand solely for this reason is now very rare.

Examination under Chapter II

Examination under Chapter II involves interaction between the applicant and the Examiner. Examination normally begins after expiry of the deadline for filing the Demand (the later of: 22 months from the priority date and 3 months from the issuance of the WOISA). However, it is possible to request that examination begin earlier, before expiry of that deadline.

If the EPO has prepared the WOISA (as is usually the case for PCT applications filed at the UK Intellectual Property Office), then the WOISA serves as the starting point for further examination.

Examination is based upon the claims as originally filed, or as amended in response to the ISR (under Chapter I), or as further amended by subsequent amendments (under Chapter II), for example amendments filed with the Demand or by the Demand deadline.

Note that any “informal comments” that may have been filed in response to the WOISA under Chapter I must be resubmitted if they are to be considered during examination under Chapter II.

If no amendments or arguments are filed by the Demand deadline, then the contents of the WOISA are used, without any substantive changes, to prepare the IPRP/Chapter II. If amendments and/or arguments are filed by the Demand deadline, then the Examiner reconsiders the WOISA, in view of those amendments and/or arguments, and prepares the IPRP/Chapter II.

Only in rare cases will the Examiner issue a second Written Opinion, and invite a second response, before preparing the IPRP/Chapter II. You should not rely upon a second Written Opinion being issued.

Costs

As a rough guide, the cost of filing a Demand, including the official fees but excluding the costs of preparing and filing any amendments and/or arguments in reply to the WOISA, is approximately £1500 (excl. VAT). Usually, about £450 of this cost will be recouped when entering the European Regional Phase.

Summary and strategy

In summary, you must decide whether or not to file a Demand (and any amendments and/or arguments).

You must make this decision by the later of: 22 months from the priority date and 3 months from the issuance of the WOISA.

So:

File a Demand, along with arguments and/or amendments addressing one or more of the objections raised in the WOISA (all by the later of: 22 months from the priority date and 3 months from the issuance of the WOISA) if you wish to try to obtain a more positive IPRP.

Don't file a Demand if you are happy to have the WOISA reissued as the IPRP, and are happy to address any objections raised in the WOISA later, during the National/Regional Phase.

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