
Changes to Rules for Filing Chapter II Demands for PCT Applications

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Many patent applicants file foreign patent applications through a process under the [Patent Cooperation Treaty \(PCT\)](#), a treaty in which most countries participate. An applicant files a PCT patent application within 12 months of the earliest filing date for an application (the “priority date”). The PCT application can be converted into national applications in participating countries by entering a “national phase” within prescribed time limits. This process allows applicants to postpone national filing fees and translation costs (the PCT application can be filed in one language).

As a result of a recent change in the rules governing PCT applications, for countries enacting laws or rules to implement the PCT changes, applicants will be able to postpone the time for entering the national phase until 30 months from the priority date without taking any steps after filing the PCT application.

Current Rules

Under the current rules, the deadline for entering the national phase is 20 months from the priority date (unless a country sets a later date). The deadline can be extended to 30 months from the priority date by filing of a “Chapter II Demand” within 19 months of the priority date. With such a filing, a patent office selected by the applicant examines the application and issues a non-binding opinion of patentability, followed by an International Preliminary Examination Report (IPER).

New Rules

The PCT has changed the basic time limit for entry into the national phase from 20 months to

30 months from the priority date (some countries and patent bodies, such as the European Patent Office, may have a longer time limit). Thus, the PCT will provide a single time period for national phase filing of PCT applications, regardless of whether an applicant files a Chapter II Demand. The filing of the Chapter II Demand for an opinion of patentability and an IPER is now optional and independent of the desire to “buy more time.”

Subject to the passage of implementing legislation (see next section below), the change in rules applies to PCT applications for which the 20-month period expires on or after April 1, 2002 – that is, for applications for which the 19-month Chapter II Demand deadline falls on or after March 1, 2002. For such applications and for filing national phase applications in those countries that have enacted implementing legislation, the Chapter II Demand deadline can be disregarded without jeopardizing the ability to enter the national phase because the deadline for entry is extended automatically to 30 months from the priority date.

However, under certain circumstances, such as when the applicant wishes to amend the application prior to entry into the national phase or where a Preliminary Examination Report may expedite prosecution in the national phase, filing of a Chapter II Demand may be desired.

Implementing Legislation

These new rules will apply only to PCT participating countries that have enacted national implementing legislation or rulemaking. The [United States](#) and the European Patent Office have implemented conforming rulemaking, and therefore the changes will take place for applications with a 20 month priority date on or after April 1, 2002 filed in the national phase in the United States or in Europe. Other countries, including Japan, have not enacted such legislation and are not expected to until after April 1, 2002. Until a participating country amends its national laws to comply with the new PCT rules, the old time limit for entry into the national phase of 20 months from the priority date will continue to apply in that patent office. If the applicant wants to file a national phase application in one or more countries that have not enacted such legislation or rulemaking, the applicant will only be able to delay the entry into the national phase until 30 months from the priority date for those countries by filing a Chapter II Demand within 19 months from the priority date as under current rules.

Participating countries have been asked to provide, by January 31, 2002, information about when they expect to implement conforming legislation or rulemaking. The [PCT Gazette](#) and

the PCT Newsletter are supposed to provide information on those countries that have amended their laws or rules.

Reasons for the Rule Change

The changes to time limits for entry into national phase will alleviate the burdens placed on various patent offices. Under the new rules, applicants who wish merely to “buy more time” do not need to file a Chapter II Demand, and the number of demands filed is expected to decrease significantly. Membership in the PCT has grown to [112 countries](#) since its adoption in 1970. In 2000, 90,948 PCT applications were filed, an increase of 22.9% compared with 1999. The majority of PCT applications file a Chapter II Demand and undergo international preliminary examination. In 2000 alone, patent offices produced a total of 59,201 Preliminary Examination Reports. This rise in PCT filings has generated an enormous increase in workload for the patent offices, some of which are having difficulty in meeting the demands placed on them.

Mary Rose Scozzafava

mary.scozzafava@haledorr.com

Michael Diener

michael.diener@haledorr.com