

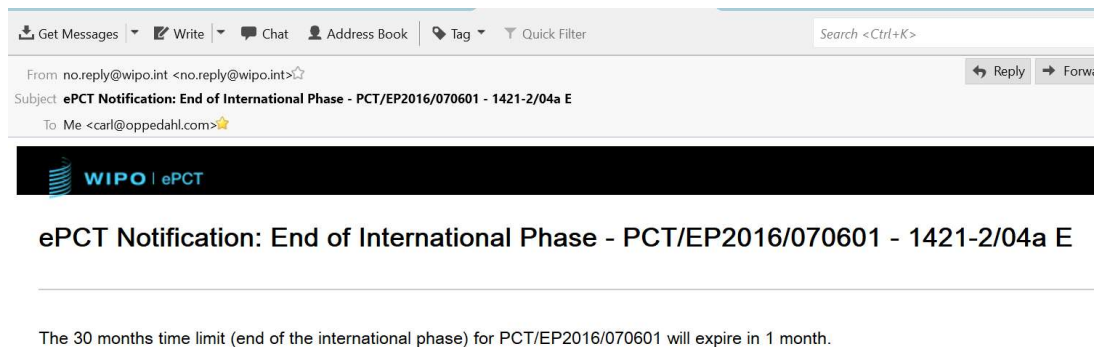
2025 PCT Training Seminar

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National phase entry generally – tips for some offices

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Isn't it nice?



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IPRP-I and IPRP-II

- Every PCT application gets an International Preliminary Report on Patentability (except in the rare case where no ISR was established)
- If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I)
- If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II)

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IPRP-I

If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I)

- ❑ This comes from the International Bureau
- ❑ The IB simply places a cover sheet over the Written Opinion of the ISA
- ❑ This happens shortly after the 30th month

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IPRP-II

- If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II)
- This is mailed by the International Preliminary Examining Authority
- This often happens around the 28th month

WO/ISA and WO/IPEA

- Every application receives a Written Opinion of the International Searching Authority (except in the infrequent case where no ISR was established)
- If a Demand is filed, then usually the IPEA adopts the WO/ISA as its Written Opinion
- An IPEA could, however, establish its own WO
- This sometimes happens if the IPEA is not the same as the ISA
- If the IPEA establishes its own WO, this is termed the WO/IPEA

Entry into national phase and regional phase outside of the US

- WIPO provides a table which summarizes the time limits for national- and regional-phase entry
- Click on “PCT” and “time limits”
- Examples:
 - CN 30 months
 - EP 31 months
 - JP 30 months
 - KR 31 months
 - US 30 months

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Entry into national phase and regional phase outside of the US

- The client will need to decide where (if at all) the client wishes to enter the national and/or regional phase
- Many factors might affect these important decisions as for a particular country or region
 - Size of the economy in that country or region
 - Prosecution cost in that country or region
 - Business needs of the client in that country or region

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Entry into national phase and regional phase outside of the US

- You will need to send instructions to foreign counsel
- Best Practice is that foreign counsel already uses ePCT, in which case you need merely click to give ePCT access to foreign counsel
- Another option is to send the permalink from Patentscope (if the application has been published)
- You will need to let foreign counsel know your file number

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Entry into national phase and regional phase outside of the US

- When sending instructions to foreign counsel, allow enough time for translations and other tasks
- Coordinate with foreign counsel about local needs. For example in EPO you will probably want to limit the application to fifteen claims
- Docket to check for prompt confirmation of instructions from foreign counsel

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The IP5

- CNIPA
- EPO
- JPO
- KIPO
- USPTO

These five Offices between them account for 85% to 90% of all patent filing activity worldwide. Some corporate filers automatically do not think of other Offices.

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Cost

- Some Offices cost a lot less money than you might think.
- Australia
- Canada
- New Zealand

Especially if you have favorable results elsewhere.

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Effectiveness of courts and enforcement systems

- Great variation from one country to the next, especially historically.

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Cost

- Some filings cost really a lot of money
- Translation costs
- Government fees
- But in the case of EPO, do not forget you are getting 23 countries through one filing, plus possible extension states

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Pharma

- You will see an occasional pharma filing path in which filings are done in essentially every Office in which it is possible to file

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Where are the customer markets?

- Some corporations will file based upon where the customer markets are located
- Or based upon guesses of where the customer markets might be located in the next twenty years

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Where are the factories?

- Some corporations will file based upon where the factories are located
- If you can get enforceable rights in the places where competitors might build factories, maybe this is all that you need
- Maybe no need to worry about¹⁷

Consider lifecycle cost

- It is very easy for a client to consider merely the cost to enter national phase in various offices, failing to take into account ongoing costs
- Annuities can really add up
- Clients that have not been through this process before need to be

Selecting foreign counsel

- Worst way to pick:
 - They spammed you and you give them business
- Second worst way to pick:
 - They send you work and so you send work back to them

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Selecting foreign counsel

- Best ways to pick:
 - Referrals from trusted colleagues
 - Referrals from colleagues on the PCT listserv
 - Do they use ePCT for all functions?
 - Do they use PCT declarations 2, 3 and 4?

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Should you use a one-stop shopping service provider?

- For a cheap fixed fee per Office they will do your national-phase entries in lots of countries
- They handle the translations
- They pick the local firms
- They really keep the costs down
- Is it a good idea?
- Maybe okay for some bronze cases. Surely a bad idea for any gold cases.
- How do you know if the translations are any good?

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How to get translations done?

- There are some very expensive translation service providers
- There are some translation service providers that offer amazingly inexpensive prices
- How can you possibly know whether the work is good quality?
- Should you simply entrust the translation work to your foreign patent counsel?

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How to pay foreign counsel?

- We find Wise Business to work well for us
- If the foreign firm uses Wise Business too, then transfers each direction will be free of bank fees and will be instant

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Upcoming webinars

- 13 - Friday, December 19, 2025
Choosing between US national-phase entry and bypass continuation
- 14 - Monday, December 22, 2025
Best practices and procedure for US national-phase entry
- 15 - Tuesday, December 23, 2025
Making use of PCT-PPH, and comparison with Track I

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Thank you!