

## NOTES CONCERNING THE PROGRESS OF THE PCT APPLICATION

These notes provide essential instructions on the next steps that the applicant may take to comply with the PCT application. These notes are based on the requirements of the Patent Cooperation Treaty (PCT), Regulations under the Patent Cooperation Treaty and the PCT Administrative Instructions. In case of divergence between these notes and such requirements, the requirements will prevail. For more detailed information, see also the PCT Applicant's Guide published by the World Intellectual Property Organization (WIPO) (<http://www.wipo.int/pct/en/texts/pdf/pct.pdf>).

In these notes, the terms "Article", "Rule", "Section" and "Instruction" refer to the provisions of the PCT, Regulations under the Patent Cooperation Treaty and the Administrative Instructions, respectively.

### WHAT TO DO AFTER RECEIPT OF THE FORMS RELATING TO THE ISA?

PCT/ISA/210 – international search report; and PCT/ISA/237 – Written Opinion

#### 1) WITHDRAW OF THE INTERNATIONAL APPLICATION

Shortly after the expiration of 18 months from the priority date, the international application shall be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a declaration of withdrawal of the international application, or priority claim, shall reach the International Bureau, as provided in Rule 90bis.1 and 90bis.3, respectively, before the technical preparations for international publication have been completed.

#### 2) SUBMIT INFORMAL COMMENTS IN RESPECT OF THE RECEIVED FORM

The applicant may submit informal comments to the International Bureau concerning the Written Opinion of the International Searching Authority. The International Bureau shall send a copy of such comments to all designated Offices unless an International Preliminary Examination Report has been or is being made. Informal comments will be made publicly available on PATENTSCOPE as from the date of international publication.

**NOTES:** 1) It is worth remembering that there will be no analysis of the comments or amendments in the Written Opinion; 2) There is no form and no payment of fees is required.

#### 3) SUBMITTING AMENDMENT OF CLAIMS BEFORE THE INTERNATIONAL BUREAU AS PROVIDED IN ARTICLE 19 ( RULE 46)

Upon receipt of the International Search Report and Written Opinion of the International Searching Authority, the applicant has the possibility to amend once the claims of the international application (see Rule 46). However, it should be emphasized that, since all parts of the international application (Claims, Description and Drawings) may be amended during the international preliminary examination procedure, it is generally not necessary to make amends to the claims under Article 19 except, for example, if the applicant wishes to have these amendment published for the purpose of obtaining provisional protection or because you have other reason to amend the claim before the international publication. In addition, it should be emphasized that provisional protection is only possible in a few States (see PCT Applicant's Guide, Volume I/A, Annexes B1 and B2). Brazil does not adopt provisional protection. The applicant shall be aware that no modification of the claims is permitted, as provided in Article 19, if the International Searching Authority has declared, as provided in Article 17 (2) that the international search report could not be formulated (see the PCT Applicant's Guide, Volume I/A, paragraph 296).

#### When to submit the amendments?

The time limit referred to in Article 19 shall be two months from the date of transmittal of the International Search Report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later, provided that any amendment under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

#### Where to file the amendments?

Amendments under Article 19 shall be filed directly with the International Bureau (Rule 46.2).  
If a demand for international preliminary examination has been established, see item 4.

Amendments can preferably be sent via ePCT: <<https://pct.wipo.int/LoginForms/epct.jsp>>  
Or by mail: International Bureau of WIPO, 34 Chemin des Colombettes, 1211 Geneva 20, Switzerland.

#### How to make the amendments?

Amendments to the claims under Article 19 may be made either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed. The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

Where a claim is cancelled, no renumbering of the other claims shall be required.

However, in all cases where claims are renumbered, they shall be renumbered consecutively in Arabic numerals (Section 205 (a)).

Any amendment under Article 19 shall be in the language of publication (Rule 46.3).

#### **Which documents should/can accompany the amendments?**

Letter (administrative instructions 205.b): Amendments shall be accompanied by a letter.

The letter will not be published with the international application and the amended claims. Not to be confused with the "Statement under Article 19 (1)" (see below, concerning the "Statement under Article 19 (1)").

The statement referred to in Article 19(1) shall be in the language in which the international application is published (Rule 46.4). The letter, which must accompany the replacement sheets containing amendments to the claims, must indicate the differences between the claims as filed and those as amended.

This should be done by stating, in connection with each claim appearing in the international application (so that identical indications referring to several claims can be grouped), whether:

- i) the claim is unchanged;
- ii) the claim is cancelled;
- iii) the claim is new;
- iv) the claim replaces one or more claims as filed;
- v) the claim is the result of the division of a claim as filed;
- vi) the claim replaces one or more claims as previously amended;
- vii) the claim is the result of dividing a claim as previously amended;

#### **The following examples illustrate how the amendments should be explained in the accompanying letter:**

1. [When the number of claims originally submitted exceeds 48 claims and after amending some claims, this number exceeds 51]: "Claims 1 to 29, 31, 32, 34, 35, 37 to 48, replaced by the amended claims, maintain the same numbering; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [When originally there were 15 claims and after amending of all claims there are 11]: "Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where there were originally 14 claims and the amendment consist in the cancellation of some claims and in addition to new claims]: "Claims 1 to 6 and 14 unchanged; claims 7 to 13 canceled; new claims 15, 16 and 17 added." or "Claims 7 to 13 canceled; new claims 15, 16 and 17 added; all other claims unchanged. "
4. [Where various types of modifications have been made]: Claims 1-10 unchanged; claims 11 to 13, 18 and 19 canceled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided by the modified claims 15, 16 and 17; new claims 20 and 21 added."

#### **"Statement under Article 19 (1)" (Rule 46.4)**

Any amendment may be accompanied by a brief statement by the applicant explaining the amendment and indicating any impact it might have on the description and the drawings (which may not be amended in accordance with Article 19 (1)).

The Statement will be published together with the international application and the amended claims.

The Statement must be in the language in which the international application is published.

The Statement must not exceed 500 words if in English or when translated into English.

A statement explaining the amendment is not to be confused with and must be clearly distinguished from the letter indicating the differences between the claims as filed and those as amended and the basis for the amendment. It must therefore be identified as such by a heading "Statement under Article 19(1)."

It may not contain disparaging comments on the international search report or on the relevance of any of the citations contained in that report. References to certain citations in the report may be made only in connection with an amendment made to a specific claim.

#### **4) MAKING A DEMAND FOR INTERNATIONAL PRELIMINARY EXAMINATION**

Also during the international phase, the Applicant may request an International Preliminary Examination Report (IPER), pursuant to Article 31 of the PCT. It is worth remembering that this step is optional and will be useful when the Applicant wishes to make amendments to parts of the application beyond those permitted by Article 19 (claims) and/or to submit arguments on the written opinion received by the International Search Authority ISA and/or when you wish a new written opinion, based on the amendments and/or arguments presented. The purpose of the international preliminary examination is to analyze for the second time the patentability of an invention and gives the applicant the opportunity to evaluate the chances of obtaining patents in elected Offices before incurring the expense and trouble of entering the national phase. Moreover, it is subject to the same criteria that apply to the written opinion issued by the international search.

#### **When shall be submitted?**

A Demand may be made at any time prior to the expiration of whichever of the following periods expires a) three 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 43bis.1; or b) 22 months from the priority date

### Where shall be submitted?

The Demand must be made separately from the International Application, and be submitted directly to an International Preliminary Examining Authority which is competent to carry out International Preliminary Examination on the International Application concerned. In case the chosen Authority is INPI-BR, **the demand may be filed online by using the ePCT service** (signing in with strong authentication at <https://pct.wipo.int/ePCT>), directly at the Institute's headquarters in Rio de Janeiro or sent by mail to:

Instituto Nacional de Propriedade Industrial – INPI  
A/C: CGPCT/DIPCT  
Rua Mayrink Veiga, 9 - 6º andar  
Centro - Rio de Janeiro, RJ - CEP: 20090-910

### How to submit the Demand for International Preliminary Examination?

- a) Fill out the Demand - Form PCT/IPEA/401, available on the WIPO website  
<[http://www.wipo.int/export/sites/www/pct/en/forms/demand/ed\\_demand.pdf](http://www.wipo.int/export/sites/www/pct/en/forms/demand/ed_demand.pdf)>
- b) It must be submitted in the language of the international application;
- c) The amount of the fees is available in the Table of fees, on the WIPO website  
<<http://www.wipo.int/export/sites/www/pct/en/fees.pdf>>

The data to make the bank transfer are:

Name: INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL- INPI  
Address: Praça Mauá, No. 7, Center, Rio de Janeiro / RJ, CEP - 20081-240, Brazil  
Swift code: BRASBRJRJO  
Account number IBAN-BRAZIL: BR930000000022340003330281C1

- d) If you modify the description and/or the drawings, you must submit a replacement sheet of each sheet of the international application that, due to an amendment, differs from the previously presented sheet. When the claims are amended, you must submit replacement sheets containing a complete set of claims in substitution of all the claims originally filed (Rule 46.5.a). Replacement sheets must be accompanied by a letter in which attention will be drawn to the differences between the replaced sheets and the replacement sheets, the reasons for the modifications will be indicated (Rule 66.8). The language of the letter must be the language of publication of the request (Rule 55.3.a).

All documentation must be submitted in two copies (if the applicant wishes a copy, an additional copy must be submitted).

If at the time of submission of amendments and, where appropriate, a statement under Article 19, a demand for international preliminary examination has already been submitted, the applicant preferably, at the time of deposit of the modifications (and the declaration, if any) to the International Bureau, must submit a copy of the amendments (and the statement, if applicable) to the International Preliminary Examination Authority (Rule 53.9) and, where appropriate, a translation of said amendments to the procedure of the International Preliminary Examining Authority (see rules 55.3.a) and 62.2, first paragraph). For more information, see the notes of the application form for international preliminary examination (PCT/IPEA/401). The International Preliminary Examination Authority may communicate informally, at any time, with the applicant by telephone, in writing or by personal interview (Rule 66.6) to correct any doubt about the invention.

### 5) SUPPLEMENTARY INTERNATIONAL SEARCH REQUEST

The applicant may, at any time before the expiration of the 22 months from the priority date, request one or more supplementary international searches each to be carried out by an ISA other than the ISA that carried out the main international search. For more information on the procedure for requesting the supplementary search, see the PCT Applicant's guide, international phase, paragraphs 8.006-8.032. **NOTES:** 1) Brazil, currently, does not offer this service; 2) This step is optional;

### 6) NATIONAL PHASE ENTRY

Up to 30 months after the international filing date, or of the priority claim (if any), the national phase of each member country of interest of the applicant must be entered (Article 22).

**NOTE:** This period is 20 months for Luxembourg and the Republic of Tanzania, when the IPER demand is not filed. Upon entering the national phase, all parts of the international application may be modified in accordance with Article 28 or, as the case may be, in accordance with Article 41.

#### Consequences related to the translation of the international application to enter the national phase

The applicant must be aware of the fact that some designated or elected Offices require, upon entry into the national phase, the presentation of the translation of the amended claims under the provisions of Article 19, instead of the translation of the claims how they were filed, or in addition to these.

For more information on the requirements of each designated/elected Office, see the PCT Applicant's Guide, National Chapters.

**NOTE:** In Brazil, Portaria nº 39/2021 disciplines the procedures for entry into the national phase of PCT international applications.