

# Saving Grace: PCT National Phase Deadline Grace Periods Could Protect Your Application

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Practice Area: Patents & Intellectual Property

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In today's global marketplace, protecting innovation is essential both at home and abroad. But determining whether and where to protect an invention can often prove to be a complex feat for applicants, especially those just emerging in their field. Identifying relevant consumer bases, evaluating supply chain logistics and considering economic repercussions takes time. As many patent practitioners and clients know, however, time is a valuable piece in the patent prosecution puzzle, and should not be miscalculated.

With more than 150<sup>1</sup> contracting states across the globe, the Patent Cooperation Treaty (PCT) system provides a convenient starting point for securing foreign patent rights, while giving an applicant valuable time to market his or her product, to secure capital, and to ultimately determine whether and where to advance prosecution. Under the Paris Convention, a U.S. applicant has twelve (12) months<sup>2</sup> from the date of filing in the U.S. to file any foreign applications and gain the priority date of the U.S. application. If no foreign applications are filed, non-U.S. patent rights are irrevocably lost. This is where the benefit of the PCT system comes into play. An international PCT application, filed within the 12-month window afforded by the Paris Convention, reserves an applicant's right to pursue the grant of the application in any PCT contracting state for an additional eighteen (18) months. In other words, the applicant has thirty (30) months from the date of first filing (instead of twelve) to decide in which national (or regional) patent Office to advance prosecution.

The time limits imposed by the PCT are stringent, and only limited exceptions exist to the 30-month deadline across the 150+ contracting state members. For example, the European Patent Office<sup>3</sup> (EPO) and certain individual countries afford the applicant thirty-one (31) months from the date of first filing, and Bosnia and Herzegovina afford the applicant thirty-four (34) months from the date of first filing.

While 2.5 years (or more) may provide an applicant with ample time to decide where and whether to pursue national or regional phase applications, it also allows plenty of time for intervening events that can result in an unintentional delay entering the PCT national phase. Sometimes, an applicant entity is sold to another entity, and the new owner may wish to pursue PCT national phase applications in patent Offices not considered by the original applicant. Other times, dates are docketed, but misunderstood or simply lost in the shuffle of everyday business life.

In these situations, all hope is not necessarily lost. While all PCT contracting states abide by the 30-, 31- or 34-month rule, some allow for a grace period in which the international PCT application can be reinstated or revived to allow for filing of the national phase application. Unsurprisingly, the following examples, representing five of the top six Offices receiving PCT national phase entries in 2019<sup>4</sup>, may prove of interest to both foreign- and U.S.-origin PCT applicants:

**U.S.** - The United States Patent and Trademark Office (USPTO) received 24.3% of all PCT national phase entries in 2019, and is one of the most lenient of the 150+ contracting states. In the U.S., the deadline for filing a national stage application is thirty (30) months from the date of priority. After this deadline, the international PCT application is deemed abandoned, and an applicant must petition the USPTO for revival. If the entire delay in filing the national stage application was unintentional, an applicant may pay a fee and file a petition to revive the international PCT application. Even then, however, revival is not guaranteed, as the Office of Petitions may still deny the petition for revival.

**EPO** - The EPO received 15.7% of all PCT national phase entries in 2019. The deadline for filing a regional stage application in the EPO is thirty-one (31) months. After the 31st month has passed, the EPO will notify the applicant of the loss of rights due to a failure to meet the requirements of entering the European phase. The applicant then has a period of two months from the date of the notification in which to request "further processing" and to supply all necessary application papers. A surcharge to the EPO is also necessary.

If the time limit for requesting further processing has also expired, the applicant may request a "re-establishment of rights." However, this request is granted at the discretion of the EPO, and the applicant must establish that the application was not filed, despite "all due care<sup>5</sup> required by the circumstances having been taken."<sup>6</sup> The deadline for filing the request for re-establishment of rights under Article 122 EPC is the earlier of (a) two (2) months from the "removal of the cause of non-compliance"<sup>7</sup> or (b) twelve (12) months from expiration of the "further processing" time period. An associated fee must also be paid.

**CHINA** - With 13.2%, the China National Intellectual Property Administration (CNIPA) received the third highest number of PCT national phase entries in 2019. In China, the deadline for filing a national stage application is thirty (30) months from the date of priority. Again, after this deadline, the international PCT application is deemed abandoned. However, the 30-month time limit may be extended by two months, provided the applicant pays the prescribed fee.

**JAPAN** - The Japan Patent Office (JPO) received 9.9% of all PCT national phase entries in 2019. The deadline for filing a national stage application in Japan is thirty (30) months. While no grace period *per se* exists in Japan, Japanese translations are required with every application not provided in Japanese, and the JPO allows an additional two (2) months from filing the national stage application in which to supply the necessary translation.

**CANADA** - With 4.2%, the Canadian Intellectual Property Office (CIPO) received the sixth highest number of PCT national phase entries in 2019. While the deadline for filing a PCT national phase application in Canada is thirty (30) months, the Canadian government modified its patent rules in 2019, and restricted its formerly very forgiving grace period. The Patent Rules now require the applicant, within twelve (12) months of the expiration of the 30-month deadline, to submit a request for reinstatement of rights and a statement that the failure to meet the deadline was unintentional. A reinstatement fee must also be submitted, giving the applicant a maximum of forty-two (42) months from the priority date to complete the national phase application.

It is important to remember that the examples provided above are exceptions to the generally stringent timing rules provided in prosecuting patents both at home and abroad. If you or your company are considering filing overseas, it is highly recommended to consult with a patent attorney as to the applicable time limit for filing your national stage cases. If you have questions in this regard, we welcome the opportunity to help you secure any foreign patent protection you might need.

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<sup>1</sup> [https://www.wipo.int/pct/en/pct\\_contracting\\_states.html](https://www.wipo.int/pct/en/pct_contracting_states.html)

<sup>2</sup> The one (1) year period applies to utility patent applications. For design patents and trademarks, the time period for filing non-U.S. applications is six (6) months.

<sup>3</sup> The EPO may be designated or elected as a regional Office in any PCT patent application to allow for streamlined examination of a patent application which, if granted, can then be validated in all member countries of the EPC. Those countries currently include Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, Netherlands, Republic of North Macedonia, Norway, Poland, Portugal, Romania, Serbia, San Marino, Slovak Republic, Slovenia, Spain, Sweden, Switzerland, Turkey, and United Kingdom.

<sup>4</sup> [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_901\\_2021.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_901_2021.pdf)

<sup>5</sup> EPO Guidelines for Examination, E-VIII, 3.2.

<sup>6</sup> Article 122(1) EPC.

<sup>7</sup> With respect to late European regional phase entry, the date of "removal of the cause of non-compliance" is determined on the individual facts of each case, and is often considered to be the date on which it was discovered that the PCT application had not been timely brought into the European regional phase. As such, the applicant should provide evidence to the EPO illustrating the date on which the error was discovered, to show the request for re-establishment of rights was timely filed.

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