



PCT Prosecution: Delaying National/Regional Phase Entry

Delaying national or regional phase entry can be useful for a number of reasons. More time may be needed to raise funds before paying the fees associated with regional/national phase entry. Or you might want to judge the potential success of the invention before proceeding with national or regional phase entry.

The deadline for UK or European entry of an international (PCT) application can sometimes be delayed beyond the normal 31 month time limit via the EPO or UKIPO. Delayed entry can also be achieved under the PCT by abandoning a priority claim, although this route has significant associated risk.

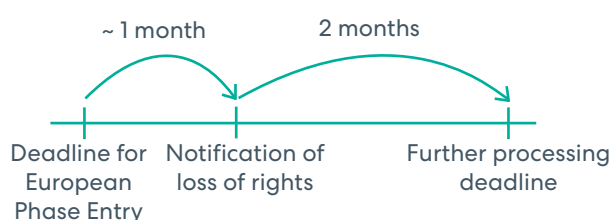
Via the EPO

Further processing

The deadline for entry into the European phase is 31 months from the priority date.

Further processing can be used to effectively delay European phase entry by two to three months, but it does incur high fees. Further processing can only be used after the 31 month deadline has expired.

After this deadline has been missed, the EPO will notify the applicant of the loss of rights due to the failure to meet the requirements to enter the European phase. The applicant can then use further processing to enter the European regional phase within two months of this notification. To do this, the applicant must complete the acts required to enter the European regional phase (including paying any unpaid fees) and pay further processing fees within the 2 month period.



This can be expensive, since there are various acts which must be performed to enter the European phase and the further processing fee must be paid for each missed act/fee.

Renewal Fee Grace Period

The renewal fee grace period provides the opportunity to delay payment of any EPO renewal fees that are due before or on entry to the European phase. EPO renewal fees are due in respect of the third year from the filing date and each year thereafter. Renewal fees in respect of the coming year are due on the last day of the month containing the anniversary of the filing date. If any renewal fee has fallen due during the 31 month period, this can be paid by the *deferred due date* which is the expiry of the 31 month time limit. However, if additional time is needed, the renewal fee can instead be paid during a 6 month grace period along with an additional fee.

Via the UKIPO

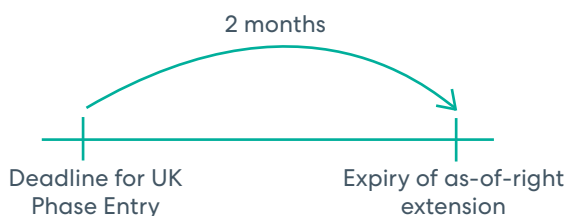


To enter the UK phase, the national fee must be paid and (if the international application is not in English) a translation of the international application into English must be filed within 31 months from the priority date.

An as-of-right two months extension of the 31 month deadline is available. This must be requested and accompanied by a fee before that 2 month extension window has expired. This can be used to effectively delay national phase entry to up to 33 months from the priority date.

In principle, further extensions of two months are possible. However, these further extensions are at the Comptroller's discretion and should not be relied upon. Each extension must be requested before the end of the 2 month extension period sought and accompanied by a fee.

Via a priority claim



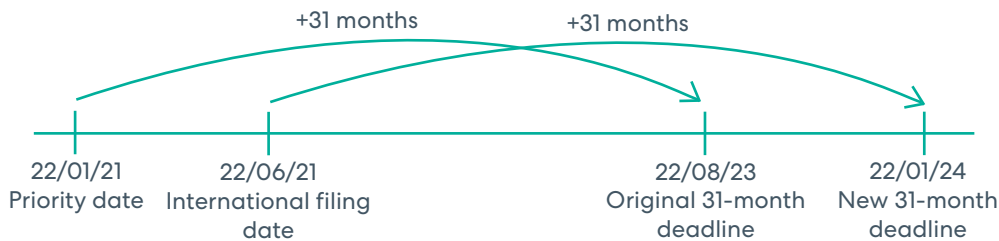
One "last resort" option to delay national/regional phase entry is abandonment of a priority claim. This is rarely advisable since additional prior art may become relevant as a result of changing the priority date of the application. However, it can, in some situations, provide a considerable extension to the deadline to enter the national/regional phase.

Under the PCT, a priority claim in an international application may be abandoned or changed

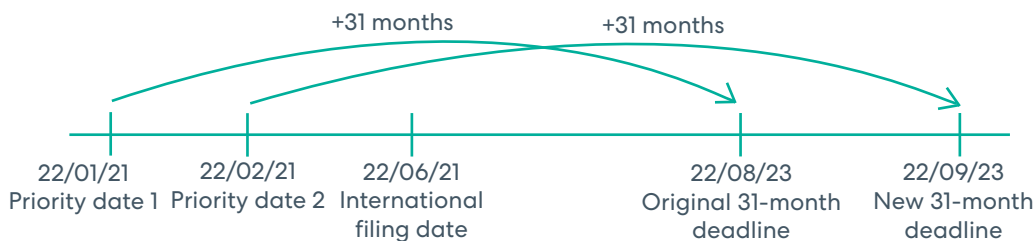
within the earlier of:

- i. 16 months from the earliest priority date; and
 - ii. 6 months from the earliest priority date as so changed,
- but no later than four months after the international filing date.

By abandoning the earliest priority claim, any time limit calculated from the earliest priority date (which includes the regional/national phase entry deadline) that has not yet expired will instead be calculated from the priority date as changed.



For example, an international application with an international filing date of 22 June 2021 has one priority claim which gives a priority date of 22 January 2021. If this priority claim is abandoned as described above, then the regional and national phase entry deadlines are calculated from the international filing date of 22 June 2021 rather than the priority date of 22 January 2021. Therefore, the deadlines are effectively extended by 5 months.



As another example, an international application with an international filing date of 22 June 2021 claims priority from two applications dated 22 February 2021 and 22 January 2021, respectively. If the earliest priority claim (22 January 2021) is abandoned as described above, then the national and regional phase entry deadlines will be calculated from the priority date of 22 February 2021 rather than 22 January 2021. Therefore, the deadlines are effectively extended by 1 month.

Abandoning a priority claim is of course a “last resort” as additional prior art may be relevant as a result of changing the priority date of the application.

Any of the above strategies can also be used to extend the deadline for national/regional phase entry if the deadline has been missed accidentally – i.e. after the deadline has already expired.

We are ready to help and to advise on any missed deadlines or the possibility of delaying deadlines.

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact hk@hik-ip.com or your usual Haseltine Lake Kempner advisor.