

How to Prevent Costly Errors with PCT National Phase Deadlines

One of the costliest patent docketing errors that can occur is missing a Patent Cooperation Treaty (PCT) National Phase deadline. A PCT National Phase deadline refers to the time limit within which an applicant must enter the national phase for a PCT application in a designated country. This deadline is unforgiving because it is impossible to get an extension for filing a PCT National Phase application in most countries. Missing a PCT National Phase deadline can cause permanent loss of foreign rights which can be extremely costly.

It is critical to correctly docket a deadline for filing PCT National Phase applications. The PCT National Phase deadline is calculated from the earliest priority date of the PCT application. For most countries, the PCT National Phase deadline is 30 or 31 months from the earliest priority date. For example, the PCT National Phase deadline is 30 months from the earliest priority date in countries like Brazil, Israel, Japan, Mexico, Thailand, and the United States. The deadline is 31 months from the earliest priority date in other countries like Australia, European Patent Office, India, Republic of Korea, and South Africa. A list of all PCT member countries and their associated time limits for filing National Phase applications can be found on the WIPO website (http://www.wipo.int/pct/en/texts/time_limits.html).

One of the most common reasons for missing a PCT National Phase deadline is an incorrect priority date entered in the docketing system. Many IP docketing systems automatically calculate the PCT National Phase deadline from the priority date in the system. If the priority date is entered incorrectly, the docketing system will calculate an incorrect PCT National Phase deadline which can lead to a costly error if the calculated deadline is later than the actual PCT National Phase deadline.

To avoid this mistake, it is important to implement a process for verifying all priority dates when they are entered in the docketing system. The priority dates can be verified by checking them against the original application documents, manually looking them up in a public database such as the USPTO's Patent Center, or electronically auditing them individually or in a batch process. It is important to note that correcting a priority date in a docketing system does not always recalculate the PCT National Phase deadline though. Some docketing systems are not designed to automatically update the PCT National Phase deadline in response to a change made to the priority date. Therefore, it is always best to verify the PCT National Phase deadline after changing the priority date in the docketing system to make sure the correct PCT National Phase deadline has been recalculated.

In conclusion, missing a PCT National Phase deadline can be a costly error, but the risk can be significantly reduced by verifying priority dates when they are entered into the docketing system and rechecking the PCT National Phase deadline after any changes are made to a priority date. For more information, watch this webinar on "Deadly Mistakes: Missing Paris

Convention and PCT National Phase Foreign Filing Deadlines and How to Avoid Them” on the Black Hills IP website.