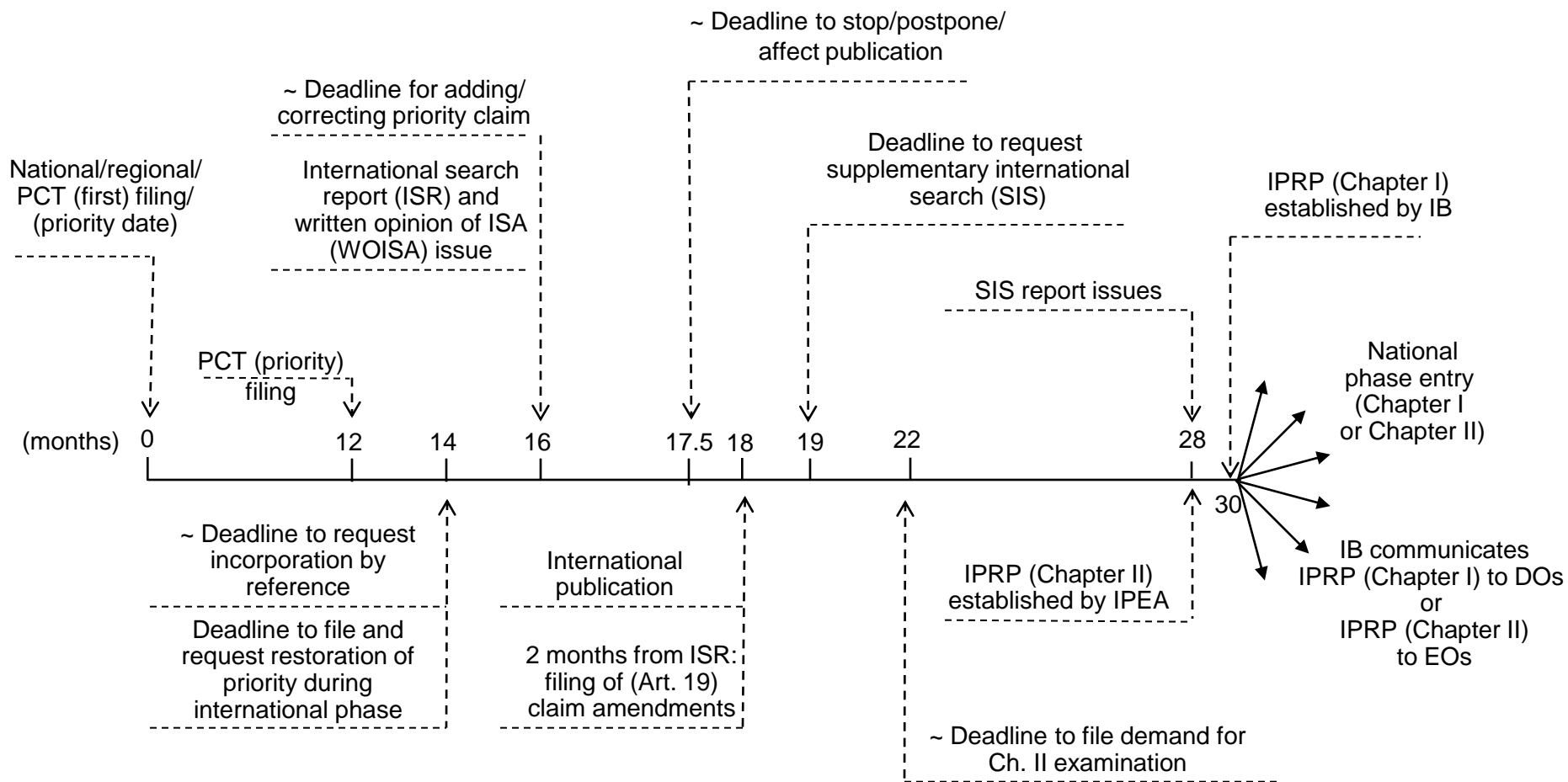




The International Phase: One User's Perspective

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Key Decision Points in the PCT System



Decisions Before Filing

- Is filing under the PCT right for my application?
- How should the first application be filed?

Is Filing under the PCT Right for my Application?

Cost v. Benefits: Advantages of PCT Filing

- Additional time to make final “filing” decisions and get information, licensees, capital, partners, etc.
- Hold geographic “filing” options open for a longer time
- Global publicity for invention via PCT publication
 - Ability to indicate invention is “available for licensing”
- Ease of filing – many States, one application
 - Online access to application file before publication via ePCT (private services)
- A search report with a written opinion by the search examiner plus an option to request supplementary searches
- The opportunity to advance prosecution in most PCT States with effort of a single official action response
- Possible use of PPH in States accepting PCT examination results for entry to their PPH

How Should the First Application be Filed?

■ Via the PCT:

- ❑ Pros: Search report and written opinion available 9 months after filing
- ❑ Cons: Patent term in all PCT States begins on the date of first (PCT) filing (this may only be of concern for some inventions)

■ Via a regular national/regional application:

- ❑ Pros: Patent term begins on the international filing date (~12 months after the priority filing) in all but the first filed country
- ❑ Cons: Priority filing decisions made without the benefit of the ISR/WOISA

■ Via a provisional application (in countries having provisional patent applications):

- ❑ Pros: Low filing fee; filing date may not start the patent term
- ❑ Cons: Provisional applications are not searched or examined; may require a translation into the local language*

* In the US, provisional patent applications may be filed in any language

Decisions when Preparing to File

Choice of Receiving Office

- Filing options available (electronic filing, fax, mail, etc.)
- Availability of priority document via PCT Request form
- National security considerations
- Availability of, and criterion used for, restoration of the right of priority
- Hours of operation and time zone differences
- Amount of transmittal fee
- Choice of International Searching Authority
- Language(s) accepted by the RO

Decisions when Preparing to File

Choice of International Searching Authority

(When filing in a receiving Office offering a choice)

- Initial cost
- Desire for search by other than office of priority filing
- Most case-strategic ISA to issue the written opinion
- Limitations on selection of the IPEA
- Available Supplementary International Searching Authorities
- Potential reduced national/regional search fees
- Potential effect on national/regional phase entry strategy
- Personal preference
- Effect on the use of the PCT-PPH

□ http://www.wipo.int/pct/en/filing/pct_pph.html

Other Decisions when Preparing to File

- Decision to e-file* or file on paper
- Decision on using PCT Rule 4.17 declarations
- Determination if DE, JP or KR must be “un-designated”
- Decisions on filing in non-PCT member States
- Decision on re-filing the priority application
- Decision on format of the Request Form

* Electronic filing of applications is available and preferred in many patent offices and in the RO/IB via PCT-SAFE. Electronic filing in the RO/IB via ePCT, a web-based system, is expected to be available in the near future

Important Deadlines at ~Month 14

- Approximate deadline for submission of a request to incorporate material contained in the priority document into the international application
- Deadline for filing a request to restore the priority right during the international phase
- These procedures are not available through all receiving Offices; see <http://www.wipo.int/pct/en/texts/restoration.html> for more details

Important Events at ~Month 16

- Final date for adding or correcting priority claims passes ~4 months after filing
 - additional time may be available in some circumstances, e.g., where the international application was filed less than one year after the earliest priority date or when correcting a claim
- International Search Report and Written Opinion of the ISA are scheduled to issue*

* The ISR and WOISA are to be issued three months after the receipt of the search copy by the ISA, which is at about four months after filing because it takes the RO ~ one month to complete the formalities review and forward the search copy of the application to the ISA

Considerations at ~Month 16

- Continue to assess patentability in light of ISR and WOISA
- Determine if there is a need to amend the claims under PCT Article 19 for publication
- Begin to consider the value of:
 - a Supplementary International Search
 - responding to the written opinion of the ISA
 - formally by filing a demand under Chapter II accompanied by arguments or
 - informally by filing informal comments with the IB

Important Deadline at ~Month 17½

Stopping or Delaying Publication

■ Applicant can:

- stop publication by withdrawing the application or
- delay publication by withdrawing a priority claim

by filing a notice of withdrawal - provided that such notice reaches the IB before completion of technical preparations for publication*

■ The notice must be signed by all the applicants where powers of attorney have not been filed or do not accompany the notice

- the notice can be conditional on being able to stop publication

■ Best practice:

- submit a withdrawal action in ePCT
- work with the PCT processing team
- remember pending publications/laying-open in countries where direct national filings were made

* 15 days before scheduled publication

Important Event at Month 18

International Publication

■ Upon publication:

- the full disclosure becomes prior art worldwide
- provisional protection may begin in some countries

Deadline at Month 19

Supplementary International Search

- A request for Supplementary International Search must be filed with the IB by Month 19
- Applicants should carefully consider the cost versus the benefit of requesting a supplementary search in light of:
 - ❑ the needs of the applicant
 - ❑ the SISAs available to conduct the SIS
 - ❑ the timing of the issuance of the SIS report
 - ❑ the sufficiency of the main search
 - ❑ the information available through other searches by national and regional patent offices, commercial search services and applicant's own search efforts

Important Deadline at Month 22

International Preliminary Examination

- The deadline for filing a demand for international preliminary examination is the later of:
 - ❑ 22 month from the priority date or
 - ❑ three months from the date of transmittal of the ISR/WOISA
- Filing a demand gives the applicant:
 - ❑ an opportunity to formally rebut the findings in the WOISA
 - ❑ an opportunity to amend the description, claims and drawings in the international application
 - ❑ an International Preliminary Report on Patentability (Chapter II) that considers the applicant's arguments and amendments which were submitted

Is International Preliminary Examination Advantageous?

- Should the examiner's findings in the Written Opinion be rebutted during the international phase?
 - formally by filing a demand under Chapter II accompanied by arguments or
 - informally by filing informal comments with the IB
- Is there a need to amend under PCT Article 34?
- Do the advantages of receiving a more favorable IPRP justify the cost of a formal Chapter II response?
- Is the use of the PPH in countries accepting positive PCT examination results for Highway entry advantageous?

Is International Preliminary Examination Advantageous?

- Do the advantages of having a more favorable IPRP justify the cost of a formal Chapter II response?
 - if the EPO establishes a favorable IPRP for novelty, inventive step and industrial applicability, rapid acceptance can be obtained via accelerated exam*
 - if the US establishes a favorable IPRP for novelty, inventive step and industrial applicability:
 - search and examination fees payable in the US at the national stage are reduced to \$0
 - the US national stage application will be picked up for examination “out of turn”*
 - acceptance without further official action in many foreign countries is based on a favorable IPRP
 - a favorable IPRP may allow use of the PPH

* For the claims presented during the international phase

Considerations at ~ Month 28

■ Chapter I processing only:

- Assess the chances of obtaining meaningful patent protection based on all the information available and determine if an informal response to the WOISA should be filed

■ Chapter I and II processing:

- Assess chances of obtaining meaningful patent protection based on the IPRP and all other information available

■ In all situations:

- Consider filing preliminary amendments and/or arguments in the national/regional Office upon entry into the national phase to address negative findings in the IPRP and to reduce national claim fees

National Phase Entry – Month 30

- Where should national phase entry be made?
- Reconsider continuing prosecution in non-PCT countries

Pre-National Phase Entry Practice Tip (1)

- Prior to entering the national/regional phase the best practice is to conduct a final review of your international application file as well as the contents of the electronic file at WIPO via PATENTSCOPE or ePCT. In particular check to be sure these papers are in the files and correct:
 - International publication – check all data in the publication and verify title, applicants, inventors, priority claims, description, claims, drawings, sequence listings, etc. are correct
 - IB/308 – this is your assurance that a copy of the international application is available to all national Offices from the IB

Pre-National Phase Entry Practice Tip (2)

- ❑ IB/304 – every priority claim should be listed on an IB/304 indicating the IB has received a certified copy of the priority document file; if any are missing, take corrective action with the IB or supply the document to the national office upon national phase entry
- ❑ IB/306 – if any changes have been made to the international application under PCT Rule 92*bis*, ensure each change has been entered and verified by issuance of an IB/306
- ❑ Other file entries – examine every other entry in the IB file for accuracy and completeness; this is the starting basis for the national file in every country where you enter the national phase



Thank You