

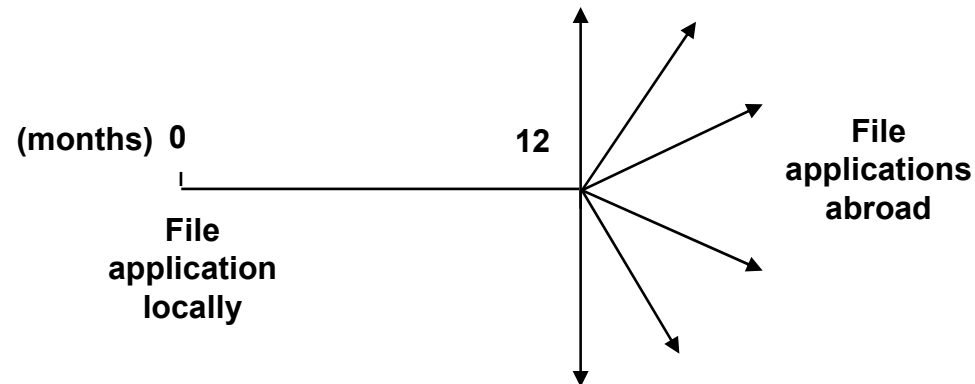


# **Strategic Use of the PCT**

**A Discussion from the User's Perspective**

**October 8, 2008**

# Traditional patent systems



**Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:**

- multiple formality requirements
- multiple searches
- multiple publications
- multiple examinations and prosecutions of applications
- translations and national fees required at 12 months

# PCT system

**Local patent application followed within 12 months by international application under the PCT, claiming Paris Convention priority, with “national phase” commencing at 30 months\*:**

- **one set of formality requirements**
- **international search**
- **international publication**
- **international preliminary examination**
- **international application can be put in order before national phase**
- **translations and national fees required at 30 months\*, and only if applicant wishes to proceed**

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**\*A few States (Luxembourg, Tanzania and Uganda) continue to apply a 20-month time limit where no demand for international preliminary examination has been filed before the expiration of 19 months from the priority date (for a complete list of time limits, see “Time Limits for Entering National/Regional Phase on the PCT Resources page at [www.wipo.int/pct/en](http://www.wipo.int/pct/en))**

# **General remarks on the PCT system (1)**

- **The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT patent”**
- **The PCT system provides for**
  - **an international phase comprising:**
    - **filing of the international application**
    - **international search and written opinion of the ISA**
    - **international publication and**
    - **international preliminary examination**
  - **a national/regional phase before designated Offices**
- **The decision on granting patents is taken exclusively by national or regional Offices in the national phase**

## **General remarks on the PCT system (2)**

- **Only inventions may be protected via the PCT by applying for patents, utility models and similar titles**
- **Design and trademark protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively)**
- **The PCT is administered by WIPO as are other international treaties in the field of industrial property, such as the Paris Convention**

# PCT Contracting States (139)

*States designated for regional and national protection except where otherwise indicated*

<u>AP ARIPO Patent (14)</u>		<u>EA Eurasian Patent (9)</u>		<u>EP European Patent (34)</u>		<u>OA OAPI Patent (15)</u>			
BW	Botswana	AM	Armenia	AT	Austria	♦	BF	Burkina Faso	
GH	Ghana	AZ	Azerbaijan	♦	BE	Belgium	♦	BJ	Benin
GM	Gambia	BY	Belarus		BG	Bulgaria	♦	CF	Central African Republic
KE	Kenya	KG	Kyrgyzstan		CH	Switzerland		CG	Congo
LS	Lesotho	KZ	Kazakhstan	♦	CY	Cyprus	♦	CI	Côte d'Ivoire
MW	Malawi	MD	Republic of Moldova		CZ	Czech Republic	♦	CM	Cameroon
MZ	Mozambique	RU	Russian Federation		DE	Germany	♦	GA	Gabon
NA	Namibia	TJ	Tajikistan		DK	Denmark	♦	GN	Guinea
SD	Sudan	TM	Turkmenistan		EE	Estonia	♦	GQ	Equatorial Guinea
♦	SL				ES	Spain	♦	GW	Guinea-Bissau
	SZ				FI	Finland	♦	ML	Mali
	TZ			♦	FR	France	♦	MR	Mauritania
	UG				GB	United Kingdom	♦	NE	Niger
	ZM			♦	GR	Greece	♦	SN	Senegal
	ZW				HR	Croatia	♦	TD	Chad
				♦	HU	Hungary	♦	TG	Togo
					IE	Ireland			
				♦	IS	Iceland			
					IT	Italy			
					LI	Liechtenstein			
					LT	Lithuania			
					LU	Luxembourg			
				♦	LV	Latvia			
				♦	MC	Monaco			
				♦	MT	Malta			
				♦	NL	Netherlands			
					NO	Norway			
					PL	Poland			
					PT	Portugal			
					RO	Romania			
					SE	Sweden			
				♦	SI	Slovenia			
					SK	Slovakia			
					TR	Turkey			

♦ Regional patent only

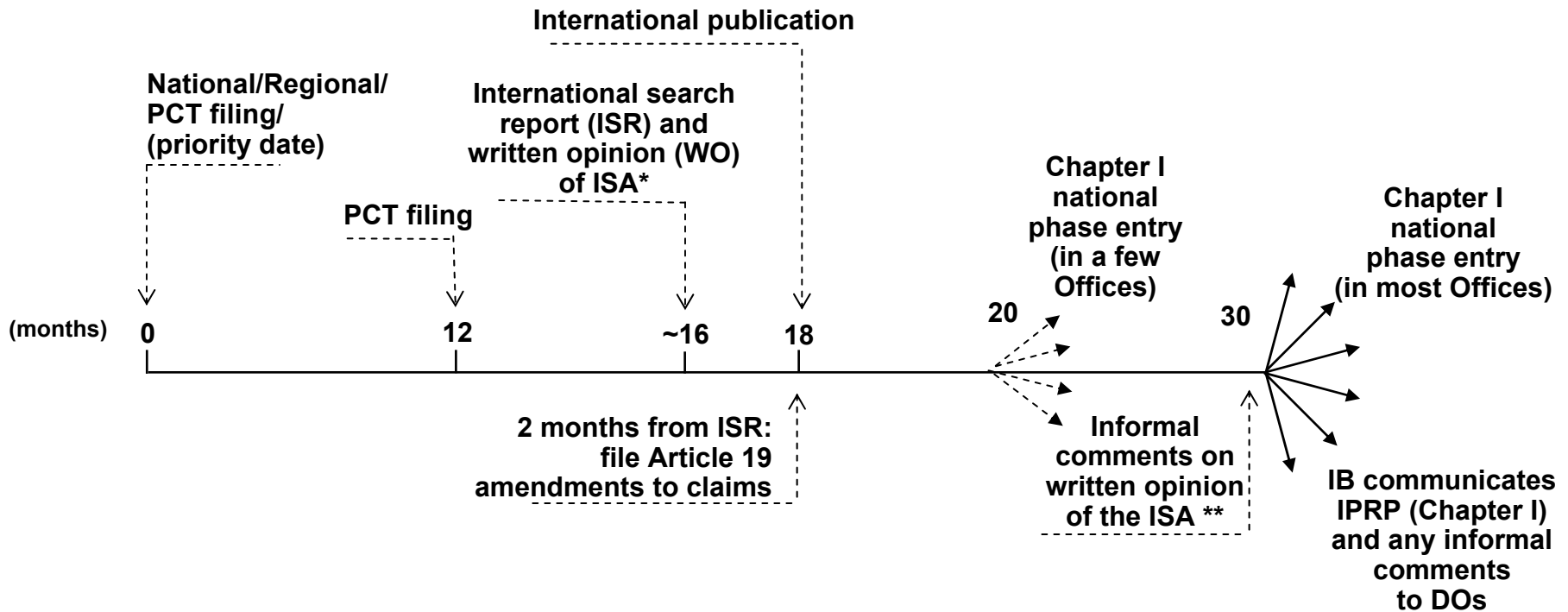
# PCT Contracting States (139) (continued)

*States designated for national protection only except where otherwise indicated*

AE	United Arab Emirates	HN	Honduras	MY	Malaysia
AG	Antigua and Barbuda	ID	Indonesia	NG	Nigeria
✧ AL	Albania	IL	Israel	NI	Nicaragua
AO	Angola	IN	India	NZ	New Zealand
AU	Australia	JP	Japan	OM	Oman
✧ BA	Bosnia and Herzegovina	KM	Union of the Comoros	PG	Papua New Guinea
BB	Barbados	KN	Saint Kitts and Nevis	PH	Philippines
BH	Bahrain	KP	Democratic People's Republic of Korea	✧ RS	Serbia
BR	Brazil			SC	Seychelles
BZ	Belize	KR	Republic of Korea	SG	Singapore
CA	Canada	LA	Lao People's Democratic Republic	SM	San Marino
CN	China	LC	Saint Lucia	SV	El Salvador
CO	Colombia	LK	Sri Lanka	SY	Syrian Arab Republic
CR	Costa Rica	LR	Liberia	ST	São Tomé & Príncipe (as of 3 July 08)
CU	Cuba	LY	Libyan Arab Jamahiriya	TN	Tunisia
DM	Dominica	MA	Morocco	TT	Trinidad and Tobago
DO	Dominican Republic	ME	Montenegro	UA	Ukraine
DZ	Algeria	MG	Madagascar	US	United States of America
EC	Ecuador	✧ MK	The former Yugoslav Republic of Macedonia	UZ	Uzbekistan
EG	Egypt			VC	Saint Vincent and the Grenadines
GD	Grenada	MN	Mongolia	VN	Viet Nam
GE	Georgia	MX	Mexico	ZA	South Africa
GT	Guatemala				

✧ Extension of European patent possible

# PCT TIMELINE - Chapter I only

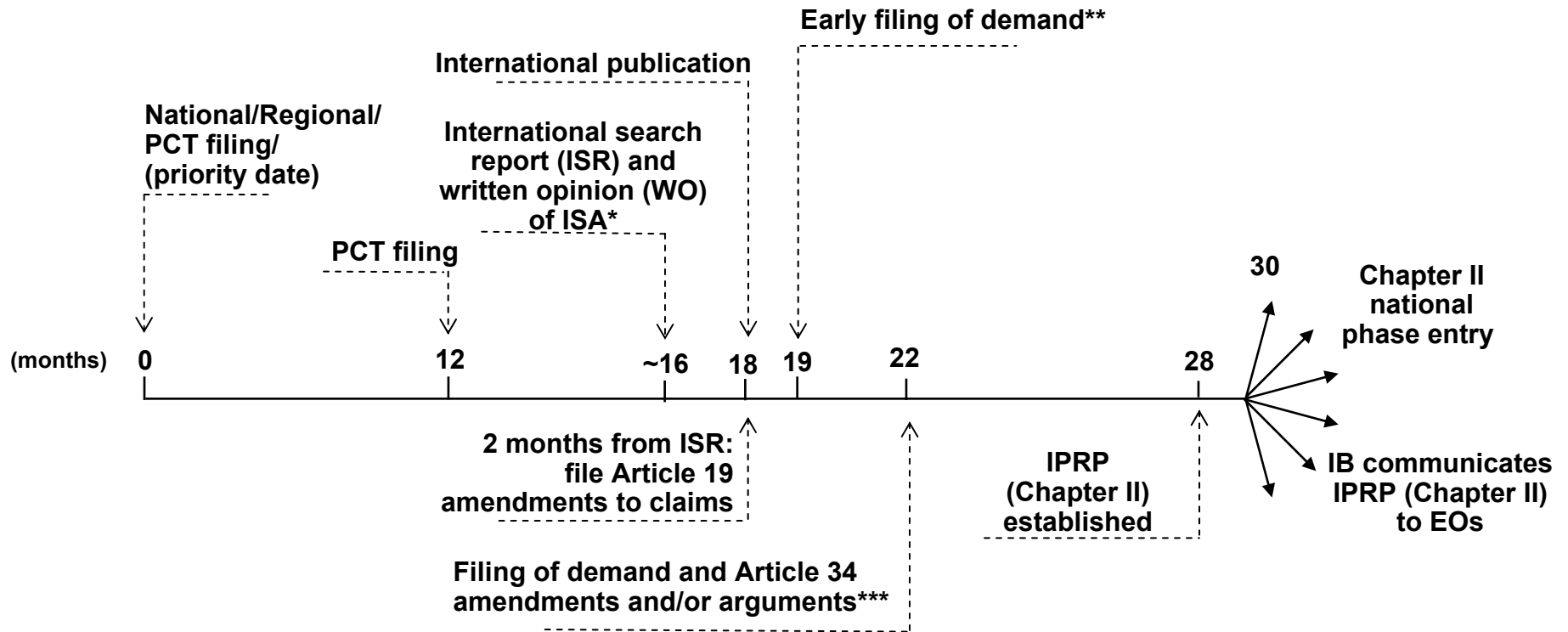


\* If PCT is a first filing, the ISA is to establish the ISR and WO of the ISA before the expiration of 9 months from the priority date (Rule 42.1)

\*\* Informal comment on the written opinion of the ISA may be submitted to the IB up until 30 months from the priority date



## PCT TIMELINE - Chapter II

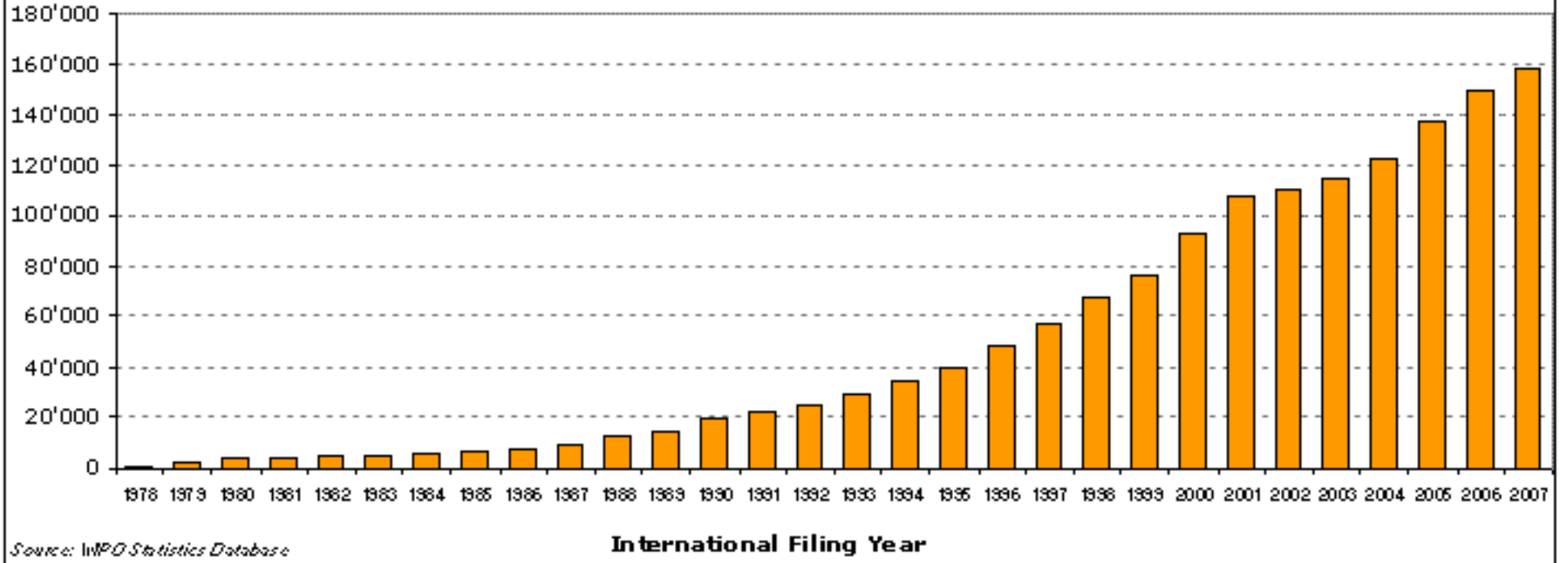


\* If PCT is a first filing, the ISA will establish the ISR and WO of the ISA before the expiration of 9 months from the priority date (Rule 42.1)

\*\* In respect of a few States (Luxembourg, Tanzania and Uganda), the time limit of 30 months to enter national phase will, however, only apply if those States have been elected in a demand filed before the expiration of 19 months from the priority date (for a complete list of time limits, see “Time Limits for Entering National/Regional Phase on the PCT Resources page at [www.wipo.int/pct/en](http://www.wipo.int/pct/en))

\*\*\* A demand for international preliminary examination may be filed at any time prior to the expiration of 3 months from the date of transmittal of the ISR and WO of the ISA, or 22 months from the priority date, whichever time limit expires later (Rule 54bis.1(a)).

**PCT International Application Filing Trends**





Is the PCT right for my application?

## **Cost vs. Benefits**

- **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**
- **Ease of filing -- many states, one application**
- **A single search report and considered examination report plus the opportunity to advance prosecution in many states with effort of a single action response**



Should I use the PCT for filing  
in all PCT member states?

- **In general, using the PCT to make the filings in all PCT member states is the most efficient, there are strategic exceptions:**
  - ◆ **For US applicants, it may be advantageous to file and prosecute the US application under national practice**
    - **Starts US national prosecution earlier**
    - **May allow PCT (international) processing to proceed with minimal concern for US issues (provided the US national phase is not entered from the US designation)**
  - ◆ **For US applicants, it may be advantageous to file the European equivalent directly under regional practice**
    - **Insures early receipt of EPO search results**
    - **Allows PCT to utilize ISA/KR to get broadest look at prior art**
    - **May reduce overall cost of international filing**



# Strategic Considerations when using the PCT

➤ **When to use the PCT – as the first filing or at the end of the priority year?**

- ◆ **For applications first filed under the PCT (no priority claim):**
  - **ISR & WOISA are due 9 months from filing**
  - **Patent term in all PCT countries begins with the PCT filing date**
  
- ◆ **For applications filed at the end of the priority year:**
  - **ISR & WOISA are due at approximately 16 months, about 4 months from filing**
  - **Patent term starts with the PCT filing at the end of the priority year, one year later than with a PCT first filing**
  - **Opportunity to file improved specification (new matter) in PCT filing**
  - **Possible better idea of what is commercially important**
  - **Additional countries may have joined PCT during priority year**



## ➤ **Selection of Receiving Office**

### ◆ **Receiving Office at the USPTO**

- **Applications receive foreign filing license review**
- **US priority documents easily available and free**
- **Filing date via express mail or e-filing via EFS Web**
- **Choice of US, EP or KR as the International Searching Authority**
- **Only the unintentional criterion will be used for restoration of priority claim and the fee is \$1410**
- **Higher transmittal fee (\$300)**

### ◆ **Receiving Office at the International Bureau**

- **For inventions made in the US, a foreign filing license is needed to comply with US law**
- **Applicant must order and file US priority documents**
- **Filing date via fax and PCT SAFE e-filing**
- **Possible greater choices of ISA**
- **Both criteria for restoration of priority claim; no fee**
- **Lower transmittal fee (\$101)**

## ➤ **Selection of the International Searching Authority**

- ◆ **Overall cost**
  - **ISA/US - \$1800\***
  - **ISA/EP - \$2665**
  - **ISA/KR - \$ 244**
  
- ◆ **Desire for diversified sources of prior art searches**
  
- ◆ **Area of technology**
  
- ◆ **Source of Written Opinion**
  
- ◆ **Desired Int'l. Prelim. Examining Authority (Chapter II only)**
  
- ◆ **Potential of reduced national phase entry costs**

\* Proposed increase to \$2225 published in the June 18, 2008 *Federal Register*

## ➤ **Ability to amend the application**

- ◆ **Amending under Article 19**
  - **Must be made by the later of 2 months from transmittal of ISR or 16 months from the earliest priority date**
  - **Claim amendments ONLY**
  - **Submitted to the IB**
  - **Published with application**
  - **Will not be reviewed by an examiner**
  
- ◆ **Amending under Article 34**
  - **Made during Chapter II process**
  - **Can amend description, claims & drawings**
  - **Not published (but will be public at 30 months)**
  - **Will be reviewed by an examiner**
  
- ◆ **Amending upon national phase entry**
  - **The PCT guarantees at least one opportunity to amend the application, generally within 30 days of entry**
  - **Most national laws allow more opportunities to amend**

## ➤ **Ability to stop or postpone publication**

- ◆ **Publication can be stopped by:**
  - a) **Withdrawing the entire application**
  - b) **With International Bureau**
  - c) **Prior to 15 days before the scheduled date of publication**
  - d) **By filing a notice of withdrawal (Form IB/372) with the signatures of (or power from) all applicants**
  
- ◆ **Publication can be postponed by:**
  - a) **Withdrawing the earliest priority claim**
  - b) **With International Bureau**
  - c) **Prior to 15 days before the scheduled date of publication**
  - d) **By filing a notice of withdrawal (Form IB/372) with the signatures of (or power from) all applicants**

## ➤ **Optional International Preliminary Examination**

◆ **Applicants can file a formal response to the written opinion of the ISA and communicate with the IPEA examiner to help put the application in order for acceptance in relation to novelty, inventive step and industrial applicability by:**

- a) **Filing a demand for IPE within the later of 22 months of priority or 3 from issuance of the ISR**
  - b) **Submitting arguments countering the findings in the written opinion**
  - c) **Submitting any amendments desired (Article 34)**
  - d) **Resulting in issuance of an International Preliminary Report on Patentability – Chapter II of the PCT**
- **The IPRP-Ch. II, an advisory report on (absolute) novelty, inventive step and industrial applicability, is sent to all national offices where the national phase is entered**

## ➤ **Entering the National Phase**

- ◆ **The national phase may be entered and national processing started at any time during the PCT international phase**
- ◆ **The national phase MUST be entered in all countries of interest by 30 months from the earliest priority date (some countries allow extra time)**
- ◆ **Applicants have complete freedom to enter the national phase in as many or as few countries as is commercially justified**
- ◆ **Under the PCT, applicants are guaranteed one opportunity to amend the application (national law may provide for additional opportunities)**

## ➤ **Entering the National Phase**

- ◆ **Upon entering the national phase an applicant should consider submitting preliminary amendments and arguments to overcome any negative findings in the IPRP (Ch. I or Ch. II) as well as amendments to bring the claims into conformance with local practice and reduce any excess claims fees**



Safeguards under the PCT:

Strategic Considerations when  
Things Go Wrong



**The PCT provides built-in safeguards and optional procedures to help insure applicants' submissions are safe and mistakes in filing can be corrected**

- **Applications inadvertently filed with a non-competent Office are date stamped on receipt and forwarded to the IB for processing; the date of filing with the competent Office is taken to be the date of receipt by the non-competent Office**
- **Priority claims can be added or changed up to four months from filing (and longer in some circumstances)**
- **Obvious mistakes in an application may be corrected by a request to the competent authority**
- **Changes in the name of applicants, inventors, agents, common representatives can easily be made via letter/fax**
- **In general, applicant has one month from the relevant filing to pay any fees due, if payment is not made within that period, applicant will be invited to pay a late payment fee**
- **Extensions of time for responding to invitations are usually available and are free of charge**

- **Any PCT deadline that has not expired may be advanced in time by withdrawal of the priority claim (including publication and national phase entry)**
- **In most countries the published PCT text may be used as the basis to correct poor translations**
- **The opportunity to request reinstatement of an application that failed to meet the national deadline for national phase entry**
- **The right to take any negative decision rendered during the international phase before the national offices during the national phase**
- **Within 2 months from filing, parts or elements missing from the application at the time of filing can be added to the application if the missing part or element is entirely contained in the priority document**
- **Priority may be restored for applications filed beyond the end of the priority year and within 14 months of the claimed priority date**



Safeguards under the PCT:

Incorporation by Reference of  
Matter in the Priority Document

# **Missing elements and parts of the international application (Rule 20)**

## **Objective:**

**To enable inclusion of accidentally omitted elements or parts that are contained in priority application without affecting the international filing date**

- element = all of the description or all of the claims**
- part = part of the description, part of claims or part or all of pages of drawings**

## **Conditions:**

- priority application contains the element or part (Rule 26.6(b))**
- request contains statement of (conditional) incorporation by reference (Rule 4.18)**
- timely confirmation of incorporation by reference (Rules 20.6 and 20.7)**

**Competent Authority: RO**

# **Confirmation of incorporation by reference (1) (Rules 20.6 and 20.7)**

**Time limit: 2 months from filing or from invitation to correct  
(Rule 20.7)**

**Documents to be filed (Rule 20.6):**

- notice of confirmation**
- missing sheets**
- copy of earlier application as filed unless priority document already submitted**
- translation if not in language of international application**
- indication as to where in the priority document (and translation) the missing sheets are contained**

# **Confirmation of incorporation by reference (2) (Rules 20.6 and 20.7)**

**If not all requirements for incorporation by reference are fulfilled (for example, if a missing element or part is not entirely contained in the earlier application):**

- the international application is assigned a later filing date (date of receipt of missing element or part),**
- applicant may request that missing part be disregarded (Rule 20.5(e))**

# **Invitation by RO to correct defect under Article 11(1) (Rule 20.3)**

**Where entire description or all claims are missing, the RO invites applicant to either:**

- furnish a correction under Article 11(2) and international application is accorded a later filing date or,**
- confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained**

# **Effect of incorporation by reference in national phase (Rule 82*ter*.1(b))**

**DOs may, to a limited extent, review decision allowing the  
incorporation by reference**

**Declarations of incompatibility with national law (reservations)  
were made by a number of ROs and DOs**

**See WIPO web site at:**

**[http://www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**



# **Incorporation by reference Declarations of incompatibility with national law**

**The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 with its national/regional law:**

**– Incompatibility as RO (Rule 20.8(a)):**

**BE, CU, CZ, DE, ES, HU, ID, IT, JP, KR, MX, PH**

**– Incompatibility as DO (Rule 20.8(b)):**

**CN, CU, CZ, DE, ES, HU, ID, JP, KR, LT, MX, PH, TR**



Safeguards under the PCT:

Restoration of the Priority Right

# **Restoration of the right of priority Competent Authorities (Rules 26*bis*.3 and 49*ter*.2 )**

## **Competent Authorities:**

- RO during the international phase**
- DO during the national phase**

# **Restoration of the right of priority**

## **Applicable criteria**

### **(Rules 26*bis*.3 and Rule 49*ter*.2)**

- **Two possible criteria for restoration:**
  - **failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken**
  - **failure to file the application within the priority period was unintentional**
- **All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law**
  - **RO/IB will apply both criteria**
  - **RO/US will apply ONLY the unintentional criterion**

# **Restoration of the right of priority by the receiving Office (Rule 26*bis*.3)**

## **Conditions:**

- request to restore must be filed with the RO**
- time limit: within a period of 2 months from the date of the expiration of the priority period**
- filing of statement of reasons for failure to comply with the time limit**
- statement should preferably be accompanied by a declaration or other evidence to support such statement**
- where applicable, payment of the required fee**
  - RO/IB charges no fee**
  - RO/US charges \$1410**

# **Restoration of the right of priority: Effects if priority right is not restored by RO (Rule 26*bis*.3)**

- **Any priority claim to an earlier application filed less than 14 months before the international filing date**
  - **will not be declared void even if priority is not restored by the RO**
  - **will serve as a basis to calculate time limits during the international phase**
- **The validity of such a priority claim in the national phase is not assured**

## **Restoration of the right of priority: Effect in the national phase (Rule 49*ter*.1)**

### **Effect of RO restoration in the national phase:**

- RO restoration based on the “due care” criterion is effective in all DOs**
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)**
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible**
- RO refusal to restore is not binding on DOs**

**Declarations of incompatibility with the national law (reservations) were made by a number of ROs and DOs; see the WIPO website at: [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)**

# Restoration of the right of priority

## Reservations made by Offices

The following Offices have notified the International Bureau of the incompatibility of Rule 26*bis*.3(a) to (i), Rule 49*ter*.1(a) to (d) and/or Rule 49*ter*.2(a) to (g) with their national/regional law:

- Incompatibility as RO (Rule 26*bis*.3(j)):  
BE, BR, CO, CU, CZ, DE, DZ, ES, FR, GR, HU, ID, IN, IT, JP,  
KR, NO, PH, PT
- Incompatibility of the effect of decision of RO on DO (Rule 49*ter*.1(g)):  
BR, CA, CN, CO, CU, CZ, DE, DZ, ES, HU, ID, IN, JP, KR, LT,  
MX, NO, PH, PT, TR, US
- Incompatibility as DO (Rule 49*ter*.2(h)):  
BR, CA, CN, CO, CU, CZ, DE, DZ, ES, HU, ID, IN, JP, KR, LT,  
MX, NO, PH, PT, TR, US





# Future PCT Features

# **PCT Changes Approved by the Assembly in 2007**

**(Meeting in Geneva 24<sup>th</sup> September through 3<sup>rd</sup> October, 2007)**

## **Supplementary international search (SIS)**

- **One additional international search in addition to the primary search**
- **Effective on or after 1 January 2009 (when AT, RU, SE and XN intend to offer SIS)**

## **Addition of Brazil and India as ISAs and IPEAs**

- **Effective upon execution of agreements between WIPO and BR/IN**
- **Following this addition there are 15 ISAs/IPEAs in the PCT system**

**Korean and Portuguese added as languages of publication (for applications filed on or after 1 January 2009)**

## **Other approved matters:**

- **The ability to request the use the results of searches by other ISAs and/or national offices when carrying out an international search (Rules 4.12 & 12*bis*) (See new Request form of 1 July 2008)**
- **Allowing ROs to extend the time for payment of any fees required in association with requests for restoration of priority (Rule 26*bis*.3(d))**
- **Clarification that the only sure way of preventing publication of an international application considered is by filing an express withdrawal of the IA with the IB prior to completion of technical preparations for publication.**



Where To Get Help

# **US consultants to WIPO on PCT matters**

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**Website: [www.TDRPatents.com](http://www.TDRPatents.com)**

# Where to get help at the USPTO

USPTO Internet site: <http://www.uspto.gov>

PCT Home page: <http://www.uspto.gov/go/pct>

## PCT Help Desk

- Tel: (571) 272-4300
- Fax: (571) 273-0419
- Hours of operation: 9 AM to 4:30 PM eastern time on days when the federal government is open

**PCT Legal Office – decides petitions filed in international and national phase applications**

- Fax: (571) 273-0459

**PCT Operations – processing section for international and national phase applications**

- Tel: (703) 305-3165
- Fax: (571) 273-3201

**Electronic Business Center – technical assistance with EFS-Web**

- Tel: (866) 217-9197 or (571) 272-4100

# Where to get help at WIPO on PCT-related questions (1)

<b>PCT Infoline</b>	<b>Tel:</b>	<b>41 22 338 83 38</b>
	<b>Fax:</b>	<b>41 22 338 83 39</b>
	<b>email:</b>	<b>pct.infoline@wipo.int</b>
<b>PCT Processing Section 1</b>	<b>Gijsbertus Beijer</b>	<b>41 22 338 94 79</b>
	<b>Fax:</b>	<b>41 22 338 82 70</b>
<b>PCT Receiving and Processing Team</b>	<b>Gijsbertus Beijer</b>	<b>41 22 338 92 22</b>
	<b>Fax</b>	<b>41 22 910 06 10</b>
<b>Order online at</b>	<b>Internet URL:</b>	<b>www.wipo.int.ebookshop</b>
	<b>Email:</b>	<b>publications.mail@wipo.int</b>
<b>WIPO Switchboard</b>	<b>Tel:</b>	<b>41 22 338 91 11</b>
<b>PCT Internet</b>	<b>Internet URL:</b>	<b>www.wipo.int/pct</b>
<b>PCT-SAFE</b>	<b>Internet URL:</b>	<b>www.wipo.int/pct-safe</b>

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