



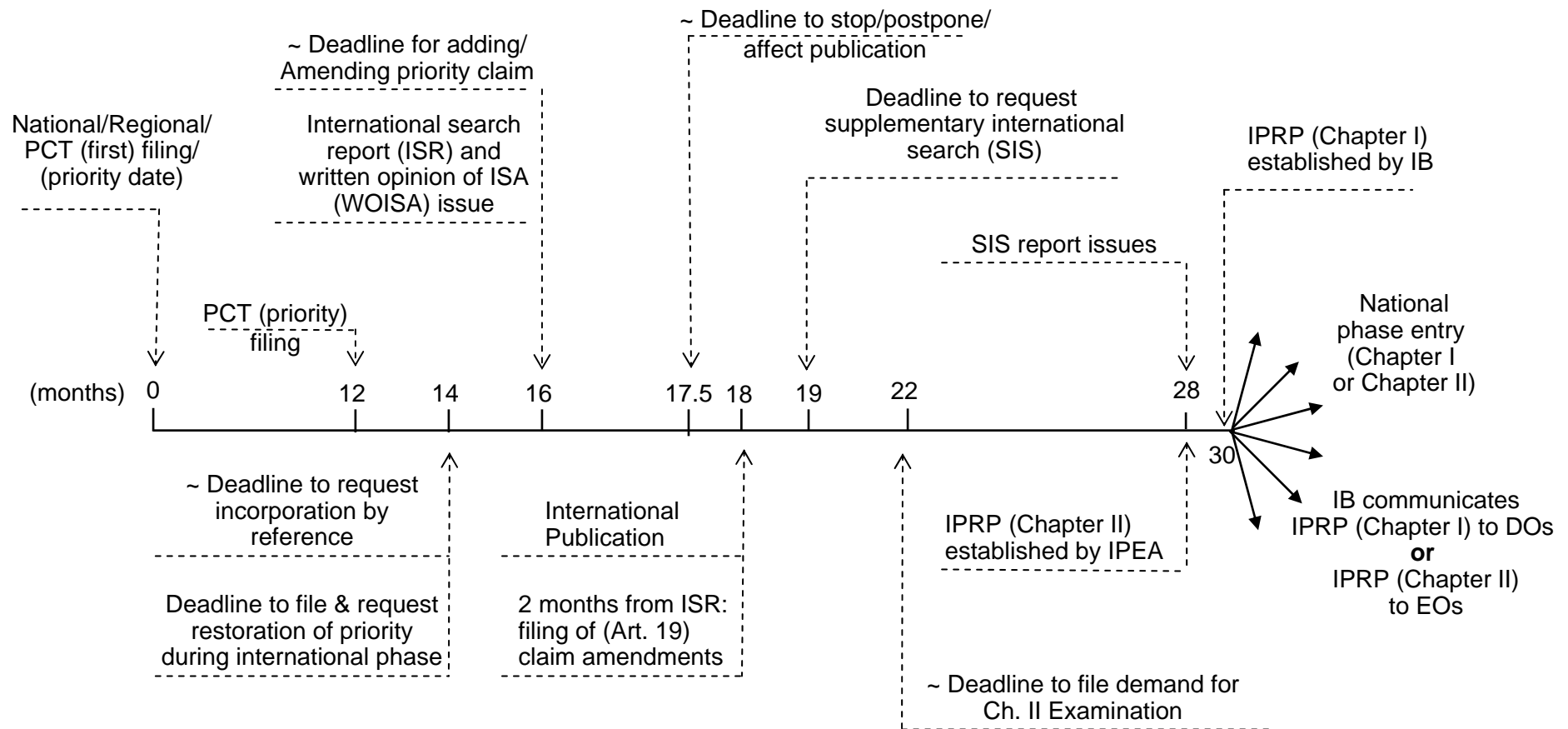
# Strategic Use of the PCT: A US User's Perspective

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This presentation draws upon a wealth of practical filing experience and presents commercially successful filing strategies. They are not, however, necessarily the views of WIPO.

# Key Decision Points in the PCT System



# Initial Strategic Case Decisions

- 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
- Ease of filing - many states, one application
- A single search report and opinion on patentability plus an option to request supplementary searches
- Option to request international preliminary examination
- The opportunity to advance prosecution in many states with effort of a single official action response
- Possible use of PPH in states accepting positive PCT reports 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
- Via a US provisional application:
  - Pros: Low filing fee; filing date does not start the patent term in US
  - Cons: Provisional applications are not searched or examined
- Via a regular national/regional application:
  - Pros: Patent term begins with 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

# Choice of the Receiving Office

- National security considerations
- Criterion used for restoration of priority claim
- International Searching Authorities available

# Choice of International Searching Authority

(When filing in a receiving Office offering a choice)

- Initial cost
- Area of technology
- Desire for more diversified (broader) search
- Source of WOISA
- 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 availability of PCT/PPH

# Early National Phase Entry

- Applicant can enter the national phase at any time after filing
- Early national phase entry can be made in different Offices at different times
- Early national processing can only begin at the specific request of the applicant
- Once national phase processing has commenced in a country, the national phase application is not affected by:
  - Withdrawal of the international application
  - Withdrawal of priority claim in the international application
- If the national phase is entered before publication, a copy of the international application must be provided to the designated Office
- No national or regional Office can require entry before 30 months from priority



# After receipt of the International Search Report and Written Opinion (1)

- The first substantive information an applicant receives during the international phase is the ISR and WOISA
- Following analysis of the information in the ISR and WOISA an applicant may take one or more actions:
  - File amendments to the claims under Article 19
    - Must be filed with the IB within 2 months of mailing of ISR
    - Must include a complete set of claims in replacement of the claims originally filed
    - Must be accompanied by a letter indicating the basis for the amendments in the application as filed
    - Amendments will be published along with originally filed claims

# After receipt of the International Search Report and Written Opinion (2)

- Postpone or suspend publication
  - Postpone publication by withdrawing priority claims
  - Suspend publication by withdrawing the application
  - Must be done before completion of technical preparations for publication

# After receipt of the International Search Report and Written Opinion (3)

- File a demand for international preliminary examination
  - Deadline for filing a demand is the later of 22 months from priority or 3 months from mailing of the ISR
  - Filing a demand early and requesting examination to start early maximizes the time available for the examination process
  - Allows the opportunity to rebut negative findings in the WOISA
  - Allows amendment of description, claims and drawings under Article 34
  - Provides an option for an oral interview with the IPEA examiner
  - Provides a final report (IPRP) considering your arguments and amendments

# After receipt of the International Search Report and Written Opinion (4)

- Selection of an IPEA different from the ISA may be possible and advantageous depending on case needs:
  - ISA/KR and IPEA/US or vice versa
  - ISA/EP and IPEA/US or IPEA/KR
  - ISA/AU and IPEA/US or IPEA/KR
- Some IPEAs will only examine applications in which they were the ISA (EP and AU, for example)
- Request SIS
  - File a response to the findings in the WOISA using the “informal” procedure
- If a declaration under Article 17.2(a) that no ISR will be established is issued, applicant’s options are limited

# Supplementary International Search (1)

- Gives an opportunity to obtain a search from selected ISA other than the primary ISA
  - The scope of services offered vary by SISA
    - Full search of all available documents
    - Search only in specified languages
    - Search of subject matter not searched by primary ISA
- Must be filed with the IB by month 19
- Search of one invention only
- No Written Opinion is generated

# Supplementary International Search (2)

- Consider the cost versus the benefit of 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 primary search being conducted by the ISA
  - the information available through other searches by national and regional patent offices, independent search services and applicant's own search efforts

# National Phase Entry – Month 30

## Accelerated Examination/PPH

- Based on case needs, accelerated national processing and examination is available in some countries
  - PCT/PPH programs are in place in some countries if the appropriate ISA/IPEA is utilized
  - Some states have national procedures for accelerated examination
    - EPO (PACE) – no reason necessary
    - GB – will accept request based on favorable PCT results
    - CA – accepts request based on a variety of reasons
    - Other states have accelerated programs – check local agents