



NAtional Roving seminar

Roving Seminar on the Patent Cooperation Treaty (PCT)

organized by

the World Intellectual Property Organization (WIPO)

in cooperation with

the Intellectual Property India

Federation of Indian Chambers of Commerce and Industry (FICCI)

Conference Report

Mumbai, India, November 17, 2014

Kolkata, India, November 19, 2014

Delhi, India, November 24, 2014

Supported by

NUJS, Kolkata



About FICCI



FEDERATION OF INDIAN CHAMBERS OF COMMERCE AND INDUSTRY (FICCI) since 1927 has been the rallying point for free enterprises in India. It has empowered Indian Businesses in the changing times, to shore up their competitiveness and enhance their global reach. With a nationwide membership of 500 chambers of business association, FICCI stands for quality, competitiveness, and transparency, accountability and business –government-civil society partnership to spread ethics based business practices and to enhance the quality of life of common people.

FICCI has a reach in all 29 states and 7 Union Territories; through its Secretariat at New Delhi & 12 State Offices. FICCI has 1,800 direct members from the corporate sector, both private and public, including SMEs and MNCs and 2,50,000 lakh (approx.) indirect members through various regional chambers of commerce. ranging from 44 industrial verticals including public & private industries, associations, individuals, SME's etc.

FICCI strongly believes that it is important to provide entrepreneurs conducive environment which can foster innovation. FICCI IPR DIVISION is dedicated to the task of holistic development, protection, incentivization and promotion of Intellectual Property in India.

The *Intellectual Property Education Centre (IPEC)* is one of its kind online educational website second only to the WIPO educational initiative. Since its inception FICCI IPEC has successfully provided the certificate course to over 5,000 students, industry professionals, ex-government employees, etc. The courses include general course on IPR; specialized courses on Competition Law, Pharmaceutical R&D and US Patent. The plan for 2015 includes revamping the IPEC website alongwith updating the existing course material and also adding courses on IP enforcement, IP landscaping, IP Commercialization, R&D and Tech Transfer.

FICCI also established the *Intellectual Property Facilitation Centre (IPFC)* in New Delhi and Guwahati under the mandate of the Ministry of Micro, Small & Medium Enterprises (MSME). Headed by a team of experts from Legal & MSME; the IPFC helps MSME, Entrepreneurs, Individual Inventors etc. to identify, develop, protect, register, commercialize and use IP to business advantage. IPFC in 2015 endeavors to develop a holistic web system to provide the services IP consultancy, IP related knowledge, Commercialization Consultancy, Tech Transfer, linking international and national search databases; providing technical training in searching these databases; for payment of fee or for free to MSME; individuals innovators, etc. all over the Country and abroad.

FICCI IPR Division is dedicated to tackling IP related problem at the grass root level. The Division is engaged in conducting roving seminars for general IP Awareness & International Filing; Police & Customs Training for identifying IP related Offences and tackling them effectively; Judiciary Roundtables for making the Judiciary sensitive to the industry perspective of the losses and the impact of IP infringement.

In addition the Division is also involved in developing education curriculum to be included in the school syllabi at primary, secondary & higher secondary level. The division is actively involved in making policy suggestions to the IPR Think Tank.

CONTACTS

Dipankar Barkakati

Additional Director – IPR Division

Email: dipankar.barkakati@ficci.com

Federation of Indian Chambers of Commerce and Industry

Federation House, Tansen Marg, New Delhi-110001

SUMMARY OF PROCEEDINGS

Introduction

The PCT was concluded in 1970, amended in 1979, and modified in 1984 and 2001.

It is open to States party to the Paris Convention for the Protection of Industrial Property (1883). Instruments of ratification or accession must be deposited with the Director General of WIPO.

The PCT is an international treaty with more than 145 Contracting States.¹ The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single “international” patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent Offices in what is called the “national phase”.

The **PCT procedure** includes:

Filing: you file an international application with a national or regional patent Office or WIPO, complying with the PCT formality requirements, in one language, and you pay one set of fees.

International Search: an “International Searching Authority” (ISA) (one of the world’s major patent Offices) identifies the published patent documents and technical literature (“prior art”) which may have an influence on whether your invention is patentable, and establishes a written opinion on your invention’s potential patentability.

International Publication: as soon as possible after the expiration of 18 months from the earliest filing date, the content of your international application is disclosed to the world.

Supplementary International Search (optional): a second ISA identifies, at your request, published documents which may not have been found by the first ISA which carried out the main search because of the diversity of prior art in different languages and different technical fields.

International Preliminary Examination (optional): one of the ISAs at your request, carries out an additional patentability analysis, usually on an amended version of your application.

National Phase: after the end of the PCT procedure, usually at 30 months from the earliest filing date of your initial application, from which you claim priority, you start

to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.

The Treaty makes it possible to seek patent protection for an invention simultaneously in each of 148 contracting countries by filing an "international" patent application. Such an application may be filed by anyone who is a national or resident of a Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva. If the applicant is a national or resident of a Contracting State which is party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the revised Bangui Agreement Relating to the Creation of an African Intellectual Property Organization or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Industrial Property Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

The international application is then subjected to what is called an "international search." That search is carried out by one of the major patent offices appointed by the PCT Assembly as an International Searching Authority (ISA). The said search results in an "international search report," that is, a listing of the citations of such published documents that might affect the patentability of the invention claimed in the international application. At the same time, the ISA prepares a written opinion on patentability.

The international search report and the written opinion are communicated by the ISA to the applicant who may decide to withdraw his application, in particular where the said report or opinion makes the granting of patents unlikely.

If the international application is not withdrawn, it is, together with the international search report, published by the International Bureau.

The procedure under the PCT has great *advantages* for the applicant, the patent offices and the general public:

1. the applicant has up to 18 months more than he has in a procedure outside the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees; he is assured that, if his international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any designated Office during the national phase of the

processing of the application; on the basis of the international search report or the written opinion, he can evaluate with reasonable probability the chances of his invention being patented; and the applicant has the possibility during the international preliminary examination to amend the international application to put it in order before processing by the designated Offices;

- (ii) the search and examination work of patent offices can be considerably reduced or virtually eliminated thanks to the international search report, the written opinion and, where applicable, the international preliminary examination report that accompany the international application;
- (iii) since each international application is published together with an international search report, third parties are in a better position to formulate a well-founded opinion about the patentability of the claimed invention.

Functioning of Receiving Office- IP India as receiving office

An Indian applicant can file a PCT International application (**Section 2(1)(ia), 7(1A), 39 PCT/RO/101**) in the following manner:

Filing in the Indian Patent Office acting as Receiving Office

1. An international patent application can be filed in Indian Patent Office as a Receiving Office, in request form (PCT / RO / 101);
2. In such case, the applicant shall make request for permission under Section 39. After the grant of such permission, the Indian Patent Office shall transmit the patent application to the IB.

After filing a patent application in India

1. An international patent application can be filed within twelve months from the filing of patent application in India, in the Indian Patent Office, as a Receiving

Office. However, if such an application is filed before the expiry of 6 weeks from the date of filing in India, permission u/s 39 is required.

2. [An applicant has another option to file an International Application within twelve months from the filing of patent application in India, directly in IB, claiming the priority of the previously filed Indian Patent Application along with the prescribed application fee. A certified copy of the Indian Patent Application may be filed with the International application within sixteen months from the date of priority.]

Applicant has to pay the prescribed transmittal fee in addition to the International Application fee and search fee.

Requirements of PCT International Application

(Section 102(h), 208, 801 of Administrative Instructions under the PCT)

A]The International Application should contain

1. a request,
2. a description,
3. one or more claims,
4. one or more drawings (where required) and
5. an abstract.
6. should be in one of the prescribed languages, and
7. The required fee should be paid.

B]The request may also be presented

1. as a computer printout as prescribed by Section 102(h) of the Administrative Instructions under PCT or,
2. alternatively, as a computer printout prepared using the PCT-EASY software, in which case it must be accompanied by a computer disk containing a copy of the data as contained in the request in electronic form and copy of the abstract.

C] The request should contain a petition, i.e., a request that the International Application be processed according to the PCT.

D] Request should further contain

1. the title of the invention, necessary data concerning the applicant, the inventor and the agent representing the applicant.
2. It must be signed by the applicant or his agent.
3. Declaration of inventorship should be signed by the inventor(s)/the applicants in convention country, as applicable, and not by the agent.
4. Where there are two or more applicants, each applicant should sign at his choice either the request or, if the request is signed by an agent, a separate power of attorney.
5. The request should also contain details of priority (where applicable) and
6. an of competent International Searching Authority.

Competent International Searching Authorities for an Indian Applicant:

Austrian Patent Office (AT); Australian Patent Office (AU); European Patent Office (EP), China Intellectual Property Office (CN); United States Patent & Trademark Office (US); Swedish Patent Office (SE)

E] A certified copy of the priority document is required for each priority claimed in the application and the same is to be furnished within 16 months from the priority date.

F] **Language of International Application**

1. Application as filed in any Receiving Office in India it has to be either in English or Hindi. However, an application in Hindi shall be accompanied by a duly verified English translation.

G] **Claims**

1. The Claims must define the subject matter of the invention for which protection is sought. They must be clear and concise and fully supported by the description.

H] Drawings

1. The drawings are only required where they are necessary for the understanding of the invention. This will be the case for example for an engineering type of invention. It will not be the case when an invention cannot be drawn, as is the case for a chemical product

I] Abstract

1. It must be drafted in a way, which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use of the invention.

J] Sequence Listing to be filed only on an electronic medium.

Functions of IPO as Receiving Office

(Section 35, Article 3, 4, 11, 14 of PCT. PCT Receiving Office Guidelines)

The Indian Patent Office receives the PCT International Application from the applicant or from his authorized Agent.

B] The Office accords the **date of receipt of international application as the international filing date**, provided that the Office has found that, at the time of receipt:

1. The applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the Office;
2. The international application is in the prescribed language;
3. The international application contains at least the following elements:
 - an indication that it is intended as an international application,
 - the designation of at least one contracting state,
 - the name of applicant, as prescribed,

- a part which on the face of it appears to be a description, a part which on the face of it appears to be claim(s).

- C] At the time of receipt, if above requirements [A-B] not fulfilled, then Office, invites the applicant to file the required correction. If the applicant complies with the invitation, as provided in the regulations, the Office accords the date of receipt of the required correction as the international filing date.
- D] Then the Office checks following defects in the International Application :
1. it is not signed as provided in the regulations,
 2. it does not contain the prescribed indications concerning the applicant,
 3. it does not contain a title,
 4. it does not contain an abstract,
 5. it does not comply to the extent provided in the regulations with the prescribed physical requirements.

If the Office finds any of the above defects, it invites the applicant to correct the international application as soon as possible, ordinarily within one month from the date of filing, giving a time limit of two months for correction. If the applicant fails to make correction within the prescribed time limit, the application shall be considered withdrawn and the Office declares so.

- E] If the international application refers to drawings which, but, are not included in that application, the Office notifies the applicant and if the applicant furnishes the same within the time limit, the international filing date shall be the date on which the drawings are received by the Office. Otherwise, any reference to the said drawings shall be considered non-existent.
- F] If the Office finds that within the prescribed time limits the fee prescribed under Art.3(4)(iv) has not been paid, or no fee prescribed under Art.4(2) has been paid the international application shall be considered to be withdrawn and the Office declares so.
- G] If the language of filing of the International Application is the one acceptable to the Office but not acceptable by the International Searching Authority to carry out International search, the applicant is required to furnish, within one month from the filing date of the Application, the translation into a language among the following:

- a language accepted by the International Searching Authority to carry out international search;

- a language of publication by IB (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian or Spanish)

H] The Office then transmits the “*record copy*” of the International Application to **the International Bureau** and the “*search copy*” to the **International Searching Authority**. **The Office** keeps a third copy, the “*home copy*”. [note: The transmittals do not take place if, and as long as, national prescriptions concerning national security apply and the provisions of Section 35 follow.]

I] The Office then mails the record copy promptly to the International Bureau and in any case not later than five days prior to the expiration of the 13th month from the priority date.

J] The search copy is transmitted by the Office to the International Searching Authority at the time of transmittal of the record copy to the International Bureau except, where the search fees has not been paid on time, in which case, the transmittal of search copy takes place after that fees has been paid.

PCT National Phase Application

Article 22, 23 of PCT

The national phase follows the international phase.

1. Has the effect of a national (or regional) application as from the international filing date, and the decision to grant protection for the invention is the task of the Office of or acting for that State (the “designated Office”).
2. The national phase starts only if the applicant performs certain acts, either before the expiration of a certain time limit or together with an express request that it start earlier;
3. No notification to the applicants in this regard.
4. The applicant has sole responsibility for performing them in due time.
5. The consequences of failure to do so are fatal to the application

It should be noted that the acts must be performed in due time even if, for some reason, the international search report and the written opinion of the International

Searching Authority or the international preliminary report on patentability (Chapter I or II of the PCT) are not yet available.

Basic Requirements to enter National Phase in INDIA

Section 7,10(4A),135, 138(4).Rule 20, 21.Form-6, 13,18.Rule 17.1 (a or b) of PCT Regulations.

The jurisdiction of filing is the same as that of the ordinary Application. Address for service in India shall be filed.

- B] For the National Phase Application, the title, description, drawings, abstract and claims as filed with the International Application under PCT shall be taken as the Complete Specification.
- C] However, if the applicant has amended the Complete Specification under Chapter-I and/or Chapter-II of the PCT, such amended specification shall be taken as the Complete Specification for the purpose of filing in India. The applicant may make a request to the Controller for amendment of the complete specification which was filed with the National Phase Application, as a separate request in Form-13, along with the application.
- D] Application on the date of filing in India, Section 138(4) read with Rule 7(2)(c) mandates that the applicant shall pay the whole fee along with the application, based on such PCT International Application.
- E] In case of a change in name of an applicant, if the change has occurred after the international filing date and has not been reflected in a notification from the International Bureau (Form PCT/IB/306), the change may be effected by filing **Form 6 and/or Form 13**.
- F] If PCT/IB/304 is available on the website of WIPO, the Patent Office shall not require the applicant to submit the priority document. If not available, the Office may request for the same from the International Bureau.
- G] However, if the applicant has not complied with the requirements of rule 17.1 paragraph [a or b] of the regulations made under the PCT, he shall submit the priority document to the office before the expiry of thirty one months from the date of priority.
- H] Where the applicant does not comply with the requirements of (G) above, the Controller shall invite the applicant to file the priority document or the translation thereof within three months from the date of such invitation. If

the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.

- I] All other formalities that are required for filing and processing an ordinary patent application shall apply to a National Phase application.
- J] Processing of a national phase Application will not commence before the expiry of 31 months from the date of priority. However, the applicant may file an express request for processing before 31 months, in Form 18.

Procedure before the EPO as Receiving Office

Who can file (PCT Rules 18,19)- all national or residents of EPO contracting states in English, German or French

How to file:

- hard copies of application may be filed in paper
- online (via eOLF, PCT SAFE) for PCT applications, subsequently-filed documents and PCT Chapter II;
- web filing (via ePCT or CMS) since October / November 2014

Representation

1. As RO, ISA, SISA and IPEA, the EPO has **waived** the requirement to provide a **power of attorney**

1. For the effective **appointment** of a **professional representative** (agent), **common agent or common representative**
2. The waiver does not apply to ...
 1. **Legal practitioners** Art. 134(8) EPC
 2. **Employees** who may act on behalf of a legal entity with its place of business in an EPC Contracting State Art. 133(3) EPC

Where general authorisation registered with the EPO, no copy required,
indication of number is sufficient

1. Inventors are no longer required to sign the international application

Address for correspondence

New EPO practice as of 1 November 2014 in the **international phase**:

1. Each applicant (natural / legal person) who is NOT represented by an agent and/or who does NOT have to be represented may
Art. 27(7) PCT, Art. 133(2) EPC
2. indicate as address for correspondence any address (worldwide)
3. of a natural / legal person *Rule 4.4 PCT*

→ Example: APPL 1: SHELL B.V. – NL; AfC.: PETROBRAS SA – BR

When application enters the **European phase** -different practice:

1. Has to be within an EPC Contracting State, and'
2. The applicant's own address (sub-division within a firm allowed)
 1. maybe “new” (=different) AfC has to be indicated!
 2. Example: APPL 1: SIEMENS AG – BERLIN – DE;
AfC.: SIEMENS AG Patent Dept. – MUNICH – DE

Why file international applications (IAs) with the EPO acting as receiving Office

(RO/EP)?

1. RO/EP focuses on quality for the international publication
2. Application available to the EPO as RO, ISA, IPEA and DO/EO in the same electronic file system
3. Consistency in practice between PCT and EPC procedures at the EPO
4. Swift transmission of
 1. Record copies to the IB (average 11 days)
 2. Search copies to ISA/EP (average 15 days)

Procedure before the EPO as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA)

EPO as International Searching Authority (ISA)

1. **Competence:** EPO may be selected as ISA by all applicants provided that their receiving Office specified the EPO = ISA
2. Most receiving Offices have specified the EPO (exceptions are AE, AG, AU, CA, CN, DM, KN, KP, KR, PG and IR)
3. If applicants of these countries wish to specify the EPO as ISA, then the international application may be filed in the name of an applicant residing in a country which has specified the EPO as ISA, e.g. a subsidiary company
4. If the IB is acting as receiving Office, the EPO is competent as ISA, if the international application could have been filed with a receiving Office that specified the EPO as ISA
5. **Market share:** In 2013, EPO drew up 90 % of all ISRs in Europe, 36% in the USA, 4% in Japan
6. **Users:** In 2013, 66% of all ISRs drawn up by the EPO based on PCT applications filed in Europe, 27% USA, 2% Japan

Why Choose EPO as International Searching Authority (ISA)

because we are renowned internationally for our top quality searches:

7. **Highly-skilled, multilingual examiners using state-of-the-art databases** including patent documents from over 100 countries
8. Same **quality standards** applied as for European search performed under the EPC, **delivered** for timely publication **at 18 months**
9. Continuous improvement of **our documentation** coverage, taking ever more **Asian documentation** into account
10. Informative **written opinions** issued in addition to the international search report, which have proven to be an **excellent basis for PCT-PPH requests** in the USA, Japan, Korea and China
11. **Cost-efficiency:** When entering the European phase, we do **not** draw up and charge applicants for a **supplementary search report**

The EPO as Supplementary International Searching Authority (SISA)

12. Since 2010 the EPO offers this new service to all PCT applicants irrespective of ROs and ISAs
13. gives e.g. Indian applicants who got a PCT search by a patent Office other than the EPO a chance for an EPO search still in the international phase
14. same quality, fee and advantages as for EPO's international search → dispense of supplementary European search

Choosing EPO as SISA- formalities for request

R. 45bis.1 PCT

1. SIS request must be filed at IB not at the SISA, ISA, RO, IPEA etc (PCT AG I, 8.008)
2. Time limit = 19 months from priority/filing date
3. SIS request must be in EN/FR – languages of the IB (R. 92.2(d) PCT)
4. Fees paid to IB <1m of request (R. 45bis.2,3 PCT):
 1. SIS-search fee (EPO fee = EPO ISA search fee)
 2. SIS handling fee (set by IB)
 3. Late payment with surcharge possible
5. If not filed/translated into EN, FR, DE – translation to be filed at IB
 1. with SIS-request,
 2. late filing possible (no penalty fee)

The EPO as International Preliminary Examining Authority (IPEA)

EPO may be selected as IPEA by applicants who selected the EPO as ISA or any other European ISA → benefit: enhanced dialogue between applicant and examiner

In 2013, the EPO drew up almost 8 000 international preliminary examination reports, which constitutes 50% of the total worldwide

EPO offers as IPEA:

1. Top quality ***preliminary opinions*** regarding patentability, encouraging full dialogue between the applicant and the examiner in charge
2. Top-up ***search for prior art*** that became available in the time period between the international search and the international preliminary examination
3. ***Solid basis*** for the applicant to assess the chances for patent protection across the world and to decide whether or not to **proceed** with the application into the **European phase**
4. Further possibility to submit **amendments** under Article 34 PCT
5. Good basis for accelerating the processing of the application in the USA, Japan, Korea and China under the **PCT-PPH scheme**
6. **50% reduction of the fee** for the examination performed during the European phase

PCT ROVING SEMINAR, KOLKATA





Mr. Ken-Ichiro Natsume, World Intellectual Property Organization (WIPO) during the PCT Roving Seminar at Kolkata at NUJS on 18th Nov 2014

PCT ROVING SEMINAR, NEW DELHI



Mr. Christof Mathoi, Lawyer, International Legal Affairs, PCT, Dir. 5.2.2, European Patent Office during PCT Roving Seminar in New Delhi



Mr. Ken-Ichiro Natsume, World Intellectual Property Organization (WIPO) during PCT Roving Seminar in New Delhi



Dr. K.S. Kardam, Senior Joint Controller of Patents & Designs, PATENT OFFICE DELHI and International Searching Authority and International Preliminary Examining Authority, (ISA/IPEA) during PCT Roving Seminar in New Delhi



Audiences at the PCT Roving Seminar, New Delhi.