Roving Seminar for International filings through the Patent Cooperation Treaty (PCT)

Dehradun, 20 June 2019
Lucknow, 24 June 2019
Kolkata, 26 June 2019
Bhubaneswar, 28 June 2019

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Patents and Technology Sector
World Intellectual Property Organization
Contents

- WIPO: A Brief History
- Overview of the PCT System
- PCT Membership
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A brief history of The World Intellectual Property Organization (WIPO)
One of the oldest specialized agencies of the United Nations, the World Intellectual Property Organization (WIPO) has a long and interesting past.
1883 – Paris Convention

The Paris Convention for the Protection of Industrial Property is Born.

1886 – Berne Convention

Following a campaign by French writer Victor Hugo and his Association *Littéraire et Artistique Internationale* the Berne Convention for the Protection of Literary and Artistic Works is agreed.
1891 – Madrid Agreement
With the adoption of the Madrid agreement, the first International IP filing service launched: The Madrid System for the international registration of marks.

1893 – BIRPI established
The Paris and Berne Conventions combine to form WIPO's immediate predecessor, the United International Bureaux for the Protection of Intellectual Property – best known by its French acronym, BIRPI. The organization, with a staff of seven, is based in Berne, Switzerland.
1970 – BIRPI becomes WIPO

The Convention establishing the World Intellectual Property Organization (WIPO) comes into force and BIRPI is thus transformed to become WIPO. The newly established WIPO is a member state-led, intergovernmental organization, with its headquarters in Geneva, Switzerland.
1974 – WIPO joins the UN

WIPO joins the United Nations (UN) family of organizations, becoming a specialized agency of the UN. All member states of the UN are entitled, though not obliged, to become members of the specialized agencies.
1978 – PCT System launched

The PCT international patent system begins operation. The PCT expands rapidly to become WIPO's largest international IP filing system today.
1994 – AMC established

The WIPO Arbitration and Mediation Center is established. The Center offers alternative dispute resolution services to help solve international commercial disputes between private parties.
1998 – WIPO Academy opens its doors

The **WIPO Academy** is established to provide general and specialized courses on IP. Academy courses are interdisciplinary in their approach and targeted at a wide range of IP professionals.
2007 – WIPO Development Agenda adopted

WIPO formally adopts its Development Agenda, with the aim of ensuring that development issues are taken into consideration throughout the Organization's work.
What is WIPO

- WIPO is the global forum for intellectual property services, policy, information and cooperation. We are a self-funding agency of the United Nations, with 192 member states.

- Our mission is to lead the development of a balanced and effective international intellectual property (IP) system that enables innovation and creativity for the benefit of all. Our mandate, governing bodies and procedures are set out in the WIPO Convention, which established WIPO in 1967.
What we do

We help governments, businesses and society realize the benefits of IP.

We provide

- a **policy** forum to shape balanced international IP rules for a changing world;
- global **services** to protect IP across borders and to resolve disputes;
- **technical infrastructure** to connect IP systems and share knowledge;
- **cooperation** and **capacity-building** programs to enable all countries to use IP for economic, social and cultural development;
- a world **reference** source for IP information
What is a Patent?

- A territorial right that is granted by a government authority for an invention in a field of technology

- Right to prevent others from making, using, distributing, selling or importing the invention

- Application for a patent is made with a national or regional patent authority, or alternatively, through the Patent Cooperation Treaty
How to protect your invention in multiple countries

- Patents are limited to the territory, granted by a government authority for an invention in a field of technology.

  - Traditional Direct or Paris route
  - PCT Route
Traditional patent systems (Paris Route)

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
What is the Patent Cooperation Treaty (PCT)?

- An international treaty facilitating the process of seeking patent protection in all PCT member countries instead of filing separate national or regional patent applications.
- An efficient and advantageous procedure for users of the patent system and patent Offices.
- A patent “filing” system, not a patent “granting” system.
- International and national phase.
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase.
PCT TIMELINE

- National/Regional/PCT filing/ (priority date)
- PCT filing
- International search report (ISR) and written opinion (WO) of ISA
- International publication
- 2 months from ISR: filing of claims amendments (optional)
- Filing of demand and Article 34 amendments and/or arguments (optional)
- Request for supplementary international search (optional)
- Supplementary international search report (SISR)
- IPRP (Chapter II) established
- IB communicates IPRP (Chapter I or II) to DOs/EOs
- National phase entry

152 States

0 12 16 18 22 28
Traditional Patent System vs. PCT System

**Traditional**

- File local application
- (months) 0

152 States

**PCT**

- File local application
- (months) 0

- File PCT application

152 States

- International search report & written opinion
- 12 months
- Report on state of the art (prior art documents and their relevances) + initial patentability opinion
- 16 months

- International publication
- 18 months

- Enter national phase
- 22 months (optional)
- International preliminary report on patentability
- 28 months (optional)

- 152 States

- 30 months
Why Use the PCT?

- “Internationalization” of a single PCT application providing near global geographical coverage
- Time delay (additional time for decision making)
- Cost deferral
- Patentability assessment
- Amendment possibilities
- Electronic filing of PCT applications at reduced expense
- Centralized management of your PCT application in ePCT
Certain PCT Advantages

The PCT, as the cornerstone of the international patent system, provides a worldwide system for simplified filing and processing of patent applications, which –

- brings the world within reach
- postpones the major costs associated with internationalizing a patent application
- provides a strong basis for patenting decisions
- harmonizes formal requirements
- protects applicant from certain inadvertent errors
- evolves to meet stakeholders needs
- is used by the world’s major corporations, universities and research institutions when they seek multinational patent
PCT procedures

- Filing PCT International application (RO)
- International Search (ISA)
- International Publication (IB)
- Supplementary International Search (optional) (SISA)
- International Preliminary Examination (optional) (IPEA)
- National Phase
PCT Membership
Today: 152 States

Recent accessions:
- Jordan
- Kuwait
- Cambodia
## Non-Contracting States (41)

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The PCT applicant (Article 9 and Rule 18)

- At least one of the applicants must be a national or resident of a PCT Contracting State (Rule 18.3)

- The applicant may be a natural person (e.g. the inventor) or a legal entity (e.g. company, university, NGO)

- It is possible to indicate different applicants for different designated States (Rule 4.5(d))
Minimum requirements for an international filing date (Article 11(1))

The international PCT application must contain at least:

- an indication that it is intended as an international application
- a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
- the name of the applicant (Rule 4.5)
- a description (Rule 5)
- a claim (Rule 6)
Minimum requirements for an international filing date (Article 11(1)) (2)

Note that if:

- none of the applicants have the right to file with the receiving Office for reasons of residence or nationality (Rules 18 and 19); or

- the application is filed in a language not accepted by the receiving Office for that purpose (Rule 12.1),

the receiving Office will transmit the application to the receiving Office of the International Bureau for further processing (Rule 19.4)
Where to file the PCT international application by applicants from India (Rule 19)

- With a national Office (RO/IN)
- With the International Bureau of WIPO

For details, see PCT Applicant’s Guide, International Phase, General Information, Annexes B1 and B2
Not required for obtaining an international filing date

- Payment of fees
- Applicant’s signature
- Title of the invention
- Abstract
- Drawings (for missing drawings, see Article 14(2) and Rule 20.5)
- Translation into language of search or publication
Choice of receiving Office

- Accepted filing languages (English or Hindi)
- Choice of the International Searching Authorities
The competent ISAs are specified by the RO/IN
(AU, AT, CN, EP, IN, SE and US)

If more than one is specified by the RO, the applicant has the choice:

- in making that choice, the applicant must take into account the language(s) accepted by the ISA (a translation of the international application for the purposes of international search may be required in certain cases (Rule 12.3))

Choice of ISA to be indicated in the request (Box No. VII)
The request

- Electronic filing of the international application
  - ePCT-Filing

- Other filing means provided by the receiving Office
Signature of the request (1)  
(Rules 4.15, 26.2bis(a))

In principle, the request must be signed by all persons (legal entity or natural persons) indicated as “applicant” or “applicant and inventor”

BUT: if only one of the applicants signs, the lack of signature of the other applicants will not be considered a defect
Signature of the request (3)  
(Rules 4.15, 26.2bis(a))

- If the request is not signed by the applicant(s) but by an agent, a separate power of attorney signed by all the applicant(s) must be filed (either original individual power or copy of general power).

BUT: if only a power of attorney signed by one applicant is filed, the lack of powers of attorney signed by the other applicants will not be considered a defect.

NOTE: ROs may waive requirement that a separate power or a copy of a general power of attorney must be submitted.
Declarations
Declarations under Rule 4.17

- Purpose: possibility to anticipate certain national phase requirements during the international phase (Rule 51bis.2)
- Inclusion in request or subsequent filing is optional
- Declarations relate to the following matters (Rule 4.17):
  - identity of the inventor
  - applicant’s entitlement to apply for and be granted a patent
  - applicant’s entitlement to claim priority of an earlier application
  - declaration as to inventorship (for the US designation only)
  - non-prejudicial disclosures or exceptions to lack of novelty
Agents and Common Representatives
Agents (Rule 90)

- Is an agent required by RO/IN?
  - No, but an address for service in India is required

- Who can act as agent?
  - any patent agent registered to practice before RO/IN can act as agent and automatically has the right to practice before the IB, the ISA and the IPEA (Article 49);
  - an agent who has the right to practice before the ISA and/or IPEA can be appointed specifically for the purposes of the procedure before that ISA or IPEA (Rule 90.1(b) and (c));

- What is a common agent?
  - an agent appointed by all the applicants
Common representatives (Rule 90)

Who can act as common representative?

- one of the applicants, who is entitled to file an international application (i.e., who is a resident or national of a PCT Contracting State), may be appointed by all the other applicants, or

- where neither a common agent nor a common representative has been appointed, the first named applicant in the request who is entitled to file an international application with the RO with which the international application was filed is automatically “deemed” to be common representative.
Fees Payable under the PCT
Cost associated in filing and processing of an international application under the PCT

- international filing fee of 1,330 Swiss francs (for IB)
- search fee – vary from 150 to 2050 Swiss francs depending on the ISA chosen (for ISA)
- Transmittal fee – a small amount depending on the receiving Office (for RO)
Fee reduction

- When filing electronically, based on the type of filing and the format of the application

- Applicants (natural person) from developing countries fee reduction of 90% for certain fees, including the international filing fee (see www.wipo.int/pct/fee_reduction.pdf)

- Some ISAs provide reduction on search fee if the applicant or applicants are national or residents from certain countries (see PCT Applicant’s Guide www.wipo.int/pct/en/appguide/index.jsp)

- On National Phase – some national or regional offices for natural persons, universities, not-for-profit research institutes and SMEs (see www.wipo.int/pct/en/appguide/index.jsp at National Chapters)
Chapter I:

- Transmittal fee, international filing fee, search fee: one month from the date of receipt of the international application by the RO (Rules 14.1(c), 15.4 and 16.1(f))

- Special provisions for cases where the international application is transmitted to RO/IB under Rule 19.4 (Rule 19.4(c))
PCT Statistics
Tremendous growth in PCT applications since 1978
PCT Application Filings

Source: Economics and Statistics Division, WIPO
International applications received in 2018 by country of origin

- 22.1% originating in US, 21% in China, 19.6% in Japan
- 62.7% from the top 3 countries, 77.5% from top 5 countries, 92.4% of filings from top 15 countries
PCT filings with the receiving Office, India

The International Patent System
Top PCT Applicants from India in 2018

1. COUNCIL OF SCIENTIFIC AND INDUSTRIAL RESEARCH
2. TVS MOTOR COMPANY LIMITED
3. INDIAN INSTITUTE OF SCIENCE
4. INDIAN INSTITUTE OF TECHNOLOGY MADRAS (IIT MADRAS)
5. RELIANCE INDUSTRIES LIMITED
6. UPL LTD
7. CIPLA LIMITED
8. MSN LABORATORIES PRIVATE LIMITED, R&D CENTER
9. GLENMARK PHARMACEUTICALS LIMITED
10. MUNIYAL AYURVEDIC RESEARCH CENTRE
Top PCT Applicants in 2018

1. Huawei Technologies—CN (5,405)
2. Mitsubishi Electric—JP (2,812)
3. Intel—US (2,499)
4. Qualcomm—US (2,404)
5. ZTE—CN (2,080)
6. Samsung—KR (1,997)
7. BOE Technology Group—CN (1,813)
8. LG Electronics—KR (1,697)
9. Ericsson—SE (1,645)
10. Bosch—DE (1,524)
11. Microsoft—US (1,476)
12. Panasonic—JP (1,465)
13. Sony—JP (1,342)
14. Siemens—DE (1,211)
15. Hewlett-Packard—US (1,170)
Top University PCT Applicants in 2018

1. University of California (US)
2. Massachusetts Institute of Technology (US)
3. Shenzhen University (CN)
4. South China University of Technology (CN)
5. Harvard University (US)
6. University of Texas System (US)
7. Tsinghua University (CN)
8. Seoul National University (KR)
9. Leland Stanford Junior University (US)
10. China University of Mining and Technology (CN)
11. Osaka University (JP)
12. Johns Hopkins University (US)
13. Korea Advanced Institute of Science and Technology (KR)
14. University of Tokyo (JP)
15. Hanyang University (KR)
PCT applications by applicant type

The business sector accounted for 85.3% of all PCT applications filed in 2018.

A11. Distribution of PCT applications by applicant type, 2004–2018

Note: The government and public research organizations (PROs) sector includes private non-profit organizations and hospitals. The university sector includes all educational institutions. For confidentiality reasons, data are based on the publication date.

Note: The government and PROs sector includes private non-profit organizations and hospitals. The university sector includes all educational institutions. For confidentiality reasons, data are based on published applications and on the publication date.

17.1% of all inventors in PCT applications were women (+0.8 percentage points)

32.6% of PCT applications in 2018 included at least one woman inventor (+2.1 percentage points)

Source: WIPO Statistics Database, March 2019
Share of women among listed inventors in PCT applications by geographical region, 2008, 2013 and 2018


Top 5 Fields of Technology (2018)

Top 5 fields of technology
Number of published applications and share of total

- **Digital communication**: 20,271 (8.6%)
- **Computer technology**: 19,152 (8.1%)
- **Electrical machinery, apparatus, energy**: 16,577 (7.0%)
- **Medical technology**: 15,826 (6.7%)
- **Transport**: 10,867 (4.6%)
Filing Trends for the Top 5 Origins

Source: WIPO Statistics Database, March 2019
PCT Applications by Medium of Filing

Distribution in 2018 (2017 in brackets): 2.9% (3.8%) paper, PDF 60.2% (57.9%), EFS-Web 8.3% (9.1%), XML 28.6% (29.2%)

Source: WIPO Statistics Database, March 2019
XML filings rose by 6 percentage points from 2008 to 2011, then by 2.5 percentage points from 2011 to 2018.
Filings through the ePCT-filing portal increased by 44.1% to 24,070 applications, 9.5% of the total of international applications filed in 2018.
Share of PCT publications in English declined (45.6% in 2018)

Other percentages: 19.6% Japanese, 17.9% Chinese, 7.3% German, 5.8% Korean, 2.5% French, 0.62% Spanish, 0.43% Russian, 0.22% Portuguese, 0.01% Arabic

Source: WIPO Statistics Database, March 2019
United States of America and China received more than 55,000 applications.

Highest percentage rises for filings in Turkey (+44.5%), India (+21.4%) and at the International Bureau (+20.2%)
PCT Applications for the Top 20 Origins

Source: WIPO Statistics Database, March 2019
China became second most used International Searching Authority in 2018.

IP5 Offices established 93.4% of reports.

High percentage increases in search reports from Offices India (+48.7%), Chile (+40.1%), Singapore (+24.9%) and China (+18.1%).
Recent developments
PATENTSCOPE
• ePCT
• WIPO Translate & WIPO Pearl
• Licensing availability
• Third Party Observations
• PCT Direct
• PCT Online Service – Training Options
• PCT Highlights
PATENTSCOPE

- 3.5 million published PCT applications!
- 74 million patent documents (57 regional or national collections)
- https://patentscope.wipo.int
PATENTSCOPE - Enhancements

- Interface available in 10 languages (plus mobile version)
- “Documents” tab includes the new section “Search and Examination-Related Documents”
- Information on national phase entry for 66 countries
- Access 57 searchable national and regional patent collections
- New secure access to PATENTSCOPE via https
- WIPO Translate
  - Translation tool based on neural machine translation technology that enables it to convert highly technical patent documents into a second language in a style and syntax that closely mirrors common usage
- Cross-Lingual Expansion
  - Allows the search of a term/phrase and its variants in several languages by entering the term(s) in one language, the system will suggest variants and translate the term(s) allowing the search of patent documents in other languages
(12) DEMANDE INTERNATIONALE PUBLIÉE EN VERTU DU TRAITÉ DE COOPÉRATION EN MATIÈRE DE BREVETS (PCT)

(19) Organisation Mondiale de la Propriété Intellectuelle
Bureau international

(43) Date de la publication internationale
7 mars 2013 (07.03.2013)

(51) Classification internationale des brevets :
G01R 29/02 (2006.01)

(21) Numéro de la demande internationale :
PCT/FR2011/051978

(22) Date de dépôt international :
29 août 2011 (29.08.2011)

(25) Langue de dépôt :
français

(26) Langue de publication :
français

(71) DÉPOSANT (pour tous les États désignés sauf US) : CRF-TECH [FR/FR], 2 rue Jean Peron, F-44600 Colombelles (FR).

(72) Inventeurs : et

(75) Inventeurs/Déposants (pour US seulement) : CANARD, David [FR/FR], Co Crftech, 2 rue Jean Peron, F-44600 Colombelles (FR); LECUYER, Matthieu [FR/FR], Co Crftech, 2 rue Jean Peron, F-44600 Colombelles (FR).

(74) Manufacturé : MAILLET, Alain ; Cabinet LE GUENMAILLET, B.P 70250, 5 place Néougue, F-35802 Dinard Côtes (FR).

(54) Title : DEVICE FOR MEASURING A DURATION OF A LEVEL OF AN ELECTRICAL SIGNAL

(54) Titre : DISPOSITIF DE MESURE D'UNE DURÉE D'UN NIVEAU D'UN SIGNAL ÉLECTRIQUE

— avec rapport de recherche internationale (Art. 21/3)
ePCT

- The global portal for managing PCT applications
- Available since May 2011
- Offers one central file for access and secure and direct interaction by applicants, Offices/Authorities and the IB
- ePCT is based on individual / personal accounts
- Private services and the public services mode
- Web filing (ePCT-Filing) with participating receiving Offices including RO/IN
WIPO launched Neural Machine Translation (AI) for Asian Languages in October 2016

Access to the world’s IP information
Search technology, terminology and brand-related information in our free global databases. Download our other reference materials: publications, statistics, economic studies and more.

PATENTSCOPE
58,220,000 international and national patent documents

Global Brand Database
27,960,000 international and national records of trademarks, appellations of origin and emblems

ROMARIN
International marks recorded under the Madrid System

Global Design Database
1,700,000 industrial design registrations from the Hague System and participating national collections

WIPO Lex
14,100 records of national IP laws and treaties of some 200 countries

IP for development
Learn about our global cooperation and development activities, assistance to IP offices. Consult information by country. Join the Technology and Innovation Support Center (TISC).
WIPO Translate NMT is a powerful instant translation tool, designed specifically to translate patent texts (now almost all languages are available using Neural Machine Translation technology). Simply cut and paste text from a patent document into the box below and select from the available language pairs, then click on "Translate".

Related links
- WIPO Translate: Cutting-Edge Translation Tool For Patent Documents Extends Language Coverage
WIPO Pearl

- Launched in September 2014
- Multilingual terminology portal which gives access to scientific and technical terms derived from patent documents
- Available in all ten PCT languages
- Helps to promote accurate and consistent use of terms across different languages and makes it easier to search and share scientific and technical knowledge
- All content validated with reliability scores
- Integrated with PATENTSCOPE
- Further details can be found at: www.wipo.int/wipopearl/search/home.html
Applicants interested in concluding license agreements in relation to their international application may request the International Bureau to make this information available in PATENTSCOPE:

- **How?** Applicants should submit a “Licensing Availability Request” to the IB using an ePCT “Action”
  - Alternatively, Form PCT/IB/382 may be used
- **When?** At the time of filing or within 30 months from the priority date
- **Free of charge**
- Applicants can file multiple licensing requests or update previously submitted ones (within 30 months from the priority date)
Licensing availability (2)

- Licensing indications will be made publicly available after international publication of the application.

- The licensing indications will be visible on PATENTSCOPE under the “Bibliographic data” tab with a link to the submitted licensing request itself.

- International applications containing licensing information can be searched for in PATENTSCOPE.

- The licensing indication displayed under the “Bibliographic data” tab may be revoked by the applicant at any time, that is, also after 30 months from the priority date.
Third Party Observations - Main Features

- Allows third parties to submit prior art observations relevant to novelty and inventive step.
- Web-based system using ePCT or web-forms in PATENTSCOPE.
- Free-of-charge.
- Submissions possible until the expiration of 28 months from the priority date.
- Applicants may submit comments in response until the expiration of 30 months from the priority date.
- Anonymous submission of third party observations possible.
- Third-party supplied documents will not be available via PATENTSCOPE, but will be made available to International Authorities and national Offices.
Third Party Observations – Role of the IB

- Checks for spam
- Notifies the applicant of submission of observations
- Makes observations available in PATENTSCOPE
- Sends to International Authorities and designated Offices observations, cited documents, and applicant responses
- Available since July 2012
“PCT Direct”

- New service offered by:
  - EPO since 1 November 2014
  - Israel Patent Office since 1 April 2015

- During the PCT procedure, applicants can address patentability issues raised in the search opinion established for the priority application by the same office.

- Aims at improving the efficiency and quality of the procedure before the ISA.

- Further details can be found on the EPO website:

- Further details can be found on the Israel Patent Office website:
  http://index.justice.gov.il/En/units/ILPO/Departments/PCT/News/Pages/PCTDirect.aspx
Technology and Innovation Support Centers (TISCs)

- Support to inventors, small and medium enterprises, universities and research centers, and others to more fully exploit their innovative potential and to create, protect, and manage their intellectual property rights.

- Two core clusters of activities:
  - Access to specialized databases
  - Capacity building

- In India we have TISCs in Ahmedabad, Chandigarh, Chennai, Jaipur, Thiruvananthapuram and Visakhapatnam

http://www.wipo.int/tisc/
Arbitration and Mediation Center (AMC)

- Independent and impartial body that offers alternative dispute resolution options for the resolution of commercial disputes between private parties (time and cost efficient alternatives to litigation)

- Provides mediation, arbitration and expert determination services for IP and other commercial disputes

- 25% lifetime reduction on AMC’s registration and administration fees where at least one party to the dispute has been named as an applicant or inventor in a published PCT application (no relationship to the dispute is required)

- Fee calculator

http://www.wipo.int/amc/en/calculator/adr.jsp
PCT information and training

- “Learn the PCT” Video Series

  (http://www.wipo.int/pct/en/training/index.html)

  A series of 29 short videos designed to provide a basic introduction to important aspects and issues in the PCT system (in English)


- PCT Distance Learning Course available in the 10 publication languages


- PCT Webinars


  Free webinars on PCT topics for companies/law firms on request

- More information on the PCT resources website:

  www.wipo.int/pct
Subscribe to PCT Highlights, our regular legal and news updates

High-level summary of recent and future developments in the PCT, with hyperlinks to more detailed information, databases, videos, etc.

Thank you

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Functions of the receiving Office (RO), the International Authorities (ISA/IPEA) and the Role of the International Bureau under the PCT
Functions of the receiving Office
The Receiving Office

- PCT applications are filed with a receiving Office
- Formalities check of the PCT application
- Accords or refuses an international filing date
- Specifies one or more International Authorities for search (ISA) or examination (IPEA)
- Collects fees for the receiving Office, International Bureau and the International Searching Authority
Competent receiving Office (RO):

RO/IN or/ RO/IB
Fees not payable during international phase

Under the PCT, there is:

- no fee for requesting extension of time to correct certain formal defects
- no claims fee (at the time of filing of the international application or during the international phase, if claims are added)
- no fee for late response to certain communication (for example, invitation to correct or written opinion)
- no fee for filing a request for rectification of an obvious mistake under Rule 91
- no fee for requesting a change in the indications concerning the applicant, inventor, etc. under Rule 92bis
The International Bureau as receiving Office
International Bureau as receiving Office (RO/IB) (1)

- The International Bureau is available as receiving Office for nationals and residents of all PCT Contracting States (Rule 19.1(a)(iii))

- Compliance with national security provisions is applicant’s responsibility

- RO/IB accepts international applications filed in ANY language

- The competence of ISAs and IPEAs will be determined as if the international application had been filed with a competent national or regional Office (Rules 35.3(a) and 59.1(b)). Choice of ISA must be indicated in the request (Rules 4.1(b)(iv) and 4.14bis)
International Bureau as receiving Office (RO/IB) (2)

- An agent has the right to practice before RO/IB if qualified to act before a competent national or regional Office (Rule 83.1bis)

- RO/IB has waived the requirement that a separate power of attorney or a copy of a general power of attorney has to be submitted in respect of any agent or common representative indicated in Box IV of the request, subject to certain conditions (see www.wipo.int/pct/en/texts/pdf/p_a_waivers.pdf)

- No transmittal fee for applicants from certain Contracting States
Transmittal of international applications to RO/IB (Rule 19.4) (1)

Cases where the international application will be transmitted to RO/IB:

- if it is filed by an applicant from a PCT Contracting State with an Office which is not competent as receiving Office because of the nationality or residence of the applicant
- if it is in a language which is not accepted by the Office with which it is filed
- if for any other reason, the receiving Office and RO/IB agree to the transmittal and the applicant authorizes it
Transmittal of international applications to RO/IB (Rule 19.4) (2)

- Conditions for the transmittal:
  - any applicable national security requirements are met
  - a fee, equal to the transmittal fee, is paid (not all Offices will require such a fee)

- Effect of the transmittal on the international filing date: the international filing date will be the date of receipt by the “non competent” Office provided that
  - the minimum requirements for according an international filing date are met
Transmittal of international applications to RO/IB (Rule 19.4) (3)

- Consequences of the transmittal:
  - All PCT filing fees will be payable to the International Bureau in Swiss Francs, Euro or US Dollars.
  - The one-month time limit for payment being calculated from the actual date of receipt of the application by RO/IB.
  - Any fees paid to the non-competent Office, other than a fee equal to the transmittal fee (if required), will be refunded.
  - The question whether the person previously appointed as agent is entitled to represent the applicant before RO/IB must be checked (Rule 83.1bis).
  - The question whether the International Searching Authority chosen by the applicant is correct will be checked (Rule 35).
The International Authorities (ISA/IPEA)
The International Searching Authorities (ISAs)
International Searching Authorities
(23 in total)

- AT – Austria
- AU – Australia
- BR – Brazil
- CA – Canada
- CL – Chile
- CN – China
- EG – Egypt
- ES – Spain
- FI – Finland
- IL – Israel
- IN – India
- JP – Japan
- KR – Republic of Korea
- PH – Philippines (IPOPHL) (not yet operational)
- RU – Russian Federation
- SE – Sweden
- SG – Singapore
- TR – Turkey
- UA – Ukraine
- US – United States of America
- XN – Nordic Patent Institute (Denmark, Iceland, Norway)
- XV – Visegrad Patent Institute (VPI) (Czech Republic, Hungary, Poland, Slovakia)

Receiving Office decides on which ISAs is/are competent
ISAs for IN applicants

- Competent ISA/IPEAs
  - ISA/AU
  - ISA/AT
  - ISA/CN
  - ISA/EP
  - ISA/IN
  - ISA/SE
  - ISA/US
PCT International Search

- It is a high quality search of the relevant patent documents and other technical literature in the languages in which most patent applications are filed.
- High quality assured by the standards prescribed in the PCT for the documentation to be consulted.
- Is established by the qualified staff and uniform search methods of the ISAs, which are all experienced patent Offices.
- The search results are published in an international search report and a written opinion of the ISA on the potential patentability of the invention.
The International Search Report (ISR)

- It consists mainly of a listing of references to published patent documents and technical journal articles which might affect the patentability of the invention disclosed in the international application.

- The report contains indications for each of the documents listed as to their possible relevance to the critical patentability questions of novelty and inventive step (non-obviousness).
The Value of the International Search Report (ISR)

- The report enables you to evaluate your chances of obtaining patents in the PCT Contracting States.

- A favorable ISR will assist you in the further processing of the application in those countries in which you wish to obtain protection.

- An unfavorable (for example, if it lists documents which challenge the novelty and/or inventive step of the invention), the opportunity is to amend the claims to better distinguish the invention from those documents and have then published, or to withdraw the application before it is published.
### Example: PCT International Search Report (PCT/ISA/210)

<table>
<thead>
<tr>
<th>Category</th>
<th>Citation of document, with indication, where appropriate, of the relevant passages</th>
<th>Relevant to claim No.</th>
</tr>
</thead>
<tbody>
<tr>
<td>X</td>
<td>JP 50-14535 B (NCR CORPORATION) 28 May 1975 (28.05.75), column 4, lines 3 to 27</td>
<td>7-9, 11</td>
</tr>
<tr>
<td></td>
<td>GB 392415 A (JONES) 18 May 1933 (18.05.33)</td>
<td>1-3</td>
</tr>
<tr>
<td>X</td>
<td>Fig. 1</td>
<td>4, 10</td>
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<tr>
<td></td>
<td>Y page 3, lines 5-7</td>
<td>11-12</td>
</tr>
<tr>
<td>X</td>
<td>A Fig. 5, support 36</td>
<td></td>
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<tr>
<td>Y</td>
<td>GB 2174500 A (STC) 5 November 1986 (05.11.86)</td>
<td>1-3</td>
</tr>
<tr>
<td></td>
<td>X page 1, lines 5-15, 22-34, 46-80; Fig. 1</td>
<td>4</td>
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<tr>
<td>A</td>
<td>GB 2174500 A (STC) 5 November 1986 (05.11.86)</td>
<td>1</td>
</tr>
<tr>
<td>A</td>
<td>US 4322752 A (BIXTY) 30 March 1982 (30.03.82)</td>
<td>1-5</td>
</tr>
</tbody>
</table>

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**Symbols indicating which aspect of patentability the document cited is relevant to (for example, novelty, inventive step, etc.):**

- **X:** Novelty
- **Y:** Invention step
- **A:** Other aspect

**Documents relevant to whether or not your invention may be patentable:**

- JP 50-14535 B
- GB 392415 A
- GB 2174500 A
- US 4322752 A
- GREEN, J.P. Integrated Circuit and Electronic Compass

**The claim numbers in your application to which the document is relevant:**

- 7-9, 11
- 1-3
- 4, 10
- 11-12
- 1-3
- 4
- 1
- 1-5
Written Opinion of the International Searching Authority (ISA)

- The ISA will establish the written opinion, at the same time that it establishes the ISR.
- It is a preliminary and non-binding opinion on whether the invention appears to meet the patentability criteria in light of the search report results.
- The written opinion will be sent to the applicant and the International Bureau together with the ISR.
- It helps the applicant to understand and interpret the results of the ISR with specific reference to the text of the international application, being a special help to evaluate the chances of obtaining a patent.
IP5 Offices established 93.4% of reports in 2018 (93.7% in 2008).

Increases in percentage share for China, Japan and Republic of Korea; decreases for EPO and United States of America.
Supplementary International Search (SIS)
Supplementary International Searching Authorities (7 in total)

- AT – Austria
- FI – Finland
- RU – Russian Federation
- SG – Singapore
- SE – Sweden
- TR – Turkey
- UA – Ukraine
- XN – Nordic Patent Institute (Denmark, Iceland, Norway)
- XV – Visegrad Patent Institute (VPI) (Czech Republic, Hungary, Poland, Slovakia)
Supplementary International Search (SIS)

SIS permits the applicant to request, in addition to the international search (the «main international search»), one or more supplementary international searches each to be carried by an ISA other than the ISA which carried out the main international search.

The additional Search has the potential of reducing the risk of new patent documents and other technical literature being discovered in the national phase since, by requesting SIS the applicant can enlarge the linguistic and/or technical scope of the documentation searched.
### Supplementary International Search Requests

<table>
<thead>
<tr>
<th>Supplementary international searching authority</th>
<th>2013</th>
<th>2014</th>
<th>2015</th>
<th>2016</th>
<th>2017</th>
<th>2018</th>
</tr>
</thead>
<tbody>
<tr>
<td>Austria</td>
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<td>1</td>
<td>1</td>
<td></td>
</tr>
<tr>
<td>European Patent Office</td>
<td>30</td>
<td>61</td>
<td>40</td>
<td>44</td>
<td>40</td>
<td>54</td>
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<tr>
<td>Russian Federation</td>
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<td>22</td>
<td>3</td>
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<tr>
<td>Sweden</td>
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<td>3</td>
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<tr>
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<td>1</td>
</tr>
<tr>
<td>Ukraine</td>
<td></td>
<td></td>
<td></td>
<td>2</td>
<td></td>
<td>1</td>
</tr>
<tr>
<td><strong>Total</strong></td>
<td><strong>67</strong></td>
<td><strong>109</strong></td>
<td><strong>64</strong></td>
<td><strong>48</strong></td>
<td><strong>49</strong></td>
<td><strong>63</strong></td>
</tr>
</tbody>
</table>

Source: WIPO Statistics Database, March 2019

- The EPO accounted for 85.7% of requests for supplementary international search in 2018.
International Publication (1)

- Takes place shortly after 18 months from the earliest filing date
- One of the main functions of the International Bureau
- Contents of published PCT application
  - Standardized front page with bibliographic data, title and abstract
  - Description, claims and drawings (if any)
  - International Search Report
  - Other elements prescribed by the PCT Regulations (e.g., amended claims, declarations, etc.)
International Publication (2)

- Ten publication languages (Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, Spanish)
- PCT application file maintained by the International Bureau is publicly available after international publication and contains other documents such as the application as filed, written opinion of the ISA, PCT Forms and general correspondence
The International Preliminary Examining Authorities (IPEAs)
International Preliminary Examination

- The IPEA which carry out the international preliminary examination are the ISAs mentioned earlier.
- International preliminary examination is a second evaluation of the potential patentability of the invention.
- If the applicant wish to make amendments in order to overcome documents identified in the ISR and conclusions made in the written opinion of the ISA, the international preliminary examination provides the only possibility to actively participate in the examination process and potentially influence the findings of the examiner before entering the national phase.
The Value of the International Preliminary Report of Patentability (IPRP)

- The IPRP is provided to the applicant, the International Bureau and to the national (or regional) patent offices.
- The report consists of an opinion on the compliance with the international patentability criteria of each claim which have been searched.
- The IPRP provides with an even stronger basis on which to evaluate the chances of obtaining patents.
- However, the decision on the granting of a patent remains the responsibility of each of the national or regional offices; the IPRP should be considered by the Offices but is not binding on them.
Reports established by IPEA fell by 3.8% in 2018 to 12,767.

84.8% of IPRPs (Chapter II) were produced by the EPO, the JPO or the USPTO.

Source: WIPO Statistics Database, June 2019
PCT fees payable to the International Preliminary Examining Authority (IPEA)

- preliminary examination fee
- handling fee *(for IB)*
- late payment fee
- additional examination fee
- protest fee *(where applicable)*
- fee for copies of documents
- late furnishing fee *(furnishing of a sequence listing)*

*(Fees indicated in italics are payable only in certain circumstances)*
Time limits for payment of fees

Chapter II:

- preliminary examination fee and handling fee: one month from the date of receipt of the demand by the IPEA or 22 months from the priority date, whichever expires later (Rules 57.3 and 58.1(b))

- special provisions for cases where the demand is transmitted to the competent IPEA under Rule 59.3 (Rules 57.3 and 58.1(b))
Invitation to pay missing fees (Chapter II) (Rule 58bis)

- If the fees due (i.e., preliminary examination fee and handling fee) are not paid within the applicable time limit:
  - the IPEA invites the applicant to pay to it the missing fees within one month from the date of the invitation; and
  - the IPEA may require a late payment fee of 50% of the missing amount (minimum: handling fee; maximum: double the amount of the handling fee)

- Examination will not start until the fees are paid (Rule 69.1(a)(ii))

- Consequence in case of non-payment:
  
  If the amount paid is not sufficient to cover the examination fee, the handling fee and, where applicable, the late payment fee, the demand will be considered by the IPEA as if it had not been submitted and the IPEA will so declare
The Role of the International Bureau under the PCT
Role of WIPO in the PCT

- WIPO Administers the PCT

- WIPO organizes:
  - PCT Assembly
  - PCT Working Group
  - The Meeting of International Authorities
WIPO also ..........

- Provides overall Coordination of the PCT System
- Provides assistance to existing, new and potential Contracting States and their Offices
- Provides advice on implementing the PCT in the national legislation and on setting up internal procedures in the Contracting States’ patent Offices
- Publishes the *PCT Applicant’s Guide* and the *PCT Newsletter*
- Creates and disseminates PCT information via the PCT Website, webinars and through telephone and email assistance
- Organizes and gives PCT Seminars and training courses and providing legal advice on request to Offices and users
The PCT Operations
PCT Operations Tasks

- Receipt of Documents
- Formality Examination
- Translation
- Publication
- Handling of requests for supplemental international search
- Communication
- Archiving
- Development and maintenance of IT tools used
Receipt of Documents

- Paper documents by mail (Offices and Applicants)
- PCT Electronic Data Interchange (EDI) Service (Offices)
- ePCT Public Services and Private Services (Offices and Applicants)
- Fax machine* (Offices and Applicants)
- Email (not for official communications) (Offices and Applicants)
- DAS (digital access service) for priority documents

*Note: Fax transmissions no longer recommended since January 1, 2018
Formality Examination

- Data Entry and Validation
- Record Copy Check
- Document Processing and Examination
- Quality Control
Preparing International Publication

- Publication List
- Technical Preparation for Image Publication
- Technical Preparation for XML Publication
Quality Control

- Quality Control of International Applications based on randomly selected applications or per “theme” (example: Article 19, Sequence Listings, …).
- Each team controls part of their own applications and checks applications from all other teams.
- The aim is to find errors and make sure consistency is applied across the teams when processing and examining applications.
- Target is 10% of applications to be quality checked.
Timeliness in processing PCT applications by the International Bureau
Timeliness of formalities examination, 2005 - 2018

Note: The International Bureau (IB) performs a formality examination of PCT applications and related documents promptly after receipt. Once the formality examination of a PCT application is completed, the IB sends a form to the applicant acknowledging receipt of the application. Timeliness is calculated as the time elapsed between the date of receipt of the record copy of the PCT application and the date of issuance of form PCT/IB/301.

Timeliness in publishing PCT applications, 2004 - 2018

Note: PCT applications and related documents are to be published “promptly” after the expiration of 18 months from the priority date, unless the applicant requests early publication, or the application is withdrawn or considered withdrawn. Timeliness is calculated as the time elapsed between the time limit of 18 months from the priority date and the actual publication date.

Distribution of PCT applications by filing medium, top 20 receiving offices, 2018

Note: EPO is the European Patent Office.
Timeliness in transmitting international search reports to the International Bureau, measured from date of receipt of the search copy by international searching authority, 2018

Note: The international searching authority (ISA) must establish the international search report (ISR) within three months of receiving a copy of the application – known as the search copy – or nine months from the priority date (or, if no priority is claimed, from the international filing date), whichever expires later. Timeliness is calculated as the time between the date when the ISA receives a copy of the PCT application and the date when it transmits the ISR to the International Bureau (or, if applicable, the date of receipt of the declaration under Article 17(2)(a)). This figure shows timeliness in establishing the ISR where the applicable time limit for establishing the ISR under Rule 42 is three months from receipt of the search copy. When the date of receipt of the search copy is unknown and the ISA is the same office as the receiving office, we consider the search copy to have been received on the international filing date and calculate the timeliness accordingly. EPO is the European Patent Office.

Unit cost of processing a published PCT application, 2012 – 2018

Unit cost = (total cost of production: number of publications) + storage costs

Direct costs: PCT administration and program, including outsourcing budgets

Indirect costs: Building, IT, HR, ….

Note: The International Bureau (IB)’s efficiency in processing PCT applications can be measured by the unit cost of processing, defined as the average total cost of publishing a PCT application. Average total cost is determined by total PCT System expenditure, plus a proportion of expenditure on support and management activities. The unit cost includes the cost of all PCT activities, including translation, communication, management, etc. Costs have direct and indirect components. Direct costs reflect expenditure incurred by the IB in administering the PCT System and related programs. Indirect costs reflect expenditure for supporting activities, such as buildings and information technology. Indirect costs are weighted in order to take into account only the share that is attributable to the PCT System. The unit cost is calculated by dividing the total cost of production by the number of PCT applications published.

Thank you

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Entry into the National Phase
Is there life beyond the international phase?
Of course there is…. 

Some may say this is where it really gets interesting…
PCT National Phase

- After the end of the international phase (30 months)
- PCT is a gateway to national patent systems
- Leads to the grant (or refusal) of a patent by national or regional Offices
Decisions to be taken by the applicant

- Whether
  - to proceed with or drop the international application?

- When
  - at the end of 30 months (in some cases 31 months or more)
    - under Chapter I?*
    - under Chapter II?
  - early entry?

- Where (choice limited to designated/elected Offices)
  - which national Offices
  - which regional Offices

* LU and TZ continue to apply a 20-month time limit
Acts to be performed by the International Bureau

WIPO

Published international application* containing:
- bibliographic data
- copy of international application as originally filed (description, claims, abstract, drawings)
- copy of international search report and English translation (if not already in English)
- copy of any amendments to the claims (and any statement) under Article 19

Where no demand was filed: copy of IPRP (Chapter I) and English translation (if not already in English) and copy of any informal comments

Copy of priority document(s)*

* ONLY under Chapter II: copy of international preliminary report on patentability (Chapter II) including any annexes*

* ONLY under Chapter II: if not already in English, English translation of the international preliminary report on patentability (Chapter II), but not of annexes*

Designated/Elected Office

* Copies are sent, depending on the Office concerned, either during the international phase or, upon request from the Office to the International Bureau, after the applicant has entered the national phase
Acts to be performed by the Applicant

- Payment of the national fee
- Translation of the international application (description, claims, abstract, text matter of drawings) as originally filed**
  - **ONLY under Chapter I**: translation of claims as amended (and any statement) under Article 19**
  - **ONLY under Chapter II**: translation of the annexes to the international preliminary report on patentability (Chapter II)**
- In case of early entry into the national phase (i.e., before communication of copy of the international application by IB), copy of the international application**
- Fulfillment of certain special requirements under Rule 51bis (for example, appointment of agent, inventor's oath or declaration, assignment, etc.) **

** For further details on the requirements and time limits applicable in a particular designated/elected Office, see the relevant national chapter in the PCT Applicant’s Guide, National Phase
Recommendations for preparing entry into the national phase (1)

- Leave sufficient time, where necessary, to prepare the translation of the international application.

- Send your local agent, copies of the (relevant) documents on file: the published international application, the international search report and written opinion by the ISA, the international preliminary examination report, priority documents; note that none of these documents are required to be filed by the local agent at the local patent office.
Recommendations for preparing entry into the national phase (2)

- Where you would prefer avoiding paying additional claims fee or other fees that are applicable under any particular national law, prepare the application, and any amendments thereof, according to the national practice.

- Even though several designated/elected Offices provide for longer time limits, it is preferable to docket the 30-month time limits for all Offices (See www.wipo.int/pct/en/texts/reservations/res_incomp.html for exceptions under Article 22(1)).
A few further tips to remember

- Remember to monitor time limits for entering national phase
  - they apply irrespective of delays in the international phase

- Make necessary indications that application is entering the national phase, i.e., that it is not a direct national filing

- Translation of the international application must be correct and complete (no subject matter may be added and/or deleted)

- Pay the required fees (amount may be different from that applicable to direct national filing)
Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
  - unintentionally
  - or - at the option of the Office -
  - in spite of due care required by the circumstances
Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Applicants may submit a request for reinstatement and enter the national phase within:
  - 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
  - 12 months from the date of expiration of the time limit to enter national phase; whichever period expires first
DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f):
  - CA Canada
  - CN China
  - DE Germany
  - IN India
  - KR Republic of Korea
  - LV Latvia
  - MX Mexico
  - NZ New Zealand
  - PH Philippines
  - PL Poland

- The national law applicable by some of these Offices may nevertheless provide for other forms of protection against loss of rights - for further details, see for each DO/EO, the relevant National Chapter in the *PCT Applicant’s Guide*, National Phase.
630,000 national phase entries estimated for 2017 (+2.3%)

About 83% are non-resident national phase entries
526,000 non-resident national phase entries (+2.7%), 398,900 non-resident Paris-route filings (-1.9%) in 2017

57.3% of all non-resident applications filed through PCT in 2017 (56.3% in 2016)
U.S. origin national phase entries rose by 5.2% from 174,417 to 183,532 in 2017 (192,933 in 2015)

2.7% growth for China (after 3 successive years of >20% growth)
Growth in national phase entries for U.S. (+5.1%), EPO (+4.0%) and Japan (+4.1%) for 2017
Where to Get Help on the PCT?
PCT Resources/Information

For general questions about the PCT, contact the PCT Information Service at:

Telephone: (+41-22) 338 83 38
Facsimile*: (+41-22) 338 83 39
E-mail: pct.infoline@wipo.int

Contact the speaker:

mougamadou.abidine@wipo.int
+41-22-338-9289

* Note: Fax transmissions no longer recommended since January 1, 2018
Thank you

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