Patent Cooperation Treaty (PCT) related matters

Speaker: Christine Bonvallet, Head
PCT User Resources Section
PCT Legal and User Relations Division
Outline

- PCT Status Report
- PCT Working Group 2018
- PCT Assembly – Oct. 2018 – 1 July 2019 changes
- Transmission of National Phase Entry Data
- PCT Minimum Documentation
- PCT Recent Developments
Patent Cooperation Treaty Overview

Overview of the PCT System

- First filing: Application filed with national/regional patent office (priority date)
- PCT filing: 12 months
- International publication: 16 months
- Transmittal of international search report + written opinion: 18 months
- Communication by the International Bureau to national/regional offices: 22 months
- PCT national phase:
  - Application enters national phase before selected patent offices: 28 months
  - National or regional search and examination
  - Grant or refusal by national or regional offices

Benefits
- One PCT application with legal effect in all PCT Contracting States
- Harmonized formal requirements
- Receive patentability information to support strategic decision-making
- Postpone significant costs for national processing by 18 months

Source: WIPO, April 2018
Key Moments in PCT History

- 26 years to 1st million
- 7 years to 2nd million
- 5 years to 3rd million
PCT Applications

2017: 243,500 (+4.5%)
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International applications received in 2017 by country of origin

- 23.3% originating in US, 20% in China, 19.8% in Japan
- 63% from the top 3 countries, 77% from top 5 countries, 93% of filings from top 15 countries

CN: +13.4% (double digit growth every year since 2003)
SE: +7%
JP: +6.6%

Asia: 49.1%
Europe: 24.9%
North America: 24.3%
Distribution of PCT Applicants in 2017

- Businesses: 84.8%
- Individuals: 5.4%
- Universities: 1.9%
- Government: 8%

IP Information Roundtable 9
30.10.2018
Top PCT Applicants 2017

Top 50 applicants:

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() of published PCT applications

- JP (15)
- US (13)
- CN (10)
- DE (5)
- KR (3)
- NL (2)
- FR (1)
- SE (1)
Top University PCT Applicants 2017

1. University of California (US)
2. Massachusetts Institute of Technology (US)
3. Harvard University (US)
4. University of Texas (US)
5. Johns Hopkins University (US)
6. University of Florida (US)
7. Seoul National University (KR)
8. Hanyang University (KR)
9. Stanford University (US)
10. Korea Advanced Institute of Science and Technology (KR)
11. Shenzhen University (CN)
12. Columbia University (US)
13. University of Tokyo (JP)
14. University of Michigan (US)
15. China University of Mining and Technology (CN)
16. King Abdullah University of Science and Technology (SA)
17. University of Pennsylvania (US)
18. Korea University (KR)
19. Tsinghua University (CN)
20. Tohoku University (JP)
Top Government and Public Research Organization PCT Applicants 2017

1. Commissariat à L’Energie Atomique et aux Energies Alternatives (FR)
2. Fraunhofer-Gesellschaft Zur Förderung Der Angewandten Forschung E. V. (DE)
3. China Academy of Telecommunications Technology (CN)
4. Institut National de la Santé et de la Recherche Médicale (FR)
5. Centre National de la Recherche Scientifique (FR)
6. Agency of Science, Technology and Research (SG)
7. National Institute of Advanced Industrial Science and Technology (JP)
9. Shenzhen Institute of Advanced Technology (CN)
10. Mayo Foundation for Medical Education and Research (US)
11. Council of Scientific and Industrial Research (IN)
12. Sloan-Kettering Institute for Cancer Research (US)
13. Consejo Superior de Investigaciones Científicas (ES)
15. Commonwealth Scientific and Industrial Research Organisation (AU)
16. Cedars-Sinai Medical Center (US)
17. Nederlandse Organisatie Voor Toegepastnatuurwetenschappelijk Onderzoek TNO (NL)
18. Institute of Physical and Chemical Research (JP)
PCT Working Group 2018
PCT WG 2018 Outcomes

- Agreed amendment to Rule 69.1(a), allowing IPEA to begin IPE when in possession of demand, fees, ISR and WO (effectively reversing current default, unless applicant requests postponement)
- IB to draft new amendment proposals for 2019 WG on “erroneously filed elements and parts”
- IB to consult member States on issues relating to proposed fee reduction for universities and prepare document for 2019 WG on options and implementation issues
- IB invited to work with Offices and users on requirements and proposals for systems to assist national phase entry
- Noted:
  - IB-proposed priorities and directions for future development of PCT
  - document on PCT applications linked to UN Security Council sanctions, and concluded that IB’s existing arrangements for handling such cases are appropriate and fully consistent with PCT
  - preparations for launch of 3rd pilot on collaborative search and examination between IP5 offices
PCT Rule Changes – 1 July 2019

- Amendment to PCT Rule 69.1(a):
  - IPEA can start the IPE once it is in possession of the demand, the fees, the ISR (or Article 17.2(a) declaration) and written opinion, unless the application expressly requests to postpone the start of the IPE until the expiration of the time limit under PCT Rule 54bis.1(a)
  - Adopted a document for appointment of an ISA

- Above amendments enter into force on July 1, 2019 and will apply to PCT applications for which a Chapter II demand is filed on or after that date
Transmission of National Phase Entry Data
Transmission of National Phase Entry Data (NPE) – Aims

Before July 1, 2017

- Designated Offices provided NPE data to International Bureau on voluntary basis
- 50 designated Offices had provided data, but only 16 on a “regular” basis

Aims of Rule Changes from July 1, 2017:

- Improved access to information on where protection is sought
- Better linkage to national phase publications in languages different from international application
Revised Data Format for Collection of National Phase Information (1)

Revised Data Format Specifications for the Collection of PCT National Phase Information (version number 4.1)*

Offices required to send within 2 months the following data items for events in national phase:

- Office code (WIPO Standard ST.3)
- International application number
- National application number
- Event type
- Event date
- National publication number (where relevant)
- Kind code of publication (where relevant)

* Available at http://www.wipo.int/patentscope/en/data/index.html#backfile
Revised Data Format for Collection of National Phase Information (2)

Compulsory event types:
- National phase entry
- National publication
- Date of grant of patent (publication of granted patent or notice of grant)

Optional event types:
- Refusal
- Withdrawal
- Continuation of processing after refusal or withdrawal
- Divisional application

Data transmitted in CSV or XML format
Transmission of National Phase Entry Data -- Update

NPE – Status Report (Document PCT/WG/11/10)

- In addition to the PCT Electronic Data Interchange (PCT-EDI) system, national entry data can be also provided by means of an ‘Action’ through ePCT

- In the context of IPAS, WIPO has updated the WIPO Publish software application to include automatic process for furnishing national phase entry data (on this, please find additional information in document WIPO/IP/ITAI/GE/18/4)

- 63 designated Offices have provided data, 32 on a “regular” basis (Reminder: maximum number of DOs supplying national phase entry data is 124[152])
PCT Minimum Documentation
PCT Minimum Documentation – Definition

PCT Rule 34 defines the minimum documentation that an International Searching Authority is required to consult:

- national patent documents (as specified in Rule 34.1(c))
- published international (PCT) applications, published regional applications for patents and inventors’ certificates, and published regional patents and inventors’ certificates
- other published items of non-patent literature as the International Searching Authorities shall agree upon and which shall be published in a list by the International Bureau …
PCT Minimum Documentation – Lists of Patent Documents and Periodicals

WIPO Handbook on Industrial Property Information and Documentation

  - Last updated in November 2001
  - People’s Republic of China and Republic of Korea since added to Rule 34.1(c)
  - Numbers contained as ranges – unused numbers not always identified
  - Scope of national patent documents part of minimum documentation under Rule 34.1(c)(vi)

- Part 4.2 – List of Non-Patent Literature
  - Last updated in February 2010
PCT Minimum Documentation – Issues

PCT minimum documentation requires revision:

- Definition of patent documents for electronic searching
  - Standards for Offices to have their national collections included in the PCT minimum documentation and allow access to Authorities and database providers
  - Types of documentation – utility models
  - Components of patent data that should be present in patent collections in PCT minimum documentation

- Non-patent literature
  - Electronic access to periodicals
  - Traditional knowledge databases (Indian TKDL)
PCT Minimum Documentation Task Force

- European Patent Office took over leadership in 2016
- Four objectives (EPO High Level Position Paper – Appendix to document PCT/MIA/24/4)
  - Objective A: Create up-to-date inventory (patent and non-patent parts)
  - Objective B: Recommend criteria and standards for including a national patent collection
  - Objective C: Propose bibliographic and text components of patent data that should be present in patent collections
  - Objective D: Recommend criteria and standards for non-patent literature and assess proposal for adding Indian TKDL
Objective A – Create up-to-date inventory (patent and non-patent parts)

- Discussions on lists of Patent Publications belonging to the PCT minimum documentation updated by the EPO: Document dated October 27, 2017
- Discussions on lists of Non-Patent Literature belonging to the PCT minimum documentation updated by the EPO: Document dated October 27, 2017

- Comments due by November 13, 2017

Objective B – Recommended criteria and standards for including a national patent collection in the PCT Minimum Documentation

- Discussions on PCT Minimum Documentation – Language Issues updated by the EPO: Document dated May 16, 2018
Objective B (Continued)

- Discussions on proposal to include utility models in the PCT Minimum Documentation updated by the EPO: Document dated May 16, 2018
  - Comments due by September 10, 2018

Objective C – Proposed clearly-defined bibliographic and texts components of patent data in patent collections belonging to the PCT Minimum Documentation

- Discussions based on the latest document issued by the EPO, dated May 16, 2018 (WIPO Standard ST.37)
  - Comments due by September 10, 2018
Objective D – Discussions to be led by the United States Patent and Trademark Office (USPTO) and assess proposal for adding Indian TKDL

- Circular C. PCT 1544 (July 9, 2018): Questionnaire sent to ISAs and IPEAs (currently, comments under review)
- Report to Meeting of International Authorities in February 2018 (documents PCT/MIA/25/4 and PCT/MIA/25/9)

Sept-Nov. 2018 Round 4 discussions

Final report to MIA with Recommendations in Dec. 2018
Recent developments
Recent Developments

- New ISAs/IPEAs
- PCT Highlights
- PCT Collaborative Search and Examination Pilot Group (CS&E)
- Licensing availability
- Third Party Observations
- ePCT Coverage
New ISAs/IPEAs

- Twenty three (23) Offices now hold the status as ISA/IPEA

  - The State Intellectual Property Service of Ukraine (SIPSU) started operations as an ISA/IPEA on 5 February 2016

  - The Visegrad Patent Institute started operations as ISA/IPEA on 1 July 2016

  - Turkish Patent and Trademark Office started operations as from 8 March 2017

  - The Intellectual Property Office of the Philippines has been appointed as an ISA/IPEA (2017) (*not yet operational*)
PCT Highlights

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

- Targeted, in particular, at managers and attorneys

- Possibility to subscribe to the PCT Highlights mailing list for update notifications

Collaborative search & examination

- 3rd pilot on a collaborative search & examination
- IP5 Offices (EPO, USPTO, JPO, SIPO, KIPO)
- 100 files per Offices over the first two years

CS&E Request

CS&E: Process model

PCT ISA checks CS&E criteria fulfilled, formalities examination, confirms acceptance

ISA Examiner (Step 1) Carries out search, prepares provisional opinion and provisional search report

ISA Examiner (Step 2) Produces final International Search Report and Written Opinion

"Peer" examiners 4 other IP5 Offices Contribution based on ISA provisional opinion and search report

Product CS&E International Search and Written Opinion

Evaluation CS&E metrics will be monitored over the lifetime of the 500 applications

Expected Benefits

Earlier information from all IP5 offices

All offices contribute to product quality

Applicant driven

100 files per ISA over 2 years
Licensing availability (1)

- 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
1. The applicant hereby requests the International Bureau to indicate the availability for licensing purposes of the invention(s) claimed in this international application on the PATENTSCOPE website.

2. Licensing terms (optional): The applicant is willing to license the claimed invention(s):
   - [ ] in:
     - [ ] all PCT Contracting States
     - [ ] all PCT Contracting States except (indicate each State by its two-letter code): __________________________

Language: English

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Language: English

992 results
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

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### PATENT COOPERATION TREATY

#### PCT

#### THIRD PARTY OBSERVATION

**PCT Administrative Instructions Part 8**

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#### Basis and contents of observation

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   - References to documents: 1
   - Uploaded copies of documents: 0
3. Further explanations:
   - Uploaded copies of documents: 1

#### Citation # 1 (Patent/utility model) (# uploaded documents: 0):

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“PCT Direct” (1)

- 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
PCT Direct Concept

- File local application
- Receive local search opinion (same Office as ISA (EP/IL))
- File PCT application
- International search report & written opinion
- (optional) File demand for International preliminary examination
- Possibility of amendments and arguments to IPEA
- Possibility of informal comments
- Possibility of comments on local search opinion in view of adding value to ISR and WO
- “PCT Direct Letter”
- Enter national phase
- Possibility of amendments and reaction according to national law

(months)

0-12

12

16

22

30
“PCT Direct” (2)

Requirements:

- the informal comments are filed together with the PCT application
  - with any RO if ISA/EP is chosen
  - with RO/IL if ISA/IL;
- EPO or Israel Patent Office is selected as ISA;
- the PCT application claims priority of an earlier application searched by the
  - EPO (European first filing or national first filing)\(^1\)
  - Israel Patent Office

Form:

- the informal comments are filed in form of a “PCT Direct Letter” in a single document in PDF format and the words “PCT Direct/informal comments” have been indicated under “Other” in Box IX of the PCT request form (Form PCT/RO/101)

\(^1\) The EPO performs national searches for France, Netherlands, Belgium, Luxembourg, Italy, Turkey, Greece, Cyprus, Malta, San Marino, Lithuania, Latvia and Monaco
Informal comments:

- They are arguments regarding the patentability of the claims of the PCT application.
- May include explanations regarding any modifications to the application documents, in particular to the claims, in comparison with the earlier application (e.g. marked-up copy).
- Aim at overcoming objections raised in the search opinion established for the priority application.
- Do not form part of the PCT application, but are made publicly available on PATENTSCOPE.
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Thank you for your attention!

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