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PCT Related Matters

IP Information Roundtable

Geneva
25 October
2017

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Outline

- Amendments to PCT Regulations as from 1 July 2017
- Transmission of National Phase Entry Data
- PCT Minimum Documentation
- PCT Assembly – October 2017

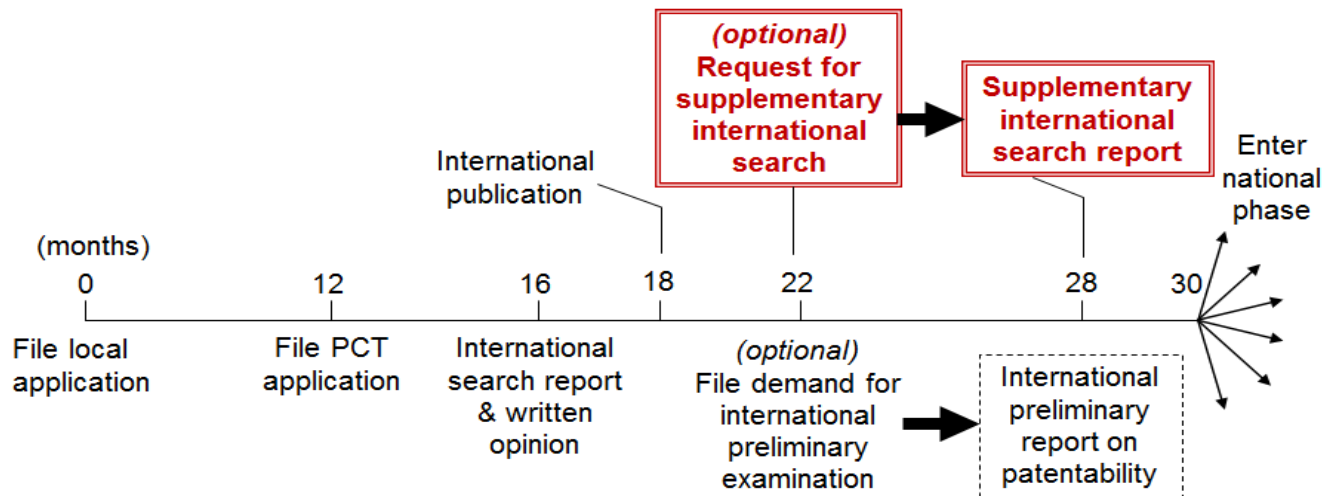


Amendments to the PCT Regulations as from 1 July 2017

PCT Rule Changes (1)

■ Amendment to PCT Rule 45*bis*.1

- Extension of the deadline for requesting supplementary international search from 19 to 22 months from the priority date
- Effective for international applications in respect of which the 19-month time limit for filing a supplementary search request has not yet expired



PCT Rule Changes (2)

- Amendment to PCT Rules 12*bis*, 23*bis* and 41
 - Transmittal of earlier search and/or classification results by ROs to ISAs
 - General Rule: ROs forward the search/classification results from priority applications without the applicant's express permission
 - Exception:
 - ROs which have notified the IB (before April 14, 2016) of incompatibility of such forwarding with applicable national law
 - Even where an RO in principle applies the procedure above, they may allow applicants to request, at the time of filing of the PCT application, not to have the earlier search results forwarded to the ISA, if the RO notified the IB accordingly (before April 14, 2016)
 - Applies to applications filed on or after July 1, 2017

PCT Rule Changes (3)

- Amendment to PCT Rules 86 and 95
 - Obligation for designated Offices to send national phase entry and related data to the IB
 - Data required to be transmitted:
 - Date national phase entered
 - National application number
 - Number and date of national publication
 - Date of grant, and number and date of national publication as granted
 - Time limit for reporting: 2 months from event (or as soon as reasonably possible thereafter)
 - Objective: visibility of the status of PCT application during the national phase on PATENTSCOPE under the “National phase” tab
 - Applies to applications for which the acts referred to in Article 22 or Article 39 are performed on or after July 1, 2017



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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 (NPE) – Update

- NPE data from more than 30 designated Offices in revised data format available in PATENTSCOPE
- “WIPO Publish Module” available for Offices using IPAS to meet new NPE data transmission requirements
- International Bureau continuing with efforts with remaining Offices to provide transmission files
- Verification of timeline of data coverage for Offices supplying data to start in coming months
- Development of XML schema components based on WIPO Standard ST.27 to facilitate exchange of patent legal status data may affect specification in future



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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

- Part 4.1 – Inventory of Patent Documents (1920 – 2000)
 - 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

PCT Minimum Documentation Task Force – State of Play

- Objective A – Create up-to-date inventory
 - Discussions on lists of patent documents and non-patent literature in PCT minimum documentation updated by the EPO
- Objectives B and C – discussions in 2017 and 2018
- Objective D – Discussions to be led by the United States Patent and Trademark Office

- Report to Meeting of International Authorities in February 2018



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PCT Assembly – October 2017

PCT Assembly Decisions

- Appointed Intellectual Property Office of the Philippines as an International Searching and Preliminary Examining Authority
 - Effective when Office notifies date when it is ready to begin operations
- Extended appointment of the 22 present International Searching and Preliminary Examining Authorities until end 2027
 - New agreements between International Bureau and each Authority enter into force on January 1, 2018
- Adopted amendments to PCT Regulations and an Understanding

PCT Rule Changes

- Amendment to Schedule of Fees
 - Clarification that 90% reductions in item 5 are intended only for persons filing an international application in their own right and not those filing an international application on behalf of a person or entity not eligible for the reduction
- Amendment to PCT Rules 4.1 and 41.2
 - Correction of references to reflect amendments to Rules 12*bis* and 23*bis* adopted in 2015 and 2016
- Above amendments enter into force on July 1, 2018

Understanding in relation to Fee Reductions

- PCT Assembly adopted an Understanding in relation to fee reductions in item 5 of the Schedule of Fees
 - Reduction in item 5 “is intended to apply only in the case where the applicants indicated in the request are the sole and true owners of the application and under no obligation to assign, grant, convey or license the rights in the invention to another party which is not eligible for the fee reduction”
- Entered into force on October 11, 2017



Thank you!

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