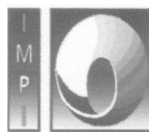


WIPO/INV/MTY/02/20

ORIGINAL:English

DATE:April2002



MEXICANINSTITUTEOF  
INDUSTRIALPROPERTY



WORLDINTELLECTUAL  
PROPERTYORGANIZATION



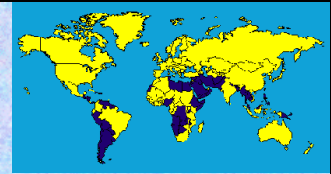
INSTITUTEOFTECHNOLOGYAND  
SUPERIORSTUDIESOFMONTERREY

**INTERNATIONALWORKSH OPON  
MANAGEMENTANDCOMME RCIALIZATIONOFINVENT IONS  
ANDTECHNOLOGY**

organizedby  
theWorldIntellectualPropertyOrganization(WIPO)  
incooperationwith  
theMexicanInstituteofIndustrialProperty(IMPI)  
and  
theInstituteofTechnologyandSuperiorStudiesofMonterrey(ITESM)  
**Monterrey(Mexico),April17to19,2002**

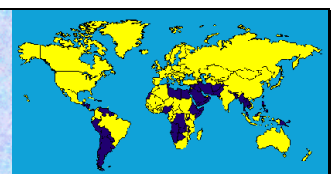
PATENTINGSTRATEGIEANDTHEPATENTCOOERATIONTREATY(PCT)

*DocumentpreparedbyMr.JohnH.Hornickel,ChiefIntellectualPropertyCounsel,  
Bridgestone/FirestoneAmericasHolding,Inc.,Akron,  
Ohio,UnitedStatesofAm erica*

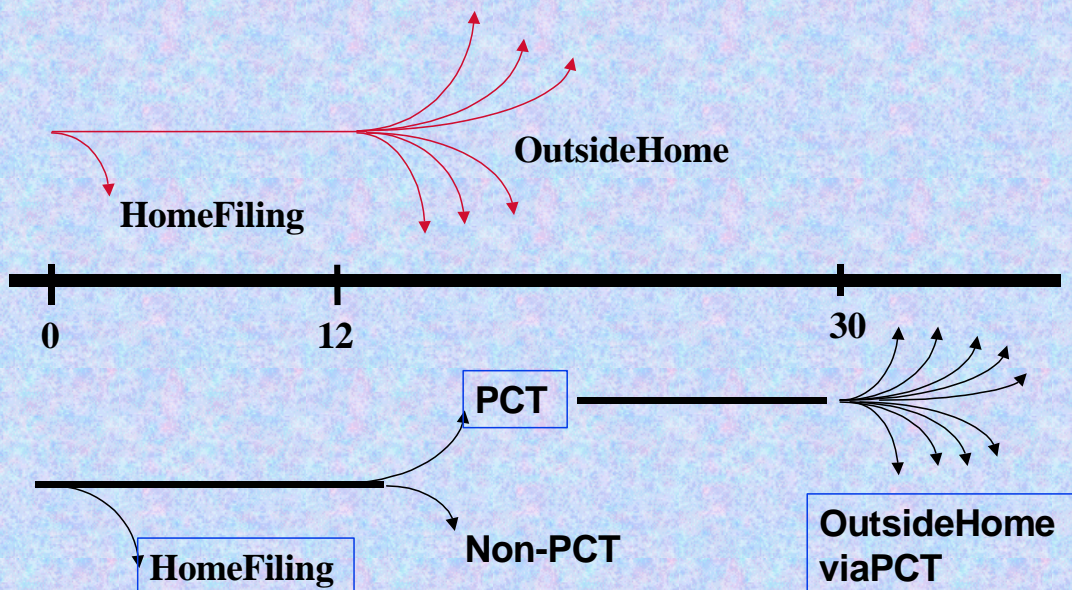


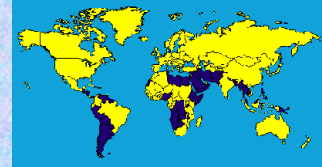
# The Patent Cooperation Treaty

- A Cooperation Among Governments to Benefit Inventors and Investors
- Now Over 100 Countries Participate
- Inventors Use One Patent Application to Seek Protection
- Investors Have One Source of Information to Make Decisions



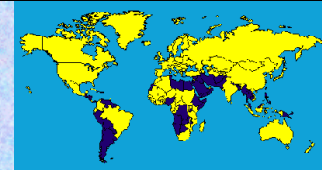
# Basic PCT Timeline





## ThePCT

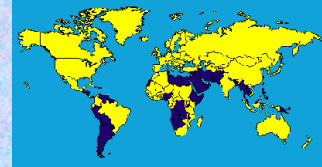
- APatentSystemThatProtectsInventorsand InformsInvestorstofromMarkets
- MajorWorldLanguagesUsed
- InventorsGetaFormalitiesExamination,a Search,aPublication,andaPreliminary SubstantiveExamination
- InvestorsGetPublicationInformationand ExaminationInformation



## ThePCT (Continued)

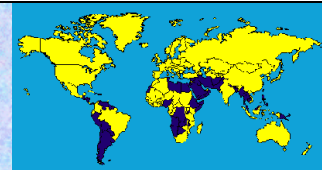
- InventorsGetTIME
- InvestorsGetTIME
- TheMarketHasItsOwnTime
- Publicationat18MonthsfromFirstApplication FilingSetsTimeinMotion





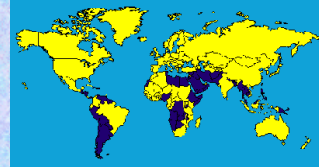
## The PCT (Continued)

- Consolidates Inventor Efforts
- Delays Inventor and Investor Expenses
- Maintains Options for Both Inventor and Investor
- Predicts Results of Patenting Systems
- Preserves Unity of Invention



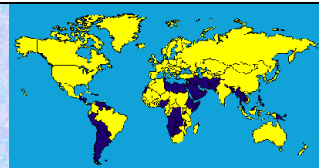
## PCT Preamble

- Desiring to Make A Contribution to the Progress of Science and Technology
- Desiring to Perfect the Legal Protection of Inventions
- Desiring to Simplify and Render More Economical ... the ... Protection for Inventions
- Desiring to ... Accelerate Access to Technical Information [of] ... Inventions



## PCT Preamble

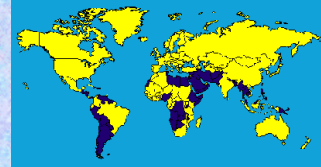
- **Desiring to Foster and Accelerate Economic Development of Developing Countries ... to Increase the Efficiency of their Legal Systems ... Instituted for the Protection of Inventions,**
- **The Contracting States have adopted the PCT.**



## PCT Formalities

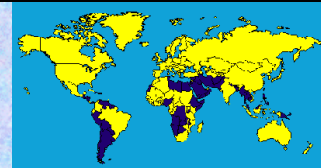
- **One Application, One Set of Drawings, Variable Claim Options**
- **Standardized Request and Demand Forms**
- **“PCT Easy ” Software**
- **Efficient Regional Patent Designations**
- **>6 Designations at One Price**





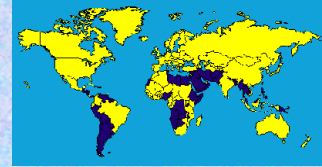
## PCTSearch

- Various Authorities including European Patent Office (EP)
- EP is Premier Searching Authority With Three Official Languages and Major Venue for European Patenting
- EP has Quite Refined Customized Functional Searching Classifications



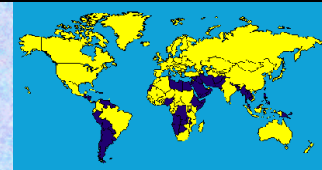
## PCTPublication

- Information for Investors and the Market
- One Document (The “Pamphlet”) Contains Names of Inventor(s)/Applicant(s); Invention; Claims; Search Results
- Easily Available on Paper, CDROM, Internet -- Public and Private Sources
- “Mystery” of Investment -- All Designations



## Article 19 Amendments

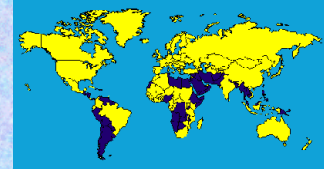
- Opportunity to Adjust Claims between Search Results and Publication
- Helpful for Preliminary Protection Designations
- First Opportunity to Amend Application
- Conservative Use Unless Major Unexpected Prior Art Found in PCT Search Results



## PCT Preliminary Examination

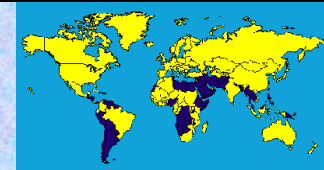
- Various Authorities including EPO (EP)
- Identify in Demand Form before 19 Months from First Application Filing
- EP is Premier Substantive Examination Location
- “Unofficial” Start to EP Regional Examination





## PCT Preliminary Exam

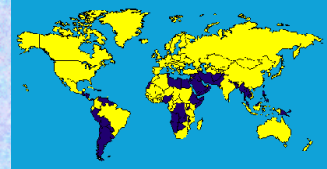
- EPPatentAttorneyAssistanceIsOptional
- DirectEPPatentPracticeisVery EfficientandEducational
- UseofSubstitutePagestoAmendApplication andClaims
- Goalofa “PositiveReport ” fromEPO Examiner



## PCT “PositiveReport ”

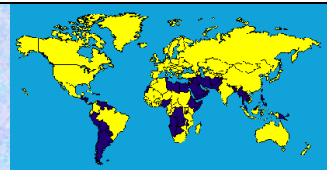
- *VeryPersuasive* Decision
- AsCloseAsInventorsandInvestorsHavetoa WorldwidePatentingDecision
- ThePCTApplicationofthePositiveReport BecomesRegisteredin “Registration” Countries
- APositiveReportfromEPExaminer MinimizesEPRegionalExamination





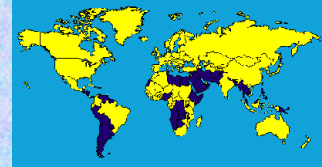
## PCT National or Regional Stage

- Decision at 30 Months Before Large Expenses of Translations and National Filing/Associate Fees
- What Elected States to Delete
- What Countries in Regional Election to “Add”
- Use IPER to Best Advantage



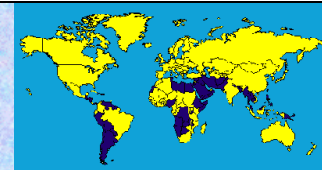
## International Phase Advantages

- One Application
- One Language
- One Extended Timeline
- Multiple Choices--One Best for Each Invention



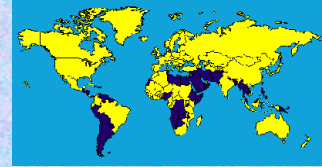
## PCTChoice#1

- Wheretofile?
- ApprovedLocalReceivingOffice
- WIPOInternationalBureau(IB)
- NationalSecurityConsiderations



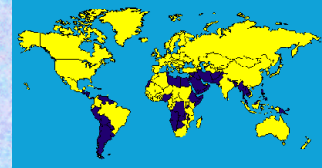
## PCTChoice#2

- Whentofile?
- PriorityApplication
- ParisConventionorWTOTreatyApplication



## PCTChoice#3

- When in Paris Convention Year?
- At 11 Months, 29 Days
  - Client Decisions
  - Patent Term Starts as Late as Possible
- At 4-5 Months
  - Patent Term Starts Earlier
  - Search Results Available in Paris Convention Year



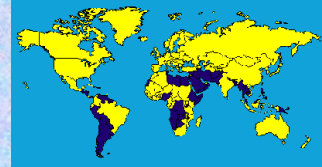
## PCTChoice#4

- What Countries to Designate?
- USA (English)
  - Inventor Signatures
  - Unity of Invention vs. Restriction Practice
- EPO (English)
  - One Designation Saves Choice to Regional Stage
- ARIPO (English)





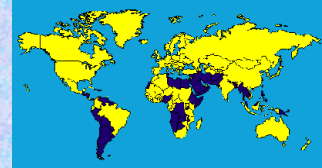
## PCTChoice#4 (Continued)



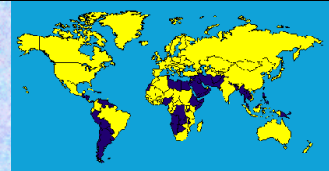
- OAPIRegion(French)
- EurasianRegion(Russian)
- China
- India
- Japan
- Canada
- Mexico



## PCTChoice#4 (Continued)

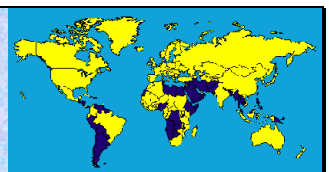


- Australia
- NewZealand
- UnitedArabEmirates
- SouthKorea
- Singapore
- Israel



## PCTChoice#4 (Continued)

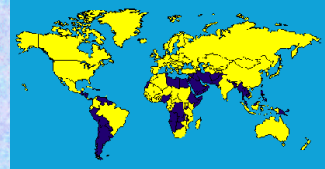
- Non-EPO European Countries
  - Norway
  - Central Europe
- Latin America
  - Cuba
  - Costa Rica
  - Colombia
  - Ecuador



## PCTChoice#5

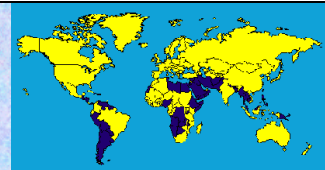
- What Claims to Prosecute in National Stage?
- Those Searched.
  - No Demand Needed
- Those Preliminary Examined.
  - What Was IPER Result?
  - Methods of Medical Treatment
  - Methods of Doing Business





## PCTChoice#6

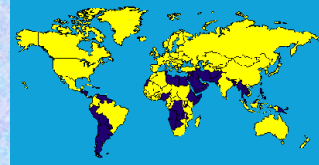
- WhentoEnterNationalStage?
- ChapterIafterSearchandPublication
- ChapterIIafterPreliminaryExamination
- ChapterIIDuringPreliminaryExamination
  - USANationalStageIssues
  - 102(e)StatuswithNationalStage
  - PCTArticle 40 vs. “EarlyProcessing”



## PCTChoice#7

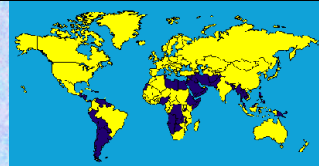
- WhentoRequestFinalExamination?
- USAand102(e)Issues
- Japanbefore7YearsfromPCTFilingDate  
(Soontobe3Years)
- Canadabefore7YearsfromPCTFilingDate
- Koreabefore5YearsfromPCTFilingDate





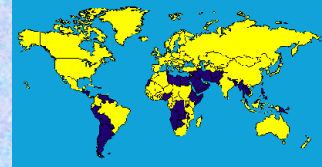
## Inventors and Investors at 50 Months from PCT Filing

- A Formalities Examination
- A Publication of Invention with Search Report
- A Preliminary Examination of Substance
- A Clear Route to Registration
- A Refined Route to Substantive Allowance
- All Before Translations and Local Fees
- A Choice of 100+ Countries



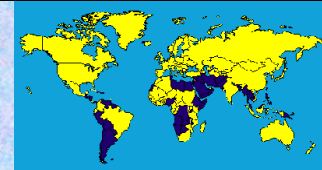
## PCT Costs and Benefits

- Rules Familiarity
- Forms Familiarity
- Docketing Familiarity
- Payment for Added Time and Service
- Claims of Priority
- Added Choices Reduce Mechanization of Office Procedure



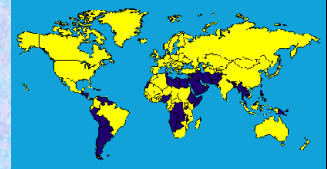
## PCTResources

- LittleRedBookofTreatyandRegulation
- PCTApplicant'sGuide
- WIPOInternetWebSite
  - PCTPublications
  - OfficialGazette
  - AdministrativeInstructions
  - SearchandExaminingGuidelines



## PCTResources Continued

- PCTNewsletter
- WIPOPCTHelpDesk
- WIPOPCTLegalDivision
- AIPLAPCTIssuesCommittee
- EPOExaminationGuidelines(Maroon)
- EPOCaseBook(White)



Thankyou.



**BRIDGESTONE/FIRESTONE**

**AMERICAS HOLDING, INC.**

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ChiefIntellectualPropertyCounsel

Phone:330 /379-4605Fax:330/379 -3816

Email: HornickelJohn@bfusa.com

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