

Australian Patent Office KRW

Korean Intellectual Property Office AUD, SGD

The above-mentioned changes are indicated in Fee Table I(b).

(Updating of *PCT Applicant's Guide*, Annexes D (AU and KR))

PCT-SAFE Update

Release of new version of the PCT-SAFE Client software

A new version of the PCT-SAFE Client software (version 3.51.075.251, dated 1 October 2016) is now available and can be downloaded at:

http://www.wipo.int/pct-safe/en/download/download_client.html

Further details on this new version of PCT-SAFE are available in the “Release notes” and the “What’s new” document on the above-mentioned web page.

New/Updated PCT Resources

Seminar materials

Seminar materials, covering all aspects of the PCT procedure, have been updated in English, Japanese and Spanish to take into account the amendments to the PCT Regulations which entered into force on 1 July 2016 and are available at, respectively:

http://www.wipo.int/pct/en/seminar/basic_1/document.pdf

http://www.wipo.int/pct/es/seminar/basic_1/document.pdf

http://www.wipo.int/pct/ja/seminar/basic_1/document.pdf

Other languages will follow shortly.

In addition, seminar materials, based on an advanced PCT seminar which was held at WIPO Headquarters in Geneva on 26 and 27 September 2016, are now available in English at:

http://www.wipo.int/pct/en/seminar/basic_1/advanced_seminar.pdf

The information included in the document covers the procedural aspects of the international and national phases, the filing and management of PCT applications in ePCT, and recent and future PCT developments.

Warning about requests for payment of fees: legal actions against fraudulent entities

Information about successful legal actions against fraudulent entities is now available at:

<http://www.wipo.int/pct/en/warning/judgments/successes.html>

This includes a Judgement of a Florida Court and a Ruling of the Supreme Court of Czechia (formerly Czech Republic).

IPO closed dates search engine

A new design of the search engine for intellectual property Offices' closed dates, which features improved navigation, is available in Chinese, English, French and Spanish at, respectively:

<http://www.wipo.int/pct/dc/closeddates/page/index.xhtml?lang=ZH>

<http://www.wipo.int/pct/dc/closeddates/faces/page/index.xhtml>

<http://www.wipo.int/pct/dc/closeddates/page/index.xhtml?lang=FR>

<http://www.wipo.int/pct/dc/closeddates/page/index.xhtml?lang=ES>

PCT forms

Form PCT/IB/384 (Request for Omission of Information from International Publication and/or Public File Access) is now available in editable PDF format in English and French at, respectively:

http://www.wipo.int/pct/en/forms/ib/editable/ed_ib384.pdf

http://www.wipo.int/pct/fr/forms/ib/editable/ed_ib384.pdf

PATENTSCOPE Search System

WIPO Translate Now Available for Bibliographic Data and Long Japanese and French Documents

WIPO Translate, the machine translation tool developed by WIPO and available within the PATENTSCOPE user interface, now offers translation of full-length documents into Japanese and French from English, and vice versa. This feature was introduced last year for long Chinese texts.

It is recalled that WIPO Translate also offers translation of bibliographic data from/to any of the following languages: German, English, Spanish, French, Japanese, Korean, Russian and Chinese. Bibliographic data in languages other than English will first be translated into English and then into any of the languages supported. It is, for example, now possible to translate bibliographic data in Chinese into Russian using WIPO Translate.

As for previous versions, WIPO translate has been trained exclusively on patent texts and operated with a secure https protocol. Note that independent evaluation tools show that it is more accurate than other publicly available solutions and, as a result, users can get a better, clearer idea of the nature of an invention than may be possible with external translation tools.

PCT in the News

A link to the following article in the *WIPO Magazine* (No. 5/2016) has been added to the "PCT in the News" page of the PCT website.

Francis Gurry on the challenges for multilateralism in the field of intellectual property

During the WIPO Assemblies, which took place between 3 and 11 October 2016, the Director General of WIPO, Francis Gurry, shared his views on the challenges for multilateralism in the field of intellectual property. About the PCT, he stated:

“We are seeing a huge amount of change in the IP system. One obvious example is the shift in the geography of innovation. Three Asian countries are now among the top five patent filing countries in WIPO’s PCT System. Japan and China are in second and third position after the United States, and the Republic of Korea is in fifth position after Germany. This is a huge change that we have seen unfold over the last 20 years. A similar shift has occurred in the areas of scientific and creative production. That is an area of great change that will continue.

The full article and other extracts from the *WIPO Magazine* are available at:

http://www.wipo.int/pct/en/news/pct_news.html

The *WIPO Magazine*, Issue No. 5/2016 is available at:

http://www.wipo.int/wipo_magazine/en/2016/05/

Practical Advice

Requesting early publication of an international application

Q: I am the agent for an applicant in respect of an international application which is to be filed shortly. The applicant is keen to have the application published early, so that the invention will become part of the prior art as early as possible. If I request early publication of the application under PCT Article 21(2)(b)), are there any issues that I should be aware of?

A: The international application becomes part of the prior art as soon as it is published (see PCT Rule 34.1(b)(ii)). Clearly, earlier publication means that your competitors will be able to see the contents of your application earlier than is normally the case. Furthermore, early publication of your application may be cited against you in relation to your later-filed applications in the same field, and so early publication needs to be considered very carefully. Nevertheless, for many applicants, it may bring significant advantages. Earlier publication may result in your application being able to be cited as prior art with effect from an earlier date than would normally be the case in any future search of a patent application filed by a third party. This may more easily allow you to prevent a third party from obtaining a patent for the same or a closely-related invention. It will put you at an advantage over competitors, and may be especially useful in respect of countries where you have no intention of entering the national phase. Earlier publication also means that your invention will be made available to the public earlier, and may confer earlier provisional protection before certain designated (or elected) Offices and under certain conditions.

International publication normally takes place promptly after the expiration of 18 months from the priority date (PCT Article 21(2)(a)), although it can take place earlier than this if you request the International Bureau (IB) to publish the international application before the expiration of the above-mentioned time limit (PCT Article 21(2)(b)). You can do this by submitting an online request to the IB using the Action “Request for Early Publication” in ePCT private services. After signing and submitting the request for early publication, a message is displayed to confirm that the ePCT Action has been successfully submitted to the IB for processing. Early publication of the international application can also be requested by way of a signed letter uploaded into ePCT public services or sent by fax or mail to the IB.

The IB will do its best to publish the international application as soon as possible after receipt of the request for early publication, provided that any necessary fees have been paid. Note,

however, that publication will not be immediate, as the IB will, for operational reasons, need some time to prepare your application for publication. For example, if the abstract has not yet been translated, the PCT Translation Division would need time to do this. The IB will acknowledge receipt of your request for early publication, and will notify you of the new scheduled publication date.

Requesting early publication of the international application may, however, affect certain procedures during the international phase, and you are advised to take the following considerations into account before making such a request.

Filing the international application with the IB as receiving Office (RO/IB)

If you would like to request that international publication takes place as early as possible in the international phase, you may wish to consider the advantage of filing with the RO/IB – this could reduce the processing time prior to publication by eliminating the amount of time that a national or regional Office acting as receiving Office might take to transmit the record copy to the IB. For information on filing an international application at the RO/IB, please see “Direct filing of PCT applications with the International Bureau as PCT receiving Office (RO/IB)” at:

<http://www.wipo.int/pct/en/filing/filing.html>

Request for early publication where the ISR is not yet available to the IB

If you request early publication of the international application too early, the International Searching Authority (ISA) may not have had time to carry out the international search, and so the international application will have to be published without the international search report (ISR) (or, as the case may be, declaration under PCT Article 17(2) that the ISA will not carry out the search). If the ISR is not yet available for publication together with the international application, the IB will charge a special publication fee, the amount of which is indicated in the *PCT Applicant's Guide*, Annex B (IB) (at the time of writing, it is CHF 200). International publication would take place as soon as possible after receipt of the request for early publication and after payment of the special fee. The international application would then be republished later, upon receipt of the ISR, and, since you would still have two months from the establishment of the ISR or 16 months from the priority date (whichever time limit expires later), to make amendments to the claims under PCT Article 19 (see PCT Rule 46.1), if the IB receives such amendments within that time limit, the international application would be republished again.

Request for early publication where the International Search Report (ISR) is already available to the IB

If the ISR is already available to the IB, there is no fee payable for making a request for early publication. International publication will be effected by the IB as soon as possible after receipt of the applicant's request for early publication. As mentioned above, you would still have two months from the establishment of the ISR or 16 months from the priority date (whichever time limit expires later) to make PCT Article 19 amendments, and if the IB receives such amendments within that time limit, the international application would be republished.

Actions which may have to be taken earlier than usual

If you request early publication of the international application, there are certain actions which may need to be taken before the (earlier) completion of technical preparations for publication (which usually occurs 15 days prior to the date of international publication). Some of the actions

that you would need to take in good time before completion of technical preparations are discussed below.

- Requesting a change under PCT Rule 92*bis* concerning the applicant, agent, common representative or inventor if that change is to be reflected in the international publication.
- Correction of physical defects in the international application: any physical defects in the international application should be corrected before the request for early publication is made if you wish any such correction to be included in the published international application. Notwithstanding, if the receiving Office invites you to make a correction giving a time limit which expires after completion of technical preparations for international publication, and you submit the correction after completion of technical preparations for publication, any such correction would be the subject of a republication of the international application.
- Correction or addition of a priority claim: if you need to request a correction or an addition of a priority claim under PCT Rule 26*bis*.1(a), this should be done before requesting early publication of the international application – if you do it afterwards, the request for correction/addition will be considered not to have been submitted unless the request for early publication is withdrawn before completion of technical preparations for international publication (PCT Rule 26*bis*.1(b)).
- Requesting restoration of the right of priority in the international phase: if you wish to request restoration of the right of priority under PCT Rule 26*bis*.3⁵, all the requirements for the restoration request⁶ must be complied with before the completion of technical preparations for international publication of the international application (if that date falls prior to the expiration of the time limit for requesting restoration of the right of priority of two months from the date on which the priority period expired) (PCT Rule 26*bis*.3(e)).
- Inclusion of references to deposits of biological material: although there are some designated (or elected) Offices which require the submission of indications regarding deposited biological material already at the time of filing the international application, please note that there are also some Offices which require such indications to be submitted by the time the request for early publication is made (PCT Rule 13*bis*.4(c)). For details on the requirements of the designated Offices in this respect, please refer to the *PCT Applicant's Guide*, Annex L.
- Translation of the international application for the purposes of international publication: if the language of filing of the international application is not a language of publication, you should ensure that the translation is furnished before completion of technical preparations for publication, if the latter occurs prior to the expiration of 14 months from the priority date (PCT Rule 12.4(a)).

⁵ That is, if you are claiming the priority of an earlier application, and you have failed to file the international application within the priority period, but you do file it within the period of two months from that date, and can justify that such failure occurred in spite of due care required by the circumstances having been taken, or was unintentional.

⁶ That is, the submission of the request for restoration to the receiving Office (including a statement of the reasons for the failure to file the international application within the priority period), the submission of any request for the addition of any missing priority claim and the payment of any applicable fee.

