

Theme 6

Strategies for Using the PCT

Encouraging creativity and innovation



WORLD
INTELLECTUAL
PROPERTY
ORGANIZATION

PCT Seminar for SMEs and Independent Inventors - November 2009

Review of PCT Essentials

- International filing procedure, not a patent grant
- Defer decisions on where to obtain patent protection for a period of 30 months from the priority date
- Additional time to make final “filing” decisions, defer costs, identify business partners, secure financing

Examples of PCT Strategies

- Before filing
- PCT filing
- International phase
- National phase

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Examples of PCT Strategies

Before filing

- Assessing your invention
- Doing your technology search
- Getting professional help

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Examples of PCT Strategies

PCT filing

- US provisional to PCT
- PCT First
- US non-provisional to PCT
- Selecting the receiving Office
- Selecting the ISA/IPEA

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Examples of PCT Strategies

International phase

- International publication
- Evaluating ISA/IPEA reports
- Taking advantage of amendment possibilities
- Supplementary International Search

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Examples of PCT Strategies

National phase

- Patent Prosecution Highway (PPH)
- Entering early

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Before Filing

- Assessing your invention
 - Is my invention patentable?
 - Type of invention (e.g., significant impact, minor improvement)
 - Design complexity (e.g., is it easy to design around the invention?)

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Before Filing

- Assessing your invention
 - Global market for the invention (e.g., how many countries would be interested?)
 - Is your invention critical to standards (e.g., device depends on several technologies functioning together)
 - Infringement risk (e.g., how easily can your invention be copied and infringed upon?)

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Before Filing

- Assessing your invention
 - What are the industry trends (e.g., is there a lot of patent activity in my field of technology?)
 - How should I seek to protect my invention?

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Before Filing

- Doing your technology search
 - Published patent documents are an essential information resource when determining novelty and non-obviousness
 - PATENTSCOPE® and national patent databases
 - Variety of searching techniques using keywords, International Patent Classification (IPC), Inventor, Applicant, etc.

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Before Filing

- Doing your technology search
 - Non-patent literature
 - Journals, research publications, theses, etc.

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Before Filing

- Getting professional help from a patent agent or attorney
 - Specialist in patent and PCT procedures
 - Provides advice on patentability
 - Prepares your application

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Before Filing

- Getting professional help from a patent agent or attorney
 - Performs various acts on your behalf during the international and national phases
 - Helps you obtain the maximum possible protection for your invention (e.g., patent claims of broadest possible scope)

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PCT Filing

- US provisional to PCT
 - Provides a lower-cost first patent filing
 - Provides an additional 12 months to follow-up the provisional application by filing other applications such as national/regional applications, US nonprovisional, PCT
 - Patentability of national/regional phase application is examined on the basis of the filing date of the provisional application

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PCT Filing

- US provisional to PCT
 - No claims required (although recommended)
 - Written description and any drawings must support the invention that is claimed in a later-filed national/regional phase application
 - Patent term starts from the international filing date and not the US provisional filing date

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PCT Filing

- US provisional to PCT
 - No publication, search, or examination
 - Inexpensive means for establishing a filing date
 - Filing fee: \$ 220 / \$ 110 (small entity)

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PCT Filing

- PCT First
 - Start with PCT rather than a national application
 - Delay payment of national fees by 30 months
 - More search and examination options possible for a PCT than for a national application
 - Choice of ISAs/IPEAs

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PCT Filing

- PCT First
 - Early availability of the international search report and the written opinion of the ISA at around **9 months** from the international filing date
 - Patent term starts from the international filing date in all countries

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PCT Filing

- US non-provisional to PCT
 - US non-provisional is filed followed by PCT application 12 months later
 - Useful if you want to obtain your US patent as soon as possible

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PCT Filing

- Selecting the receiving Office
 - Typically RO/US or RO/IB but additional options may exist if there are multiple applicants with different nationalities
 - Fees, i.e., transmittal fee
 - Electronic filing options and fee reductions
 - Familiarity with the Office and/or the national patent system

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PCT Filing

- Selecting the receiving Office
 - Language
 - RO/IB: any language
 - RO/US: English only
 - Hours of operation
 - Foreign filing license requirements
 - Must be obtained prior to filing with RO/IB
 - RO/US will issue a foreign filing license as part of formalities review process

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PCT Filing

- Selecting the receiving Office
 - Competent ISAs and IPEAs
 - Depends on the receiving Office
 - RO/IB offers a full range of ISA/IPEA options in the case of multiple applicants with different nationalities and residences
 - Payment methods

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PCT Filing

- Selecting the ISA/IPEA
 - Subject matter competency, e.g., some areas of technology may be excluded from search
 - Timeliness
 - Language
 - Costs

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International Phase

- International publication
 - Not necessary to wait for official 18-month publication (extra publication fee may apply if search report is not available)
 - Maximize global publicity for your invention in PATENTSCOPE®
 - PCT publication number can be used to promote technologies which are available for licensing

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International Phase

- Evaluating ISA/IPEA reports
 - Carefully review and assess the report, e.g., findings on novelty, inventive step and industrial applicability of the claimed invention
 - Field of prior art search, IPC symbols
 - Language coverage, e.g., citation and number of foreign language documents

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International Phase

- Taking advantage of amendment possibilities
 - Article 19 (claims) filed with the International Bureau after receipt of the international search report prepared by the ISA for provisional protection

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International Phase

- Taking advantage of amendment possibilities
 - Article 34 (description, claims, drawings) before the IPEA
 - Subject to the filing of a demand and payment of fees
 - Getting the application in order and allowable form before the start of the national phase procedure

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International Phase

- Supplementary International Search
 - Useful for a more complete overview of the prior art
 - Applicant can have a different International Authority conduct a second search
 - Possibility of additional language coverage
 - Offered at the moment by the Russian Patent Office, Swedish Patent Office, and the Nordic Patent Institute

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National Phase

- Patent Prosecution Highway (PPH)
 - Bilateral arrangements between patent Offices
 - Use and exploit search and examination reports from an Office of First Filing (OFF)
 - Office of Second Filing (OSF) can exploit the search and examination reports of the OFF to expedite national processing

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National Phase

- PPH and the PCT
 - The Trilateral Offices (Japan Patent Office, European Patent Office, United States Patent and Trademark Office) will start a pilot in January 2010
 - Positive PCT search and examination results can be used as a basis for PPH requests in the Trilateral Offices

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National Phase

- Entering early
 - Invention is ready for commercial sale
 - No need to wait 30 months
 - Get your patent sooner, e.g., in cases of infringement
 - Obtain certainty of patent rights, e.g., for licensing agreements

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Conclusion

- Using the PCT wisely
 - Identify business needs and requirements
 - Do your technology search
 - Maximize the 30-month time delay
 - Use amendments and arguments to obtain a positive report from the IPEA
- Getting professional help

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PCT Questions

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