

As of January 01, 2004, the obligatory international search and optional international preliminary examination procedures shall be converged into what will be called an enhanced international search and preliminary examination (EISPE) system. The main difference would be that the ISR would contain a written opinion based on certain international criteria for patentability (novelty, inventive step and industrial applicability), which is similar in scope and content to the written opinion made by an international preliminary examining authority today, before the IPER is established. **Therefore the new ISR under the EISPE system which will be called the international preliminary report on patentability Chapter I (IPRP Chapter I), would also offer the agent a basis on which to advise his client as to whether or not a patent application is viable and worth pursuing in any or all of the countries designated. In turn, the new IPER would be called the international preliminary report on patentability Chapter II (IPRP Chapter II).**



DOES THE PCT OFFER PROCEDURAL SAFEGUARDS?

Several years of experience have shown that the PCT offers a robust and reliable system for use by patent agents in representing their clients' needs. The system is organized in such a way that for instance: agents receive an invitation to correct defects or pay missing amounts of fees within a certain time limit, the time limits for correction of defects can be extended, provided that minimum requirements for obtaining a filing date under Article 11 have been met, errors can be corrected without affecting the application or its filing date, etc. **Thus, the dependability of the system can be attributed to the various procedural safeguards in place. As a consequence of such procedural leeway, it is only in rare circumstances that an international application would be considered withdrawn for non-compliance with PCT formal requirements.**

DOES THE PCT COEXIST WITH NATIONAL LEGISLATION?

As of July 1, 2003, there are 121 Contracting States of the PCT. These countries which are located throughout the world, all have differing economic and legal regimes. One of the prerequisites for becoming a Member State to the PCT is being a Contracting Party to the Paris Convention for the Protection of Industrial Property. Whilst, on the one hand, the international phase of processing of international applications is almost exclusively provided for under the Treaty, the national phase of processing, in each country concerned, is provided for under the applicable national law. In particular, the granting of patents is exclusively the role of national and regional patent Offices. **The PCT neither invades nor limits the application of substantive national law, notwithstanding any minor procedural changes that would be necessary to ensure consistency with the Treaty. It is important to emphasize the fact that the PCT is a mechanism for filing international applications. Therefore, in all those designated/elected countries for which the applicant wishes to continue the procedure of seeking patent protection (after having received the ISR and/or IPER), he/she must enter the so-called "national phase". These patent applications, in turn, must be treated as if they were national applications and, depending on the national law of the country, the applicant must then be represented by a local patent agent. With regard to patent agents, Article 27 (7) of the PCT reinforces the national law requirements concerning local representation.**

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**ADVANTAGES
OF THE
PATENT COOPERATION
TREATY (PCT)
FOR PATENT AGENTS IN
DEVELOPING COUNTRIES**

Patent Cooperation Treaty (PCT)



WORLD
INTELLECTUAL
PROPERTY
ORGANIZATION

WHAT FACTORS INFLUENCE THE ADVANTAGES TO BE DERIVED FROM THE PCT?

From a global standpoint the extent to which PCT advantages could benefit a PCT Contracting State depends on various factors. For instance, if the legal framework for better protection of inventions is present, foreign and local inventors and enterprises, would be more willing to seek protection. This however, would also depend to a certain extent on the national economic policy of the country in question. Nevertheless, in developing countries where the economic environment is attractive or in which economies are growing rapidly, the probability of benefiting from the PCT becomes more apparent.

WHAT IS THE ROLE OF PATENT AGENTS IN THE PCT?

From a general perspective, a patent agent's involvement with the PCT is two-fold:

1) to act as agent during the international phase, representing local applicants who are interested in "bulk" patent protection. Any person who has the right to practice before

the local patent office (which acts as receiving Office for PCT applications), would automatically be entitled to represent a local applicant before all PCT international authorities.

2) to act as agent during the national phase, representing a non-resident/resident applicant. Any person who has the right to practice before the local patent office can be appointed by a non-resident/resident applicant to represent him/her in the entire national phase, up to and beyond grant of a patent.

Once patent agents have gone through the initial learning process, the uniform and simplified formality requirements prescribed by the Treaty can be easily observed and applied in patent prosecution.

WOULD ACCESSION TO THE PCT ADVERSELY AFFECT THE PATENT AGENTS' WORK LOAD?

Patent agents are often wary of the consequences of a country's accession to the PCT. In regimes where the national law makes it mandatory for an applicant to be represented by a local patent agent, facts and figures have shown that the accession to the PCT by these developing countries will by no means reduce the work load of patent agents. However, with an increased willingness on the part of the applicant to seek patent protection through the PCT route, which usually becomes apparent after the first 18 months following accession, more national and foreign applicants will seek the services of local patent agents for the prosecution of their applications before the local authorities.

WOULD ACCESSION TO THE PCT ADVERSELY AFFECT THE INCOME OF PATENT AGENTS?

In cases where the work load volume of agents has increased due to a rise in the need for the services of local agents, there would be an immediate impact on the patent agents' income. In most developing countries, fees charged by patent agents for processing PCT applications are usually the same as those charged for direct national applications. Hence, the accession to the PCT by a country would not adversely affect the income of patent agents.

IS THE PCT A COMPLICATED PATENT FILING PROCESS?

The PCT greatly facilitates the filing and processing of patent applications by imposing a standardized coherent format and allowing for more time before entering the national phase. Despite an initial learning phase, users find the procedure very convenient thanks to the uniform formality requirements prescribed in the Treaty and its Regulations. It is relevant to point out that there are certain formalities that are prescribed when filing national applications, for instance, legalization or notarization of documents, which are not required under the PCT. This means a few less formality tasks for the agent so far as PCT applications are concerned. Furthermore, the Treaty prohibits Contracting States from imposing formal requirements in addition to those set out in the Regulations under the Treaty.

WHAT IMPACT WILL THE EVENTUAL ELECTRONIC FILING WITHIN THE PCT HAVE ON PATENT AGENTS?

With the emergence of electronic filing of PCT applications, PCT-Electronic Application System (EASY) software actually provides a first step towards full electronic filing of PCT applications and, will be integrated into the future PCT electronic filing system (PCT-SAFE). The tangible benefits of using the PCT-EASY software are manifest in the series of validation rules contained therein, which have the effect of reducing most of the formality handling errors involved in filing PCT applications, as well as familiarizing agents/applicants with certain PCT requirements. Developing countries in which patent agents use computers for storing, processing and viewing applications, are very often familiar with the PCT request form in the PCT-EASY format. Use of the PCT-EASY format would facilitate the task of patent attorney firms for eventual electronic filing of international applications.

TO WHAT EXTENT DOES THE PCT FACILITATE THE WORK OF THE PATENT AGENT?

The PCT is a very useful tool for patent agents. As mentioned before there is one set of formality requirements where the patent agent files and/or receives the PCT application in a standard format which greatly simplifies the task of rectification with respect to the form. On the assumption that the international application complies with filing and formalities requirements, it is then subjected to an international (prior art) search, undertaken by one of the Patent Offices acting as an International Searching Authority (ISA)¹, and concluded by an International Search Report (ISR). The majority of international applications subsequently undergo the optional international preliminary examination procedure which is carried out by one of the Offices mentioned above. Such examination is then concluded by an International Preliminary Examination Report (IPER), which contains an opinion as to whether the claimed invention meets certain international criteria for patentability (novelty, inventive step and industrial applicability). These reports offer the agent a basis on which to advise his client as to whether or not a patent application is viable and worth pursuing in any or all of the countries designated or elected in the PCT process.

¹ At present there are 11 International Searching Authorities: Austrian Patent Office, Australian Patent Office, Canadian Patent Office (as of 01/01/04), China Intellectual Property Office, European Patent Office, Japan Patent Office, Korean Intellectual Property Office, Russian Patent Office, Spanish Patent and Trademark Office, Swedish Patent Office, and United States Patent and Trademark Office. All International Searching Authorities are International Preliminary Examining Authorities.

