# Theme 6

# Strategies for Using the PCT

Encouraging creativity and innovation

WORLD INTELLECTUAL PROPERTY ORGANIZATION



## 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



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# Examples of PCT Strategies

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





# Examples of PCT Strategies

Before filing

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

# 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





# Examples of PCT Strategies

International phase

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

# Examples of PCT Strategies

National phase

- Patent Prosecution Highway (PPH)
- Entering early





# 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?)

# 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?)





# 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?

# 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.



# Before Filing

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

# Before Filing

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





# 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)

# 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





# 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

# PCT Filing

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



# 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

# 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



# 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

# 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





# 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

# 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





# PCT Filing

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

# 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





# 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

# 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





# 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

# 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



# 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

# 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



# 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

# 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



# PCT Questions

| | USPTO | WIPO |
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