



# Patent Cooperation Treaty (PCT) Workshop

Organized by WIPO

In Cooperation with the Intellectual Property Department,  
Ministry of Commerce and Industry

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## *Speaker Outline*

# **The PCT System:**

**01 – Introduction**

**02 – The PCT International Phase**

**03 – International Search and International Preliminary Examination**

**04 – The PCT National Phase**

**05 – The ePCT System**

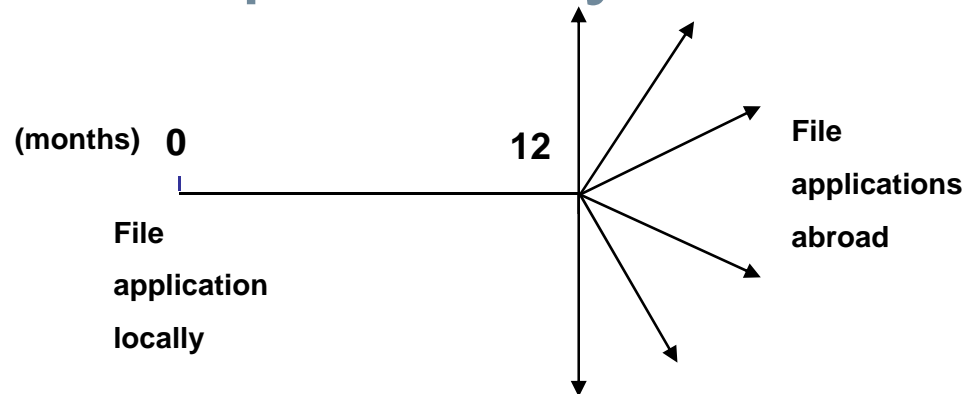
**06 – The Use of the PCT System as an Engine for Technology Transfer**

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# Introduction to the PCT System

# Traditional patent systems



- Local patent application followed within 12 months by multiple foreign applications claiming priority under Paris Convention:
  - multiple formality requirements
  - multiple searches
  - multiple publications
  - multiple examinations and prosecutions of applications
  - translations and national fees required at 12 months
- Some rationalization because of regional arrangements:  
ARIPO, EAPO, EPO, OAPI

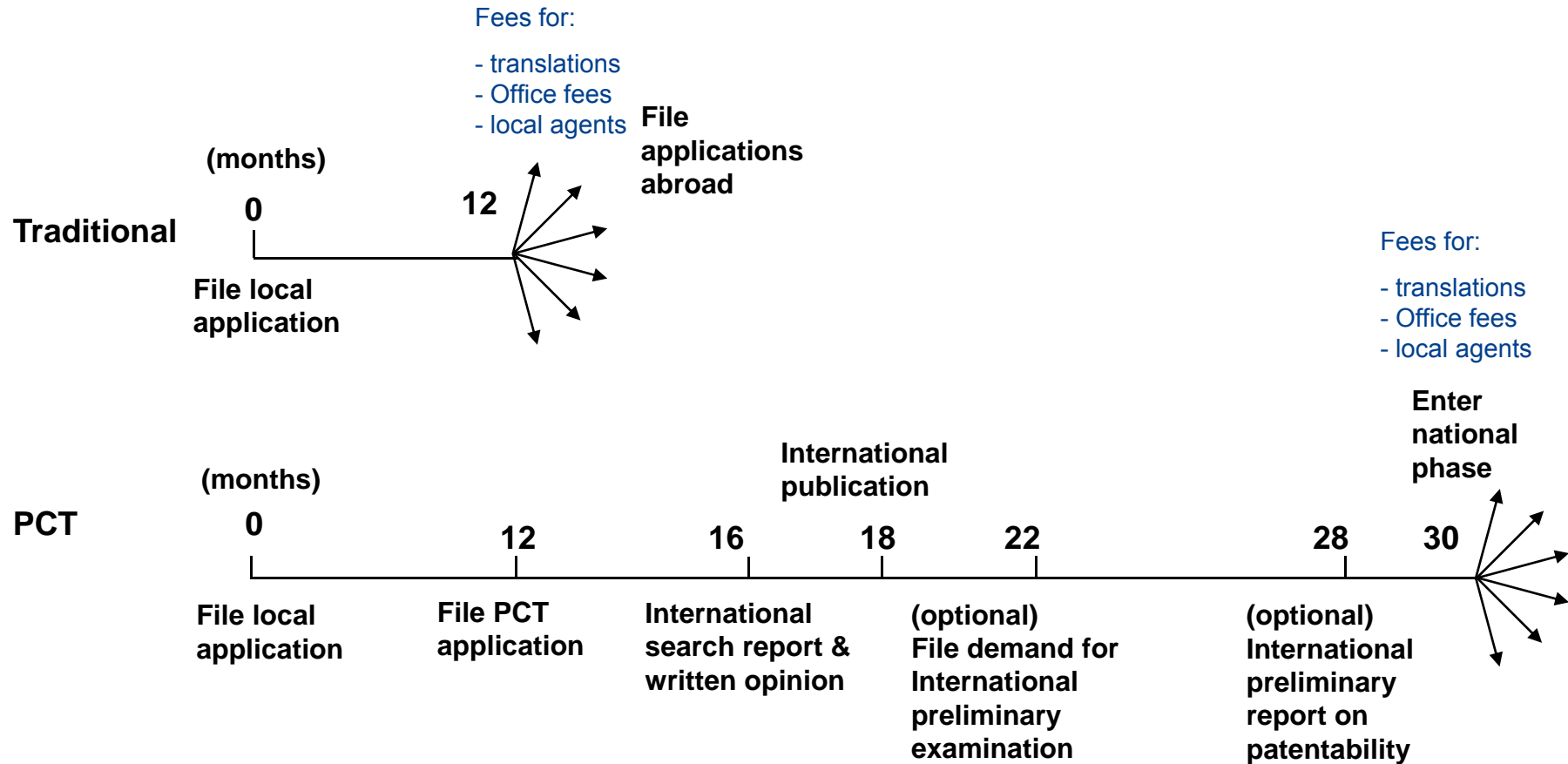
# PCT system

Local patent application followed within 12 months by international application under the PCT, claiming Paris Convention priority, with “national phase” commencing at 30 months\*:

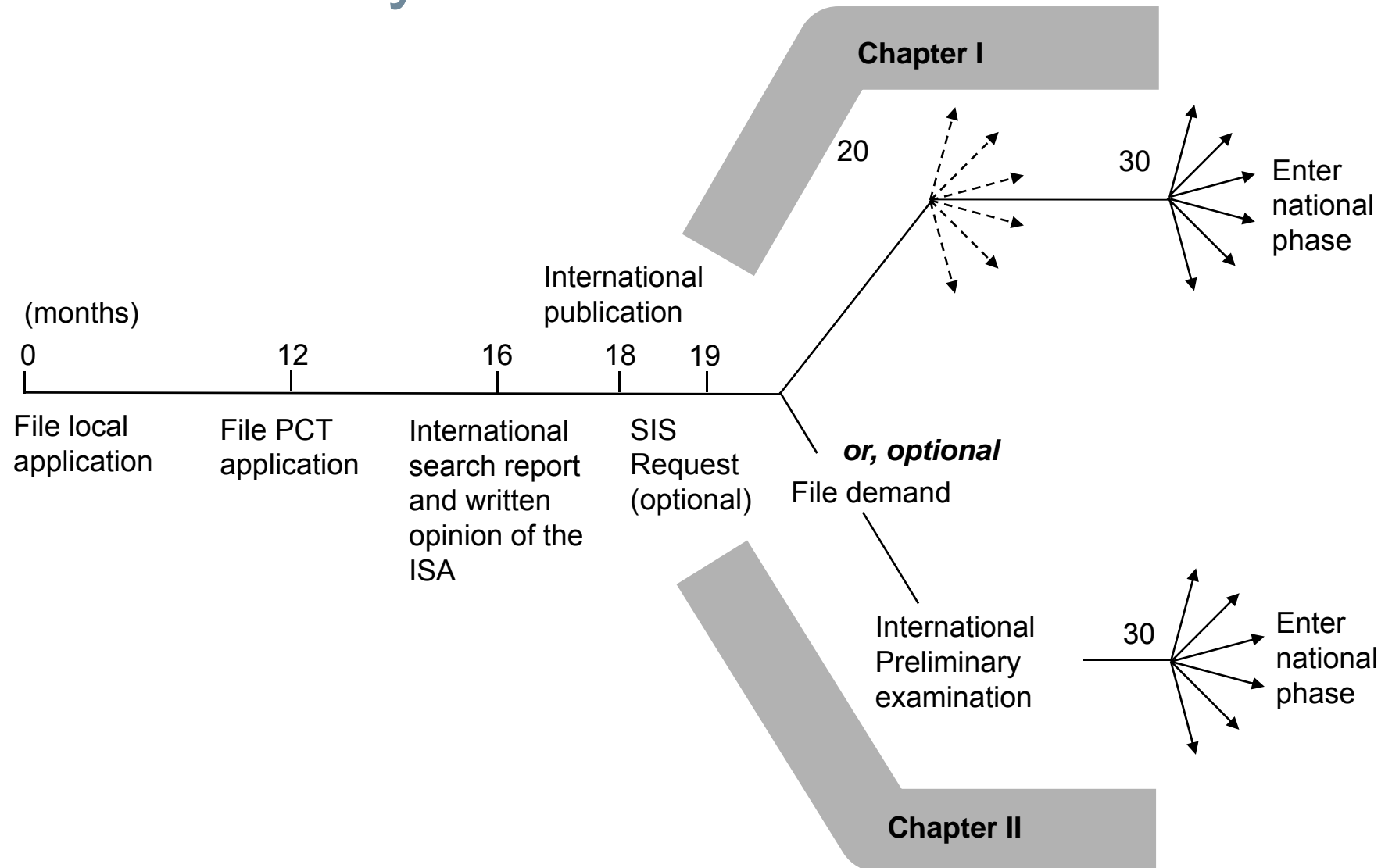
- one set of formality requirements
- international search
- international publication
- international preliminary examination
- international application can be put in order before national phase
- translations and national fees required at 30 months,\* and only if applicant wishes to proceed

\* For exceptions, see [http://www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html)

# Traditional patent system vs. PCT system



# The PCT system



# General remarks on the PCT system (1)

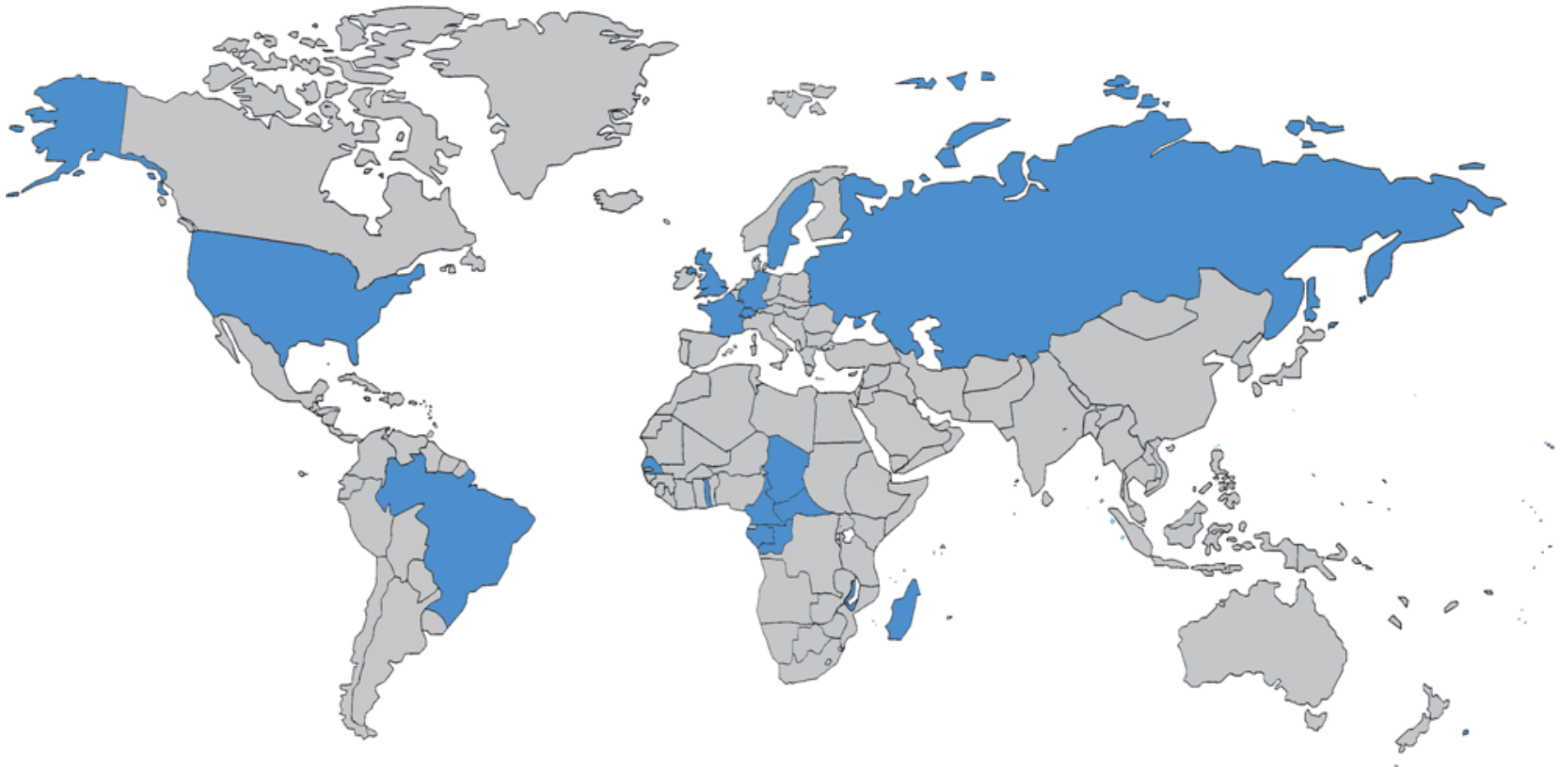
- The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT patent”
- The PCT system provides for
  - an international phase comprising:
    - filing of the international application
    - international search and written opinion of the ISA
    - international publication and
    - international preliminary examination
  - a national/regional phase before designated Offices
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase



# General remarks on the PCT system (2)

- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles.
- Design and trademark protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively).
- The PCT is administered by WIPO as are other international treaties in the field of industrial property, such as the Paris Convention.

# The PCT in 1978 = 18 Member States



# 2017 : 152 PCT Member States



# PCT Contracting States (151)

*States designated for regional protection and also, unless otherwise indicated, national protection*

## EA Eurasian Patent

AM Armenia  
 AZ Azerbaijan  
 BY Belarus  
 KG Kyrgyzstan  
 KZ Kazakhstan  
 RU Russian Federation  
 TJ Tajikistan  
 TM Turkmenistan

## EP European Patent

AL	Albania <sup>1</sup>	LI	Liechtenstein
AT	Austria	LT	Lithuania
* BE	Belgium	LU	Luxembourg
BG	Bulgaria	* LV	Latvia
CH	Switzerland	* MC	Monaco
* CY	Cyprus	MK	The former Yugoslav Republic of Macedonia <sup>1</sup>
CZ	Czech Republic		
DE	Germany	* MT	Malta
DK	Denmark	* NL	Netherlands
EE	Estonia	NO	Norway
ES	Spain	PL	Poland
FI	Finland	PT	Portugal
* FR	France	RO	Romania
GB	United Kingdom	RS	Serbia <sup>1</sup>
* GR	Greece	SE	Sweden
HR	Croatia <sup>1</sup>	* SI	Slovenia
HU	Hungary	SK	Slovakia
* IE	Ireland	SM	San Marino
IS	Iceland	TR	Turkey
* IT	Italy		

\* Regional patent only

1 Extension agreement continues to apply to applications filed before 1 January 2008 (for HR), 1 January 2009 (for MK), 1 May 2010 (for AL) or 1 October 2010 (for RS)

# PCT Contracting States (151) (continued)

*States designated for regional protection and also, unless otherwise indicated, national protection*

## AP ARIPO Patent

BW	Botswana
GH	Ghana
GM	Gambia
KE	Kenya
LR	Liberia
LS	Lesotho
MW	Malawi
MZ	Mozambique
NA	Namibia
RW	Rwanda (from 24.09.2011)
<b>SD</b>	<b>Sudan</b>
SL	Sierra Leone
* SZ	Swaziland
TZ	United Republic of Tanzania
UG	Uganda
ZM	Zambia
ZW	Zimbabwe

## OA OAPI Patent

* BF	Burkina Faso
* BJ	Benin
* CF	Central African Republic
* CG	Congo
* CI	Côte d'Ivoire
* CM	Cameroon
* GA	Gabon
* GN	Guinea
* GQ	Equatorial Guinea
• GW	Guinea-Bissau
• <b>KM</b>	<b>Union of the Comoros</b>
* ML	Mali
* <b>MR</b>	<b>Mauritania</b>
* NE	Niger
* SN	Senegal
* TD	Chad
* TG	Togo

\* Regional patent only

# PCT Contracting States (151) (continued)

*States designated for national protection only except where otherwise indicated*

<b>AE</b> United Arab Emirates	ID	Indonesia	<b>OM</b> Oman
AG Antigua and Barbuda	IL	Israel	PA Panama
AO Angola	IN	India	PE Peru
AU Australia	IR	Islamic Republic of Iran	PG Papua New Guinea
BA Bosnia and Herzegovina	<b><u>JO</u></b> <b>Jordan (-&gt;9 June 2017)</b>		PH Philippines
BB Barbados	JP	Japan	<b>QA</b> Qatar
<b>BH</b> Bahrain	<b><u>KH</u></b> <b>Cambodia</b>		<b>SA</b> Saudi Arabia
BN Brunei Darussalam	KN	Saint Kitts and Nevis	SC Seychelles
BR Brazil	KP	Democratic People's	SG Singapore
BZ Belize		Republic of Korea	ST Sao Tome and Principe
CA Canada	KR	Republic of Korea	SV El Salvador
CL Chile	<b>KW</b> Kuwait		<b>SY</b> Syrian Arab Republic
CN China	LA	Lao People's Democratic	TH Thailand
CO Colombia		Republic	<b>TN</b> Tunisia
CR Costa Rica	LC	Saint Lucia	TT Trinidad and Tobago
CU Cuba	LK	Sri Lanka	UA Ukraine
<b>DJ</b> Djibouti	<b>LY</b> Libya		US United States of America
DM Dominica	<b>MA</b> Morocco		UZ Uzbekistan
DO Dominican Republic	MD	Republic of Moldova	VC Saint Vincent and
<b>DZ</b> Algeria	* ME	Montenegro	the Grenadines
EC Ecuador	MG	Madagascar	VN Viet Nam
<b>EG</b> Egypt	MN	Mongolia	ZA South Africa
GD Grenada	MX	Mexico	
GE Georgia	MY	Malaysia	
GT Guatemala	NG	Nigeria	
HN Honduras	NI	Nicaragua	
	NZ	New Zealand	

# Countries not yet PCT Contracting States (42)

Afghanistan

Andorra

Argentina

Bahamas

Bangladesh

Bhutan

Bolivia

Burundi

Cambodia

Cabo Verde

Democratic Republic of

Congo

Eritrea

Ethiopia

Fiji

Guyana

Haiti

Iraq

Jamaica

Kiribati

Lebanon

Maldives

Marshall Islands

Mauritius

Micronesia

Myanmar

Nauru

Nepal

Pakistan

Palau

Paraguay

Samoa

Solomon Islands

Somalia

South Sudan

Suriname

Timor-Leste

Tonga

Tuvalu

Uruguay

Vanuatu

Venezuela

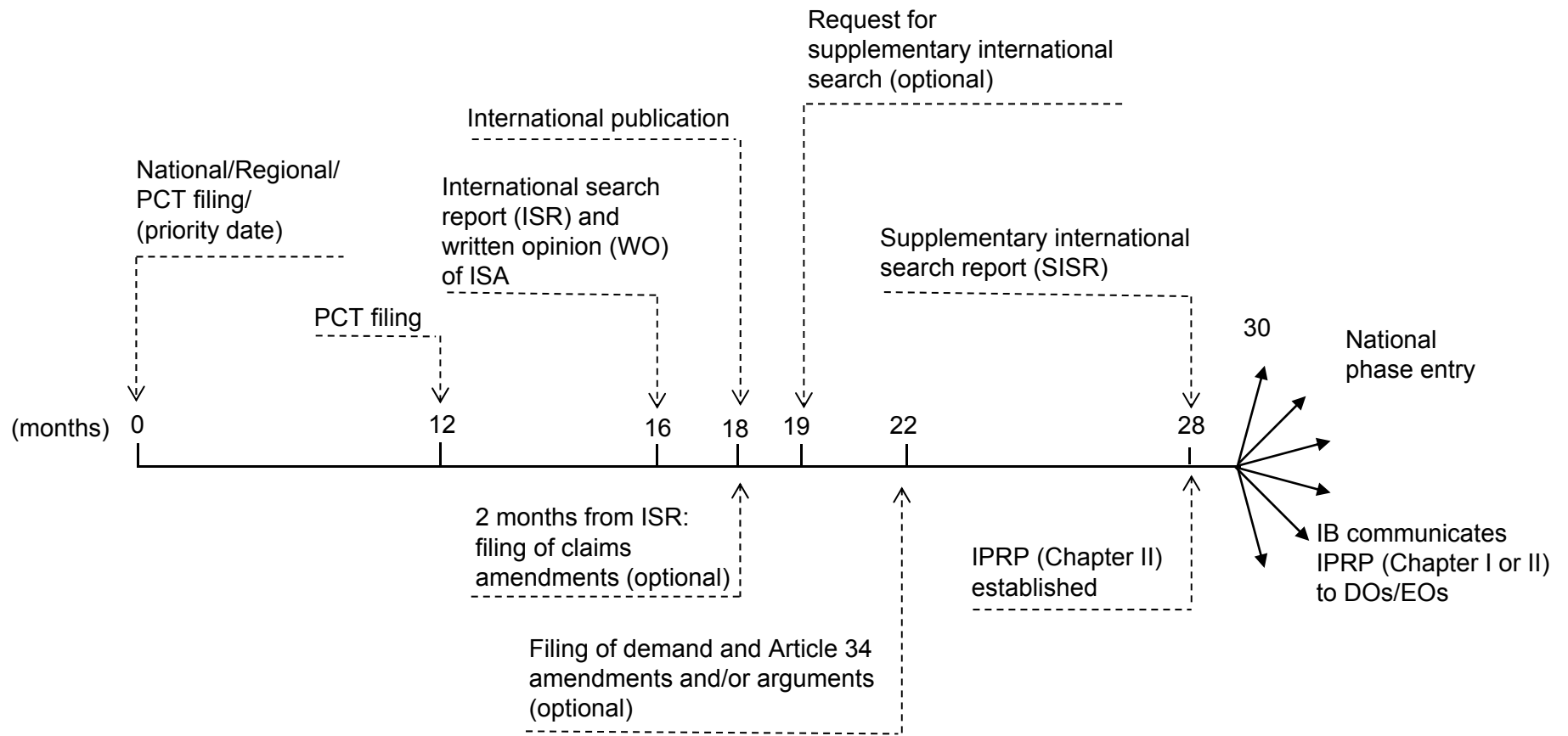
Yemen



# PCT Timeline



# PCT TIMELINE



# Non-applicability of time limit of 30 months under Article 22(1)

- The Offices of the following States have notified the International Bureau that they will not apply the 30 month time limit under Chapter I, as of 1 April 2002, for as long as modified Article 22(1) is not compatible with their national law:
  - LU Luxembourg
  - TZ United Republic of Tanzania
  - UG Uganda
- Where one of these States has been designated for the purposes of a regional patent, the applicable time limit is 31 months
- If no demand for international preliminary examination is filed before the expiration of 19 months in respect of above States, the national phase will have to be entered before the expiration of 20 or 21 months from the priority date



## Basics of the PCT

- The international application
- The international filing date
- The applicant
- Competent RO and ISA

# The international application

- Only one application filed, containing, by default, the designation of all States (for every kind of protection available) and usual priority claim(s)
- Has the effect of a regular national filing (including establishment of a priority date) in each designated State: the international filing date is the filing date in each designated State
- Filed in one language
- Filed with one office
- One set of formality requirements
- Delays national processing until 30 months from the priority date (for exceptions, see [www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html))

# Minimum requirements for an international filing date (Article 11(1)) (1)

## ■ The application must contain at least:

- an indication that it is intended as an international application
- a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
- the name of the applicant (Rule 4.5)
- a description (Rule 5)
- a claim (Rule 6)

# Minimum requirements for an international filing date (Article 11(1)) (2)

## ■ Note that if:

- none of the applicants have the right to file with the receiving Office for reasons of residence or nationality (Rules 18 and 19); or
- the application is filed in a language not accepted by the receiving Office for that purpose (Rule 12.1),

the receiving Office will transmit the application to the receiving Office of the International Bureau for further processing (Rule 19.4)

# Not required for obtaining an international filing date

- payment of fees
- applicant's signature
- title of the invention
- abstract
- drawings (for missing drawings, see Article 14(2) and Rule 20.5)
- translation into language of search or publication

# The PCT applicant (Article 9 and Rule 18)

- The applicant may be a natural person (e.g. the inventor) or a legal entity (e.g. company, university, NGO) (also for the US since 16 September 2012)
- It is possible to indicate different applicants for different designated States (Rule 4.5(d))
- At least one of the applicants must be a national or resident of a PCT Contracting State (Rule 18.3)



# Where to file the international application (Rule 19)

- with a national Office
- with the International Bureau of WIPO, or
- with a regional Office

For details, see PCT Applicant's Guide, International Phase, General Information, Annexes B1 and B2

# Choice of receiving Office

## Considerations:

- Accepted filing languages
- Choice of International Searching Authorities
- Criteria for restoration of the priority right and fee to be paid
- Possibility to incorporate by reference
- Acceptance of pre-conversion files

# Which ISA(s) is (are) competent (Rule 35)

- The competent ISA(s) is (are) specified by the RO
- If more than one is specified by the RO, the applicant has the choice:
  - in making that choice, the applicant must take into account the language(s) accepted by the ISA (a translation of the international application for the purposes of international search may be required in certain cases (Rule 12.3))
- If the international application is filed with RO/IB, the competent ISAs will be those which would have been competent if the international application had been filed with (any of) the national or regional Office(s) which, on the basis of applicant's nationality or residence, could be a competent RO
- Choice of ISA to be indicated in the request (Box No. VII)



## ■ ISAs / IPEASs Around the World

# 22 ISAs / IPEAs Around the World

- [ ] Australian Patent Office (IPEA/AU)
- [ ] Austrian Patent Office (IPEA/AT)
- [ ] Canadian Commissioner of Patents (IPEA/CA)
- [ ] Egyptian Patent Office (IPEA/EG)**
- [ ] European Patent Office (IPEA/EP)
- [ ] Federal Service on Intellectual Property, Patents and Trademarks (Russian Federation) (IPEA/RU)
- [ ] Indian Patent Office (IPEA/IN)
- [ ] Intellectual Property Office of Singapore (IPEA/SG)
- [ ] Israel Patent Office (IPEA/IL)
- [ ] Japan Patent Office (IPEA/JP)
- [ ] Korean Intellectual Property Office (IPEA/KR)
- [ ] National Board of Patents and Registration of Finland (IPEA/FI)
- [ ] National Institute of Industrial Property (IPEA/BR)
- [ ] National Institute of Industrial Property of Chile (IPEA/CL)
- [ ] Nordic Patent Institute (IPEA/XN)
- [ ] Spanish Patent and Trademark Office (IPEA/ES)
- [ ] State Intellectual Property Office of the People's Republic of China (IPEA/CN)
- [ ] State Intellectual Property Service of Ukraine (IPEA/UA)
- [ ] Swedish Patent and Registration Office (IPEA/SE)
- [ ] Turkish Patent and Trademark Office (IPEA/TR)
- [ ] United States Patent and Trademark Office (IPEA/US)
- [ ] Visegrad Patent Institute (IPEA/VP [two letter code to be confirmed])

# Languages for ISAs / IPEAs

- Arabic (accepted by ISA/EG)**
- Chinese (accepted by ISA/CN)
- English (accepted by ISA/AT, ISA/AU, ISA/BR, ISA/CA, ISA/CN, ISA/EG, ISA/EP, ISA/FI, ISA/IL, ISA/IN, ISA/JP, ISA/KR, ISA/RU, ISA/SE, ISA/US, ISA/XN)
- French (accepted by ISA/AT, ISA/CA, ISA/EP, ISA/SE (for certain applicants only))
- German (accepted by ISA/AT, ISA/EP)
- Japanese (accepted by ISA/JP)
- Korean (accepted by ISA/KR)
- Portuguese (accepted by ISA/BR)
- Russian (accepted by ISA/AT, ISA/RU)
- Spanish (accepted by ISA/BR, ISA/ES)

# Serviced States & Prior Agreement

International Searching Authority (ISA)/ International Preliminary Examining Authority (IPEA)	Contracting States for which the ISA/IPEA will carry out international search/preliminary examination	Languages and Kinds of Application	Is prior agreement with the ISA/IPEA needed before it can be specified?
Austrian Patent Office (ISA/IPEA/AT)	Any developing country in conformity with the established practice of the United Nations, in accordance with the obligations of the Authority within the framework of the European Patent Organisation.	English, French, German, Hungarian, Russian	Agreement between Austrian Patent Office and your Office is required
State Intellectual Property Office of the People's Republic of China (ISA/IPEA/CN)	China, Angola, India, Kenya, Liberia, Thailand, Turkey, Ghana, Zimbabwe, India; and any State that the Authority will specify	Chinese, English	Agreement by the State Intellectual Property Office of the People's Republic of China is required
Egyptian Patent Office (ISA/IPEA/EG)	Open to All States, and in practice mainly selected by Arab States	Arabic, English	Yes
European Patent Office (ISA/IPEA/EP)	Any Contracting State	(i)English, French, German, Dutch <sup>3</sup> (ii)as an IPEA the EPO may act only if the search is or has been performed by EP, AT, FI, XN, ES and SE	No, specification in PCT Questionnaire is sufficient
United States Patent and Trademark Office (ISA/IPEA/US)	United States of America, Bahrain, Barbados, Brazil, Chile, Dominican Republic, Egypt, Guatemala, India, Israel, Mexico, New Zealand, Peru, Philippines, Saint Lucia, South Africa, Thailand, Trinidad and Tobago, and any State that the Authority will specify	English	Agreement with the United States Patent and Trademark Office is required



# ISA / IPEA Statistics

**Table C.3.1: Distribution of international search reports by ISA and by origin**

International searching authorities	Total plus the top three origins	International filing year					ISA share 2014 (%)	Change from 2013 (%)
		2010	2011	2012	2013	2014		
Australia	Australia	1,703	1,636	1,544	1,473	1,602	57.9	8.8
	Singapore	402	381	387	444	462	16.7	4.1
	New Zealand	270	283	253	261	250	9.0	-4.2
	<b>Total*</b>	<b>3,423</b>	<b>3,140</b>	<b>2,832</b>	<b>2,699</b>	<b>2,766</b>	<b>1.3</b>	<b>2.5</b>
Austria	South Africa	60	82	91	121	99	46.7	-18.2
	United Arab Emirates	9	8	10	25	30	14.2	20.0
	Republic of Korea	139	39	18	19	25	11.8	31.6
	<b>Total*</b>	<b>409</b>	<b>251</b>	<b>178</b>	<b>233</b>	<b>212</b>	<b>0.1</b>	<b>-9.0</b>
Brazil	Brazil	307	432	425	497	453	99.3	-8.9
	Colombia				5	3	0.7	-40.0
	<b>Total*</b>	<b>310</b>	<b>435</b>	<b>429</b>	<b>509</b>	<b>456</b>	<b>0.2</b>	<b>-10.4</b>
Canada	Canada	2,096	2,301	2,179	2,228	2,348	93.4	5.4
	United States of America	37	21	80	60	53	2.1	-11.7
	Barbados	4	11	6	4	45	1.8	1,025.0
	<b>Total*</b>	<b>2,208</b>	<b>2,396</b>	<b>2,339</b>	<b>2,324</b>	<b>2,515</b>	<b>1.2</b>	<b>8.2</b>
Chile	Chile					35	n.a.	n.a.
	El Salvador					2	n.a.	n.a.
	Mexico					1	n.a.	n.a.
	<b>Total*</b>					<b>38</b>	<b>0.0</b>	<b>n.a.</b>
China	China	12,118	16,207	18,273	21,126	25,188	90.9	19.2
	United States of America	293	583	1,023	1,101	1,261	4.6	14.5
	Japan	96	145	103	137	187	0.7	36.5
	<b>Total*</b>	<b>13,271</b>	<b>18,017</b>	<b>20,720</b>	<b>23,706</b>	<b>27,711</b>	<b>12.9</b>	<b>16.9</b>
Egypt	Egypt				14	14	93.3	0.0
	Saudi Arabia					1	6.7	n.a.
	<b>Total*</b>				<b>14</b>	<b>15</b>	<b>0.0</b>	<b>7.1</b>
European Patent Office	United States of America	16,980	17,593	18,661	20,996	21,756	27.3	3.6
	Germany	17,416	18,524	18,423	17,616	17,653	22.1	0.2
	France	7,039	7,194	7,528	7,681	8,112	10.2	5.6
	<b>Total*</b>	<b>68,937</b>	<b>71,633</b>	<b>75,147</b>	<b>77,412</b>	<b>79,716</b>	<b>37.2</b>	<b>3.0</b>





## ■ Main Advantages of Accession to the Patent Cooperation Treaty (PCT)

# Advantages for PCT Accession

- By filing only one application under the PCT with the national Office, or with the International Bureau of WIPO, the applicant obtains the effect of a regularly filed national or regional patent application for all the PCT Contracting States
- An applicant whether a natural person or not and who is a national and resident of certain developing countries would be entitled to a 90% reduction of certain PCT fees in respect of international applications filed under the PCT

# Advantages for PCT Accession

- The processing of the international application by the patent Offices of the Contracting States will not—unless expressly requested by the applicant— start until 30 months from the priority date. The PCT therefore allows the applicant 18 months more time than he would have without using the PCT to decide whether and for which countries he wishes to pursue patent protection, thereby delaying the expenses of translating the application, paying national fees and appointing local patent agents. Furthermore, the applicant would, thanks to the results of international preliminary reports on patentability, have a clear view on whether it would be worthwhile to continue to pursue his aim of obtaining patents for his invention

# 90% Fee Reductions (Proposed)

- Algeria (DZ)
- Bahrain (BH)
- Comoros (KM)
- Djibouti (DJ)
- Egypt (EG)
- Iraq (IQ)
- Jordan (JO)
- Kuwait (KW)
- Lebanon (LB)
- Libya (LY)
- Mauritania (MR)
- Morocco (MA)
- Oman (OM)
- Palestine (PS)
- Qatar (QA)
- Saudi Arabia (SA)
- Somalia (SO)
- Sudan (SD)
- Syria (SY)
- Tunisia (TN)
- United Arab Emirates (AE)
- Yemen (YE)