

Global Intellectual Property Systems: The Patent Cooperation Treaty (PCT) – Introduction and Recent Developments



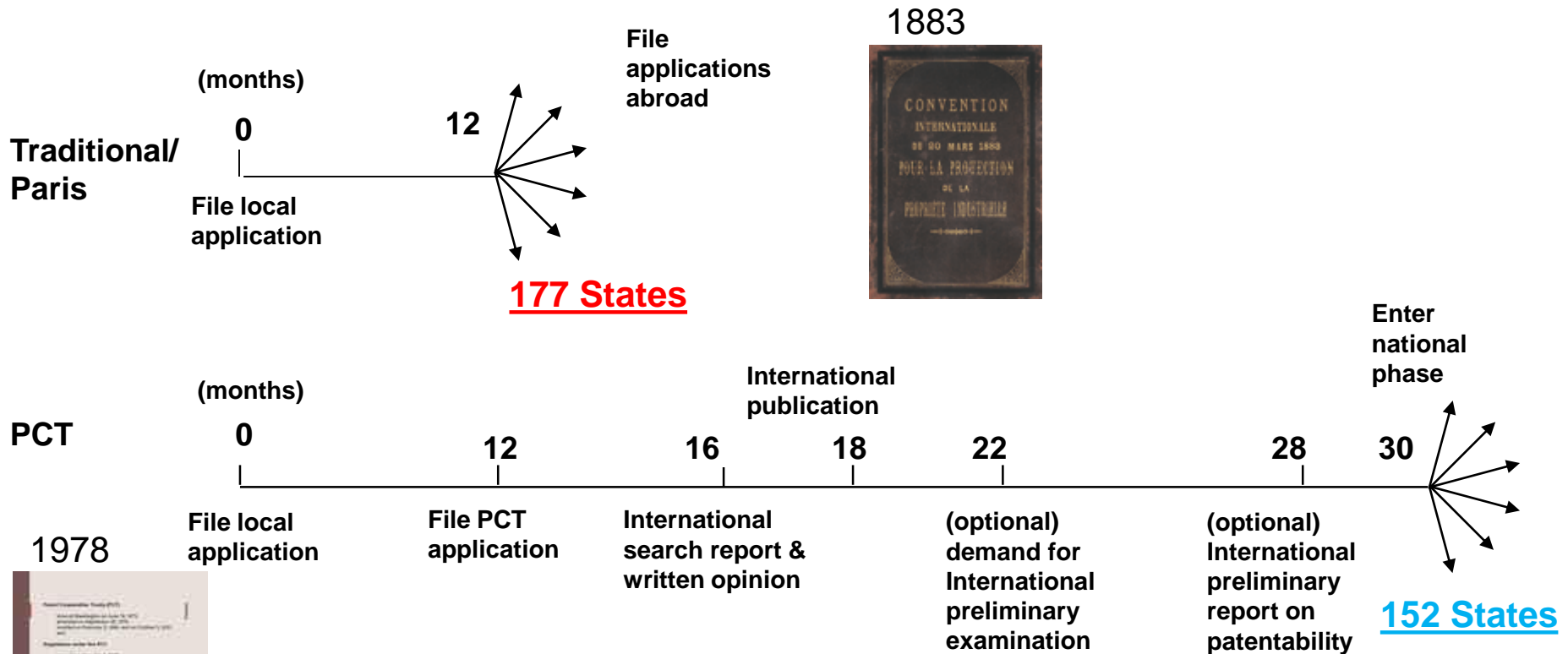
Roving Seminars: WIPO Services and Initiatives

Finnish Patent and Registration Office (PRH), Helsinki, Finland

May 27, 2019

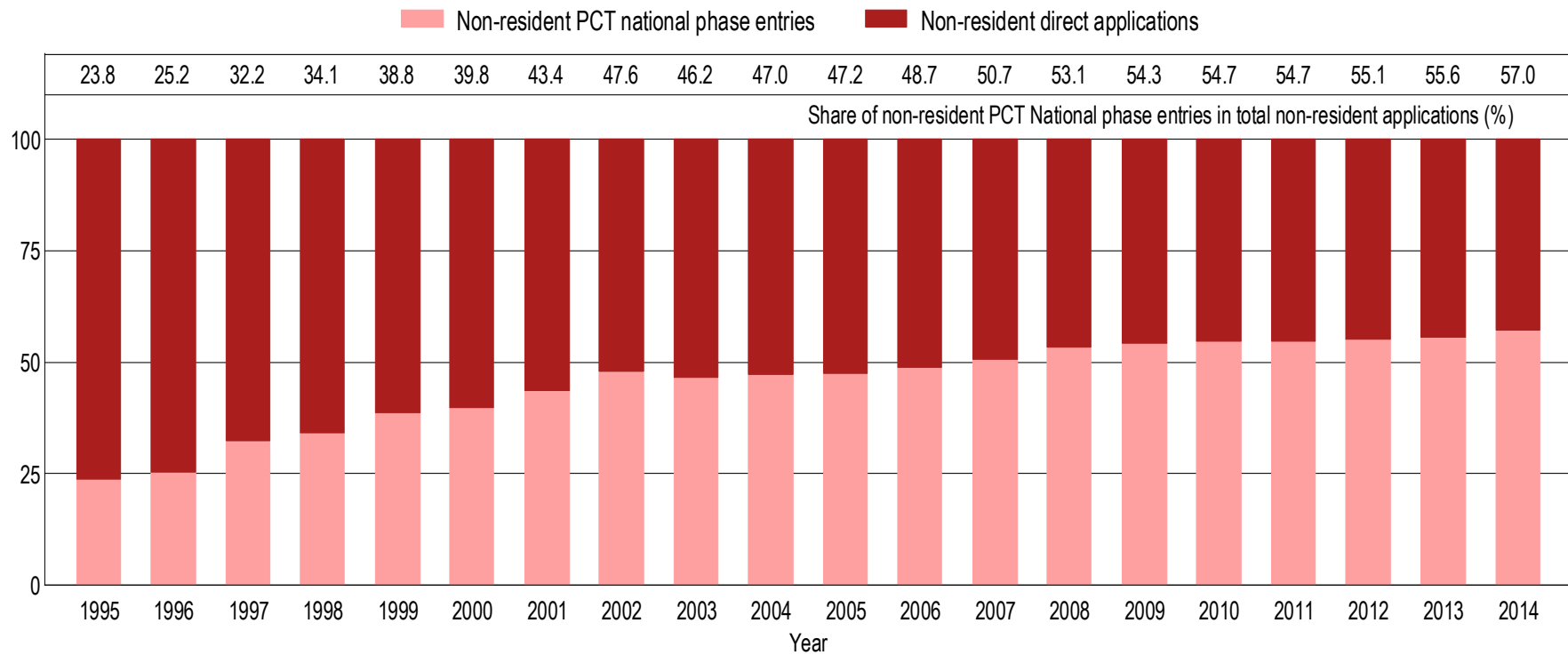
- Speaker: Aino Metcalfe, Head, PCT eServices Unit,
PCT Information Systems Division, WIPO

Seeking patents internationally - Paris system vs. PCT system



Paris route vs. PCT national phase

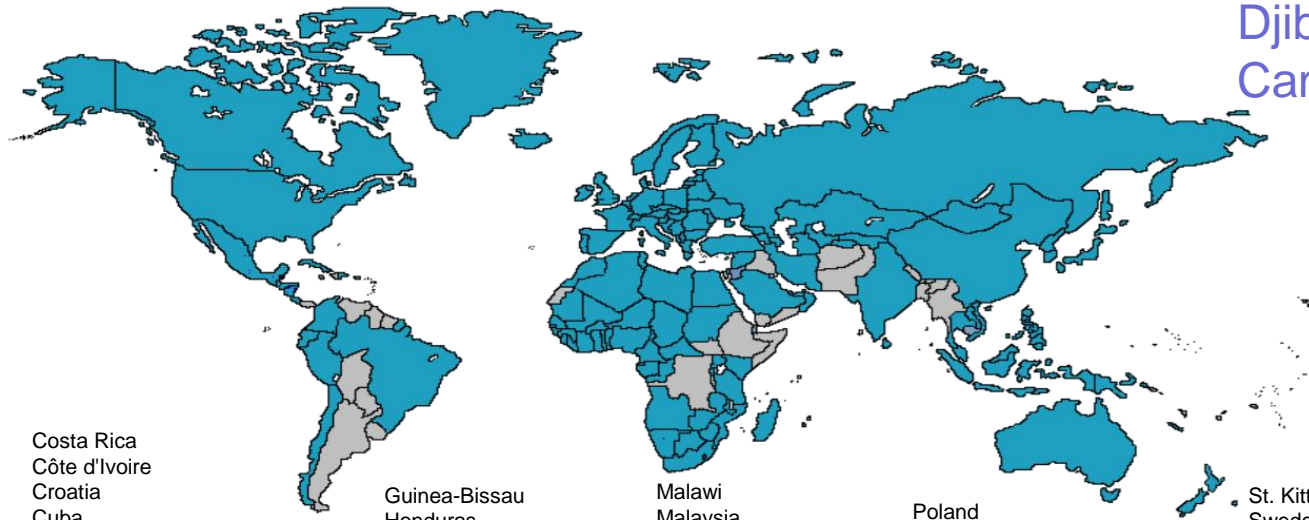
“Market share”



152 PCT States

Latest accessions:

Jordan
Kuwait
Djibouti
Cambodia



Albania
Algeria
Angola
Antigua and Barbuda
Armenia
Australia
Austria
Azerbaijan
Bahrain
Barbados
Belarus
Belgium
Belize
Benin
Bosnia and Herzegovina
Botswana
Brazil
Brunei Darussalam
Bulgaria
Burkina Faso
Cambodia (8 Dec. '16)
Cameroon
Canada
Central African Republic
Chad
Chile
China
Colombia
Comoros
Congo

Costa Rica
Côte d'Ivoire
Croatia
Cuba
Cyprus
Czech Republic
Democratic People's
Republic of Korea
Denmark
Djibouti (23 Sept. '16)
Dominica
Dominican Republic
Ecuador
Egypt
El Salvador
Equatorial Guinea
Estonia
Finland
France
Gabon
Gambia
Georgia
Germany
Ghana
Greece
Grenada
Guatemala
Guinea

Guinea-Bissau
Honduras
Hungary
Iceland
India
Indonesia
Iran (Islamic Republic of)
Ireland
Israel
Italy
Japan
Jordan (9 June 17)
Kazakhstan
Kenya
Kuwait (9 Sept. '16)
Kyrgyzstan
Lao People's Dem Rep.
Latvia
Lesotho
Liberia
Libyan Arab Jamahiriya
Liechtenstein
Lithuania
Luxembourg
Madagascar

Malawi
Malaysia
Mali
Malta
Mauritania
Mexico
Monaco
Mongolia
Montenegro
Morocco
Mozambique
Namibia
Netherlands
New Zealand
Nicaragua
Niger
Nigeria
Norway
Oman
Panama
Papua New Guinea
Peru
Philippines

Poland
Portugal
Qatar
Republic of Korea
Republic of Moldova
Romania
Rwanda
Russian Federation
Saint Lucia
Saint Vincent and
the Grenadines
San Marino
Sao Tomé e Príncipe
Saudi Arabia
Senegal
Serbia
Seychelles
Sierra Leone
Singapore
Slovakia
Slovenia
South Africa
Spain
Sri Lanka
Sudan
Swaziland

St. Kitts and Nevis
Sweden
Switzerland
Syrian Arab Republic
Tajikistan
Thailand
The former Yugoslav
Republic of Macedonia
Togo
Trinidad and Tobago
Tunisia
Turkey
Turkmenistan
Uganda
Ukraine
United Arab Emirates
United Kingdom
United Republic of Tanzania
United States of America
Uzbekistan
Viet Nam
Zambia
Zimbabwe

UN Member States not yet in PCT

Afghanistan

Andorra*

Argentina**

Bahamas

Bangladesh*

Bhutan

Bolivia

Burundi

Cape 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

(41)

*Also in discussions
with GCC Patent Office
about linking its system
to PCT*

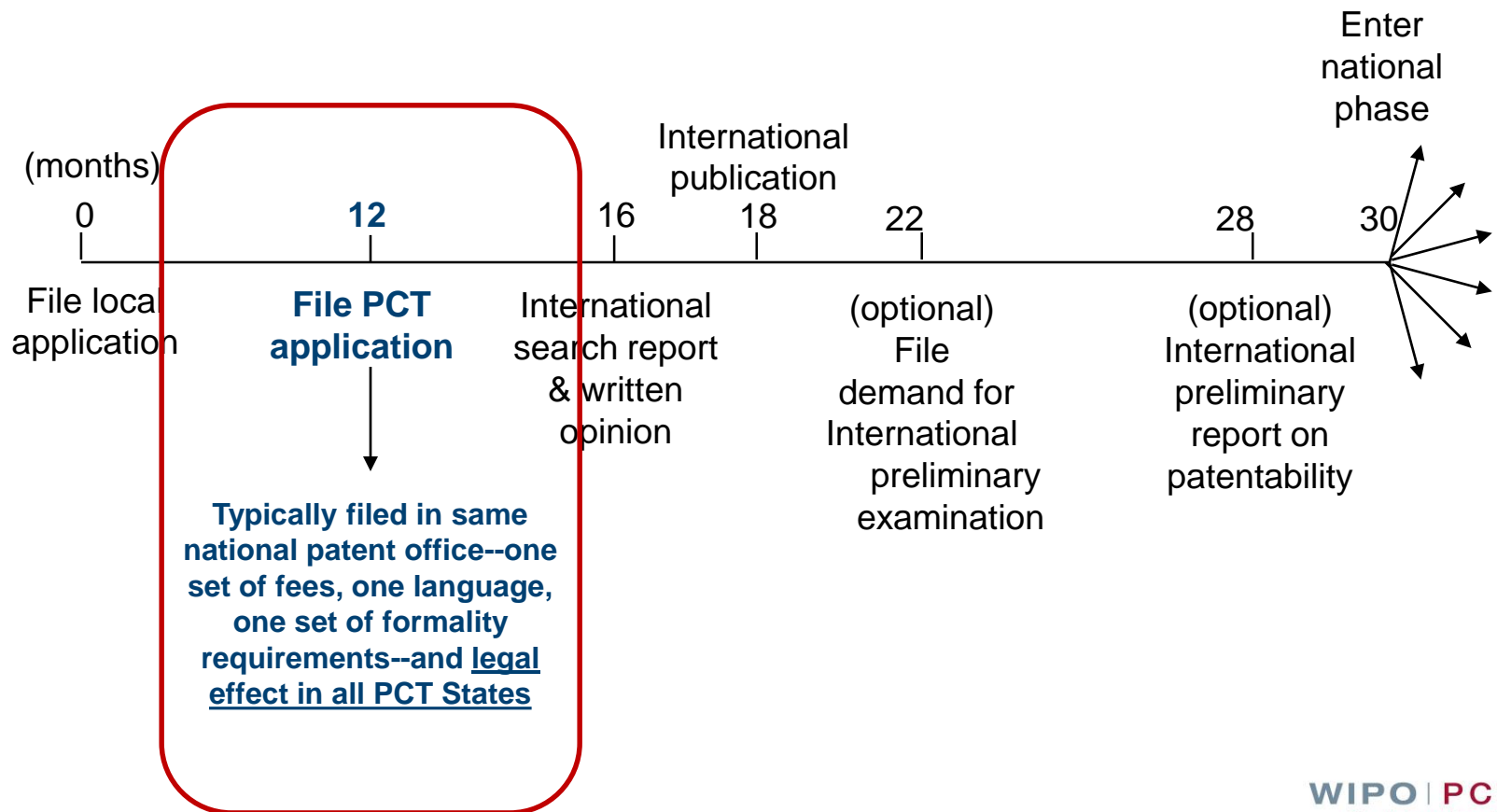
**preparing to accede*

***PCT discussions ongoing*

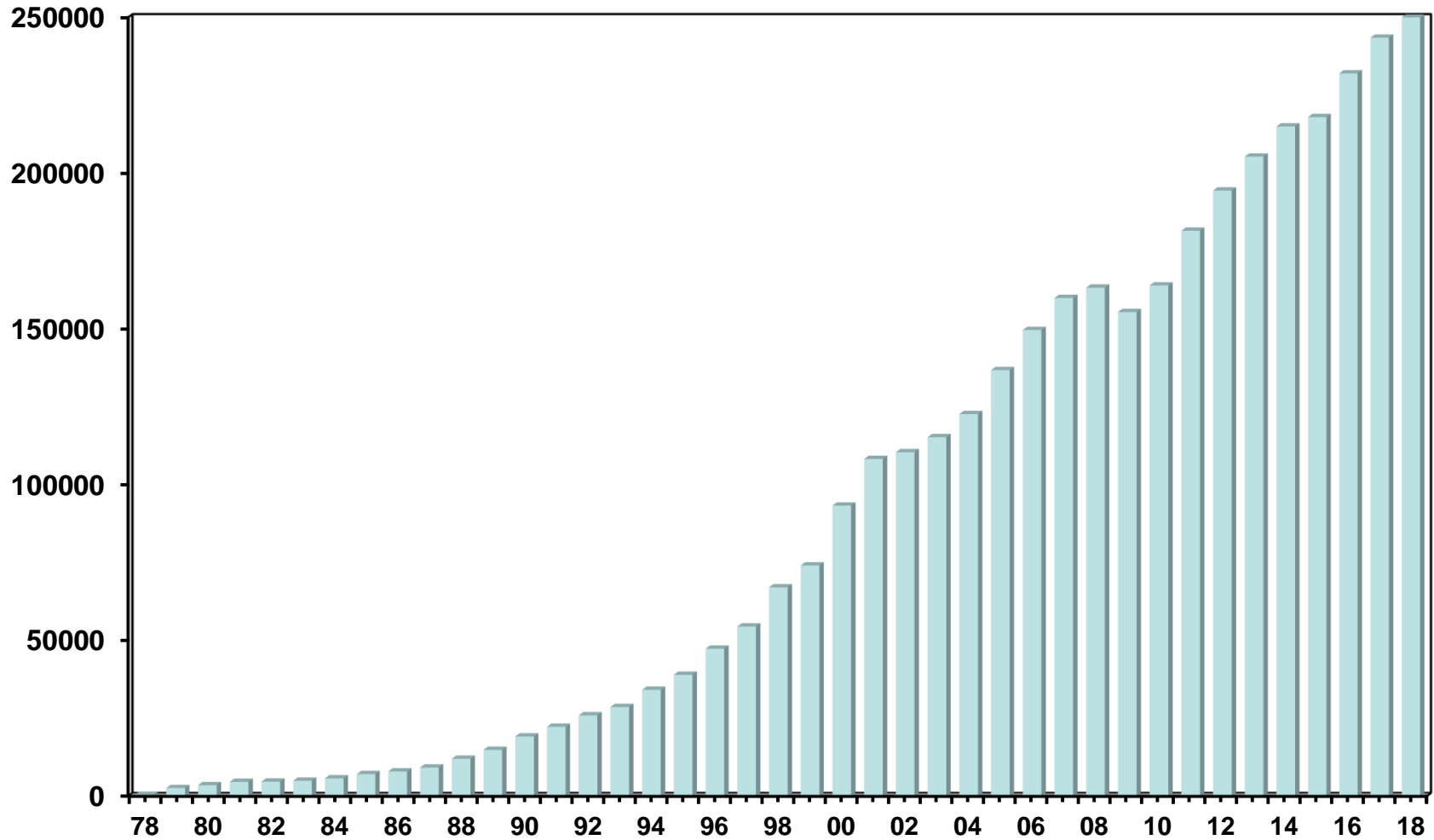
General remarks on the PCT system

- The PCT system is a patent application “filing” system, not a patent “granting” system; there is no “PCT patent,” “international patent” or “global patent”
- The decision on granting patents is made exclusively by national or regional Offices after the international phase
- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles

Using the PCT system to seek international patent protection

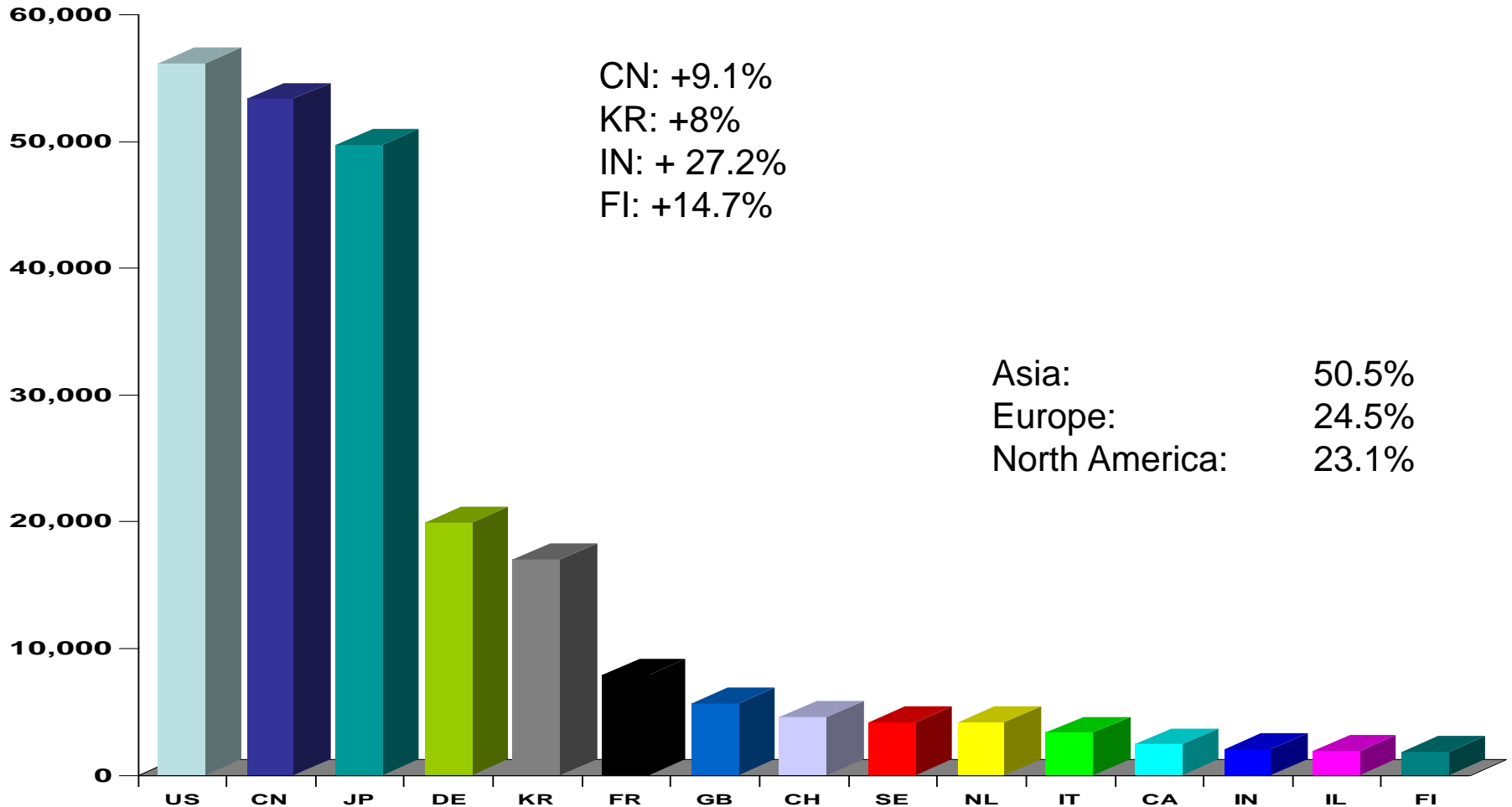


PCT Applications



2018: 253,000 applications (+ 3.9 %)

International applications received in 2018 by country of origin



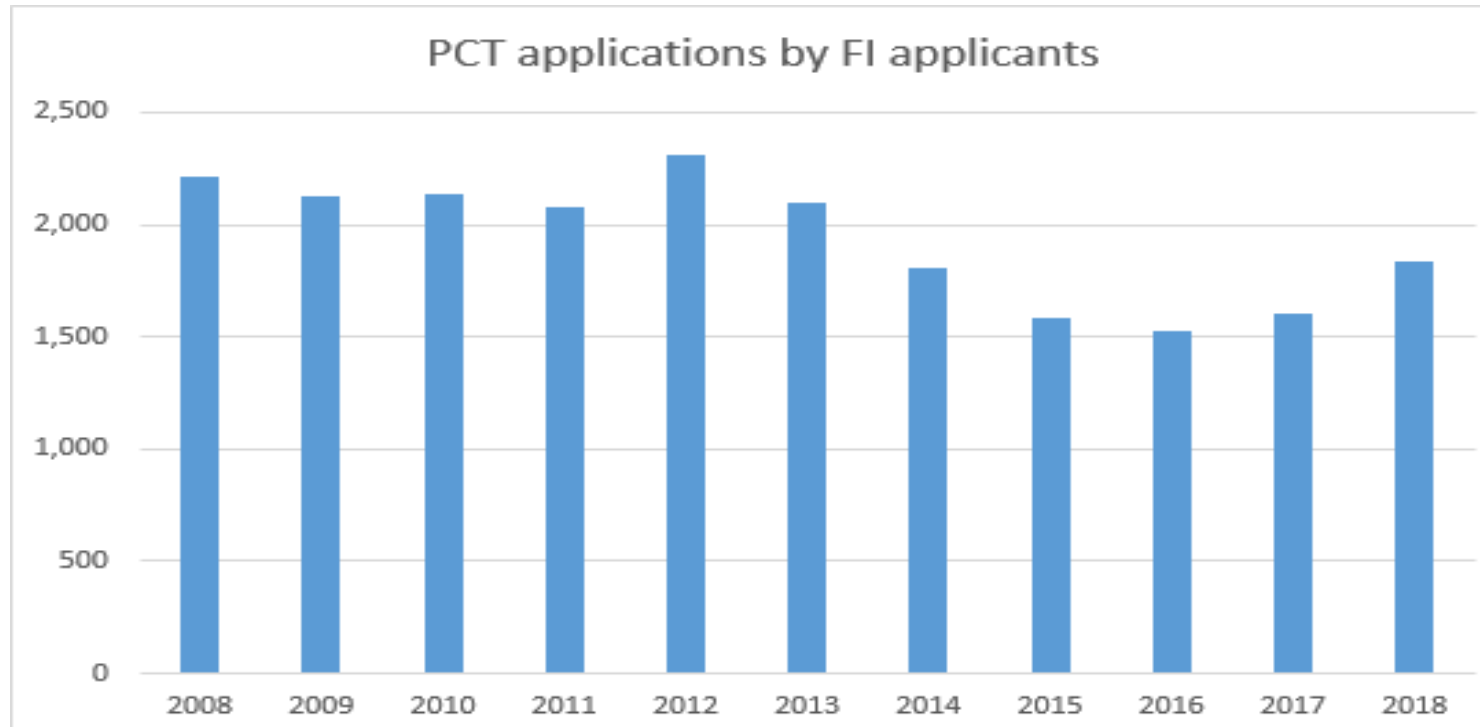
- 22.1% originating in US, 21% in China, 19.6% in Japan
- 62.7% from the top 3 countries, 77.5% from top 5 countries, 92.4% of filings from top 15 countries

Top PCT Applicants in 2018

1. Huawei Technologies—CN (5,405)
2. Mitsubishi Electric—JP (2,812)
3. Intel—US (2,499)
4. Qualcomm—US (2,404)
5. ZTE—CN (2,080)
6. Samsung—KR (1,997)
7. BOE Technology Group—CN (1,813)
8. LG Electronics—KR (1,697)
9. Ericsson—SE (1,645)
10. Bosch—DE (1,524)
11. Microsoft—US (1,476)
12. Panasonic—JP (1,465)
13. Sony—JP (1,342)
14. Siemens—DE (1,211)
15. Hewlett-Packard—US (1,170)

*() of published
PCT applications*

PCT use by FI applicants



- ❑ Receiving Office options for residents/nationals of Finland: RO/FI: Around 61%; RO/EP: 33%; RO/IB: 6% in 2018

Top-10 FI PCT users 2017

Applicant	2017
NOKIA TECHNOLOGIES OY	315
NOKIA SOLUTIONS AND NETWORKS OY	263
OUTOTEC (FINLAND) OY	72
WARTSILA FINLAND OY	52
KONE CORPORATION	49
STORA ENSO OYJ	45
TEKNOLOGIAN TUTKIMUSKESKUS VTT	42
KEMIRA OYJ	40
HELSINKI UNIVERSITY	13
AALTO UNIVERSITY	11

More details:

https://www.wipo.int/ipstats/en/statistics/country_profile/profile.jsp?code=FI

Certain PCT advantages (1)

- The PCT provides a worldwide system for simplified filing and processing of patent applications, which:
 - ❑ Postpones the major costs associated with internationalizing a patent application: translations, local agents, Office fees
 - ❑ Provides a strong basis for patenting decisions:
International search report and written opinion by the International Searching Authority (ISA)
 - ❑ Harmonizes formal requirements:
PCT Applicant's Guide, paragraph 4.011: "There is a prescribed form for the international application. This form must be accepted by all designated Offices for the purposes of the national phase, so that there is no need to comply with a great variety of widely differing formal requirements in the many countries in which protection may be sought."

Certain PCT advantages (2)

- ❑ Procedures to protect the applicant from various inadvertent errors:
 - Non-competent receiving Office: transmit to RO/IB
 - Invitations to correct defects & pay fees (most Offices)
 - Restoration of priority
 - Missing parts/incorporation by reference
 - Rectification of obvious mistakes
 - Removal of sensitive information
 - Excuse of national phase entry delay

ePCT

- WIPO's online portal (<https://pct.wipo.int>) providing:
 - ❑ Secure and direct interaction with PCT applications maintained by the International Bureau
 - ❑ Applicants can conduct most PCT transactions electronically, with IB and ROs, ISAs, IPEAs
 - ❑ Web-based filing available to all PCT filers
 - ❑ Real-time validation against the IB processing system
 - ❑ Create WIPO Account + add strong authentication (one-time password via app or SMS, EPO smart card, WIPO digital certificate): access to full range of services
 - ❑ Compatible with EPO's filing tools: facilitates access to PCT applications after filing

Recent Legal and Other PCT Developments

Summary of Recent PCT Legal Changes

- July 2016: two additional protections/safeguards:
 - Procedure to effectively remove from PCT applications and WIPO's publicly accessible application-related documents “sensitive” information mistakenly submitted (PCT Rules 9, 48 & 94)
 - the information which is sought to be removed must be:
 - irrelevant to the disclosure
 - prejudicial to personal or economic interests, and
 - there must be no prevailing public interest in its access
 - Missed time limits due to large-scale Internet outages
 - extension of *force majeure* excuse of delay provision to time limits missed due to “general unavailability of electronic communications services” (amended Rule 82*quater*)
 - covers outages that affect widespread geographical areas or many individuals, as distinct from localized problems associated with a particular building or single user

Summary of Recent PCT Legal Changes

■ July 2017:

□ PCT national phase becomes more transparent:

- Designated Offices are required to provide the IB with timely national phase entry and related data (Rules 86 & 95)
 - Within 2 months from expiry of national phase deadline or asap thereafter
 - Date of national phase entry, national application number, number and date of any national publication, and date of grant
- PATENTSCOPE “National phase” tab to contain more information
 - Data from 68 Offices, with more expected

□ Receiving Offices required to forward earlier search or classification results on priority applications to the ISA (Rules 12*bis*, 23*bis* & 41)

- ROs were allowed to opt out if this procedure was incompatible with national law when the amendments were introduced
 - PRH (and 10 other ROs) made this notification to opt out

■ July 2019:

□ Timing of International Preliminary Examination (Rule 69.1(a)): IPEA to begin examination when in possession of demand, fees, ISR and WO, unless postponement is requested

Other developments: color drawings (1)

- IB has implemented an “interim solution” as to color drawings:
 - Electronic applications made to certain ROs using ePCT or PCT-SAFE can indicate that the application as filed contains color images
 - Triggers a notification on the front page of the published application that the application as filed contains color drawings which are available for download from PATENTSCOPE

- May be helpful for designated Offices (DO) which accept color drawings, although:
 - The legal PCT requirement still has not yet changed
 - Color images or greyscale will be converted by the IB to black & white
 - DOs may still require black & white in the national phase

Other developments: color drawings (2)

- The purpose is not to encourage use of color images but to recognize that many applications contain color images and allow/assist DOs which accept color images to more easily access them
 - Eventual goal is to have full color processing through international phase and into national phase, and adapted legal requirements

Other developments: Contingency document upload

- Turning off fax at the IB at the end of 2019
- An alternate means for submitting documents and new applications in the exceptional situation that ePCT is down
 - <https://pct.wipo.int/ePCTExternal/pages/UploadDocument.xhtml>
 - Allows upload of PDF documents without signing into a WIPO account—you provide email address which is validated, then get a link to the service. You upload the document(s) and get an automated confirmation of receipt.
- WIPO strongly encourages use of ePCT for filing and submitting subsequent documents!

WIPO IP Portal

- The new portal will ‘join up’ the different services, allowing WIPO’s customers to navigate seamlessly and access them from one central point:
 - Filing systems, search databases, classification tools, renewals, payments made in a consistent manner etc.
- A single user account for all WIPO services
- Customizable: what you want to see ‘at a glance’
- The services may not change much, but be standardized in the way they look – useful for new customers and those with little prior knowledge of IP
- Launch due in September 2019

WIPO IP Portal

ALL	PCT	Classification Tools	Legal Texts
PATENTS	▶ PATENTSCOPE	▶ IPCPUB	▶ WIPO Lex
MARKS	▶ ePCT	▶ IPCRMS	Portal
DESIGNS	▶ PCT Time Limit Calculator	▶ IPC RECLASS	▶ WIPO IP Portal
IP ALTERNATIVE DISPUTE RESOLUTION	▶ WIPO Pearl	▶ IPC EFORUM	
DOMAIN NAME DISPUTE RESOLUTION	▶ DAS		
GEOGRAPHICAL INDICATIONS	▶ CASE		
FINANCE			

PCT best practices/reminders

■ Do:

- View and review filed application online asap after filing; via ePCT also publication front page preview
- Review published application immediately after publication (PATENTSCOPE)
- Request RO to prepare and transmit priority document, or use digital access service (DAS)
- Consider submitting any restoration of priority requests to RO/IB
- File *92bis* requests only with the IB directly
- Respect national phase entry time limit
- Call/e-mail the IB when you have a doubt or question!

■ Don't:

- Submit a notice of withdrawal to the RO or any authority other than the IB

PCT information and training

- Extensive information resources on PCT webpage (<https://www.wipo.int/pct/en/>)
- 29 video segments about specific PCT topics on WIPO's Youtube channel and PCT page
- PCT Distance learning course in the 10 PCT publication languages
- PCT Webinars
 - Updates on developments in PCT procedures and strategies—previous webinars are archived and freely available
 - Training also upon request, for example, on how to use ePCT
- PCT seminars and training sessions: see PCT seminar calendar (<https://www.wipo.int/pct/en/seminar/seminar.pdf>)
- Monthly Newsletter (<https://www.wipo.int/pct/en/newslett/>)

Help with PCT

- General or legal questions about the PCT:
 - E-mail: pct.infoline@wipo.int
 - Tel: +41-22-338-8338
- Questions on PCT electronic services, in particular ePCT:
 - E-mail: pct.eservices@wipo.int
 - Tel: +41-22-338-9523
 - Online Chat
 - 'HELP' link in the ePCT header:
<https://www.wipo.int/pct/en/epct/support.html>
- Monday to Friday, 9 am – 6 pm Geneva time