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## **Q&A Sheet**

### **Roving Webinar on WIPO Services and Initiatives – Day 2**

organized by

the World Intellectual Property Organization (WIPO)

and

the Canadian Intellectual Property Office (CIPO)

**May 28, 2021**

Service	Question Asked	Answer
<b>Patent Cooperation Treaty (PCT)</b> <a href="https://www.wipo.int/pct/en/">https://www.wipo.int/pct/en/</a>	Is it necessary to have a patent to start a startup in Canadian science and technology parks?	No, it is generally not necessary to have an issued patent or a pending patent application to participate in an accelerator or incubator program. However, different programs have different admission requirements, and you should check with each organization to determine whether you meet their requirements.
	Is there any option to pay PCT national fees to DOs through RO/IB channel by using a current account at WIPO? like trade mark and Madrid system? or does WIPO have any future plan to add this kind of services?	No, the PCT being an international patent filing system, grants are not handled by WIPO internationally; the PCT does not eliminate the need to further prosecute the application in the national phase and the fees are due to the national (regional)(Designated) Offices; the PCT does not provide for a centralized system to pay the national fees after national phase entries are further prosecuted. WIPO does not have any such plan.
	How are some countries valid longer than the WIPO record? Shouldn't they expire at the same time?	Patent prosecution and grant after the expiration of the 30 months are regulated by the national (regional) legislation of each national (regional) (Designated) Office where the international application is further prosecuted for national (regional) patent granting. Some variations may exist from one jurisdiction to another.
	In my country (Comoros Islands), how can I get a patent for my products and protect them?	Comoros are a PCT Member State and also Member of OAPI (African Intellectual Property Organization based in Yaounde, Cameroon). A national and/or resident from Comoros can file a PCT application either with OAPI as a Receiving Office (see <a href="#">Annex B(KM)</a> and <a href="#">Annex C(OA)</a> ) or with the International Bureau as a Receiving Office (see <a href="#">Annex C(IB)</a> )
	I am in Canada, if I first file a patent application in China next month, when and where should I send my PCT to, via CIPO website or WIPO website?	The receiving Office where you file your PCT application is based on your nationality or residency. Canadian nationals or Canadian residents, have the option of filing either with CIPO or the International Bureau. In selecting the receiving Office, you should keep in mind that each receiving Office has specific International Searching and Examining Authorities (ISA/IPEA) which are competent to carry out the search and examination for applications filed at said Office. For applications filed at the Canadian receiving Office the competent ISA/IPEA is CIPO. The competent ISA/IPEA for

		<p>applications filed with the International Bureau is dictated by the nationality of the applicants. If there are applicants of different nationalities, then there may be different options for the ISA/IPEA. The decision of whether you file at CIPO or WIPO is your choice. Applicants' decisions are often based on future prosecution of their application. CIPO strongly encourages applicants to seek a qualified patent agent to help with all aspects of your patent application, including determining where and when to file. Please see the following website for a list of qualified patent agents (<a href="http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04549.html">http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr04549.html</a>).</p>
	<p>Is there any service to pay prosecution of PCT application in national phase by WIPO current account? like Madrid system, which are possible to pay fees in CHF to all designated countries. Does WIPO have any plan to offer these kind of services? this could help SMEs to manage their budgeting.</p>	<p>No, the PCT being an international patent <u>filing</u> system, grants are not handle by WIPO internationally; the PCT does not eliminate the need to further prosecute the application in the national phase and the fees are due to the national (regional) (Designated) Offices); the PCT does not provide for a centralized system to pay the national fees. WIPO does not have any such plan.</p>
	<p>There are 12 months from PCT international publication to PCT national phase, how can new inventions be protected before entering the national phase? People can see my invention (patent application materials) during international publication before it is granted. How can my invention be protected?</p>	<p>Publication of patent applications before grant is a legal requirement in many countries and is a public policy measure intended to balance the rights of inventors with the rights of the public. It is usually unavoidable. In the United States, you may submit a non-publication request to prevent your US patent application from being published before issuance, but you must certify that you did not and will not file the application in another patent office that requires publication.</p> <p>If you filed a PCT application, you have the option of entering the national phase early. You don't have to wait until 30 or 31 months to enter the national phase and start examination. Some countries also offer the option of accelerating examination for a fee.</p> <p>Many countries also provide provisional rights: if you do obtain a granted patent in that country, you may be able to recover compensation from infringers who performed infringing acts during the period your patent application was published. The availability</p>

		<p>and scope of these provisional rights can vary by country, and you should consult legal advice if this is of concern to you.</p>
	<p>The Applicant, whether an individual or a company, can file ePCT without a patent attorney or not?  Particularly,  1) in case of multiple applicants, wherein one applicant is Canadian has a joint application with foreign companies, do the Applicants have a possibility to communicate with CIPO without a patent agent?  2) if the Applicant is a foreigner with a service address in Canada, has the Applicant still to be introduced by a patent agent at CIPO for filing ePCT?  3) is there any rule where a foreign Applicant, either an individual and/or a company, can directly communicate with CIPO without a representative, and where the rules can be found?</p>	<p>A PCT or Canadian patent application can be filed without patent agent representation, and a request for Canadian national phase entry can be filed without an agent. However, a Canadian agent is required for prosecution of an application when an applicant is not the inventor.</p> <p>1) Because the applicants include companies, a patent agent must be appointed to prosecute the application.</p> <p>2) The PCT application can be filed directly by the applicant.</p> <p>3) The Canadian rules regarding representation apply to applicants regardless of address or nationality. If the applicants are the inventors, they may communicate directly with CIPO without an agent. It does not matter if they are located outside Canada. If the applicants include a non-inventor, then they must appoint a Canadian agent to represent them.</p> <p>Please refer to the Canadian <i>Patent Rules</i>, subsection 27(2) and section 36: <a href="https://laws-lois.justice.gc.ca/eng/regulations/SOR-2019-251/FullText.html">https://laws-lois.justice.gc.ca/eng/regulations/SOR-2019-251/FullText.html</a></p>
	<p>In the Paris vs. PCT example (entering EU at 14-31 mo.), does the applicant need to be careful about EU requirement for absolute novelty (no grace period)?</p>	<p>Yes, the applicant needs to be careful about the requirement for absolute novelty (note: we are referring to the European Patent Office established under the European Patent Convention, not the European Union; the United Kingdom is still party to the European Patent Convention and is accessible through an application filed with the EPO).</p> <p>The relevant date for assessing novelty is the filing date of the European patent application: Article 54(2) EPC. In the case of a</p>

		PCT application that enters the regional phase in the EPO, this is the international filing date, not the regional phase entry date.
	Do countries which are not members of other multilateral IP treaties such as Paris convention, TRIPs agreement etc. become members of PCT? In other words, should IP treaties to be considered independently, or as a package like WTO (Uruguay round) agreements?	Any country that wants to become a PCT Member State needs to accede also to the Paris Convention, first, it is a legal requirement to become a PCT Member State. TRIPS agreements are administered by WTO, they do not relate to WIPO. The membership requirements are different with WIPO and WTO. Some PCT Member States can also be WTO Members.
	In the search, if it found that the invention is published in few countries, can an applicant will be allowed to apply for patent in rest of the countries? Because patent is a country specific right. Can you please give your view on this	While patent rights are territorial, the prior art citable for novelty and inventiveness is not. Prior art affecting the novelty or inventiveness of an invention can be found in publications in any language, from any country. This is written into national laws and conventions, and/or confirmed by judicial interpretations in individual countries.
	If one country grants patent, whether other 152 member countries allow patent or reject in view of their being signatory country?	Patent prosecution and grant after the expiration of the 30 months are regulated by the national (regional) legislation of each national (regional) (Designated) Office where the international application is further prosecuted for national (regional) patent granting. e.g. if as a result of the national phase prosecution a patent is granted in the USA, there is no guarantee than one is granted, in China, etc.
	What is the cost of patent filling in CIPO?	The official fees are available on the CIPO website: <a href="https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00142.html">https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00142.html</a>
<b>WIPO Mediation, Arbitration, and Domain Name Dispute Resolution</b>  <a href="https://www.wipo.int/amc/en/">https://www.wipo.int/amc/en/</a>	Under WIPO rules what is the maximum time for recording the final mediation by mediation or Award by arbitrator?	According to the WIPO Rules, the arbitration proceedings, wherever possible, shall be declared closed within not more than nine months (three months in expedited arbitration) after either the delivery of the Statement of Defense or the establishment of the Tribunal, whichever event occurs later. The final award should, wherever reasonably possible, be made within three months (one month in expedited arbitration) thereafter.

<a href="https://www.wipo.int/amc/en/domains/">https://www.wipo.int/amc/en/domains/</a>		<p>Mediation is an informal procedure allowing a high level of party autonomy, which shall be conducted in the manner agreed by the parties. Typically, a WIPO Mediation takes around 3-4 months, but can be completed in shorter time frames if parties so wish</p>
	<p>What are the fees for mediation and arbitration for WIPO ADR CENTRE? Can we engage our own advocates having submitted arbitration to WIPO CENTRE or we must engage from the counsels from the WIPO ADR CENTRE only?</p>	<p>1. Fees: The WIPO Center publishes on its website a detailed <a href="#">schedule of fees and costs</a>. In general, the fees of WIPO mediation proceedings include the administration fees (based on the amount in dispute) and the mediator's fees (fixed fees or hourly rate). The fees of WIPO arbitration proceedings consist of three main parts: the fixed registration fees, the administration fees (based on the amount in dispute) and the arbitrator(s)'s fees (hourly rate).</p> <p>2. Parties are free to engage their own counsel to represent them in WIPO ADR proceedings. As for the appointment of the neutral (i.e. mediator/arbitrator) in WIPO proceedings, according to the <a href="#">WIPO Rules</a>, parties may agree themselves on the person of the mediator/arbitrator or on another procedure for appointing the mediator/arbitrator; where such agreement is absent, the mediator/arbitrator will be appointed pursuant to the WIPO Center's list procedure.</p>
	<p>Is there always satisfaction to all parties involved in ADR in cases that WIPO has handled? if not what happens after that?</p>	<p>The <a href="#">settlement rate</a> of WIPO mediation has reached 78% in 2020, and the settlement rate of WIPO arbitration also reaches 33%, which indicates a high level of parties' intention to collaborate in WIPO proceedings.</p> <p>In some WIPO mediation cases where the parties had not reached a final settlement during mediation meetings, they settled the dispute through direct negotiation shortly after the termination of WIPO mediation, or in subsequent WIPO arbitration proceedings</p>
	<p>Can sports contract litigation be settled in the WIPO arbitration system?</p>	<p>The WIPO Center provides ADR guidance and case administration services to help parties resolve disputes arising <a href="#">in the area of IP and sports</a>, without the need for court litigation.</p> <p>As a flexible, time- and cost-efficient mechanism alternative to court litigation, ADR helps parties in such disputes to adopt</p>

		practical and satisfactory solutions. ADR allows parties to choose a mediator, arbitrator or expert with specific expertise in sports law, IP and dispute resolution. ADR provides a neutral forum in which an international dispute can be resolved through a single procedure. Moreover, ADR may be designed in a way so as to allow for efficient enforcement of the outcome
	Is the award is appealable under WIPO rules? What is the appeal period?	In principle, the award issued by the tribunal is final and binding between the parties, unless otherwise agreed by the parties in the arbitration agreement.  Exceptionally, where an appeal procedure has been agreed by the parties in the arbitration agreement, the tribunal, the parties and the WIPO Center shall follow the procedure accordingly.
	Are WIPO mediations resolutions mechanisms applicable in not member states' businesses?	WIPO ADR services are available to parties from WIPO member states and non-member states
<b>WIPO Global Databases</b> <a href="https://www.wipo.int/global_ip/en/">https://www.wipo.int/global_ip/en/</a>	Does WIPO keep track of search strings used in WIPO Databases?	No, WIPO does not keep track of the users' search strings. All is put in place to guaranty the highest levels of security and anonymity to PATENTSCOPE users. The HTTPS protocol is used to encrypt the traffic between the user's browsers and the servers to prevent eavesdropping and no external tracker is used in any way like Google Analytics or else.
	Is it possible to search and specify different technologies and technical domain?	Yes, this can be achieved by using boolean logic and classification codes (IPC and/or CPC). Please see details of the International Patent Classification at <a href="https://www.wipo.int/classifications/ipc/en/">https://www.wipo.int/classifications/ipc/en/</a> Here is an example of query to search vaccines in the agricultural domain: EN_AB:vaccine AND ICF:(A01 OR C05 OR C12N)
<b>WIPO IP Portal</b> <a href="https://ipportal.wipo.int/">https://ipportal.wipo.int/</a>	What is the benefit of using the widgets? Do they replace the actual IP services?	Currently, there are more than 15 available widgets in the IP Portal's dashboard. The benefit of these widgets is that they provide quick access to your information, such as payment transactions or allow you to perform some basic tasks, like searches. Additionally, there are some generic widgets, such as the world clock in which you can add multiple clocks in different time zones, or the latest news, where you may find all the news shared through the available communication sources. For more information about the use of each widget please add one in your

		<p>dashboard and select “How to use” from the Settings. Please note that the widgets do not replace the IP services. They present summary information from the existing IP services and provide you with a quick entry point into the services.</p>
	<p>How easy is to create a WIPO account?</p>	<p>The creation of a WIPO account is very easy and is free of charge. You can click on “Create WIPO Account” button in the landing page of the IP Portal <a href="https://ipportal.wipo.int/">https://ipportal.wipo.int/</a> and provide your user information. It will take only 2 minutes and it will provide great value since you will be able to navigate around all the WIPO applications, access additional features when searching the databases and make full use of the IP Portal functionalities.</p>