

Theme 1: Introduction to the Patent Cooperation Treaty (PCT)

Encouraging creativity and innovation



WORLD
INTELLECTUAL
PROPERTY
ORGANIZATION

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
 - optional supplementary international search and
 - optional 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

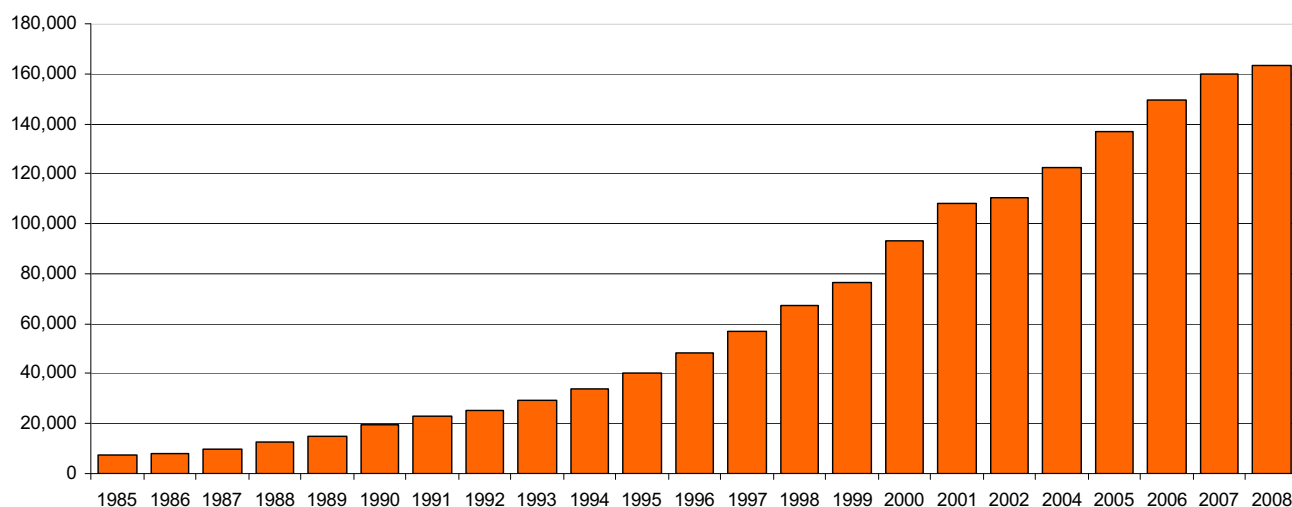
PCT Contracting States (142)(continued)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	HN	Honduras	NZ	New Zealand
AG	Antigua and Barbuda	ID	Indonesia	OM	Oman
✧ AL	Albania	IL	Israel	PE	Peru
AO	Angola	IN	India	PG	Papua New Guinea
AU	Australia	JP	Japan	PH	Philippines
✧ BA	Bosnia and Herzegovina	KM	Union of the Comoros	✧ RS	Serbia
BB	Barbados	KN	Saint Kitts and Nevis	SC	Seychelles
BH	Bahrain	KP	Democratic People's Republic of Korea	SG	Singapore
BR	Brazil	KR	Republic of Korea	ST	Sao Tome & Principe
BZ	Belize	LA	Lao People's Democratic Republic	SV	El Salvador
CA	Canada	LC	Saint Lucia	SY	Syrian Arab Republic
CL	Chile	LK	Sri Lanka	TH	Thailand (as of 24 December 2009)
CN	China	LR	Liberia	TN	Tunisia
CO	Colombia	LY	Libyan Arab Jamahiriya	TT	Trinidad and Tobago
CR	Costa Rica	MA	Morocco	UA	Ukraine
CU	Cuba	ME	Montenegro	US	United States of America
DM	Dominica	MG	Madagascar	UZ	Uzbekistan
DO	Dominican Republic	MN	Mongolia	VC	Saint Vincent and the Grenadines
DZ	Algeria	MX	Mexico	VN	Viet Nam
EC	Ecuador	MY	Malaysia	ZA	South Africa
EG	Egypt	NG	Nigeria		
GD	Grenada	NI	Nicaragua		
GE	Georgia				
GT	Guatemala				

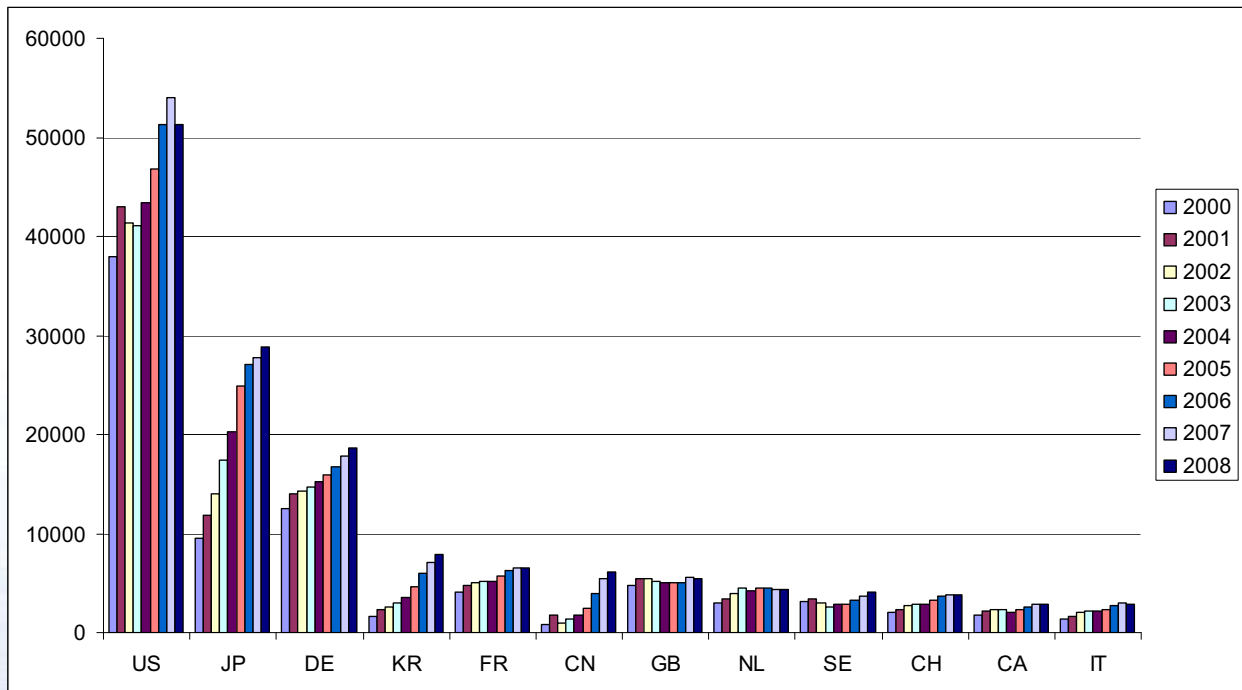
✧ Extension of European patent possible

Trends in PCT filings: number of international applications filed (1985 – 2008)



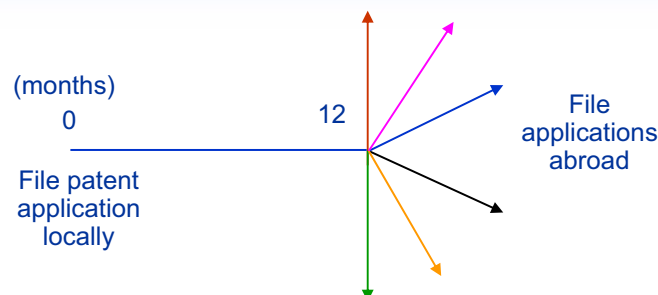
Source: WIPO statistics database

Trends in PCT filing: Leading countries



Source: WIPO statistics database

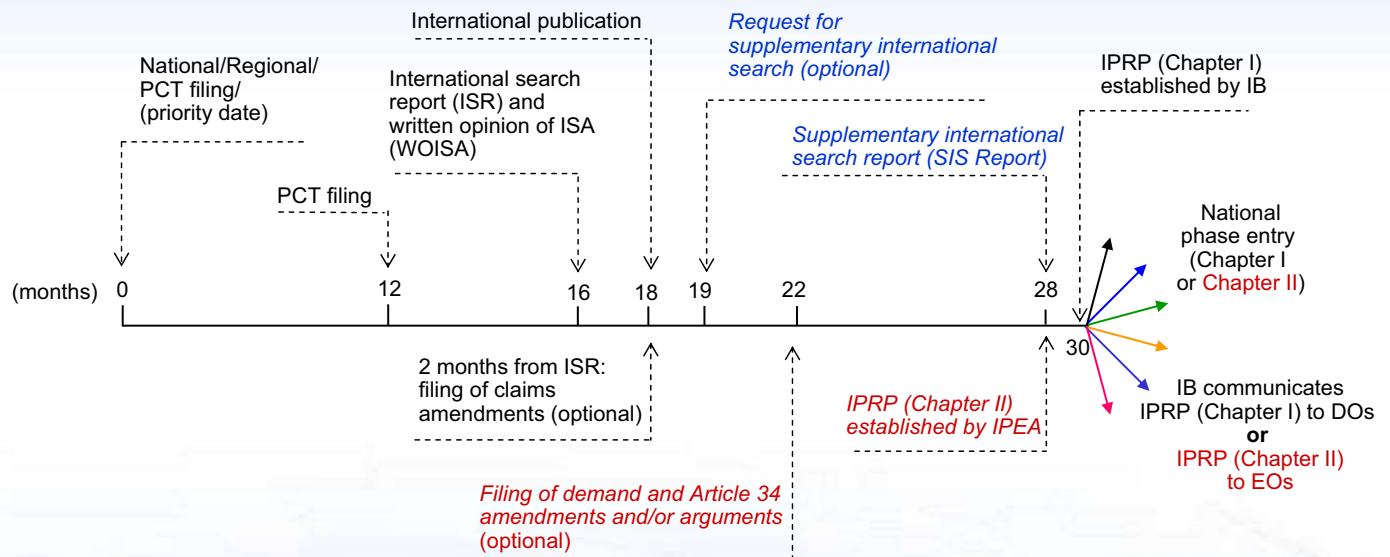
Traditional patent system (Paris Convention filings)



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

PCT Timeline



Local patent application filed followed within 12 months by filing an international application that claims priority under Paris Convention to the local application:

- one set of formality requirements
- international search resulting in international search report and written opinion of the ISA
- international publication
- optional international preliminary examination and optional supplementary international search
- translations and national fees required at 30 months, and only if applicant wishes to proceed

International Search Report (ISR)

- Contains among other information:
 - International Patent Classification (IPC) symbols; and, if the US is International Searching Authority (ISA), US classification
 - indications of the technical areas searched
 - a list of the relevant prior art documents
- Time limit to establish ISR and written opinion of the ISA:
 - 3 months from the date of receipt of the search copy by the ISA (about 16 months from the priority date) or
 - 9 months from the priority date, for example, where the international application does not claim prioritywhichever time limit expires later

Prior art cited on the International Search Report (ISR)

- Prior art is defined as
 - everything which has been made available to the public, anywhere in the world,
 - by means of written disclosure,
 - which is capable of being of assistance in determining that the claimed invention is or is not new and that it does or does not involve an inventive step,
 - provided the making available to the public occurred prior to the international filing date

Example of prior art documents cited on the ISR

C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X --- Y ---	US 4,573,621 A (NOVAK et al) 08 March 1983 (08.03.1983), col 1, line 5 and figure 3	1 and 2 -----
A		3 and 5 -15 -----
		4 and 16 - 20
Y	US 4,183,453 A (BARRETT et al) 15 January 1980 (15.01.1980), col 7, line 7 and figures 5 - 7	3 and 5 - 10
Y	US 3,041,614 A (D'HAEM et al) 03 July 1962 (03.07.1962), col 4, line 76 to col 5, line 23	11 - 15
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.		
* Special categories of cited documents:		
"A"	document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"E"	earlier application or patent but published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O"	document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family
"P"	document published prior to the international filing date but later than the priority date claimed	

Written opinion of the ISA (WOISA)

- A preliminary non-binding opinion on:
 - novelty (not anticipated)
 - inventive step (not obvious)
 - industrial applicability
- A WOISA will be established for all international applications at the same time as the ISR
- The WOISA is sent to applicant and to the International Bureau (IB) together with the ISR
- The WOISA is not published but it is available to the public from the WIPO Internet site - but not until after 30 months
- There is no formal procedure for applicants to respond to the WOISA; applicants may submit informal comments to the IB

Written opinion of the ISA Prior art applied against the claims

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement			
1.	Statement			
	Novelty (N)	Claims	3 - 20	YES
		Claims	1 and 2	NO
	Inventive step (IS)	Claims	4 and 16 - 20	YES
		Claims	1 - 3 and 5 - 15	NO
	Industrial applicability (IA)	Claims	1 - 20	YES
		Claims	NONE	NO
2.	Citations and explanations:			
	<p>Claims 1 and 2 lack novelty under PCT Article 33(2) as being anticipated by NOVAK et al. NOVAK et al teach the claimed electromagnetic fastener tool 10 with a housing 12 having a fastener magazine assembly 18 mounted thereon with the magazine assembly having a fastener output channel. The magazine assembly is pivoted between a first position wherein the tool cannot be actuated and a second position wherein a fastener may be drive from the tool (see figure 3 and column 1, line 65 - column 2, line 5). The magazine assembly is moved from the first position to the second position by placing the fastener output channel firmly against a work piece. As shown in Figure 3 and described at column 4, lines 6 - 49, the magazine assembly and the trigger button 24 are coupled by a safety mechanism 62. This safety mechanism has a sliding rod 64 with the lower end of the rod being attached to the top of channel of the magazine assembly such that the rod moves with the magazine assembly. When the magazine assembly is placed on a work piece, it rotates into the second position and pushes the rod upward. The upper portion of the rod has a spring 74 which includes a cam surface 76, a curved surface 78 and a bottom edge 81. The bottom edge of the spring is normally positioned adjacent to flange 86 of trigger button 24 and blocks upward movement of the trigger button. Thus the trigger button may not be depressed (moved upward) to actuate the tool until the bottom edge of the spring is moved away from the flange. This is accomplished by the interaction of curved surface 78 of spring 74 with a corresponding curved</p>			

International preliminary report on patentability (Chapter I of the PCT) – “IPRP (Chapter I)”

- If applicant does not file a demand for international preliminary examination:
 - IB establishes IPRP (Chapter I) on basis of the WOISA
 - applicant can file informal comment on the written opinion of the ISA directly with the IB up until 30 months from the priority date
 - IPRP (Chapter I) and any informal comments by applicant
 - are sent to designated Offices
 - are made publicly available (but not “published” like the international application and ISR)
 - but not before the expiration of 30 months from the priority date

PATENT COOPERATION TREATY
PCT
INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter I of the Patent Cooperation Treaty)
(PCT Rule 44bis)

Applicant's or agent's file reference	FOR FURTHER ACTION		See item 4 below
International application No.	International filing date (<i>day/month/year</i>)	Priority date (<i>day/month/year</i>)	
International Patent Classification (IPC) or national classification and IPC			
Applicant			
<p>1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44bis.1(a).</p> <p>2. This REPORT consists of a total of _____ sheets, including this cover sheet. In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.</p> <p>3. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p> <p>4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).</p>			
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 338 82 70		Date of issuance of this report	
		Authorized officer	
Form PCT/IB/373 (July 2009)		Telephone No. +41 22 338 XX XX	

Basics of international preliminary examination

- International preliminary examination
 - is an optional procedure
 - is requested by filing a “demand” directly with the International Preliminary Examining Authority (IPEA)
 - results in issuance of a preliminary, non-binding opinion by the IPEA on novelty, inventive step and industrial applicability set forth in the International Preliminary Report on Patentability (Chapter II of the PCT) - “IPRP (Chapter II)”
 - gives applicant the opportunity to
 - amend the description, claims and drawings before entering the national phase in the elected Offices
 - argue the findings in the written opinion of the ISA with the aim of overcoming any negativities
 - hold an oral interview with the examiner prior issuance of the IPRP (Chapter II) to discuss the claimed invention and distinguish it over the prior art

Filing a demand

- The demand must be filed within the later of:
 - 3 months from the date of transmittal of the search report and WOISA or
 - 22 months from the priority date*
- Applicant may file the demand early and indicate that he expressly wishes international preliminary examination to start earlier than the time limit above
 - otherwise the IPEA must wait until the expiration of the time limit to begin Chapter II examination
- The demand should be filed directly with the IPEA

* if applicant wants to enter the national phase directly in LU, TZ or UG at 30 months (or later), he must file the demand before 19 months from the priority date

International preliminary report on patentability (Chapter II of the PCT) – IPRP (Chapter II)

- IPRP (Chapter II)
 - will be established by the IPEA by about 28 months from the priority date
 - is sent to the applicant and the IB
- The IB forwards copies of the report, and any required translation of the report into English (prepared by the IB), to the elected Offices

PATENT COOPERATION TREATY
PCT
INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference	FOR FURTHER ACTION		See Form PCT/IEA/416
International application No.	International filing date (<i>day/month/year</i>)	Priority date (<i>day/month/year</i>)	
International Patent Classification (IPC) or national classification and IPC			
Applicant			

- This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
- This REPORT consists of a total of _____ sheets, including this cover sheet.
- This report is also accompanied by ANNEXES, comprising:
 - _____ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - _____ (*sent to the International Bureau only*) a total of (indicate type and number of electronic carrier(s) containing a sequence listing, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see paragraph 30is of Annex C of the Administrative Instructions).
- This report contains indications relating to the following items:

<input checked="" type="checkbox"/> Box No. I	Basis of the report
<input type="checkbox"/> Box No. II	Priority
<input type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/> Box No. IV	Lack of unity of invention
<input type="checkbox"/> Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/> Box No. VI	Certain documents cited
<input type="checkbox"/> Box No. VII	Certain defects in the international application
<input type="checkbox"/> Box No. VIII	Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/V	Authorized officer
Facsimile No.	Telephone No.

Form PCT/IEA/409 (cover sheet) (July 2009)

Advantages of using the PCT (1)

- Additional time
 - to make final decisions on the commercial importance of the invention
 - to lineup licensees, capital, partners
- Global publicity for the invention through publication of the international application
- Ease of filing
- Additional information obtained during the international phase
 - international search report
 - written opinion of the ISA
 - optional supplementary international search
 - optional international preliminary examination

Advantages of using the PCT (2)

- Ability to have amended claims published in response to the international search report for provisional protection
- Option of filing a single response to negative findings in the written opinion of the ISA with the goal of receiving a “positive” IPRP (Chapter II)
- Optional ability to amend the description, claims and/or drawings with the effect in all elected States
- Ability to start national/regional processing at any time during the international phase or to delay the decisions until at least 30 months