

The Patent Cooperation Treaty (PCT) at the center of the international patent system

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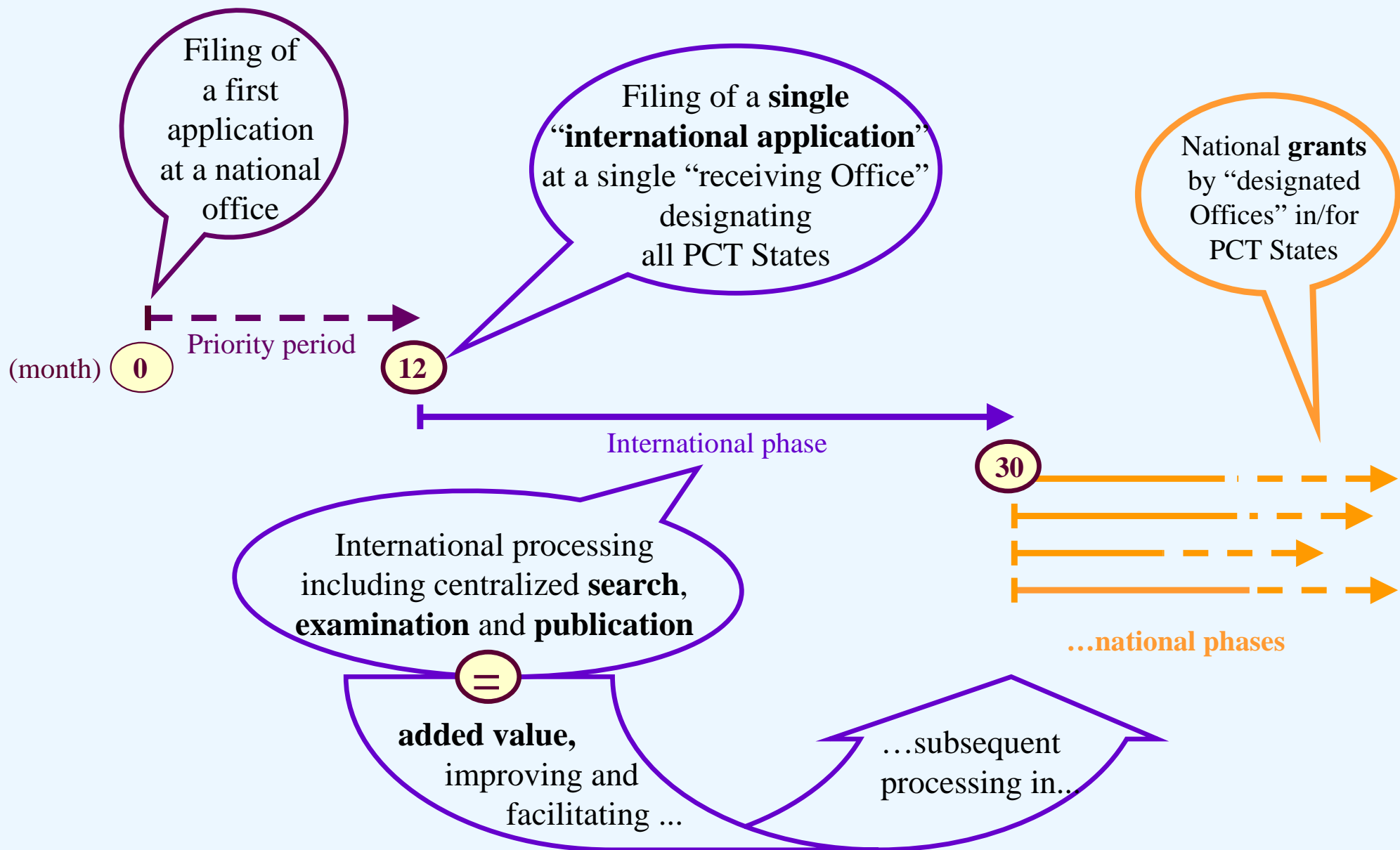
This presentation will highlight the following topics :

- 1 Setting the scene: the PCT system in a few dates and numbers
- 2 What does the PCT signify beyond these dates and numbers
 - a an international treaty in the field of patents
 - b the international system for the filing of patent applications
 - c the momentum for improving the international patent system
 - d a model of international cooperation
 - e an open door into a wealth of scientific and technical information
- 3 An outline of the PCT procedure
 - a the international phase
 - b the national phase
- 4 **PatentScope** or how to access resource materials on PCT and patent matters

1 Setting the scene

- patent **filing** (not granting) system
for **inventions**
- **at the center of**
international **legal framework**
international **system**
of offices and organizations

Introducing the PCT procedure



1

Setting the scene: a few dates and numbers

- Concluded in June 1970
78 countries, 11 IGOs 11 NGOs
- Started in June 1978
18 countries
500 applications
- By end 2004
more than one million applications
- In 2005
128 countries
130,000 applications

A few more dates and numbers

Evolution of the numbers of PCT filings

June to December 1978	<500
1979 (first full year)	2,600+
1980	3,500+
1990	19,000+
2000	90,000+
2004	123,000
2005 (provisional)	134,000



**In the Fall of 2004
the one millionth
application was filed**

Main countries of origin of filings in 2005

US (34%)
JP (18%)
DE (12%)
FR (<5%), GB (<5%), NL (<5%)

The main PCT applicants in 2005

The first worldwide

The first US

- | | | |
|-----|------------------|----|
| 1. | Philips | NL |
| 2. | Matsushita | JP |
| 3. | Siemens | DE |
| 4. | Nokia | FI |
| 5. | Bosch | DE |
| 6. | Intel | US |
| 7. | BASF | DE |
| 8. | 3M | US |
| 9. | Motorola | US |
| 10. | DaimlerChrysler | DE |
| 11. | Kodak | US |
| 12. | Honeywell | US |
| 13. | Ericsson | SE |
| 14. | Samsung | KR |
| 15. | Procter & Gamble | US |
| 16. | Sony | JP |
| 17. | Mitsubishi | JP |
| 18. | DuPont | US |
| 19. | Toyota | JP |
| 20. | Thomson Lic. | FR |

The top 20 applicants represent about 10-12 % of annual filings

2

What does the PCT signify beyond these dates and numbers ?

- a an international treaty in the field of patents
- b the international system for the filing of patent applications
- c the momentum for improving the international patent system
- d a model of international cooperation between countries and intergovernmental organizations around the world
- e an open door into a wealth of scientific and technical information

2 a The PCT: an international treaty in the field of patents

- Multilateral treaty
 - with several subsidiary legal texts
- Other multilateral treaties
 - Paris Convention
 - regional patent treaties
 - etc.
- National laws

2 a The PCT: an international treaty in the field of patents

The intention of the Contracting States
as illustrated by selected keywords from the preamble to the Treaty:

- to make a contribution to the **progress of science and technology**
- to perfect the **legal protection** of inventions
- to simplify and render **more economical** the obtaining of protection in several countries
- to facilitate and accelerate **access by the public** to technical information contained in documents describing new inventions
- to foster and accelerate **economic development** for developing countries

The framework in which the PCT was concluded in 1970

- national laws of future PCT Contracting States

- then existing international instrument of which a number of the future PCT Contracting States were already members:
 - Paris Convention for the Protection of Industrial Property (1883)

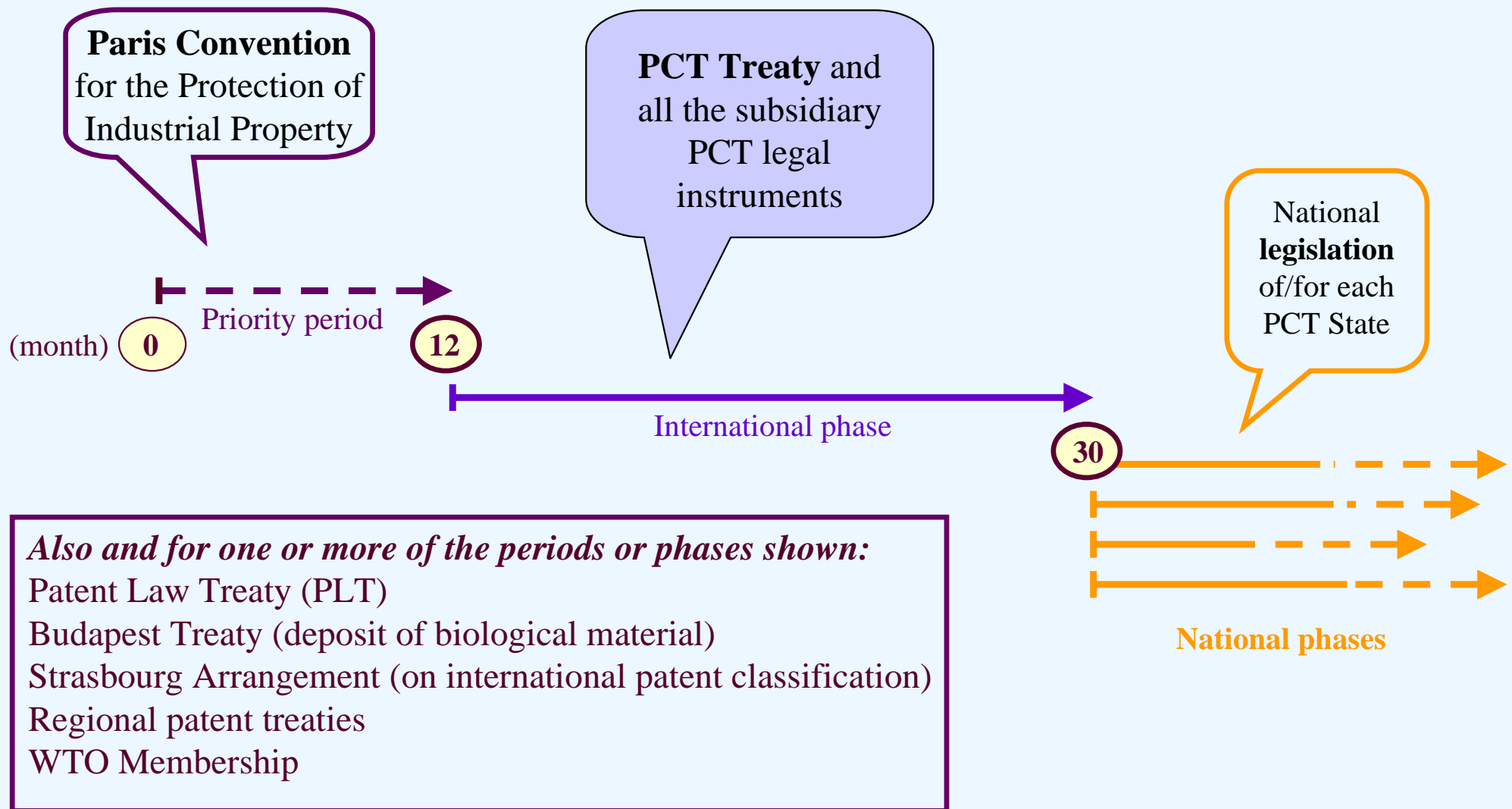
- then soon to be concluded international or regional instruments of which a number of the future PCT Contracting States would also be members:
 - Strasbourg Agreement concerning the International Patent Classification (1971)
 - European Patent Convention (EPC) (1973)

- from its conclusion, the PCT became an essential part of the background holding the overall structure of the international patent system

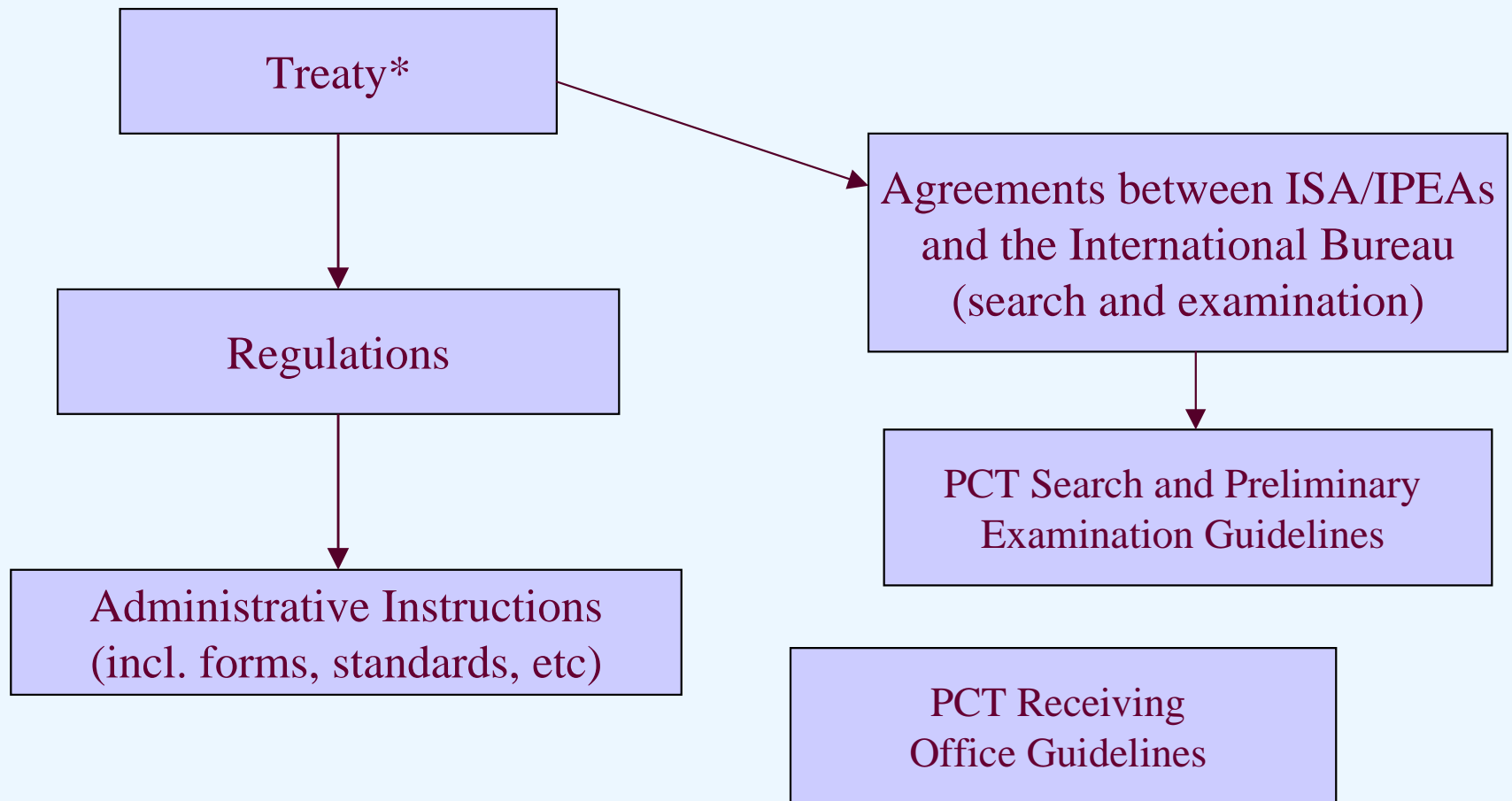
The treaties and conventions concluded subsequently to the PCT

- instruments of which a number of the PCT Contracting States were going to become members in the course of the following years or are still today considering or preparing to becoming members:
 - Bangui Agreement (OAPI system and Office) (1977)
 - Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (1977)
 - Treaty between Liechtenstein and Switzerland (1980)
 - Harare Protocol (ARIPO system and Office) (1982)
 - TRIPs Agreement within the framework of the WTO (1994)
 - Eurasian Patent Convention (EAPC) (1994)
 - Patent Law Treaty (PLT) (2000)

The main legal instruments of the patent system



The main PCT legal texts



- * *Containing several chapters, two of which in particular will often be referred to:*
- **Chapter I** - *All steps except preliminary examination by the IPEA*
 - **Chapter II** - *Only preliminary examination by the IPEA and national phase on that basis*

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The international system for the filing of patent applications

-- **a patent “filing” system** for :

- inventions only (via patents, utility models or similar titles)
- not a patent “granting” system :
 - decision to grant patents solely within the jurisdiction of national offices
 - a “PCT patent” does not exist

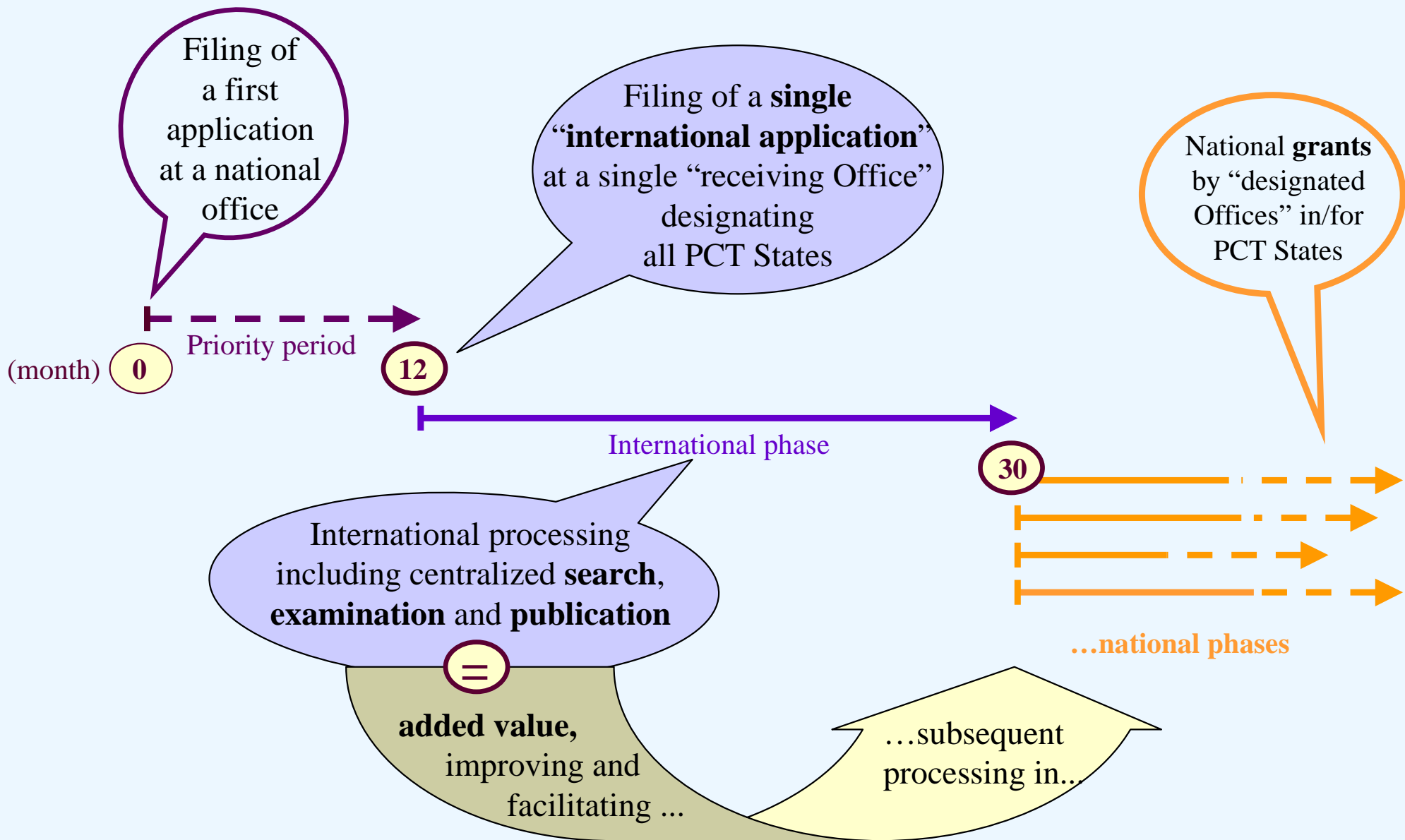
-- **the only international patent filing system**

available to date to patent applicants worldwide

Outline of the procedure

- **One** centralized international phase
for all PCT countries
- **Followed by** national examination processes
but only in countries of interest

Outline of the procedure



The momentum for improving the patent system

- Momentum engineered and encouraged by:
 - consistency between all elements
 - rationalization of procedures and approaches
 - cooperation between all interested parties
 - predictability of the system

- All these are visible in particular through:
 - international standards
 - agreed interpretation of Treaty provisions (and subsidiary texts)
 - guidelines for processing applications and for search and examination
 - timeline of the international procedure
 - guaranteed availability of detailed information
on various legal, procedural and technical aspects

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A model of international cooperation between countries and intergovernmental organizations around the world

- More than 100 offices
 - national and regional
 - various PCT functions

- OPCT of WIPO
 - administration of the PCT system
 - publication and access to files

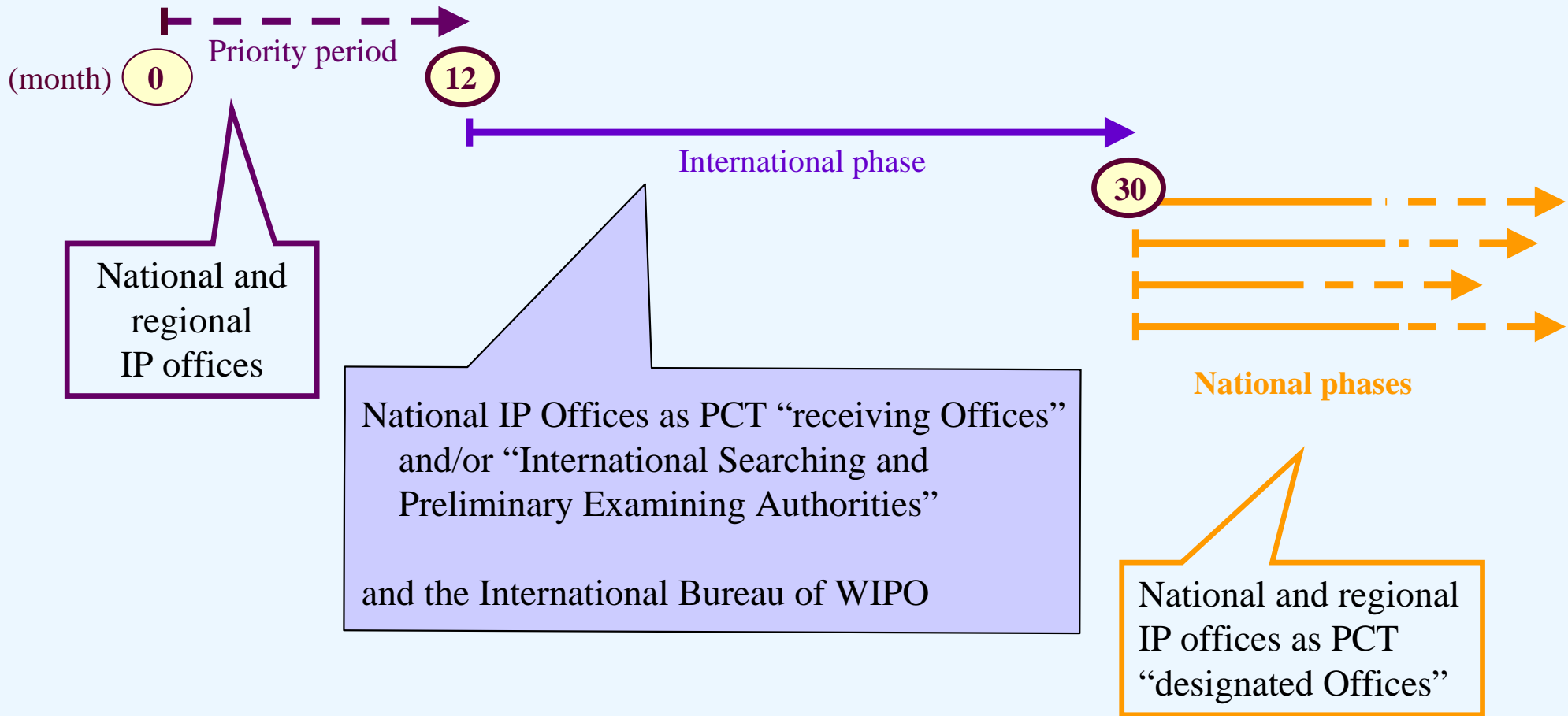
A model of international cooperation

- Relatively smooth operation of the system, amidst the challenges posed by the great diversity in:
 - culture of the various countries, in particular, their IP and patent cultures
 - their legal and patent systems
 - the respective official languages in use at the various Offices

- While extensive consultation processes are aimed at finding a balance throughout the entire system: via sessions of the various bodies and other meetings, electronic forums, informal discussions, etc.

- It remains essential that the PCT cater for the peculiarities of national laws and practices, hence its inherent intricacies, e.g.:
 - US law: inventorship and the qualifying applicant
 - JP law: self-designation effect when priority is claimed
 - EPC: “WTO priorities” not recognized until entry into force of EPC 2000

The main offices and organizations involved



Sharing PCT responsibilities

-- the receiving Office

- is one of the following:
 - the national Office of any Contracting State willing to assume this responsibility
 - the regional Office acting for one or more Contracting States, with their consent
 - the International Bureau, by decision of the PCT Union Assembly

- specifies:
 - the international authority(ies) competent to carry out search and examination in relation to PCT applications filed with it
 - the language(s) in which PCT applications may be filed with it

- checks:
 - whether it is competent
 - the documents constituting and those accompanying the application
 - whether fees are paid
 - whether certain time limits are complied with

- receives and directs correspondence from the applicant to offices and authorities

- collects fees and transfers some of them to the ISA and the International Bureau

Sharing PCT responsibilities

-- International Searching and Preliminary Examining Authority

-- the ISA/IPEA is one of the following:

- the national Office of any Contracting State willing to assume this responsibility
- the regional Office acting for one or more Contracting States, with their consent
- or an intergovernmental organization

and is appointed by the PCT Union Assembly

[as ISA] - discovers the relevant prior art

- establishes the international search report
- produces a first written opinion on the patentability of the invention
- in certain cases, carries out “international-type searches”
with respect to national applications filed with certain Contracting States

[as IPEA] - produces a (second) opinion on the patentability of the invention

- examines amendments made to the application
or arguments presented by the applicant
- establishes the international preliminary report on patentability

Sharing PCT responsibilities

-- the International Bureau of WIPO

- acts as “Secretariat” of the PCT Union Assembly and other PCT bodies
- constitutes the framework for the general coordination of the PCT system amongst all PCT offices and authorities
- offers assistance to (current and potential) Contracting States and their Offices,
 - e.g., advice as to implementation of the PCT in the national law
- offers assistance to users of the system
 - e.g., guides, training courses, infoline

- maintains and publishes all PCT legal texts (Treaty and subsidiary texts)
- is the only receiving Office competent for all applicants,
 - regardless of their nationality or residence
- translates into English various parts of the application of a technical nature
- publishes all PCT applications and the PCT Gazette
- retains, for 30 years, the only legally binding copy of the PCT application

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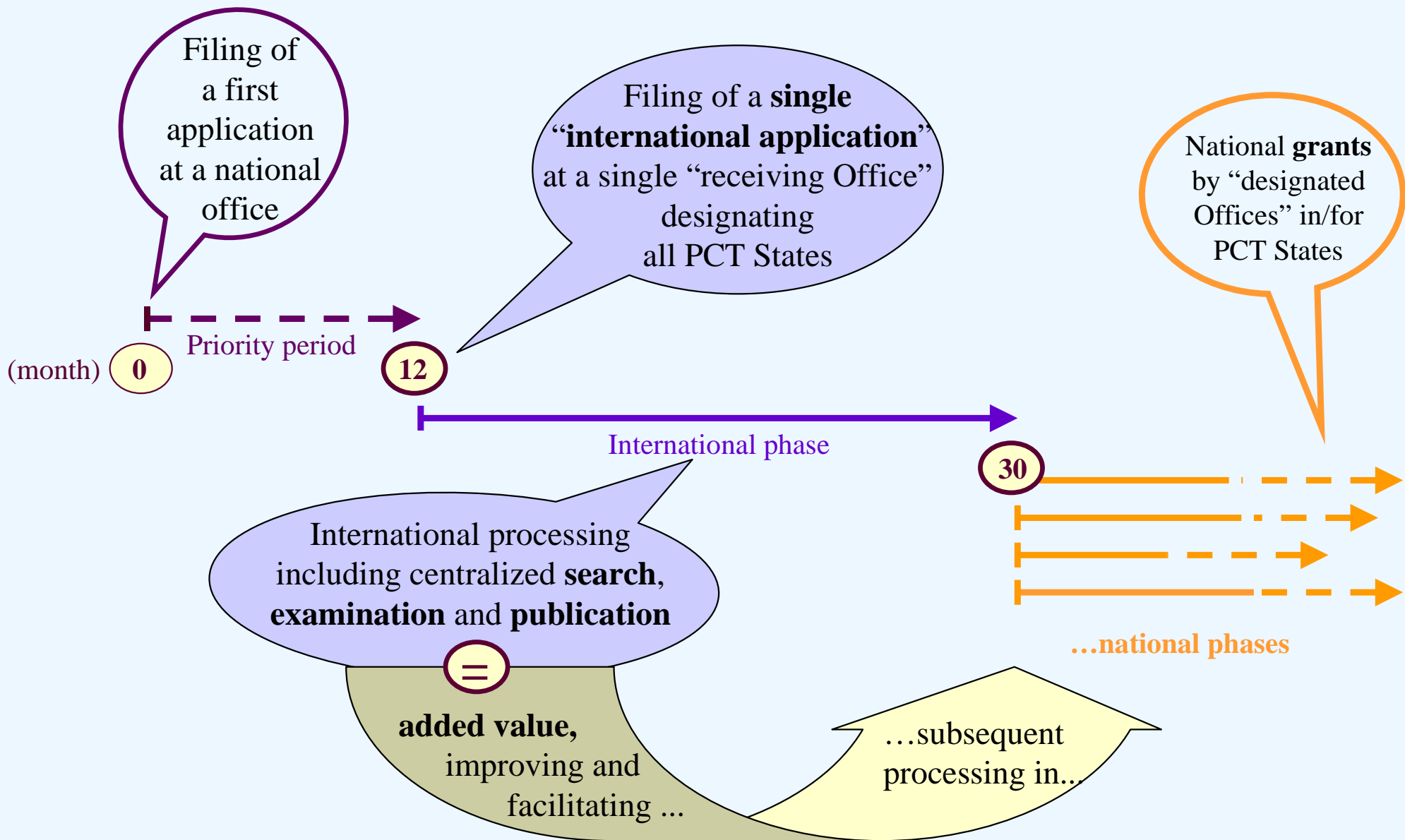
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An open door into a wealth of scientific and technical information via PatentScope

- from the date of international publication,
 - a wealth of information becomes available
 - bibliographical data about the international application
 - technical content of:
 - the application itself
 - any earlier application whose priority is claimed
 - through access to:
 - the published version of the full text of applications
 - the PCT Gazette
 - copies of documents contained in the file
 - access being facilitated by a number of on-line services and search tools from the WIPO Internet site, through a portal called “PatentScope” at: **<http://www.wipo.int/patentscope/en/>**

3

Outline of the PCT procedure



The international phase

4 steps

step 1 filing

step 2 search and unilateral examination on patentability

step 3 publication

(optional) **step 4** examination on patentability
(applicant may intervene)

Step 1—filing

Requires

- **one** applicant having a link with the PCT
nationality
or residence
- **one** description
- **one** claim

Step 1—filing

- **one** filing
- **one** language
- equates **actual national filing**
- in each PCT country

Step 1—filing

- **one** set of fees
- **one** agent only for international phase
- **one** centralized submission of other documents

Filing of the PCT application

- filing a patent application under the PCT guarantees the applicant
 - an international filing date
 - which is immediately effective in all PCT Contracting States
 - including recognition of priority rights claimed according to the Paris Convention
 - provided:
 - the applicant has a link with at least one PCT Contracting State (through nationality or residence)
 - the application fulfills a few minimum requirements (as to form and contents)

- depending on the selected office*, such filing may even be made:
 - at any time of day, any day of the year
 - in any language
 - without any signature, appointed agent, or payment
 - in paper or fully or partly electronic form

[for example, the International Bureau of WIPO]*

The international filing date

A few minimum requirements must be met:

- with respect to nationality or residence:
 - at least one of the applicants (natural person or legal entity) must be
 - either a national
 - or a resident of a PCT Contracting State

- with respect to the minimum contents of the international application:
 - a description
 - at least one claim
 - the name of the applicant whose indication of nationality or residence determines the link with a Contracting State
 - an indication that the application is filed under the PCT (“Petition”)

[the filing will constitute the designation of all PCT Contracting States]

Effects of the international application

- from the international filing date, the international application has :
 - the effect of a “regular national filing” within the meaning of the Paris Convention
 - in each designated State

- in other words :
 - the international filing date is considered to be the “actual” filing date in each designated State

- in addition, and to the extent the international application itself contains new matter, the priority of the international application may be claimed in a subsequent (national, regional or international) application in respect of such new matter

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...Outline of the procedure...

- ... the international phase

Step 2—search and unilateral examination

Search

- by **one** office
- relevant **prior art**
PCT definition
- results in **international search report**

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...Outline of the procedure...

- ... the international phase

Step 2—search and unilateral examination

Unilateral examination

- by **one** office (same as for search)
- opinion on patentability
- generally results in
international preliminary report on patentability
unless applicant requests optional examination

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...Outline of the procedure...

- ... the international phase

Step 3—publication

- by **WIPO**
- in one of **seven** publication languages
- full text in **electronic** and paper forms
available via Patentscope site
at www.wipo.int/patentscope/en/
- **with PCT file inspection** available via
<http://www.wipo.int/pctdb/en/search-adv.jsp>

International publication -- main features and effects (1)

- it is effected
 - by the International Bureau
 - “promptly” after the expiration of 18 months from the priority date
 - in two main formats: full text of applications (“pamphlets”) and gazette
 - each in two media: electronic and paper*
 - in one of the PCT publication languages
(Arabic*, Chinese, English, French, German, Japanese, Russian, Spanish)

** As from April 1, 2006, the only legal publication will be the electronic versions of both applications and gazette; paper copies will however remain available in certain cases*

*** Arabic becomes a PCT publication language as from April 1, 2006*

International publication -- main features and effects (2)

- its date constitutes the date on which the PCT application becomes part of the prior art
- it has the effect of a national publication in each of the designated States
 - with a few exceptions
- it can be stopped or delayed by the applicant
- it may take place earlier, upon the express request of the applicant

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...Outline of the procedure...

- ... the international phase

Step 4—Optional examination

- by **one** office (often same as for search)
- **second** opinion on patentability
 - if based on applicant's amendments and/or arguments
 - otherwise, usually same opinion as at search time
- results in **international preliminary report on patentability**

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...Outline of the procedure...

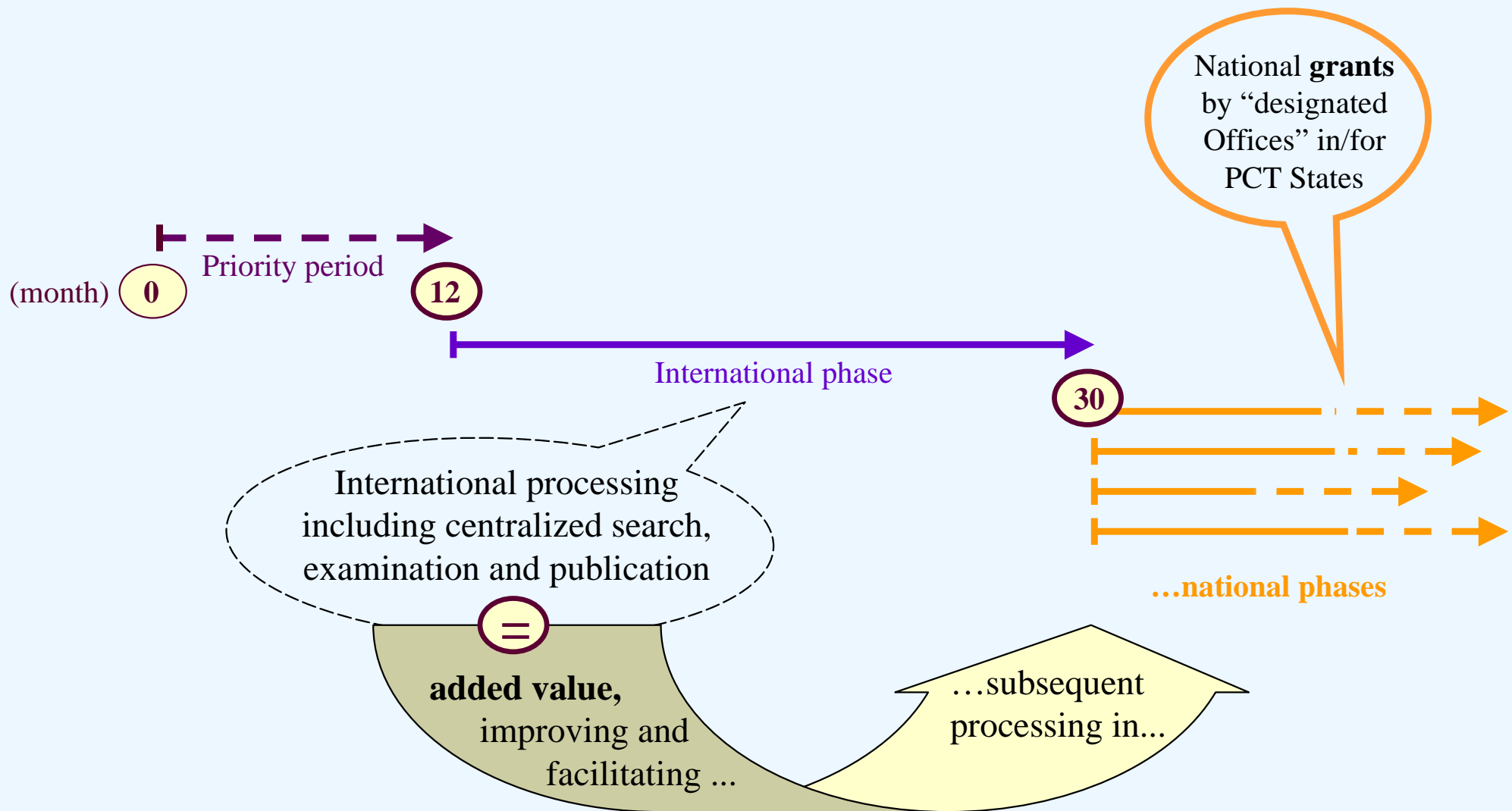
- **... the international phase**

Results of the international phase

- publication of full text
- international search report
- international preliminary report on patentability

Basis for national phase entry decision and process

The national phase



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...Outline of the procedure...

○ ○ ... the national phase

○ **must be entered**

by the applicant

before each designated Office

before the end of the international phase

○ **but only if**

patent protection still desired

National phase before designated Offices

- only relevant in (or for) PCT States
 - where the applicant still wants to obtain national (or regional) patents

- for each designated Office
 - at the express request of the applicant,
 - together with:
 - translation of the international application
 - and payment of the national fee

- within the time limit of 30 months from the priority date
 - (with a few exceptions
 - in particular time limit of 31 months,
 - and, in very rare cases time limit of 20 months)

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...Outline of the procedure...

○ ○ ... the national phase

- **Depending on national office, will proceed**
on basis of
only PCT reports (search and examination)
or PCT reports and national examination
or national examination only
- **Will end with**
grant
or rejection
or abandonment

What designated Offices may or may not require: general principles (1)

- time limit for compliance with national phase requirements
 - the Office cannot impose any obligation to comply with its requirements before the expiration of 30 months from the priority date

- form and contents of the international application
 - the Office can apply any requirements which are more favorable to applicants than those fixed in the Treaty and Regulations
 - the Office cannot apply requirements which are different from or add to the latter

- allegations or declarations contained in the application
 - the Office can require evidence
 - but only after national processing has commenced

- qualifying as applicant according to the national law
 - the Office of the designated State concerned can reject the application if the applicant is not the inventor (with respect to the US)

What designated Offices may or may not require : general principles (2)

- representation of the applicant for the purposes of national processing
 - the requirement of mandatory representation is permitted, but only once national processing has started

- substantive conditions of patentability
 - any criteria or other conditions of the national law are permitted in particular with respect to definition of prior art
 - the requirement to submit evidence is permitted

- preservation of the national security of the country
 - all measures that the country concerned considers necessary are permitted

- protection of the general economic interests of the country
 - all measures that the country concerned wishes to take are permitted, including those aimed at limiting the rights of its nationals or residents to file international applications

3 Public access to PCT and patent information

<http://www.wipo.int/patentscope/en/>

- central point of entry
- general legal, informational and training
- on specific applications
 - legal status
 - scientific and technical contents
- statistics
- other patent matters

3

...Public access to PCT and patent information...

- **Main PCT legal texts**
 - Treaty and
 - Regulations
 - Administrative Instructions
 - Legal notices in the PCT Gazette
 - WIPO Standards
 - authentic versions in English and French
 - for some texts
 - also in official translations in
 - Chinese, German, Italian, Japanese,
 - Portuguese, Russian, Spanish, etc.

3

...Public access to PCT and patent information...

- ○ **Main PCT information material**
 - PCT Applicant's Guide
English and French
 - PCT Newsletter
English
 - PCT seminar and training material
English, French, German, Spanish, Japanese, etc.
 - Notices, cumulative tables, lists, etc. on numerous PCT features

3

...Public access to PCT and patent information...

● ● ● other PCT and patent matters

- Patent and PCT statistics
 - filings
 - national phase entries
 - national grants
 - (several search criteria)
- General patent-related matters
 - patent law
 - Patent Law Treaty (PLT)
 - current patent issues

very much

Thank you for your attention

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