

The PCT system in 2004, 2005 and beyond ...

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This presentation will highlight the following topics:

- Some figures on filings
- Patent and PCT statistics
- Latest news on Contracting States and International Authorities
 - Effects of PCT Reform (January 1, 2004) ●
 - Amendments of the PCT Regulations (April 1, 2005) ●
 - Priority documents, forms of certification (October 2004) ●
- Patent Law Treaty (PLT) (April 28, 2005)
- International Patent Classification (IPC) Reform (January 1, 2006)
 - Changes under review, possible implementation beyond 2005 ●

Some figures..... on filings

One Million PCT Applications filed since June 1978
Milestone reached in Fall 2004

About 123,000 PCT Applications received in 2004 (+ 11% // 2003)
For 2005 : estimated increase of 6%

Evolution in **geographical distribution** :

JP in 2nd place (almost 20% of filings), behind the US (35%),
and ahead of DE (12%), FR (<5%), GB (<5%), NL (<4%)

Some figures.....on electronic filings

Evolution of e-filings compared to paper filings :

13.5% filings online or on CD or DVD (<8% XML and <6% pdf)
34.5% paper filings with PCT-EASY request (on diskette)
52% filings entirely on paper

In **number** of filings :

JP (5,400)*, EP (2,600), IB (2,000), KR (1,400), FR (378), etc.

In **% of total** filings with the corresponding receiving Office :

KR (52%), IB (35%), JP (33%)*, FI (19%),
EP (18%), ES (14%), FR (13%), etc.

* E-filing available since end-April 2004 for PCT applications filed in Japan

Some figures on filings at the RO/IB as receiving Office

7,000 filings in 2004, or + 8% // 2003

For 2005 : estimated increase of 14%

In **17 languages**

of which 91.5% in English et 1.7% in French

From **more than 90** countries

top 10 being the following :

NL (34.6%), US (10%), FI (7%), IT (7%), DE (6.3%),
CH (5%), FR (4.3%), ZA (3.8%), IN (3.5%), CA (2.5%)

35% of applications filed **online** (PCT-SAFE)

The most frequent PCT users in 2004*

1.	Philips	NL	+ 2,360
2.	Matsushita	JP	+ 1,710
3.	Siemens	DE	+ 1,290
4.	Nokia	FI	+ 800
5.	Bosch	DE	+ 700
6.	Intel	US	+ 600
7.	BASF	DE	+ 590
8.	3M	US	+ 590
9.	Motorola	US	+ 570
10.	Sony	JP	+ 570
11.	Mitsubishi	JP	+ 560
12.	Ericsson	SE	+ 530
13.	DaimlerChrysler	DE	+ 520
14.	Bayer	DE	+ 470
15.	Honeywell	US	+ 410
16.	Procter & Gamble	US	+ 390
17.	IBM	US	+ 390
18.	Thomson Lic.	FR	+ 390
19.	DuPont	US	+ 370
20.	Samsung	KR	+ 370

Also from emerging countries :

Samsung	KR	+ 370
LG Electronics	KR	+ 310
Huawei Tech.	CN	+ 170
Ranbaxy Labs.	IN	< 160
ZTE Corp.	CN	< 150

The top 20 PCT filers represented about 12 % of all filings in 2004

* according to provisional ranking

Patent and PCT statistics

Dedicated page to IP statistics on the WIPO website
(access via the PCT homepage)

- PCT public data
- Patent statistics (WIPO collections)

Aims of the International Bureau :

Accuracy of the data

Reliable and user-friendly system at the disposal of
diverse categories of users

Any comments are welcome !

Latest newson Contracting States

New PCT Contracting States:

The Comoros (KM) bound as from April 3, 2005
Nigeria (NG) to be bound as from May 8, 2005

Agreements on the **extension of European Patents**:

Serbia and Montenegro (YU) as from November 1, 2004
Bosnia and Herzegovina (BA) as from December 1, 2004

similar agreements still in force:

Albania, Croatia, Latvia (only until July 1, 2005, date on which Latvia becomes an EPC Member State), the former Yugoslav Republic of Macedonia

Latest newson International Authorities

Canada In July 2004, the Canadian IP Office started functioning as an **ISA / IPEA** for applications filed by applicants from Canada

Finland In April 2005, the National Board of Patents and Registration started functioning as an **ISA / IPEA** for applications filed by applicants from Finland

EPO The **limitation** of the EPO's competence as an ISA and IPEA (applying, since March 1, 2002, but only to PCT/US or PCT/IB filings) in the field of:

- **business methods**: was prolonged until March 1, 2007 (for demands filed until that date)

(Reminder: the limitations in the fields of **biotechnology and telecommunications** stopped applying with international applications filed since January 1, 2004)

Effects of PCT Reform....in force from January 1, 2004

1-- Global and automatic designation system

- the **request “constitutes” the designation** of all Contracting States bound as at the international filing date
- **exclusion of certain designations** (“self-designation effect”) **applies only to DE, KR, RU** designations (for national protection)
in practice, the exclusions remain marginal
- **does not apply to JP** designation
withdrawal of JP designation (to avoid “**self-designation effect**”) in nearly 50% of cases by Japanese applicants
- choice for type of protection (national or regional, patent or other title) to be made only at time of entry into the national phase
- **withdrawal of any designation** remains possible at any time until 30 months from priority date

Effects of PCT Reform....in force from January 1, 2004

- 2-- **Chapter II demands:** the number of demands for international preliminary examination under Chapter II
 - **has decreased** since 2002
(decrease of 0.5% in 2002, of 20% in 2003, of 27% in 2004)
 - for 2005, it has been estimated that it **will decrease** to around 30% of filings

Effects of PCT Reform....in force from January 1, 2004

3-- Enhanced international search and preliminary examination system

Refer also to new PCT Search and Examination Guidelines, available from WIPO website

- Special PCT Gazette No. 02/2004 of March 25, 2004
- correspond to USPTO MPEP and EPO Examination Guidelines

- written opinion by the **ISA**

- **informal comments** “in response” to the written opinion by the ISA

- demand for Chapter II examination
 - new actual time limit** (minimum of 22 months from priority date)

- written opinion by the **IPEA**
 - if same Authority as ISA
 - if not same Authority as ISA

- establishment of International Preliminary Report on Patentability
“IPRP (Chapter II)” by IPEA

- conversion by the IB of ISA written opinion into **“IPRP (Chapter I)”**

Effects of PCT Reform....in force from January 1, 2004

4-- What the enhanced international search and preliminary examination system has not (really) changed

- applicant's entitlement to and time limit for **amending the claims under Article 19** after issuance of the search report

- applicant's entitlement to and time limit for **amending the description, claims and drawings under Article 34**, but
 - strong recommendation to **file amendments with the demand** instead of waiting for IPEA written opinion, so as to ensure that amendments will be considered by the IPEA before it issues the new Chapter II IPRP report (former "IPER")

- distinctions between amendments, rectifications of obvious errors and corrections of informalities remain unchanged

Amendments of the PCT Regulations in force from April 1, 2005

1-- Protest procedure in case of lack of unity of invention

- all **time limits fixed at one month** (Rules 40.1 and 68.2)
- references to a “**review body**” constituted in the framework of the ISA/IPEA replacing the “three member board”, “special instance” or “competent higher Authority” (Rules 40.2 and 68.3)
- the examiner who made the decision which is the subject of the protest **can be a member of the review body**, but cannot be the only member (Rules 40.2(d) et 68.3(d)); the former Rules excluded this possibility
- the ISA/IPEA which wishes to require the payment of a protest fee for the review of the protest **is not required to apply a two stage review process** (Rules 40.2(e) and 68.3(e))

(refer also to modifications of Annex B (Unity of invention) of the Administrative Instructions)

Amendments of the PCT Regulations

in force from April 1, 2005

2-- Late furnishing fee for sequence listings (Rules 13*ter*.1 and 13*ter*.2)

- **may** be required by the ISA
- applies to listings **both in electronic as well as paper** forms
- **cannot exceed 25%** of the international filing fee

Amendments of the PCT Regulations

in force from April 1, 2005

3-- Corrigenda and consequential amendments, further to the amendments in force since January 1, 2004

- in respect to Rules :
- 3.3(a)(ii)
 - 4.6(a)
 - 16*bis*.1(a) and (c)
 - 23.1(c)
 - 43*bis*.1(a)
 - 44.1
 - 53.9(b)
 - 69.1(a)(iii)
 - 69.1(d)(iii)
 - 76.5

Amendments of the PCT Regulations

in force from April 1, 2005

4-- Other consequential modifications

-- Administrative Instructions

sequence listings

(Sections 208, 313, 513, 801-804, Annexes C and C-*bis*)

protest procedure in case of non-unity of invention

(Section 403, 502, 603)

electronic filing and processing (Sections 101, 701, 702)

-- Forms, in particular:

Request (PCT/RO/101)

ISR (PCT/ISA/210)

WO by IPEA (PCT/IPEA/408)

I PRP (Chapter II) (PCT/IPEA/409)

Amendments of the PCT Regulations

from April 1, 2005

5-- The amended Rules and other modified texts and forms

- **apply** to all international applications whose international filing date is on or after April 1, 2005
- **do not apply** to international applications whose international filing date is before April 1, 2005,
 - **exception**: amended Rules 13*ter*.2, 53.9, 68.2, 68.3 and 69.1 apply to any international application for which a demand for international preliminary examination is filed on or after April 1, 2005, regardless of the international filing date

Priority documents.....forms of certification (effective October 2004)

The Assemblies of the Paris and PCT Unions, meeting jointly in October 2004, agreed on the following principles :

- it is for the competent Authority furnishing the priority document to **determine what constitutes certification and how it will proceed**
- each Office must accept a single certification that applies to more than one priority document (“**collective certification**”)
- **in the framework of the PCT**, once a priority document has been certified by the receiving Office, and transmitted to the International Bureau in electronic form, no designated Office may require a different form of certification or any re-certification
 - - the International Bureau will continue, on request by any designated Office, to **furnish copies in paper form** of priority documents

The Patent Law Treaty (PLT)entered into force on April 28, 2005 (1)

Ten States are now bound, after having adhered to or ratified the Treaty:

Croatia, Denmark, Estonia, Kyrgyzstan, Moldova,
Nigeria, Romania, Slovakia, Slovenia, Ukraine

Main features:

- applies to national and regional applications and during the national phase of PCT international applications (but after entry into national phase)
- filing date requirements
- standardized applications
- standardized forms
- simplified procedures before the Office
- avoiding loss of rights
- co-existence of paper and electronic filing and communications

The Patent Law Treaty (PLT) ...entered into force on April 28, 2005 (2)

Advantages

for applicants and their representatives:

- **predictable, uniform and simple procedures**
- opportunity to **correct errors**
- **reduced risk of loss of rights** and enhanced legal certainty
- **cost reduction**

for Offices:

- enhanced **efficiency in operations**

The International Patent Classification (IPC) Reformwill enter into force on January 1, 2006

Aims

adapt the IPC to an electronic environment
increase its efficiency for the retrieval of patent information
facilitate its use by IP offices and the general public

Introduction of a two-level structure :

core level (20,000 entries), to be revised every 3 years
advanced level (70,000 entries), continuous revision

Introduction by International Authorities of **a system of monitoring the validity** of IPC symbols assigned

Certain ISA/IPEAs have announced that they will not be able to respect the date of entry into force

Changes under review, implementation beyond 2005...

What will be presented to the PCT Assembly in September 2005

- entry into force proposed for **beginning 2006**
- entry into force proposed for **2007**

Reasons why **new proposals must be presented** to the Working Group on Reform of the PCT between end 2005 and early 2006

What is no longer under review

What is being continued without changes to the legal framework

Changes under review, implementation beyond 2005...

What will be presented to the PCT Assembly in September 2005

with entry into force proposed for **beginning 2006:**

- online international publication of PCT applications
- introduction of Arabic as a PCT publication language
- modification of the conditions for the exclusion of certain designations (“self-designation effect”) (modification of Rule 4.9(b))

Changes under review, implementation beyond 2005...

Online international publication of PCT applications

- **for pamphlets**, the legal framework is in place since April 1, 2005 (modified Section 406 of the Administrative Instructions)
Section 406(b):
“Pamphlets may be published, for the purposes of Article 21, on paper or wholly or partly in electronic form.”
- **starting date will be determined**, when technical systems are ready, and notice will be published in Gazette
- **applicants** will no longer systematically receive paper copies of pamphlets, but **will be notified of Internet address of the online publication** (but paper copies will remain available, upon their express request)
- **publication of PCT Gazette** exclusively in electronic form requires an amendment of Rule 86

(Refer to PCT Gazette No.13/2005, dated March 31, 2005)

Changes under review, implementation beyond 2005...

Introduction of Arabic as a PCT publication language

- at the request of **Egypt**
- applications filed in Arabic would be **published in Arabic**
- for as long as there will be no ISA / IPEA accepting Arabic as a search and examination language,

applicant would be required to file a translation

into a search and examination language accepted by the ISA / IPEA

(refer to documents PCT/R/WG/7/10, April 18, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

What will be presented to the PCT Assembly in September 2005

with entry into force proposed for **2007**:

- missing elements or parts of the international application
- restoration of the right of priority
- rectification of obvious mistakes
- inclusion of Korean patent documents to PCT minimum documentation

Changes under review, implementation beyond 2005...

Missing elements or parts of the international application

Later furnishing of missing parts

will **no longer** affect the international filing date provided that:

- the Request contains an **incorporation by reference** of the description, claims and/or drawings (or parts thereof) which are contained in the priority application, and
- the applicant **confirms the incorporation** by reference, with a copy of the relevant document or pages,
- within a **time limit of two months**

Possibility for receiving Offices and designated Offices to **notify incompatibility** of future modified Rules with national law

(Refer to documents PCT/R/WG/7/2, dated April 5, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

Restoration of the right of priority (1)

- A. **retention of priority claim during the international phase:**
 - international filing date is later than 12 months after priority date but within 2 months from the expiration of these 12 months
- B. **restoration of the right of priority by the receiving Office** during the international phase
 - for consistency with the PLT,
 - on the basis of “due care” or “unintentionality”
- C. **effect of receiving Office decision on designated States**
 - if “due care”: receiving Office decision effective in all designated States
 - if “unintentionality”: receiving Office decision effective only in designated States which apply that criterion or a more favorable criterion

Changes under review, implementation beyond 2005...

Restoration of the right of priority (2)

- D. **prior art** for the purposes of international search, written opinions and IPRPs
 - **no effect on international search**
since “relevant date” is the international filing date
 - for written opinions and preliminary examination,
proposal to **consider as “relevant date” the priority date**
unless the Authority expressly considers the priority claim not to be valid

(refer to documents PCT/R/WG/7/3, April 5, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

Rectification of obvious mistakes (1)

- "**notional person**" who should understand what was intended by the applicant and should make the finding whether the alleged mistake is obvious
 - ["**obvious to the competent Authority**"
rather than "obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification" (as at present)]
- **new actual single time limit** for requesting rectification in all cases:
26 months from priority date
- use of **evidence** (documents) contained in the file as at the relevant date
- mistakes which are **not rectifiable**: omission of entire element(s) or sheet(s) (but refer to "incorporation by reference")

Changes under review, implementation beyond 2005...

Rectification of obvious mistakes (2)

- **effect on search reports, written opinions, examination reports**

 - not if** ISA/IPEA has started to draw up report or opinion

- **effect on designated Offices**

 - not if** national processing has started before Office being notified

- **rectification still possible by designated Offices** during national phase of mistakes made by the receiving Office or by the International Bureau

- **possibility for a designated Office not to take a rectification into account** which it would not have authorized as a “competent Authority”

(refer to documents PCT/R/WG/7/6, dated April 5, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

PCT minimum documentation

- review of the **concept**
- **definition** and **content**
- addition of **Korean patent documents** (KIPRIS)
- inclusion of sources of information on **traditional knowledge**

Note: **Thirteen TK periodicals already included**
(following approval by the Meeting of International
Authorities since 2003)

(refer to documents PCT/MIA/11/14, dated February 25, 2005,
PCT/R/WG/7/11, dated April 18, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

What must be reviewed and new proposals presented to the Working Group on PCT Reform (between end 2005 and early 2006)

- international publication in multiple languages
- supplementary international searches
- Swiss proposal relating to the declaration of the source of genetic resources and traditional knowledge in patent applications

Changes under review, applicable beyond 2005...

International publication in multiple languages

-- **applicant would be entitled to request publication** of the international application:

- **in one or more languages**, other than “the” language of publication
- **in the language of filing** if it is not “the” language of publication

in order to benefit from certain effects under certain national laws, if publication is in a certain language :

- **prior art effect**
- **provisional protection**

(refer to documents PCT/R/WG/7/4, April 5, 2005 and 7/13, May 31, 2005)

Changes under review, implementation beyond 2005...

Supplementary international searches

- introduced as a means of **improving the quality** of international searches
- but should **avoid duplication** of main international search
- **ISAs would be free to decide whether or not to offer** such searches (without affecting timeliness and quality of main searches)
- **applicant** would **be free to choose the ISA** amongst those agreeing to participate
- **primary purpose** of a supplementary international search should be to **find prior art in languages or in extended prior art collections** which are the specialization of the supplementary Authority and not of the main Authority
- **results** of the supplementary search would be **available to the public**

(refer to documents PCT/R/WG/7/7, dated April 11, 2005 and May 31, 2005)

Changes no longer under review...

Centralized recording of certain changes by the International Bureau

Rejection by Member States of the proposal of **single and centralized** recording of changes which would have applied not only during the international phase but also **during the national phase**

Rejection for the following reasons:

- - legal basis?
- - complication of the procedure
- - duplication of the workload
- - risk of confusion for the applicants and third parties
- - legal uncertainty as to national recordings

(refer to documents PCT/R/WG/7/5, dated April 5, 2005 and May 31, 2005)

Changes which do not require amendments to the legal framework ...

Online access to documents and data of PCT applications

- - via a **new database** currently under development at WIPO
- - **three groups of users:**
 - applicants and agents, Offices and Authorities, general public
- - **each group with different:**
 - access rights, levels of security
- - **implementation expected to be in phases and by modules**

**Thank you
for your attention...**